

Schedule A

SAMPLE FORM FOR STATEMENT OF OPPOSITION

In the event that the online system is down, the following may be used to prepare a statement of opposition for filing against a Protocol Application. Completed forms may be sent by email to the following address: **ic.tmobmadrid-comcmadrid.ic@canada.ca**.

This form must be completed in English or French (with the exception of the information concerning the relied upon trademark applications, registrations and prohibited marks).

Using this suggested form will allow the Registrar to efficiently and accurately prepare the Notification of Total Provisional Refusal Based on Opposition to be Filed with the International Bureau.

Provide the following information concerning the **Opposed trademark application**.

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| Trademark application No. | |
| International registration No. | |
| Trademark | |
| Applicant | |
| Statement of goods and services | |
| Advertisement date | |
| Please attach CIPO Fee Payment Form (or otherwise complete fee information here) | |

Provide the following information concerning the **Opponent**.

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| Full name of the opponent | |
| Address of the opponent (if not based in Canada, also the address for service in Canada or the address of the opponent's agent based in Canada) | |
| Full name of the opponent's agent (if any) | |
| Address of the opponent's agent (if any) | |
| Email address of the opponent's agent (if any) | |
| Email address of the opponent (if no appointed representative or agent) | |

Grounds of opposition

Please check and complete only the relevant boxes that apply. Unless stated otherwise, all section references are references to the Trademarks Act.

Section 38(2)(a) – The application does not conform to the requirements of subsection 30(2):

Section 30(2)(a) – The application does not contain a statement in ordinary commercial terms of the goods and services associated with the trademark applied for.

Goods and services not specified in ordinary commercial terms

Section 30(2)(b) – The application does not contain particulars of the defined standard that the use of the certification mark is intended to indicate **and/or** a statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used or proposed to be used.

Any additional information

Section 30(2)(c) – The application does not contain a representation or description, or both, that permits the trademark to be clearly defined and that complies with any prescribed requirements under section 30 of the *Trademarks Regulations*.

Identify subsection(s) of section 30 of the *Trademarks Regulations* not complied with.

Any additional information (please explain why the application is being opposed on this ground).

Section 30(2)(d) – The application does not contain the information or statement prescribed by section 31 of the *Trademarks Regulations*.

Identify subsection(s) of section 31 of the *Trademarks Regulations* not complied with.

Any additional information (please explain why the application is being opposed on this ground).

Section 38(2)(a.1) - The application was filed in bad faith.

Any additional information

Section 38(2)(b) - The trademark is not registrable:

Section 12(1)(a) – The trademark is not registrable because it is a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years.

Any additional information

Section 12(1)(b) – The trademark is not registrable because whether depicted, written or sounded it is either clearly descriptive or deceptively misdescriptive of:

the character or quality of the goods and services with which the trademark is either **used**, or **proposed to be used**

the conditions of or the persons employed in the production of the goods and services or of their place of origin

Good(s) and service(s)

Language in which the trademark is either clearly descriptive or deceptively misdescriptive

French

English

Any additional information

Section 12(1)(c) – The trademark is not registrable because it is the name of any one of the goods or services with which the trademark is used or proposed to be used.

Language in which the trademark is the name of the goods or services
(not required if English or French)

Good(s) and service(s)

Any additional Information

Section 12(1)(d) – The trademark is not registrable because it is confusing with a registered trademark.

Trademark application and registration numbers for relied upon trademarks

Any additional information

Section 12(1)(e) – The trademark is not registrable because it is a sign or combination of signs whose adoption is prohibited by sections 9 or 10.

Section 9 – The adoption of the trademark is prohibited by section 9.

Prohibited mark serial number(s) (if applicable)

Any additional information (please identify the subsection(s) of section 9 on which this ground of opposition is based and explain why the adoption of the trademark is prohibited by the subsection(s)).

Section 10 – The adoption of the trademark is prohibited by section 10:

The trademark has become recognized as designating the following with respect to the goods and services with which it is associated:

- | | |
|--------------------------------------|---|
| <input type="checkbox"/> kind | <input type="checkbox"/> value |
| <input type="checkbox"/> quality | <input type="checkbox"/> place of origin |
| <input type="checkbox"/> quantity | <input type="checkbox"/> date of production |
| <input type="checkbox"/> destination | |

Any additional information

Section 12(1)(f) – The trademark is not registrable because it is a denomination whose adoption is prohibited by section 10.1.

Denomination

Any additional information

Section 12(1)(g) – The trademark is not registrable because it is, in whole or in part, a protected geographical indication identifying a wine, where the trademark is to be registered in association with a wine not originating from a territory indicated by the geographical indication.

Protected geographical indication and number

Any additional information

Section 12(1)(h) – The trademark is not registrable because it is, in whole or in part, a protected geographical indication identifying a spirit, where the trademark is to be registered in association with a spirit not originating from a territory indicated by the geographical indication.

Protected geographical indication and number

Any additional information

Section 12(1)(h.1) – The trademark is not registrable because it is, in whole or in part, a protected geographical indication, and the trademark is to be registered in association with an agricultural product or food – belonging to the same category, as set out in the schedule, as the agricultural product or food identified by the protected geographical indication – not originating in a territory indicated by the geographical indication.

Protected geographical indication and number

Any additional information

Section 12(1)(i) – The trademark is not registrable because it is a mark whose adoption is prohibited by subsection 3(1) of the *Olympic and Paralympic Marks Act*, subject to subsection 3(3) and paragraph 3(4)(a) of that Act.

Any additional information (please provide the details of the Olympic or Paralympic mark(s) that the mark so nearly resembles as to be likely to be mistaken for it by

including the trademark and reference to the legislation).

Section 12(2) – The trademark is not registrable because, in relation to the goods or services in association with which it is used or proposed to be used, its features are dictated primarily by a utilitarian function.

Good(s) and service(s)

Any additional information

Section 104 of the *Trademarks Regulations* – The trademark is not registrable because the goods or services specified in the Protocol application are not within the scope of the international registration.

Good(s) and service(s)

Any additional information

Section 38(2)(c) – The applicant is not the person entitled to registration of the trademark:

Section 16(1)(a) – The applicant is not the person entitled to registration because the trademark applied for was confusing with a trademark previously used or made known in Canada by any other person.

Each trademark relied upon and associated goods and services
(Registration and application numbers of used or made known trademarks are acceptable. Trademarks which are relied upon and not the subject of an application or registration must be clearly identified along with the associated goods/services.)

Section 16(1)(b) – The applicant is not the person entitled to registration because the trademark applied for was confusing with a pending trademark application previously filed in Canada by any other person.

Application number

Section 16(1)(c) – The applicant is not the person entitled to registration because the trademark applied for was confusing with a tradename previously used in Canada by any other person.

Each tradename relied upon and associated goods and services

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Section 38(2)(d) – The trademark is not distinctive.

Any additional information (please explain why the trademark is not distinctive within the meaning of section 2 of the Act).

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Section 38(2)(e) – The applicant was not using or did not propose to use the trademark in Canada in association with the goods and services applied for, at the date the application was filed.

Any additional information (please explain why the applicant is not using or did not propose to use the trademark).

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Section 38(2)(f) – The applicant was not entitled to use the trademark in Canada in association with the goods and services applied for, at the date the application was filed.

Any additional information (please explain why the applicant is not entitled to use the trademark in Canada).

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Include **printouts** of each of the applications, registrations and prohibited marks relied upon in the statement of opposition **OR** complete the following **Information relating to each of the applications, registrations and prohibited marks relied upon in the statement of opposition.**

| | |
|-------------------------------|--|
| Registration No. | |
| Application No. | |
| Filing date | |
| Priority date (if any) | |
| Full name of the owner | |
| Address of the owner | |

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|---|--|
| Reproduction of the mark | |
| Statement of goods and services if any | |