

# ROBERT DOUGLAS PECK

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BARRISTER AND SOLICITOR

February 26, 2010

*Via email*

Ms. Stephanie Golden  
Canadian Intellectual Property Office  
Trade-marks Branch  
50 Victoria Street,  
Place du Portage II  
Gatineau, QC K1A 0C9

Attention: Ms. Stephanie Golden

Dear Ms. Golden

**Re: Proposed Practice Notice: Professional Designations and their initials**

The proposed practice notice was drawn to my attention in my capacity as the general counsel to the Institute of Chartered Accountants of Ontario. More particularly, I was asked what impact the practice notice would have on (i) a request by the regulatory authority of a profession, which is a “public authority” within the meaning of the *Trade-marks Act*, for the publication of the adoption and use of a mark as an official mark for wares and services, pursuant to section 9(1)(n)(iii) of the *Trade-marks Act* and (ii) an application by the regulatory authority of a profession for a certification mark.

I assume that the proposed practice notice will have no impact on a request for public notice under section 9 (1)(n)(iii) of the *Trade-marks Act*. I make this assumption because: there is no reference in the proposed practice notice to requests for public notice under section 9(1)(n)(iii); the mark used by a regulatory authority of a profession (public authority) as an official mark for wares and services will often be or include the professional designation itself or an acronym therefor; and the provisions of section 12(1)(b) do not apply to a request for public notice under section 9(1)(n).

I assume that the proposed practice notice would apply to applications for certification marks.

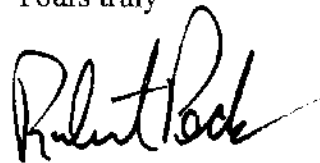
Would you please confirm my assumptions, if they are correct, and correct them if they are wrong.

With respect to the application of the proposed practice notice to certification marks, I recommend that the following issues be clarified:

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- The proposed practice notice refers to a mark that **“appears to be”** or **“does consist of”** a professional designation [emphasis added]. It is not clear how examiners are to treat a certification mark or other trade-mark that includes a professional designation, along with other words or design elements. I recommend that the practice notice clarify that such a trade-mark is to be considered in its totality and that composite trade-marks are to be examined in accordance with the Practice Notice entitled *“Paragraph 12(1)(b): “Sounded” Test Applied to Composite Marks Which Include Words That Are the Dominant Feature of the Mark”*, published February 16, 2005.
- The proposed practice notice refers to the fact that **“the mere addition of** an abbreviation, acronym or initial of the professional designation contained in the trade-mark will not render the trade-mark registrable” [emphasis added]. It is not clear how examiners are to treat a mark that consists of or includes an abbreviation, acronym or initial of a professional designation but does not include the full professional designation itself. I recommend that the practice notice clarify that such a trade-mark is to be examined in accordance with the proposed Practice Notice entitled *“Descriptiveness and abbreviations, acronyms or initials”*.

Yours truly



Robert D. Peck

RDP:kf