TRADEMARK AGENT EXAMINATION

INSTRUCTIONS TO CANDIDATES

1. The only aids permitted are the copies of the *Trade-marks Act* and *Trade-marks Regulations* provided by CIPO and an unmarked dictionary (English or French or French/English).

2. Cell phones, smart phones, and any device that allows for wireless communication or the retrieval of information from memory may not be used during the examination.

3. You must place your assigned number on each examination paper, answer book and envelope. No other form of identification is permitted on any material submitted.

4. There are two parts to this exam – Part A and Part B, and you are allowed three hours for each part. There are 150 marks available for each part so allocate your time accordingly.

5. At the conclusion of each examination session, insert the examination paper together with the answer book(s) into the envelope and seal the envelope.

6. Marks will be provided for an answer (or a part of an answer) that:
   - clearly identifies the question being answered, BY NUMBER;
   - is written LEGIBLY, IN INK, double-spaced within the indicated margins in THE ANSWER BOOK;
   - is provided on the right-hand pages of the answer book ONLY; and
   - provides the most precise reference possible when asked to cite the relevant provision(s) of the *Trade-marks Act* or *Trade-marks Regulations* (i.e. section, sub-section and/or paragraph).

7. Marks will NOT be given for
   - anything written on a left-hand page of the answer book or on the examination itself; and
   - anything that cannot be deciphered with a reasonable degree of certainty.

8. Salutations, signatures and other formalities of correspondence are not required in your answers; substance is important. Read each question carefully and ensure that your answer responds to the question posed. Answers given in point form are acceptable except where the question specifically asks you to draft or write your answer.

9. Where a question asks you to cite the relevant provision(s) of the *Trade-marks Act* or *Trade-marks Regulations*, you must provide the most precise reference possible (i.e. section, sub-section and/or paragraph).

10. Where a question asks you to list a specific number of answers, for example, “list two options”, only the number of answers specified in the question will be marked.
QUESTION 1 (2 marks)

Your client has asked you to file an application for the trademark TIKI LOUNGE LOGOS and has provided you with a date of first use in Canada as 2015. Can you file the application with this date of first use? Yes or no. (1 mark) Give one reason in support of your answer. (1 mark)

QUESTION 2 (2 marks)

Upon filing your client’s trademark application for CONNECT & CONQUOR covering “social networking services”, you notice that there is a typographical error in the trademark. The trademark as filed reads CONECNT & CONQUOR. The application has not yet been examined. You write to the Office on behalf of your client to correct the error. Will the Office correct the error at this stage? Yes or no. (1 mark) Give one reason in support of your answer. (1 mark)

QUESTION 3 (2 marks)

If an applicant fails to claim a priority filing date within the 6 month period for doing so, the applicant can request a retroactive extension of time to do so. Yes or No. (1 mark) Cite the relevant provision(s) of the Trade-mark Act or Regulations. (1 mark)

QUESTION 4 (2 marks)

Once a foreign application issues to registration, can the underlying foreign application be used to claim a priority filing date in Canada. Yes or no. (1 mark) Give one reason in support of your answer. (1 mark)

QUESTION 5 (4 marks)

On the same day, two different applicants filed proposed use applications for the exact same mark covering the exact same goods and services. Assuming no other possible objections, what action will the Office take? (1 mark) In point form, give support for your answer. (1 mark) Cite the relevant provision(s) of the Trade-marks Act or Regulations. (1 mark) Provide the leading case that determines this. (1 mark)

QUESTION 6 (Total of 4 marks)

(a) What paragraph of the Trade-marks Act stipulates that an application must contain a statement of goods or services in specific and ordinary commercial terms in association with which the mark has been or is proposed to be used? (1 mark)

(b) In point form list three principles applied by the Office for determining whether the goods or services are in ordinary commercial terms. (3 marks)
QUESTION 7 (Total of 2 marks)

(a) While specimens are not required to file a trademark application, an examiner may request a specimen to aid in understanding the nature of the applicant’s goods or services. What provision(s) of the Trade-marks Act or Regulations justifies this request? (1 mark)

(b) Your client has applied for the trademark BONES R OS. The colour red has been claimed as a feature of the mark. If the examiner requests specimens, do the specimens need to show the mark in the colour red? (1 mark)

QUESTION 8 (3 marks)

Your client has claimed the colour yellow as a feature of their trademark YELLOW BIRD. The application states that the letters are yellow. Will an examiner require the applicant to submit a drawing lined for colour? Yes or no. (1 mark) Give one reason in support of your answer. (1 mark) Cite the relevant provision(s) of the Trade-mark Act or Regulations. (1 mark)

QUESTION 9 (2 marks)

True or False? An applicant must claim colour in a Canadian trademark application relying on a foreign registration where colour is claimed. (1 mark) Give one reason in support of your answer. (1 mark)

QUESTION 10 (Total of 16 marks)

You receive instructions from an Australian associate to file an application for registration of the trademark PURPLE PEONY in the name of Eggplant Flowers Clothing Inc. for clothing and retail store services. The associate also advises that the mark is in use in Canada and Australia and that the applicant is the owner of an Australian registration, registered July 15, 2010, for the exact mark and same goods and services.

(a) List two filing bases for Canadian the trademark application. (2 marks)

(b) List three further pieces of information required at a minimum in order to obtain a filing date for the Canadian application. (3 marks)

(c) The application for PURPLE PEONY has now been filed and your associate asks you to provide a preliminary report on what objections and/or requirements would likely be raised in an Office Action from the Trade-marks Office. In point form, list four objections/requirements which could be raised in an Office Action and cite any relevant provision(s) of the Trade-marks Act or Trade-marks Regulations. (4 marks)

(d) The Office Action has issued and along with the issues identified above, the Examiner has also raised an objection based on the official mark PURPLE PEONY FLOWERS owned by the City of Peony, Ontario. In point form, advise your client of two options for overcoming this citation. Support your answer by citing any relevant provision(s) of the Trade-marks Act or Trade-marks Regulations. (3 marks)
(e) The Office Action also raised a confusion objection based on a registration for the trademark FUSCHIA POPPY for various articles of clothing (registered March 3, 2010). Your client advises that it conducted an investigation and that it was unable to locate any use of the trademark. In point form, advise your client of the four best options for overcoming the confusion citation. Only your first four options will be marked. (4 marks)

QUESTION 11 (2 marks)

On behalf of an American client you filed an application in Canada based on use and your client’s registration in the United States. You received a certified copy of the American registration which shows that the American registration was assigned to a new owner after the filing of the Canadian application. Can the Canadian application continue to rely on the American registration? Yes or no. (1 mark) Give one reason in support of your answer. (1 mark)

QUESTION 12 (2 marks)

True or False? An applicant in Canada relying on an application for use and registration abroad can state that foreign use has been in more than one country. (1 mark) Give one reason in support of your answer. (1 mark)

QUESTION 13 (3 marks)

Your new client Buddy Newman, Inc. informs you that they recently filed a trademark application for BORGEN covering “sweaters” and the “retail sale of sweaters”. They also inform you that they did not conduct a preliminary search of the Trademarks Office records to determine if there are any prior applications or registrations for confusingly similar marks. You conduct a quick search of the Trademarks Office database and locate a registration for the trademark BORGEN SWEATERS covering “sweaters” owned by Buddy Newman, Inc. doing business as MNO Ventures. Do you foresee any issues with this mark? Yes or no. (1 mark) Give one reason in support of your answer. (1 mark) Cite relevant provision(s) of the Trade-marks Act or Regulations (1 mark).

QUESTION 14 (2 marks)

You note that a trademark has been associated with another trademark in error. Do you have a basis on which to request the Examiner to correct this error? Yes or No. (1 mark) Cite the relevant provision(s) of the Trade-mark Act or Regulations. (1 mark)

QUESTION 15 (2 marks)

Your client is the owner of NFLD9999 for the trademark JUST LAUGH covering “candy”. Your client has now applied for the trademark JUST LAUGH covering “chocolate-coated candy”. Will these marks be associated? (1 mark) In point form, indicate why or why not. (1 mark)
**QUESTION 16 (Total of 20 marks)**

Your client wishes to adopt the trademark BOSS in Canada in association with the services “operation of a repair shop offering repairs for small engines, specifically, lawnmowers, riding mowers, snowmobiles, outboard motors and generators”. Your client has asked you to do a search of the Trademarks Register prior to filing for the mark BOSS for the services of interest.

The search located the following marks:

<table>
<thead>
<tr>
<th>TRADE-MARK</th>
<th>REG. / APPL’N NO.</th>
<th>GOODS / SERVICES</th>
<th>OWNER</th>
</tr>
</thead>
<tbody>
<tr>
<td>(a) BOSS</td>
<td>1,638,933</td>
<td>Operation of a business renting, leasing and repairing riding mowers, lawnmowers, hedge trimmers, stump pullers and tractors.</td>
<td>Lawn Boss Forestry Services, Inc. (Toronto, Ontario)</td>
</tr>
<tr>
<td>(b) POWERDRIFT Boss</td>
<td>1,588,000</td>
<td>Motor vehicle parts namely, carburetors, stick-shift handles and mud-flaps.</td>
<td>Bosston Street Racing Limited (Boston, Massachusetts)</td>
</tr>
<tr>
<td>(c) BOSS</td>
<td>987,340</td>
<td>Operation of truck weighing stations.</td>
<td>City of Calgary, Department of Vehicle Licensing and Enforcement</td>
</tr>
<tr>
<td>(d) Big Boss</td>
<td>TMA448,490</td>
<td>Marine racing motors.</td>
<td>Boss Marine of the Antilles (Dutch Antilles B.V.)</td>
</tr>
<tr>
<td>Production</td>
<td>Expunged: Jan 1, 2015</td>
<td>Marine racing motors.</td>
<td>Boss Marine of the Antilles (Dutch Antilles B.V.)</td>
</tr>
<tr>
<td>Motors</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>(e) LE BOSS</td>
<td>TMA894,554</td>
<td>Boat engines and repair and maintenance of boat motors.</td>
<td>Longueuil Marine Ltée (Longueuil, Quebec)</td>
</tr>
<tr>
<td>(f) BOSS MARINA</td>
<td>1,760,439</td>
<td>Marine supplies, namely, oars, boat tarps, rope, life jackets, sails, steering wheels, boat fuel and decals; Operation of a marina fuel dock for boats.</td>
<td>Susan Boss-Haug Marina, Limited (Winnipeg, Manitoba)</td>
</tr>
<tr>
<td>(g) BOSS LANDSCAPING</td>
<td>1,894,588</td>
<td>Garden irrigation systems.</td>
<td>Boss Brothers, Inc. (Green Bay, Wisconsin)</td>
</tr>
</tbody>
</table>
Provide a brief search opinion by indicating whether each of the trademarks listed above is likely to be an obstacle to the registration of your client’s with a “yes or no” for each trademark (0.5 marks each) and in point form, support each opinion with short explanation(s) (2 marks each). No marks will be given for the “yes or no” answer unless at least one correct supporting explanation is given for each trademark.

**QUESTION 17 (Total of 5 marks)**

Your client is the owner of the trademark WIDGET-WISE which registered January 15, 2010 in the name of Widgetty-Wise, Inc. Your client advises that Widgetty-Wise, Inc. merged with Wise Widgets Company on July 16, 2013 and continued in business as Wise Widgets Company. The trademark WIDGET-WISE was then assigned by Wise Widgets Company on March 3, 2015 to Bigger Widgets Limited.

(a) Advise what documentation, if any, is needed to record the merger. **(1 mark)** Are there any applicable fees? **(1 mark)**

(b) Advise what documentation, if any, is needed to record the assignment. **(1 mark)** Are there any applicable fees? **(1 mark)** Cite any relevant provision(s) of the *Trade-marks Act* or *Trade-marks Regulations* **(1 mark)**

**QUESTION 18 (1 mark)**

True or False? Advertising of the mark on a publically accessible website which has been declared under Section 9 may support a claim to the enforceability of rights under Section 9 of the *Trade-marks Act*. **(1 mark)**

**QUESTION 19 (1 mark)**

True or False? Non-Canadian entities can own and request publication of a mark under Section 9 of the *Trade-marks Act*. **(1 mark)**

**QUESTION 20 (1 mark)**

True or False? “Public authority” is defined under Section 9 of the *Trade-marks Act*. **(1 mark)**
QUESTION 21 (1 mark)

True or False? A public authority can own both certification marks and marks declared under Section 9 of the *Trade-marks Act.* *(1 mark)*

QUESTION 22 (1 mark)

True or False? Only public authorities can request public notice of use and adoption of a mark claimed under Section 9(n) of the *Trade-marks Act.* *(1 mark)*

QUESTION 23 (1 mark)

True or False? Registration as a charity before Revenue Canada is accepted as proof of status as a public authority under Section 9 of the *Trade-marks Act.* *(1 mark)*

QUESTION 24 (1 mark)

True or False? Only Canadian universities can register marks under Section 9(1)(n)(ii) of the *Trade-marks Act.* *(1 mark)*

QUESTION 25 (1 mark)

True or False? The public notice of an official mark may be declared ineffective to give rise to any rights or prohibitions under Section 9 of the *Trade-marks Act* if the applicant is not found to have been a public authority at the time the mark was applied for. *(1 mark)*

QUESTION 26 (1 mark)

True or False? The Office is not required to keep a list of geographical indications.

QUESTION 27 (1 mark)

True or False? Examiners must provide information pertaining to protected geographical indications if an objection is raised.

QUESTION 28 (1 mark)

What provision of the *Trade-marks Act* allows for registration of a trademark that is objectionable pursuant to Section 12(1)(a) or (b) provided that the applicant can file evidence to show the trademark is “not without distinctive character.” *(1 mark)*

QUESTION 29 (1 mark)

If an applicant claims that their mark is “not without distinctive character” what provision of the *Trade-marks Act* or *Regulations* specifies that the applicant must file evidence in support? *(1 mark)*
QUESTION 30 (2 marks)

Your client has claimed that their mark HOME NOW in a stylized font is “not without distinctive character”. Upon review of the client’s foreign trademark registration, you note that the certified copy shows that the registered trademark is HOME NOW in block letter form. Can the applicant continue to claim this benefit? Yes or no. (1 mark) Give one reason in support of your answer. (1 mark)

QUESTION 31 (2 marks)

Your client filed a trademark application for the mark MAINTAIN CITY covering “jeans”. Two days later, your client advises you that they would like to amend the statement of goods to cover “casual clothing.” Can this amendment be made? Yes or No. (1 mark) Cite the relevant provision(s) of the Trade-mark Act or Regulations. (1 mark)

QUESTION 32 (1 mark)

Your client, BYZ Co. has asked that you file a trademark application on their behalf for the trademark GF covering “jewellery”, based on use in Canada since 1999. You had looked at the Goods and Services Manual and you know that “jewellery” is an acceptable statement of goods. However, six months later, you receive an examiner’s report asking if the applicant’s goods are made with gold. On what basis is the Examiner’s request being made?

QUESTION 33 (2 marks)

Why do examiners take special care when reviewing confusing trademarks which cover pharmaceuticals? (1 mark) What is the leading case the dictates this principle? (1 mark)

QUESTION 34 (Total of 15 marks)

As a registered trade-mark agent, your client Bewitched Soups Inc. has approached you inquiring how to protect its intellectual property rights in Canada. The company sells BEWITCHINGLY GOOD soup mixes in Canada in a small soup cauldron shaped container. The words BEWITCHINGLY GOOD appears on the front side of the container and on the back side appears a separate highly stylized soup cauldron design. The soup cauldron shaped container is purple. The recipe for the spice mix component of the soup mixes is considered a company secret. The stylized soup cauldron design was developed by a graphic artist who did not work for your client but rather was employed by an advertising agency.

(a) Advise your client of three regular trademark applications it could file for. (3 marks)

(b) Advise your client as to the other types of protection that may be available under the current provisions of the Trade-marks Act. (1 mark – you must indicate what is being protected and
**what specific type of IP**. Advise your client whether there are any materials or documents that must be filed in support of such application and, if so, what it must show. (2 marks)

(c) Advise your client if any other type of protection may be available under any other Federal statutory provisions in Canada (other than the *Trade-marks Act*) to protect its IP rights. You must indicate, in point form, (1) the type of protection and what IP right is protectable (3 marks) and (2) any special considerations or limitations for each type of IP protection (only 1 reason will be accepted for each type of IP protection). (3 marks)

(d) Your client has advised you that it wants to take advantage of pursuing protection under some of these other Federal statutory provisions. As a registered trade-mark agent, can you act on behalf of your client to file for and obtain protection under these other Federal statutory provisions? (1 mark) Give one reason to support your answer. (2 marks)

**QUESTION 35 (3 marks)**

Your clients are Mr. and Mrs. Jones, who operate under a partnership, doing business as *Monkey See Monkey Do*. Your client currently has a family of eight (8) associated trademark registrations containing the words *MONKEY DO*. Four of these marks cover “children’s clothing” and the other four marks cover “chocolate banana muffins”.

Unfortunately, Mr. and Mrs. Jones are going through a divorce. They have decided to dissolve the partnership and are comfortable having you act on both their behalf. They advise you that they have reached an agreement stating that Mr. Jones will assume ownership of the trademarks for “chocolate banana muffins” and Mrs. Jones will assume ownership of the trademarks for “children’s clothing”.

a) What three things need to be done to change the ownership from the partnership to Mr. and Mrs. Jones individually? (3 marks)

**QUESTION 36 (Total of 15 marks)**

Please indicate yes or no whether the following trade-marks would be registrable. You must indicate (1) “yes” or “no” in your answer and support your answer by indicating (2) the most relevant sections of the *Trade-marks Act* and/or *Trade-marks Regulations* and (3) the most significant reason to support your answer. Ignore any confusion issues and do not assume any acquired distinctiveness. (3 marks each)

(a) CHARLIE CHAPLIN for use in association with hats
(b) SUPER GROW for lawn fertilizer
(c) PALLONCINO for paper party streamers, paper party hats, party balloons (PALLONCINO is Italian for “balloons”)
(d) BILL’S GOVERNMENT APPROVED for car emission testing services
(e) WILLIAMS BROTHERS for upholstery services
QUESTION 37 (7 marks)

Your client has already received one (1) extension of time to respond to an Office Action. According to the Practice Notice dated March 11, 2010, entitled “Extensions of Time in Examination”, indicate whether the following circumstances would result in a second extension of time being “granted” or “refused” to respond to the Office Action. (1 mark each)

a) Your client has an intention to amend the application to add a claim pursuant to subsection 16(2) of the Trade-marks Act.

b) You have previously requested two (2) additional extensions of time to the one mentioned above, but you recently fell ill with shingles, which has resulted in file backlog at your office.

c) Your client is awaiting the foreign certified copy to issue, since the foreign application has just recently proceeded to registration.

d) Your client is asking you to request a third extension of time to obtain the certified copy of their foreign registration. The foreign use/registration is the sole filing basis for the application.

e) Your client has filed an assignment for the registration which was cited against your client’s application and you are awaiting recordal.

f) You are trying to obtain evidence from your client in order to claim the benefit of Section 12(2) of the Act to potentially overcome a 12(1)(b) objection.

g) The trademark that was cited against your client’s trademark is the subject of a Section 45 proceeding initiated by your client.

QUESTION 38 (5 marks)

On behalf of a client in Japan you filed a Canadian application for DUSTBOX based on use of the mark in Canada and use of the mark in Japan and Japanese application No. 4568 for “mops, brooms and dust cloths”. The Canadian DUSTBOX application received an office action calling for the filing of a certified copy of the registration to issue from the Japanese application. The due date to respond is today and your client has contacted you on an urgent basis, telling you that the Japanese application has been opposed in Japan.

In point form, list two options that are available to your client and any related requirements. Cite any relevant provision(s) of the Trade-marks Act or Trade-marks Regulations and whether any government fees are required (5 marks) Only the first two options will be marked

QUESTION 39 (2 marks)

What are the two factors that the Office considers to abandon an allowed application based on proposed use? (2 marks)
QUESTION 40 (3 marks)

On what three grounds will the Office refuse an application for the registration of a trademark?

QUESTION 41 (Total of 8 marks)

Match the case name with the applicable legal principle.

<table>
<thead>
<tr>
<th>Case Name</th>
<th>Principle</th>
</tr>
</thead>
<tbody>
<tr>
<td>A. Champagne Moet &amp; Chandon v. Ridout Wines Ltd./Les Vins Ridout Ltee (1983), 77 C.P.R. (2d) 63</td>
<td>1. For there to be use of a trademark in Canada, there must be advertising of the mark in Canada and the services must be performed in Canada, or be available to be performed in Canada.</td>
</tr>
<tr>
<td>B. Benson &amp; Hedges (Canada) Ltd. v. Empresa Cubana Del Tabaco (1975), 23 C.P.R. (2d) 274 (T.M.O.B.)</td>
<td>2. Display of a trademark for services, on a website not originating in Canada, may be use and advertising of the trademark in association with services offered in Canada.</td>
</tr>
<tr>
<td>C. TCC Holdings Inc. v. Families as Support Teams Society, 2014 FC 830</td>
<td>3. If a foreign trademark owner whose mark is not use in Canada can establish goodwill and reputation in its trademark in Canada, it may be able to prevent the adoption of a confusingly similar mark, in Canada even if the foreign mark has not been used in Canada.</td>
</tr>
<tr>
<td>D. FileNET Corporation v. Canada (Registrar of Trade-marks) (2002), 22 C.P.R. (4th) 328 (F.C.A.)</td>
<td>4. A mark which is applied to wares for the purpose of ornament or decoration only is not registrable as a trad-mark.</td>
</tr>
<tr>
<td>E. Orkin Exterminating Co. v. Pestco of Canada (1985) 5 CPR (3d) 433 (Ont. CA)</td>
<td>5. Section 10 prevents a single trader from having a monopoly over a mark that is common to the trade and well understood as designating a particular quality of wares or services.</td>
</tr>
<tr>
<td>F. HomeAway.com, Inc. v. Hrdlicka 2012 FC 1467</td>
<td>6. A party claiming status as a public authority for purposes of holding a mark under Section 9(1)(n)(iii) must be under significant government control at all times.</td>
</tr>
<tr>
<td>G. W.J. Hughes &amp; Sons “Corn Flower” Ltd. v. Morawiec, (1970), 62 C.P.R. 21, [1970] Ex. C.J. No. 11 (QL) (Ex. Ct.) (Corn Flower).</td>
<td>7. Sections 3 and 4 of the Trade-marks Act are not applicable to official marks, however, these sections may nonetheless assist in the interpretation of the meaning of &quot;adoption&quot; and &quot;use&quot; of official marks.</td>
</tr>
<tr>
<td><strong>H. Porter v. Don the Beachcomber</strong> (1966), 48 C.P.R. 280</td>
<td></td>
</tr>
<tr>
<td>----------------------------------------------------------</td>
<td></td>
</tr>
<tr>
<td>8. An application based originally on proposed use may not be amended to claim a date of first use in Canada as such an amendment would be contrary to Rule 31(d).</td>
<td></td>
</tr>
</tbody>
</table>