

Kluwer Trademark Blog

A Way with Words: Strategies for Reducing the Likelihood of an Objection to Description of Goods and Services in Canadian Trademark Applications

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Paragraph 30(2)(a) of the *Trademarks Act* requires that an application for a trademark must describe the associated goods and services in “ordinary commercial terms.” Approximately 64% of all objections raised by CIPO trademark examiners relate to goods and services descriptions. This note explains how applicants can mitigate the risk and cost of encountering such an objection.

Using the Goods and Services Manual

The most effective and reliable strategy for drafting acceptable descriptions in Canada is to use the descriptions identified in *CIPO Goods and Services Manual* (the “*Manual*”), which is an online database of nearly 80,000 pre-approved descriptions. Applicants can search terms by keyword, view all the terms in the *Manual* by first letter, or view all the terms associated with a particular Nice Classification. Using these descriptions is virtually objection-proof. It is also constantly expanding, with about 10,000 new entries having been recently added.

The most effective way to use the *Manual* is to draft a description using only pre-approved terms. Applications containing such terms are also more likely to be expedited through the examination process, as explained in a CIPO [practice notice](#). In other words, using this method may allow applicants to reduce the delay between filing and first examination by about six months.

A drawback associated with using only such pre-approved terms is a lack of flexibility. The *Manual* is not exhaustive, especially in relation to rapidly emerging industries. Applicants trading in these industries may wish to forego the practical certainty associated with using only pre-approved terms in favor of an original or custom description. Applicants drafting such descriptions should employ the following additional strategies to reduce the risk of an objection.

Striving for Specificity

Under section 29 of the *Trademarks Regulations*, a statement of goods and services must describe each good or service in a manner that identifies a specific good or service. Applicants should use precise and specific wording to ensure that a custom description complies with this requirement. In the case of goods, applicants could consider including the type or subtype (e.g., “cases, namely smartphone cases”) or the relevant area of use. Another strategy is to locate pertinent “Retired” terms in the *Manual* and click on the circular “Additional Notes” button next to the term, which

sometimes provides additional guidance.

Words such as “including,” “featuring,” “related to,” and “etc.” should be used carefully, as these words will only be accepted if they follow sufficiently specific goods or services. For example, “clothing, including jackets” is unacceptable but “clothing namely jackets” is acceptable for the same reason. A similar rule governs the use of “parts and fittings,” which must follow sufficiently specific goods to be acceptable.

Applicants should avoid phrases such as “similar goods” and “related goods,” which CIPO considers to be indefinite. The terms “or” and “and/or” should also be avoided if they create excessive ambiguity (e.g., where the description for an application in Class 9 is “smartphones and/or digital tablets”). Clarifying ambiguities in a draft description may require lengthening or broadening the description.

The terms “apparatus and instruments” and “data” are also often not acceptable unless followed by greater specificity.

Perfecting Your Punctuation

Proper punctuation is crucial. Individual goods or services in a statement should be separated by semicolons (e.g., “smartphones; cases for smartphones; digital tablets”). Any terms appearing within two semicolons are considered to stand on their own and must be sufficiently specific without reference to other parts of the statement. Accordingly, semicolons should not separate terms such as “accessories therefor” or “parts and fittings therefor” from their grammatical subjects. Finally, avoid using a colon as a substitute for “namely” or “specifically,” as CIPO will not accept this (e.g., “lenses: eyeglass lenses”).

Generality is Good (For Industry Terms)

Avoid using registered trademarks in goods and services descriptions. This strategy may seem obvious, but many perceived generic or household words are in fact registered trademarks in Canada. Common examples of registered trademarks which could be mistaken for generic industry terms include ASPIRIN for painkillers, THERMOS for insulated bottles, and YOYO for a toy consisting of a cylindrical spindle with string. Ensuring that a statement of goods and services contains no registered trademarks may require a brief search of the [CIPO Trademarks Database](#).

Knowing the Context-Specific Rules

The [CIPO Trademarks Examination Manual](#) (the “*Examination Manual*”) sets out specific rules and guidelines for describing certain types of goods and services. Applicants seeking a registration covering one or more of the following goods and services should consult the relevant sections of the *Examination Manual* to better understand how to avoid an objection:

- Computer software and computer programs ([Section 2.4.5.10](#))
- Discs and other blank or pre-recorded media ([Section 2.4.5.11](#))
- Pharmaceutical, medical, or homeopathic preparations ([Section 2.4.5.12](#))
- Medical marijuana and cannabis oil ([Section 2.4.5.12](#))
- Intangibles such as electricity, websites, or domain names ([Section 2.4.5.13](#))
- Electronic data transmission services ([Section 2.4.5.15](#))
- Telecommunications services ([Section 2.4.5.16](#))

- Advertising, promotion, and marketing services ([Section 2.4.5.14](#))

Analyzing Approved Applications

Finally, using the [CIPO Trademarks Database](#) to review the goods and services descriptions for third-party registrations and advertised applications covering similar goods and services may help applicants determine what is likely to be accepted by CIPO. This strategy offers less certainty, however, as examiners are not bound by past examination practices.

Future Considerations

CIPO is accepting requests for additions to *The Manual* and seeks to expand it considerably to promote more use. This remains problematic to many users claiming priority from their home country applications, or for international applications designating Canada.

Applicants who require assistance drafting acceptable goods and services descriptions or responding to a technical objection related to a trademark application in Canada should contact any member of the [Trademarks Practice Group](#) or send a message to info@bereskinparr.com.

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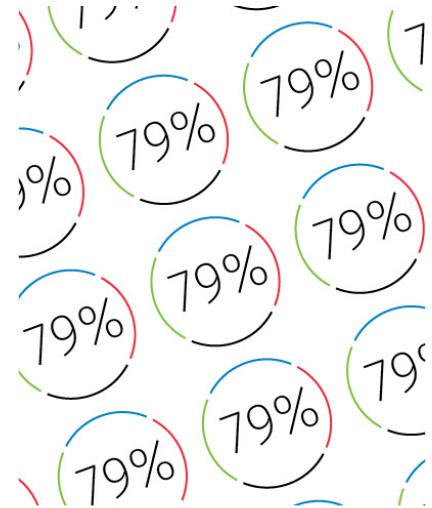
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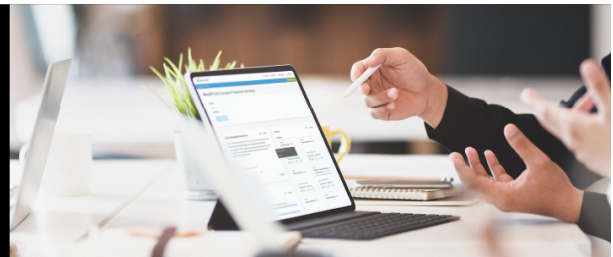
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