

TRADEMARK OPPOSITIONS IN CANADA

What is an Opposition Proceeding?

A trademark opposition is a complex adversarial proceeding. It is commenced by a third party who objects to the registration in Canada of a trademark which is the subject of a still pending application. The purpose of an opposition proceeding is to determine whether the trademark should be registered to the applicant in Canada.

In most cases, a trademark registration grants the registrant the exclusive right to use the trademark across Canada. A valid trademark registration is also considered an absolute defence to any claims of infringement that may be brought by another party respecting a similar mark. However, the refusal of trademark application does not necessarily mean that the applicant cannot use the trademark in Canada. Only the courts can issue orders against parties prohibiting the use of a trademark.

Most opposition proceedings are resolved during the course of the opposition, but a complete opposition may last more than two years.

Who can Oppose a Trade-Mark?

Any person may oppose a pending trademark application. If desired, any number of persons can be named jointly as opponents. All joint opponents must be identified in the statement of opposition when filed.

What are the Grounds of Opposition?

A pending trademark application may be opposed on the following grounds:

- the **application does not conform** with regulatory requirements, usually in that:
 - the stated date of “first use” of the mark in Canada is inaccurate; or
 - the applicant could not have been satisfied that it was entitled to registration of the trademark in Canada given its knowledge that another party had prior use of the mark, or a confusingly similar mark, in Canada.

- the applied-for-mark is **not registrable** in Canada, usually in that:
 - the mark is a generic term for the associated wares or services (in any language);
 - the mark is primarily merely a surname;
 - the mark is confusing with another trademark, official mark, an Olympic mark or a geographical indication registered in Canada;
 - the mark may be mistaken for an official crest, flag or symbol adopted by any level of government in Canada, the government of another country, the Red Cross (and other equivalent organizations) or the Royal family; or
 - the mark is scandalous, obscene or immoral.
- the applicant is **not the person entitled to registration** of the trademark in Canada, usually in that:
 - another party had prior use of the mark or a confusingly similar mark in Canada; or
 - the applicant used the mark only as a licensee of another party.
- the trademark is **not distinctive** of the applicant, usually in that:
 - another party had prior use of the mark or a confusingly similar mark in Canada; or
 - multiple parties had prior use of the mark or confusingly similar marks in Canada.

When & How is an Opposition Commenced?

An opposition cannot be commenced until after the trade-mark application has been advertised in the [Trade-marks Journal](#). After advertisement, there is a two-month period within which a potential opponent can: (a) file a statement of opposition; or (b) request a four month extension of time to do so.

With sufficient reasons and the payment of the required fee, a retroactive extension of time may be granted to file a statement of opposition after the two-month period of time has elapsed. However, no opposition proceeding may be

initiated for any trademark application after a notice of allowance has been issued.

An opposition is formally commenced by the filing of a statement of opposition together with the required fee with the Trademark Opposition Board. At present, the prescribed fee is \$750.

What are the Steps in an Opposition Proceeding?

Step	When...	What...
1	Within 2 months after advertisement...	Opponent files: (a) statement of opposition; or (b) a request for 3 month extension of time to do so.
2	Within 3 months after statement of opposition is filed...	Opposition board reviews statement of opposition and, if approved, forwards copy to counsel for the applicant.
3	Within 2 months after statement of opposition is forwarded to the applicant...	Applicant serves and files: (a) counterstatement; or (b) with the consent of the opponent, a request for 2 month extension of time to do so.
4	Within 4 months after counterstatement is filed...	Opponent serves and files: (a) affidavit evidence; (b) a statement that it intends to file no evidence; or (c) with the consent of the applicant, a request for 3 month extension of time to do so.
5	Within 2 months after opponent serves affidavit evidence...	Applicant <u>may</u> simultaneously request: (a) an order for cross-examination of the opponent's affiants; and (b) an order extending the time period for filing its own affidavit evidence until 4 months after said examination is complete.
6	4 months after opponent files affidavit evidence...	Applicant serves and files: (a) affidavit evidence; (b) a statement that it intends to file no evidence; or, (c) with the consent of the opponent, a request for 3 month extension of time to do so.
7	Within 2 months after opponent serves affidavit evidence...	Opponent <u>may</u> simultaneously request: (a) an order for cross-examination of the applicant's affiants; and (b) an order extending the time period for filing its reply affidavit evidence until 4 months after said examination is complete.
8	1 month after applicant files affidavit evidence...	Opponent files: (a) reply affidavit evidence; or (b) with the consent of the opponent, a request for 4 month extension of time to do so.
9	Within 14 days after all affidavit evidence is filed...	Opposition board will issue notice inviting the submission of written argument. After this notice is issued, no further orders for cross-examination may be requested.

10	1 month after invited to submit written argument...	Applicant and opponent file: (a) written argument; or (b) a request for 4 month extension of time to do so. Upon receipt, opposition board forwards copy of written argument to the opposing parties.	16	Within 6 months after oral hearing...	Opposition board releases written decision.
11	1 month after receiving forwarded copy of written argument filed by opposing party...	Applicant or opponent may request an oral hearing to be conducted in either English or French. Hearing date may be scheduled as much as be 12 – 18 months after request is filed.	17	Within 2 months after decision is released...	Notice of appeal served and filed, if any.
12	No less than 90 days before the hearing date...	Notice of hearing date issued.	<p><i>Finalizing Settlement:</i> If the parties agree in principle to resolve the opposition, the opposition board will grant a <u>3 month</u> extension of time to finalize the terms of agreement. This extension will be granted only once during an opposition proceeding.</p> <p><i>Cooling Off Period:</i> The opposition board will grant one extension of time of <u>up to nine months</u> at any stage of an opposition proceeding to allow the parties to negotiate a settlement of the dispute. This extension is especially intended to assist party's negotiating trade-mark disputes in multiple jurisdictions. Again, this extension will be granted only once during an opposition proceeding.</p>		
13	Within 30 days after notice of hearing date...	Applicant and opponent required to confirm attendance at hearing. With sufficient reasons, hearing may be rescheduled once to accommodate counsels' schedules.	<p>Is Evidence Confidential?</p> <p>All legal documents and evidence filed with the opposition board is available for public inspection. The opposition board has no authority to grant confidentiality orders restricting access to any of its records.</p>		
14	No less than 5 days prior to oral hearing...	Applicant and opponent file list of case law to be relied upon in oral argument together with copies of any unpublished cases.	<p>Can Legal Costs be Recovered?</p> <p>No. The opposition board does not have the authority to award legal costs to any party involved in an opposition proceeding.</p>		
15	No less than 90 days after notice of hearing date issued...	Oral hearing conducted: (a) in person at Ottawa; (b) by videoconference; or (c) by telephone conference call. Simultaneous translation may be requested where required.			

What are the Settlement Options?

The parties are strongly encouraged to consider the options for settlement at every stage of an opposition proceeding. Indeed, most opposition proceedings settle prior to a decision.

An opposition proceeding may be resolved in a variety of ways, the most common being:

- a. the express abandonment of the application, with or without prejudice;
- b. the express abandonment of the opposition, with or without prejudice;
- c. the abandonment of the application by failing to file a counterstatement or evidence by the stipulated deadlines;
- d. the abandonment of the opposition by failing to file evidence by the stipulated deadlines;
- e. the negotiation of a co-existence agreement wherein the parties agree to terms upon which both may continue to use their respective marks, including an agreement to either expressly abandon the application or withdraw the opposition.

Where Can I Get More Information?

You can get more information by visiting the web site for:

Canadian Intellectual Property Office
www.cipo.ic.gc.ca

Or by contacting:

Ballagh & Edward LLP
McMaster Innovation Park
175 Longwood Road South, Suite 102
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