SUBMISSIONS IN RESPECT OF

Pre-Consultation Notice - Proposed Amendments to the Trade-marks Regulations Pertaining to Opposition Proceedings

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PART I
Comments on Proposed Regulatory Amendments

Background

Moffat & Co/Macera & Jarzyna, LLP respectfully submit the following comments on the proposed amendments to the Trade-mark Regulations ("Regulations") regarding opposition proceedings as set out in the Pre-Consultation Notice dated July 26, 2010.

Our comments are guided by the principles of natural justice which govern administrative boards and tribunals such as the Trade-marks Opposition Board (the "Board"). Given that the proposed amendments to the Regulations relate to procedure, we are particularly mindful of issues relating to procedural fairness.

In our view, there is a pressing need to reduce the time taken to complete opposition proceedings, and to simplify the proceedings. Currently, it usually takes several years to complete an opposition proceeding. This is unacceptable. There is an urgent need to improve the timeliness of the process - from filing the Statement of Opposition to rendering the Board's decision.

Trade-marks go to the very identity of a business and often distinguish core products or services offered by a business. Businesses and business persons, applicants and opponents, all require an expeditious and cost-effective determination by the Board of trade-mark rights. Instead, opposition proceedings are often characterized by unacceptable delays that jeopardize and undermine business certainty.

We support the Canadian Intellectual Property Office's ("CIPO") goals of providing "a reasonably swift and inexpensive determination" and trying to "modernize, streamline and simplify the administration of the trade-mark opposition regime".

We believe our comments will assist CIPO in achieving its goals.
1. **Filing of Evidence Electronically with the Registrar**

CIPO's proposed amendments

- Allow for electronic filing of evidence with the Trade-marks Office
- Delete section 3(9) of the Regulations
- Specify acceptable means of electronic transmission in accordance with section 3(6) of the Regulations;
- Add the following provision:

  **Electronic Sworn Affidavit or Solemn Declaration**
  (1) An affidavit made under oath or a statutory declaration may be filed electronically if it contains a signature attestation and the following undertaking:

  *The document that we are electronically submitting to the Registrar of Trade-marks is an electronic version of the paper document that has been signed by the affiant/declarant. The paper copy of the signed document is available and will be produced if requested by the Registrar.*

  **Maintenance of Document**
  (2) The document referred to in subrule (1) must be maintained in paper form by the party filing the document until one year after all periods for appeals expire.

  *Upon request of the Registrar, the filer must provide the original documents for review.*

**Our comments**

**Definition of "filed electronically"**

1.1 In principle, we favour the ability to file documents electronically. However, further clarification is required to define what does "filed electronically" mean in a practical sense.

1.2 For instance, what kind of media would be acceptable for electronic filing? Is information stored electronically on a memory key acceptable for filing? Are compact-discs or DVDs acceptable? Does "electronically" mean only an attachment to an email?

1.3 Any documents to be filed electronically should be in a universal format (e.g. PDF, TIFF, JPEG format) that is easily accessible to the other side, and to the
public. The universal format for acceptable forms of media should be identified in the Regulations.

1.4 In addition, file size limits should be considered. Many offices have limits on the size of email attachments.

**Unequal application and enforcement of proposed undertaking**

1.5 There is no mechanism to enforce the proposed undertaking provided by non-lawyers. Unlike for lawyers, there are no sanctions for trade-mark agents or lay persons for failing to carry out or abide by an undertaking once given.

1.6 The Board has no powers to enforce undertakings.

1.7 In contrast, lawyers are regulated by their respective provincial law societies. A lawyer who gives an undertaking to a tribunal must carry out and abide by that undertaking. An undertaking is considered a personal promise given by the lawyer that must be fulfilled.

1.8 For instance, Rule 4.01(7) of The Law Society of Upper Canada, *Rules of Professional Conduct* provides:

> “4.01(7) A lawyer shall strictly and scrupulously carry out an undertaking given to the tribunal or to another legal practitioner in the course of litigation.”

a. The accompanying commentary to this Rule provides:

> "*Unless clearly qualified, the lawyer's undertaking is a personal promise and responsibility.*"

1.9 Rule 6.03(10) of the same *Rules of Professional Conduct* provides:

> “6.03(10) A lawyer shall not give an undertaking that cannot be fulfilled and shall fulfill every undertaking given.”

a. The accompanying commentary to this Rule provides, among other things,

> "*Undertakings should be written or confirmed in writing and should be absolutely unambiguous in their terms. If a lawyer giving an undertaking does not intend to accept personal responsibility, this should be stated clearly in the undertaking itself. In the absence of such a statement, the*"
person to whom the undertaking is given is entitled to expect that the lawyer giving it will honour it personally."

1.10 A lawyer who fails to abide by his/her undertaking may be disciplined by the respective law society for professional misconduct.¹

1.11 For the reasons stated above, the requirement to file the proposed undertaking is unequal in its application and enforcement. There are no repercussions for non-lawyers to fail to abide by their undertaking. In contrast, law societies consider undertakings to be personal promises given by lawyers to the Board that must be fulfilled.² Lawyers who fail to abide by their undertaking may be disciplined by their respective law societies.

Revisions to subsection (1) and to proposed undertaking

1.12 Despite our comments above, if the proposed undertaking is required, then we propose the following revisions which are indicated below:

**Electronic Sworn Affidavit or Solemn Declaration and Exhibits**

(1) An *A signed copy of an* affidavit made under oath or a statutory declaration *along with all accompanying exhibits* may be filed electronically *only* if it contains a *signature attestation* and the following undertaking:

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¹ The Law Society of Upper Canada, *Rules of Professional Conduct*, Rule 6.11 provides:

**Disciplinary Authority**

6.11 (1) A lawyer is subject to the disciplinary authority of the Society regardless of where the lawyer’s conduct occurs.

**Professional Misconduct**

6.11 (2) The Society may discipline a lawyer for professional misconduct.

² See The Law Society of British Columbia’s *Annotated Professional Conduct Handbook*, section 7 which provides:

"7. A lawyer must
(a) not give an undertaking that cannot be fulfilled,
(b) fulfill every undertaking given..."

See also the Law Society of Alberta’s *Code of Professional Conduct*, Rule 10 which provides:

"R.10 A lawyer must honour all undertakings given by the lawyer regardless of their form or the manner in which they have been communicated."

5
The document that we are electronically submitting to the Registrar of Trade-marks is an electronic version of the paper document that has been signed by the affiant/declarant along with all accompanying exhibits. The paper copy of the signed document and exhibits are is-available and will be produced if requested by the Registrar or the opposing side.

Include reference to exhibits in title and in undertaking itself

1.13 A copy of all exhibits should also be filed along with a copy of the affidavit or declaration. To file the text of the affidavit or declaration alone denies the other side to opportunity to be served with the complete affidavit or declaration.

1.14 Accordingly, we suggest revising CIPO's proposed amendment as follows:

   a. insert the words "and Exhibits" at the end of the title "Electronic Sworn Affidavit or Solemn Declaration"; and

   b. amend subsection (1) and the undertaking itself to explicitly require the filing of a copy of exhibits.

Explicitly state a signed copy must be filed

1.15 CIPO's proposed amendment does not clearly state that an actual signed copy of the affidavit or declaration needs to be filed, when done so electronically.

1.16 According, we suggest revising subsection (1) to explicitly state that an affidavit made under oath or a statutory declaration may be filed only if a signed copy of the affidavit or declaration is filed.

Allow opposing side to receive paper copy

1.17 Procedural fairness requires that the other side be entitled to request a paper copy of the signed affidavit or declaration along with a copy of the exhibits.

1.18 Accordingly, we also suggest revising CIPO's proposed undertaking to indicate that the opposing side may request a paper copy of the signed affidavit or declaration along with exhibits.
2. Service

CIPO's proposed amendments

- Allow parties more ability to serve their documents by electronic means
- Amend section 37(1) of the Regulations as follows:

(1) Service of any document or other material on a party required to be served in an opposition proceeding under section 38 of the Act or these Regulations must be effected:

   a. by personal service
   b. by sending the document or other material by registered mail or courier and by obtaining an acknowledgment of receipt
   c. by facsimile in the case of a document that is 25 pages or less
   d. in any other manner, including by electronic transmission with consent of the party or their agent.

(2) Unless the parties are agreed otherwise, if a party has appointed a trade-mark agent or has named a representative for service, service must be effected on that agent or representative for service.

Proof of Service

(3) The party effecting service must notify the Registrar in writing of both the manner and date of service.

Effective Date of Service by Registered Mail and Courier

(4) Service by registered mail or courier is deemed to be effected on the later of:

   a. the date of mailing or shipping as indicated on the post office or courier receipt, and
   b. the date on which the party effecting service submits to the Registrar a notice in accordance with subsection (3).

(5) If the Registrar has reasonable grounds to believe that any document or material that is required to be served in an opposition proceeding has not been served within the prescribed time, the Registrar shall request that proof of service be submitted to the Registrar within a time specified by the Registrar. If proof of service is not submitted within the specified time, the document or material shall be considered not to have been served.
General

(6) Service of a document or other material in a manner not complying with subsections (1) to (4) shall nevertheless be considered to be valid service if, and on the date when, the document or material comes to the notice of the person to be served.

Our comments

2.1 We suggest the following revisions to CIPO’s proposed amendment as indicated below:

(1) Service of any document or other material on a party required to be served in an opposition proceeding under section 38 of the Act or these Regulations must be effected:

a. by personal service;
b. by sending the document or other material by registered mail or courier and by obtaining an acknowledgment of receipt or confirmation of delivery from Canada Post or the courier;
c. by facsimile in the case of a document that is 25 pages or less, inclusive of fax cover page; or
d. in any other manner, including by electronic transmission with consent of the adverse party or their agent or representative for service.

(2) Unless the parties are agreed otherwise, if a party has appointed a trade-mark agent or has named a representative for service, service must be effected on that agent or representative for service.

Proof of Service

(3) The party effecting service must notify the Registrar in writing of both the manner and date of service.

Effective Date of Service by Registered Mail and Courier

(4) Service by registered mail or courier is deemed to be effected on the later of:

a. the date of mailing or shipping as indicated on the post office or courier receipt, and
b. the date on which the party effecting service submits to the Registrar and to the other party a notice in accordance with subsection (3).
(5) If the Registrar has reasonable grounds to believe that any document or material that is required to be served in an opposition proceeding has not been served within the prescribed time, the Registrar shall request that proof of service be submitted to the Registrar within a time specified by the Registrar. If proof of service is not submitted within the specified time, the document or material shall be considered not to have been served.

**General**

(6) Service of a document or other material in a manner not complying with subsections (1) to (4) shall nevertheless be considered to be valid service if, and on the date when, the document or material comes to the notice of the person to be served:

**In general**

2.2 Service under section 37(1) of the Regulations should be limited as follows:

   a. service shall not be effected on a Saturday, Sunday or any other day defined as a holiday in subsection 35(1) of the Interpretation Act.

   b. service after 5:00 p.m. (recipient's time zone) shall be deemed to be served at 9:00 a.m. the next business day.

**Subsection 1(b)**

2.3 Delete the phrase "acknowledgment of receipt" from subsection (1)(b) because this phrase is unclear and ambiguous. What constitutes "acknowledgment of receipt"? Who is the acknowledgment from - the party being served or Canada Post or the courier that serves the documents or other material?

2.4 Presumably, the purpose of obtaining the acknowledgment is to have confirmation that the documents or other materials have indeed been served. According, we have replaced "acknowledgment of receipt" with "confirmation of delivery from Canada Post or the courier".

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3 Federal Court Rule, 144(2)
Subsection (1)(c) and (d)

2.5 For purposes of clarity, we propose that the 25 page limit explicitly state that the fax cover page is included. This practice is consistent with both the Federal Court Rules⁴ and the Ontario Superior Court of Justice, Rules of Civil Procedure.⁵

2.6 A document served by fax should also have the following additional limitations:
   
a. a document that is served by fax shall include a fax cover page that includes the following information:
   
i. Name, address and telephone number of sender;
   ii. Name of person on whom the document is served;
   iii. Date and time of transmission;
   iv. Total number of pages transmitted, including cover page;
   v. Number of a fax machine at which documents may be received;
   vi. Name and telephone number of person to contact if problem occurs in transmission.⁶

   b. the document that is served by fax shall consist of a font size no less than 11 points.

2.7 In subsection (1)(d), delete the word "other" before "manner"; and delete the phrase "including by electronic transmission". The deleted word and phrase are both unnecessary and redundant.

2.8 There are three possible recipients of service documents, namely the adverse party itself, its agent, or its representative for service. Our revision identifies all three possible recipients and explicitly states consent is required by one of them.

Delete subsection (6)

2.9 All of subsection (6) is deleted because it is too broad in scope and is too open for possible abuse.

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⁴ Federal Court Rule 140(4)

⁵ Rule 16.05(3.1)

⁶ Federal Court Rule 140 and Form 140 and Rules of Civil Procedure, Rule 16.05(3)
2.10 The specific phrase "comes to the notice of the person being served" within subsection (6), is too vague and uncertain. The effect of this phrase is to override subsections (1) to (4) and render these subsections meaningless.

2.11 For example, under subsection (6) and despite subsection (1)(d), a party may still serve a document by email on an adverse party despite the adverse party's refusal to be served by this method. Arguably, once the document is in the adverse party's office inbox, it still has "come to the notice" of the adverse party. Accordingly, it may be considered by the Registrar as served pursuant to subsection (6), regardless of whether in fact, the adverse party saw the email. Such a situation undermines the entire service process.

3. Reply Evidence

CIPO's proposed amendments

- Deleting s.43 of the Regulations which allows an opponent to file reply evidence as of right.

Our comments

3.1 We strongly oppose the proposed deletion of section 43 of the Regulations that allows an opponent to file reply evidence as a right.

3.2 To deny the opportunity to file reply evidence as a right undermines the principle of procedural fairness. For this reason, courts grant to the plaintiff the right to file reply evidence, and to advocate reply arguments.

3.3 The right to file reply evidence is necessary to ensure that each party has an equal opportunity to see and respond to the complete evidence filed by the other.

3.4 Reply evidence allows the opponent an opportunity to contradict or qualify new facts that emerge from the applicant's evidence, which the opponent had no chance to deal with when the opponent filed its evidence under section 41 of the Regulations. Where such new facts relate to the merits of the opposition (e.g. confusion, distinctiveness), then the opponent must have the right to file reply evidence.

3.5 For example, state of the register evidence is often filed by applicants, as part of their submission to the Board, to show the existence of purportedly relevant third party marks and possibly to show by inference, use of such marks in the marketplace. In order to fully respond to the applicant's submission, the
opponent requires the right to file reply evidence to contradict or qualify this evidence. Reply evidence may be filed to show that some, or all, of the purported third party marks are in fact under license or filed with the consent of the Opponent; or that the purported marks are not in actual use in Canada.

3.6 CIPO raises three concerns to support deleting section 43 of the Regulations, namely:
   a. reply evidence is rarely filed in any event;
   b. much of what is filed as reply evidence is not restricted to reply evidence; and
   c. the prescribed period for filing reply evidence is rarely used which leads to unnecessary delay in the proceedings.

3.7 With regard to the first concern, it is the right to have an opportunity to file reply evidence, not the fact that reply evidence is filed or not, that is essential to procedural fairness. Those who choose to file reply evidence should not be denied their right to do so.

3.8 With regard to the second concern that evidence being filed as reply evidence is not true reply evidence, we submit that this concern is already addressed by hearing officers who properly refuse to admit such evidence at all or simply accord little, if any, weight to such evidence.

3.9 The third concern regarding delay may be mitigated by fixing a time certain for the opponent to file its reply evidence. We propose a two (2) month period to file reply evidence with no possible extensions of time. The impact of this two-month period is minimal on the overall length of the proceeding.

4. Cross-examinations

CIPO’s proposed amendments

- Allow the parties to file their evidence sequentially under sections 41 and 42 of the Regulations before entering a prescribed period of three (3) months in which both parties would conduct all necessary cross-examinations.

- Amend section 44 of the Regulations as follows:

  44(1) All cross-examinations on affidavits or statutory declarations that have been filed with the Registrar in evidence under Rules 41 and 42 and are being relied on as evidence in the opposition must be completed within three months after the
filing and serving of the applicant's evidence under Rule 42 or the expiration of the
time for doing so, whichever is earlier.

44(2) No further evidence shall be adduced by any party except with leave of the
Registrar and on such terms as the Registrar determines to be appropriate,
including making an order for the cross-examination under oath of any affiant or
declarant on an affidavit or declaration that has been filed with the Registrar and
is being relied on as evidence in the opposition.

44(3) Cross-examinations shall be held at a time, date and location and before a
person agreed to by the parties or in the absence of an agreement, a party may
request that the Registrar issue an order setting the date, time and location of the
cross-examination.

Our comments

4.1 We support the proposal of sequential filing of evidence followed by a prescribed
period to complete all cross-examinations.

4.2 However, we would go further and allow for the sequential filing of the opponent's
evidence (under section 41), the applicant's evidence (under section 42) and
opponent's reply evidence (under section 43). After the reply evidence is served
and filed, or after expiry of the period to do so, the parties would then have a
three (3) month period to complete all necessary cross-examinations by both
parties. Of course, with consent, the parties could commence cross examinations
at an earlier date.

4.3 We repeat our comments in section 3 above regarding the necessity to allow the
opponent to have the opportunity to file reply evidence as a right.

4.4 Sequential filing is consistent with the practice in most, if not, all courts.
Sequential filing is consistent with CIPO's objective of conducting oppositions in a
timely manner.

4.5 If evidence is being filed sequentially, then it makes procedural sense for all
evidence - including any reply evidence - to be filed sequentially. Sequential filing
of all evidence simplifies the opposition regime.

4.6 In our view, in the vast majority of cases, three (3) months is sufficient time to
complete all necessary cross-examinations, including cross-examination on reply
evidence.
4.7 Completing all cross-examinations in the prescribed period should significantly decrease the overall length of time of the proceedings.

4.8 We recognize that there may be situations where a two month delay in commencing the cross-examinations may occur where an opponent allows the period to file reply evidence to expire without filing reply evidence.

5. Transcripts and Undertakings

CIPO’s proposed amendments

- The party who conducts the cross-examination is responsible for filing the transcript and the party whose affiant or declarant was cross-examined is responsible for filing the undertakings.

- Amend section 44(4) of the Regulations as follows:

  44(4) A transcript of the cross-examination and exhibits to the cross-examination shall be filed with the Registrar by the party conducting the cross-examination and served on the other party within one month after the date of the cross-examination.

  44(5) Any documents or materials undertaken to be submitted by the party whose affiant or declarant is being cross-examined shall be filed with the Registrar by that party and served on the other party to the proceeding within one month after the date of the cross-examination.

Our comments

5.1 We disagree with the proposal to allow the party whose affiant or declarant was cross-examined to be responsible for filing the answers to undertakings.

5.2 The right to cross-examination is a fundamental aspect of procedural fairness. The adverse party has the opportunity to cross-examine the affiant or declarant who has given evidence on behalf of the other party.

5.3 It is the adverse party's cross-examination. The adverse party controls the cross-examination. The cross-examination includes both the resulting transcript and the resulting answers to undertakings provided by the affiant or declarant on behalf of the other party.

5.4 To remove the adverse party's responsibility to file the answers to undertakings is to remove part of the adverse party's right to control its cross-examination.
5.5 To give control over the filing of answers to undertakings to the other side is to open the cross-examination process to possible abuse. If the other side is now responsible to file the answers to undertakings, there is no check to prevent the other side from bolstering its evidence through the answers it files. There is no right to continue cross-examination on the answers filed.

5.6 Presently, if the adverse party receives an answer that is improperly accompanied by new evidence that should have been filed initially, the adverse party may still exercise control to preserve the integrity of its cross-examination. The adverse party may file the answer provided but refuse to file the new evidence provided improperly.

5.7 In that case, there is no prejudice to the other side. The other side has the right to seek leave to file as additional evidence the new evidence, on which there is the possibility of cross-examination.

5.8 The present safeguard against the above-mentioned possibility of abuse is removed completely if the other side has the responsibility to file answers to undertakings.

6. Written Arguments and Hearings

CIPO’s proposed amendments

- Amend section 46 of the Regulations to set prescribed deadlines for parties to file and serve their written arguments sequentially followed by a prescribed period in which both parties may request an oral hearing.

- More particularly, there would be a three (3) month prescribed deadline following the completion of cross-examinations for the opponent to file and serve its written argument followed by a three (3) month prescribed deadline for the applicant to file and serve its written arguments. Parties may also request leave to file additional arguments under amended section 46(3) of the Regulations. Within one month after the service of the applicant’s written argument, either party may request an oral hearing.

- These amendments are reflected in the following amendments to section 46 of the Regulations:

46(1) The opponent may file written arguments with the Registrar and serve the applicant with a copy thereof within three months after completion of the parties' cross-examinations or the expiration of the time for doing so, whichever is earlier.
46(2) The applicant may file written arguments with the Registrar and serve the opponent with a copy thereof within three months after service of the opponent's written arguments or the expiration of the time for doing so, whichever is earlier.

46(3) No written arguments shall be filed and served after the expiration of the periods referred to in subsections (1) and (2), except with leave of the Registrar.

46(4) Either party may, within one month after service of the applicant's written arguments, file and serve a request to be heard at a hearing, which request must specify whether:
   i. the party will make representations in person or by telephone;
   ii. the party will make representations in English or French; and
   iii. simultaneous translation will be required if the other party makes representations in the other official language.

46(5) A party must choose English or French as the language for the hearing. A party may change the choice of language by notifying the Registrar in writing. The notice must be received by the Registrar no later than one month before the hearing.

In order to give effect to the new provisions requiring parties to serve written arguments, s. 45(3) of the Regulations should be deleted and s. 36 of the Regulations would also require amendment to delete the following phrase: “...with the exception of a written argument filed pursuant to subsection 46(3), to the other party in the opposition proceeding”.

Our comments

Sequential filing of written arguments

6.1 We support the proposal of sequential filing of written arguments. However, we would go further and allow for the sequential filing of the opponent's written argument, the applicant's written argument, and the opponent's reply written argument.

6.2 Our proposal provides the opponent the opportunity to file a reply written argument, as a right, instead of requesting leave to file it as an additional written argument under amended section 46(3).

6.3 This sequential filing of written arguments, including a reply written argument, is consistent with court practice and also mirrors the procedure at oral hearings before the Board.
6.4 Our reasoning for allowing the opportunity to file reply evidence as a right in section 3 above, equally applies to the opportunity for the opponent to file a reply written argument as a right. It is consistent with the principle of procedural fairness.

6.5 The right to file a reply argument is necessary to ensure that each party has an equal opportunity to hear and respond to the full submission of the other.

6.6 The reply written argument allows the opponent an opportunity to contradict or qualify new facts, issues or arguments that emerge from the applicant's written argument which the opponent had no chance to deal with when the opponent filed its initial written argument. Where such new facts, issues or arguments go to the merits of the opposition, then the opponent must have the right to reply.

6.7 If the reply argument is not restricted to true reply, then the Board may reject it, or if there is an oral hearing, reject it at the oral hearing.

6.8 The delay involved in allowing the opportunity to file a reply written argument may be mitigated by fixing a time certain for the opponent to file its reply argument. We propose a two (2) month period to file a reply written argument with no possible extensions of time. The impact of this two-month period is minimal on the overall length of the proceeding.

6.9 Furthermore, there is no prejudice to the applicant for allowing a reply written argument to be filed. The applicant, if it so wishes, may seek leave to file an additional written argument under amended section 46(3) of the Regulations.

**Requesting and scheduling of oral hearing**

6.10 To expedite the hearing date for the oral hearing, we propose that either party may request an oral hearing once all of the evidence is filed (including reply evidence), or the period to do so expires. Once the evidence is filed, the parties are in a position to determine if an oral hearing is required or preferable. It is not necessary to wait until the written arguments are filed (including possible reply argument), to request an oral hearing.

6.11 Our proposal provides the Board with at least eight months advance notice (three months each for the main written arguments, and two months for the reply argument) to schedule the oral hearing. Our proposal should significantly move forward the hearing date for an oral hearing.
PART II

Alternative Approach to Opposition Proceedings

General overview

1.1 In our view, the existing trade-mark opposition regime should be replaced in favour of an alternative approach that we outline in general terms below.

1.2 In our alternative approach, once a Counterstatement is served and filed, the Board sets the date for an oral hearing two years from the filing date of the Counterstatement.

1.3 At the same time, the Registrar also sets deadlines by which all other steps leading up to the oral hearing must be completed. The parties may confer with each other in an effort to reach a mutually acceptable timetable for all other steps leading to the fixed hearing date. The parties would jointly file this schedule to the Registrar and the schedule shall be subject to the Registrar’s approval.

1.4 The hearing date is fixed and shall not be extended unless:
   a. the parties both eventually choose not to attend an oral hearing;
   b. the parties settle the opposition; or
   c. the Registrar exercising his/her discretion, extends the hearing date.

1.5 Once the schedule of events are established, the parties shall have very limited ability to extend any deadlines, unless to complete bona fide settlement negotiations, or if extraordinary circumstances exist. The onus will be on the requesting party seeking an extension of time to justify moving away from set deadlines.

1.6 Our alternative approach is based in part on the U.S. trade-mark opposition regime. However, unlike the U.S. regime, the availability of extensions of time to complete a given step will be very limited.

1.7 Our alternative approach is also based, in part, on the case management regimes in use in the Federal Court of Canada and other Canadian courts.

1.8 In our view, our approach provides the following advantages all of which are consistent with the principle of procedural fairness. These advantages are as follows:
a. provides a reasonably swift determination regarding registration of the subject trade-mark application;

b. provides and promotes a degree of certainty as to when each step in the process shall occur and when a decision shall be reached;

c. opportunities for unnecessary delay are significantly reduced;

d. streamlines and modernizes the existing regime and makes it more consistent with procedural fairness safeguards found in our courts; and

e. simplifies the administration of the opposition regime.

General framework

1.9 Within 30 days of serving and filing the Counterstatement, the Board shall issue a notice to the parties setting the date for the oral hearing and for all deadlines by which various steps leading to the oral hearing must be completed.

1.10 The hearing date will be set for two (2) years from the filing of the Counterstatement. The remaining steps shall occur within prescribed periods of time:

a. **Pleadings Stage** - already completed with service and filing of Counterstatement. In our approach, the Counterstatement must be filed within two (2) months of service of the Statement of Opposition. No extension of time is available except for extraordinary circumstances.

b. **Evidence Stage** - serving and filing of all evidence, namely:

i. opponent's evidence within four (4) months from the filing of the Counterstatement;

ii. applicant's evidence within four (4) months from service of opponent's evidence; and

iii. opponent's reply evidence, if any, within two (2) months from service of the applicant's evidence.

c. **Cross-examination stage** - completion of all cross-examinations within three (3) months of service of opponent's reply evidence.
d. The parties shall write to the Board to confirm whether they will attend the oral hearing within one (1) month of the completion of the evidence phase.

e. **Written argument stage** - the parties shall serve and file their written arguments as follows:

i. the opponent's written argument within two (2) months from the completion of the cross-examination stage;

ii. the applicant's written argument within two (2) months from service of the opponent's written argument; and

iii. the opponent's reply written argument within one (1) month from service of the applicant's written argument.

f. **Oral hearing** - attendance at the oral hearing

1.11 As indicated above, the parties if they chose to do so, may jointly file a revised timetable for all steps in the opposition proceedings, except for the hearing date.

1.12 This schedule must be approved by the Registrar.

**ALL OF THE ABOVE IS RESPECTFULLY SUBMITTED BY MOFFAT & CO. / MACERA & JARZYNA, LLP.**