

1. Practice notice on opposition to Protocol applications and section 45 cancellation proceedings against protocol registrations

I Opposition proceedings

I.1 Protocol applications will be treated the same as domestic applications

Unless otherwise required by the Madrid Protocol and set out in the Regulations, a Protocol application undergoes the same opposition process as a domestic application.

I.2 Notice of opposition period

129 If, in respect of a Protocol application, it is likely that the opposition period will extend beyond the end of 18 months after the date of notification of territorial extension, the Registrar must so inform the International Bureau.

CIPO will notify the International Bureau (IB) of all Protocol applications yet to be advertised 10 months after the deemed filing date of each application and update the Canadian Trademarks Database to show this notification. The sending of the notice at this time will allow potential opponents to request and obtain the full four month extension of time to file a statement of opposition.

- *We support this notification appearing on the Trademark Database.*
- *We understand this is an automatic notice to the IB that “opposition is possible” after 18 months.*

I.3 Extension limitation when filing a statement of opposition to a protocol application

125 In respect of a Protocol application, the Registrar is not permitted, on application made to the Registrar, to extend, under section 47 of the Act, the two-month period referred to in subsection 38(1) of the Act by more than four months.

- This limitation of extensions of time is to ensure that the Registrar is in a position to notify the IB of a provisional refusal based on opposition within the time limit set out in the Madrid Protocol.
- Article 5(2) f the Madrid Protocol explains that an office may notify a refusal of protection after the expiry of the 18 month time limit in certain circumstances:

- IF it has notified the IB, before the expiry of the 18 month time limit, of the possibility of oppositions being filed after the expiry of the 18 month time limit,
- and the notification of refusal based on opposition is made the earlier of:
 - seven months from the date on which the opposition period begins (i.e. from the date of advertisement); or
 - one month after the end of the opposition period.

- If CIPO does not notify the IB of a provisional refusal based on opposition within the time limit specified in Article 5(2) of the Madrid Protocol, the opposition cannot proceed, and the Protocol application will mature to registration and the trade-mark will be protected in Canada (see sections 132(1)(c) and (d) of the Regulations).
- *We understand recourse in this scenario is only available through the Federal Court?*
- Upon request, the Registrar will generally grant a single **extension of time of four months** of the deadline to oppose a Protocol application. The Registrar cannot grant an extension of time on request to file a statement of opposition beyond four months, including requests based on exceptional circumstances or a cooling-off period. However, cooling-off periods and extensions of time based on exceptional circumstances will be available after the filing of the statement of opposition as set out in Practice in Trademarks Opposition Proceedings.
- It is recommended that the on-line window for filing extensions be utilized. The use of the on-line extension window permits confirmation of receipt, while reducing delay and the possibility of mishandling of submissions en route to CIPO.
- *We understand use of the online window for filing extensions will result in an automatic confirmation.*

I.3.a Retroactive extension of time

- Pursuant to section 47(2) of the Act and subject to the limitation in section 125 of the Regulations, the Registrar may grant a retroactive extension of time to oppose a Protocol application. Due to the time it may take to process a retroactive extension of time request, it is recommended that a statement of opposition be filed and the statement of opposition fee be paid at the same time as applying for the extension of time. If it is not filed at the same time, there is a risk that the time required to process the extension of time, will not allow the opponent time to file the statement of opposition and the Registrar to send the provisional refusal based on opposition to the IB prior to the deadline set out in Article 5(2) of the Madrid Protocol.
- *We understand a retroactive extension must be filed in the same four month period, must include an extension fee, and will be assessed for compliance with Section 47(2) in the same manner for both protocol and national applications.*

I.4 Filing a statement of opposition

126 A statement of opposition under section 38 of the Act in respect of a Protocol application must be in English or French and be filed by using the online service that is designated by the Registrar as being accepted for that purpose.

- This requirement is intended to:
 - enable CIPO to fulfill its obligation to notify the IB of oppositions within the deadline set out in Article 5(2) of the Madrid Protocol; and
 - assist in avoiding errors in preparing a statement of opposition which will then form the basis of the provisional refusal based on opposition.
- A statement of opposition not filed through the online system will **not** be considered and an opposition proceeding will **not** be instituted against the application.
- Hard copies of electronically-filed documents should not be sent to the Registrar as to do so may result in processing delays
- The information entered into the form must be entered in English or French. It cannot include both languages (with the exception of the information concerning the relied upon trademark applications, registrations and prohibited marks).

- *We understand this required electronic process is essential to ensure:*
 - a) efficient tracking and notification of deadlines*
 - b) all mandatory information is included*

I.4.a Plan ahead

- It is recommended to plan ahead. Because unexpected technological problems can occur, users should keep filing deadlines in mind and allow plenty of time to resolve any issues which may arise.
- Once four or more months have passed since the date of advertisement, the Registrar is precluded from granting an extension of time on request (see section 125 of the Regulations).

- *For the benefit of all practitioners, we wish to repeat the comments of the Board in our earlier review that:*

Opposition procedure against Protocol Applications requires careful planning as we are relying on IT systems and working within strict deadlines. We understand the ultimate deadline is that which falls on the extended four month term based on the Board's Ottawa time zone (regardless of where the Statement of Opposition is filed from) in accordance with Section 9(4) of the Trademarks Regulations which confirms that it is the local time of the Office of the Registrar of Trademarks. Opponents are therefore strongly encouraged not to wait until the final deadline.

I.4.b Procedure when the on-line system for filing a statement of opposition is down

- If the on-line system is down during CIPO's business hours, the Registrar will place an alert on CIPO's website, send a notification through the Trademarks listserv and change the voicemail message on the general information number to advise that the system is down.
- If, when filing a statement of opposition, outside of business hours, the on-line system is down or no confirmation that the statement of opposition has been received upon filing, please follow the procedure outlined below for when the on-line system is down.
- When the on-line system is down or no confirmation is received outside of business hours, statements of opposition must be filed by attaching the statement of opposition to an email and sending it to the following address: ic.tmobmadrid-comcmadrid.ic@canada.ca. To assist in the preparation of the provisional refusal based on opposition, the form at Schedule A should be used. Statements of opposition sent to this email address at any time other than when the (i) on-line system is down or (ii) no confirmation has been sent out will not be considered by the Registrar.

I.5 Assessment of the statement of opposition

Once filed, a statement of opposition will be reviewed by the Registrar prior to the notification of provisional refusal being sent to the IB.

If the Registrar considers that the opposition raises a substantial issue for decision pursuant to section 38(4) of the Act, a copy of the statement of opposition will be forwarded to the applicant and a notice of provisional refusal based on opposition will be sent to the IB. As with domestic applications, the forwarding of the statement of opposition triggers an applicant's deadline to file and serve its counter statement [section 38(6) of the Act].

If the Registrar considers that the opposition does not raise a substantial issue for decision, the statement of opposition will be rejected pursuant to section 38(4) of the Act and the reasons for rejection will be provided to the opponent. A notice of provisional refusal will be sent to the IB to allow for the possibility that the rejection could be appealed pursuant to section 56 of the Act. If the rejection is overturned on appeal, the statement of opposition will be forwarded to the applicant. As with domestic applications, the forwarding of the statement of opposition triggers an applicant's deadline to file and serve its counter statement [section 38(6) of the Act]. If the rejection is not appealed or the Registrar's decision to reject the statement of opposition is upheld on appeal, a statement of grant of protection will be sent to the IB when a registration certificate issues with respect to that application.

- *You have previously confirmed that an Interlocutory Ruling request can be filed against a Protocol Application and that the standard of review will be the same as for a national application.*
- *For the benefit of all practitioners, we clarify that there is a new ground of opposition to protocol cases only under Section 104 and specifically a ground under Section 38(2)(b) that a protocol application is not registrable if the goods and services are not within the scope of the international registration.*

I.6 Notification of provisional refusal

127 If, in respect of a Protocol application, a statement of opposition is filed, the Registrar must send to the International Bureau a notification of provisional refusal.

After a statement of opposition has been filed, a letter to the IB will be prepared attaching the statement of opposition. This will be the provisional refusal based on opposition and will have the information required in Rules 16 and 17 of the Common Regulations including:

- the dates of the opposition period (including any extensions to that period);
 - a copy of the statement of opposition;
 - a print-out from the Canadian Trademarks Database detailing the relied upon rights including any applications and registrations as specified by the opponent through the on-line system or in the statement of opposition; and
 - copies of the relevant Trademark legislation [**or list of the relevant sections**].
- *Following earlier consultation, the Board had set out to confirm the process for reliance on common law rights in the electronic opposition document. We acknowledge that the Board contacted WIPO and received the following response:*

Rule 17 of the Common Regulations states that all the grounds for refusal should be indicated in the provisional refusal. The opponent should include all the grounds and all the marks he is basing the opposition on as the holder of the international registration should be given exhaustive information in the provisional refusal of the status of his mark and possible obstacles preventing protection in Canada. The holder would need to decide, upon receipt of the provisional refusal, whether there is a chance to overcome the refusal so that it may be worth it to obtain a local attorney to handle the case before the Office. Otherwise, you may have the situation where the holder believes there are one or two prior rights and would be able to overcome these, and then the opponent may produce information on further marks.

We also draw your attention to section 15 of the administrative instructions which says in part:

... Where the opposition is based on a conflict with an earlier right other than a mark which is registered or is the subject of an application for registration, that right, and preferably the owner of that right, shall be identified as concisely as possible...

A copy of the provisional refusal as sent to the IB will be sent to the opponent and the applicant. The Canadian Trademarks Database will also be updated to show that the provisional refusal based on opposition has been sent. If an opponent has filed a statement of opposition and the Canadian Trademarks Database has not been updated to show that the provisional refusal has been sent to the IB within two weeks of its filing, the Trademarks Opposition Board (TMOB) should be contacted by calling either 1-866-997-1936 and asking to be transferred to the TMOB or calling (819) 997-7300 directly.

- *We acknowledge that an opponent is to accept responsibility for checking the Trademark Database to ensure the database has been updated to show that the provisional refusal has been sent to the IB within two weeks of the filing of a Statement of Opposition and if not, to contact the Board at the designated phone numbers provided.*

I.7 Opposition proceeds according to the usual process

Once the statement of opposition is forwarded to the applicant and the provisional refusal has been sent to the IB, the file will follow the usual opposition process and existing procedures, as outlined in section 38 of the Act, sections 42-58 of the Regulations, and Practice in Trademark Opposition Proceedings, until a decision is reached and the appeal period has expired.

I.8 Process once opposition proceedings have been concluded

130 The Registrar must send a statement of confirmation of total provisional refusal in respect of a Protocol application to the International Bureau if:

- a. the Protocol application is deemed to have been abandoned under subsection 38(11) of the Act; or
- b. the Registrar refuses the Protocol application under subsection 38(12) of the Act with respect to all of the goods or services specified in it and either the period for filing an appeal has ended and no appeal has been filed or, if an appeal has been taken, the final judgment has been decided in favour of the opponent.

132(1) In respect of a trademark that is the subject of a Protocol application, the Registrar must register the trademark in the name of the applicant, issue a certificate of its registration and send a statement to the International Bureau that protection is granted to the trademark if:

- a. the Protocol application has not been opposed and the opposition period has ended;
- b. the Protocol application has been opposed and the opposition has been decided in favour of the applicant and either the period for filing an appeal has ended and no appeal has been filed or, if an appeal has been taken, the final judgment has been decided in favour of the applicant; ...

I.8.a If a decision is reached

Once a decision on the opposition has been issued, and the appeal period has expired, the Registrar must notify the IB of the final decision on the provisional refusal based on opposition. If the Registrar's decision is appealed, the IB is notified of the final decision after all proceedings have concluded. In the case of multiple oppositions, the IB is only notified once there is a final decision refusing the application or all proceedings have been concluded such that a statement of grant of protection will be sent. A copy of the statement of grant of protection or confirmation of total provisional refusal will be sent to the applicant and the opponent(s).

I.8.b If an opposition is withdrawn

If an opposition is withdrawn and no other opposition proceedings are on-going, a statement of grant of protection will be sent to the IB. A copy of the statement of grant of protection will also be sent to the opponent and the applicant.

I.8.c If an application is deemed abandoned

If an application is deemed abandoned under section 36 or subsection 38(11) of the Act, CIPO will communicate this abandonment through a confirmation of total provisional refusal to the IB. A copy of the confirmation of total provisional refusal will be sent to the opponent and the applicant.

I.9 Irregularity

If there is a problem with the provisional refusal, the IB will notify CIPO of an irregularity.

- If a notice of irregularity issues because the provisional refusal was sent outside the time limit set forth in Article 5(2) of the Madrid Protocol, the provisional refusal will not be recorded and the trademark will mature to registration (see also section 132(1)(d) of the Regulations).
- If a notice of irregularity issues because the provisional refusal is irregular in other respects (for example, if the notification of provisional refusal does not contain a reproduction of a conflicting earlier mark, or if other relevant details relating to an earlier mark, including the name and address of its owner, are missing), the IB will invite CIPO to rectify its notification within two months. If the two month deadline is not met, the provisional refusal will not have any effect and the trademark will mature to registration (see Rule 18(1)(d) of the Common Regulations).
- Irregularities requiring remedy solely by CIPO will be addressed by CIPO without any input required on the part of the opponent.

- If an irregularity needs to be addressed by the opponent, the opponent will be informed and asked to provide a response within **two weeks** so that CIPO may respond to the IB within the two month deadline. If an email address or facsimile number has been provided for the opponent, CIPO will send a courtesy copy of the irregularity and any correspondence generated by the Registrar by email or facsimile

- *We understand the online system should substantially cut down on irregularity notices. Opponents should be strongly encouraged to always indicate an email address for any urgent contact required. Could the Board confirm if extensions of the two week deadline might be permitted for exceptional circumstances?*

I.10 No new grounds of opposition

128 If the Registrar sends to the International Bureau a notification of provisional refusal based on an opposition, the statement of opposition may not be amended to add a new ground of opposition.

The obligation to notify the IB of the potential grounds of opposition within the strict time limits set out in Article 5(2) of the Madrid Protocol is the underlying reason for section 128 of the Regulations. As such, an opponent should ensure that it has included all applicable grounds in its statement of opposition. Furthermore, as the provisional refusal filed with the IB cannot be amended at a later date to include additional trademarks, all relied upon trademarks, including common law trademarks, should be included along with their particulars, including (if applicable) the application number, registration number, filing date, and registration date, a reproduction of the trademark, and goods and services (for further information see the Common Regulations, Rules 17(2)(v) and 18(2)).

The Registrar may consider an amendment to an existing ground of opposition to be a new ground if the amendment substantially changes the basis on which this ground was originally pleaded. In assessing whether an amendment seeks to add a new ground of opposition, the statement of opposition as a whole will be considered. An example of an amendment that could potentially be considered a new ground, would be the addition of a trademark that was not pleaded in the original statement of opposition. An amendment which could potentially not be considered a new ground is if there was a section 12(1)(b) ground of opposition and a section 2 ground of opposition which simply alleges that the trademark was not distinctive without any further allegations was amended to state that the trademark was not distinctive because it was clearly descriptive.

- *We are grateful for the examples of acceptable and unacceptable amendments. We understand that for an unacceptable amendment, the Board would indicate in their response to the leave request, that it does not comply with the Regulations.*

In recognition of the fact that an opponent may wish to rely on the maturation of a referenced application under section 12(1)(d) of the Act, an amendment to the statement of opposition to reference the addition of a registration to an existing section 12(1)(d) ground will not generally be considered a new ground of opposition so long as the corresponding application was referenced in the statement of opposition and a copy of the application was sent to the IB.

I.11 Additional reasons for extensions beyond benchmarks

Practice in Trademarks Opposition Proceedings establishes various benchmarks for extensions of time and cooling off periods at different stages of the opposition proceeding. Parties wishing to exceed these benchmarks should generally point to exceptional circumstances to obtain a further extension of their deadline. The Registrar may consider certain communications from the IB or the applicant for a Protocol application to constitute exceptional circumstances, including where the trademark is the subject of a correction, limitation, cancellation or transformation.

I.12 Limitations

While a limitation to the International Registration in respect of Canada can be made directly with the IB, for efficient processing it is preferable that an applicant wishing to amend the goods and services in a Protocol application do so by filing an application directly with the Registrar. The Registrar will then assess whether the amendment complies with section 35 of the Regulations and will advise the applicant and opponent accordingly.

I.13 Failure to consider a request for extension of time

142(1) The Registrar may remove a Protocol registration from the register if the Registrar registered the trademark without considering a previously filed request for an extension of time to file a statement of opposition, unless the time limit under Article 5(2) of the Protocol to make a notification of provisional refusal based on an opposition has ended.

If the Registrar becomes aware that a Protocol application has registered without having considered a previously filed request for an extension of time to file a statement of opposition, which would otherwise have been granted, and the time limit under Article 5(2) has not yet expired, the Registrar will remove the Protocol registration and immediately notify the potential opponent, including by email or facsimile (if provided). While the Registrar is not permitted to extend the time for filing a statement of opposition beyond four months on request see I.3 Extension Limitation when Filing a Statement of Opposition to a Protocol Application, the Registrar may exercise discretion to do so on its own initiative, in appropriate circumstances.

- *This seems to suggest that the Board would grant additional delay beyond the four months to oppose voluntarily at its own discretion to accommodate this unusual circumstance. Is this correct?*

II Section 45 cancellation proceedings

Section 45 Cancellation Proceedings against a Protocol registration will follow the same process as a section 45 proceeding against a domestic registration, as set out in sections 67-74 of the Regulations and the Practice in Section 45 Proceedings, with the exception of an additional step. In the case of a Protocol registration, once a final decision is reached and the appeal period has expired, if the registration is expunged in whole or in part, the IB will be notified pursuant to Rule 19. If the registration is expunged in whole, the IB will be notified of a full invalidation; if the registration is expunged in part, the IB will be notified of a partial invalidation.

This practice notice is intended to provide guidance on the Canadian Intellectual Property Office practice and interpretation of relevant legislation. However, in the event of any inconsistency between this notice and the applicable legislation, the legislation must be followed. The provisions of this practice notice are general guidelines only, are not binding in any particular case and are subject to change.

Schedule A (Sample form for statement of opposition)

[View as PDF](#) (PDF: 259 KB; 7 pages)

In the event that the online system is down, the following may be used to prepare a statement of opposition for filing against a Protocol Application. Completed forms may be sent [by email](#).

This form must be completed in English or French (with the exception of the information concerning the relied upon trademark applications, registrations and prohibited marks).

Using this suggested form will allow the Registrar to efficiently and accurately prepare the Notification of Total Provisional Refusal Based on Opposition to be Filed with the International Bureau.

Provide the following information concerning the **Opposed trademark application**.

Trademark application No.

International registration No.

Trademark

Applicant

Statement of goods and services

Advertisement date

Please attach CIPO Fee Payment Form (or otherwise complete fee information here)

Provide the following information concerning the **Opponent**.

Full name of the opponent

Address of the opponent (if not based in Canada, also the address for service in Canada or the address of the opponent's agent based in Canada)

Full name of the opponent's agent (if any)

Address of the opponent's agent (if any)

Email address of the opponent's agent (if any)

Email address of the opponent (if no appointed representative or agent)

Grounds of opposition

Please check and complete **only** the relevant boxes that apply. Unless stated otherwise, all section references are references to the Trademarks Act.

Section 38(2)(a) – The application does not conform to the requirements of subsection 30(2):

Section 30(2)(a) – The application does not contain a statement in ordinary commercial terms of the goods and services associated with the trademark applied for.

Goods and services not specified in ordinary commercial terms

Section 30(2)(b) – The application does not contain particulars of the defined standard that the use of the certification mark is intended to indicate **and/or** a statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used or proposed to be used.

Any additional information

Section 30(2)(c) – The application does not contain a representation or description, or both, that permits the trademark to be clearly defined and that complies with any prescribed requirements under section 30 of the Trademarks Regulations.

Identify subsection(s) of section 30 of the Trademarks Regulations not complied with.

Any additional information (please explain why the application is being opposed on this ground).

Section 30(2)(d) – The application does not contain the information or statement prescribed by section 31 of the Trademarks Regulations.

Identify subsection(s) of section 31 of the Trademarks Regulations not complied with.

Any additional information (please explain why the application is being opposed on this ground).

Section 38(2)(b) - The trademark is not registrable:

Section 12(1)(a) – The trademark is not registrable because it is a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years.

Any additional information

Section 12(1)(b) – The trademark is not registrable because whether depicted, written or sounded it is either clearly descriptive or deceptively misdescriptive of:

the character or quality of the goods and services with which the trademark is **used**

the character or quality of the goods and services with which the trademark is **proposed to be used**

the conditions of or the persons employed in the production of the goods and services or of their place of origin

Good(s) and service(s)

Language in which the trademark is either clearly descriptive or deceptively misdescriptive French English

Any additional information

Section 12(1)(c) – The trademark is not registrable because it is the name of any one of the goods or services with which the trademark is used or proposed to be used.

Language in which the trademark is the name of the goods or services (not required if English or French)

Good(s) and service(s)

Any additional Information

Section 12(1)(d) – The trademark is not registrable because it is confusing with a registered trademark.

Trademark application and registration numbers for relied upon trademarks

Any additional Information

Section 12(1)(e) – The trademark is not registrable because it is a sign or combination of signs whose adoption is prohibited by sections 9 or 10.

Section 9 – The adoption of the trademark is prohibited by section 9.

Prohibited mark serial number(s) (if applicable)

Any additional information (please identify the subsection(s) of section 9 on which this ground of opposition is based and explain why the adoption of the trademark is prohibited by the subsection(s).

Section 10 – The adoption of the trademark is prohibited by section 10:

The trademark has become recognized as designating the following with respect to the goods and services with which it is associated:

kind

- value
- quality
- place of origin
- quantity
- date of production
- destination

Any additional information

Section 12(1)(f) – The trademark is not registrable because it is a denomination whose adoption is prohibited by section 10.1.

Denomination

Any additional information

Section 12(1)(g) – The trademark is not registrable because it is, in whole or in part, a protected geographical indication identifying a wine, where the trademark is to be registered in association with a wine not originating from a territory indicated by the geographical indication.

Protected geographical indication and number

Any additional information

Section 12(1)(h) – The trademark is not registrable because it is, in whole or in part, a protected geographical indication identifying a spirit, where the trademark is to be registered in association with a spirit not originating from a territory indicated by the geographical indication.

Protected geographical indication and number

Any additional information

Section 12(1)(h.1) – The trademark is not registrable because it is, in whole or in part, a protected geographical indication, and the trademark is to be registered in association with an agricultural product or food – belonging to the same category, as set out in the schedule, as the agricultural product or food identified by the protected geographical indication – not originating in a territory indicated by the geographical indication.

Protected geographical indication and number

Any additional information

Section 12(1)(i) – The trademark is not registrable because it is a mark whose adoption is prohibited by subsection 3(1) of the Olympic and Paralympic Marks Act, subject to subsection 3(3) and paragraph 3(4)(a) of that Act.

Any additional information (please provide the details of the Olympic or Paralympic mark(s) that the mark so nearly resembles as to be likely to be mistaken for it by including the trademark and reference to the legislation).

Section 12(2) – The trademark is not registrable because, in relation to the goods or services in association with which it is used or proposed to be used, its features are dictated primarily by a utilitarian function.

Good(s) and service(s)

Any additional information

Section 104 of the Trademarks Regulations – The trademark is not registrable because the goods or services specified in the Protocol application are not within the scope of the international registration.

Good(s) and service(s)

Any additional information

Section 38(2)(c) – The applicant is not the person entitled to registration of the trademark:

Section 16(1)(a) – The applicant is not the person entitled to registration because the trademark applied for was confusing with a trademark previously used or made known in Canada by any other person.

Each trademark relied upon and associated goods and services (Registration and application numbers of used or made known trademarks are acceptable. Trademarks which are relied upon and not the subject of an application or registration must be clearly identified along with the associated goods/services.)

Section 16(1)(b) – The applicant is not the person entitled to registration because the trademark applied for was confusing with a pending trademark application previously filed in Canada by any other person.

Application number

Section 16(1)(c) – The applicant is not the person entitled to registration because the trademark applied for was confusing with a tradename previously used in Canada by any other person.

Each tradename relied upon and associated goods and services

Section 38(2)(d) – The trademark is not distinctive.

Any additional information (please explain why the trademark is not distinctive within the meaning of section 2 of the Act).

Section 38(2)(e) – The applicant was not using or did not propose to use the trademark in Canada in association with the goods and services applied for, at the date the application was filed.

Any additional information (please explain why the applicant is not using or did not propose to use the trademark).

Section 38(2)(f) – The applicant was not entitled to use the trademark in Canada in association with the goods and services applied for, at the date the application was filed.

Any additional information (please explain why the applicant is not entitled to use the trademark in Canada).

Include **printouts** of each of the applications, registrations and prohibited marks relied upon in the statement of opposition **or** complete the following **Information relating to each of the applications, registrations and prohibited marks relied upon in the statement of opposition.**

Registration No.

Application No.

Filing date

Priority date (if any)

Full name of the owner

Address of the owner

Reproduction of the mark

Statement of goods and services if any

2. Practice notice on the Pilot project on registrar initiated section 45 proceedings

I Selection of registrations

The Registrar may initiate a section 45 proceeding against any registration that has been registered for a period of more than three years. A section 45 proceeding initiated by the Registrar may be limited to particular goods or services set out in the registration.

The registrations chosen for participating in the pilot project will be chosen randomly from within two groups of registrations: those registered a threshold number of years ago or those including more than a certain number of Nice classes.

- *We support the removal of the identified “subsets” of registrations listed in the previous draft Practice Notice and support that these proceedings involve the strictly random selection of registrations which are more than 3 years past the date of registration.*

I.1 Registrations which will not be subject to registrar initiated section 45 proceedings

I.1.1 No authority to issue the notice

The Registrar will not issue a Section 45 Notice if there is no authority to do so. Following are examples of where the Registrar has no authority to issue a Section 45 Notice:

- the registration has been on the register for less than three years; or
- the registration was on the Newfoundland register prior to April 1, 1949. [Footnote 1](#)

I.1.2 Good reasons not to issue the notice

The Registrar may also decline to issue a Section 45 Notice against a randomly chosen registration if there are good reasons **not** to issue a Section 45 Notice. Following are examples of what may be considered good reasons not to issue a Section 45 Notice:

- the trademark registration is already the subject of a section 45 proceeding pending before the Registrar or on appeal;
 - it is within three years of the date of issuance of a previous Section 45 Notice in cases in which the proceeding led to a final decision under section 45 of the Act;
 - it is within three years of the date of issuance of a Registrar-initiated Section 45 Notice and the proceeding was discontinued; or
 - the Registrar considers that issuing a section 45 Notice would be frivolous.
- *For this last point, the Board has not defined “frivolous”. In our workshop, the Board clarified that because these are randomly selected, they cannot be ‘vexatious’ and that ‘frivolous’ could relate to a situation where a Section 45 has issued and/or recently*

concluded against a similar mark of the registrant. Could the Board clarify the meaning of frivolous in the notice? By way of example, frivolous in this context means there are facts which support that the proceeding would be superfluous against a particular registration?

- Would the Board consider an ongoing opposition based on a registration, which is against a confusingly similar mark, a reason not to initiate the Section 45 proceeding? The involvement of the registration in an opposition challenge would reasonably indicate that the trade mark registration is not “deadwood”. In practice, this might involve ensuring that the registrant is not actively involved in opposition proceedings against a similar mark.*

I.2 Circumstances where only certain goods and services in a registration will be included in the section 45 notice

The Registrar will not include in its Registrar initiated Section 45 Notices goods and services which have been registered less than three years [section 45(1) of the Act].

I.2.1 Amended registration

Where a registration has been amended to extend the statement of goods or services under section 41 of the Act, the Registrar considers that the three-year period for such goods/services applies **from the date of registration of the amendment**. In that regard, reference may be made to section 41(2) of the Act, which provides that an application to extend the statement of goods/services in respect of which a trademark is registered has the effect of an application for registration of a trademark in respect of the goods or services specified in the application for amendment. Accordingly, a registered owner is **not** required to furnish evidence of use in respect of goods or services that have been listed in a registration for less than three years.

I.2.2 Merged registrations

Where a registration is the result of a merger pursuant to section 41(f) of the Act, the Registrar considers that the three-year period begins on the day the particular goods or services matured to registration. Accordingly, a registered owner is **not** required to furnish evidence of use in respect of goods or services that have been registered for less than three years.

If a registration subject to a section 45 proceeding is merged with another registration, the section 45 proceeding will continue but **only** with respect to the goods and services that were subject to the section 45 notice as issued.

I.3 Issuance of the section 45 notice

Section 45 Notices issued on the Registrar's own initiative will be sent to the address of record of the registered owner, with copy to the registered owner's recorded trademark agent in Canada, if any.

The Registrar is **not** responsible for any correspondence **not** received by the registered owner or its trademark agent, including the Section 45 Notice, in cases where the Registrar has **not** been notified of a change of address [section 6(2) of the Regulations].

II Review and option for discontinuance

In all cases, the Registrar will review the evidence before notice is given that written representations may be submitted to assess whether the registered owner has shown use of the trademark in association with the registered goods and services specified in the Section 45 Notice.

II.1 When proceedings will be discontinued

- If the Registrar is satisfied upon reviewing the evidence that it clearly shows use of the trademark in association with all of the registered goods and services, the Registrar will discontinue the section 45 proceedings and the registered owner will be so advised.

II.2 When proceedings will be discontinued if some goods and services are deleted

- If the Registrar is satisfied upon its review that **it is plain and obvious that the evidence** shows use of the trademark for some of the registered goods or services, then the Registrar's notice inviting written representations will indicate that the section 45 proceeding will be discontinued if the remaining goods and services are deleted. If the registered owner wishes the proceeding to be discontinued, the registered owner must notify the Registrar that they delete the remaining goods and services. Upon receiving this request, the Registrar will delete the remaining goods and services and discontinue the proceeding.
- *We previously recommended to the Board that it consider the use of notice on the Trademark Database to indicate that a Section 45 proceeding has been discontinued. The Board has acknowledged that this will be considered in a future improvement of the IT system.*

II.3 When proceedings will continue

- If the Registrar is not satisfied upon reviewing the evidence that it clearly shows use of the trademark with any of the registered goods and services, the Registrar will give notice to the registered owner that they may submit written representations pursuant to section 73 of the Regulations and the proceedings will continue.
 - For greater certainty, no option for discontinuance will be provided for cases involving special circumstances that may excuse the absence of use. In these cases, the Registrar will not have evidence of use of the trademark and a final

decision discussing whether there are in fact special circumstances excusing non-use is warranted.

- If the Registrar's notice inviting written representations indicates that the section 45 proceeding will be discontinued if some of the goods or services are deleted, and the registered owner does not delete these goods and services, the proceedings will continue.

III Correspondence

Correspondence addressed to the Registrar in respect of a section 45 proceeding must follow sections 3 to 15, 68 and 69 of the Regulations and the Canadian Intellectual Property Office's practice with respect to correspondence procedures. All correspondence relating to section 45 proceedings should:

- be clearly marked "**Attention: Section 45 Proceedings**";
- identify the name of the registered owner;
- identify either the trademark registration number or the number of the trademark application that resulted in the registration; and
- identify the trademark.

Documents, including evidence, submitted to the Registrar are open to the public and cannot be returned to the registered owner [section 29(1)(f) of the Act].

- *It has been suggested that the attention line feature capital letters for Section and Proceedings.*
- *In light of Bill C-86 and confidentiality orders which may be granted by the Registrar, should we amend this section to indicate that evidence is open to the public unless a confidentiality order has been granted?*

IV Evidence

In general, the rules of evidence which are applicable in the Federal Court are applicable in section 45 proceedings.

IV.1 Timing

The registered owner must furnish evidence within **three months** from the date of the Section 45 Notice [section 45(1) of the Act].

IV.2 Manner of submitting evidence

Evidence must be submitted to the Registrar by way of affidavit or statutory declaration [section 45(2) of the Act]. More than one affidavit or statutory declaration may be furnished on behalf of the registered owner, regardless of whether the affidavit or statutory declaration is

signed by the registered owner [Canada (Registrar of Trademarks) v Harris Knitting Mills Ltd (1985), 4 CPR (3d) 488 (FCA)].

IV.2.1 Evidence in electronic form or by electronic means

Section 64(1) of the Act provides that any document, information or fee that is provided to the Registrar may be provided in electronic form and by electronic means as specified by the Registrar. This includes evidence. The form and means by which evidence may be electronically provided to the Registrar are set out in the Practice Notice entitled Electronic Evidence in Opposition and Section 45 Proceedings.

IV.3 Evidence of use of the registered trademark

The evidence furnished in response to the Section 45 Notice should demonstrate:

- use of the registered trademark in Canada at any time during the three-year period preceding the date of the Section 45 Notice (the relevant period) with respect to each of the registration's goods or services specified in the Section 45 Notice; and, if not,
- the date when the registered trademark was last used in Canada and the reason(s) for the absence of use since that date.

[section 45(1) of the Act]

The relevant definitions of "use" are set out in section 4 of the Act.

The evidence must **show** use of the trademark by the registered owner or an assignee entitled to be recorded as registered owner *Star-Kist Foods Inc v Canada (Registrar of Trademarks) (1988), 20 CPR (3d) 46 (FCA)*], licensed use of the trademark pursuant to section 50 of the Act, or licensed use of a certification mark pursuant to section 23(2) of the Act.

The type of evidence necessary to show use varies from case to case [*Union Electric Supply Co Ltd v Registrar of Trademarks (1982), 63 CPR (2d) 56 (FCTD)*]. However, the use of the trademark must be in compliance with section 4 of the Act and must be shown with respect to each of the goods and services listed in the registration or specified in the Section 45 Notice [section 45(1) of the Act].

The affidavit or statutory declaration must contain sufficient facts to support a conclusion that the trademark has been used in Canada, as opposed to containing bare assertions of use, which have been held to be insufficient to maintain a trademark registration under section 45 of the Act [*Plough (Canada) Ltd v Aerosol Fillers Inc (1980), 53 CPR (2d) 62 (FCA)*]. The evidence should be forthcoming in quality, not quantity [*Phillip Morris Inc v Imperial Tobacco Ltd (1987), 13 CPR (3d) 289 (FCTD)*].

IV.4 Evidence of licensed use

Where evidence of use is by a licensee of the registered owner pursuant to section 50 of the Act, it is not necessary to furnish a copy of any license agreement in a section 45 proceeding. A statement in the affidavit or statutory declaration that the registered owner had, under the

license, direct or indirect control of the character or the quality of the subject goods or services is sufficient [Empresa Cubana Del Tabaco v Shapiro Cohen, 2011 FC 102, affirmed 2011 FCA 340].

IV.5 Evidence of special circumstances excusing non-use

In cases where the trademark was not in use at any time during the relevant period, the affidavit or statutory declaration should indicate the date the trademark was last in use and the reason(s) for the absence of use since that date.

In order for the registration not to be expunged, the Registrar must be satisfied that there were "special circumstances" excusing the absence of use during the relevant period. "Special circumstances" means circumstances or reasons that are unusual, uncommon, or exceptional [John Labatt Ltd v Cotton Club Bottling Co (1976), 25 CPR (2d) 115 (FCTD)].

The Registrar will consider all **three** of the following criteria in determining whether the evidence demonstrates special circumstances excusing the absence of use of the trademark in Canada:

- the length of time during which the trademark has not been used;
- whether the reasons for the absence of use were due to circumstances beyond the control of the owner; and
- whether there exists a serious intention to resume use of the trademark shortly.

[Canada (Registrar of Trade Marks) v Harris Knitting Mills Ltd, 4 CPR (3d) 488 (FCA) and Smart & Biggar v Scott Paper Limited (2008), 65 CPR (4th) 303 (FCA)]

IV.6 Consequences for registered owner's failure to furnish evidence

If the registered owner does not furnish any evidence in response to the Section 45 Notice, the trademark is liable to be expunged [section 45(3) of the Act].

- *The Board has removed reference to the issuance of a decision expunging the trade mark registration under Section 45(3). Will the Board continue to issue the first notice of expungement announcing that it will occur following an administrative appeal period?*

V Written representations

Written representations are **not** required in section 45 proceedings. If the registered owner does not submit written representations within two months of the Registrar issuing the notice setting the deadline to submit them or advises the Registrar that no written representations will be filed, the Registrar will proceed as soon as administratively possible to issue the final decision, unless the registered owner requests to be heard.

VI Hearings

A registered owner may **only** make representations at a hearing if they file a request to be heard in accordance with the requirements set out in section 74(1) of the Regulations.

VI.1 Timing

The time within which a registered owner must give the Registrar written notice of its request to be heard is within one month from the submission of the registered owner's written representations (or statement that no written representations will be filed) or where no written representations have been submitted, within one month of its deadline to do so [section 74(2)(a) of the Regulations].

VI.2 Request for hearing

The request for hearing must specify the following information:

- whether the registered owner wishes to make representations in person, by telephone, or by video conference (if feasible, as determined by the Registrar on a case by case basis); and
- whether the registered owner will make representations in English or French.

[section 74(1) of the Regulations]

If the registered owner has not furnished the specific information required by the Registrar in its request to be heard as detailed above, the Registrar will assume that the registered owner will appear in person and will schedule the hearing for two and a half hours, with representations to be made in the official language in which the request to be heard was made.

VI.3 Changes to hearing request

If a registered owner who has requested to be heard wishes to make any changes with respect to their appearance at a scheduled hearing, the registered owner should, as soon as possible and **no less than one month** prior to the scheduled hearing date, communicate such changes by:

- sending confirmation of the changes with respect to their appearance by e-mail (to the email address provided in the hearing confirmation notice); or
- calling the Canadian Intellectual Property Office, Information Branch at 1-866-997-1936 and asking to be transferred to the Trademarks Opposition Board (TMOB); or
- calling TMOB directly at 819-997-7300 and asking to speak to the Case and Hearing Coordinator; and
- sending written confirmation to the Registrar of the changes with respect to their appearance by facsimile or regular mail.

No changes with respect to a hearing will be made until a request is received in writing. While reasonable efforts will be made, the Registrar may not be able to accommodate changes that are requested less than one month before the date of the scheduled hearing.

VI.4 Scheduling of hearings

Once the file is ready to be scheduled for a hearing, the Registrar will issue a notice to the registered owner setting out the time, date, location, manner and duration of the hearing and, the official language in which representations will be made in accordance with the information provided in the request for hearing.

The Registrar will issue a notice advising the registered owner of the scheduled hearing date at least 90 days prior to the hearing date.

VI.4.1 Rescheduling a hearing

The Registrar may reschedule a hearing date **once**, upon request, as soon as administratively possible.

VI.5 Cancellation of hearing

If a registered owner who has requested to be heard determines that the hearing no longer wishes to attend a hearing, then the registered owner should, as soon as possible, communicate this to the Registrar by:

- sending confirmation of the cancellation e-mail (to the email address provided in the hearing confirmation notice); or
- calling the Canadian Intellectual Property Office, Information Branch at 1-866-997-1936 and asking to be transferred to the Trademarks Opposition Board (TMOB); or
- calling TMOB directly at 819-997-7300 and asking to speak to the Case and Hearing Coordinator; and
- sending written confirmation of the cancellation to the Registrar by facsimile or regular mail.

A hearing will not be cancelled until such time as the registered owner requests for cancellation is received in writing.

If a hearing is cancelled, the Registrar will proceed to issue a decision in due course, except in cases where the section 45 proceeding has been discontinued by the Registrar or the registration has been voluntarily cancelled or expunged for failure to renew.

VI.6 Jurisprudence

At the hearing, the Hearing Officer/Member will have a copy of all case law included in the Common List of Authorities (Common List), which identifies cases that are frequently cited in opposition and section 45 proceedings.

At least two weeks prior to the hearing date, by facsimile or email (to the email address provided in the hearing notice), the registered owner should provide the Registrar with:

- their list of case law; and
- copies of any decisions to be relied upon at the hearing that are not available on the Registrar's database of decisions and are otherwise unreported.

The registered owner is not required to file a book of authorities. If the registered owner wishes the Hearing Officer/Member to refer at the hearing to any case law that is not identified in the Common List, it may bring copies to the hearing.

VII Extensions of time

Nothing in this practice notice is intended to limit the discretion of the Registrar under section 47 of the Act. In this practice notice, references to circumstances when the Registrar will or will not grant an extension of time and the length of those extensions are intended as general guidance only. As such, any expressions stating the Registrar will or will not grant an extension of time are intended to be interpreted as the Registrar will generally grant or will generally not grant an extension of time.

Deadlines and available extensions of time at each stage of the proceeding

Stage of Proceeding	Statutory deadline	Benchmark extensions	Extensions of time based upon exceptional circumstances
Registered owner's evidence	3 months from the date of the Section 45 Notice	4 months	Determined on a case by case basis
Registered owner's written representations	2 months from the date of the notice inviting the registered owner to submit written representations	Not available	Determined on a case by case basis
Request for hearing	1 month from the earlier of the submission of the registered owner's written submissions or 1 month from the expiry of such deadline	Not available	Not available

Section 47 of the Act is discretionary. It enables the Registrar to grant extensions of time in section 45 proceedings if the Registrar is satisfied that the facts justify the need for an extension of time [Sandhu Singh Hamdard Trust v Canada (Registrar of Trademarks) (2007), 62 CPR (4th) 245 (FCA), affirming 47 CPR (4th) 373 (FCTD)].

All requests for an extension of time under section 47 of the Act must be accompanied by the prescribed fee [section 14 of the Regulations and Item 1 of the Schedule to the Regulations].

VII.1 Extensions of time – benchmark

The Registrar will grant **one** request for an extension of time up to a maximum benchmark of **four months**, for the registered owner **to furnish evidence** in response to a Section 45 Notice. The legislative intent behind section 45 is to provide an efficient and summary procedure for removing trademarks which are not in use from the Register. In view of this, further extensions of time for taking this step will only be granted in exceptional circumstances [see VII.2 below]. Likewise, extensions of time for taking any other steps in a proceeding will only be granted in exceptional circumstances.

The Registrar will **not** grant more than one request for a benchmark extension of time for a registered owner **to furnish evidence**, even where such multiple requests would only amount to the maximum benchmark of **four months**.

VII.2 Extensions of time – exceptional circumstances

The Registrar will only grant an extension of time beyond the benchmark for a registered owner to furnish its evidence or grant an extension of time for the registered owner to submit written representations, if exceptional circumstances have been demonstrated.

The Registrar will not grant an extension of time to extend the deadline for requesting a hearing.

Following are examples of what the Registrar **may** consider exceptional circumstances justifying an extension of the time.

VII.2.1 Recent change in the registered owner's instructing principal or trademark agent

If there has been a very recent change in the registered owner's instructing principal or trademark agent, the Registrar may grant an extension of time allowing a reasonable period of time to enable the new trademark agent or instructing principal to become familiar with the file.

VII.2.2 Circumstances beyond the control of the person concerned

Examples of factors that could amount to exceptional circumstances beyond the control of the person concerned include illness, accident, death, bankruptcy or other serious and unforeseen circumstances.

VII.2.3 Assignment of the registration

If there has been a recent assignment of the registration that is the subject of the section 45 proceeding, the Registrar may grant an extension of time allowing a reasonable period of time to enable the new trademark owner to become familiar with the file.

VII.3 Extensions of time – retroactive

If a registered owner is facing a statutory deadline that has already passed, the Registrar may consider a request for a retroactive extension of time [section 47(2) of the Act].

Requests for a retroactive extension of time must:

- be accompanied by the prescribed fee [section 47(2) of the Act, section 14 of the Regulations and Item 1 of the Schedule to the Regulations]; and
- include sufficient facts for the Registrar to determine that the failure of the registered owner to meet its deadline or apply for an extension within the time limit was not reasonably avoidable [Kitchen Craft Connection Ltd v Canada (Registrar of Trademarks) (1991), 36 CPR (3d) 442 (FCTD)].

The Registrar will not grant a retroactive extension of time pursuant to section 47(2) of the Act for taking a step in a section 45 proceeding if the proceeding has already advanced to a subsequent stage.

The Registrar considers that there is no authority to grant a retroactive extension of time under section 47(2) after the Registrar has reached the final decision under section 45(3) of the Act [Re Wolfville Holland Bakery Ltd (1964), 42 CPR 88 (Ex Ct) and Ford Motor Co of Canada Ltd v Registrar of Trade Marks (1977), 36 CPR (2d) 135 (FCTD)].

VIII Decision

The Registrar will render a final decision in writing, in accordance with section 45(3) of the Act, to maintain, amend or expunge the registration. The decision will be sent to the registered owner in accordance with section 45(4) of the Act.

Pursuant to section 45(5) of the Act, the Registrar shall act in accordance with the decision as soon as administratively possible if no appeal is initiated under section 56 of the Act or, if an appeal is initiated, the Registrar will act in accordance with the final judgement given in appeal, as the case may be.

- *We wish to reiterate here that we recommend the use of some notice on the Trademark Database to indicate that a Section 45 proceeding has been discontinued or in the case of a favourable decision, successfully defended or satisfied.*

IX Appeals

The decision of the Registrar to maintain, expunge or amend the registration may be appealed to the Federal Court of Canada [section 56 of the Act]. Appeals must be filed in accordance with the Federal Courts Act and the Federal Courts Rules and filed with the Registrar in accordance with section 56(2) of the Act. See [Service of Documents on the Registrar of Trademarks](#) for further information.

X Madrid protocol registrations

A Registrar initiated section 45 proceeding against a Madrid Protocol Registration will follow the same process as a Registrar initiated section 45 proceeding against a domestic registration as set out above, with an additional step:

In the case of a Madrid Protocol Registration, once a final decision is reached and the appeal period has expired, if the registration is expunged in whole or in part, the International Bureau will be notified pursuant to rule 19 of the Common Regulations.

This practice notice is intended to provide guidance on the Canadian Intellectual Property Office practice and interpretation of relevant legislation. However, in the event of any inconsistency between this notice and the applicable legislation, the legislation must be followed. The provisions of this practice notice are general guidelines only, are not binding in any particular case and are subject to change.

Footnotes

Footnote 1

Section 67(1) of the Act provides that the provisions of the Act do not apply to trademark registrations that were on the Newfoundland register prior to April 1, 1949. Any trademark registered in Newfoundland prior to April 1, 1949 is governed by the laws of Newfoundland as they existed at that time, and pursuant to section 28 of that legislation, rights, once granted by registration, are to continue without limitation.

3. Practice notice on Practice in trademark opposition proceedings

I Correspondence

Correspondence addressed to the Registrar of Trademarks (the Registrar) in respect of an opposition proceeding must follow sections 3-15, 43 and 44 of the Regulations and the Canadian Intellectual Property Office's practice with respect to correspondence procedures. All correspondence relating to an opposition proceeding should:

- be clearly marked "**Attention Opposition Board**";
- include the name of the opponent;
- include the name of the applicant;
- identify the application number; and
- identify the trademark.

Correspondence intended for the Registrar must not relate to more than one application [section 4(1) of the Regulations].

However, in the case of opposition proceedings against related applications (i.e. those that involve the submitting and serving of identical materials in concurrent proceedings with the same parties), parties are permitted to reference more than one application in their correspondence pertaining to the provision of evidence, written representations and hearing requests [section 4(2)(h) of the Regulations]. It is only necessary to submit a single copy of the correspondence and any accompanying documents, if such correspondence and documents are submitted by way of physical delivery. Where a party has submitted a single copy, it is only necessary to serve a single copy. For information on the requirements for serving and submitting documents in electronic form or by electronic means, please consult Electronic Evidence in Opposition and Section 45 proceedings.

- *We appreciate the clarification that evidence and written submissions in related matters when filed physically may be combined. However, electronic submissions require a copy of the evidence and arguments be submitted as a separate transaction for each file in related cases.*
- *It has been recommended that the attention line include a capital O and B in Opposition Board.*
- *Is Electronic evidence in Opposition and Section 45 to be a new Practice Notice?*

Documents, including evidence, submitted to the Registrar are open to the public and cannot be returned to the party that filed them [section 29(1)(f) of the Act].

- *In light of Bill C-86, should we clarify that the evidence is open to public inspection unless a confidentiality order has been granted by the registrar?*

I.1 Requirement to copy other party

After the Registrar has forwarded a copy of the statement of opposition to the applicant under section 38(5) of the Act, a party corresponding with the Registrar must copy the other party, on the same day, with any correspondence sent to the Registrar relating to the opposition, other than a document they are otherwise required to serve [section 44 of the Regulations].

II Pleadings

II.1 Statement of opposition

Any person (opponent) may file a statement of opposition with the Registrar within two months after the advertisement of a trademark application on the Canadian Intellectual Property Office (CIPO) website [section 38(1) of the Act and section 41 of the Regulations]. The date of advertisement will be clearly indicated on the CIPO website.

A statement of opposition must be based on the grounds of opposition set out in section 38(2) of the Act and the grounds must be set out in sufficient detail to enable the applicant to reply thereto [section 38(3)(a) of the Act].

It is the responsibility of the opponent to ensure that each ground of opposition is properly pleaded. The failure to do so may result in a ground of opposition not being considered [Massimo De Berardinis v Decaria Hair Studio (1984), 2 CPR (3d) 319 (TMOB)].

The Registrar's responsibility is only to determine whether the statement of opposition raises one substantial issue for decision and not to ensure that all grounds are properly pleaded [sections 38(4) and 38(5) of the Act].

- *We recommend that it be clarified that a statement of opposition may be based on “one or more of” the grounds of opposition ...*

II.1.1 Joint opponents

A statement of opposition may name any number of persons jointly as opponents.

Where an extension of time to oppose is granted in the name of one person, a subsequently filed statement of opposition may name that person jointly as opponent along with any number of other persons, whether or not they were named in the initial request for the extension of time to oppose.

An opponent, whether a single person or several persons, may appoint a single trademark agent and must provide a single postal address for correspondence [section 6(1) of the Regulations].

II.1.2 Required fee

The fee for filing a statement of opposition is set out in Item 9 of Schedule 1 to the Regulations. If the statement of opposition is not accompanied by payment in full of the prescribed fee, the Registrar will inform the prospective opponent and will not consider the statement of opposition until such payment is received.

II.2 Interlocutory rulings

The applicant may request an interlocutory ruling to strike all or any portion of the opponent's statement of opposition. Such request **must** be made **prior to** the filing and serving of the counter statement [section 38(6) of the Act]. The Registrar will **not** consider interlocutory ruling requests that are filed at the same time as or after the counter statement.

Once a request for an interlocutory ruling has been filed, the Registrar will give the opponent an opportunity to reply and/or request leave to file an amended statement of opposition under section 48 of the Regulations to address the applicant's objections.

A request for an interlocutory ruling will have no effect on the applicant's deadline for filing and serving its counter statement unless the applicant specifically requests an extension of time under section 47 of the Act prior to or at the same time it requests the interlocutory ruling. In such cases, the Registrar will generally grant the applicant a one month extension of time from the date of the interlocutory ruling to file and serve its counter statement.

Once the counter statement has been filed and served, issues concerning striking all or any portion of the opponent's pleadings will only be considered at the decision stage.

Requests for an interlocutory ruling to strike all or any portion of the applicant's counter statement will not be considered.

- *We are thankful for the clarification that the Interlocutory ruling process cannot be used to attack any or all of the applicant's counter statement.*

II.3 Counter statement

Within two months after a copy of the statement of opposition has been forwarded to the applicant, the applicant shall file and serve a counter statement [section 38(7) of the Act and section 47 of the Regulations]. The counter statement need only state that the applicant intends to respond to the opposition.

A trademark application will be **deemed abandoned** under section 38(11) of the Act if the applicant does not **file and serve** its counter statement within the time prescribed by section 47 of the Regulations.

III Service in opposition proceedings

This section is intended to cover service requirements in general. For more detailed information on service requirements for electronically filed evidence, please consult Electronic Evidence in Opposition and Section 45 Proceedings.

- *We request clarification as to whether Electronic Evidence in Opposition and Section 45 Proceedings refers to a new or intended Practice Notice.*

III.1 Service on representative of the applicant

If an applicant has not appointed a trademark agent in Canada, they may set out the name and address in Canada of a person on whom or a firm on which service of any document in respect of an opposition may be made by:

- providing such information in their counter statement; or
 - filing with the Registrar and serving on the opponent a separate notice setting out this information [section 45 of the Regulations].
- *May the 'person' in Canada be a non-lawyer or non-agent and represent a party in these proceedings before the Board?*

III.2 Service on trademark agent

If a party to be served appoints a trademark agent that resides in Canada in respect of an opposition proceeding, service must be effected on that agent unless the parties agree otherwise [section 46(2) of the Regulations].

III.3 Manner of service

Service can be effected **in any manner that is agreed to by the parties**, including by electronic means [section 46(1)(e) of the Regulations]. This option is available regardless of whether the party being served has an address in Canada.

In the absence of the parties agreeing to service in any other manner, and where the party seeking to effect service has the information necessary to do so, service of a document must be effected by:

- personal service;
 - registered mail; or
 - courier.
- *The Board previously clarified that no "pre-arranged consent" is required for the above manners of service.*

[sections 46(1)(a) to (c) of the Regulations]

In the absence of the parties agreeing to service in any other manner, and where the party effecting service **does not have** the necessary information to serve the other party by personal service, registered mail or courier, service must be effected by:

- the sending of a notice to the other party advising that the document to be served has been filed with or provided to the Registrar [section 46(1)(d) of the Regulations].

- *We support the broadening of this provision beyond situations where the party being served does not have an address in Canada to include situations where the party effecting service does not have the necessary information to serve the other party.*

III.3.1 Personal service

If the party being served is **represented by a trademark agent**, the Registrar considers that a document can be served by personal service by:

- leaving a copy of the document with the agent or an employee of the agent at the agent's office.

If the party being served is **self-represented**, the Registrar considers that a document can be served by personal service by:

- hand delivering a copy of the document to the party being served;
 - if the address of record for the party being served is a place of business, leaving a copy of the document with an employee of the business at the address of record for the party being served; or
 - if the address of record for the party being served is a residence, leaving a copy of the document with an adult at that address and mailing a copy of the document to the postal address of record for the party being served.
- *We support the addition of the mailing requirement when service is effected at a residence.*

III.3.2 Registered mail

Registered mail is a service offered by Canada Post to customers that includes proof of mailing and/or proof of delivery. The service secures the signature of the party being served or the party's representative or appointed agent and provides the serving party with either a print-out of tracking information or a mailing receipt showing the date the document was provided to Canada Post.

The Registrar considers any service by Canada Post that provides the tracking of a document or requires signature on delivery (including, for example, XpressPost) to fall within the definition of service by registered mail [Biogen Idec Ma Inc v Canada (Attorney General), 2016 FC 517].

- *We support the amendments made to this section to broaden the possible services which provide tracking or signature of delivery by Canada Post.*

III.3.3 Courier

Courier is a third-party service other than registered mail which provides confirmation of receipt of a document for delivery, personal delivery and proof of delivery.

III.3.4 Sending a notice

Parties effecting service by the sending of a notice may do so by regular mail, registered mail or courier to the address of record for the party being served on the same date that they filed with or provided to the Registrar the document to be served. This will enable the Registrar to confirm that service was made on the correct party if the Registrar requests proof of service under section 46(9) of the Regulations.

Such notice should identify the proceeding, the parties to the proceeding and each of the documents filed with the Registrar. The date on which the documents were filed with the Registrar should also be indicated.

If contacted by the party being served by sending of a notice, the serving party is encouraged to provide a copy of any documents referred to in the notice to the party being served. Copies of documents may also be obtained by contacting CIPO's Client Service Centre and paying the requisite fee.

III.4 Effective date of service

The effective date of service of a document depends on the manner of service [section 46(3) of the Regulations].

Effective date of service

Manner of service	Effective date of service
Personal service	Day the document is delivered
Registered mail	Day the document is mailed
Courier	Day the document is provided to the courier
Electronic means	Day the document is transmitted*
Notice	Day the notice is sent*

- **for Notice, would sent mean the day the notice is “mailed”?*
- **for Electronic means, is transmitted synonymous with ‘sent’? If I am on the West Coast and send an email on December 3 at 11:59p.m. and the recipient is on Eastern time, is the date of service December 3?*

III.5 Notification to the registrar

A party effecting service in an opposition proceeding **must** notify the Registrar of:

- the manner of service employed; and
- the effective date of service.

[section 46(8) of the Regulations]

Where service of a document in respect of an opposition has been effected in any other manner, pursuant to section 46(1)(e) of the Regulations, the notification to the Registrar should clearly indicate the manner of service (**e.g.** email or facsimile) and indicate that the party being served consented to this manner of service.

Parties are expected to notify the Registrar about the manner and effective date of service of their documents on the other party in their covering letter attached to the documents they submit to the Registrar. For example, the covering letter attached to the documents submitted to the Registrar may state "service effected on the [applicant/opponent] by courier today".

- *We support the addition of the paragraph directly above as an additional clarification of the expected procedure.*
- *We understand that if consent is required but not indicated, the Board will ask the other side to confirm their consent. If they did not, the party serving will be required to file a request for delay under 47(2) to serve another way ie., personal service, registered mail or courier.*

III.6 Proof of service

The Registrar may request proof of service of a document in an opposition proceeding, for example, in situations where there is a dispute between the parties with respect to whether service was effected [section 46(9) of the Regulations].

Such proof must be provided **within one month** from the date of the Registrar's request. If it is not provided within that time period, the document **will be deemed not to have been served**. Deadlines will not be suspended when proof of service is requested.

The proof of service required under section 46(9) of the Regulations will depend on the manner of service. The following will generally be accepted by the Registrar as proof of service:

Proof of service

Manner of service Acceptable proof of service

Personal service in Canada	Affidavit of service from the individual effecting service, indicating: i) how service was effected; ii) who was served; and iii) the date of service; or other proof of service in accordance with the rules of civil procedure in the province in which service took place.
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Proof of service

Manner of service Acceptable proof of service

Registered mail	Print-out of tracking information or copy of receipt showing date of delivery to Canada Post.
Courier	Print-out of tracking information or copy of courier slip showing date of delivery to courier.
Notice under section 46(1)(d)	Signed statement from the serving party indicating the date and manner the notice was sent (e.g. regular mail, registered mail or courier). Footnote 1
Electronic means	<p>Facsimile: Copy of the confirmation of facsimile transmission indicating: i) the fax number of the serving party; ii) the fax number of the party being served; iii) the date and time of the transmission; and iv) the total number of pages transmitted (including cover page).</p> <p>Email: Copy of sent email (excluding attachments), indicating: i) the name/email address to whom the email was sent; ii) the name/email address from whom the email was sent; and iii) the time and date the email was sent.</p>

- *We understand there is no time limit on when proof may be requested and parties should be encouraged to maintain records on “service” throughout the proceeding.*

III.7 Irregular service

The Registrar will consider a document to have been validly served if the Registrar determines that it has been provided to the party being served [section 46(10) of the Regulations]. The effective date of service will be the day on which the document was provided to the party being served. The Registrar will confirm what it considers as the effective date of service at the time that it informs the parties of its determination.

If there is a lengthy delay between the time the document was provided to a party being served and the time the document came to the relevant person's attention, or between the date the document is provided to the party being served and the date the Registrar makes its determination under section 46(10) of the Regulations, the Registrar may consider granting an extension of time to the party being served for taking the next step.

- *Please confirm that “consent” is not required for irregular service. We must simply prove the party received it. Will a party need to explain why it didn't come to their immediate attention?*

IV Evidence

In general, the rules of evidence which are applicable in the Federal Court are applicable in opposition proceedings. While rulings on evidentiary matters will only be made at the decision stage and not during the course of an opposition proceeding, technical objections to the manner of submitting evidence should be made at the earliest opportunity.

IV.1 Timing

The opponent's deadline to submit and serve its evidence (or a statement that it does not wish to submit evidence) is four months from the effective date of service of the applicant's counter statement [section 50 of the Regulations].

The applicant's deadline to submit and serve its evidence (or a statement that it does not wish to submit evidence) is four months from the effective date of service of the opponent's evidence or statement [section 52 of the Regulations].

The opponent's deadline to submit and serve evidence in reply (if any) is one month from the effective date of service of the applicant's evidence or statement [section 54 of the Regulations].

IV.2 Manner of submitting evidence

Evidence must be submitted to the Registrar by way of affidavit or statutory declaration. If the evidence consists of a document or extract from a document that is in the official custody of the Registrar, 'it may be submitted by way of a certified copy [section 49 of the Regulations and section 54(1) of the Act].

- *We support the new title of this section.*
- *We confirm that the Board has previously clarified that certified copies are only required under Section 54 of the Act. State of the register evidence does not require certification.*

IV.2.1 Evidence submitted in electronic form or by electronic means

Section 64(1) of the Act provides that any document, information or fee that is provided to the Registrar may be provided in electronic form and by electronic means as specified by the Registrar. This includes evidence. The form and means by which evidence may be electronically provided to the Registrar are set out in Electronic Evidence in Opposition and Section 45 Proceedings.

IV.3 Partial evidence

Since deadlines are calculated from effective dates of service, a party that plans to submit and serve its evidence **in part** prior to its evidence deadline should notify the Registrar and the other party in its cover letter that the initial evidence being submitted and served is partial evidence. In the absence of any indication to the contrary at the time the party submits its evidence, the Registrar will assume that it constitutes the whole of its evidence.

IV.4 Consequences for failure to submit and serve evidence

An application **will be deemed abandoned** under section 38(11) of the Act if the applicant does not submit and serve either evidence or a statement that the applicant does not wish to submit evidence within the prescribed time [section 53 of the Regulations]. Similarly, an opposition **will be deemed to be withdrawn** under section 38(10) of the Act if the opponent does not submit and serve either evidence or a statement that the opponent does not wish to submit evidence within the prescribed time [section 51 of the Regulations].

A party submitting a statement that it does not wish to submit evidence in accordance with section 50 or section 52 of the Regulations is not precluded from later seeking leave to submit additional evidence pursuant to section 55 of the Regulations. However, such a request will only be granted if it is in the interests of justice to do so (see section V below).

V Leave to amend pleadings or submit additional evidence

The Registrar will grant leave to amend a statement of opposition or counter statement [section 48 of the Regulations] or submit additional evidence [section 55 of the Regulations] if the Registrar is satisfied that it is in the interests of justice to do so having regard to all the surrounding circumstances including:

- the stage the opposition proceeding has reached;
- why the amendment was not made or the evidence not submitted earlier;
- the importance of the amendment or the evidence; and
- the prejudice which will be suffered by either party.

[McDowell v Automatic Princess Holdings, LLC, 2015 FC 980 and Dairy Processors Association of Canada v Dairy Farmers of Canada, 2014 FC 1054]

Requests for leave to amend a statement of opposition or counter statement must be accompanied by an amended statement of opposition or counter statement and the amendments should be clearly indicated with deletions shown in strike-through and additions shown in underline.

Requests for leave to submit additional evidence must be accompanied by at least a draft copy of the affidavit or statutory declaration which is proposed to be submitted.

Once written representations have been requested pursuant to section 57(1) of the Regulations, a request for leave to submit additional evidence must be accompanied by an indication that the affiant or declarant will be made available for cross-examination at the request of the other party.

A copy of a request for leave, together with a copy of the amended statement of opposition or counter statement or the affidavit or statutory declaration which is proposed to be submitted, must be sent to the other party. If the other party raises no objection to the request for leave, it will likely be granted.

VI Amended applications

Correspondence requesting that an application be amended must specifically identify the changes being made to the application. If the goods and/or services are being amended, parties may file an amended application with deletions shown in strike-through and additions shown in underline.

If the applicant's correspondence or amended application fails to clearly identify the requested amendment, the applicant will be asked to identify the specific changes at issue.

VII Cross-examination

Before giving the parties notice that they may file written representations, the Registrar must, on the application of any party and on such terms as the Registrar may direct, order the cross-examination under oath of any deponent on the affidavit/declaration that has been submitted to the Registrar and is being relied on as evidence in the opposition [section 56(1) of the Regulations].

VII.1 Effect of a request for cross-examination on the prescribed deadline for submitting evidence

VII.1.1 Effect on applicant's evidence

The applicant's request for a cross-examination order has no effect on the prescribed deadline for the applicant to submit and serve its evidence. Accordingly, cross-examination orders will specify that they have no effect on any outstanding deadlines.

However, if an applicant's request for a cross-examination order is made within **two months** from the completion of all the section 50 evidence, the applicant may request an extension of time under section 47 of the Act for submitting and serving its section 52 evidence or statement and ask that the extension of time only begin to run from the completion of the cross-examination. If such an extension of time is requested, the Registrar will issue a cross-examination order granting the applicant an extension of time of **four months** from the completion of the cross-examination to submit and serve its section 52 evidence or statement.

If the applicant is in default of completing the cross-examination within the deadline fixed by the Registrar in the order, the four month extension of time to submit and serve its section 52 evidence or statement will be **automatically reduced to two months** from the previously fixed deadline for completing the cross-examination or from the date on which the applicant informs the Registrar that it will not proceed with the cross-examination, whichever is earlier.

VII.1.2 Effect on opponent's reply evidence

If an opponent's request for a cross-examination order is made within **one month** from the completion of all the section 52 evidence, the opponent may request an extension of time under section 47 of the Act for submitting and serving its reply evidence and ask that the extension of

time only begin to run from the completion of the cross-examination. If such an extension of time is requested, the Registrar will issue a cross-examination order granting the opponent an extension of time of **four months** from the completion of the cross-examination to submit and serve its section 54 evidence.

If the opponent is in default of completing the cross-examination within the deadline fixed by the Registrar in the order, the four month extension of time to submit and serve its reply evidence will be **automatically reduced to two months** from the previously fixed deadline for completing the cross-examination or from the date on which the opponent informs the Registrar that it will not proceed with the cross-examination, whichever is earlier.

VII.2 Conducting the cross-examination

Nothing in this practice notice is intended to limit the discretion of the Registrar under section 56 of the Regulations. In this practice notice, references to the Registrar's orders specifying the period to conduct a cross-examination or how it must be conducted are intended as general guidance only. As such, any expressions stating that the Registrar will order certain terms in relation to cross-examination are intended to be interpreted as the Registrar will generally order certain terms in relation to cross-examination.

Both parties are responsible to ensure that the time limits established in the cross-examination order are met. If the cross-examination cannot be arranged by mutual agreement, the Registrar will, on request, set the date, time and location for the cross-examination in accordance with section 56(2) of the Regulations as follows.

Where the deponent resides in Canada

The party requesting the cross-examination order will:

- conduct the cross-examination at the place of business of the party whose deponent is being cross-examined or at the office of their trademark agent in Canada;
- pay all expenses incurred in having its trademark agent present at the place where the deponent is being cross-examined; and
- bear the cost of all expenses necessary with respect to the cross-examination including the hiring of a reporter and the preparation and delivery of a copy of the transcript to the Registrar and service of it on the other party.

The party whose deponent is being cross-examined will:

- pay all expenses incurred in having its deponent and trademark agent present at the place where the deponent is being cross-examined, and the preparation and delivery of a copy of its responses to undertakings to the Registrar and service of the responses to undertakings on the other party.

Where the deponent resides outside of Canada or the parties are unable to come to an agreement concerning cross-examination in Canada

The deponent will be made available for cross-examination in Canada and the party whose deponent is being cross-examined will pay all expenses incurred in making their deponent

available in Canada. Once the deponent is made available in Canada, the cross-examination and the costs associated therewith will be handled in the same manner as described above with respect to the cross-examination of a deponent residing in Canada.

VII.2.1 Conducting the cross-examination by video conference or other electronic means

While personal attendance is the preferred method of cross-examination, the parties may agree to conduct cross-examination by video conference or other electronic means. In the absence of agreement, the Registrar will order that cross-examination take place by video conference where the balance of convenience favours this method. In deciding whether or not to order that cross-examination take place by video conference, the Registrar will have regard to the following:

- the importance of the affiant's evidence to the determination of the issues in the opposition;
 - the location and personal circumstances of the affiant including whether an affiant is unable to attend in person because of infirmity, illness or any other reason;
 - the costs that would be incurred if an affiant had to be physically present;
 - the costs that would be incurred if cross-examination by video conference is ordered; and
 - the prejudice to the parties, including whether prejudice could arise from practical difficulties which could undermine the ability of a party to conduct a full cross-examination.
- *The Board has previously confirmed that this new test represents a change in policy.*

Requests of this nature are not limited to cases where the deponent resides outside of Canada.

All other costs associated with the cross-examination shall be handled in the same manner as described above with respect to the cross-examination of a deponent residing in Canada.

Where cross-examination by video conference cannot be completed due to technical issues, a second order for cross-examination may be requested.

VII.3 Service requirements – transcripts and undertakings

Parties are required to submit documents to the Registrar and serve documents related to a cross-examination on each other sequentially as follows [section 56(3) of the Regulations].

The party who conducted the cross-examination:

- must submit to the Registrar and serve on the other party the transcript and the exhibits of the cross-examination; and

The party that was cross-examined:

- must submit to the Registrar and serve on the other party any information, document or material that they undertook to provide in the course of the cross-examination.

Each party's respective deadline will be specified by the Registrar in the cross-examination order.

VII.4 Failure to comply with cross-examination submitting and service requirements

VII.4.1 Failure to submit and serve transcript

If the party who conducted the cross-examination does not submit and serve the cross-examination transcript, the other party can request a copy of the transcript from the reporter and request leave to submit it as additional evidence under section 55 of the Regulations.

VII.4.2 Failure to submit and serve undertakings

The Registrar will not make rulings during the course of an opposition as to whether certain questions asked in cross-examination should be answered or whether answers given are adequate.

Failure to answer proper questions or submit and serve undertakings may, however, result in negative inferences being drawn or in the affidavit or statutory declaration being ignored at the decision stage [Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd (1984), 3 CPR (3d) 325 at 332 (TMOB)].

VII.5 Inadmissibility of affidavit or statutory declaration

Failure by the deponent to attend a cross-examination shall result in the affidavit or statutory declaration not being part of the evidence [section 56(4) of the Regulations].

VIII Written representations

The Registrar will give the parties notice that they may submit and serve written representations sequentially after the reply evidence stage has closed [section 57 of the Regulations].

If the parties are awaiting a ruling on a request for leave to file additional evidence or for cross-examination to be completed, the Registrar may consider granting an extension of time for a party to submit and serve written representations on this basis.

Parties who do not submit and serve written representations by the prescribed deadline may still request to be heard.

VIII.1 Opponent

The time within which the opponent may submit and serve its written representations or statement that no representations will be submitted (statement) is **two months** from the date of the Registrar's notice inviting parties to submit and serve written representations [section 57(2) to section 57(4) of the Regulations].

VIII.2 Applicant

The time within which the applicant may submit and serve its written representations (or statement) is as follows [section 57(5) to section 57(7) of the Regulations].

Where the opponent **has** submitted and served written representations (or a statement) within the prescribed time:

- **two months** from the effective date of service of the opponent's written representations (or statement).

Where the opponent **has not** submitted and served written representations (or a statement) within the prescribed time:

- **two months** from the expiry of the opponent's deadline to submit and serve its written representations.

IX Hearings

A party may **only** make representations at a hearing if they file a request to be heard in accordance with the requirements set out in section 58(1) of the Regulations.

A party's request to be heard may be conditional on the other party also requesting to be heard, as long as the information required is set out in the request and the request is filed within the prescribed time [section 58(1) of the Regulations]. If both parties file requests to be heard that are conditional on the other party also requesting to be heard, a hearing will not be scheduled and a decision will be issued.

- *We support the additional clarification that the receipt of two conditional Hearing Requests equals "no Hearing".*

IX.1 Timing

The time within which a party must give the Registrar written notice of its request to be heard is as follows [section 58(1) of the Regulations].

Where the applicant **has** submitted and served its written representations (or statement) on the opponent within the prescribed time:

- **one month** from the effective date of service of the applicant's written representations (or statement).

Where the applicant **has not** submitted and served its written representations (or statement) on the opponent:

- **one month** from the expiry of the applicant's deadline to submit and serve its written representations.

IX.2 Request for hearing

The request to be heard must specify the following information:

- whether the party wishes to make representations in person, by telephone, or by video conference (if feasible, as determined by the Registrar on a case by case basis);
- whether the party will make representations in English or French;
- whether simultaneous interpretation will be required if the other party to the opposition makes representations in the other official language; and
- as the case may be, the reasons why the party considers it will be necessary for the hearing to last more than two and one half hours.

[sections 58(1)(a) and (b) of the Regulations]

If a party has not furnished the specific information required by the Registrar in its request to be heard as detailed above, the Registrar will assume that party will appear in person and will schedule the hearing for two and a half hours, with representations to be made in the official language in which the request to be heard was made with no arrangements for simultaneous interpretation.

IX.3 Changes to hearing request

If a party who has requested to be heard wishes to make any changes with respect to their appearance at a scheduled hearing, the party should, as soon as possible and **no less than one month** prior to the scheduled hearing date, communicate such changes by:

- sending confirmation of the changes with respect to their appearance by e-mail (to the email address provided in the hearing confirmation notice); or
- calling the Canadian Intellectual Property Office, Information Branch at 1-866-997-1936 and asking to be transferred to the Trademarks Opposition Board (TMOB); or
- calling TMOB directly at 819-997-7300 and asking to speak to the Case and Hearing Coordinator; and
- sending written confirmation to the Registrar of the changes with respect to their appearance by facsimile or regular mail.

No changes with respect to a hearing will be made until a request is received in writing. While reasonable efforts will be made, the Registrar may not be able to accommodate changes that are requested less than one month before the date of the hearing.

IX.4 Scheduling of hearings

Once the file is ready to be scheduled for a hearing, the Registrar will issue a notice to the parties setting out the time, date, location, manner and duration of the hearing, the official language(s) in which representations will be made, and whether simultaneous translation will be provided, in accordance with the information provided by the parties in their request to be heard.

The Registrar will issue a notice advising parties of scheduled hearing date at least 90 days prior to the hearing date.

IX.4.1 Rescheduling a hearing

The Registrar may reschedule a hearing date **once**, upon request, with consent of the other party as soon as administratively possible. In appropriate circumstances, the Registrar may grant a request to reschedule without consent.

IX.5 Simultaneous interpretation

The Registrar will arrange for any French and English interpreters needed at the hearing. Parties are entitled to make representations in either English or French at the hearing, but must indicate their preference in the request to be heard. The Registrar will provide simultaneous translation in English and/or French, provided that the Registrar has **no less than one month notice** in advance of the scheduled hearing date.

IX.6 Cancellation of hearing

If a party who has requested to be heard no longer wishes to attend a hearing, the party should, as soon as possible, communicate this to the Registrar by:

- sending confirmation of the cancellation by e-mail (to the email address provided in the hearing confirmation notice); or
- calling the Canadian Intellectual Property Office, Information Branch at 1-866-997-1936 and asking to be transferred to the Trademarks Opposition Board (TMOB); or
- calling TMOB directly at 819-997-7300 and asking to speak to the Case and Hearing Coordinator; and
- sending written confirmation to the Registrar of the cancellation by facsimile or regular mail.

If both parties requested a hearing, it will only be cancelled **if both parties consent** to the cancellation. A hearing will not be cancelled until such time as the party or parties' request for cancellation is received in writing.

If a hearing is cancelled, the Registrar will proceed to issue a decision in due course, except in cases where the application has been abandoned or the opposition has been withdrawn.

- *We recommend that this also provide that a party may request cancellation on behalf of both parties as long as the other party is copied and their consent is noted.*

IX.7 Jurisprudence

At the hearing, the Member will have a copy of all case law included in the Common List of Authorities (‘‘Common List’’), which identifies the cases that are frequently cited in opposition and section 45 proceedings.

At least two weeks prior to the hearing date, by facsimile or e-mail parties should provide one another and the Registrar (to the e-mail address provided in the hearing notice) with:

- *Recommend to call out the shortened reference to Common List with quotes*
- their list of case law; and
- copies of any decisions to be relied upon at the hearing which are not available on the Registrar's database of decisions and are otherwise unreported.
- *We support the change of timing from 5 days to two weeks.*

Parties are not required to file books of authorities. If a party wishes the Member to refer at the hearing to any case law that is not identified on the Common List, the party may bring copies to the hearing.

X Extensions of time

Nothing in this practice notice is intended to limit the discretion of the Registrar under section 47 of the Act. In this practice notice, references to circumstances when the Registrar will or will not grant an extension of time and the length of those extensions are intended as general guidance only. As such, any expressions stating that the Registrar will or will not grant an extension of time are intended to be interpreted as the Registrar will generally grant or will generally not grant an extension of time.

Statutory/administrative deadlines and available extensions of time at each stage of the proceeding

Stage of proceeding	Statutory or administrative deadline	Benchmark extension	One cooling off extension for each party	Extensions of time based upon exceptional circumstances
Statement of opposition	2 months from the date of advertisement of application on the website	4 months	Up to 9 months on consent	Determined on a case by case basis
Counter statement	2 months from the date that the Registrar	2 months Footnote 2		

Statutory/administrative deadlines and available extensions of time at each stage of the proceeding

Stage of proceeding	Statutory or administrative deadline	Benchmark extension	One cooling off extension for each party	Extensions of time based upon exceptional circumstances
	forwards statement of opposition			
Opponent's evidence	4 months from the effective date of service of counter statement	Up to 3 months with the other party's consent		
Applicant's evidence	4 months from the effective date of service of opponent's evidence (or statement)	Up to 3 months with the other party's consent		
Cross-examination	Within the period specified by the Registrar in the notice of cross-examination	Up to 4 months with the other party's consent		
Cross-examination replies undertakings	Within the period specified by the Registrar in the notice of cross-examination	Up to 1 month with the other party's consent		
Opponent's reply evidence	1 month from the effective date of service of the applicant's evidence (or statement)	Up to 4 months with the other party's consent		
Opponent's written representations	2 months from the date of the Registrar's notice under section 57(1) of the Regulations	Up to 2 months with the other party's consent	Up to 9 months consent	⁹ Determined on a case by case basis
Applicant's written representations	2 months from the earlier of the effective date of service of the opponent's written representations (or statement) or the expiry of such deadline	Up to 2 months with the other party's consent		
Request hearing	1 month from the earlier of the effective date of service of the applicant's written representations (or statement) or from the expiry of such deadline	Not available	Not available	Not available

All requests for an extension of time of a deadline fixed by the Act or prescribed by the Regulations pursuant to section 47(1) of the Act (statutory deadlines) must be accompanied by the prescribed fee [section 14 of the Regulations and Item 1 of the Schedule of the Schedule to the Regulations].

Requests for extensions of time of deadlines not fixed by the Act or prescribed by the Regulations (administrative deadlines) do not require payment of any fee.

X.1 Extensions of time – benchmarks

Section 47 of the Act is discretionary, allowing the Registrar to grant extensions of time fixed by the Act or prescribed by the Regulations if the Registrar is satisfied that the facts justify the need for an extension of time [Sandhu Singh Hamdard Trust v Canada (Registrar of Trademarks) (2007), 62 CPR (4th) 245 (FCA), affirming 47 CPR (4th) 373 (FCTD)].

The Registrar will only grant **one** request for an extension of time up to each of the benchmarks detailed in the chart above. The Registrar has established benchmarks in order to provide guidance, transparency and fairness with respect to the manner in which the Registrar will exercise discretion under section 47 of the Act with respect to the granting of extensions of time at each stage of opposition proceedings.

The Registrar will not grant more than one request for an extension of time at a particular stage even where such multiple requests amount to the maximum benchmark.

The Registrar will not grant parties extensions of time for requests to be heard.

X.2 Extensions of time – cooling off period

A party facing a deadline that needs to be extended can request an extension of time based on "cooling off" in addition to the benchmark extension.

Statistically, the vast majority of opposition cases settle before the Registrar issues the final decision and the best resolution in any dispute is often a settlement reached by the parties involved [insert link to CIPO website page on Alternative Dispute Resolution]. Accordingly, in an effort to encourage settlement or mediation, the Registrar will grant each party **one** extension of time up to a maximum benchmark of nine months, **on consent**, which may be requested by the applicant or the opponent **at any stage up to and including the filing and serving of the applicant's written representations**.

The Registrar considers that the practice of granting each party an extension of time amounting to the possibility of an eighteen-month cooling off period should provide parties with a reasonable period of time in which to pursue and finalize settlement of the trademark opposition.

If the parties fail to settle the opposition proceeding within the cooling off period, the parties must carry on with the opposition proceeding and comply with the legislative and regulatory requirements whether or not the parties are continuing their settlement negotiations and/or mediation of the opposition.

X.2.1 Opting out of cooling off

When granting a cooling off extension, the Registrar will specify that the extension will be granted until the earlier of 9 months from the original deadline or one month after the consenting party notifies the Registrar in writing that it has withdrawn its consent to the extension of time. The party who requested the cooling off extension may end the cooling off period by taking the necessary step to meet its extended deadline.

X.3 Extensions of time – exceptional circumstances

The Registrar will grant an extension of time beyond the benchmark if the Registrar determines that the party has demonstrated exceptional circumstances justifying a further extension of time.

All requests for an extension of time beyond the maximum benchmark should be clearly marked "**Exceptional circumstances /extension request**".

Following are examples of what the Registrar **may** consider a circumstance justifying a further extension of the time based on exceptional circumstances.

X.3.1 Co-pending opposition proceedings

If there are co-pending opposition proceedings in Canada between the same parties for related trademarks, the Registrar may grant an extension of time beyond the benchmark to synchronize deadlines between the proceedings for completing the same requirement.

X.3.2 Recent change in the party's instructing principal or trademark agent

If there has been a very recent change in a party's instructing principal or trademark agent, the Registrar may grant an extension of time beyond the benchmark allowing the party a reasonable period of time to enable a new trademark agent or instructing principal to become familiar with the file.

X.3.3 Circumstances beyond the control of the person concerned

Examples of factors that could amount to exceptional circumstances beyond the control of the person concerned include illness, accident, death, bankruptcy or other serious and unforeseen circumstances.

X.3.4 Assignment

There has been a recent assignment of either the trademark that is the subject of opposition or a trademark application or registration being relied upon by the opponent in the opposition proceeding.

X.3.5 Revised application

A revised application for the trademark that is the subject of the opposition has been filed with the Registrar and the revision, if accepted, would put an end to the opposition proceeding or substantially change the nature of the opposition proceeding.

- *Recommend the possible clarification “.....and the revision, if accepted by the Registrar,....”*

X.3.6 Finalizing settlement

Either the applicant or the opponent may request one further extension of time in addition to the benchmark and cooling off extensions in order to fully finalize and complete settlement negotiations. While this request can be made by either party, the Registrar will only grant this extension of time once during the course of an opposition proceeding up to a maximum period of three months on consent.

Once either the applicant or the opponent has been granted this extension of time the Registrar will not grant a further extension of time for this purpose to either party at any time during the opposition proceeding.

X.3.7 Circumstances at the cross-examination stage

Subject to the diligence of a party in conducting/completing cross-examination, the following are examples of additional circumstances that may be considered as exceptional at the cross-examination stage:

- the need to schedule multiple cross-examinations;
- waiting for the transcript or replies to undertakings of a recent cross-examination; or
- the terms of the cross-examination order apply to a recently substituted affidavit or statutory declaration.

X.4 Extensions of time – retroactive

If a party is facing a statutory deadline that has already passed, the Registrar may consider a request for a retroactive extension of time [section 47(2) of the Act].

Requests for a retroactive extension of time must:

- be accompanied by the prescribed fee [section 47(2) of the Act, section 14 of the Regulations and Item 1 of the Schedule of the Regulations]; and
- include sufficient facts to satisfy the Registrar that the failure of the party to meet its deadline or apply for an extension within the extended time limit was not reasonably avoidable [Kitchen Craft Connection Ltd v Canada (Registrar of Trade Marks) (1991), 36 CPR (3d) 442 (FCTD)].

The Registrar will not grant a retroactive extension of time pursuant to section 47(2) of the Act in respect of a particular stage of an opposition proceeding if the proceeding has advanced to a subsequent stage.

XI Decision

After considering the evidence and representations of the parties, the Registrar will render a final decision in writing, in accordance with section 38(12) of the Act, to refuse the application, reject the opposition, or refuse the application with respect to one or more of the goods or services specified in it and reject the opposition with respect to the others.

The Registrar will not hold decisions in abeyance or agree not to issue a decision based on consent of the parties and/or pending settlement negotiations.

In the absence of a court order, the Registrar has no authority to stay opposition proceedings pending the outcome of court litigation *Anheuser-Busch Inc v Carling O'Keefe Breweries of Canada Ltd* (1982), 69 CPR (2d) 136 (FCA)].

XII Appeals

The decision of the Registrar under section 38(12) of the Act may be appealed to the Federal Court [section 56 of the Act]. Appeals must be filed in accordance with the Federal Courts Act and the Federal Courts Rules. See [Service of Documents on the Registrar of Trademarks](#) for further information.

This practice notice is intended to provide guidance on the Canadian Intellectual Property Office practice and interpretation of relevant legislation. However, in the event of any inconsistency between this notice and the applicable legislation, the legislation must be followed. The provisions of this practice notice are general guidelines only, are not binding in any particular case and are subject to change.

Footnotes

Footnote 1

Each of the parties is required to have a postal address for correspondence on record with the Registrar [section 31(a) of the Regulations and section 38(3)(b) of the Act]. In order to enable the Registrar to determine that service was made on the correct party, the Registrar will therefore generally only accept a signed statement as proof of service by way of notice under section 46(1)(d), if the notice is sent by regular mail, registered mail or courier to the postal address of record for the party being served.

[Return to footnote 1 referrer](#)

Footnote 2

See also section II.2 Interlocutory Rulings.

4. Practice notice on Practice in section 45 proceedings

I Correspondence

Correspondence addressed to the Registrar in respect of a section 45 proceeding must follow sections 3 to 15, 68 and 69 of the Regulations and the Canadian Intellectual Property Office's practice with respect to correspondence procedures. All correspondence relating to section 45 proceedings should:

- be clearly marked "**Attention: Section 45 Proceedings**";
- identify the name of the registered owner;
- identify either the trademark registration number or the number of the trademark application that resulted in the registration; and
- identify the trademark.

Correspondence intended for the Registrar must not relate to more than one registration [section 4(1) of the Regulations].

However, in the case of section 45 proceedings against related registrations (i.e. those that involve the submitting and serving of identical materials in concurrent proceedings with the same parties), parties are permitted to reference more than one trademark registration in their correspondence pertaining to the provision of evidence, written representations and hearing requests [section 4(2)(h) of the Regulations]. It is only necessary to submit a single copy of the correspondence and any accompanying documents, if such correspondence and documents are submitted by way of physical delivery. Where a party has submitted a single copy, it is only necessary to serve a single copy. For information on the requirements for serving and submitting documents in electronic form or by electronic means, please consult Electronic Evidence in Opposition and Section 45 Proceedings.

- *We appreciate the clarification that evidence and written submissions in related matters when filed physically may be combined. However, electronic submissions require a copy of the evidence and arguments be submitted as a separate transaction for each file in related cases.*
- *It has been recommended that the attention line include a capital S and P for Section 45 Proceedings.*
- *Is Electronic Evidence in Opposition and Section 45 to be a new Practice Notice?*

Documents, including evidence, submitted to the Registrar are open to the public and cannot be returned to the party that filed them [section 29(1)(f) of the Act].

- *In light of Bill C-86, should we clarify that the evidence is open to public inspection unless a confidentiality order has been granted by the registrar?*

I.1 Requirement to copy other party

After the Registrar has forwarded a notice to the registered owner of the trademark under section 45(1) of the Act (Section 45 Notice), a party corresponding with the Registrar must copy the other party on the same day with any correspondence sent to the Registrar relating to the section 45 proceeding other than a document they are otherwise required to serve [section 69 of the Regulations].

II Section 45 notice

II.1 Trademark on the register more than three years

Any person (requesting party) may file a written request asking the Registrar to forward a Section 45 Notice to the registered owner of a trademark that has been registered for a period of three or more years.

Per section 45(1) of the Act, the requesting party may request that the Registrar limit the Section 45 Notice to particular goods or services set out in the registration.

A requesting party need not send a copy of its request to the registered owner of the trademark.

II.1.1 Required fee

A request for the issuance of a Section 45 Notice must be accompanied by payment in full of the prescribed fee as required by section 45(1) of the Act, section 67 of the Regulations, and Item 13 of the Schedule to the Regulations. Where the request is not accompanied by payment in full of the prescribed fee, the Registrar will inform the requesting party and will not issue the Section 45 Notice until such payment is received.

In cases where the Registrar has the authority to issue a Section 45 Notice, but decides not to do so (see section II.1.4 below), a refund will not generally be issued.

II.1.2 Amended registration

Where a registration has been amended to extend the statement of goods or services under section 41 of the Act, the Registrar considers that the three-year period for such goods/services applies **from the date of registration of the amendment**. In that regard, reference may be made to section 41(2) of the Act, which provides that an application to extend the statement of goods/services in respect of which a trademark is registered has the effect of an application for registration of a trademark in respect of the goods or services specified in the application for amendment. Accordingly, a registered owner is **not** required to furnish evidence of use in respect of goods or services that have been listed in a registration for less than three years.

II.1.3 Merged registrations

Where a registration is the result of a merger pursuant to section 41(f) of the Act, the Registrar considers that the three-year period begins on the day the particular goods or services matured to registration. Accordingly, a registered owner is **not** required to furnish evidence of use in respect of goods or services that have been registered for less than three years.

If a registration subject to a Section 45 Notice is merged with another registration, the section 45 proceeding will continue but **only** with respect to the goods and services that were subject to the Section 45 Notice as issued.

II.1.4 Good reasons not to issue the notice

Upon receipt of a written request under section 45 made after three years from the date of registration, the Registrar will issue a Section 45 Notice, unless the Registrar sees good reason for not doing so [Molson Companies Ltd v John Labatt Ltd et al (1984), 1 CPR (3d) 329 (FCTD)].

The Registrar determines whether there are good reasons **not** to issue a Section 45 Notice on a case by case basis. Following are examples of what may be considered good reasons not to issue a Section 45 Notice, depending on the facts of the particular case:

- the trademark registration is already the subject of a section 45 proceeding pending before the Registrar or on appeal;
 - the request is within three years of the date of issuance of a previous Section 45 Notice in cases in which the proceeding led to a final decision under section 45 of the Act; or
 - the Registrar considers that the request is frivolous or vexatious.
- *We acknowledge and support the Board's inclusion of 'vexatious' to bullet 3.*
 - *The Board has removed reference to "registrar-initiated proceedings in the past 3 years which were discontinued"? Is there a reason for this as this does appear in the corresponding registrar-initiated Practice Notice?*
 - *Can the Board define or describe 'frivolous', such as there are facts which indicate that the proceeding against a particular registration would be superfluous?*

II.1.5 No authority to issue the notice

The Registrar will not issue a Section 45 Notice if it has no authority to do so. Following are examples of where the Registrar has no authority to issue a Section 45 Notice:

- the registration has been on the register for less than three years;
- the registration was already expunged or cancelled; or
- the registration was on the Newfoundland register prior to April 1, 1949 . [Footnote 1](#)

II.1.6 Issuance of the section 45 notice

If the Registrar decides to issue the Section 45 Notice, it will be sent to the address of record of the registered owner, with copies to the requesting party and the registered owner's recorded trademark agent in Canada, if any.

The Registrar is **not** responsible for any correspondence **not** received by the registered owner or its trademark agent, including the Section 45 Notice, in cases where the Registrar has **not** been notified of a change of address [section 6(2) of the Regulations].

III Service in section 45 proceedings

This section is intended to cover service requirements in general. For more detailed information on service requirements for electronically filed evidence, please consult Electronic Evidence in Opposition and Section 45 Proceedings.

- *Is Electronic Evidence in Opposition and Section 45 a new or intended new Practice Notice?*

III.1 Service on representative of party

If a party to a section 45 proceeding has not appointed a trademark agent in Canada, that party may file with the Registrar and serve on the other party, a notice setting out the name and address in Canada of a person on whom or a firm on which service of any document may be made in respect of the proceeding [section 70 of the Regulations].

- *May the 'person' in Canada be a non-lawyer or non-agent and represent a party in these proceedings before the Board?*

III.2 Service on trademark agent

If a party to be served appoints a trademark agent that resides in Canada in respect of a section 45 proceeding, service must be effected on that agent unless the parties agree otherwise [section 71(2) of the Regulations].

III.3 Manner of service

Service can be effected **in any manner that is agreed to by the parties**, including by electronic means [section 71(1)(e) of the Regulations]. This option is available regardless of whether the party being served has an address in Canada.

In the absence of the parties agreeing to service in any other manner, and where the party seeking to effect service has the information necessary to do so, service of a document must be effected by:

- personal service;
- registered mail; or
- courier.

[sections 71(1)(a) to (c) of the Regulations]

In the absence of the parties agreeing to service in any other manner, and where the party effecting service **does not have** the necessary information to serve the other party by personal service, registered mail or courier, service must be effected by:

- the sending of a notice to the other party advising that the document to be served has been submitted with or provided to the Registrar [section 71(1)(d) of the Regulations].
- *We support the broadening of this provision beyond situations where the party being served does not have an address in Canada to indicate situations where the party effecting service does not have the necessary information to serve the other party.*

III.3.1 Personal service

If the party being served is **represented by a trademark agent**, the Registrar considers that a document can be served by personal service by:

- leaving a copy of the document with the agent or an employee of the agent at the agent's office.

If the party being served is **self-represented**, the Registrar considers that a document can be served by personal service by:

- hand delivering a copy of the document to the party being served;
- if the address of record for the party being served is a place of business, leaving a copy of the document with an employee of the business at the address of record for the party being served; or
- if the address of record for the party being served is a residence, leaving a copy of the document with an adult at that address and mailing a copy of the document to the postal address of record for the party being served.
- *We support the addition of the mailing requirement when service is effected at a residence.*

III.3.2 Registered mail

Registered mail is a service offered by Canada Post to customers who require proof of mailing and/or proof of delivery. The service secures the signature of the party being served or of the party's representative or appointed agent and provides the serving party with either a print-out of tracking information or a mailing receipt showing the date the document was provided to Canada Post.

The Registrar considers any service by Canada Post that provides the tracking of a document or requires signature on delivery (including, for example, **XpressPost**) to fall within the definition of service by registered mail [Biogen Idec Ma Inc v Canada (Attorney General), 2016 FC 517].

- *We support the amendments made to this section to broaden to other services which provide tracking or signature of delivery by Canada Post.*

III.3.3 Courier

Courier is a third-party service other than registered mail which provides confirmation of receipt of a document for delivery, personal delivery and proof of delivery.

III.3.4 Sending a notice

Parties effecting service by the sending of a notice may do so by regular mail, registered mail or courier to the address of record for the party being served on the same date that they filed with or provided to the Registrar the document to be served. This will enable the Registrar to confirm that service was made on the correct party if the Registrar requests proof of service under section 71(9) of the Regulations.

Such notice should identify the proceeding, the parties to the proceeding and each of the documents filed with the Registrar. The date on which the documents were filed with the Registrar should also be indicated.

If contacted by the party being served by sending of a notice, the serving party is encouraged to provide a copy of any documents referred to in the notice to the party being served. Copies of documents may also be obtained by contacting CIPO's Client Service Centre and paying the requisite fee.

III.4 Effective date of service

The effective date of service of a document depends on the manner of service [section 71(3) of the Regulations].

Effective date of service	
Manner of service	Effective date of service
Personal service	Day the document is delivered
Registered mail	Day the document is mailed
Courier	Day the document is delivered to the courier
Electronic means	Day the document is transmitted
Notice	Day the notice is sent

- **for Notice, would “sent” mean the day the notice is “mailed”?*
- **for Electronic means, is “transmitted” synonymous with ‘sent’? If I am on the West Coast and send an email on December 3 at 11:59p.m. and the recipient is on Eastern time, is the date of service December 3?*

III.5 Notification to the registrar

A party effecting service in a section 45 proceeding **must** notify the Registrar of:

- the manner of service employed; and
- the effective date of service.

[section 71(8) of the Regulations]

Where service of a document in respect of a section 45 proceeding has been effected in any other manner, pursuant to section 71(1)(e) of the Regulations, the notification to the Registrar should clearly indicate the manner of service (**e.g.** email or facsimile) and indicate that the party being served consented to this manner of service.

Parties are expected to notify the Registrar about the manner and effective date of service of their documents on the other party in their covering letter attached to the documents they submit to the Registrar. For example, the covering letter attached to the documents submitted to the Registrar may state "service effected on the [requesting party/registered owner] by courier today".

III.6 Proof of service

The Registrar may request proof of service of a document in a section 45 proceeding, for example, in situations where there is a dispute between the parties with respect to whether service was effected [section 71(9) of the Regulations].

Such proof must be provided **within one month** from the date of the Registrar's request. If it is not provided within that time period, the document **will be deemed not to have been served**. Deadlines will not be suspended when proof of service is requested.

The proof of service required under section 71(9) of the Regulations will depend on the manner of service. The following will generally be accepted by the Registrar as proof of service:

Proof of service

Manner of service	Proof of service
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Personal service in canada	Affidavit of service from the individual effecting service, indicating: i) how service was effected; ii) who was served; and iii) the date of service; or other proof of service in accordance with the rules of civil procedure in the province in which service took place.
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Registered mail (or equivalent service)	(or) Print-out of tracking information or copy of receipt showing date of delivery to Canada Post.
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Proof of service

Manner of service	Proof of service
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Courier	Print-out of tracking information or copy of courier slip showing date of delivery to courier.
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Notice under section 71(1)(d)	Signed statement from the serving party indicating the date and manner the notice was sent (e.g. regular mail, registered mail or courier). Footnote 2
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Facsimile: Copy of the confirmation of facsimile transmission indicating: i) the fax number of the serving party; ii) the fax number of the party being served; iii) the date and time of the transmission; and iv) the total number of pages transmitted (including cover page).

Electronic means	Email: Copy of sent email (excluding attachments), indicating: i) the name/email address to whom the email was sent; ii) the name/email address from whom the email was sent; and iii) the time and date the email was sent.
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III.7 Irregular service

The Registrar will consider a document to have been validly served if the Registrar determines that it has been provided to the party being served [section 71(10) of the Regulations]. The effective date of service will be the day on which the document was provided to the party being served. The Registrar will confirm what it considers as the effective date of service at the time that it informs the parties of its determination.

If there is a lengthy delay between the time the document was provided to a party and the time the document came to the relevant person's attention, or between the date the document is provided to the party being served and the date the Registrar makes its determination under section 71(10) of the Regulations, the Registrar may consider granting an extension of time to the party being served for taking the next step.

IV Evidence

In general, the rules of evidence which are applicable in the Federal Court are applicable in section 45 proceedings. While rulings on evidentiary matters will only be made at the decision stage and not during the course of a section 45 proceeding, technical objections to the manner of submitting evidence should be made at the earliest opportunity.

IV.1 Timing

The registered owner must furnish and serve evidence within **three months** from the date of the Section 45 Notice [section 45(1) of the Act and section 72 of the Regulations].

IV.2 Manner of submitting evidence

Evidence must be submitted to the Registrar by way of affidavit or statutory declaration [section 45(2) of the Act]. More than one affidavit or statutory declaration may be furnished on behalf of the registered owner, regardless of whether the affidavit or statutory declaration is signed by the registered owner [Canada (Registrar of Trademarks) v Harris Knitting Mills Ltd (1985), 4 CPR (3d) 488 (FCA)].

IV.2.1 Evidence submitted in electronic form or by electronic means

Section 64(1) of the Act provides that any document, information or fee that is provided to the Registrar may be provided in electronic form and by electronic means as specified by the Registrar. This includes evidence. The form and means by which evidence may be electronically provided to the Registrar are set out in Electronic Evidence in Opposition and Section 45 Proceedings.

IV.3 Evidence of use of the registered trademark

The evidence furnished in response to the Section 45 Notice should demonstrate:

- use of the registered trademark in Canada at any time during the three-year period **immediately** preceding the date of the Section 45 Notice (the relevant period) with respect to each of the registration's goods or services specified in the Section 45 Notice; and, if not,
- the date when the registered trademark was last used in Canada and the reason(s) for the absence of use since that date.

[section 45(1) of the Act]

The relevant definitions of "use" are set out in section 4 of the Act.

The evidence must **show** use of the trademark by the registered owner or an assignee entitled to be recorded as registered owner *Star-Kist Foods Inc v Canada (Registrar of Trademarks) (1988), 20 CPR (3d) 46 (FCA)*], licensed use of the trademark pursuant to section 50 of the Act, or licensed use of a certification mark pursuant to section 23(2) of the Act.

The type of evidence necessary to show use varies from case to case [*Union Electric Supply Co Ltd v Registrar of Trademarks (1982), 63 CPR (2d) 56 (FCTD)*]. However, the use of the trademark must be in compliance with section 4 of the Act and must be shown with respect to each of the goods and services listed in the registration or specified in the Section 45 Notice [section 45(1) of the Act].

The affidavit or statutory declaration must contain sufficient facts to support a conclusion that the trademark has been used in Canada, as opposed to containing bare assertions of use, which have been held to be insufficient to maintain a trademark registration under section 45 of the Act [*Plough (Canada) Ltd v Aerosol Fillers Inc (1980), 53 CPR (2d) 62 (FCA)*]. The evidence should be forthcoming in quality, not quantity [*Phillip Morris Inc v Imperial Tobacco Ltd (1987), 13 CPR (3d) 289 (FCTD)*].

- *The word 'immediately' does not appear in the companion paragraph in the Registrar Initiated Section 45 Notice.*

IV.4 Evidence of licensed use

Where evidence of use is by a licensee of the registered owner pursuant to section 50 of the Act, it is not necessary to furnish a copy of any license agreement in a section 45 proceeding. A statement in the affidavit or statutory declaration that the registered owner had, under the license, direct or indirect control of the character or the quality of the subject goods or services is sufficient [*Empresa Cubana Del Tabaco v Shapiro Cohen*, 2011 FC 102, affirmed 2011 FCA 340].

IV.5 Evidence of special circumstances excusing non-use

In cases where the trademark was not in use at any time during the relevant period, the affidavit or statutory declaration should indicate the date the trademark was last in use and the reason(s) for the absence of use since that date.

In order for the registration not to be expunged, the Registrar must be satisfied that there were "special circumstances" excusing the absence of use during the relevant period. "Special circumstances" means circumstances or reasons that are unusual, uncommon, or exceptional [*John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD)].

The Registrar will consider all **three** of the following criteria in determining whether the evidence demonstrates special circumstances excusing the absence of use of the trademark in Canada:

- the length of time during which the trademark has not been used;
- whether the reasons for the absence of use were due to circumstances beyond the control of the owner; and
- whether there exists a serious intention to resume use of the trademark shortly.

[*Canada (Registrar of Trade Marks) v Harris Knitting Mills Ltd*, 4 CPR (3d) 488 (FCA) and *Smart & Biggar v Scott Paper Limited* (2008), 65 CPR (4th) 303 (FCA)]

IV.6 Consequences for registered owner's failure to furnish evidence

If the registered owner does not furnish any evidence in response to the Section 45 Notice, the trademark is liable to be expunged i [section 45(3) of the Act].

- *There is a small typographical error after "expunged"*
- *The Board has removed reference to the issuance of a decision. Will you still issue the first notice indicating the registration will be expunged following an administrative two month appeal period?*

IV.7 Consequences for registered owner's failure to serve evidence

If the registered owner does not serve its evidence on the requesting party in compliance with section 71 of the Regulations, the Registrar is not required to consider such evidence, in accordance with section 45(2.2) of the Act.

V No Cross-examination in section 45 proceedings

The Registrar has no authority to order cross-examination on an affidavit or statutory declaration furnished as evidence in a section 45 proceeding [Burke-Robertson v Carhartt Canada Ltd (1994), 56 CPR (3d) 353 (FCTD)].

VI Written representations

The Registrar will give the parties notice that they may submit and serve written representations sequentially after the registered owner has furnished evidence in response to the Section 45 Notice [section 45(2) of the Act and section 73 of the Regulations].

Written representations are **not** required in section 45 proceedings. If neither party submits and serves written representations within the respective deadlines, or requests a hearing, the Registrar will proceed in due course and as soon as administratively possible to issue the final decision.

Parties who do not submit and serve written representations by the prescribed deadline may still request to be heard.

VI.1 Requesting party

The time within which the requesting party may submit and serve its written representations or a statement that no representations will be submitted (statement) is **two months** from the date of the Registrar's notice inviting **parties** (should this be Requesting Party?) to submit and serve written representations [sections 73(4) and (5) of the Regulations].

The deadline to file written representations is two months from the date of the Registrar's notice inviting "parties" to submit written representations. Should this be changed to "inviting the Requesting Party"? What does the second reference to the word "statement" clarify here "a statement that no representations will be submitted (statement)"?

VI.2 Registered owner

The time within which the registered owner may submit and serve its written representations (or statement) is as follows [sections 73(6) and (7) of the Regulations].

Where the requesting party **has** submitted and served written representations (or a statement) within the prescribed time:

- **two months** from the effective date of service of the requesting party's written representations (or statement).

Where the requesting party **has not** submitted and served written representations (or a statement) within the prescribed time:

- **two months** from the expiry of the requesting party's deadline to submit and serve its written representations (or statement).

VII Hearings

A party may **only** make representations at a hearing if they file a request to be heard in accordance with the requirements set out in section 74(1) of the Regulations.

A party's request to be heard may be conditional on the other party also requesting to be heard, as long as the information required is set out in the request and the request is filed within the prescribed time [section 74(2) of the Regulations]. If both parties file requests to be heard that are conditional on the other party also requesting to be heard, a hearing will not be scheduled and a decision will be issued.

- *We support the additional clarification that two conditional Hearing Requests equal “no Hearing”.*

VII.1 Timing

The time within which a party must give the Registrar written notice of its request to be heard is as follows [section 74(2)(b) of the Regulations].

Where the registered owner **has** submitted and served its written representations (or a statement) within the prescribed time:

- **one month** from the effective date of service of the registered owner's written representations (or statement).

Where the registered owner **has not** submitted and served written representations (or statement) within the prescribed time:

- **one month** from the expiry of the registered owner's final deadline to submit and serve its written representations (or statement).

VII.2 Request for hearing

The request to be heard must specify the following information:

- whether the party wishes to make representations in person, by telephone, or by video conference (if feasible, as determined by the Registrar on a case by case basis);
- whether the party will make representations in English or French; and
- whether simultaneous interpretation will be required if the other party to the proceeding makes representations in the other official language.

[section 74(1) of the Regulations]

If a party has not furnished the specific information required by the Registrar in its request to be heard as detailed above, the Registrar will assume that party will appear in person and will schedule the hearing for two and a half hours, with representations to be made in the official language in which the request to be heard was made with no arrangements for simultaneous interpretation.

VII.3 Changes to hearing request

If a party who has requested to be heard wishes to make any changes with respect to their appearance at a scheduled hearing then the party should, as soon as possible and **no less than one month** prior to the scheduled hearing date, communicate such changes by:

- sending confirmation of the changes with respect to their appearance by e-mail (to the email address provided in the hearing confirmation notice); or
- calling the Canadian Intellectual Property Office, Information Branch at 1-866-997-1936 and asking to be transferred to the Trademarks Opposition Board (TMOB); or
- calling TMOB directly at 819-997-7300 and asking to speak to the Case and Hearing Coordinator; and
- sending written confirmation to the Registrar of the changes with respect to their appearance by facsimile or regular mail.

No changes with respect to a hearing will be made until a request is received in writing. While reasonable efforts will be made, the Registrar may not be able to accommodate changes that are requested less than one month before the date of the scheduled hearing.

VII.4 Scheduling of hearings

Once the file is ready to be scheduled for a hearing, the Registrar will issue a notice to the parties setting out the time, date, location, manner and duration of the hearing, the official language(s) in which representations will be made, and whether simultaneous translation will be provided, in accordance with the information provided by the parties in their request to be heard.

The Registrar will issue a notice advising parties of the scheduled hearing date at least 90 days prior to the hearing date.

VII.4.1 Rescheduling a hearing

The Registrar may reschedule a hearing date **once**, upon request, with consent of the other party as soon as administratively possible. In appropriate circumstances, the Registrar may grant a request to reschedule without consent.

VII.5 Simultaneous interpretation

The Registrar will arrange for any French and English interpreters needed at the hearing. Parties are entitled to make representations in either English or French at the hearing, but must indicate their preference in the request to be heard. The Registrar will provide simultaneous translation in English or French, provided that the Registrar has **no less than one month notice** in advance of the scheduled hearing date.

VII.6 Cancellation of hearing

If a party who has requested to be heard no longer wishes to attend a hearing, the party should, as soon as possible, communicate this to the Registrar by:

- sending confirmation of the cancellation e-mail (to the email address provided in the hearing confirmation notice); or
- calling the Canadian Intellectual Property Office, Information Branch at 1-866-997-1936 and asking to be transferred to the Trademarks Opposition Board (TMOB); or
- calling TMOB directly at 819-997-7300 and asking to speak to the Case and Hearing Coordinator; and
- sending written confirmation of the cancellation to the Registrar by facsimile or regular mail.

If both parties requested a hearing, it will only be cancelled **if both parties consent** to the cancellation. A hearing will not be cancelled until such time as the party or parties' request for cancellation is received in writing.

If a hearing is cancelled, the Registrar will proceed to issue a decision in due course, except in cases where the section 45 proceeding has been discontinued on consent or the registration has been voluntarily cancelled or expunged for failure to renew.

- *We recommend that this also provide that a party may request cancellation on behalf of both parties, as long as the other party is copied on the cancellation request and their consent is noted.*

VII.7 Jurisprudence

At the hearing, the Hearing Officer/Member will have a copy of all case law included in the Common List of Authorities (¶Common List¶), which identifies cases that are frequently cited in opposition and section 45 proceedings.

- *Recommend to call out the shortened reference to Common List with quotes*

At least two weeks prior to the hearing date, by facsimile or email, parties should provide one another and the Registrar (to the email address provided in the hearing notice) with:

- their list of case law; and
- copies of any decisions to be relied upon at the hearing that are not available on the Registrar's database of decisions and are otherwise unreported.
- *We support the change of timing from 5 days to two weeks.*

Parties are not required to file books of authorities. If a party wishes the Hearing Officer/Member to refer at the hearing to any case law that is not identified in the Common List, the party may bring copies to the hearing.

VIII Extensions of time

Nothing in this practice notice is intended to limit the discretion of the Registrar under section 47 of the Act. In this practice notice, references to circumstances when the Registrar will or will not grant an extension of time and the length of those extensions are intended as general guidance only. As such, any expressions stating the Registrar will or will not grant an extension of time are intended to be interpreted as the Registrar will generally grant or will generally not grant an extension of time.

Deadlines and available extensions of time at each stage of the proceeding			
Stage of proceeding	Statutory deadline	Benchmark extensions	Extensions of time based upon exceptional circumstances
Registered owner's evidence	3 months from the date of the Section 45 Notice	4 months	Determined on a case by case basis
Requesting party's written representations	2 months from the date of the notice for written representations	Not available	Determined on a case by case basis
Registered owner's written representations	2 months from the earlier of the effective date of service of the requesting party's written representations (or statement) or 2 months from the expiry of such deadline	Not available	Determined on a case by case basis
Request for hearing	1 month from the earlier of the effective date of service of the registered owner's written representations (or statement) or 1	Not available	Not available

Deadlines and available extensions of time at each stage of the proceeding

Stage of proceeding	Statutory deadline	Benchmark extensions	Extensions of time based upon exceptional circumstances
	month from the expiry of such deadline		

Section 47 of the Act is discretionary. It enables the Registrar to grant extensions of time in Section 45 proceedings if the Registrar is satisfied that the facts justify the need for an extension of time [Sandhu Singh Hamdard Trust v Canada (Registrar of Trademarks) (2007), 62 CPR (4th) 245 (FCA), affirming 47 CPR (4th) 373 (FCTD)].

All requests for an extension of time under section 47 of the Act must be accompanied by the prescribed fee [section 14 of the Regulations and Item 1 of the Schedule to the Regulations].

VIII.1 Extensions of time – benchmark

The Registrar will only grant **one** request for an extension of time up to a maximum benchmark of **four months**, for the registered owner **to furnish and serve evidence** in response to a Section 45 Notice. The legislative intent behind section 45 is to provide an efficient and summary procedure for removing trademarks which are not in use from the Register. In view of this, further extensions of time for taking this step will only be granted in exceptional circumstances [see VIII.2 below]. Likewise, extensions of time for taking any other steps in a proceeding will only be granted in exceptional circumstances.

The Registrar will **not** grant more than one request for a benchmark extension of time for a registered owner **to furnish and serve evidence**, even where such multiple requests would only amount to the maximum benchmark of **four months**.

VIII.2 Extensions of time – exceptional circumstances

The Registrar will only grant an extension of time beyond the benchmark for a registered owner to furnish and serve its evidence or grant an extension of time for the parties to submit and serve written representations, if exceptional circumstances have been demonstrated.

The Registrar will not grant an extension of time to extend the deadline for requesting a hearing.

Following are examples of what the Registrar **may** consider exceptional circumstances justifying an extension of the time.

VIII.2.1 Recent change in the party's instructing principal or trademark agent

If there has been a very recent change in the party's instructing principal or trademark agent, the Registrar may grant an extension of time allowing a reasonable period of time to enable the new trademark agent or instructing principal to become familiar with the file.

VIII.2.2 Circumstances beyond the control of the person concerned

Examples of factors that could amount to exceptional circumstances beyond the control of the person concerned include illness, accident, death, bankruptcy or other serious and unforeseen circumstances.

VIII.2.3 Assignment of the registration

If there has been a recent assignment of the registration that is the subject of the section 45 proceeding, the Registrar may grant an extension of time allowing a reasonable period of time to enable the new trademark owner to become familiar with the file.

VIII.2.4 Amendment of the registration

An application to amend the subject registration to delete certain goods or services filed with the Registrar pursuant to section 41(1)(c) of the Act may be considered to be an exceptional circumstance, if the deletion would put an end to the proceeding or substantially change the nature of the proceeding.

VIII.3 Extensions of time – retroactive

If a party is facing a statutory deadline that has already passed, the Registrar may consider a request for a retroactive extension of time [section 47(2) of the Act].

Requests for a retroactive extension of time must:

- be accompanied by the prescribed fee [section 47(2) of the Act, section 14 of the Regulations and Item 1 of the Schedule to the Regulations]; and
- include sufficient facts for the Registrar to determine that the failure of the party to meet its deadline or apply for an extension within the time limit was not reasonably avoidable [Kitchen Craft Connection Ltd v Canada (Registrar of Trademarks) (1991), 36 CPR (3d) 442 (FCTD)].

The Registrar will not grant a retroactive extension of time pursuant to section 47(2) of the Act in respect of a particular stage in a section 45 proceeding if the proceeding has already advanced to a subsequent stage.

The Registrar considers that there is no authority to grant a retroactive extension of time under section 47(2) after the Registrar has reached the final decision under section 45(3) of the Act [Re Wolfville Holland Bakery Ltd (1964), 42 CPR 88 (Ex Ct) and Ford Motor Co of Canada Ltd v Registrar of Trade Marks (1977), 36 CPR (2d) 135 (FCTD)].

IX Discontinuance of section 45 proceedings

If the requesting party does not submit and serve written representations or a request to be heard, the Registrar **may** issue a notice requesting that the parties confirm whether they wish to discontinue the proceeding on consent.

At any time prior to the issuance of the final decision, the Registrar **may** discontinue a section 45 proceeding upon receipt of a request signed by or on behalf of both parties.

In the absence of such consent from both parties, the proceeding will continue through to the decision stage.

X Decision

The Registrar will render a final decision in writing, in accordance with section 45(3) of the Act, to maintain, amend or expunge the registration. The decision will be sent to both the registered owner and the requesting party in accordance with section 45(4) of the Act.

Pursuant to section 45(5) of the Act, the Registrar shall act in accordance with the decision as soon as administratively possible if no appeal is initiated under section 56 of the Act or, if an appeal is initiated, the Registrar will act in accordance with the final judgement given in appeal, as the case may be.

The Registrar will **not** hold decisions in abeyance or agree not to issue a decision based on consent of the parties and/or pending settlement negotiations.

In the absence of a court order, the Registrar has no authority to stay section 45 proceedings pending the outcome of court litigation [*Anheuser-Busch Inc v Carling O'Keefe Breweries of Canada Ltd* (1982), 69 CPR (2d) 136 (FCA)].

XI Appeals

The decision of the Registrar to maintain, expunge or amend the registration may be appealed to the Federal Court [section 56 of the Act]. Appeals must be filed in accordance with the Federal Courts Act and the Federal Courts Rules and filed with the Registrar in accordance with section 56(2) of the Act. See [Service of Documents on the Registrar of Trademarks](#) for further information.

XII Madrid protocol registrations

A section 45 proceeding against a Madrid Protocol Registration will follow the same process as a section 45 proceeding against a domestic registration as set out above, with an additional step:

In the case of a Madrid Protocol Registration, once a final decision is reached and the appeal period has expired, if the registration is expunged in whole or in part, the International Bureau will be notified pursuant to rule 19 of the Common Regulations.

This practice notice is intended to provide guidance on the Canadian Intellectual Property Office practice and interpretation of relevant legislation. However, in the event of any inconsistency between this notice and the applicable legislation, the legislation must be followed. The provisions of this practice notice are general guidelines only, are not binding in any particular case and are subject to change.

Footnotes

Footnote 1

Section 67(1) of the Act provides that the provisions of the Act do not apply to trademark registrations that were on the Newfoundland register prior to April 1, 1949 . Any trademark registered in Newfoundland prior to April 1, 1949 is governed by the trademark laws of Newfoundland as they existed at that time. Such legislation provided that, once granted by registration, trademark rights are to continue without limitation.

[Return to footnote 1 referrer](#)

Footnote 2

Each of the parties is required to have a postal address for correspondence on record with the Registrar [section 31(a) of the Regulations]. In order to enable the Registrar to determine that service was made on the correct party, the Registrar will therefore generally only accept a signed statement as proof of service by way of notice under section 71(1)(d), if the notice is sent by regular mail, registered mail or courier to the postal address of record for the party being served.

5. Practice notice on Divisional applications in opposition

I Introduction

An application may be divided any time after advertisement but before registration, including during the two month period following advertisement, any extended opposition period and after the filing of a statement of opposition, so long as the goods or services divided out are within the scope of the original application as advertised [section 39(1)(b) of the Act]. A divisional application may also be divided in which case section 39 of the Act applies as if that divisional application were an original application [section 39(5) of the Act].

II Use of divisional applications in opposition

The ability to divide applications during opposition allows applicants to move certain goods or services forward when, for example, (i) the opposition involves only some of the goods or services in the original application or (ii) the parties agree that the opposition against some of the goods or services could be settled allowing these goods or services to proceed to registration while the remaining goods or services are subject to opposition. Although the purpose of permitting divisional applications in opposition is, in part, to allow for settlement and subsequent withdrawal of an opposition against some goods or services, the consent of the opponent is not required for the filing of a divisional application.

III Correspondence

An applicant must copy an opponent on any correspondence relating to an opposed application after the filing of a statement of opposition, pursuant to section 44 of the Regulations. This includes the filing of a divisional of an opposed application.

The Registrar will copy an opponent or proposed opponent on correspondence concerning a divisional application. Furthermore, if an application is a divisional application or the corresponding original application to a divisional application, this will be noted on the Canadian Trademarks Database.

- *We support the new reference that divisionals and corresponding original applications to a divisional, will be noted on the Trademark Database.*

IV Any action taken

The general rule is that any action taken in respect of the original application, on or before the day on which the divisional application is filed, is deemed to be an action in respect of the divisional application (section 40(1) of the Regulations). This includes the submission of a statement of opposition and any steps taken in an opposition proceeding such as the submitting of evidence or attendance at a hearing. Section 40(2) of the Regulations sets out exceptions to this general rule, including:

- when a divisional application is filed after the withdrawal or rejection of an opposition; or
- when a divisional application is filed for goods or services deleted from the original application during the two-month period following advertisement.
- *We understand that Bill C-86 brings changes to the filing of divisionals after advertisement to make it mandatory that the divisional be filed on the same day.*

V Procedure followed for divisional applications filed during or after opposition proceedings

Set out below are the procedures that will be followed with respect to divisional applications filed (a) during opposition proceedings and (b) following the withdrawal or rejection of an opposition proceeding. The procedure to be followed in the exceptional case where a divisional application is filed for goods or services removed during the two-month period following advertisement is set out below at VI. A chart summarizing the procedures to be followed appears as Schedule A to this practice notice.

- *We are very grateful for the addition of the summary chart 'Schedule A' now included with this Practice Notice. We understand, however, that the provisions of C-86 which make mandatory the filing of a divisional on the same day following publication may bring changes to that Schedule.*

If a divisional application is filed, the parties may wish to request leave to amend their statement of opposition or counter statement or file additional evidence with respect to the opposition proceeding against the divisional application [see Practice in Trademarks Opposition Proceedings].

V.a Divisional application is filed during an opposition proceeding

This section covers the situation where a divisional application is (i) filed during an opposition proceeding for goods or services within the scope of the corresponding original application on its advertisement date (and is therefore in compliance with section 39(1)(b) of the Act) and (ii) the goods or services in the divisional application were within the scope of the corresponding original application for the two-month opposition period following advertisement (as such the exception set out in section 40(2)(c) of the Regulations does not apply).

In these circumstances pursuant to section 40(1) of the Regulations, all actions taken by the Registrar, an applicant, or an opponent pertaining to the original application are deemed to be taken with respect to the divisional application. For example, the original application and divisional application have the same advertisement date and any statements of opposition filed with respect to the original application apply to the divisional application.

Because all actions pertaining to the original application are deemed to be taken on the divisional application, any deadline outstanding on the original application as a result of actions taken before the filing of the divisional application will also be outstanding on the divisional application. **The parties should take care to monitor any outstanding deadlines on the**

original application and ensure that they also meet them with respect to the divisional application. In situations where a deadline expires between the time the divisional application is filed and it is accepted or where a deadline will expire within three weeks of acceptance of the divisional application, the Registrar will generally use the Registrar's discretion to extend this deadline for a brief period of time and this will be confirmed in writing to the parties once the Registrar has confirmed the acceptance of the divisional and its application number. Finally, the Registrar may also use the Registrar's discretion to align the deadlines for the opposition proceedings against the original application and the divisional application(s) to increase efficiencies for both the parties and the Trademarks Opposition Board.

- *We acknowledge the addition of the final sentence in this last paragraph that the Registrar may use its discretion to align the deadlines for the opposition proceedings against the original and divisional to increase efficiencies.*
- *For the benefit of practitioners generally, we share our previous exchange with the Board regarding the potential scenario set out below in which a request to divide is initiated by an applicant close to its deadline, for any reason, but to potentially gain a timing advantage in the proceeding due to the administrative delay in the administrative processing and acceptance of a divisional:*
 - *In paragraph V.a Divisional Filed During Opposition Proceedings – where a request to divide is initiated close to a deadline or where the deadline will expire within three weeks of acceptance of the Divisional, the Hearing Officer will use its discretion to extend the opposition deadline, which will be confirmed to parties in the Board's letter accepting the Divisional. We acknowledge that the deadline facing the original application remains.*
 - *An applicant may use this provision to gain advantage for a deadline by dividing within one month of an evidence deadline, by way of example. This is particularly relevant where the opponent may have refused consent to an extension of that evidence deadline.*
 - *If, in the Registrar's discretion, the Divisional Application process is being abused by an applicant in an opposition proceeding to frustrate or gain procedural advantage, could we add a stipulation that Registrar may refuse to accept the application to divide? Answer: Section 39 of the Trademarks Act (as amended) provides that an application may be divided if the goods or services in the divisional are within the scope of the original application on its filing date and, if advertised, in the scope of the original application on its advertisement date. Therefore, the Registrar is not in a position to refuse an application to divide on other basis (including the one set forth above).*
- *Further, per the CIPO policy section, the following are the only circumstances in which a divisional will be refused:*

Assuming the correspondence and communications rules are respected (i.e. request is from the applicant or their agent), a divisional application will not be processed if:

 - *The provisions under subsections 39(1) and (2) of the Trademarks Act are not met; or*

- *The provisions under subsections 123(1), (2) and (3) of the Trademarks Regulations are not met with respect to a Protocol Application; or*
- *The applicant attempts, contrary to paragraph 35(2)(d) of the Regulations, to amend an application to add an indication that it is a divisional application; or*
- *The original application is inactive or registered*

Two example scenarios (Scenarios 1 and 2) are set out below:

Scenario 1

- Application for apples, bananas, grapes, oranges, nectarines is advertised on February 1
- Opponent files a statement of opposition forwarded to the applicant on April 1
- Applicant files and serves its counter statement on June 1
- Opponent files and serves its evidence on September 1
- Applicant deletes apples and bananas from the original application and files a divisional application for these goods on September 30
- Registrar accepts the divisional application and confirms its application number; the applicant's deadline to file evidence on the divisional application is the same as its deadline to file evidence on the original application
 - **Original application:** for grapes, oranges, nectarines and the applicant has a deadline of January 1 to submit and serve its evidence or a statement that no evidence will be filed
 - **Divisional application:** for apples, bananas, and the applicant has a deadline of January 1 to submit and serve its evidence or a statement that no evidence will be filed

Scenario 2

- Application for apples, bananas, grapes, oranges, nectarines is advertised on February 1
- Opponent requests a three month extension of time to oppose the application on April 1, the extension is granted on April 3
- Applicant deletes apples and bananas from the original application and files a divisional application for these goods on April 10
- Registrar accepts the divisional application and confirms its application number; the statement of opposition deadline on the divisional application is the same as the original application
 - **Original application:** for grapes, oranges, nectarines and the opponent has a deadline of July 1 to oppose
 - **Divisional application:** for apples, bananas and the opponent has a deadline of July 1 to oppose

V.b Divisional application is filed after the withdrawal or rejection of an opposition proceeding

For divisional applications filed after the withdrawal or rejection of an opposition, actions taken with respect to the original application apply to the divisional application with the exception of the withdrawal or rejection of the opposition. This is because the Registrar needs to confirm that the withdrawal or rejection of the opposition applies to the goods or services in the divisional application.

For a divisional application filed after the withdrawal or rejection of an opposition, the Registrar will review the divisional application and confirm whether the goods or services in the divisional application were within the scope of the application at the time of the withdrawal or rejection of the opposition. If so, the Registrar will generally reject or consider withdrawn the opposition against the divisional application.

If the Registrar is not satisfied that the goods or services in the divisional application were within the scope of the application at the time of the withdrawal or rejection of the opposition, the Registrar will write the opponent to advise that a divisional application has been filed and request that it confirm whether it would like its opposition to continue against the divisional application. If the opponent advises the Registrar that it wishes its opposition to continue against the divisional application, the Registrar will generally set a deadline for the next step in the opposition proceeding.

Two example scenarios (Scenarios 3 and 4) are set out below:

Scenario 3

- Application as advertised: apples, bananas, grapes, oranges, nectarines
- Statement of Opposition and counter statement filed
- Opponent submits its evidence
- Opposition is withdrawn
- Applicant deletes apples and files a divisional application for apples
- Registrar confirms that apples was within the scope of the application on the date the opposition was withdrawn
- Registrar withdraws opposition against apples
 - **Original application:** for bananas, grapes, oranges, nectarines and proceeds to registration
 - **Divisional application:** for apples and proceeds to registration

Scenario 4

- Application as advertised: apples, bananas, grapes, oranges, nectarines
- Statement of Opposition and counter statement filed
- Opponent files its evidence
- Applicant deletes apples
- Opposition is withdrawn
- Prior to registration of the trademark for bananas, grapes, oranges, nectarines, a divisional application is filed for apples

- Registrar confirms that apples was not within the scope of the application on the date the opposition was withdrawn
- Registrar writes opponent to confirm whether it wishes to continue its opposition against the divisional application for apples
- Opponent confirms that it does
- Registrar sets the deadline for the applicant to submit and serve its evidence and the opposition proceeds against the divisional application
 - **Original application:** the original application for bananas, grapes, oranges, nectarines proceeds to registration
 - **Divisional application:** the divisional application for apples remains in opposition and the applicant has a forthcoming deadline to submit and serve its evidence or statement that no evidence will be submitted

VI Divisional application is filed for goods or services removed during the two month period following advertisement

- *We understand that Bill C-86 brings changes to the filing of divisionals after advertisement to make mandatory the requirement to file it same day, which appears to then preclude scenarios 5 and 6 listed below:*

In this exceptional situation, an applicant (i) removes goods or services from its application during the two month period following advertisement and (ii) after this two month period, files a divisional application including goods or services which were outside the scope of the application at the end of the advertisement period. Section 40(2)(c) of the Regulations requires the advertisement of the divisional application since potential opponents have not had two months in which to oppose the goods or services in the divisional application.

Two example scenarios where goods or services are removed during the two-month period following advertisement (Scenarios 5 and 6) are set out below. In each of these cases, the divisional application is advertised since the goods or services did not remain in the original application for the entire two-month period following advertisement.

Scenario 5

- Application for apples, bananas, grapes, oranges, nectarines is advertised on February 1
- Applicant deletes apples on March 1
- Opponent opposes application for bananas, grapes, oranges, nectarines on April 1
- Registrar forwards the statement of opposition on May 1
- Applicant files and serves a counter statement on June 1
- Applicant files a divisional application for apples on August 1
 - **Original application:** the opposition against the original application for bananas, grapes, oranges, nectarines continues and the opponent has a deadline of

- October 1 to submit and serve its evidence or a statement that no evidence will be submitted
- **Divisional application:** the divisional application for apples will be advertised for a two-month period for opposition purposes

Scenario 6

- Application for apples, bananas, grapes, oranges, nectarines is advertised on February 1
- Applicant deletes apples on March 1
- No oppositions or extensions of time to oppose are filed on or before April 1
- Before the original application matures to registration, applicant files a divisional application for apples on April 10
 - **Original application:** the original application for bananas, grapes, oranges, nectarines will proceed to registration
 - **Divisional application:** the divisional application for apples will be advertised for a two-month period for opposition purposes

VII Divisional application is filed after the opposition period is extended but before a statement of opposition is filed

Scenario 7 illustrates when it is **necessary to request a retroactive extension of time** pursuant to section 47(2) of the Act to oppose a divisional application. Specifically, if an extension of time to file a statement of opposition is obtained, goods or services are deleted after the two-month advertisement period, and a divisional application is filed after the extended deadline to oppose where the opponent has not filed a statement of opposition with respect to the original application, should the potential opponent want to oppose the divisional application, it must request a retroactive extension of time. In these circumstances, the Registrar will generally grant the retroactive extension of time request as a potential opponent cannot file a statement of opposition against a good or service which has been deleted from an application. As such, the failure to file the statement of opposition was not reasonably avoidable.

- *We understand that Bill C-86 brings changes to the filing of divisionals after advertisement to make mandatory the requirement to file it same day, which appears to then preclude scenario 7 listed below:*

Scenario 7

- Application for apples, bananas, grapes, oranges, nectarines is advertised on February 1
- Potential opponent requests an extension of time on April 1 to extend the statement of opposition deadline until July 1
- Applicant deletes apples on May 1

- No oppositions or further extensions of time to oppose are filed before or on July 1
- Before the original application matures to registration, applicant files a divisional application for apples on July 10
 - **Original application:** the original application for bananas, grapes, oranges, nectarines will proceed to registration
 - **Divisional application:** the potential opponent will be alerted to the filing of a divisional application for apples; if it wishes to oppose this application it should request a retroactive extension of time to file a statement of opposition
-
- *We understand the below chart will now change in light of Bill C-86 and the requirement to file a divisional on the same day following the advertisement of an application.*

Schedule A

Summary of procedures followed for divisional applications filed after advertisement

When application is filed	divisional	Procedure after the filing of the divisional application
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Divisional filed for goods or services deleted during the two-month period following advertisement		The divisional application will be advertised for opposition since potential opponents have not had two months in which to oppose the goods or services in the divisional application [section 40(2)(c) of the Regulations].
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Divisional is filed after the two-month opposition period has been extended		The divisional application will be subject to the extended opposition period. If the divisional application is filed after the expiry of the extended opposition period, the potential opponent will need to request and obtain a retroactive extension of time to oppose the divisional application pursuant to section 47(2) of the Act.
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Divisional is filed during the opposition (After the filing of a statement of opposition but before the opposition case closes)		All actions taken by the Registrar, an applicant, or an opponent pertaining to the original application are deemed to be taken with respect to the divisional application [section 40(1) of the Regulations].
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Divisional is filed after withdrawal or rejection of opposition		The Registrar will review the divisional application and confirm whether the goods or services in the divisional application were within the scope of the original application at the time of the withdrawal or rejection of the opposition.
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- If so, the Registrar will reject or consider withdrawn the opposition against the divisional application.

Summary of procedures followed for divisional applications filed after advertisement

When a divisional application is filed Procedure after the filing of the divisional application

- If not, the Registrar will write the opponent to advise that a divisional application has been filed and request that it confirm whether it would like its opposition to continue against the divisional application and if necessary grant an extension time.

Divisional registration certificate issued after hasThe request to file a divisional application will not be processed. A divisional application can only be filed prior to registration.

This practice notice is intended to provide guidance on the Canadian Intellectual Property Office practice and interpretation of relevant legislation. In the event of any inconsistency between this notice and the applicable legislation, the legislation must be followed. The provisions of this practice notice are general guidelines only, are not binding in any particular case and are subject to change.