

CANADA

Trade-marks Act

Last amended on September 21, 2017

Current to October 13, 2017

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SHORT TITLE

1. Short title

This Act may be cited as the Trade-marks Act.

INTERPRETATION

2. Definitions

In this Act,

certification mark means a mark that is used for the purpose of distinguishing or so as to distinguish wares or services that are of a defined standard with respect to

- (a) the character or quality of the wares or services,
- (b) the working conditions under which the wares have been produced or the services performed,
- (c) the class of persons by whom the wares have been produced or the services performed, or
- (d) the area within which the wares have been produced or the services performed, from wares or services that are not of that defined standard;

confusing, when applied as an adjective to a trade-mark or trade-name, means a trade-mark or trade-name the use of which would cause confusion in the manner and circumstances described in section 6;

Convention means the Convention of the Union of Paris made on March 20, 1883 and any amendments and revisions thereof made before or after July 1, 1954 to which Canada is party;

country of origin means

- (a) the country of the Union in which the applicant for registration of a trade-mark had at the date of the application a real and effective industrial or commercial establishment, or
- (b) if the applicant for registration of a trade-mark did not at the date of the application have in a country of the Union an establishment as described in paragraph (a), the country of the Union where he on that date had his domicile, or
- (c) if the applicant for registration of a trade-mark did not at the date of the application have in a country of the Union an establishment as described in paragraph (a) or a domicile as described in paragraph (b), the country of the Union of which he was on that date a citizen or national;

country of the Union means

- (a) any country that is a member of the Union for the Protection of Industrial Property constituted under the Convention, or
- (b) any WTO Member;

distinctive, in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is

adapted so to distinguish them;

distinguishing guise means

(a) a shaping of wares or their containers, or

(b) a mode of wrapping or packaging wares

the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others;

geographical indication means, in respect of a wine or spirit, an indication that

(a) identifies the wine or spirit as originating in the territory of a WTO Member, or a region or locality of that territory, where a quality, reputation or other characteristic of the wine or spirit is essentially attributable to its geographical origin, and

(b) except in the case of an indication identifying a wine or spirit originating in Canada, is protected by the laws applicable to that WTO Member;

owner, in relation to a certification mark, means the person by whom the defined standard has been established;

package [Repealed]

person includes any lawful trade union and any lawful association engaged in trade or business or the promotion thereof, and the administrative authority of any country, state, province, municipality or other organized administrative area;

person interested includes any person who is affected or reasonably apprehends that he may be affected by any entry in the register, or by any act or omission or contemplated act or omission under or contrary to this Act, and includes the Attorney General of Canada;

prescribed means prescribed by or under the regulations;

proposed trade-mark means a mark that is proposed to be used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others;

protected geographical indication means a geographical indication that is on the list kept pursuant to subsection 11.12(1);

register means the register kept under section 26;

registered trade-mark means a trade-mark that is on the register;

registered user [Repealed]

Registrar means the Registrar of Trade-marks appointed under section 63;

related companies means companies that are members of a group of two

or more companies one of which, directly or indirectly, owns or controls a majority of the issued voting stock of the others;

representative for service means the person or firm named under paragraph 30(g), subsection 38(3), paragraph 41(1)(a) or subsection 42(1);

trade-mark means

(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

(b) a certification mark,

(c) a distinguishing guise, or

(d) a proposed trade-mark;

trade-name means the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual;

use, in relation to a trade-mark, means any use that by section 4 is deemed to be a use in association with wares or services;

wares [Repealed]

WTO Agreement has the meaning given to the word "Agreement" by subsection 2(1) of the World Trade Organization Agreement Implementation Act;

WTO Member means a Member of the World Trade Organization established by Article I of the WTO Agreement.

3. When deemed to be adopted

A trade-mark is deemed to have been adopted by a person when that person or his predecessor in title commenced to use it in Canada or to make it known in Canada or, if that person or his predecessor had not previously so used it or made it known, when that person or his predecessor filed an application for its registration in Canada.

4. When deemed to be used

(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

Idem

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

Use by export

(3) A trade-mark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

5. When deemed to be made known

A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with goods or services, and

- (a) the goods are distributed in association with it in Canada, or
 - (b) the goods or services are advertised in association with it in
 - (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the goods or services, or
 - (ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the goods or services,
- and it has become well known in Canada by reason of the distribution or advertising.

6. When mark or name confusing

(1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

Idem

(2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

Idem

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the goods or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or

performed by the same person, whether or not the goods or services are of the same general class.

Idem

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the goods or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

What to be considered

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

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

UNFAIR COMPETITION AND PROHIBITED MARKS

7. Prohibitions

No person shall

- (a) make a false or misleading statement tending to discredit the business, goods or services of a competitor;
- (b) direct public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his goods, services or business and the goods, services or business of another;
- (c) pass off other goods or services as and for those ordered or requested;
- (d) make use, in association with goods or services, of any description that is false in a material respect and likely to mislead the public as to
 - (i) the character, quality, quantity or composition,
 - (ii) the geographical origin, or
 - (iii) the mode of the manufacture, production or performance of the goods or services.
- (e) [Repealed]

8. Warranty of lawful use

Every person who in the course of trade transfers the property in or the possession of any goods bearing, or in packages bearing, any trade-mark or trade-name shall, unless before the transfer he otherwise expressly states in writing, be deemed to warrant, to the person to whom the property or possession is transferred, that the trade-mark or trade-name has been and may be lawfully used in connection with the goods.

9. Prohibited marks

- (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,
 - (a) the Royal Arms, Crest or Standard;
 - (b) the arms or crest of any member of the Royal Family;
 - (c) the standard, arms or crest of His Excellency the Governor General;
 - (d) any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;

(e) the arms, crest or flag adopted and used at any time by Canada or by any province or municipal corporation in Canada in respect of which the Registrar has, at the request of the Government of Canada or of the province or municipal corporation concerned, given public notice of its adoption and use;

(f) the emblem of the Red Cross on a white ground, formed by reversing the federal colours of Switzerland and retained by the Geneva Convention for the Protection of War Victims of 1949 as the emblem and distinctive sign of the Medical Service of armed forces and used by the Canadian Red Cross Society, or the expression "Red Cross" or "Geneva Cross";

(g) the emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f);

(g.1) the third Protocol emblem – commonly known as the "Red Crystal" – referred to in Article 2, paragraph 2 of Schedule VII to the *Geneva Conventions Act* and composed of a red frame in the shape of a square on edge on a white ground, adopted for the same purpose as specified in paragraph (f);

(h) the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f);

(h.1) the international distinctive sign of civil defence (equilateral blue triangle on an orange ground) referred to in Article 66, paragraph 4 of Schedule V to the *Geneva Conventions Act*;

(i) any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;

(i.1) any official sign or hallmark indicating control or warranty adopted by a country of the Union, if the sign or hallmark is on a list communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;

(i.2) any national flag of a country of the Union;

(i.3) any armorial bearing, flag or other emblem, or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem or abbreviation is on a list

communicated under article 6ter of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;

(j) any scandalous, obscene or immoral word or device;

(k) any matter that may falsely suggest a connection with any living individual;

(l) the portrait or signature of any individual who is living or has died within the preceding thirty years;

(m) the words "United Nations" or the official seal or emblem of the United Nations;

(n) any badge, crest, emblem or mark

(i) adopted or used by any of Her Majesty's Forces as defined in the National Defence Act,

(ii) of any university, or

(iii) adopted and used by any public authority, in Canada as an official mark for goods or services,

in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

(n.1) any armorial bearings granted, recorded or approved for use by a recipient pursuant to the prerogative powers of Her Majesty as exercised by the Governor General in respect of the granting of armorial bearings, if the Registrar has, at the request of the Governor General, given public notice of the grant, recording or approval; or

(o) the name "Royal Canadian Mounted Police" or "R.C.M.P." or any other combination of letters relating to the Royal Canadian Mounted Police, or any pictorial representation of a uniformed member thereof.

Excepted uses

(2) Nothing in this section prevents the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of any mark

(a) described in subsection (1) with the consent of Her Majesty or such other person, society, authority or organization as may be considered to have been intended to be protected by this section; or

(b) consisting of, or so nearly resembling as to be likely to be mistaken for

(i) an official sign or hallmark mentioned in paragraph (1)(i.1), except in respect of goods that are the same or similar to the goods in respect of which the official sign or hallmark has been adopted,

or

(ii) an armorial bearing, flag, emblem or abbreviation mentioned in paragraph (1)(i.3), unless the use of the mark is likely to mislead the public as to a connection between the user and the organization.

10. Further prohibitions

Where any mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, no person shall adopt it as a trade-mark in association with such goods or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

10.1 Further prohibitions

Where a denomination must, under the *Plant Breeders' Rights Act*, be used to designate a plant variety, no person shall adopt it as a trade-mark in association with the plant variety or another plant variety of the same species or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that denomination as to be likely to be mistaken therefor.

11. Further prohibitions

No person shall use in connection with a business, as a trade-mark or otherwise, any mark adopted contrary to section 9 or 10 of this Act or section 13 or 14 of the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952.

11.1 Further prohibitions

No person shall use in connection with a business, as a trade-mark or otherwise, any denomination adopted contrary to section 10.1.

11.11 Definitions

In sections 11.12 to 11.2,

Minister means the member of the Queen's Privy Council for Canada designated as the Minister for the purposes of sections 11.12 to 11.2; **responsible authority** means, in relation to a wine or spirit, the person, firm or other entity that, in the opinion of the Minister, is, by reason of state or commercial interest, sufficiently connected with and knowledgeable of that wine or spirit to be a party to any

proceedings in respect of an objection filed under subsection 11.13(1).

11.12 List

(1) There shall be kept under the supervision of the Registrar a list of geographical indications.

Statement of Minister

(2) Where a statement by the Minister, setting out in respect of an indication the information mentioned in subsection (3), is published in the Canada Gazette and

(a) a statement of objection has not been filed and served on the responsible authority in accordance with subsection 11.13(1) and the time for the filing of the statement of objection has expired, or

(b) a statement of objection has been so filed and served, but it has been withdrawn or deemed under subsection 11.13(6) to have been withdrawn or it has been rejected pursuant to subsection 11.13(7) or, if an appeal is taken, it is rejected pursuant to the final judgment given in the appeal,

the Registrar shall enter the indication on the list of geographical indications kept pursuant to subsection (1).

Information

(3) For the purposes of subsection (2), the statement by the Minister must set out the following information in respect of an indication:

(a) that the Minister proposes that the indication be entered on the list of geographical indications kept pursuant to subsection (1);

(b) that the indication identifies a wine or that the indication identifies a spirit;

(c) the territory, or the region or locality of a territory, in which the wine or spirit is identified as originating;

(d) the name of the responsible authority in relation to the wine or spirit and the address of the responsible authority's principal office or place of business in Canada, if any, and if the responsible authority has no office or place of business in Canada, the name and address in Canada of a person or firm on whom service of any document or proceedings in respect of an objection may be given or served with the same effect as if they had been given to or served on the responsible authority itself; and

(e) the quality, reputation or other characteristic of the wine or spirit that, in the opinion of the Minister, qualifies that indication as a geographical indication.

Removal from list

(4) The Registrar shall remove an indication from the list of

geographical indications kept pursuant to subsection (1) on the publication in the *Canada Gazette* of a statement by the Minister that the indication is to be removed.

11.13 Statement of objection

(1) Within three months after the publication in the *Canada Gazette* of a statement referred to in subsection 11.12(2), any person interested may, on payment of the prescribed fee, file with the Registrar, and serve on the responsible authority in the prescribed manner, a statement of objection.

Ground

(2) A statement of objection may be based only on the ground that the indication is not a geographical indication.

Content

(3) A statement of objection shall set out

(a) the ground of objection in sufficient detail to enable the responsible authority to reply thereto; and

(b) the address of the objector's principal office or place of business in Canada, if any, and if the objector has no office or place of business in Canada, the address of the principal office or place of business abroad and the name and address in Canada of a person or firm on whom service of any document in respect of the objection may be made with the same effect as if it had been served on the objector.

Counter statement

(4) Within three months after a statement of objection has been served on the responsible authority, the responsible authority may file a counter statement with the Registrar and serve a copy on the objector in the prescribed manner, and if the responsible authority does not so file and serve a counter statement, the indication shall not be entered on the list of geographical indications.

Evidence and hearing

(5) Both the objector and the responsible authority shall be given an opportunity, in the manner prescribed, to submit evidence and to make representations to the Registrar unless

(a) the responsible authority does not file and serve a counter statement in accordance with subsection (4) or if, in the prescribed circumstances, the responsible authority does not submit evidence or a statement that the responsible authority does not wish to submit evidence; or

(b) the objection is withdrawn or deemed under subsection (6) to have been withdrawn.

Withdrawal of objection

(6) The objection shall be deemed to have been withdrawn if, in the prescribed circumstances, the objector does not submit evidence or a statement that the objector does not wish to submit evidence.

Decision

(7) After considering the evidence and representations of the objector and the responsible authority, the Registrar shall decide that the indication is not a geographical indication or reject the objection, and notify the parties of the decision and the reasons for the decision.

11.14 Prohibited adoption of indication for wines

(1) No person shall adopt in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a wine in respect of a wine not originating in the territory indicated by the protected geographical indication; or

(b) a translation in any language of the geographical indication in respect of that wine.

Prohibited use

(2) No person shall use in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a wine in respect of a wine not originating in the territory indicated by the protected geographical indication or adopted contrary to subsection (1); or

(b) a translation in any language of the geographical indication in respect of that wine.

Prohibited use

(3) No person shall use in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a wine in respect of a wine that originates in the territory indicated by the protected geographical indication if that wine was not produced or manufactured in accordance with the law applicable to that territory; or

(b) a translation in any language of the geographical indication in respect of that wine.

Prohibited adoption of indication for spirits

(4) No person shall adopt in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a spirit in respect of a spirit not originating in the territory indicated by the protected geographical indication; or

(b) a translation in any language of the geographical indication in respect of that spirit.

Prohibited use

(5) No person shall use in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a spirit in respect of a spirit not originating in the territory indicated by the protected geographical indication or adopted contrary to subsection (4); or

(b) a translation in any language of the geographical indication in respect of that spirit.

Prohibited use

(6) No person shall use in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a spirit in respect of a spirit that originates in the territory indicated by the protected geographical indication if that spirit was not produced or manufactured in accordance with the law applicable to that territory; or

(b) a translation in any language of the geographical indication in respect of that spirit.

11.15 Prohibited adoption of indication for spirits

(1) No person shall adopt in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a spirit in respect of a spirit not originating in the territory indicated by the protected geographical indication; or

(b) a translation on the list kept under subsection 11.12(1) of the protected geographical indication in respect of that agricultural product or food.

Prohibited use

(2) No person shall use in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying an agricultural product or food of a category set out in the schedule in respect of an agricultural product or food belonging to the same category that does not originate in the territory indicated by the protected geographical indication or adopted contrary to subsection (1); or

(b) a translation on the list kept under subsection 11.12(1) of the protected geographical indication in respect of that agricultural

product or food.

Prohibited use

(3) No person shall use in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying an agricultural product or food of a category set out in the schedule in respect of an agricultural product or food belonging to the same category that originates in the territory indicated by the protected geographical indication if that agricultural product or food was not produced or manufactured in accordance with the law applicable to that territory; or

(b) a translation on the list kept under subsection 11.12(1) of the protected geographical indication in respect of that agricultural product or food.

11.16 Exception when authorized

(1) Sections 11.14 and 11.15 and paragraphs 12(1)(g) to (h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of a protected geographical indication, or any translation of it in any language, with the consent of the responsible authority.

Exception for personal names

(2) Sections 11.14 and 11.15 do not prevent a person from using, in the course of trade, the person's name or the name of the person's predecessor in title, except where the name is used in such a manner as to mislead the public.

Exception for comparative advertising

(3) Sections 11.14 and 11.15 do not prevent a person from using a protected geographical indication, or any translation of it in any language, in comparative advertising.

Exception not applicable to labels or packaging

(4) Subsection (3) does not apply to comparative advertising on labels or packaging.

11.17 Continued use - wines or spirits

(1) Section 11.14 does not apply to the continued and similar use of a protected geographical indication identifying a wine or spirit, or any translation of it in any language, by a Canadian who has used it in a continuous manner in relation to any business or commercial activity in respect of goods or services

(a) in good faith before April 15, 1994, or

(b) for at least ten years before that date.

Definition of "Canadian"

(2) For the purposes of this section (1), "Canadian" means

(a) a Canadian citizen;

(b) a permanent resident within the meaning of subsection 2(1) of the Immigration and Refugee Protection Act who has been ordinarily resident in Canada for not more than one year after the time at which the permanent resident first became eligible to apply for Canadian citizenship; and

(c) an entity that carries on business in Canada.

Use - certain cheeses

(3) Section 11.15 does not apply to the use, in connection with a business, of any of the indications "Asiago", "Feta", "Φέτα" (Feta), "Fontina", "Gorgonzola" or "Munster", or any translation of them in any language, by a person if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of cheeses, as set out in the schedule, before October 18, 2013.

Use with qualifying term

(4) Section 11.15 does not apply to the use, in connection with a business, of any of the indications "Asiago", "Feta", "Φέτα" (Feta), "Fontina", "Gorgonzola" or "Munster", or any translation of them in any language, in respect of an agricultural product or food of the category of cheeses, as set out in the schedule, if

(a) a qualifying term such as "kind", "type", "style" or "imitation" is used in connection with the indication or the translation; and

(b) the geographical origin of the cheese is clearly displayed on the cheese or on the packaging in which it is distributed, or is in any other manner associated with the cheese so that notice of the cheese's origin is given to the person to whom the cheese is transferred.

Use of the indication "Beaufort"

(5) Section 11.15 does not apply to the use, in connection with a business, of the indication "Beaufort", or any translation of it in any language, by a person if

(a) the person or their predecessor in title used the indication or the translation for at least 10 years before October 18, 2013 in relation to any business or commercial activity in respect of an agricultural product or food of the category of cheeses, as set out in the schedule; or

(b) the person uses the indication or the translation in relation to

any business or commercial activity in respect of a cheese product that was produced in the proximity of the Beaufort Range on Vancouver Island in British Columbia.

Use of the indication “Nurnberger Bratwurste”

(6) Section 11.15 does not apply to the use, in connection with a business, of the indication “Nürnberg Bratwürste”, or any translation of it in any language, by a person, if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of fresh, frozen and processed meats, as set out in the schedule, for at least five years before October 18, 2013.

Use of the indication “Jambon de Bayonne”

(7) Section 11.15 does not apply to the use, in connection with a business, of the indication “Jambon de Bayonne”, or any translation of it in any language, by a person, if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of dry-cured meats, as set out in the schedule, for at least 10 years before October 18, 2013.

Restriction

(8) For the purposes of subsections (3) and (5) to (7), no person is a predecessor in title if they only transferred the right to use the indication or the translation, or both.

11.18 Exception for disuse

(1) Sections 11.14 and 11.15 and paragraphs 12(1)(g) to (h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of a protected geographical indication, or any translation of it in any language, if the indication has ceased to be protected by the law applicable to the territory in which the wine or spirit or the agricultural product or food is identified as originating, or has fallen into disuse in that territory.

Exceptions for customary names

(2) Sections 11.14 and 11.15 and paragraphs 12(1)(g) to (h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of a protected geographical indication that is identical to

(a) a term customary in common language in Canada as the common name for the wine or spirit or the agricultural product or food;

(b) a customary name of a grape variety existing in Canada on or before

the day on which the WTO Agreement comes into force; or

(c) a customary name of a plant variety or an animal breed existing in Canada on or before the day on which the indication is entered on the list kept under subsection 11.12(1).

Exception for translation – customary term

(2.1) Sections 11.14 and 11.15 and paragraphs 12(1)(g) to (h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of a translation of a protected geographical indication that is identical to a term customary in common language in Canada as the common name for a wine or spirit or an agricultural product or food.

Exception for common names for wines

(3) Subsections 11.14(1) to (3) and paragraph 12(1)(g) do not prevent the adoption, use or registration as a trademark or otherwise, in connection with a business, of the following indications in respect of wines:

Exception for common names for spirits

(4) Subsections 11.14(4) to (6) and paragraph 12(1)(h) do not prevent the adoption, use or registration as a trademark or otherwise, in connection with a business, of the following indications in respect of spirits:

- (a) [Repealed]
- (b) Marc;
- (c) [Repealed]
- (d) Sambuca;
- (e) Geneva Gin;
- (f) Genièvre;
- (g) Hollands Gin;
- (h) London Gin;
- (i) Schnapps;
- (j) Malt Whiskey;
- (k) Eau-de-vie;
- (l) Bitters;
- (m) Anisette;
- (n) Curacao; and
- (o) Curaçao.

Exception for common names for agricultural products or food

(4.1) Section 11.15 and paragraph 12(1)(h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of the following indications in respect of an agricultural product or food:

- (a) Valencia Orange;
- (b) Orange Valencia;
- (c) Valencia;
- (d) Black Forest Ham;
- (e) Jambon Forêt Noire;
- (f) Tiroler Bacon;
- (g) Bacon Tiroler;
- (h) Parmesan;
- (i) St. George Cheese;
- (j) Fromage St-George; and
- (k) Fromage St-Georges.

Spelling variations

(4.2) For purposes of subsection (4.1), the indications set out in paragraphs (f) and (g) include spelling variations of those indications in English and French.

Exception - "county"

(4.3) Section 11.15 and paragraph 12(1)(h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of the term "county", or any translation of it in any language, in association with an agricultural product or food if that term is used to refer to the name of a territorial division or an administrative division of a territory.

Powers of Governor in Council

(5) The Governor in Council may, by order, amend any of subsections (3) to (4.1) by adding or deleting an indication in respect of a wine or spirit or an agricultural product or food, as the case may be.

11.19 Exception for failure to take proceedings

(1) (1) Sections 11.14 and 11.15 do not apply to the adoption or use of a trade-mark by a person if no proceedings are taken to enforce those sections in respect of that person's use or adoption of the trade-mark within five years after use of the trade-mark by that person or that person's predecessor-in-title has become generally known in Canada or the trade-mark has been registered by that person in Canada, unless it is established that that person or that person's predecessor-in-title first used or adopted the trade-mark with knowledge that such use or adoption was contrary to section 11.14 or 11.15, as the case may be.

Proceedings after five years

(2) In proceedings respecting a registered trade-mark commenced after the expiry of five years from the earlier of the date of registration

of the trade-mark in Canada and the date on which use of the trade-mark by the person who filed the application for registration of the trademark or that person's predecessor in title has become generally known in Canada, the registration must not be expunged or amended or held invalid on the basis of any of paragraphs 12(1)(g) to (h.1) unless it is established that the person who filed the application for registration of the trade-mark did so with knowledge that the trademark was in whole or in part a protected geographical indication.

11.2 Acquired rights - wines

(1) Section 11.14 and paragraph 12(1)(g) do not prevent the adoption, use or registration as a trade-mark in association with a wine of a protected geographical indication, or any translation of it in any language, by a person if they have, in good faith, before the later of January 1, 1996 and the day on which protection of the indication in the territory indicated by the indication begins,

(a) filed an application in accordance with section 30 for, or secured the registration of, the trade-mark in association with a wine; or

(b) acquired rights through use to the trade-mark in respect of a wine.

Acquired rights - spirits

(2) Section 11.14 and paragraph 12(1)(h) do not prevent the adoption, use or registration as a trade-mark in association with a spirit of a protected geographical indication, or any translation of it in any language, by a person if they have, in good faith, before the later of January 1, 1996 and the day on which protection of the indication in the territory indicated by the indication begins,

(a) filed an application in accordance with section 30 for, or secured the registration of, the trade-mark in association with a spirit; or

(b) acquired rights through use to the trade-mark in respect of a spirit.

Acquired rights - agricultural products and food

(3) Section 11.15 and paragraph 12(1)(h.1) do not prevent the adoption, use or registration as a trade-mark in association with an agricultural product or food of a category set out in the schedule of a protected geographical indication, or any translation of it in any language, by a person if they have, in good faith, before the day on which a statement by the Minister is published under subsection 11.12(2) or (2.1) in respect of the indication or translation, (a) filed an application in accordance with section 30 for, or secured the registration of, the trade-mark in association with an agricultural product or food belonging to the same category; or

(b) acquired rights through use to the trade-mark in respect of an agricultural product or food belonging to the same category.

11.21 Removal from the list

(1) On the application of any person interested, the Federal Court has exclusive jurisdiction to order the Registrar to remove an indication or a translation from the list of geographical indications kept under subsection 11.12(1) on any of the grounds set out in subsection (2) or (3), as the case may be.

Grounds - indication

(2) The grounds for the removal of an indication are

(a) that, on the day on which the application is made, the indication is not a geographical indication;

(b) that, on the day on which the application is made, the indication is identical to a term customary in common language in Canada as the common name for the wine or spirit or the agricultural product or food;

(c) that, except in the case of an indication identifying a wine or spirit or an agricultural product or food as originating in Canada, when the statement by the Minister in respect of the indication is published or on the day on which the application is made, the indication is not protected by the law applicable to the territory in which the wine or spirit or the agricultural product or food is identified as originating;

(d) in the case of an indication identifying an agricultural product or food, that, when the statement by the Minister is published, the indication is confusing with

(i) a registered trade-mark, or

(ii) a trade-mark that was previously used in Canada and that has not been abandoned; or

(e) in the case of an indication identifying an agricultural product or food, that

(i) when the statement by the Minister is published, the indication is confusing with a trademark in respect of which an application for registration was previously filed in Canada, and

(ii) on the day on which the application is made, that application for registration remains pending or the trade-mark is registered.

Grounds - translation

(3) The grounds for the removal of a translation are (a) that, on the day on which the application is made, the translation is identical to a term customary in common language in Canada as the common name for

the agricultural product or food;

(b) that, when the statement by the Minister in respect of the translation is published, the translation is confusing with

(i) a registered trade-mark, or

(ii) a trade-mark that was previously used in Canada and that has not been abandoned;

(c) that

(i) when the statement by the Minister in respect of the translation is published, the translation is confusing with a trade-mark in respect of which an application for registration was previously filed in Canada, and

(ii) on the day on which the application is made, that application for registration remains pending or the trade-mark is registered; or

(d) that, when the statement by the Minister in respect of the translation is published, the translation is not a faithful translation of the indication.

How application is made

(4) An application shall be made by the filing of an originating notice of motion, by counter-claim in an action for an act contrary to section 11.14 or 11.15, or by statement of claim in an action claiming additional relief under this Act.

Summary proceedings

(5) The proceedings on an application shall be heard and determined summarily on evidence adduced by affidavit unless the Federal Court directs otherwise.

Effect of order on translation

(6) If the Federal Court orders the removal of an indication identifying an agricultural product or food from the list, the Registrar shall remove any translation of that indication from the list.

11.22 CETA indications

Paragraph 11.18(2) (a) and section 11.21 do not apply with respect to a protected geographical indication that is listed in Part A of Annex 20-A, as amended from time to time, of Chapter Twenty of the Comprehensive Economic and Trade Agreement between Canada and the European Union and its Member States, done at Brussels on October 30, 2016.

11.23 Canada - Korea indications

Paragraphs 11.18(2) (a) and (c) and section 11.21 do not apply with

respect to an indication that is a protected geographical indication and that is included in the following list:

- (a) GoryeoHongsam;
- (b) GoryeoBaeksam;
- (c) GoryeoSusam;
- (d) IcheonSsal;
- (e) ginseng rouge de Corée;
- (f) ginseng blanc de Corée;
- (g) ginseng frais de Corée;
- (h) riz Icheon;
- (i) Korean Red Ginseng;
- (j) Korean White Ginseng;
- (k) Korean Fresh Ginseng;
- (l) Icheon Rice.

11.24 Powers of Governor in Council

The Governor in Council may, by order, amend the schedule by adding or deleting a category of agricultural product or food.

REGISTRABLE TRADE-MARKS

12. When trade-mark registrable

- (1) Subject to section 13, a trade-mark is registrable if it is not
- (a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;
 - (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;
 - (c) the name in any language of any of the goods or services in connection with which it is used or proposed to be used;
 - (d) confusing with a registered trade-mark;
 - (e) a mark of which the adoption is prohibited by section 9 or 10;
 - (f) a denomination the adoption of which is prohibited by section 10.1;
 - (g) in whole or in part a protected geographical indication identifying a wine, where the trade-mark is to be registered in association with a wine not originating in a territory indicated by the geographical indication;
 - (h) in whole or in part a protected geographical indication identifying a spirit, where the trade-mark is to be registered in association with a spirit not originating in a territory indicated by the geographical indication;
 - (h.1) in whole or in part a protected geographical indication, and the trade-mark is to be registered in association with an agricultural product or food – belonging to the same category, as set out in the schedule, as the agricultural product or food identified by the protected geographical indication – not originating in a territory indicated by the geographical indication; and
 - (i) subject to subsection 3(3) and paragraph 3(4)(a) of the Olympic and Paralympic Marks Act, a mark the adoption of which is prohibited by subsection 3(1) of that Act.

Idem

- (2) A trade-mark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration.

13. When distinguishing guises registrable

(1) A distinguishing guise is registrable only if

(a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration; and

(b) the exclusive use by the applicant of the distinguishing guise in association with the goods or services with which it has been used is not likely unreasonably to limit the development of any art or industry.

Effect of registration

(2) No registration of a distinguishing guise interferes with the use of any utilitarian feature embodied in the distinguishing guise.

Not to limit art or industry

(3) The registration of a distinguishing guise may be expunged by the Federal Court on the application of any interested person if the Court decides that the registration has become likely unreasonably to limit the development of any art or industry.

14. Registration of marks registered abroad

(1) Notwithstanding section 12, a trade-mark that the applicant or the applicant's predecessor in title has caused to be duly registered in or for the country of origin of the applicant is registrable if, in Canada,

(a) it is not confusing with a registered trade-mark;

(b) it is not without distinctive character, having regard to all the circumstances of the case including the length of time during which it has been used in any country;

(c) it is not contrary to morality or public order or of such a nature as to deceive the public; or

(d) it is not a trade-mark of which the adoption is prohibited by section 9 or 10.

Trade-marks regarded as registered abroad

(2) A trade-mark that differs from the trade-mark registered in the country of origin only by elements that do not alter its distinctive character or affect its identity in the form under which it is registered in the country of origin shall be regarded for the purpose of subsection (1) as the trade-mark so registered.

15. Registration of confusing marks

(1) Notwithstanding section 12 or 14, confusing trade-marks are registrable if the applicant is the owner of all such trade-marks, which shall be known as associated trade-marks.

Record

(2) On the registration of any trade-mark associated with any other registered trade-mark, a note of the registration of each trade-mark shall be made on the record of registration of the other trade-mark.

Amendment

(3) No amendment of the register recording any change in the ownership or in the name or address of the owner of any one of a group of associated trade-marks shall be made unless the Registrar is satisfied that the same change has occurred with respect to all the trade-marks in the group, and corresponding entries are made contemporaneously with respect to all those trade-marks.

PERSONS ENTITLED TO REGISTRATION OF TRADE-MARKS

16. Registration of marks used or made known in Canada

(1) Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with wares or services is entitled, subject to section 38, to secure its registration in respect of those goods or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

(c) a trade-name that had been previously used in Canada by any other person.

Marks registered and used abroad

(2) Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that the applicant or the applicant's predecessor in title has duly registered in or for the country of origin of the applicant and has used in association with wares or services is entitled, subject to section 38, to secure its registration in respect of the wares or services in association with which it is registered in that country and has been used, unless at the date of filing of the application in accordance with section 30 it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

(c) a trade-name that had been previously used in Canada by any other person.

Proposed marks

(3) Any applicant who has filed an application in accordance with section 30 for registration of a proposed trade-mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the wares or services specified in the application, unless at the date of filing of the application it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

(c) a trade-name that had been previously used in Canada by any other person.

Where application for confusing mark pending

(4) The right of an applicant to secure registration of a registrable trade-mark is not affected by the previous filing of an application for registration of a confusing trade-mark by another person, unless the application for registration of the confusing trade-mark was pending at the date of advertisement of the applicant's application in accordance with section 37.

Previous use or making known

(5) The right of an applicant to secure registration of a registrable trade-mark is not affected by the previous use or making known of a confusing trade-mark or trade-name by another person, if the confusing trade-mark or trade-name was abandoned at the date of advertisement of the applicant's application in accordance with section 37.

VALIDITY AND EFFECT OF REGISTRATION

17. Effect of registration in relation to previous use, etc.

(1) No application for registration of a trade-mark that has been advertised in accordance with section 37 shall be refused and no registration of a trade-mark shall be expunged or amended or held invalid on the ground of any previous use or making known of a confusing trademark or trade-name by a person other than the applicant for that registration or his predecessor in title, except at the instance of that other person or his successor in title, and the burden lies on that other person or his successor to establish that he had not abandoned the confusing trade-mark or trade-name at the date of advertisement of the applicant's application.

When registration incontestable

(2) In proceedings commenced after the expiration of five years from the date of registration of a trade-mark or from July 1, 1954, whichever is the later, no registration shall be expunged or amended or held invalid on the ground of the previous use or making known referred to in subsection (1), unless it is established that the person who adopted the registered trade-mark in Canada did so with knowledge of that previous use or making known.

18. When registration invalid

(1) The registration of a trade-mark is invalid if

- (a) the trade-mark was not registrable at the date of registration,
- (b) the trade-mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced,
- (c) the trade-mark has been abandoned, or
- (d) subject to section 17, the applicant for registration was not the person entitled to secure the registration.

Exception

(2) No registration of a trade-mark that had been so used in Canada by the registrant or his predecessor in title as to have become distinctive at the date of registration shall be held invalid merely on the ground that evidence of the distinctiveness was not submitted to the competent authority or tribunal before the grant of the registration.

19. Rights conferred by registration

Subject to sections 21, 32 and 67, the registration of a trade-mark in respect of any goods or services, unless shown to be invalid, gives

to the owner of the trade-mark the exclusive right to the use throughout Canada of the trade-mark in respect of those goods or services.

20. Infringement

(1) The right of the owner of a registered trade-mark to its exclusive use is deemed to be infringed by any person who is not entitled to its use under this Act and who

(a) sells, distributes or advertises any goods or services in association with a confusing trade-mark or trade-name;

(b) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any goods in association with a confusing trade-mark or trade-name, for the purpose of their sale or distribution;

(c) sells, offers for sale or distributes any label or packaging, in any form, bearing a trade-mark or tradename, if

(i) the person knows or ought to know that the label or packaging is intended to be associated with goods or services that are not those of the owner of the registered trade-mark, and

(ii) the sale, distribution or advertisement of the goods or services in association with the label or packaging would be a sale, distribution or advertisement in association with a confusing trademark or trade-name; or

(d) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any label or packaging, in any form, bearing a trade-mark or trade-name, for the purpose of its sale or distribution or for the purpose of the sale, distribution or advertisement of goods or services in association with it, if

(i) the person knows or ought to know that the label or packaging is intended to be associated with goods or services that are not those of the owner of the registered trade-mark, and

(ii) the sale, distribution or advertisement of the goods or services in association with the label or packaging would be a sale, distribution or advertisement in association with a confusing trademark or trade-name.

Exception - bona fide use

(1.1) The registration of a trade-mark does not prevent a person from making, in a manner that is not likely to have the effect of depreciating the value of the goodwill attaching to the trade-mark,

(a) any *bona fide* use of his or her personal name as a trade-name; or

(b) any *bona fide* use, other than as a trade-mark, of the geographical

name of his or her place of business or of any accurate description of the character or quality of his or her goods or services.

Exception – utilitarian feature

(1.2) The registration of a trade-mark does not prevent a person from using any utilitarian feature embodied in the trade-mark.

Exception

(2) The registration of a trade-mark does not prevent a person from making any use of any of the indications mentioned in subsection 11.18(3) in association with a wine, any of the indications mentioned in subsection 11.18(4) in association with a spirit or any of the indications mentioned in subsection 11.18(4.1) in association with an agricultural product or food.

21. Concurrent use of confusing marks

(1) Where, in any proceedings respecting a registered trade-mark the registration of which is entitled to the protection of subsection 17(2), it is made to appear to the Federal Court that one of the parties to the proceedings, other than the registered owner of the trade-mark, had in good faith used a confusing trade-mark or trade-name in Canada before the date of filing of the application for that registration, and the Court considers that it is not contrary to the public interest that the continued use of the confusing trade-mark or trade-name should be permitted in a defined territorial area concurrently with the use of the registered trade-mark, the Court may, subject to such terms as it deems just, order that the other party may continue to use the confusing trade-mark or trade-name within that area with an adequate specified distinction from the registered trade-mark.

Registration of order

(2) The rights conferred by an order made under subsection (1) take effect only if, within three months from its date, the other party makes application to the Registrar to enter it on the register in connection with the registration of the registered trade-mark.

22. Depreciation of goodwill

(1) No person shall use a trade-mark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

Action in respect thereof

(2) In any action in respect of a use of a trade-mark contrary to subsection (1), the court may decline to order the recovery of damages

or profits and may permit the defendant to continue to sell goods marked with the trade-mark that were in his possession or under his control at the time notice was given to him that the owner of the registered trade-mark complained of the use of the trade-mark.

CERTIFICATION MARKS

23. Registration of certification marks

(1) A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which the certification mark is used.

Licence

(2) The owner of a certification mark may license others to use the mark in association with wares or services that meet the defined standard, and the use of the mark accordingly shall be deemed to be use thereof by the owner.

Unauthorized use

(3) The owner of a registered certification mark may prevent its use by unlicensed persons or in association with any wares or services in respect of which the mark is registered but to which the licence does not extend.

Action by unincorporated body

(4) Where the owner of a registered certification mark is an unincorporated body, any action or proceeding to prevent unauthorized use of the mark may be brought by any member of that body on behalf of himself and all other members thereof.

24. Registration of trade-mark confusing with certification mark

With the consent of the owner of a certification mark, a trade-mark confusing with the certification mark may, if it exhibits an appropriate difference, be registered by some other person to indicate that the goods or services in association with which it is used have been manufactured, sold, leased, hired or performed by him as one of the persons entitled to use the certification mark, but the registration thereof shall be expunged by the Registrar on the withdrawal at any time of the consent of the owner of the certification mark or on the cancellation of the registration of the certification mark.

25. Descriptive certification mark

A certification mark descriptive of the place of origin of goods or services, and not confusing with any registered trade-mark, is registrable if the applicant is the administrative authority of a country, state, province or municipality including or forming part of the area indicated by the mark, or is a commercial association having

an office or representative in that area, but the owner of any mark registered under this section shall permit the use of the mark in association with any goods or services produced or performed in the area of which the mark is descriptive.

REGISTER OF TRADE-MARKS

26. Register

(1) There shall be kept under the supervision of the Registrar

(a) a register of trade-marks and of transfers, disclaimers, amendments, judgments and orders relating to each registered trade-mark; and

(b) the register of registered users that was required to be kept under this subsection as it read immediately before section 61 of the Intellectual Property Law Improvement Act came into force.

Information to be shown

(2) The register referred to in paragraph (1)(a) shall show, with reference to each registered trade-mark, the following:

(a) the date of registration;

(b) a summary of the application for registration;

(c) a summary of all documents deposited with the application or subsequently thereto and affecting the rights to the trade-mark;

(d) particulars of each renewal;

(e) particulars of each change of name and address; and

(f) such other particulars as this Act or the regulations require to be entered thereon.

27. Register under Unfair Competition Act

(1) The register kept under the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952, forms part of the register kept under this Act and, subject to subsection 44(2), no entry made therein, if properly made according to the law in force at the time it was made, is subject to be expunged or amended only because it might not properly have been made pursuant to this Act.

Trade-marks registered before Unfair Competition Act

(2) Trade-marks on the register on September 1, 1932 shall be treated as design marks or word marks as defined in the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952, according to the following rules:

(a) any trade-mark consisting only of words or numerals or both without any indication of a special form or appearance shall be deemed to be a word mark;

(b) any other trade-mark consisting only of words or numerals or both shall be deemed to be a word mark if at the date of its registration the words or numerals or both would have been registrable independently of any defined special form or appearance and shall also be deemed to

be a design mark for reading matter presenting the special form or appearance defined;

(c) any trade-mark including words or numerals or both in combination with other features shall be deemed

(i) to be a design mark having the features described in the application therefor but without any meaning being attributed to the words or numerals, and

(ii) to be a word mark if and so far as it would at the date of registration have been registrable independently of any defined form or appearance and without being combined with any other feature; and

(d) any other trade-mark shall be deemed to be a design mark having the features described in the application therefor.

Trade-marks registered under Unfair Competition Act

(3) Trade-marks registered under the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952, shall, in accordance with their registration, continue to be treated as design marks or word marks as defined in that Act.

28. Indexes

(1) There shall be kept under the supervision of the Registrar

(a) an index of registered trade-marks;

(b) an index of trade-marks in respect of which applications for registration are pending;

(c) an index of applications that have been abandoned or refused;

(d) an index of the names of owners of registered trade-marks;

(e) an index of the names of applicants for the registration of trade-marks;

(f) a list of trade-mark agents; and

(g) the index of the names of registered users that was required to be kept under this subsection as it reads immediately before section 61 of the *Intellectual Property Law Improvement Act* comes into force.

List of trade-mark agents

(2) The list of trade-mark agents shall include the names of all persons and firms entitled to represent applicants in the presentation and prosecution of applications for the registration of a trade-mark or in other business before the Trade-marks Office.

29. Inspection

(1) Subject to subsection (2), the registers, the documents on which the entries therein are based, all applications, including those abandoned, the indexes, the list of trade-mark agents and the list of

geographical indications kept pursuant to subsection 11.12(1) shall be open to public inspection during business hours, and the Registrar shall, on request and on payment of the prescribed fee, furnish a copy certified by the registrar of any entry in the registers, indexes or lists, or of any of those documents or applications.

Register of registered users

(2) The disclosure of documents on which entries in the register required to be kept under paragraph 26(1)(b) are based is subject to the provisions of subsection 50(6), as it reads immediately before section 61 of the Intellectual Property Law Improvement Act comes into force.

APPLICATIONS FOR REGISTRATION OF TRADE-MARKS

30. Contents of application

An applicant for the registration of a trade-mark shall file with the Registrar an application containing

(a) a statement in ordinary commercial terms of the specific goods or services in association with which the mark has been or is proposed to be used;

(b) in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of goods or services described in the application;

(c) in the case of a trade-mark that has not been used in Canada but is made known in Canada, the name of a country of the Union in which it has been used by the applicant or his named predecessors in title, if any, and the date from and the manner in which the applicant or named predecessors in title have made it known in Canada in association with each of the general classes of goods or services described in the application;

(d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant or the applicant's named predecessor in title, if any, in association with each of the general classes of goods or services described in the application;

(e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;

(f) in the case of a certification mark, particulars of the defined standard that the use of the mark is intended to indicate and a statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used;

(g) the address of the applicant's principal office or place of business in Canada, if any, and if the applicant has no office or place of business in Canada, the address of his principal office or place of business abroad and the name and address in Canada of a person

or firm to whom any notice in respect of the application or registration may be sent, and on whom service of any proceedings in respect of the application or registration may be given or served with the same effect as if they had been given to or served on the applicant or registrant himself;

(h) unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed; and

(i) a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the wares or services described in the application.

31. Applications based on registration abroad

(1) An applicant whose right to registration of a trade-mark is based on a registration of the trade-mark in another country of the Union shall, before the date of advertisement of his application in accordance with section 37, furnish a copy of the registration certified by the office in which it was made, together with a translation thereof into English or French if it is in any other language, and such other evidence as the Registrar may require to establish fully his right to registration under this Act.

Evidence required in certain cases

(2) An applicant whose trade-mark has been duly registered in his country of origin and who claims that the trade-mark is registrable under paragraph 14(1)(b) shall furnish such evidence as the Registrar may require by way of affidavit or statutory declaration establishing the circumstances on which he relies, including the length of time during which the trade-mark has been used in any country.

32. Further information in certain cases

(1) An applicant who claims that his trade-mark is registrable under subsection 12(2) or section 13 shall furnish the Registrar with evidence by way of affidavit or statutory declaration establishing the extent to which and the time during which the trade-mark has been used in Canada and with any other evidence that the Registrar may require in support of the claim.

Registration to be restricted

(2) The Registrar shall, having regard to the evidence adduced, restrict the registration to the goods or services in association with which the trade-mark is shown to have been so used as to have become

distinctive and to the defined territorial area in Canada in which the trade-mark is shown to have become distinctive.

33. applications by trade unions, etc.

Every trade union or commercial association that applies for the registration of a trade-mark may be required to furnish satisfactory evidence that its existence is not contrary to the laws of the country in which its headquarters are situated.

34. Date of application abroad deemed date of application in Canada

(1) When an application for the registration of a trade-mark has been made in or for any country of the Union other than Canada and an application is subsequently made in Canada for the registration for use in association with the same kind of wares or services of the same or substantially the same trade-mark by the same applicant or the applicant's successor in title, the date of filing of the application in or for the other country is deemed to be the date of filing of the application in Canada, and the applicant is entitled to priority in Canada accordingly notwithstanding any intervening use in Canada or making known in Canada or any intervening application or registration if

(a) the application in Canada, including or accompanied by a declaration setting out the date on which and the country of the Union in or for which the earliest application was filed for the registration of the same or substantially the same trade-mark for use in association with the same kind of wares or services, is filed within a period of six months after that date, which period shall not be extended;

(b) the applicant or, if the applicant is a transferee, the applicant's predecessor in title by whom any earlier application was filed in or for any country of the Union was at the date of the application a citizen or national of or domiciled in that country or had therein a real and effective industrial or commercial establishment; and

(c) the applicant furnishes, in accordance with any request under subsections (2) and (3), evidence necessary to establish fully the applicant's right to priority.

Evidence requests

(2) The Registrar may request the evidence before the day on which the application is allowed pursuant to section 39.

How and when evidence must be furnished

(3) The Registrar may specify in the request the manner in which the evidence must be furnished and the period within which it must be

furnished.

35. Disclaimer

The Registrar may require an applicant for registration of a trade-mark to disclaim the right to the exclusive use apart from the trade-mark of such portion of the trade-mark as is not independently registrable, but the disclaimer does not prejudice or affect the applicant's rights then existing or thereafter arising in the disclaimed matter, nor does the disclaimer prejudice or affect the applicant's right to registration on a subsequent application if the disclaimed matter has then become distinctive of the applicant's goods or services.

36. Abandonment

Where, in the opinion of the Registrar, an applicant is in default in the prosecution of an application filed under this Act or any Act relating to trade-marks in force prior to July 1, 1954, the Registrar may, after giving notice to the applicant of the default, treat the application as abandoned unless the default is remedied within the time specified in the notice.

37. When applications to be refused

(1) The Registrar shall refuse an application for the registration of a trade-mark if he is satisfied that

(a) the application does not conform to the requirements of section 30,

(b) the trade-mark is not registrable, or

(c) the applicant is not the person entitled to registration of the trade-mark because it is confusing with another trade-mark for the registration of which an application is pending,

and where the Registrar is not so satisfied, he shall cause the application to be advertised in the manner prescribed.

Notice to applicant

(2) The Registrar shall not refuse any application without first notifying the applicant of his objections thereto and his reasons for those objections, and giving the applicant adequate opportunity to answer those objections.

Doubtful cases

(3) Where the Registrar, by reason of a registered trade-mark, is in doubt whether the trade-mark claimed in the application is registrable, he shall, by registered letter, notify the owner of the registered

trade-mark of the advertisement of the application.

38. Statement of opposition

(1) Within two months after the advertisement of an application for the registration of a trade-mark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar.

Grounds

(2) A statement of opposition may be based on any of the following grounds:

- (a) that the application does not conform to the requirements of section 30;
- (b) that the trade-mark is not registrable;
- (c) that the applicant is not the person entitled to registration of the trade-mark; or
- (d) that the trade-mark is not distinctive.

Content

- (3) A statement of opposition shall set out
- (a) the grounds of opposition in sufficient detail to enable the applicant to reply thereto; and
 - (b) the address of the opponent's principal office or place of business in Canada, if any, and if the opponent has no office or place of business in Canada, the address of his principal office or place of business abroad and the name and address in Canada of a person or firm on whom service of any document in respect of the opposition may be made with the same effect as if it had been served on the opponent himself.

Frivolous opposition

(4) If the Registrar considers that the opposition does not raise a substantial issue for decision, he shall reject it and shall give notice of his decision to the opponent.

Substantial issue

(5) If the Registrar considers that the opposition raises a substantial issue for decision, he shall forward a copy of the statement of opposition to the applicant.

Counter statement

(6) The applicant shall file a counter statement with the Registrar and serve a copy on the opponent in the prescribed manner and within the prescribed time after a copy of the statement of opposition has been served on the applicant.

Evidence and hearing

(7) Both the opponent and the applicant shall be given an opportunity,

in the prescribed manner, to submit evidence and to make representations to the Registrar unless

(a) the opposition is withdrawn or deemed under subsection (7.1) to have been withdrawn; or

(b) the application is abandoned or deemed under subsection (7.2) to have been abandoned.

Withdrawal of opposition

(7.1) The opposition shall be deemed to have been withdrawn if, in the prescribed circumstances, the opponent does not submit either evidence under subsection (7) or a statement that the opponent does not wish to submit evidence.

Abandonment of application

(7.2) The application shall be deemed to have been abandoned if the applicant does not file and serve a counter statement within the time referred to in subsection (6) or if, in the prescribed circumstances, the applicant does not submit either evidence under subsection (7) or a statement that the applicant does not wish to submit evidence.

Decision

(8) After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application or reject the opposition and notify the parties of the decision and the reasons for the decision.

39. When application to be allowed

(1) When an application for the registration of a trade-mark either has not been opposed and the time for the filing of a statement of opposition has expired or it has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall allow the application or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

No extension of time

(2) Subject to subsection (3), the Registrar shall not extend the time for filing a statement of opposition with respect to any application that has been allowed.

Exception

(3) Where the Registrar has allowed an application without considering a previously filed request for an extension of time to file a statement of opposition, the Registrar may withdraw the application from allowance at any time before issuing a certificate of registration and, in accordance with section 47, extend the time for filing a statement of opposition.

REGISTRATION OF TRADE-MARKS

40. Registration of trade-marks

(1) When an application for registration of a trade-mark, other than a proposed trade-mark, is allowed, the Registrar shall register the trade-mark and issue a certificate of its registration.

Proposed trade-mark

(2) When an application for registration of a proposed trade-mark is allowed, the Registrar shall give notice to the applicant accordingly and shall register the trade-mark and issue a certificate of registration on receipt of a declaration that the use of the trade-mark in Canada, in association with the goods or services specified in the application, has been commenced by

- (a) the applicant;
- (b) the applicant's successor in title; or
- (c) an entity that is licensed by or with the authority of the applicant to use the trade-mark, if the applicant has direct or indirect control of the character or quality of the goods or services.

Abandonment of application

(3) An application for registration of a proposed trade-mark shall be deemed to be abandoned if the Registrar has not received the declaration referred to in subsection (2) before the later of

- (a) six months after the notice by the Registrar referred to in subsection (2), and
- (b) three years after the date of filing of the application in Canada.

Form and effect

(4) Registration of a trade-mark shall be made in the name of the applicant therefor or his transferee, and the day on which registration is made shall be entered on the register, and the registration takes effect on that day.

Section 34 does not apply

(5) For the purposes of subsection (3), section 34 does not apply in determining when an application for registration is filed.

AMENDMENT OF THE REGISTER

41. Amendments to register

(1) The Registrar may, on application by the registered owner of a trade-mark made in the prescribed manner, make any of the following amendments to the register:

(a) correct any error or enter any change in the name, address or description of the registered owner or of his representative for service in Canada;

(b) cancel the registration of the trade-mark;

(c) amend the statement of the wares or services in respect of which the trade-mark is registered;

(d) amend the particulars of the defined standard that the use of a certification mark is intended to indicate; or

(e) enter a disclaimer that does not in any way extend the rights given by the existing registration of the trade-mark.

Conditions

(2) An application to extend the statement of wares or services in respect of which a trade-mark is registered has the effect of an application for registration of the trade-mark in respect of the wares or services specified in the application for amendment.

42. Representative for service

(1) The registered owner of a trade-mark who has no office or place of business in Canada shall name another representative for service in place of the latest recorded representative or supply a new and correct address of the latest recorded representative on notice from the Registrar that the latest recorded representative has died or that a letter addressed to him at the latest recorded address and sent by ordinary mail has been returned undelivered.

Change of address

(2) When, after the dispatch of the notice referred to in subsection (1) by the Registrar, no new nomination is made or no new and correct address is supplied by the registered owner within three months, the Registrar or the Federal Court may dispose of any proceedings under this Act without requiring service on the registered owner of any process therein.

43. Additional representations

The registered owner of any trade-mark shall furnish such additional representations thereof as the Registrar may by notice demand and, if

he fails to comply with that notice, the Registrar may by a further notice, fix a reasonable time after which, if the representations are not furnished, he may expunge the registration of the trade-mark.

44. Notice for information

(1) The Registrar may at any time, and shall at the request of any person who pays the prescribed fee, by notice in writing require the registered owner of any trade-mark that was on the register on July 1, 1954 to furnish him within three months from the date of the notice with the information that would be required on an application for the registration of the trade-mark made at the date of the notice.

Amendments to register

(2) The Registrar may amend the registration of the trade-mark in accordance with the information furnished to him under subsection (1).

Failure to give information

(3) Where the information required by subsection (1) is not furnished, the Registrar shall by a further notice fix a reasonable time after which, if the information is not furnished, he may expunge the registration of the trade-mark.

45. Registrar may request evidence of user

(1) The Registrar may at any time and, at the written request made after three years from the date of the registration of a trade-mark by any person who pays the prescribed fee shall, unless the Registrar sees good reason to the contrary, give notice to the registered owner of the trade-mark requiring the registered owner to furnish within three months an affidavit or a statutory declaration showing, with respect to each of the goods or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date.

Form of evidence

(2) The Registrar shall not receive any evidence other than the affidavit or statutory declaration, but may hear representations made by or on behalf of the registered owner of the trade-mark or by or on behalf of the person at whose request the notice was given.

Effect of non-use

(3) Where, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence, it appears to the Registrar that a trade-mark, either with respect to all of the goods or services

specified in the registration or with respect to any of those wares or services, was not used in Canada at any time during the three year period immediately preceding the date of the notice and that the absence of use has not been due to special circumstances that excuse the absence of use, the registration of the trade-mark is liable to be expunged or amended accordingly.

Notice to owner

(4) When the Registrar reaches a decision whether or not the registration of a trade-mark ought to be expunged or amended, he shall give notice of his decision with the reasons therefor to the registered owner of the trade-mark and to the person at whose request the notice referred to in subsection (1) was given.

Action by Registrar

(5) The Registrar shall act in accordance with his decision if no appeal therefrom is taken within the time limited by this Act or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

RENEWAL OF REGISTRATIONS

46. Renewal

(1) The registration of a trade-mark that is on the register by virtue of this Act is subject to renewal within a period of fifteen years from the day of the registration or last renewal.

Notice to renew

(2) If the registration of a trade-mark has been on the register without renewal for the period specified in subsection (1), the Registrar shall send a notice to the registered owner and to the registered owner's representative for service, if any, stating that if within six months after the date of the notice the prescribed renewal fee is not paid, the registration will be expunged.

Failure to renew

(3) If within the period of six months specified in the notice, which period shall not be extended, the prescribed renewal fee is not paid, the Registrar shall expunge the registration.

Effective date of renewal

(4) When the prescribed fee for a renewal of any trade-mark registration under this section is paid within the time limited for the payment thereof, the renewal takes effect as of the day next following the expiration of the period specified in subsection (1).

EXTENSIONS OF TIME

47. Extensions of time

(1) If, in any case, the Registrar is satisfied that the circumstances justify an extension of the time fixed by this Act or prescribed by the regulations for the doing of any act, he may, except as in this Act otherwise provided, extend the time after such notice to other persons and on such terms as he may direct.

Conditions

(2) An extension applied for after the expiration of the time fixed for the doing of an act or the time extended by the Registrar under subsection (1) shall not be granted unless the prescribed fee is paid and the Registrar is satisfied that the failure to do the act or apply for the extension within that time or the extended time was not reasonably avoidable.

TRANSFER

48. Trade-mark transferable

(1) A trade-mark, whether registered or unregistered, is transferable, and deemed always to have been transferable, either in connection with or separately from the goodwill of the business and in respect of either all or some of the goods or services in association with which it has been used.

Where two or more persons interested

(2) Nothing in subsection (1) prevents a trade-mark from being held not to be distinctive if as a result of a transfer thereof there subsisted rights in two or more persons to the use of confusing trade-marks and the rights were exercised by those persons.

Registration of transfer

(3) The Registrar shall register the transfer of any registered trade-mark on being furnished with evidence satisfactory to him of the transfer and the information that would be required by paragraph 30(g) in an application by the transferee to register the trade-mark.

CHANGE OF PURPOSE IN USE OF MARK

49. Change of purpose

If a mark is used by a person as a trade-mark for any of the purposes or in any of the manners mentioned in the definition "certification mark" or "trade-mark" in section 2, it shall not be held invalid merely on the ground that the person or a predecessor in title uses it or has used it for any other of those purposes or in any other of those manners.

LICENCES

50. Licence to use trade-mark

(1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trademark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the goods or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

Idem

(2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the goods or services is under the control of the owner.

Owner may be required to take proceedings

(3) Subject to any agreement subsisting between an owner of a trade-mark and a licensee of the trade-mark, the licensee may call on the owner to take proceedings for infringement thereof, and, if the owner refuses or neglects to do so within two months after being so called on, the licensee may institute proceedings for infringement in the licensee's own name as if the licensee were the owner, making the owner a defendant.

51. Use of trade-mark by related companies

(1) Where a company and the owner of a trade-mark that is used in Canada by that owner in association with a pharmaceutical preparation are related companies, the use by the company of the trade-mark, or a trade-mark confusing therewith, in association with a pharmaceutical preparation that at the time of that use or at any time thereafter,

(a) is acquired by a person directly or indirectly from the company, and

(b) is sold, distributed or advertised for sale in Canada in a package bearing the name of the company and the name of that person as the distributor thereof,

has the same effect, for all purposes of this Act, as a use of the trade-mark or the confusing trade-mark, as the case may be, by that owner.

Where difference in composition

(2) Subsection (1) does not apply to any use of a trade-mark or a confusing trade-mark by a company referred to in that subsection in association with a pharmaceutical preparation after such time, if any, as that pharmaceutical preparation is declared by the Minister of Health, by notice published in the *Canada Gazette*, to be sufficiently different in its composition from the pharmaceutical preparation in association with which the trade-mark is used in Canada by the owner referred to in subsection (1) as to be likely to result in a hazard to health.

Definition of "pharmaceutical preparation"

(3) In this section, "pharmaceutical preparation" includes

- (a) any substance or mixture of substances manufactured, sold or represented for use in
 - (i) the diagnosis, treatment, mitigation or prevention of a disease, disorder or abnormal physical state, or the symptoms thereof, in humans or animals, or
 - (ii) restoring, correcting or modifying organic functions in humans or animals, and
- (b) any substance to be used in the preparation or production of any substance or mixture of substances described in paragraph (a), but does not include any such substance or mixture of substances that is the same or substantially the same as a substance or mixture of substances that is a proprietary medicine within the meaning from time to time assigned to that expression by regulations made pursuant to the *Food and Drugs Act*.

Offences and Punishment

51.01 Sale, etc., of goods

(1) Every person commits an offence who sells or offers for sale, or distributes on a commercial scale, any goods in association with a trade-mark, if that sale or distribution is or would be contrary to section 19 or 20 and the person knows that

(a) the trade-mark is identical to, or cannot be distinguished in its essential aspects from, a trade-mark registered for such goods; and

(b) the owner of that registered trade-mark has not consented to the sale, offering for sale, or distribution of the goods in association with the trade-mark.

(c) [Deleted]

Manufacture, etc., of goods.

(2) Every person commits an offence who manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any goods, for the purpose of their sale or of their distribution on a commercial scale, if that sale or distribution would be contrary to section 19 or 20 and the person knows that

(a) the goods bear a trade-mark that is identical to, or that cannot be distinguished in its essential aspects from, a trade-mark registered for such goods; and

(b) the owner of that registered trade-mark has not consented to having the goods bear the trade-mark.

(c) [Deleted]

Services

(3) Every person commits an offence who sells or advertises services in association with a trade-mark, if that sale or advertisement is contrary to section 19 or 20 and the person knows that

(a) the trade-mark is identical to, or cannot be distinguished in its essential aspects from, a registered trade-mark registered for such services; and

(b) the owner of the registered trade-mark has not consented to the sale or advertisement in association with the trade-mark.

(c) [Deleted]

Labels or packaging

(4) Every person commits an offence who manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any label or packaging, in any form, for the purpose of its sale or of its distribution on a commercial scale or for the purpose of the sale, distribution on a commercial scale or advertisement of goods or

services in association with it, if that sale, distribution or advertisement would be contrary to section 19 or 20 and the person knows that

(a) the label or packaging bears a trade-mark that is identical to, or that cannot be distinguished in its essential aspects from, a registered trade-mark;

(b) the label or packaging is intended to be associated with goods or services for which that registered trademark is registered; and

(c) the owner of that registered trade-mark has not consented to having the label or packaging bear the trade-mark.

(d) [Deleted]

Trafficking in labels or packaging

(5) Every person commits an offence who sells or offers for sale, or distributes on a commercial scale, any label or packaging, in any form, if the sale, distribution or advertisement of goods or services in association with the label or packaging would be contrary to section 19 or 20 and the person knows that

(a) the label or packaging bears a trade-mark that is identical to, or that cannot be distinguished in its essential aspects from, a registered trade-mark;

(b) the label or packaging is intended to be associated with goods or services for which that registered trademark is registered;

(c) the owner of that registered trade-mark has not consented to having the label or packaging bear the trademark.

Registration of trade-mark

(5.1) In a prosecution for an offence under any of subsections (1) to (5), it is not necessary for the prosecutor to prove that the accused knew that the trade-mark was registered.

Punishment Peines

(6) Every person who commits an offence under any of subsections (1) to (5) is liable

(a) on conviction on indictment, to a fine of not more than \$1,000,000 or to imprisonment for a term of not more than five years or to both; or

(b) on summary conviction, to a fine of not more than \$25,000 or to imprisonment for a term of not more than six months or to both.

Limitation Period

(7) Proceedings by way of summary conviction for an offence under this section may be instituted no later than two years after the day on which the subject-matter of the proceedings arose.

Disposition order

(8) The court before which any proceedings for an offence under this section are taken may, on a finding of guilt, order that any goods, labels, or packaging in respect of which the offence was committed, any advertising materials relating to those goods and any equipment used to manufacture those goods, labels or packaging be destroyed or otherwise disposed of.

Notice

(9) Before making an order for the destruction or other disposition of equipment under subsection (8), the court shall require that notice be given to the owner of the equipment and to any other person who, in the opinion of the court, appears to have a right or interest in the equipment, unless the court is of the opinion that the interests of justice do not require that the notice be given.

Importation and Exportation

Interpretation

51.02 Definitions

The following definitions apply in sections 51.03 to 51.12.

customs officer has the meaning assigned by the definition officer in subsection 2(1) of the Customs Act.

Minister means the Minister of Public Safety and Emergency Preparedness.

owner, with respect to a protected geographical indication identifying a wine or spirit or agricultural product or food, means the responsible authority, as defined in section 11.11, for the wine or spirit or agricultural product or food identified by the indication.

protected mark means a registered trade-mark or a protected geographical indication.

relevant protected mark means

(a) a trade-mark registered for goods that is identical to, or cannot be distinguished in its essential aspects from, a trade-mark on such goods, including their labels or packaging, that are detained by a customs officer; or

(b) a protected geographical indication identifying, as the case may be, a wine or spirit, or an agricultural product or food of a category set out in the schedule, that is identical to, or cannot be distinguished in its essential aspects from, an indication on such a wine or spirit or such an agricultural product or food, or on their labels or packaging, that is detained by a customs officer.

working day means a day other than a Saturday or a holiday.

Prohibition

51.03 No importation or exportation

(1) Goods shall not be imported or exported if the goods or their labels or packaging bear – without the consent of the owner of a registered trade-mark for such goods – a trade-mark that is identical to, or that cannot be distinguished in its essential aspects from, that registered trade-mark.

Exception

(2) Subsection (1) does not apply if

(a) the trade-mark was applied with the consent of the owner of the trade-mark in the country where it was applied;

(b) the sale or distribution of the goods or, in the case where the trade-mark is on the goods' labels or packaging, of the goods in association with the labels or packaging would not be contrary to this Act;

(c) the goods are imported or exported by an individual in their possession or baggage and the circumstances, including the number of goods, indicate that the goods are intended only for their personal use; or

(d) the goods, while being shipped from one place outside Canada to another, are in customs transit control or customs transshipment control in Canada.

Wine or spirits

(2.1) Wine or spirits shall not be imported or exported if they, or their labels or packaging, bear a protected geographical indication and the wine or spirits

(a) do not originate in the territory indicated by the indication; or

(b) do originate in the territory indicated by the indication but were not produced or manufactured in accordance with the law applicable to that territory.

Agricultural products or food

(2.2) An agricultural product or food of a category set out in the schedule shall not be imported or exported if it, or its label or packaging, bears a protected geographical indication and the agricultural product or food

(a) does not originate in the territory indicated by the indication; or

(b) does originate in the territory indicated by the indication, but was not produced or manufactured in accordance with the law applicable to that territory.

Exception

(2.3) Subsections (2.1) and (2.2) do not apply if

(a) the sale or distribution of the wine or spirit or the agricultural product or food – or, if the label or packaging of that wine, spirit or agricultural product or food bears a protected geographical indication and the sale or distribution of that wine, spirit or agricultural product or food in association with that label or packaging – would not be contrary to this Act;

(b) the wine or spirit or the agricultural product or food is imported or exported by an individual in their possession or baggage and the circumstances, including the number of such goods, indicate that they are intended only for the individual's personal use; or

(c) the wine or spirit or the agricultural product or food, while being shipped from one place outside Canada to another, is in customs transit control or customs transshipment control in Canada.

Restriction

(3) The contravention of subsection (1), (2.1) or (2.2) does not give rise to a remedy under section 53.2.

Request for Assistance

51.04 Request for assistance

(1) The owner of a protected mark may file with the Minister, in the form and manner specified by the Minister, a request for assistance in pursuing remedies under this Act with respect to goods imported or exported in contravention of section 51.03.

Information in request

(2) The request for assistance shall include the name and address in Canada of the owner of the protected mark and any other information that is required by the Minister, including information about the trade-mark and the goods for which it is registered or, in the case of a geographical indication, the goods identified by the indication.

Validity period

(3) A request for assistance is valid for a period of two years beginning on the day on which it is accepted by the Minister. The Minister may, at the request of the owner of the protected mark, extend the period for two years, and may do so more than once.

Security

(4) The Minister may, as a condition of accepting a request for assistance or of extending a request's period of validity, require that the owner of the protected mark furnish security, in an amount and form fixed by the Minister, for the payment of an amount for which the owner of the protected mark becomes liable under section 51.09.

Update

(5) The owner of the protected mark shall inform the Minister in writing, as soon as feasible, of any changes to

(a) the validity of the protected mark that is the subject of the request for assistance;

(b) the ownership of the protected mark; or

(c) the goods for which the trade-mark is registered or, in the case of a geographical indication, the goods identified by the indication.

Measures Relating to Detained Goods

51.05 Provision of information by customs officer

A customs officer who is detaining goods under section 101 of the *Customs Act* may, in the officer's discretion, to obtain information about whether the importation or exportation of the goods is prohibited under section 51.03, provide the owner of a relevant protected mark with a sample of the goods and with any information about the goods that the customs officer reasonably believes does not directly or indirectly identify any person.

51.06 Provision of information to pursue remedy

(1) A customs officer who is detaining goods under section 101 of the *Customs Act* and who has reasonable grounds to suspect that the importation or exportation of the goods is prohibited under section 51.03 may, in the officer's discretion, if the Minister has accepted a request for assistance with respect to a relevant protected mark filed by its owner, provide that owner with a sample of the goods and with information about the goods that could assist them in pursuing a remedy under this Act, such as

- (a) a description of the goods and their characteristics;
- (b) the name and address of their owner, importer, exporter and consignee and of the person who made them;
- (c) their quantity;
- (d) the countries in which they were made and through which they passed in transit; and
- (e) the day on which they were imported, if applicable.

Detention

(2) Subject to subsection (3), the customs officer shall not detain, for the purpose of enforcing section 51.03, the goods for more than 10 working days – or, if the goods are perishable, for more than five days – after the day on which the customs officer first sends or makes available a sample or information to the owner under subsection

(1). At the request of the owner made while the goods are detained for the purpose of enforcing section 51.03, the customs officer may, having regard to the circumstances, detain non-perishable goods for one additional period of not more than 10 working days.

Notice of proceedings

(3) If, before the goods are no longer detained for the purpose of enforcing of section 51.03, the owner of a relevant protected mark has provided the Minister, in the manner specified by the Minister, with

a copy of a document filed with a court commencing proceedings to obtain a remedy under this Act with respect to the detained goods, the customs officer shall continue to detain them until the Minister is informed in writing that

- (a) the proceedings are finally disposed of, settled or abandoned;
- (b) a court directs that the goods are no longer to be detained for the purpose of the proceedings; or
- (c) the owner of the mark consents to the goods no longer being so detained.

Continued detention

(4) The occurrence of any of the events referred to in paragraphs (3)(a) to (c) does not preclude a customs officer from continuing to detain the goods under the Customs Act for a purpose other than with respect to the proceedings.

51.07 Restriction on information use - section 51.05

(1) A person who receives a sample or information that is provided under section 51.05 shall not use the information, or information that is derived from the sample, for any purpose other than to give information to the customs officer about whether the importation or exportation of the goods is prohibited under section 51.03.

Restriction on information use - subsection 51.06(1)

(2) A person who receives a sample or information that is provided under subsection 51.06(1) shall not use the information, or information that is derived from the sample, for any purpose other than to pursue remedies under this Act.

For greater certainty

(3) For greater certainty, subsection (2) does not prevent the confidential communication of information about the goods for the purpose of reaching an out-of-court settlement.

51.08 Inspection

After a sample or information has been provided under subsection 51.06(1), a customs officer may, in the officer's discretion, give the owner, importer, exporter and consignee of the detained goods and the owner of the relevant protected mark an opportunity to inspect the goods.

51.09 Liability for charges

(1) The owner of a relevant protected mark who has received a sample or information under subsection 51.06(1) is liable to Her Majesty in

right of Canada for the storage and handling charges for the detained goods – and, if applicable, for the charges for destroying them – for the period beginning on the day after the day on which a customs officer first sends or makes available a sample or information to that owner under that subsection and ending on the first day on which one of the following occurs:

(a) the goods are no longer detained for the purpose of enforcing section 51.03 or, if subsection 51.06(3) applies, for the purpose of the proceedings referred to in that subsection;

(b) the Minister receives written notification in which the owner of the mark states that the importation or exportation of the goods does not, with respect to the owner's relevant protected mark, contravene section 51.03;

(c) the Minister receives written notification in which the owner of the mark states that they will not, while the goods are detained for the purpose of enforcing section 51.03, commence proceedings to obtain a remedy under this Act with respect to them.

Exception – paragraph (1) (a)

(2) Despite paragraph (1) (a), if the goods are forfeited under subsection 39(1) of the *Customs Act* and the Minister did not, before the end of the detention of the goods for the purpose of enforcing section 51.03, receive a copy of a document filed with a court commencing proceedings to obtain a remedy under this Act with respect to the detained goods or the written notification referred to in paragraph (1) (b) or (c), the period ends on the day on which the goods are forfeited.

Exception – paragraph (1) (c)

(3) Despite paragraph (1) (c), if the goods are forfeited under subsection 39(1) of the *Customs Act* after the Minister has received the written notification referred to in that paragraph, the period ends on the day on which the goods are forfeited.

Joint and several or solidary liability

(4) The owner and the importer or exporter of goods that are forfeited in the circumstances set out in subsection (2) or (3) are jointly and severally, or solidarily, liable to the owner of the relevant protected mark for all the charges under subsection (1) paid by the owner of the relevant protected mark with respect to the period

(a) in the circumstances referred to in subsection (2), beginning on the day on which the goods are no longer detained for the purpose of enforcing section 51.03 and ending on the day on which the goods are forfeited; and

(b) in the circumstances referred to in subsection (3), beginning on the day on which the Minister receives the written notification referred to in paragraph (1)(c) and ending on the day on which the goods are forfeited.

Exception

(5) Subsections (1) to (3) do not apply if

(a) the detention of the goods for the purpose of enforcing section 51.03 ends before the expiry of 10 working days – or, if the goods are perishable, before the expiry of five days – after the day on which the customs officer first sends or makes available a sample or information to the owner of the mark under subsection 51.06(1); and

(b) the Minister has not, by the end of the detention, received a copy of a document filed with a court commencing proceedings to obtain a remedy under this Act with respect to the detained goods or the written notification referred to in paragraph (1)(b) or (c).

No Liability

51.10 No liability

Neither Her Majesty nor a customs officer is liable for any loss or damage suffered in relation to the enforcement or application of sections 51.03 to 51.06 and 51.08 because of

- (a) the detention of goods, except if the detention contravenes subsection 51.06(2);
- (b) the failure to detain goods; or
- (c) the release or cessation of detention of any detained goods, except if the release or cessation contravenes subsection 51.06(3).

Powers of Court Relating to Detained Goods

51.11 Application to court

(1) In the course of proceedings referred to in subsection 51.06(3), the court may, on the application of the Minister or a party to the proceedings,

(a) impose conditions on the storage or detention of the goods that are the subject of the proceedings; or

(b) direct that the goods are no longer to be detained for the purpose of the proceedings, on any conditions that the court may impose, if their owner, importer, exporter or consignee furnishes security in an amount fixed by the court.

Minister's consent

(2) If a party applies to have the detained goods stored in a place other than a bonded warehouse or a sufferance warehouse, as those terms are defined in subsection 2(1) of the Customs Act, the Minister must consent to the storage of the goods in that place before a condition to that effect is imposed under subsection (1).

Customs Act

(3) The court may impose a condition described in subsection (2) despite section 31 of the Customs Act.

Continued detention

(4) A direction under paragraph (1)(b) that the goods are no longer to be detained for the purpose of the proceedings does not preclude a customs officer from continuing to detain the goods under the Customs Act for another purpose.

Security

(5) In the course of proceedings referred to in subsection 51.06(3), the court may, on the application of the Minister or a party to the proceedings, require the owner of the relevant protected mark to furnish security, in an amount fixed by the court,

(a) to cover duties, as defined in subsection 2(1) of the Customs Act, storage and handling charges, and any other amount that may become chargeable against the goods; and

(b) to answer any damages that may by reason of the detention be sustained by the owner, importer, exporter or consignee of the goods.

51.12 Damages against trade-mark owner

A court may award damages against the owner of a relevant protected mark who commenced proceedings referred to in subsection 51.06(3) to the owner, importer, exporter or consignee of the goods who is a party

to the proceedings for losses, costs or prejudice suffered as a result of the detention of goods if the proceedings are dismissed or discontinued.

Trade-mark Agents

51.13 Privileged communication

(1) A communication that meets the following conditions is privileged in the same way as a communication that is subject to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries and no person shall be required to disclose, or give testimony on, the communication in a civil, criminal or administrative action or proceeding:

- (a) it is between an individual whose name is included on the list of trade-mark agents and that individual's client;
- (b) it is intended to be confidential; and
- (c) it is made for the purpose of seeking or giving advice with respect to any matter relating to the protection of a trade-mark, geographical indication or mark referred to in paragraph 9(1)(e), (i), (i.1), (i.3), (n) or (n.1).

Waiver

(2) Subsection (1) does not apply if the client expressly or implicitly waives the privilege.

Exceptions

(3) Exceptions to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries apply to a communication that meets the conditions set out in paragraphs (1)(a) to (c).

Trade-mark agents - country other than Canada

(4) A communication between an individual who is authorized to act as a trade-mark agent under the law of a country other than Canada and that individual's client that is privileged under the law of that other country and that would be privileged under subsection (1) had it been made between an individual whose name is included on the list of trade-mark agents and that individual's client is deemed to be a communication that meets the conditions set out in paragraphs (1)(a) to (c).

Individual acting on behalf of trade-mark agent or client

(5) For the purposes of this section, an individual whose name is included on the list of trade-mark agents or an individual who is authorized to act as a trade-mark agent under the law of a country other than Canada includes an individual acting on their behalf and a client includes an individual acting on the client's behalf.

Application

(6) This section applies to communications that are made before the

day on which this section comes into force if they are still confidential on that day and to communications that are made after that day. However, this section does not apply in respect of an action or proceeding commenced before that day.

LEGAL PROCEEDINGS

52. Definitions

In sections 53 to 53.3,

court means the Federal Court or the superior court of a province;

duties has the same meaning as in the Customs Act;

Minister means the Minister of Public Safety and Emergency Preparedness;

release [Repealed]

53. Proceedings for interim custody

(1) Where a court is satisfied, on application of any interested person, that any registered trade-mark or any trade-name has been applied to any goods that have been imported into Canada or are about to be distributed in Canada in such a manner that the distribution of the goods would be contrary to this Act, or that any indication of a place of origin has been unlawfully applied to any goods, the court may make an order for the interim custody of the goods, pending a final determination of the legality of their importation or distribution in an action commenced within such time as is prescribed by the order.

Security

(2) Before making an order under subsection (1), the court may require the applicant to furnish security, in an amount fixed by the court, to answer any damages that may by reason of the order be sustained by the owner, importer or consignee of the goods and for any amount that may become chargeable against the wares while they remain in custody under the order.

Lien for charges

(3) Where, by the judgment in any action under this section finally determining the legality of the importation or distribution of the goods, their importation or distribution is forbidden, either absolutely or on condition, any lien for charges against them that arose prior to the date of an order made under this section has effect only so far as may be consistent with the due execution of the judgment.

Prohibition of imports

(4) Where in any action under this section the court finds that the importation is or the distribution would be contrary to this Act, it may make an order prohibiting the future importation of goods to which the trade-mark, trade-name or indication of origin has been applied.

How application made

(5) An application referred to in subsection (1) may be made in an

action or otherwise, and either on notice or ex parte.

Limitation

(6) No proceedings may be taken under subsection (1) for the interim custody of wares by the Minister if proceedings for the detention of the goods by the Minister may be taken under section 53.1.

53.1 Proceedings for detention by Minister

(1) (1) Where a court is satisfied, on application by the owner of a registered trade-mark, that any goods to which the trade-mark has been applied are about to be imported into Canada or have been imported into Canada but have not yet been released, and that the distribution of the goods in Canada would be contrary to this Act, the court may make an order

(a) directing the Minister to take reasonable measures, on the basis of information reasonably required by the Minister and provided by the applicant, to detain the goods;

(b) directing the Minister to notify the applicant and the owner or importer of the goods, forthwith after detaining them, of the detention and the reasons therefor; and

(c) providing for such other matters as the court considers appropriate.

How application made

(2) An application referred to in subsection (1) may be made in an action or otherwise, and either on notice or ex parte, except that it must always be made on notice to the Minister.

Court may require security

(3) Before making an order under subsection (1), the court may require the applicant to furnish security, in an amount fixed by the court,

(a) to cover duties, storage and handling charges, and any other amount that may become chargeable against the goods; and

(b) to answer any damages that may by reason of the order be sustained by the owner, importer or consignee of the goods.

Application for directions

(4) The Minister may apply to the court for directions in implementing an order made under subsection (1).

Minister may allow inspection

(5) The Minister may give the applicant or the importer of the detained goods an opportunity to inspect them for the purpose of substantiating or refuting, as the case may be, the applicant's claim.

Where applicant fails to commence an action

(6) Unless an order made under subsection (1) provides otherwise, the

Minister shall, subject to the Customs Act and to any other Act of Parliament that prohibits, controls or regulates the importation or exportation of goods, release the goods without further notice to the applicant if, two weeks after the applicant has been notified under paragraph (1)(b), the Minister has not been notified that an action has been commenced for a final determination by the court of the legality of the importation or distribution of the goods.

Where court finds in plaintiff' s favour

(7) Where, in an action commenced under this section, the court finds that the importation is or the distribution would be contrary to this Act, the court may make any order that it considers appropriate in the circumstances, including an order that the goods be destroyed or exported, or that they be delivered up to the plaintiff as the plaintiff's property absolutely.

53.2 Power of court to grant relief

(1) If a court is satisfied, on application of any interested person, that any act has been done contrary to this Act, the court may make any order that it considers appropriate in the circumstances, including an order providing for relief by way of injunction and the recovery of damages or profits, for punitive damages and for the destruction or other disposition of any offending goods, packaging, labels and advertising material and of any equipment used to produce the goods, packaging, labels or advertising material.

Notice to interested persons

(2) Before making an order for destruction or other disposition, the court shall direct that notice be given to any person who has an interest or right in the item to be destroyed or otherwise disposed of, unless the court is of the opinion that the interests of justice do not require that notice be given.

53.3 Unaltered state - exportation, sale or distribution

(1) A court is not permitted, in any proceeding under section 53.1 or 53.2, to make an order under that section requiring or permitting the goods to be exported, sold or distributed in an unaltered state, except in a manner that does not affect the legitimate interests of the owner of the registered trade-mark or except in exceptional circumstances, if the court finds that

(a) goods bearing the registered trade-mark have been imported into Canada in such a manner that the distribution of the goods in Canada would be contrary to this Act; and

(b) the registered trade-mark has, without the consent of the owner, been applied to those goods with the intent of counterfeiting or imitating the trade-mark, or of deceiving the public and inducing them to believe that the goods were made with the consent of the owner.

Removal of trade-mark

(2) Subsection (1) also applies with respect to goods for which the only alteration is the removal of the trademark.

54. Evidence

(1) Evidence of any document in the official custody of the Registrar or of any extract therefrom may be given by the production of a copy thereof purporting to be certified to be true by the Registrar.

Idem

(2) A copy of any entry in the register purporting to be certified to be true by the Registrar is evidence of the facts set out therein.

Idem

(3) A copy of the record of the registration of a trade-mark purporting to be certified to be true by the Registrar is evidence of the facts set out therein and that the person named therein as owner is the registered owner of the trade-mark for the purposes and within the territorial area therein defined.

Idem

(4) A copy of any entry made or documents filed under the authority of any Act in force before July 1, 1954 relating to trade-marks, certified under the authority of that Act, is admissible in evidence and has the same probative force as a copy certified by the Registrar under this Act as provided in this section.

55. Jurisdiction of Federal Court

The Federal Court has jurisdiction to entertain any action or proceeding, other than a proceeding under section 51.01, for the enforcement of any of the provisions of this Act or of any right or remedy conferred or defined by this Act.

56. Appeal

(1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

Procedure

(2) An appeal under subsection (1) shall be made by way of notice of appeal filed with the Registrar and in the Federal Court.

Notice to owner

(3) The appellant shall, within the time limited or allowed by subsection (1), send a copy of the notice by registered mail to the registered owner of any trade-mark that has been referred to by the Registrar in the decision complained of and to every other person who was entitled to notice of the decision.

Public notice

(4) The Federal Court may direct that public notice of the hearing of an appeal under subsection (1) and of the matters at issue therein be given in such manner as it deems proper.

Additional evidence

(5) On an appeal under subsection (1), evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.

57. Exclusive jurisdiction of Federal Court

(1) The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.

Restriction

(2) No person is entitled to institute under this section any proceeding calling into question any decision given by the Registrar of which that person had express notice and from which he had a right to appeal.

58. How proceedings instituted

An application under section 57 shall be made either by the filing of an originating notice of motion, by counter-claim in an action for the infringement of the trade-mark, or by statement of claim in an action claiming additional relief under this Act.

59. Notice to set out grounds

(1) Where an appeal is taken under section 56 by the filing of a notice of appeal, or an application is made under section 57 by the filing of an originating notice of motion, the notice shall set out full particulars of the grounds on which relief is sought.

Reply

(2) Any person on whom a copy of the notice described in subsection (1) has been served and who intends to contest the appeal or application, as the case may be, shall file and serve within the prescribed time or such further time as the court may allow a reply setting out full particulars of the grounds on which he relies.

Hearing

(3) The proceedings on an appeal or application shall be heard and determined summarily on evidence adduced by affidavit unless the court otherwise directs, in which event it may order that any procedure permitted by its rules and practice be made available to the parties, including the introduction of oral evidence generally or in respect of one or more issues specified in the order.

60. Registrar to transmit documents

(1) Subject to subsection (2), when any appeal or application has been made to the Federal Court under any of the provisions of this Act, the Registrar shall, at the request of any of the parties to the proceedings and on the payment of the prescribed fee, transmit to the Court all documents on file in the Registrar's office relating to the matters in question in those proceedings, or copies of those documents certified by the Registrar.

Register of registered users

(2) The transmission of documents on which entries in the register required to be kept under paragraph 26(1)(b) are based is subject to the provisions of subsection 50(6) of the *Trade-marks Act*, as it read immediately before section 69 of the *Intellectual Property Law Improvement Act* came into force.

61. Judgments

An officer of the Registry of the Federal Court shall file with the Registrar a certified copy of every judgment or order made by the Federal Court, the Federal Court of Appeal or the Supreme Court of Canada relating to any trade-mark on the register or to any protected geographical indication.

GENERAL

62. Administration

This Act shall be administered by the Minister of Industry.

63. Registrar

(1) There shall be a Registrar of Trade-marks, who shall be the Commissioner of Patents appointed under subsection 4(1) of the Patent Act. The Registrar shall be responsible to the Deputy Minister of Industry.

Acting registrar

(2) When the Registrar is absent or unable to act or when the office of Registrar is vacant, his powers shall be exercised and his duties and functions performed in the capacity of acting registrar by such other officer as may be designated by the Minister of Industry.

Assistants

(3) The Registrar may, after consultation with the Minister, delegate to any person he deems qualified any of his powers, duties and functions under this Act, except the power to delegate under this subsection.

Appeal

(4) Any decision under this Act of a person authorized to make the decision pursuant to subsection (3) may be appealed in the like manner and subject to the like conditions as a decision of the Registrar under this Act.

64. Publication of registrations

The Registrar shall cause to be published periodically particulars of the registrations made and extended from time to time under this Act, and shall in such publication give particulars of any rulings made by him that are intended to serve as precedents for the determination of similar questions thereafter arising.

65. Regulations

The Governor in Council may make regulations for carrying into effect the purposes and provisions of this Act and, in particular, may make regulations with respect to the following matters:

- (a) the form of the register and of the indexes to be maintained pursuant to this Act, and of the entries to be made therein;
- (b) the form of applications to the Registrar;
- (c) the registration of transfers, licences, disclaimers, judgments

or other documents relating to any trade-mark;

(c.1) the maintenance of the list of trade-mark agents and the entry and removal of the names of persons and firms on the list, including the qualifications that must be met and the conditions that must be fulfilled to have a name entered on the list and to maintain the name on the list;

(d) the form and contents of certificates of registration;

(d.1) the procedure by and form in which an application may be made to the Minister, as defined in section 11.11, requesting the Minister to publish a statement referred to in subsection 11.12(2); and

(e) the payment of fees to the Registrar and the amount thereof.

65.2 Regulations

The Governor in Council may make regulations

(a) respecting the list to be kept under subsection 11.12(1), including information relating to the listed geographical indications and translations to be included on the list; and

(b) respecting proceedings under section 11.13, including documents relating to those proceedings.

66. Time limit deemed extended

(1) Where any time limit or period of limitation specified under or pursuant to this Act expires on a day when the Office of the Registrar of Trade-marks is closed for business, the time limit or period of limitation shall be deemed to be extended to the next day when the Office is open for business.

When Trade-marks Office closed for business

(2) The Office of the Registrar of Trade-marks shall be closed for business on Saturdays and holidays and on such other days as the Minister by order declares that it shall be closed for business.

Publication

(3) Every order made by the Minister under subsection (2) shall be published in the *Trade-marks Journal* as soon as possible after the making thereof.

NEWFOUNDLAND

67. Registration of trade-mark before April 1, 1949

(1) The registration of a trade-mark under the laws of Newfoundland before April 1, 1949 has the same force and effect in the Province of Newfoundland as if Newfoundland had not become part of Canada, and all rights and privileges acquired under or by virtue of those laws may continue to be exercised or enjoyed in the Province of Newfoundland as if Newfoundland had not become part of Canada.

Applications for trade-marks pending April 1, 1949

(2) The laws of Newfoundland as they existed immediately before April 1, 1949 continue to apply in respect of applications for the registration of trade-marks under the laws of Newfoundland pending at that time and any trade-marks registered under those applications shall, for the purposes of this section, be deemed to have been registered under the laws of Newfoundland before April 1, 1949.

68. Use of trade-mark or trade-name before April 1, 1949

For the purposes of this Act, the use or making known of a trade-mark or the use of a trade-name in Newfoundland before April 1, 1949 shall not be deemed to be a use or making known of such trade-mark or a use of such trade-name in Canada before that date.

TRANSITIONAL PROVISION

68.1. Use of the indication “Beaufort”

(1) During the period that begins on the day on which this subsection comes into force and ends on the fifth anniversary of that day, section 11.15 does not apply to the use, in connection with a business, of the indication “Beaufort”, or any translation of it in any language, by a person if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of cheeses, as set out in the schedule, for less than 10 years before October 18, 2013.

Use of the indication “Nurnberger Bratwurste”

(2) During the period that begins on the day on which this subsection comes into force and ends on the fifth anniversary of that day, section 11.15 does not apply to the use, in connection with a business, of the indication “Nürnberg Bratwürste”, or any translation of it in any language, by a person if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of fresh, frozen and processed meats, as set out in the schedule, for less than five years before October 18, 2013.

Use of the indication “Jambon de Bayonne”

(3) During the period that begins on the day on which this subsection comes into force and ends on the fifth anniversary of that day, section 11.15 does not apply to the use, in connection with a business, of the indication “Jambon de Bayonne”, or any translation of it in any language, by a person if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of dry-cured meats, as set out in the schedule, for less than 10 years before October 18, 2013.

Restriction

(4) For the purposes of subsections 68.1(1) to (3), no person is a predecessor in title if they only transferred the right to use the indication or the translation, or both.

69. Prior applications for registration

An application for the registration of a trade-mark filed before this section comes into force shall not be refused by reason only that

subsection 50(1) deems the use, advertisement or display of the trade-mark by a licensed entity always to have had the same effect as a use, advertisement or display of the trade-mark by the owner.