

SUBMISSION BY THE

INTERNATIONAL TRADEMARK ASSOCIATION

IN RESPONSE TO THE

CANADIAN INTELLECTUAL PROPERTY OFFICE

CONSULTATION PAPER:

“PROPOSED AMENDMENTS TO THE *TRADE-MARKS*
***REGULATIONS*”**

April 18, 2012

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Trademark Office Practices Committee – Canadian Intellectual Property Office
Subcommittee

Enforcement Committee – Oppositions & Cancellations Standards & Procedures
Subcommittee

Famous & Well-Known Marks Committee – Canada Subcommittee

Non-Traditional Marks Committee – Canada Subcommittee

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1.0. INTRODUCTION

1.1 About this Submission

This submission constitutes the response of the International Trademark Association (“INTA”) to the February 23, 2012 public notice requesting comment on the Canadian Intellectual Property Office (CIPO) consultation document entitled *Proposed Amendments to the Trade-marks Regulations*, as well as to the CIPO letter dated February 24, 2012 inviting INTA to make comments on that consultation document. INTA appreciates this opportunity to provide our input on this document and welcomes the opportunity to work with CIPO regarding this and any future initiatives - to quote from CIPO’s letter - “intended to modernize, simplify and clarify CIPO’s administrative processes” as they relate to the trade-mark registration process in Canada.

1.2 About INTA

INTA is a not-for-profit membership association of more than 5,900 trade-mark owners and professionals firms from more than 190 countries. The association was founded in 1878 and is dedicated to the support and advancement of trade-marks and related intellectual property as elements of fair and effective national and international commerce. INTA members share common interests in the protection of trade-marks and the development of trade-mark law, and they rely on INTA to represent and advocate for those interests with national governments and international organizations. INTA's diverse membership includes multinational corporations and other business enterprises of all sizes, intellectual property and general practice law firms, trade-mark agent firms, service firms, trade-mark consultants, and academic institutions. INTA currently has 274 member firms and corporations in Canada.

For many years, INTA has worked closely with national trade-mark offices around the world evaluating their practices, procedures, operations and regulations, and analyzing proposed legislative and regulatory developments relating to trade-mark registration and enforcement. INTA has been pleased to provide comments to CIPO in respect of previous consultation documents. Reflecting the importance of trade-mark issues in Canada, INTA established within several of its committees subcommittees whose mandates are to specifically focus on Canada in general and CIPO in particular.

Further information about our Association can be found at www.inta.org.

2.0 COMMENTS

Throughout this paper, reference to the Canadian *Trade-marks Act* is abbreviated to “TMA” and reference to the Canadian *Trade-marks Regulations* is abbreviated to “TMR.” In keeping with common Canadian practice sections, subsections, paragraphs and subparagraphs of the TMR are referred to herein as “Rules.” Please refer to the consultation document for the Office’s proposed changes in the regulations.

2.1 Correspondence

Rule 3(6): The proposed change is generally supported given that the CIPO website is more readily accessible than the Journal. However, a concern was raised that it can sometimes be difficult to locate specific information on the CIPO website. CIPO should consider whether it is desirable to indicate a more specific website location in the proposed amended language and should also consider whether the link to the “means of transmission” needs to be more prominently displayed on the CIPO website homepage. As a general principle, wherever a provision within the TMR prescribes that the necessary information is to be located on the CIPO website, that information should be easily navigable from the website homepage.

Rule 6(1): The proposed change is generally supported. However, a concern was raised that the language is ambiguous as it pertains to the words “...consist of all the relevant administrative units up to, and including...” CIPO should consider whether those words add any useful substance to the proposed revised provision. CIPO may wish to consider the alternative language:

6. (1) Any address required to be furnished pursuant to the Act or these Regulations shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall include the house or building number, if any and the postal code or zip code, if any.

Rules 7(1) and 7(2): The proposed change would eliminate the requirement that the trade-mark be identified in correspondence with CIPO concerning applications and registrations. While INTA recognizes and appreciates that CIPO desires to streamline correspondence procedures to reduce administrative burden for correspondents, Committee members were strongly of the view that the TMR retain the requirement that the trade-mark should be identified in order to safeguard against possible adverse consequences resulting from clerical errors when writing application/registration numbers.

In respect of correspondence pertaining to opposition proceedings, INTA notes that additional identification is required in any event: Rule 35 (for which no amendment is proposed by CIPO) requires that the correspondence clearly state that it relates to the opposition proceeding. Thus, CIPO recognizes that opposition correspondence in particular should require more than the applicant name and number. INTA supports an amendment to the TMR which would require that correspondence to CIPO relating to opposition/s.45 proceedings identify: (1) that it is intended for the Opposition Board; (2) the name of the applicant/registrant; (3) the application/registration number; (4) the trade-mark; and (5) the name of the proposed opponent(s)/opponent(s) or requesting party. INTA considers that requiring this information on opposition/s.45 correspondence will be beneficial both to the parties in to the proceeding, and to CIPO and will help to eliminate issues which we foresee may result if the changes in proposed Rules 7(1) and 7(2) are adopted. A clerical error in an application number, particularly where the application opposed is one of several applications filed by the applicant at the same time (and which will be likely to bear sequential or near sequential serial numbers), or the non-identification of an opponent where there are multiple opposition proceedings pending against the same application, can be expected to lead to confusion and delay. This can be forestalled by adopting the additional correspondence identification requirements proposed by INTA.

Rule 8: A concern was raised that there may be ambiguity in Rule 8(2) regarding communications by the Registrar concerning proposed opposition proceedings, *i.e.* where a person has indicated an intention to oppose (*i.e.* by filing a request for extension of time to oppose or a statement of opposition) but no statement of opposition has yet been forwarded to the applicant under subsection 38(5) of the TMA. We suggest that the wording of proposed Rule 8(2) should be amended to read:

(2) Except as provided by the Act or these Regulations, for the purpose of an opposition proceeding or a proposed opposition proceeding under section 38 of the Act, the Registrar shall only communicate with, and shall only have regard to communications from, the applicant or the opponent.

Additionally, or in the alternative, CIPO may wish to consider adding to Rule 2 definitions for opposition proceeding and/or proposed opposition proceeding with the intent of establishing through the definitions that the Rules pertaining to opposition proceedings (or at least certain of them) shall also pertain to proposed opposition proceedings.

Also, a concern was raised regarding the wording of Rule 8(4). This paragraph appears to pertain only to “appointments” and not subsequent communications given that Rules 8(5) and 8(6) provides that the Registrar shall communicate with the opponent’s agent or associate agent, if appointed. However, if an agent has submitted correspondence regarding its appointment as agent (*e.g.* an appointment contained within the statement of opposition), in the event that there is an issue with that appointment and CIPO intends to issue a communication regarding same, we would expect that CIPO would communicate that issue to the agent (at least). As the proposed wording presently stands, CIPO would have the option of communicating with any one of three persons listed to the exclusion of the other two. It is foreseeable that this could lead to missed deadlines and other confusion and delay. We suggest that the wording be amended so that CIPO’s communication be required to be with the person that filed the appointment and that CIPO additionally have the ability to “cc” the remaining persons described in the proposed provision. Similar types of concerns may arise with respect to proposed Rule 8(10) with respect to communications from the Registrar regarding the submission of declarations of use.

Rule 9: Although there is no objection to the intent of the provisions of proposed Rule 9(1) and 9(2), we wonder why both Rule 9(1) and 9(2) are required instead of a single Rule 9 that states:

9. If a trade-mark agent appointed by an applicant, or by an opponent for the purpose of an opposition proceeding under section 38 of the Act:

(a) is not a resident of Canada, the trade-mark agent shall; and

(b) is a resident of Canada, the trade-mark agent may

appoint an associate trade-mark agent who is a resident of Canada.

2.2 Documents

Rule 13: There is some ambiguity concerning the scope of the phrase “documents filed in connection with trade-mark applications and registrations.” Does CIPO consider that the phrase includes opposition and s. 45 documents?

Rule 14(1) and 14(2): INTA agrees with CIPO’s proposed changes.

Rule 14(4): There is some concern that the proposed amendment as currently worded may create problems in particular situations. For example, where a foreign applicant in a French-speaking country wishes to file an application in Canada in English, the proposed amendment would appear to prohibit the ability to include in the application the applicant’s name and address as it would be written in the French language. Such a result is not desirable, and we assume cannot be what CIPO intends. Additionally, where an application is filed in Canada in English but relies on a French application/registration to support a claim under s.16(2), there should be no requirement to translate the wares/services into English, at least with respect to the first portion of the s.16(2) claim (*i.e.* the statement concerning the specification of wares/services appearing in the foreign application/registration). Given that English and French are the official languages of Canada, the specification from the French registration should be able to appear in French in the first portion of the s.16(2) claim. It is understandable that foreign applications/registrations that are in a language other than English or French, and the specification of wares/services appearing therein, should be required to be translated entirely into English or French, however, Canadians should not be *required* to obtain translations of documents, or of specifications of wares/services appearing in French or English language applications/registrations, from one official language of Canada to the other. Also, an application that is filed by an applicant in English and which has received objections to certain of the specifications under s.30(a) may be assigned (*e.g.* during examination) to a French speaking applicant who then wishes to amend the impugned wares specifications by reference to her own language; the CIPO proposal would seem to preclude the assignee from so doing. Would CIPO object to such an assignee from making a discrete amendment using her own language resulting in some of the discrete wares being written in English and some of the discrete wares being listed in French? Would CIPO permit the entirety of the application to be amended via translation from English to French? Additionally, query whether this proposed revision would require an application to extend a statement of wares/services to be filed in the same language as the original application?

Rule 14.1: This proposed new provision confirms that CIPO will accept for filing copies (whether electronic or paper) of affidavits or statutory declarations and provides that the original must be retained by the person that filed the documents. INTA generally supports the proposed Rule, but notes that CIPO should consider preparing a practice notice that would deal with requests by a party opposite to view the original affidavit or statutory declaration. Also, the proposed regulations do not appear to provide for any consequences for a failure to comply with the retention requirement. INTA suggests that CIPO consider whether an appropriate consequence for a failure to retain is that the Registrar be given explicit discretion to deem the affidavit/statutory not to form part of the evidence submitted and to return the filed copy to the party who filed it. This would give the Registrar the ability to disregard the evidence (such as is presently mandated in a case where an affiant fails to attend for cross-examination) in circumstances where a real issue arises concerning the fidelity or sufficiency of the copy filed

with CIPO, but would not mandate such a severe sanction where any issue concerning the filed copy is relatively minor and the failure to retain can be evidenced as having resulted from uncontrollable circumstances such as fire, natural disaster, war, acts of terror, etc.

2.3 Time

Rule 14.2: There is general concern that the provision is difficult to interpret, which is particularly problematic given that it is intended to provide “greater certainty.”

2.4 Journal

Rule 15: INTA is concerned regarding the wording “on at least a weekly basis.” Does CIPO currently have plans to publish the Journal on regular set dates with a frequency of more than once a week? At present, the Journal is published once a week on a regular, predictable date and current industry watch practices are set up accordingly. If the Journal publication schedule is not regular and predictable it will potentially create serious issues for monitoring.

Rule 17: INTA notes that section 64 of the TMA requires that:

The Registrar shall cause to be published periodically particulars of the registrations made and extended from time to time under this Act, and shall in such publication give particulars of any rulings made by him that are intended to serve as precedents for the determination of similar questions thereafter arising.

If Rule 17 is repealed as CIPO proposes, there will be no requirement that the publication of registration particulars prescribed by s. 64 TMA appear in the Journal. We therefore assume that CIPO considers that section 64 is satisfied by the publication of registration particulars on the Canadian Trade-marks Database (“CTD”) accessible through the CIPO website. If our assumption is incorrect, where does CIPO intend to publish s.64 prescribed particulars, and with what frequency? If our assumption is correct and the CTD is considered to be the means of publication that will satisfy the requirement in s.64 TMA, how is the statutory requirement that “such publication give particulars of any rulings made by him that are intended to serve as precedents for the determination of similar questions thereafter arising” so satisfied?

Also, given that s.64 TMA mandates the publication of registration particulars and precedent rulings particulars, INTA considers that it may be beneficial if there were additional new provisions in the Rules to govern the minimum content of those particulars such as Rule 16 provides in the case of particulars concerning published applications.

2.5 Application for Registration

Rule 28(3): We note that Rule 28(3) *item a* includes a reference to “standard typographical characters used by the Registrar” and that *item b* includes a reference to “the standard characters used by the Registrar.” Are these intended to refer to the same character set? Given that the relevant character set is not particularized in the proposed amendments, INTA requests that CIPO publish that character set in a Practice Notice so that it will be sufficiently clear to all concerned. The current practice notice titled Compliance with Paragraph 30(h) – Marks in a Special Form (Publication date: 1999-03-10) is insufficient in this regard.

Rule 28(5) and 28(9): A concern has been raised that the proposed wording “one or more colours applied to the whole of the visible surface of a three-dimensional object” is overly restrictive. We recognize that the proposed language is consistent with CIPO policy as expressed in the Practice Notice titled Three-dimensional Marks dated 2000-12-06 concerning trade-marks that claim colour as an element. However, INTA considers that it is not justifiable to restrict registration for colour marks only to those cases where the colour is applied to the *whole* of the visible surface of an object, as opposed to a portion of the visible surface of an object. There would appear to be no reason why an application for a claim of “one or more colours applied to a particular position on the surface of a three-dimensional object” could not be filed under proposed Rule 28(9) as a position mark. However, given that Rule 28(9) does not specifically refer to colour, to provide clarity that such a positional colour claim is indeed recognized under Rule 28(9), we encourage CIPO to consider the amending proposed Rule 28(9) as follows:

(9) An application for the registration of a trade-mark consisting of a mark applied in a particular position on a three-dimensional object must

- a. state that the application is for the registration of a position mark;
- b. contain a drawing showing the mark and its position on the three-dimensional object and showing the three-dimensional object in dotted or broken lines; and
- c. contain a description explaining the position of the mark in relation to the three-dimensional object,

and if the application is for registration of a trade-mark that consists of one or more colours applied to a particular position on the surface of a three-dimensional object, the application also

- d. must indicate that the position mark consists of the particular colour or colours applied to the particular object shown in the drawing;
- e. must indicate the name of the colour or colours claimed and, in respect of each colour, the principal parts of the trade-mark which are in that colour;
- f. may contain a reference to an internationally recognized colour system for each colour; and

g. must contain a colour drawing of the trade-mark.

Rule 28(7): In proposed Rule 28(7) *item b* the word “entirely” should be replaced with the word “entirety.” In view of current technological advances and capabilities, INTA also encourages CIPO to consider the addition of the ability to submit an electronic representation of a hologram mark. Consideration may be given to whether or not a certain number of freeze frames, in a specified mark, should also be prescribed. We encourage CIPO to consider amending the proposed Rule 28(7) as follows:

(7) An application for the registration of a trade-mark consisting of a hologram must

a. state that the application is for the registration of a hologram mark;

b. contain a drawing or drawings including one or more views capturing the holographic effect in its entirety;

c. contain a description of the hologram mark; and

d. may contain an electronic representation showing the hologram mark.

Rule 28(8): INTA supports the proposed amendments which allow for the registration of motion marks. INTA supports the idea that moving image marks be recognized through a series of drawings along with an electronic representation of the motion mark. Unlike the 2010 draft CIPO Practice Notice titled Non-traditional Marks, the proposed amendments apply a more flexible interpretation of existing legislation (in particular section 30(h) of the *Trade-marks Act*) whereby an applicant may file an electronic representation showing the mark in motion along with a drawing or drawings containing one image or a series of images depicting movement and a description of the movement.

Rule 28(10): INTA welcomes CIPO’s recent Practice Notice titled Trade-mark consisting of a Sound (Publication Date: 2012-03-28), advising that it is now accepting applications for the registration of sound marks. INTA supports the approach set out in the recent Practice Notice and the proposed amendments set out in Rule 28(10) which provide for an applicant to submit a sound mark through a combination of means, including a drawing that graphically represents the sound, a written description of the sound, along with an electronic recordation of the sound.

2.6 Amendment of Application for Registration

Rule 31: INTA generally supports the view that the TMR should be amended to facilitate the amendment of applications where applicants wish to revise the basis for entitlement to registration (and relevant dates thereunder) prior to advertisement. Presently, it is not possible to amend a proposed use application to one alleging use (see Rule 31(d) TMR), and it can be very difficult to amend a use-based application to claim an earlier date of first use (see Rule 31(c) TMR). This has resulted in applicants having to incur the expense and delay of filing new applications in Canada when a simple amendment prior to advertisement, had it been permitted,

would have remedied a deficient entitlement claim. In particular, foreign applicants wishing to register in Canada often do not know, at the time they wish to file the application, whether use of the trade-mark has commenced in Canada or not; even when it is known that the mark is in use, it is often not practicable to determine, prior to filing, when the earliest provable date of first use occurred in Canada.

The proposed deletion of Rule 31(c) and (d) will increase the ability of applicants to amend their bases for entitlement *pre-advertisement*. Upon advertisement, per Rule 32 an applicant will no longer be able to amend a basis of entitlement in a manner that would conflict with a competing claim to entitlement. Any unsubstantiated claims can readily be sorted out on opposition or, where the claim to entitlement constitutes a fraudulent misrepresentation or a material false statement material to the registration, in a post-registration invalidity proceeding. Accordingly, INTA supports the proposed amendment to Rule 31 provided that CIPO examination will continue to be conducted as it is at present such that in an evaluation of co-pending confusing applications an Examiner will only have regard to filing date (or priority date, if applicable) in assessing which applicant is entitled over the other under s. 37(1)(c) of the TMA.

Rule 31(2): INTA supports the proposed amendment and is hopeful that it will be of great assistance where applicants seek to correct clerical/typographical errors to applicant names. Under present practice the requirement in particular situations to file an affidavit justifying the change is cumbersome and expensive, and the proposed amendment should expedite corrective amendment.

Rule 32: INTA generally supports the proposed amendments to Rule 32. However, it is noted that with the addition of proposed new Rule 32(a) it will seemingly no longer be possible to correct an error in the identity of the applicant after advertisement. Some concern has been raised about limiting the correction of typographical/clerical errors to a pre-advertisement window.

With respect to proposed new Rule 32(e), INTA notes that it does not appear to prohibit a proposed-use applicant from amending the application after advertisement so as to change the basis for entitlement to registration to a claim of use or making known in Canada since a date *subsequent* to the filing date; such an amendment would permit the applicant to dispense with the need to file a declaration of use to support the initial proposed use claim. If INTA's understanding is correct, such an amendment could help to streamline the application process and would be welcomed by INTA. Please confirm that CIPO would in fact permit such an amendment as described above as it does not appear to be prohibited by the TMA or the TMR as proposed for revision.

2.7 Opposition

Rule 36: The proposed changes to Rule 36 will require any correspondence to the Registrar in respect of an opposition proceeding to be forwarded to the other party (with the exception of the filing of a statement of opposition). If the words “in respect of an opposition proceeding” are interpreted broadly, this will seemingly require initial requests for an extension of time to oppose

to be copied to the applicant. Under the current regulations there is no requirement to copy the other party until *after* the Registrar had forwarded a copy of the statement of opposition to the applicant, and thus proposed opponents presently are not required to forward copies of initial opposition extension requests. Accordingly, such a change will allow applicants to know of potential opposition proceedings contemporaneous with the request for extension by the proposed opponent. INTA would welcome such a change. However, given that there may be some difference in interpretation concerning the scope of the words “in respect of an opposition proceeding,” INTA suggests that CIPO consider revising the concluding portion of Rule 36 to read “...a copy of any correspondence in respect of an opposition proceeding or a proposed opposition proceeding to the other party.” Alternatively, the issue concerning interpretation may be remedied if Rule 2 were amended to include new definitions as suggested above in our comments concerning Rule 8.

We note that proposed new Rule 36 is silent concerning *when* the party corresponding with the registrar is required to forward a copy of the correspondence to the other party. INTA suggests that the proposed provision be amended to include words sufficient to clarify that the copy is required to be forwarded to the other party reasonably contemporaneously with the sending of the correspondence to the Registrar. It is crucial to the fair and efficient conduct of an opposition proceeding that parties to be provided with copies of correspondence to the Registrar in a timely manner.

The proposed changes to Rule 36 lack any consequence of non-compliance. Whereas the proposed changes to Rule 37 (regarding service of documents which under section 38 of the Act are required to be served on the other party) provide that the Registrar shall not have regard to a document not served in accordance with the Regulations (see proposed Rule 37(6)), there are no such sanctions in respect of materials where service is not required but which have not been copied to the other side. INTA suggests that CIPO consider revising the proposed new Rules to provide for an appropriate consequence, such as giving the Registrar discretion to not have regard or give effect to correspondence which has not been forwarded to the other side. The opposition process can only work fairly and efficiently where the parties are assured that they will timely receive all correspondence submitted to the Opposition Board by the other party.

Rule 37(1): Subject to the following comments, INTA generally supports the proposed changes to Rule 37(1) which would newly permit service by facsimile and service by email (where the party has provided an email address for service).

Email

INTA is concerned that, without further clarification in the TMR or an appropriate practice notice, email filing of evidence could create problems if it was not clear when the emails were sent or if there were any problems with successful transmission of all attachments. This is a concern given the size of some affidavits and exhibits in opposition proceedings, and the fact that some email systems limit the size of attachments, or that the format of an attachment may not be easily read. Proposed Rule 37(3) partially addresses this by requiring notice to the Registrar, which, presumably, is also required to be forwarded to the party being served. However, the notice to the Registrar is of “service of a document or other material.” If this notice does not clearly state what was served and when and to what address, there is still risk of the party being

served not knowing exactly what was filed, and if what it received was incomplete in any way. Rule 37(1) (and Rule 37(3) as well) could be amended to state that the party serving such materials must clearly particularize the documents that are being served, the number of attachments and what is included in each attachment, the time of service, and the address to which the email was sent.

Some concern has been raised regarding the words “if the party has provided an email address for service” in proposed new Rule 37(1). INTA supports an amendment to the wording that would clarify that the service by email may only be effected where the email has been sent to the email address(es) that are specifically designated in written correspondence (or set out in a statement of opposition or counterstatement) as being the address for service for the purpose of opposition proceedings. The clarification is sought to avoid situations in which a party or its agent/representative for service has multiple email addresses associated with it, and the party seeking to effect service sends an email to any of those multiple addresses rather than to an address which the recipient will know to be checking regularly.

Registered Mail

Some concern was raised concerning the benefit of CIPO deleting registered mail as a means by which service may be effected without the consent of the other party. INTA recognizes that there are issues that have arisen concerning Canada Post’s decision (some time ago now) to limit its service known as “registered mail” to a maximum weight restriction (and thus rendering it a non-viable means for service of weighty documents). However, we also understand that Canada Post has for some time offered a materially equivalent service to its registered mail service that does not have the same weight restrictions, and we note that under the present TMR registered mail continues to be a viable method to serve documents that are not particularly weighty. Thus, rather than delete registered mail as a means of service that can be effected without consent, INTA requests that CIPO consider extending registered mail to “registered mail or an equivalent postal service which requires a signature from the recipient upon delivery.” This would provide parties with more, rather than fewer, options for service.

Given that personal service and service by courier will still be permitted under the new Rules (and thus it is still contemplated that paper copies will continue to be served, notwithstanding that the new Rules will facilitate the service and filing of electronic copies), we do not see what is to be gained by removing registered mail (and, as we suggest, the additional equivalent postal services) as a means of service, but there may be something to lose. Canada is a very large country, the population of which is dispersed throughout communities of various sizes from the very large to the very small, and the ability of persons to access means of service permitted by the Rules will sometimes vary considerably depending on the size of the community. There may be some communities in Canada in which Canada Post, as a Crown corporation having a universal service obligation, presents the most viable means of effecting service for its citizens. INTA urges CIPO to consider the potential impact on rural and outlying communities if it proceeds with the elimination of registered mail (and fails to add the equivalent service for heavier items) as a service option.

Rule 37(3): INTA proposes that the wording be amended to specifically provide that the notification be in writing (so that it will be subject to Rule 36 and thus requiring a copy of the

notification to be forwarded to the party who is receiving service of the materials detailed in the notification). Without such clarification, notification could seemingly be properly effected by leaving a voicemail message with the Opposition Board clerk assigned to the file, which INTA would not support and cannot reasonably be what CIPO intends. Further, the written notification to the Registrar should be required to clearly particularize the documents that were served, the date and time of service, and in the case of an email, the address to which the email was sent and the number of attachments and what is included in each attachment.

Rule 37(4): INTA appreciates the concept of proposed new Rule 37(4) -- improper service will in and of itself no longer risk correspondence being considered not to have been filed, but questions how it will fit together with proposed Rule 37(6) which provides that no regard shall be had to evidence not properly served, and not served before the expiry of the time limit. If a party does not properly file the evidence, but then notices it, and the time limit to file evidence has passed, the “service” is now valid under proposed Rule 37(4). However, if the deadline has passed, the Registrar shall not have regard to it. INTA suggests that the Registrar be granted the discretion as to whether the evidence in such a case should be given regard or not. For example, in a case in which a party who serves something improperly due to a clerical error, (*e.g.* by regular mail instead of courier) and it is clear that the other side received it (so that proposed Rule 37(4) kicks in), it would be appropriate that the Registrar should have the ability to decide that the serving party’s evidence should nevertheless be considered notwithstanding that the error in the mode of service was not discovered until after the deadline. INTA anticipates that this discretion could reduce the expense associated with the need to request retroactive extensions of time.

Rule 37(6): INTA has serious concern that the proposed changes to Rule 37 are ambiguous concerning *when* service via the various enumerated methods is effected. This is particularly problematic because of the sanctions provided in proposed Rule 37(6) where the document is not served in accordance with the service requirements before the expiry of the prescribed time limit. While INTA supports the sanction, the parties to the opposition should be able to determine the time of service of the enumerated methods of service (and thus the applicability of the sanction) by reference to the Regulations. It is manifestly unfair to parties to opposition proceedings that while the revised TMR clearly set out an effective date of service where service is accomplished by means that *do not* comply with Rule 37(1) (*i.e.* see Rule 37(4)), the TMR should leave parties very much in a state of uncertainty concerning the effective date of service where service is effected by one of the acceptable methods that are enumerated in Rule 37(1). INTA therefore requests that CIPO amend the TMR to set out when service is effected, or deemed to be effected, by those means.

Rules 41(1), 42(1) and 43: The proposed changes to the TMR alter the manner in which the deadlines for the submission of evidence are calculated. Under the current TMR, the evidentiary deadlines are calculated from the service of the pertinent document/materials in the preceding stage. In the proposed amended TMR, the evidentiary deadlines are calculated from “after the expiry of the time for” filing/submitting the pertinent document/materials in the preceding stage. It appears that the change is to be interpreted in a manner such that the deadlines for each evidentiary stage of the proceeding will be ascertainable to the Opposition Board and to the parties (subject to any extensions that may be requested and granted) from the very outset, *i.e.* once the parties know the date that the statement of opposition has been forwarded to an

applicant under subsection 38(5) TMA. However, if CIPO considers that the time for filing/submitting the evidence at each stage actually expires upon the filing/submitting of the evidence if that filing/submitting occurs earlier than the latest permissible date for the filing/submitting of same, CIPO should clarify what is meant by the phrase “expiry of the time for.”

INTA supports CIPO’s decision that the TMR retain the opponent’s right to file reply evidence.

In proposed Rule 43, subparagraph “42(2)(a)” should be replaced with subparagraph “42(1)(a).”

Rules 44: There is some concern regarding how a grant of leave to submit additional evidence under proposed new Rule 44 (and any cross-examinations that may take place in respect of same) will impact the parties’ deadlines to file written arguments under proposed new Rule 46. The current TMR provide that a notice inviting the parties to file written arguments is not sent out until at least two weeks after “completion of the evidence.” Presently, it is left in the hands of the Opposition Board to determine when the evidence has been completed. Under the new proposed regulations, because the deadline for the filing of the parties’ written arguments will have been set once the statement of opposition is forwarded by the Registrar to the applicant, additional evidence for which leave is granted late in the proceeding may negatively impact a party’s ability to effectively prepare written arguments. INTA suggests that CIPO consider whether it would be appropriate for the new TMR to set an outer time limit for the filing of additional evidence and the completion of any cross-examinations thereunder.

Rule 44(2): The proposed revision will require a leave to file evidence outside of normal rules to be accompanied “by the evidence that the party proposes to submit.” If that evidence is costly to prepare, that puts a potentially enormous burden on a client to accept the cost of preparing evidence merely on a chance that it will be accepted. Currently, the Practice Notice recommends that the evidence be submitted, and many parties attach a draft of the affidavit. There does not appear to be a need to move away from that current practice.

INTA would prefer proposed Rule 44(2) provide that the request be accompanied by a clear description of the evidence proposed to be filed rather than require that it be accompanied by the actual evidence itself.

Additionally, INTA requests that Rule 44(2) provide specifically that the party seeking to submit the additional affidavit state that the affiant/declarant will be made available for cross examination and that Rule 44 provide for cross-examination of additional affidavits. Although cross-examination is contemplated in proposed Rule 41.1, it is limited to evidence filed in accordance with Rules 41-43. INTA suggests that cross-examination on additional evidence could parallel the concepts introduced in 44.1(1)-(7).

Further to the suggested revisions described above, INTA would support revised language for proposed Rule 44 as follows, or materially similar thereto:

- (2) A request for leave under subsection (1) must be accompanied by a clear description of the evidence that the party proposes to submit and, where that evidence consists of an affidavit(s) and/or a statutory declaration(s), by a statement that the

affiant(s)/declarant(s) will be made available for cross-examination at the request of the other party.

(3) Cross-examinations on affidavits or statutory declarations submitted with leave of the Registrar under subsection 44(1) shall be completed within two months after the grant of leave for the submission of same, at a time, date and place and before a person agreed to by the parties or, in the absence of agreement and upon request to the Registrar for an order, as designated by the Registrar in the order. The Registrar shall not make an order under this subsection (3) unless the party seeking to conduct the cross-examination establishes that they have been unable to reach an agreement with the other party concerning the arrangements for the cross-examination despite having made reasonable and timely efforts to do so and there has been no undue delay in requesting the order. Subsections 44.1(5)-(7) shall apply to cross-examinations conducted under subsection 44(3), with such modifications as necessary.

Rule 44.1: INTA is concerned about some aspects of the proposed new provisions regarding cross-examinations. Under the current TMR, an applicant can arrange matters such that its Rule 42 evidence need not be prepared until after the completion of the cross-examination on the opponent's Rule 41 evidence. Similarly, an opponent can presently arrange matters such that it need not prepare its Rule 43 evidence until after the completion of the cross-examination on the applicant's Rule 42 evidence. In many instances, the Rule 42 and Rule 43 evidence is informed by what is learned during cross-examination. In particular, at present the decision concerning whether or not an opponent prepares and files Rule 43 evidence is often determined by answers given during the cross-examination on the applicant's Rule 42 evidence. (Presumably this is one of the reasons that CIPO has not maintained its previous proposal, *i.e.* that cross-examinations not take place until all the evidence is filed, as is the case with applications in the Federal Court.)

It is foreseeable that a scenario will arise where one party will wish to conduct a cross-examination before it prepares its next evidentiary submission and the party opposite will wish to resist scheduling the cross-examination until after all the Rule 41-43 evidence is submitted. INTA would like to have a better understanding of how CIPO intends that Rule 44.1(4) would operate, particularly in the scenario set out above. Also, INTA would consider it to be most helpful if CIPO provided some guidelines concerning what the Registrar would consider to be "undue delay" in proposed new Rule 44.1(4). INTA is concerned that the procedure as set out in the proposed Rule 44.1 will lead to more, as opposed to fewer requests for leave to file additional evidence outside of normal time limits.

Additionally, it is noted that Rule 44.1(4) only provides the Registrar with the right to intervene where the parties cannot agree concerning the "arrangements" for the cross-examination. INTA also would favour giving the Registrar an increased scope to intervene concerning a cross-examination where it appears that a cross-examination on the affidavit, or a request for the scheduling of same, may be for frivolous reasons.

INTA supports proposed new Rule 44.1(6) which places the onus on the party whose affiant or declarant is being cross-examined to file with the Registrar and serve on the party who

conducted the cross examination any documents or materials undertaken during the cross-examination.

Rule 46: INTA supports the proposal for the sequential filing of written arguments, and, there is some support for additionally giving the opponent a right of written reply based on the theory that it may result in fewer requests for oral hearings. However, there is some concern both with the timelines provided by Rule 46(1)-(2), and with the concept that the triggering event for the written argument stage should be the expiry of the time for completion of cross-examinations. As for the timelines, we support increasing to three months the time that each party has to prepare written arguments (with a suggested right of reply of the opponent set at two months).

With respect to linking the time for written arguments to the conclusion of cross-examinations, there is substantial concern that the proposed revisions reflected in proposed new Rule 44.1 (i.e. staging cross-examinations after the completion of the Rule 41-43 evidence) will result in increased requests for filing additional evidence in accordance with proposed new Rule 44 after the completion of cross-examinations. INTA considers that it is not fair for either party (but in particular, given the proposed staggered filing system, grossly unfair to the opponent) to have its deadline for written arguments beginning to run without knowing whether or not any proposed additional evidence will be accepted for filing. INTA considers that the deadline for written arguments should begin to run upon notification from the Registrar and that such notification should be issued once the Opposition Board is satisfied that all of the evidence and cross-examinations that it is prepared to accept has been completed. This is consistent with our suggestion under Rule 44 that new TMR set an outer time limit for the filing of additional evidence and completion of cross-examinations thereunder; the Registrar could diarize to send out its notification a short set period of time after that deadline.

With respect to proposed new Rule 46(7), there is some concern that the period of “at least one month before the date of the hearing” does not provide sufficient flexibility for the parties and INTA suggests that it be changed to a shorter term.

Rule 47: INTA understands that CIPO’s position regarding the proposed repeal of this provision is as previously communicated in its Consultation Notice dated June 2010, namely that “This provision is not used and is considered redundant in view of the discretion conferred to the Registrar under s. 47 of the Trade-marks Act.” However, a concern was raised that there may be some deadlines that are set by practice as opposed to the TMA or the TMR, and that the repeal of Rule 47 may thereby curtail the Registrar’s ability to extend the deadline of the other party for the taking of any subsequent step. Subject to that concern, INTA does not object to the proposed repeal provided that the Registrar is prepared to continue to grant extensions in opposition proceedings in appropriate circumstances and is prepared to also extend the deadline of the other party as part of the “on such terms as he may direct” discretionary power found in s.47(1) TMA.

2.8 Transfer

Rule 48: INTA notes that proposed new Rule 48 sets a much lower standard for the recognition of transfers of trade-mark applications than the standard provided in Section 48(3) for the recognition of transfers of trade-mark registrations. Is the difference in standard justified? Also, INTA has some concern that CIPO would accept without question a request by a purported assignee to record the transfer of an application without either some documentation evidencing the transfer or an acknowledgement from the assignor.

2.9 Objection Proceedings under Section 11.13 of the Act

INTA has no specific comments concerning the proposed revisions to Rules 53, 55-61, but notes that to the extent that the proposed revisions are similar to the proposed revisions concerning opposition proceedings, our comments concerning same are also applicable to objection proceedings.

2.10 Fees

INTA supports the reduction of filing fees where the document for which the fee applies is filed electronically with CIPO.

2.11 Transitional Provisions

INTA does not object to the proposed transitional provisions, provided that the public will be given sufficient advance notice of the date upon which the proposed new Regulations will come into force. INTA recognizes that the dual opposition system that resulted from the transitional provisions SOR/2007-91 created undue administrative burden on the parties and the Board, and it is in the interests of all concerned to transition opposition files to the new Regulations as soon as possible.

2.12 Coming into Force

We do not have any comments concerning this provision.

3.0 Other Issues

INTA requests that CIPO consider whether such concepts as mediation and summary judgment could be introduced to opposition proceedings by way of amendment to the regulations.

The Registrar, in its current form of notice to the parties confirming the opposition hearing date, requires the parties to file and serve a list of cases upon which they intend to rely together with copies of any unreported decisions within a certain period of time prior to the hearing date. INTA suggests that CIPO consider whether this requirement should be incorporated into the TMR.

Additionally, given the relatively complicated rules relating to extensions and cooling-off periods provided for in the Practice Notice relating to oppositions, INTA considers that it may be of benefit to have those provisions incorporated into the TMR and subject to the public consultation process. There is substantial concern that there are certain stages in the Canadian opposition process that are very difficult for parties to extend notwithstanding that there are justifiable reasons, such as settlement negotiations. INTA favours increased flexibility in the facilitation of dispute settlement.

Additionally, INTA is aware of the recent controversy resulting from CIPO's change in practice concerning the correction of errors to registration certificates and asks that CIPO consider whether it would be feasible to propose an amendment to the TMR that would confirm that the Registrar does have the necessary authority to correct CIPO-originating errors to registration certificates. CIPO's position that only the Federal Court has authority to correct such errors creates undue hardship on trade-mark applicants.