

ABOUT BRANDS UNDER ATTACK

NEWSLETTER
JUNE 2020

ISSUES PARTICULAR TO PROTOCOL APPLICATIONS IN CANADA

Protocol Applications Now Open to Possible Opposition in Canada

IN THIS ISSUE

Madrid Protocol in Canada: NOTIFICATION OF POSSIBLE OPPOSITION

During the current public health crisis, the Canadian Intellectual Property Office ("CIPO") remains open for business as usual.

Canada acceded to the Madrid Protocol on June 17, 2019.

As of May 4, 2020 CIPO began sending to the World Intellectual Property Office ("WIPO") notification of possible opposition ("NPO") against the first extensions of International Registrations into Canada ("Protocol Applications"). This means that the granting of protection for these Protocol Applications may be subject to opposition beyond the 18-month time limit for notifying WIPO of refusal of protection in Canada under the Madrid Protocol.

Are there special restrictions in opposition proceedings against Protocol Applications in Canada? Yes.

Protocol Applications enjoy some key advantages not available to National Appli-

cations. For instance,

- No extension of time to oppose a Protocol Application is available 4 months past the initial deadline;
- No new grounds of Opposition possible against a Protocol Application once a Statement of Opposition has been issued and sent to WIPO.

However, Protocol Applications in Canada are examined to the same standards and following the same process as national applications. This includes the possibility of opposition by third parties.

The average time to examination in Canada is slower than many countries. Given the time to examination, the NPO is a step which must be taken to ensure protection is not granted in Canada without the opportunity for opposition. It is also a necessary step to allow a prospective opponent to obtain a 4-month extension of the initial 2-month deadline after advertisement to oppose. Given CIPO's requirement to appoint a Canadian agent ([discussed here](#)), CIPO will not send to WIPO but will send only to the Applicant and by mail only (or its appointed Canadian agent) any notice that an extension of time has been granted.

While a NPO does not mean the granting of protection will be opposed, it operates as a placeholder to allow prospective opponents the opportunity to oppose.

For more information on this, please contact a member of our team at: newsletter@ollip.com

Disclaimer:
This briefing note is not legal or professional advice.

ABOUT US

OLLIP P.C. is an intellectual property agency and law firm with offices in Ottawa and Toronto, Canada.

We are the authors of the leading treatise *Odutola on Canadian Trademark Practice: Vol. I Prosecution and Vol. II Opposition, Summary Cancellation and Appeals*, published by Carswell, a Thomson Reuters Business. Now in its 15th year, it is relied on by the Courts, the Trademarks Office and the trademark profession.

OLLIP P.C. has one of the few lawyers who have been certified by the Law Society of Ontario as dual specialists in trademark and copyright law.

From advice, creation to enforcement - from [brands](#), [technology](#) to [copyrights](#) - for [over 24 years](#), [successful businesses](#) and [their counsel](#) have relied on us.

Editors:
Karen Hansen
Bayo Odutola



OTTAWA
Tel.: +1 613.238.1140
Fax: +1 613.238.5181

TORONTO
Tel.: +1 647.496.0313
Fax: +1 647.496.0315
www.ollip.com

Foreign Department:
Frau Claudia Pietrulla
Tel.: +49 (0)8221.274.0097