

CWS/ATR/TM/2019/CA

Annual Technical Report on Trademark Information Activities in 2019 submitted by the Canadian Intellectual Property Office

I. GENERAL OVERVIEW OF RECENT DEVELOPMENTS IN TRADEMARK INFORMATION ACTIVITIES CARRIED OUT BY THE OFFICE

Canada's modernized trademarks legislative framework officially came into force on June 17, 2019, enabling Canada to accede to the Singapore Treaty, the Madrid Protocol, and the Nice Agreement.

By joining the Singapore Treaty, the Madrid Protocol and the Nice Agreement, Canadian businesses and innovators now have access to efficient means of protecting their trademarks in various jurisdictions around the world. A modernized trademark regime that is aligned with other jurisdictions lowers the cost and increases the ease of doing business in Canada to the benefit of both Canadian businesses and those looking to invest in Canadian markets.

Adhering to the Singapore Treaty, the Madrid Protocol, and the Nice Agreement provides Canadian businesses with:

- One form, one transaction, one currency, one place: Applicants can choose to apply for trademark protection in multiple countries via one application form sent to one location and paying one time in one currency.
- Harmonized administrative procedures and formalities: Similar and standardized trademark procedures in multiple countries lead to efficiencies, administrative savings and reduced compliance costs for businesses.
- Consistent goods and services classification system: Goods and services are classified consistently across multiple countries facilitating global trademark searching.

Modernizing Canada's domestic trademark regime also has key benefits for businesses:

- Reduced Filing Costs: Filing costs are now lower for approximately 50% of applicants.
- Lower Administrative Burden: Application and filing date requirements are simplified and streamlined. There are also increased flexibility for error correction and a broadened scope of business for trademark agents.
- Enhanced E-Services: Improved e-filing interface for clients, including enhanced functionalities and new services.

Outline of main policies and plans aimed at development of trademark information activities and expected time frames for their realization

New projects launched or resumed this year in the context of the policies and plans mentioned above, short description: aims, partners, tasks

Main areas of trademark information activities and related information and communication technology (ICT) practices which were in the focus of attention last year

Statistics: changes in terms of application filings and registrations with respect to previous year; trends or areas experiencing rapid changes

Trademark Filings

Year	Resident	Non-Resident	Total
2014	21,303	29,725	51,028
2015	22,589	29,872	52,461
2016	23,652	31,013	54,665
2017	25,853	33,060	58,913
2018	27,411	35,797	63,208
2019	28,353	30,229	58,582

Trademark Registrations

Year	Resident	Non-Resident	Total
2014	10,406	14,705	25,111
2015	13,224	18,283	31,507
2016	14,864	19,442	34,306
2017	12,257	16,364	28,621

2018	10025	14508	24,533
2019	16060	39940	56,000

Madrid Designations

Year	Registrations	Subsequent Designations
2019	4841	1499

Office of Origin

Year	Applications for International Registration
2019	289

Other matters and useful links (URLs): annual report of the Office, news page, statistics, etc.

IP Canada Report 2019

https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr04682.html

CIPO Performance Targets 2019

http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr02948.html

CIPO News

<https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/whatsnew.html>

II. SERVICES AND ACTIVITIES RELATED TO TRADEMARK INFORMATION CARRIED OUT BY THE OFFICE

Information and support provided by the Office to applicants regarding filing on paper and/or e-filing (instructions, seminars, etc.) - URLs

http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr00021.html#trade-marks

Availability of the application dossier in electronic form

Currently trademark documents are still in paper format. CIPO is undertaking a project as part of its IT Modernization initiative to create an application dossier in electronic form for trademarks.

Matters concerning classifying

(i) Classification and reclassification activities; classification systems used, e.g., International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification), International Classification of the Figurative Elements of Marks (Vienna Classification), other classification

Since June 17th 2019, CIPO requires the use of NICE classification for goods and services.

(ii) Use of electronic classification systems and pre-defined terms of the classification applied

A Goods and Services Manual is available on CIPO's website. This searchable database is designed to assist applicants in compiling the statements of goods or services required to file a Canadian trademark application. This representative listing of terms has been classified according to the latest version of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification). All entries are pre-approved by CIPO and, if selected, will be accepted by the Office without the need for further specification.

Matters concerning processing of different types of non-traditional marks (e.g., three-dimensional, motion, hologram, color mark, etc.)

Amendments to the Trademarks Act that came into force on June 17th 2019, allow for non-traditional trademarks for example and not limited to scent, texture, holograms, movement trademarks, etc.

Other activities

III. SOURCES OF TRADEMARK INFORMATION PROVIDED BY THE OFFICE

Main types of publications in the field of trademark information, outline of the content and medium (on paper, on CDs, online - URLs)

Trademarks Journal: Our weekly Trademarks Journal contains marks for applications filed, which are advertised following approvals, and announcements regarding registrations. These announcements include:

- the date of the application/registration;
- the serial number of the application/registration;
- the name and address of the owner;
- a reproduction of the trademark or necessary information for public inspection;
- a statement of goods and/or services.

Practice Notices: Practice notices pertaining to Office Practices and Policies are available on the Trademarks home page of the CIPO website under Practice Notices.

Trademark News email subscription service: Clients can register to our email subscription service to stay in touch with the latest trademarks developments at CIPO. These emails will include:

- updates to the Goods and Services Manual;
- new consultations on trademarks;
- practice notices on trademarks; and
- "What's New" announcements on trademarks posted on the CIPO website.

Twitter: CIPO's Twitter presence is intended to enhance two-way communication between CIPO and its customers as laid out in the Business Strategy.

Official Gazettes: main types of announcements, frequency of publication, medium (on paper, on CDs, online, URL), etc.

The Trademarks Journal is available in electronic form on the Canadian Intellectual Property Office (CIPO) web site (www.cipo.gc.ca). The Journal is available in PDF format and can be downloaded (free of charge), viewed and printed with Adobe Reader. The electronic form of the Journal is the official version. All Trademarks Journals from January 2000 onwards are also available online.

Trademark Journal

https://www.ic.gc.ca/opic-cipo/tmj/eng/home.html?wt_src=cipo-tm-main&wt_cxt=toptask

Practice Notices

http://www.cipo.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr00132.html

Trademark Newsletter

<http://www.cipo.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr02989.html#tradeMark>

Canadian Trademarks Database - Basic Search

<http://www.cipo.gc.ca/app/opic-cipo/trdmrks/srch/bscSrch.do?lang=eng>

Canadian Trademarks Database - Advanced Search

<http://www.cipo.gc.ca/app/opic-cipo/trdmrks/srch/tmSrch.do?lang=eng>

Canadian Goods and Services Manual

<https://www.ic.gc.ca/app/scr/ic/cgs/ext/home.html>

Information products (coverage, medium, etc.) available to examiners, including external documentation and databases

Trademarks Examination Manual

https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01614.html?Open&wt_src=cipo-agent-main

Madrid Examination and Procedures Manual

https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04632.html?Open&wt_src=cipo-tm-main

Information products (coverage, medium, etc.) and services available to external users; conditions of access (e.g., free of charge, subscription, etc.)

Trademarks Examination Manual

https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01614.html?Open&wt_src=cipo-agent-main

Legal status information (kind of information, coverage, medium, etc.)

Other sources

Canadian Trademark Legislation

Trademarks Act

<https://laws-lois.justice.gc.ca/eng/acts/t-13/>

Trademarks Regulations

<https://laws-lois.justice.gc.ca/eng/regulations/SOR-2018-227/index.html>

IV. ICT SUPPORT TO SERVICES AND ACTIVITIES RELATED TO TRADEMARK INFORMATION CARRIED OUT BY THE OFFICE

Specific software tools supporting business procedures within the Office: general description, characteristics, advantages, possible improvements

The Trademarks Branch utilizes an end-to-end trademark processing system, INTREPID II, and the system became fully operational in November 1996. INTREPID II operates in a client/server environment. All trademark employees have access to the system via an internal, Local Area Network (LAN). The system contains bibliographic trademark data dating from the beginning of Canada's trademark management system in 1864, including pending and registered trademarks, trademark designs, outgoing correspondence and trademark notices. INTREPID II is used within the office to manage the overall trademark process, including examination, opposition, assignments and renewals, and is able to make process decisions automatically. The system supports such specific office processes as preparing correspondence, updating information, preparing and transmitting notices electronically.

In July 1999, an electronic trademark application filing component was added to allow a client to file their trademark application electronically over the Internet. The e-services are continuously expanding: Trademark Renewals, the payment of the Registration Fee, and the renewal can be performed electronically over CIPO's online services.

On June 17, 2019, CIPO improved the trademarks online services to comply with the new modernized legislative framework. Furthermore, the Canadian Trademarks Databases has also been revamped with a partial new look and feel as well as new search features and new data elements, all driven from a series of engagement sessions with key Canadian stakeholders.

For all client front-ends, the information is checked for completeness, where the transaction is transferred automatically into the INTREPID II system following by an electronic acknowledgement (in PDF) via email to the client. CIPO continued to improve their electronic interactions by releasing two systems automations pertaining to the formalities of the trademark application as well as the renewal of the registered trademark. Both transactions no longer require user interventions, while the office response is issued automatically via email.

On June 17, 2019, CIPO launched their new Madrid Console, which assists CIPO to receive, examine and process international trademarks for which Canada has been designated. The console works as a workflow engine where the user can either notify a task by validating the data in INTREPID II system or perform a task with respect to a Protocol Application/Registration of a Madrid designation. The console is also designed to process the monthly financial transaction from WIPO. For Canadians wishing to register their trademarks in any of the contracting parties of the Madrid Protocol by filing an application for international registration (AIR), CIPO adopted WIPO'S Madrid e-Filing (Mef) to submit an AIR through a basic application or registration.

CIPO launched on April 1, 2019, its IP Document File Management (IPDFM) repository that serves as a common files repository fed by INTREPID II database. This solution will be eventually integrated with a new modernized IP case and workflow system. A side initiative carried on in 2019 to back capture all trademark paper files. In total, 1.6M files will be digitized over a period of three years.

Hardware used to supporting business processes of the Office

The INTREPID II system is a client/server system with the client component developed with Team Developer (Gupta SQL Windows 2005 v 4.0.0), and the UNIX (AIX) server using ORACLE 12 database. Windows file servers are used for electronic mail and for sharing common files during development. A NFS disk area on the main server is used to hold the design images. This allows client workstations to access the designs within the client interface, while storing all design images under the control of the main server.

SERVER

- BM AIX servers
- Operating System AIX
- 935 GB HardDisk, 8GB RAM
- Oracle RDMS V 12
- Oracle SQL*Net V 9
- Microfocus server express 5.0
- TCP/IP
- Image Converter: Alchemy 1.13
- Electronic Forms Generator: JF Central 5.4.1

CLIENT WORKSTATION

- Over 235 workstations are connected to the server
- Intel based (min 3.2 GHz, 1GB RAM, 80GB disk)
- SVGA monitors 19", 21" or 22" LCD mostly dual monitors
- MS-Windows 10 Professional Version 1809, MS Word 2016,
- Team Developer (Gupta SQL Windows 2005 v 4.0.0), TCP/IP SQL*Net 9.0 Samba NFS (Network File System)
- Some workstations with Bar-code readers and/or scanners

PRINTERS

- Xerox network printers
- NETWORK
- TCP/IP
- 1 gb between server and switches
- 100 mb between switches and workstation

Internal databases: coverage, updates, interlinks with external sources

CIPO's Trademarks Branch maintains a complete history of its trademark files in paper form, and information pertaining to all active marks from 1864 and inactive marks from 1979 to date in electronic form.

An initiative is underway to digitize all the trademark paper files over a period of three years. The scanned documents are transferred in a document management solution named IPDFM.

CIPO uses a Web-based search system from On Scope for trademark searches. As well, CIPO provides its trademark data to other commercial databases for external client use, through Cloud Services, in XML ST.96 format.

CIPO offers a search tool to query the database, namely Canadian Trademarks Database which is updated on a weekly basis. The format fed to the database is also XML ST.96.

Establishment and maintenance of electronic search file: file building, updating, storage, documents from other offices included in the search file

All bibliographic data contained in trademark applications and registrations are maintained on the INTREPID II system. Since the treaty's accession, the Madrid Console serves as a workflow system to manage WIPO's transactions on a weekly on a monthly basis. The console is interconnected to INTREPID II system.

The Canadian Trademarks database is available to the public on the Internet via the CIPO website. This version of the database is comprised of all active and many inactive marks that were either applied for or registered pursuant to the current Trademarks Act or former trademark legislation. The database also includes all trademarks that were cancelled, expunged, abandoned or refused after 1979, and some marks that were cancelled, expunged, abandoned or refused prior to 1979. Since the coming into force of June 17, 2019, the CTD also contains the International Registration.

Canada no longer maintains a manual search file. All trademark information is maintained within the INTREPID II database system and contains over a million marks (1,7029,184). This information is provided to various external search services.

Improved Bilingual Search Capability

We have added a feature to help clients to conduct searches in both English and French. This will help to ensure that their search query includes more terms, thereby resulting in an increased results list. This improvement is of interest to those who know their search criteria in one of Canada's official languages but not in the other.

Administrative management electronic systems (register, legal status, statistics, and administrative support)

The INTREPID II system is integrated with an improved version of the previous Trademarks Executive Information System (EIS). The EIS system permits detailed and comprehensive tracking and monitoring of trademark processes. The EIS system provides daily information on production volumes and turnaround times for trademark processes. The EIS system is available via the Intranet to allow broader access to reports within the Office.

The trademark search collection is managed in electronic form. The clients have access to the latest versions of the electronic records. A structured backup regime is in place to ensure preservation of the information.

Other matters

V. PROMOTION ACTIVITIES AIMED TO SUPPORT USERS IN ACCESS AND EFFICIENT USE OF TRADEMARK INFORMATION

Office's library (if deals with trademark information): equipment, collection management, network of libraries in the country, cooperation with foreign libraries

Public access to the trademark electronic processing system (INTREPID II) is available in the Client Service Centre.

The Canadian trademark database is available to the public on the Internet via the CIPO web site.

The official index that is required to be kept under the supervision of the Registrar of Trademarks pursuant to subsection 28(1) of the Trademarks Act, is accessible in the Canadian Trademarks Database on the CIPO Internet site.

The following trademark reference material is also available to the public via the CIPO web site:

- Trademarks Act and Regulations
- Examination Manual/ Madrid Examination Manual
- System Release Notes
- Goods/Services Manual
- Practice Notices
- Trademarks Guide
- Sample Forms
- Other reference materials
- All Trademarks Journal (in PDF format) as of January 2000 E-Services
- Service Interruption Messages

Publications related to different business procedures and trademark information sources available to users, for example, books, brochures, Internet publications, etc.

http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/en/h_wr00002e.html

Cooperation with universities, technology and innovation support centers, etc.

Education and training: training courses, e-learning modules (URLs), seminars, exhibitions, etc.

Other activities

VI. INTERNATIONAL COOPERATION ACTIVITIES IN THE FIELD OF TRADEMARK INFORMATION

International exchange of trademark information in machine-readable form (e.g., Official Gazettes)

The official Trademarks Journal is available online in PDF (Portable Document Format)

<http://www.ic.gc.ca/opic-cipo/tmj/eng/home.html>

CIPO is presently providing trademark data in XML ST.96 format, to a number of external database search providers and IPOs including weekly updates of Trademark data and design images.

Participation in international or regional activities and projects related to trademark information

CIPO attends the WIPO Madrid Working Group on a yearly basis where all of the members of the Madrid System discuss various items.

CIPO leads the Madrid eFiling International Working Group which is comprised of members from all of the IPOs that are currently using the WIPO developed Madrid eFiling system. The working group discusses areas for improvement and proposals for change to present to WIPO.

Assistance to developing countries

Other activities

VII. OTHER RELATED MATTERS