



Intellectual Property Institute of Canada
Institut de la propriété intellectuelle du Canada

Intellectual Property Institute of Canada (IPIC) submission on proposed amendments to the Trademarks Regulations and draft practice notices of the Trademarks Opposition Board

Submission to:
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The Intellectual Property Institute of Canada (IPIC) is the professional association of patent agents, trademark agents and lawyers practising in all areas of intellectual property law. Our membership totals over 1700 individuals, consisting of practitioners in law firms and agencies of all sizes, sole practitioners, in-house corporate intellectual property professionals, government personnel, and academics. Our members' clients include virtually all Canadian businesses, universities and other institutions that have an interest in intellectual property (e.g., patents, trademarks, copyrights, and industrial designs) in Canada or elsewhere, as well as foreign companies that hold intellectual property rights in Canada.

In November 2022, the Trademarks Opposition Board issued a Consultation Document providing information regarding the proposed additions to the *Trademarks Regulations* to implement Bill C-86 which Bill granted new authority to the Registrar of Trademarks to (i) award costs; (ii) grant confidentiality orders; and (iii) case manage proceedings in the context of opposition, objection and section 45 proceedings. The Consultation Document included draft Practice Notices in these three areas and sought input from the public and profession on the drafts. The drafts were reviewed by the members of the IPIC Trademark Committee and the comments were collected and summarized by a sub-committee charged with that task. The summary is set out below. The Committee observed that there were very few comments on the draft Practice Notices overall which appeared to be a positive reflection on the extensive informal consultation process engaged in by the Board early in the process and in advance of presenting the drafts for broader consultation.

Draft – Cost Awards in Proceedings under sections 11.13, 38 and 45 of the *Trademarks Act*

a. Availability of awards of costs

DRAFT - The Registrar may, at the request of a party, award costs in proceedings under sections 11.13, 38 and 45 of the Act in specific circumstances. Costs may be awarded against a party that has engaged in certain circumstances during a proceeding and will help ensure that parties are incentivized to move efficiently through a proceeding before the Registrar.

We question whether the word “circumstances” should be replaced with “conduct”

DRAFT - Cost awards are not intended to prevent a party from participating fully or from having their interests represented zealously in a fair and professional manner in a proceeding. As such, costs will only be awarded in exceptional cases.

We fully agree that costs should only be awarded in exceptional circumstances and where the conduct of a party (or their agent) has been highly objectionable or unprofessional. However, a party should be entitled to “zealous” 2

representation which is conducted in a fair and professional manner, and which would not be characterized as “unreasonable conduct” under heading 11.3.d

DRAFT - The Registrar will only consider awarding costs in a proceeding at the request of a party (section XX, XX or XX of the Regulations).

We question whether it would be advisable for there should be some residual discretion on the part of the Registrar to make a cost award where one or both of the parties is unrepresented and a party has engaged in highly objectionable or otherwise unreasonable conduct.

DRAFT - The Registrar will provide reasons for its decision on costs in the final disposition of the proceeding.

Since the power of the Registrar to award costs is new and it is in the interest of all parties to be aware, to the extent possible, of how the law in the exercise of this new power is evolving, we question whether it would be possible for the Board to post decisions in which costs have been awarded under a separate heading on the website for use as a reference source.

Draft – Practice notice on confidentiality orders

No comments

Draft – Case management in proceedings under sections 11.13, 38 and 45 of the Trademarks Act

No comments