



Innovation, Science and
Economic Development Canada
Canadian Intellectual Property Office

Innovation, Sciences et
Développement économique Canada
Office de la propriété intellectuelle du Canada

Canada

Recording of a Partial Cancellation

Madrid Working Group Roundtable - 2023

Trademarks and Industrial Designs Branch
Canadian Intellectual Property Office

Canadian *Trademarks Regulations* - Partial Cancellation

A notification of partial cancellation received while the designation to Canada is **pending** (Protocol application) is covered under section 110.

A Protocol application is deemed to be **withdrawn or amended accordingly** where a notification of partial cancellation (either voluntary or by way of ceasing of effect) is received from the International Bureau.

A notification of partial cancellation received after the designation to Canada has **been granted protection** (Protocol Registration) is covered under section 138.

A Protocol registration is either **cancelled or the register is amended accordingly** following the receipt of a notification of partial cancellation from the International Bureau.

Canadian *Trademarks Regulations* - Partial Cancellation

Sections 110 and 138 of the Canadian *Trademarks Regulations* provide that the Protocol application or registration are deemed to be “amended accordingly”

Allows for some flexibility in recording the final scope of protected goods or services after receiving a notification of partial cancellation from the IB

Where the final scope of protection has already been communicated to the IB in a Statement of Grant of Protection, a partial cancellation can be recorded with or without changes to the list of goods or services in Canada → “amended accordingly”

Issues Encountered

- Notification of partial cancellation due to ceasing of effect of the basic mark which includes goods or services that are not within the scope of the main list of the international registration
- List of goods or services in partial cancellation notifications does not always meet our specificity or ordinary commercial terms requirements (pending applications still under examination)
- Complex assessments required to determine the resulting scope of protection in Canada in relation to the main list of goods or services in the international registration

Example Where Scope of Main List is Broadened

Class	Main List	Partial Cancellation
35	Retail and online retail services for recreational vehicles	Retail and online stores featuring recreational vehicles, parts, supplies, and accessories for recreational vehicles

- Highlighted items in partial cancellation are broader in scope than the main list (protection granted without issuing a provisional refusal)
- Recording a broader statement than what was filed is contrary to our *Regulations*

Example Where Scope of Main List is Broadened

Class	Main List	Partial Cancellation
9	Mobile application software for instruction in the field of music and performance; computer educational software for instruction in the field of music through the use of educational games.	Downloadable mobile application software for instruction in the field of music and performance; downloadable computer educational software for instruction in the field of music through the use of educational games; sunglasses; microphones; providing temporary use of online non-downloadable educational software for instruction in the field of music through the use of educational games.

- Highlighted items in partial cancellation are broader in scope than the main list
- Recording a broader statement than what was filed is contrary to our *Regulations*

Example Where Nice Classification is Changed

Class	Main List at Designation	Statement in Partial Cancellation
29	Chili; [...]	Chili; [...] chicken tenders in the nature of chicken nuggets.
30	Ice cream; [...] chicken tenders.	Ice cream; [...]

- Trademark registered in Canada (protection granted)
- Good moved from class 30 to class 29
- Recording of change to Nice class is not permitted

Example Where Nice Classification is Changed

Class	Main List	Statement in Partial Cancellation
41	Providing information in the field of [...] via a website; [...]	Providing temporary use of non-downloadable computer game software; providing a web site featuring information in the field of [...]
42	Providing temporary use of non-downloadable computer game software; [...]	Class 42 is deleted.

- Trademark registered in Canada (protection granted)
- Service moved from class 42 to 41
- Recording of change to Nice class is not permitted

Example - Remove from list

Class	Main List	Statement in Partial Cancellation Remove
03	Non-medicated skin products, beauty products, cosmetic products	Non-medicated skin products namely non-medicated toiletries, non-medicated creams and lotions, non-medicated cosmetics
05	medicated skin products	medicated creams, medicated lotions, medicated soap, medicated handwash

- Goods listed in partial cancellation are to be “**removed from list**”
- Final scope of goods to be protected is unclear

Examples - Issues specific to our office

- Protocol application in opposition period
- Highlighted portion of the statement in the partial cancellation does not comply with *Trademarks Act and Regulations*
- Time limit to issue provisional refusal has expired
- No means of communicating the final scope to the IB

Class	Main List at Designation	Statement in Partial Cancellation
9	Medical software for processing medical information;	A feature sold as an integral component of recorded medical software for processing medical information;

Examples - Issues specific to our office

- Protection has been granted in Canada
- Narrower scope of protection in Canada due to our specificity requirements for goods and services
- Statement from the partial cancellation does not clearly align with the amended statement submitted by the client in the Canadian designation
- A complex assessment as shown on the next slide is required to determine the final scope in Canada

Examples - Issues specific to our office

Class	Designation	Registered statement	Partial Cancellation	Final Statement Recorded
41	Educational services, namely, conducting classes, seminars, conferences, and workshops in the fields of business, information technology, computers, management training, financial planning and investment strategies;	Educational services, namely, conducting classes, seminars, conferences, and workshops in the fields of business management, business administration, business planning, business organization, human resources, business processes and operations, and information technology, namely computer servers, computer hardware and computer software, and, computers, management training, financial planning and investment strategies;	Educational services, namely, conducting classes, seminars, conferences, and workshops in the fields of business, information technology, computers, management training, financial planning and investment strategies;	Educational services, namely, conducting classes, seminars, conferences, and workshops in the fields of business management, business administration, business planning, business organization, human resources, business processes and operations, and information technology, namely computer servers, computer hardware and computer software, and, computers, management training, financial planning and investment strategies;

Further Issues - Office of Origin

- Challenging to communicate the list of goods or services to the IB in a partial ceasing of effect notification when changes were made to the Nice Classification during examination of the basic mark
- Complex assessments are almost always required which are arduous and time consuming
- Majority of international applications that Canada certifies involve a new basic application that has not been examined

Example as an Office of Origin

Class	Basic Application	IR	Changes to Scope
12	Powered ride-on vehicles	N/A	
16	Paper party hats	N/A	
28	[...]	[...]	[...] Powered ride-on vehicles; paper party hats

- During examination goods from classes 12 and 16, which were not included in the international application, were moved to class 28 which is in the main list of the international registration
- Assessment required to ensure that the ceasing of effect notification from our office does not broaden the scope of the main list for class 28

Possible Ways Forward



As a designated office, introduce a new office practice in Canada requesting the holder's input in determining the intended final scope of protection



Introduce in the Madrid System a way for offices to declare that a partial cancellation has no effect and/or a way to communicate to the IB the final scope of goods/services protected



Abolish basic mark dependency and amend voluntary partial cancellation provisions

Questions?



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