By email to: July 21, 2017
ic.cipo-consultations-opic.ic@canada.ca

Re: Public consultation on Proposed Amendments to the *Trade-marks Regulations*

This is a submission by practitioners in the trademark field who are also very active in promoting mediation to facilitate settlement in trademark disputes.

We believe that this public consultation presents an exceptional and timely opportunity to enhance the use of ADR, particularly mediation to resolve Opposition Proceedings. It will greatly benefit the public and their advisors in resolving their trademark disputes on a timelier basis at a potentially lower cost. This would also conserve CIPO resources at least in part, by reducing pressures on Opposition Board members and their supporting staff. In this short submission, we outline why we believe this to be true.

In order to implement Canada's participation in three international trademark treaties, Bill C-31 has created several fundamental changes in trademark law and practice. While these changes will connect Canada more closely to the international trademark network of Canada's main trading partners, it is well understood that the changes will create great challenges for the Trademarks Office and its personnel.

Some of us learned during the informative presentations by Iyana Goyette and her colleagues in Montreal that the workload of the Trademarks Branch will increase dramatically. The increased workload and pressures are expected to arise as a result of Canada being designated in new International applications, territorial extension of existing registrations to Canada, filings for divisional applications and mergers, and corrections of the IC identifications by applicants, among others.

These changes will consume more of the TMO's scarce resources at a time, when it is already coping with increased stresses, such as: emphasis on more quality, longer delays in examination, greater turnover of staff due to openings elsewhere and fewer resources. We submit that some of these stresses can be alleviated by encouraging users of the opposition system to consider and adopt mediation. The opposition procedure affords numerous stages at which mediation can be usefully invoked.

We know that mediation is often misunderstood. A few confuse it with meditation, partly because of the close linguistic resemblance. Many more mistake it for arbitration. But, a mediator is more a coach than a referee. She facilitates a resolution instead of imposing one. It is only a solution to a dispute when the parties say that it is. Ideally, it is a solution which the parties themselves have designed in whole or in part.

We also know that mediation is a tool; it is not a panacea. It will not eliminate negotiations between counsel and the parties themselves in resolving disputes. It will not eliminate the need for counsel to draft and Opposition Board members to assess detailed briefs in many disputes which do not settle before the briefing stage, nor will it eliminate requests for hearings. However, in our view, it will

lighten the load. And that is something to be valued at a time when the load will be getting considerably heavier.

What are the nuts and bolts of our proposal? In our collective experience, settlement opportunities arise at each junction of the Opposition process: before both statements are exchanged, before evidence is filed, after cross-examination of a party occurs, after briefings are exchanged, and so on. This provides many spaces in the Regulations and the Practice Notice where mention of voluntary mediation can be included.

The mention can be as simple as "This would be a good time for the parties and their agents to consider the possibility of mediation by a third party neutral." Quebec has provided a helpful precedent by placing at the beginning of their recently revised Code of Civil Procedure a requirement that counsel "consider" mediation with their clients before initiating legal proceedings. This is an integral part of Quebec's expressed intention to make justice more accessible and more participatory and to lessen delays in the judicial process.

There are "low hanging fruit" opportunities for the TMO to mention that the parties might consider mediation. These include requests by parties for: extensions to complete a stage, cooling off periods, and an extension to finalize settlement. It might even be possible to require as a condition of any request where consent of the other party must be obtained, that the requesting party also state that she considered the possibility of mediation with her client or the other counsel or both.

We wish to point out that such mention of mediation would dovetail nicely with an aim of the Regulations to place more of an onus on the parties, for example, by requiring a party to indicate within 30 days whether it wishes to participate in a hearing, and by distributing the obligation between the parties to produce transcripts of cross-examinations and responses to undertakings given.

What would be the significance of the TMO including references to mediation in its Regulations and Practice Notice? In our view, these would draw mediation to the attention of practitioners at the time when they are considering their next steps in the process. The mere fact that mediation is mentioned within the description of the Regulations and Office practices would, we believe, help boost the credibility of mediation as a feasible process in facilitating settlement of trademark disputes.

In summary, we propose an interweaving of mentions of mediation into the new Regulations or Practice Notice to: lower the administrative burden on the Opposition Bureau, to decrease delays in the opposition process and to enhance satisfaction achieved by parties and their advisors in the dispute resolution process. This encouragement of mediation by the TMO would be fully in step with the demand by society for participatory justice and greater access to justice.

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