

Submission to the Canadian Intellectual Property Office

Consultation: Fee-For-Service Proposal — Trademarks

July 4, 2016



INTELLECTUAL PROPERTY INSTITUTE OF CANADA
INSTITUT DE LA PROPRIÉTÉ INTELLECTUELLE DU CANADA

The Intellectual Property Institute of Canada (IPIC) is the professional association of trademark agents, patent agents and lawyers practising in all areas of intellectual property law. Our membership totals over 1,700 individuals, consisting of practitioners in law firms and agencies of all sizes, sole practitioners, in-house corporate intellectual property professionals, government personnel, and academics. Our members' clients include virtually all Canadian businesses, universities and other institutions that have an interest in intellectual property (e.g. trademarks, patents, copyright and industrial designs) in Canada or elsewhere, and also foreign companies who hold intellectual property rights in Canada.

IPIC is pleased to respond to the request by the Canadian Intellectual Property Office (CIPO) for comments on the consultation entitled "Fee-For-Service Proposal —Trademarks". This submission was prepared by IPIC's Trademark Practice Committee and approved by IPIC's governing Council.

Fee-For-Service Proposal — Trademarks

Pursuant to the changes to the trademark regulatory regime set out in the amendments to the *Trade-marks Act* and pursuant to the consultation process set out in the *User Fees Act*, CIPO has proposed a new fee structure for various steps in the application process. IPIC is generally in agreement with the proposed fee structure. The Institute has also identified some potential areas not yet addressed by CIPO.

Comments regarding specific fees proposed

Application Fees – (for first class) the proposed approach of merging the application and registration fees into one application fee was viewed as generally fair and reasonable (both the approach and the amount). CIPO has already considered (and rejected) a two-tiered approach for *domestic v. Madrid* applicants as being administratively burdensome which was one approach advocated for by some members.

Fee-per-Nice classification – (per additional class) the proposed approach of charging a fee-per-Nice classification (\$100 per class upon application and \$125 per class upon renewal) was viewed as generally fair and reasonable.

Application to extend goods & services to an existing registration – the proposed fees for extension applications were viewed as generally fair and reasonable.

Renewals – the proposed fees for renewals were viewed as generally fair and reasonable. The above fees were viewed as being generally in-line with other jurisdictions which have similar procedures as those here in Canada. The fee per class structure would also be aligned with other jurisdictions and would hopefully serve to minimize overly broad applications, which are of concern to IPIC and its members.

Comments regarding proposed service standards

IPIC is in general agreement with the service standards proposed by CIPO.

Comments regarding steps not covered by current proposal

The proposal from CIPO addresses the primary fees which would be paid by applicants during the prosecution process. However, IPIC has identified potential areas which have not yet been addressed by CIPO and would suggest that a few of these steps be considered. For instance, the current fee proposal does not appear to address potential fees for division or merger of applications. Further, the proposal does not appear to address a mechanism for the process of refunds for official fees. For example, how a refund will be issued if an applicant has paid fees for separate classes and CIPO reclassifies the goods/services into fewer classes.

As another example, the mechanism for providing advance notice to the profession before implementation of the new fee schedule as well as the *Trade-marks Act* and *Trade-marks Regulations* to allow for relevant updates.

Summary

IPIC supports CIPO's proposed fee changes relating to trademark services.