



February 3, 2023

**VIA EMAIL**

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Dear Sirs:

**Re: Public consultation on proposed amendments to the Trademarks Regulations and draft practice notices of the Trademarks Opposition Board**

Thank you for the opportunity to provide comments on CIPO's proposed amendments to the *Trademarks Regulations*, as well as on accompanying draft practice notices, developed to carry out the amendments that were made to the *Trademarks Act* under Bill C-86 (the Budget Implementation Act, 2018, No. 2), which conferred to the Registrar of Trademarks (the Registrar) the authority to award costs, grant confidentiality orders and explicitly practice case management.

Our comments on the draft practice notice are set out below.

**Costs Awards**

1. SECTION II

- a. With respect to cost awards in Section 45 proceedings, there are situations where parties will commence multiple, successive proceedings against the same registration to trigger a "fresh" three-year period and require a registrant to go to the expense of preparing evidence. These circumstances should be discouraged through cost awards and should be considered "unreasonable conduct which causes undue expense in a proceeding".
- b. The statement regarding cost awards in cases where bad faith is alleged in an opposition appears unclear. We suggest that costs only be recoverable if the ground is successful, not simply if it is pleaded, as the draft practice notice suggests.

2. SECTION IV:

- a. In our view, it is unreasonable to hold a party accountable for costs on the basis of unreasonable behaviour by a predecessor in title with different counsel. In many cases, a predecessor in title is an entirely independent entity from the current party and was represented by different counsel. Any unreasonable

behaviour by such unrelated parties and different counsel is and was beyond the control and responsibility of the party in question.

## Case Management

### 1. SECTION VII:

- a. We suggest adding the following as an additional circumstance for the Registrar to consider in deciding whether to order case management:
  - i. any confidentiality orders that have been made or requested
- b. With respect to the circumstance identified as “f.”, we suggest revising this provision somewhat. There are many instances where the same parties are involved in multiple concurrent proceedings that may concern wholly unrelated marks. Any efforts to streamline and consolidate such proceedings through case management may unduly complicate the proceedings and undermine the purposes of case management. We therefore suggest amending this enumerated circumstance as follows:

number of files involving the same or similar parties that relate to the same or similar trademarks

### 2. SECTION IX:

- a. The final paragraph indicates that the Registrar can remove a proceeding from case management “once it is no longer necessary for a case to be a case managed proceeding to facilitate efficiency”. We suggest including a mechanism whereby the Registrar can notify the parties that it is considering removing the proceeding in question from case management and then invite the parties to make submissions. This will help prevent a unilateral removal of a proceeding from case management where there may be further or future benefits to maintaining case management.

## Confidentiality Orders

### 1. SECTION II:

- a. The general section should refer to the fact that confidentiality orders should apply to any portion of the cross-examination concerning confidential evidence and reference to same in an oral hearing. This is in keeping with the current practices before the Federal Court, where portions of cross-examination transcripts and held as being “confidential” and portions of the hearing are held with limited attendance to avoid inadvertent disclosure of otherwise confidential information.
- b. With respect to timing, one month from the date of the confidentiality order to submit further evidence may not be sufficient depending on the length of time it takes the Registrar to rule on whether an order will be granted, especially when

the request for the order is not on consent and the Registrar is requesting comments from the party opposite.

- c. Regarding the obligation to destroy all items containing confidential information, is the Registrar proposing any affidavit or declaration of destruction?
2. SECTION IV:
    - a. In Section IV.1.a, we suggest that the list of “public interests” be specifically noted as being non-exhaustive. It appears that this was the intent of this section given the use of the word “include” though this could be made clearer.
  3. SECTION X:
    - a. These two paragraphs are not clear. Is it the case that AFTER a proceeding before the Registrar, a party’s remedy for breach of a confidentiality order would be to commence a proceeding before the Federal Court; but DURING a proceeding before the Registrar, the Registrar may award costs for breach of a confidentiality order? The intention here should be made clearer. We would like to see the Registrar empowered with some ability to enforce confidentiality orders or issue sanctions for same (beyond costs awards, which are already referenced) DURING proceedings.

Yours truly,

**Cassels Brock & Blackwell LLP**



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