



March 4, 2011

By Email: darlene.carreau@ic.gc.ca

Ms. Darlene Carreau
Chair, Trade-marks Opposition Board
Canadian Intellectual Property Office
50 Victoria Street, Room 4012
Gatineau, Québec K1A 0C9

Dear Ms. Carreau:

Re: Proposed Amendments to the Trade-marks Regulations Pertaining to Opposition Proceedings

This is further to our letter of September 20, 2010, and in response to the “work in progress” initiative. We appreciate CIPO’s efforts to consult with the profession before implementing any changes.

With respect to cross-examinations, we support the proposal to dispense with requests to the Board for orders for cross-examination. However, we submit that the deadline of completing all cross-examinations within four months after the filing of the applicant’s Rule 42 evidence is unrealistic. In situations where an opponent submits reply evidence under Rule 43 two months after the applicant’s Rule 42 evidence, the applicant will have only two months to arrange for and complete cross-examination of any Rule 43 witness. This is not sufficient.

We submit that a reasonable timeframe for reply evidence under Rule 43 would be four months after the filing of the applicant’s Rule 42 evidence, and that a reasonable time frame for completing cross-examinations would be four months after the filing of the opponent’s Rule 43 reply evidence (or the expiration of the time for doing so). The regulations should also provide for cross-examination subsequently in cases where further evidence is filed pursuant to Rule 44(1).

Regarding written arguments, FICPI Canada is concerned about the proposal that they be filed and served sequentially, especially if the opponent would not

have the right to submit a reply argument. If the opponent does not have the right to submit argument in reply, the applicant would be given an unfair advantage. The result would likely be that more oral hearings would be requested by opponents.


We submit that a realistic timeframe for the opponent's written argument in a sequential scheme would be four months after the expiry of the time for completing cross-examinations (or the expiration of the time for doing so). We consider that it is reasonable that the applicant would then have a period of two months thereafter to submit its written arguments, and that the opponent would then have a period of two months thereafter to submit its reply argument. Deadlines any shorter than these are simply not reasonable, particularly given that oppositions frequently involve foreign parties and foreign legal advisors.

The resulting timeline is obviously considerably longer than the present situation where both parties submit their written arguments concurrently. Accordingly, we are of the position that sequential filing of arguments should not be introduced.

We understand that CIPO wishes to avoid protracted proceedings. However, having prescribed timelines that are unreasonably short is no solution, even if extensions are available. Each of the parties bears some responsibility for the overall timeline of an opposition, as does the Board. In cases where one of the parties wants the proceedings expedited, it can do so by taking its required steps more quickly than it is allowed by the *Regulations*, and never requesting an extension. It can also refuse to consent to extensions requested by the other party. On the other hand, if the parties are desirous of pursuing settlement discussions, provisions for extensions of time (or cooling-off periods) must be flexible.

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the proposed amendments to the Trade-marks Regulations pertaining to opposition proceedings.

Yours truly,

A handwritten signature in black ink, appearing to read 'R. Storey', with a long horizontal flourish extending to the right.

Robert B. Storey, President - FICPI Canada