

ABOUT BRANDS UNDER ATTACK

NEWSLETTER
MAY 2020

ISSUES PARTICULAR TO PROTOCOL APPLICATIONS IN CANADA

Strategies to Prevent Missing Protocol Deadlines

IN THIS ISSUE

Madrid Protocol in Canada: WHY APPOINT A CANADIAN AGENT FOR PROTOCOL APPLICATIONS

During the current public health crisis, the Canadian Intellectual Property Office ("CIPO") remains open for business as usual. When CIPO receives a designation, it issues a courtesy letter to the World Intellectual Property Office ("WIPO") representative that further correspondence regarding the Protocol application will be directly with the applicant or the appointed Canadian agent. Unlike in other jurisdictions, a Protocol Applicant without Canadian agent, will receive and CIPO will send to WIPO only a limited set of correspondence. That is CIPO will only send electronically to WIPO notices required under the Protocol including Total Provisional Refusals, Confirmations of Total Provisional Refusals, Statements of Grant of Protection and Invalidation of Registration.

CIPO will not correspond with the WIPO representative. Not all CIPO correspondence is sent to WIPO. Important communications which CIPO will not send to WIPO but will send only to the Applicant by mail are as follows:

- Approval Notices;
- subsequent Examiner's Reports (i.e. objection has been maintained but further opportunity to respond)
- Notices of Default;
- Refusals (with an appeal deadline);
- Correspondence in opposition proceedings; and
- Section 45 Notices (post-registration non-use cancellation).

This means that in many cases, a deadline will be set, but WIPO (and therefore the WIPO representative) will not be informed.

Lost Mail

CIPO correspondence is not available online. In our experience correspondence sent via mail from CIPO may not be received for various reasons. It may be lost or attached to correspondence destined to another party. Failure to meet deadlines set by such correspondence can result in loss of rights. CIPO takes no responsibility for lost mail even during the current public health crisis.

As such appointing a Canadian agent would comply with CIPO's requirements and alleviate the risk of missed deadlines.

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.

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