

# ABOUT BRANDS UNDER ATTACK

FEBRUARY 2022

## IN THIS ISSUE

### Madrid Protocol in Canada: How WIPO turned into the most favoured trademark jurisdiction

No one likes to admit that they have favourites but when it comes to obtaining VIP access to national trademark offices, the World Intellectual Property Office wins hands down. So does this make national applications the poor cousin of Protocol applications?

#### Background

In our previous Newsletter, we discussed how trademark applications in Canada filed through the Madrid Protocol are being examined much sooner than national applications. Also, in our July 2021 Newsletter, we mentioned one way to speed up the process. That is, avoid objections to the descriptions of goods and services by using the Office's "pick list" at the time of designation. The Canadian Intellectual Property Office (Office) is currently examining Protocol applications approximately 16 months after the date of WIPO's notification of designation compared to some national applications that have yet to be examined after 36 months. So how can national and Protocol applicants speed the examination process?

#### Lessons Learned

In our experience, insufficiently specific descriptions of goods and services are the basis of a large number of Examiner's objections. This in turn slows down examination. In fact, the Office is trying to reduce the burden of dealing with such

descriptions by rewarding national applications, at least, with a 5-month reduction in wait time to examination if the descriptions of goods and services in the application are on the Office's pre-approved list.

What about Protocol applications currently awaiting examination? The descriptions of goods and services can still be amended before examination. Any amendments to the descriptions before the issuance of a Total Provisional Refusal must be made through the International Bureau of WIPO. Will this speed up Protocol applications even more. Probably!

The full list of goods and services which are pre-approved by the Office are listed in the Office's Goods and Services Manual on the Office's website. Though the list in the Office's Manual changes regularly, such that a description which is listed as acceptable now might no longer be acceptable in several months when an application containing those descriptions is examined, choosing descriptions from the list still provides a better chance of the Office accepting the description.

Under Canadian law, the amended descriptions must be within the scope of the descriptions of goods and services in the Protocol application as filed. Thus, for example, if the original description were "footwear", an amendment to "footwear, namely boots and shoes" would be acceptable, but not an amendment to "shirts". And, if the descriptions in the Office's Goods and Service Manual do not properly reflect the applicant's goods and services, the applicant should instead use descriptions which are as specific as those in the Manual. Otherwise, if the descriptions don't accurately reflect the applicant's goods and services, the applicant may have trouble enforcing the registration containing those descriptions against others.

## ABOUT US

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

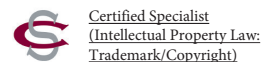
We are the authors of the leading treatise: [Odutola on Canadian Trademark Practice: Vol. I Prosecution and Vol. II Opposition, Summary Cancellation and Appeals](#), published by Carswell, a Thomson Reuters Business. Now in its 17th year, it is relied on by the Courts, the Trademarks Office and the trademark 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



Certified Specialist  
(Intellectual Property Law:  
Trademark/Copyright)

#### 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](http://www.ollip.com)

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