

CIPO Treatment of Marks Filed in Colour Through the Madrid Protocol

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Many brand owners are now seeking to register their trademarks in Canada using the Madrid Protocol system for international applications administered by the World Intellectual Property Organization (WIPO). While there are some benefits for foreign applicants, such as somewhat accelerated processing, it is important for foreign applicants and their counsel to bear in mind an important limitation related to colour marks.

The Canadian Intellectual Property Office (CIPO) takes the position that if an international application filed with WIPO contains a visual representation of the trademark in colour, even if a colour claim is not made in the international application or base registration in the applicant's home country, colour is deemed to be claimed as a feature of the trademark once the application enters Canada. Relying on paragraph 31(f) of the *Canadian Trademarks Regulations*, CIPO takes the view that in that case, the applicant is required to provide a statement that colour is claimed as a feature of the trademark, along with an appropriate description of the colours claimed. The scope of protection for the trademark in Canada will be limited accordingly, namely to the mark in the colours claimed.

To avoid this outcome, if a brand owner intends to seek registration of a trademark internationally using the Madrid Protocol and does not wish to have it limited to specific colours, the brand owner should file a black and white representations of the mark in its home country, if permitted, and with WIPO. For marks already filed in colour, a black and white version can be re-filed separately and directly in Canada to obtain broader protection.

This publication is a general summary of the law. It does not replace legal advice tailored to your specific circumstances.