

Borden Ladner Gervais LLP

Submissions Concerning the Discussion Paper on the *Proposed Amendments to the Trade-marks Regulations 2014*

We thank CIPO for the opportunity to comment on the draft regulatory changes. Many of the proposed regulatory changes are welcomed.

Third Party Submissions During Examination Stage

We have significant concerns with the proposed procedure for third party submissions at the examination stage, in particular the potential for abuse by third parties. Such a procedure may be used as a tactic, causing significant delays in the application process, and generating additional office actions requiring a response. Further, in the procedure as proposed, third party materials need not be introduced by way affidavit, and will not be subject to cross examination in order to test their reliability. Where the purpose, motive and relevance of the information and materials provided to the Examiner from a third party is questionable, the delay (and increased costs for the applicant) may come without any corresponding benefit to the examination process.

If this change in procedure is to be adopted, we suggest that where third parties have the right or opportunity to submit material which may raise registrability issues, Examiners should consider whether examination is an appropriate forum to resolve the issues that are raised.

If this proposed option is adopted, in order to reduce the likelihood that the proposed amendment may unduly prejudice applicants, including by significantly impacting timelines for national applications to proceed to registration, and by compromising CIPO's ability to meet deadlines imposed by adoption to the Madrid Protocol, further details and/or guidelines regarding this process may be helpful. For example, CIPO may consider:

- providing training and/or guidelines to Examiners, to help them assess whether the nature of the third party submission (and any registrability issues that are raised by the third party) would be better resolved in the context of an opposition;
- providing guidelines regarding the specific nature of the information and materials (and the sources of such information and materials) which may be deemed acceptable;
- empowering Examiners to limit the number of third party submissions that will be received;
- setting limits on the number of office actions that may be issued, or the length of time permitted for an Examiner to issue an office action, to control costs and delays associated with the process;
- empowering Examiners to decide, for example in cases of abuse by third parties, that one or more third party communications will not form part of the official record;

- allowing additional time for the Applicant to respond, where requested.

Division and Merger of Applications

The proposed amendments to the regulations provide that if a request for an extension of time to oppose or a statement of opposition has been filed, an application for division must contain a statement from any opponent that the opposition will be withdrawn for the classes, goods or services divided out. We submit that the language “any opponent” is ambiguous because it is not clear whether all opponents must agree to withdraw their respective oppositions for the classes of goods or services divided out. More importantly, we are concerned that this requirement opens the door to abuse by an opponent who refuses to withdraw the opposition for the divided goods/services for purely tactical reasons. To curb the potential for abuse, we believe that the Registrar should have the ability to impose sanctions on opponents who unreasonably withhold “consent” to a division, including but not limited to the ability to impose a case management schedule to accelerate the opposition process, with the consequence that the opposition will be dismissed if the opponent fails to meet the deadlines set out in the schedule.

Amendments re Methods of Service in Opposition and Summary Cancellation Proceedings

The proposed amendments to the regulations allow for service in opposition and summary cancellation proceedings to be effected in person, by courier, by facsimile up to a maximum of 20 pages, or “in any other manner with the consent of the party being served or their trademark agent”. We believe it would be helpful to have further guidelines regarding proper service (i.e., in addition to those contained in the proposed amendments) where the parties agree on electronic service. The Federal Court’s guidelines on Electronic Legal Service and Electronic Filing in the Federal Court are helpful. See: http://cas-ncr-nter03.cas-satj.gc.ca/fct-cf/pdf/Annex_English.pdf . The guidelines include a template/form for providing consent to electronic service of all documents that are not required to be personally served (the form allows parties to specify the electronic address(es) for service). The guidelines also: list the ways in which electronic service may be validated (to ensure that the served document was, in fact, received); specify that documents should be transmitted in pdf format, or any other format acceptable to the recipient, and; indicate how the deemed date of service is determined for documents served electronically.

BLG appreciates the opportunity to provide these comments. We would be pleased to further discuss these matters with CIPO at any time.