

PROCEDURE BEFORE THE TRADE-MARKS OPPOSITION BOARD AS OF OCTOBER 1, 2007

This practice notice replaces notices that have been previously published in the *Trade-marks Journal*, namely: *Procedure Before the Trade-Marks Opposition Board* published on August 19, 1996, *Review of Statements of Opposition* published on November 8, 2006 and *Service in Opposition Proceedings* published on June 13, 2007. This notice is intended to provide guidance on the Trade-marks Opposition Board practice and interpretation of relevant legislation. The provisions of this practice notice are general guidelines only, are not binding in any particular case and are subject to change. In the event of any inconsistency between this notice and the applicable legislation, the legislation must be followed.

NOTE: Opposition proceedings relating to an application for the registration of a trade-mark that was advertised in the *Trade-marks Journal* before October 1, 2007 shall be conducted in accordance with Rules 39, 41 and 42 of the *Trade-marks Regulations*, previously the *Trade-marks Regulations (1996)*, as they read on September 30, 2007. This means that:

(a) in opposition proceedings to an application **advertised before October 1, 2007**, the prescribed time limit for filing and serving a counter statement pursuant to Rule 39 is one month and the prescribed time limit for filing and serving evidence or a statement pursuant to Rule 41(1) or Rule 42(1) is one month;

(b) in opposition proceedings to an application **advertised on or after October 1, 2007**, the prescribed time limit for filing and serving a counter statement pursuant to Rule 39 is two months and the prescribed time limit for filing and serving evidence or a statement pursuant to Rule 41(1) or Rule 42(1) is four months.

Correspondence

i) In accordance with Rule 35 of the *Trade-marks Regulations* (hereinafter referred to as "the Regulations"), all correspondence relating to an opposition proceeding should be clearly marked "ATTENTION OPPOSITION BOARD".

ii) In accordance with Rule 36 of the Regulations, after the Registrar has forwarded a copy of the statement of opposition to the applicant, a copy of all correspondence to the Registrar relating to an opposition, with the exception of written arguments filed pursuant to Rule 46(3) of the Regulations, must be sent to the other party. For written arguments, a copy of the cover letter should be sent to the other party.

iii) In accordance with Rule 3(6) of the Regulations, correspondence in respect of an opposition proceeding may be transmitted to the Trade-marks Opposition Board (hereinafter referred to as "the Opposition Board") by facsimile. The Opposition Board facsimile number is: (819) 997-5092.

iv) Rule 3(9) of the Regulations indicates that evidence submitted in respect of an opposition proceeding may not be transmitted by facsimile.

Joint Opponents

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

ii) 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 this/these other person(s) was/were named in the initial request for the extension of time to oppose.

iii) An opponent, whether a single person or several persons, may only appoint a single trade-mark agent, if any.

Review of Statements of Opposition

- i) It is the responsibility of the opponent to ensure that each of its grounds of opposition is properly pleaded. The failure to do so may result in a ground of opposition not being considered: see, e.g., *Massimo De Berardinis v. Decaria Hair Studio* (1984), 2 C.P.R. (3d) 319.
- ii) The responsibility of the Opposition Board pursuant to s. 38(4) and (5) of the *Trade-marks Act* R.C.S. 1985, c. T-13 (hereinafter referred to as “the Act”) is only to determine if the opposition raises one substantial issue for decision and is not to ensure that all grounds are properly pleaded.
- iii) Before filing and serving its counter statement, the applicant may request an interlocutory ruling to strike all or any portion of the opponent’s pleadings (see *Novopharm Limited v. AstraZeneca AB* (2002), 21 C.P.R. (4th) 289 at 294 (F.C.A.)). As a general rule, a request for interlocutory ruling has no effect on any outstanding deadlines. If an applicant requests an extension of time for filing its counter statement in view of a pending request for an interlocutory ruling to strike all or any portion of the opponent’s pleadings, the interlocutory ruling will grant a one-month deadline from the date of the ruling for filing and serving the counter statement.
- iv) The Opposition Board will generally give the opponent the opportunity to reply and/or request leave to file an amended statement of opposition under Rule 40 of the Regulations to respond to the applicant’s objections.
- v) Once evidence has been filed by an opponent in accordance with Rule 41(1) of the Regulations, issues concerning striking all or any portion of the opponent’s pleadings will only be considered at the decision stage.

Extensions of Time

- i) All requests for extensions of time prescribed by the Act or the Regulations must be accompanied by the prescribed fee.
- ii) No request for an extension of time pursuant to s. 47(1) of the Act will be granted unless a sufficient reason is given to explain why additional time is needed.
- iii) No request for a retroactive extension of time pursuant to s. 47(2) of the Act will be granted unless facts are set forth to justify the conclusion that the failure to do the act or to apply for an extension within the time limit was not reasonably avoidable.
- iv) When an initial extension of time is being requested to file a statement of opposition, the date the trade-mark was advertised in the *Trade-marks Journal* should be specified.
- v) A request for an extension of time at a particular stage of an opposition will be considered according to whether the opposition proceeding concerns a trade-mark application advertised in the *Trade-marks Journal*:
 - (a) on or after October 1, 2007 - see Column A below; or
 - (b) before October 1, 2007 - see Column B below.

In the case of a trade-mark application advertised in the *Trade-marks Journal* before October 1, 2007 (Column B), a request for an extension of time will be considered according to whether the applicant or opponent, as the case may be, is seeking to extend the initial time limit prescribed by the Act or the Regulations (“Initial Deadline”) or seeking to extend a deadline for which a non-final extension of time has already been granted (“Extended Deadline”). The following standard lengths of extensions of time identified below will generally be granted:

Column A

Opposition proceedings relating to a trade-mark application advertised in the *Trade-marks Journal* on or after October 1, 2007

Filing a statement of opposition

3 months with sufficient reason(s) + 2 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown.

Filing a counter statement

2 months with sufficient reason(s).

Filing evidence pursuant to Rule 41(1) or Rule 42(1) of the Regulations

2 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown;

or

6 months in view of ongoing settlement negotiations and with the other party's consent.

Column B

Opposition proceedings relating to a trade-mark application advertised in the *Trade-marks Journal* before October 1, 2007

Filing a statement of opposition

Initial Deadline

3 months with sufficient reason(s) + 2 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown.

Extended Deadline

2 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown.

Filing a counter statement

Initial Deadline or Extended Deadline

3 months with sufficient reason(s).

Filing evidence pursuant to Rule 41(1) or Rule 42(1) of the Regulations

Initial Deadline

6 months with sufficient reason(s) + 2 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown;

or

+ 6 months in view of ongoing settlement negotiations and with the other party's consent.

Extended Deadline

2 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown;

or

6 months in view of ongoing settlement negotiations and with the other party's consent.

Column A

Opposition proceedings relating to a trade-mark application advertised in the *Trade-marks Journal* on or after October 1, 2007

Filing evidence pursuant to Rule 43 of the Regulations

4 months with sufficient reason(s) + 2 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown.

Cross-examination order

4 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown

Filing a written argument

4 months with sufficient reason(s) + 4 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown.

Requesting an oral hearing

No request for an extension of the one month delay provided by Rule 46(4) of the Regulations will likely be considered.

vi) It should be noted that having regard to the interests of third parties, once the above-noted extensions of time have been granted, a request for a further extension of time will only likely be granted if exceptional circumstances are shown. The other party's consent to the request for the extension of time will generally not constitute exceptional circumstances sufficient to justify a further extension of time under s. 47(1) of the Act.

vii) A party relying on the consent of the other party need only state that the consent has been given and is not required to file a written consent. If, however, the other party later advises the Opposition Board that it did not in fact give its consent, the extension of time may be revoked.

Column B

Opposition proceedings relating to a trade-mark application advertised in the *Trade-marks Journal* before October 1, 2007

Filing evidence pursuant to Rule 43 of the Regulations

Initial Deadline

4 months with sufficient reason(s) + 2 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown.

Extended Deadline

2 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown.

Cross-examination order

Initial Deadline or Extended Deadline

4 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown

Filing a written argument

Initial Deadline

4 months with sufficient reason(s) + 4 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown.

Extended Deadline

4 months with sufficient reason(s) and the other party's consent or if exceptional circumstances are shown.

Requesting an oral hearing

Initial Deadline or Extended Deadline

2 months with sufficient reason(s).

viii) The Opposition Board will not grant a retroactive extension of time pursuant to s. 47(2) of the Act in respect of a particular stage of an opposition proceeding where the proceeding has advanced to a subsequent stage.

Sections 38(7.1) and 38(7.2) of the Act

In the event that a party requests, but is not granted, an extension of time to comply with Rule 41(1) or Rule 42(1) of the Regulations and no evidence has yet been filed by that party, then that party will be advised that it has three weeks to file and serve a statement that it does not wish to submit evidence pursuant to Rule 41(1) or Rule 42(1) of the Regulations in order to avoid the consequences of s. 38(7.1) or s. 38(7.2) of the Act. The filing of such a statement does not preclude a subsequent request to file evidence pursuant to Rule 44(1) of the Regulations although such a request will only be granted in appropriate circumstances.

Stay of Proceedings

Having regard to the decision of the Federal Court of Appeal in *Anheuser-Busch Inc. v. Carling O'Keefe Breweries* (1982), 69 C.P.R. (2d) 136, the Opposition Board does not consider that it has jurisdiction to stay opposition proceedings.

Evidence

i) In general, the rules of evidence which are applicable in the Federal Court are applicable in opposition proceedings.

ii) Where parties are in agreement that a particular form of evidence should be accepted, the Opposition Board will usually be prepared to accept it.

iii) In general, rulings on evidentiary matters will only be made at the decision stage and not during the course of an opposition proceeding.

Service

Pursuant to Rule 37(1) of the Regulations, any statement or other material required to be served on a party in an opposition proceeding under s. 38 of the Act or under the Regulations may be served by personal service, by registered mail, by courier or in any other manner with the consent of the other party or their trade-mark agent. To comply with Rule 37(6) of the Regulations, a party's correspondence must clearly indicate the method that has been employed for service and the date of such action, in order that the effective date of service may be determined.

Leave pursuant to Rules 40 and 44(1) of the Regulations

i) Leave to amend a statement of opposition or counter statement or to file additional evidence will only be granted if the Opposition Board is satisfied that it is in the interests of justice to do so having regard to all the surrounding circumstances including: a) the stage the opposition proceeding has reached; b) why the amendment was not made or the evidence not filed earlier; c) the importance of the amendment or the evidence; and d) the prejudice which will be suffered by the other party.

ii) 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.

iii) Requests for leave to file additional evidence must be accompanied by at least a draft and preferably a sworn or declared version of the affidavit or statutory declaration which is proposed to be filed.

iv) Once written arguments have been requested pursuant to Rule 46(1) of the Regulations, no request for leave to file additional evidence will be considered unless it is specifically agreed that the affiant or declarant will be made available for cross-examination at the request of the other party.

v) A copy of a request for leave pursuant to Rule 40 or Rule 44(1) of the Regulations, together with a copy of the amended statement of opposition or counter statement or the affidavit or statutory declaration which is proposed to be filed, must be sent to the other party. In general, if the other party raises no objection to the request for leave, it will likely be granted.

vi) In general, a grant of leave under Rule 40 or Rule 44(1) of the Regulations will have no effect on any outstanding deadlines.

Amending Applications

Any letter requesting that an application be amended must specifically identify the changes being made to the application. For example, words to be deleted should be specifically identified in the letter. Ordinarily, a revised application will not be required.

Cross-examination

i) Where a request for cross-examination in respect of an affidavit or statutory declaration filed pursuant to Rule 41(1) of the Regulations is made within **two** months from the completion of all the Rule 41(1) evidence, and the prescribed fee for an extension of time has been submitted, the cross-examination order will specify that the applicant will have four months from the completion of the cross-examination to file its Rule 42(1) evidence or statement. In the case of a cross-examination order issued on or after October 1st, 2007, if the applicant is in default of completing the cross-examination within the fixed deadline, the four-month extension of time to file its Rule 42(1) 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 the earlier.

ii) The above described procedure applies *mutatis mutandis* to orders for cross-examination in respect of Rule 42(1) evidence. Apart from the above, cross-examination orders will, in general, specify that they have no effect on any outstanding deadlines.

iii) The Opposition Board 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, etc. Failure to answer proper questions or to fulfil undertakings may, however, result in negative inferences being drawn or in the affidavit or statutory declaration being ignored at the decision stage: see, e.g., *Seagram v. Seagram* (1984), 3 C.P.R. (3d) 325 at 332.

iv) It is the responsibility of the party requesting the cross-examination 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 Opposition Board will, on request, set up an appointment for the cross-examination generally as follows:

(a) Where the affiant/declarant (the "deponent") resides in Canada: the party requesting the cross-examination order will conduct the cross-examination proceedings at the place of residence of the party being cross-examined. The party requesting the cross-examination will pay all expenses involved in having his trade-mark agent present himself at the place of the deponent and bear the cost of all expenses necessary with respect to the cross-examination procedure including the hiring of a reporter and the preparation and delivery of a copy of the transcript to the Trade-marks Office. The deponent will bear the cost of any expenses incurred by his trade-mark agent and to obtain a copy of the transcript.

(b) Where the deponent resides outside of Canada and where the parties are unable to come to an agreement concerning cross-examination in the deponent's country: the deponent will be made available for cross-examination in Canada at the deponent's expense. Once the deponent is made available in Canada, the costs associated with the cross-examination will be handled in the same manner as described above with respect to the cross-examination of a deponent residing in Canada.

v) Personal attendance is always the preferred method of cross-examination. The Opposition Board may however, on an exceptional basis, consider requests for an order that a cross-examination be conducted other than by personal attendance (e.g. video conferencing or other electronic means). Requests of this nature are not limited to cases where the deponent resides outside of Canada. Each request will be considered on the specific facts presented and whether it is in the interests of justice to issue an order of this nature. All arrangements and costs associated with the set up and operation of the videoconference or other electronic equipment necessary to conduct the cross-examination will be the responsibility of the party requesting such means of cross-examination. 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.

vi) Failure by the deponent to attend a cross-examination may result in the affidavit or statutory declaration being deemed not to be part of the evidence pursuant to Rule 44(5) of the Regulations. If the deponent delays in fulfilling undertakings, the Opposition Board will, on request, set a deadline for the fulfilment of undertakings.

Oral Hearings

i) Due to delays in mail reaching the Opposition Board, the parties are required to telephone the Opposition Board to advise of any postponement or cancellation of an oral hearing. The Opposition Board telephone number is (819) 997-7300. You may also communicate with the Opposition Board by calling the Canadian Intellectual Property Office, Information Branch at 1-866-997-1936 and asking that your call be transferred to the Trade-marks Opposition Board.

ii) The parties are required to fax to one another and to the Opposition Board their list of case law and a copy of any unreported decisions or judgments they intend to rely upon at the hearing at least five working days prior to the hearing date. The Hearing Officer will not have copies of case law at the hearing unless a party provides them.