



Ficpi Canada Comments on the Practice Notice on Divisional Applications in Opposition

14 January 2019

FICPI (Federation Internationale des Conseils en Propriété Intellectuelle), comprises more than 5000 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI. FICPI represents not only the interests of Canadian patent and trade mark professionals but also our clients who span all technologies, commercial fields and sizes. FICPI has a long history of study and work aimed at improving IP systems nationally and globally. Our membership includes senior professionals at most major Canadian intellectual property firms and many smaller firms. We invite CIPO to consider the comments we have set out below in response to the Public Consultation opened from November 26, 2018 to December 21, 2019 and made on behalf of FICPI Canada.

Practice Notice on Divisional Applications in Opposition

Introductory comments

At the outset we would comment that while having the option of filing divisional applications will be useful to many applicants, it is a measure that will add to the worsening Canadian Register clutter and therefore cost of entry to new enterprises. If applicants have a readily available means of advancing some goods and services and leaving others the subject of further argument aimed at advancing the application, it will encourage filing across a greater number of classes. Divisional applications are not without cost and would therefore expect this option to be disproportionately utilized by larger entities able to bear the additional cost. This is yet another change that, overall, stands to disadvantage SMEs who are already facing additional costs owing to register clutter.

We again, strongly advocate CIPO's consideration of legislative changes to require all trademark owners to prove that they have used their marks in association with goods and services claimed as this is the single best way to ensure that SMEs are not disadvantaged unnecessarily under the new system. While we favour requiring a declaration by registrants after 5 years of registration, the same results could be achieved if Registrar initiated s. 45 actions were brought in respect of all registrations reaching the 5-year mark.

V Procedures followed for divisional applications filed during or after opposition proceedings

This section references the situation of parties requesting leave to file an amended statement of opposition or counterstatement when a divisional application has been filed. We would favour reference in the practice notice to a default rule that has the effect of ensuring that pleadings relating to



goods and services that have been divided out of an application are considered to have been revised to reflect the current listing of goods and services. Perhaps this could be done with simple confirmation from the party that it is what is intended. This would save parties the cost of preparing and filing revised pleadings thereby making Opposition proceedings less costly and time consuming.

VII Divisional application is filed after the opposition period is extended but before a statement of opposition is filed

In this provision the Board has identified that it would be sympathetic to requests for retroactive extensions of time in which to Oppose an application that had goods or services divided out during the period in which the time in which to Oppose has been extended but before a Statement of Opposition has been filed. It is of course reasonable that an Opponent be permitted to do this otherwise there is potential for considerable manipulation of the process of filing divisionals to avoid Opposition. However, we believe that the Opponent should also be permitted to receive a retroactive extension of time to Oppose the application from which the divisional was created.

The Opponent will have based its decision about the continuance of Opposition on a set of facts that included removal of particular goods and/or services. It would therefore be unfair to preclude the Opponent from re-opening the initial Opposition were some goods and services then made the subject of a divisional application. By way of example, an Opponent in the mining field might feel justified in Opposing an application for a similar mark that covered mining equipment and “computer programming and software design” services. Were the applicant then to delete its mining equipment goods but retain the computer programming and software design services the Opponent might accept this state of affairs. However, once the Applicant re-claimed the mining related equipment in a divisional application and it became obvious its commercial interests covered the mining field the opponent might decide that to adequately protect its rights it would be best to oppose both the divisional and the parent application. In permitting a retroactive extension of time in respect of the parent application as well, we hope abuse of the process through the filing of divisionals will be minimized.

We thank the Registrar for the clear examples provided for in the practice notice. These are incredibly helpful in simplifying the proposed procedures. However, in practice we recognize that the problems and solutions will be far more nuanced. For this reason, every effort should be made to ensure that the practice of filing divisional applications does not disadvantage trademark owners who wish to protect their rights through opposition.



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

[FICPI Submission Template
enter paper title here]

* * *

FICPI Comprises The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a regional Andean Section comprising our membership in Colombia, Ecuador, Peru, Venezuela and Bolivia, a provisional national section in Poland and individual members in a further 41 countries and regions. This submission is made on behalf of FICPI CANADA

[End of document]



FICPI Canada Comments on Practice in trademark opposition proceedings

14 January 2019

FICPI (Federation Internationale des Conseils en Propriété Intellectuelle), comprises more than 5000 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI. FICPI represents not only the interests of Canadian patent and trademark professionals but also our clients who span all technologies, commercial fields and sizes. FICPI has a long history of study and work aimed at improving IP systems nationally and globally. Our membership includes senior professionals at most major Canadian intellectual property firms and many smaller firms. We invite CIPO to consider the comments we have set out below in response to the Public Consultation opened from November 26, 2018 to December 21, 2019 and made on behalf of FICPI Canada.

Practice in trademark opposition proceedings – Initial Comments

We thank the Board for the thoughtful and extensive study that went into the preparation of this practice notice. It represents a vast improvement over the current Opposition Practice document. The document exhibits much better organization and brings needed clarity to a number of components of Opposition proceedings. The Notice should provide practitioners and trademark owners with an excellent guide to Opposition practice. Since neither the Board nor opposing counsel benefit from involvement with unskilled persons, we are hopeful these new and better descriptions will raise the level of Opposition practice in Canada.

We have not positively commented on each and every notable improvement but rather have chosen the most welcomed. Unfortunately, there are also a few areas where revision and clarification would assist users of the system. We draw your attention to these in the hope of your further consideration of these with a view to possible revision.

II.2 Interlocutory rulings

This section of the practice notice explicitly prohibits an Opponent from seeking an interlocutory ruling to strike a portion of the counterstatement. We wonder on what authority the Registrar has made this prohibition when the case *Novopharm Limited v. AstraZeneca AB*(2002), 21 C.P.R. (4th) 289 at 294 (F.C.A.), which is identified as authority in the current practice, does reference both



Applicant and Opponent.

More specifically:

Even though there is no express provision in the Regulation, section 40 necessarily implies that an applicant or opponent may make an interlocutory motion to amend its own pleadings. I think it must also follow that the applicant or opponent may make an interlocutory motion to strike all or any portion of the other party's pleadings. As determined in Novopharm, supra, the appropriate time to challenge pleadings is at an interlocutory stage before evidence is filed.

We believe there are instances wherein it is equitable to allow an Opponent to seek clarification to pleadings contained in a counterstatement. Absent this, the Opponent could incur unnecessary expense to lead evidence and arguments in response to pleadings that are uncertain. There is a clear bias in favour of applicants if an Opponent is prevented from challenging the clarity of pleadings under any circumstances. The principle that a party is entitled to know the case it must meet applies equally to Opponent and Applicant, particularly when for example the Opponent carries the initial, if light, burden. Poorly pleaded counterstatements complicate proceedings as much as poorly pleaded Statements of Opposition do- there should be a readily accessible means for fixing both.

We also believe that it is reasonable to expect a decision in respect of an interlocutory challenge prior to advancing to the next stage un the proceedings. For this reason, requesting a ruling should “stop the clock” with the challenging party’s next deadline running from the date of the interlocutory decision. This is particularly the case given what is often a lengthy wait for an interlocutory ruling.

IV Evidence

This section should prove helpful to both new and seasoned representatives. Well done!

IV.3 Partial Evidence

This small change should prove helpful at preventing sharp practices. Reducing the opportunity for a small minority to take advantage of the process stands to benefits all users of the system and increase the value of proceedings to participants.

VII.2 Conducting the Cross-examination



This section again brings much needed clarity to what is currently a confusing morass of deadlines and responsibilities.

The removal of the requirement for consent to conduct the cross-examination by video conference is another very welcomed change. This one small measure will ensure that parties do not risk loss of evidence simply because of high cost of travel to conduct the cross-examination in person. This change should go a long way towards ensuring the proceedings are accessible to, and useable by, SMEs.

VII.3 Service requirements

Making the party cross-examined file responses to undertakings does simplify the proceedings and is therefore a welcomed change. However, while we do not object to this section in its entirety we wonder if the mandatory language “must submit” is appropriate? The deposing party has the choice to file or not, and indeed this is contemplated by the following section, VII.4. Perhaps revision to this section would remedy what appear to be contradictory suggestions as to whether filing of transcripts is mandated.

IX.7 Jurisprudence

Under current practice there is considerable variation amongst practitioners as to how notification of case law relied upon during the Hearing must be identified and when this had to be provided to the other party and the Board. What resulted under the current practice notice was situation wherein some Agents respected the intent of the practice notice, namely to allow a party opportunity to research and prepare a response to any additional jurisprudence that would be discussed at during the hearing, whereas others ignored it with no apparent ramification. The revised practice notice does not address this issue and in fact further obfuscates this aspect of the proceedings.

We suggest that the practice notice should be revised to make it clear that failure to provide notification in advance could result in the submissions surrounding the particular case not being considered and/or an adjournment of the Hearing to allow the other party sufficient time to respond.

We also suggest a better description of what “The Common List of Authorities” is and what the “Registrar’s database of decisions comprises. It might be useful for the notice to provide for the



option of a party requesting copies of decisions from opposing counsel, if they wish.

We suggest it would be appropriate to remove the ambiguity in the last sentence of this section which might suggest to some that no advance notification is required and it will suffice to merely bring a copy along the day of the Hearing, raising the case for the first time on that day.

X Extensions of Time

We strongly applaud the extension of the cooling off period so that it now runs up to and including argument stage. The fact is that parties might decide that owing to the disclosure of facts or arguments not initially known, negotiated settlement is best. In fact, it is counterintuitive to suggest, as the current practice does, that the optimal time for negotiations is before the evidence stage concludes. In reality no party should settle without seeing the evidence relied upon by the other party. That Canadian Opposition practice now proposed, facilitates negotiation at all reasonable stages in Opposition proceedings is a laudable advancement.

For most, if not all cases, more than one month is however needed to collect, prepare and file responses to undertakings. Anticipating the effect of pending Bill C-86, we expect evidence in Opposition to become more, not less, complex. We also expect more detailed cross-examinations with a greater number of requests for undertakings. One month is, quite simply, insufficient now. At the very least the collection of, for example, voluminous or very old documentation required to respond to undertakings should be listed as a justification for an extension of time based on exceptional circumstances.



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

[FICPI Submission Template
enter paper title here]

* * *

FICPI Comprises The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a regional Andean Section comprising our membership in Colombia, Ecuador, Peru, Venezuela and Bolivia, a provisional national section in Poland and individual members in a further 41 countries and regions. This submission is made on behalf of FICPI CANADA

[End of document]



FICPI Canada Comments on Practice in section 45 proceedings

14 January 2019

FICPI (Federation Internationale des Conseils en Propriété Intellectuelle), comprises more than 5000 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI. FICPI represents not only the interests of Canadian patent and trade mark professionals but also our clients who span all technologies, commercial fields and sizes. FICPI has a long history of study and work aimed at improving IP systems nationally and globally. Our membership includes senior professionals at most major Canadian intellectual property firms and many smaller firms. We invite CIPO to consider the comments we have set out below in response to the Public Consultation opened from November 26, 2018 to December 21, 2019 and made on behalf of FICPI Canada.

Practice in section 45 proceedings

IV.4 Evidence of licensed use

We would urge caution in stating that it is not necessary to furnish a copy of any license agreement in a section 45 proceeding and “A statement in the affidavit or statutory declaration that the registered owner had under license, direct or indirect control of the character or the quality of the subject goods or services is sufficient. [Empresa Cubana Tabaco v Shapiro Cohen, 2011 FCA340].” While it is true that a license is not always necessary, we do not believe that it is settled law that a mere statement that the owner had direct or indirect control will in all cases suffice.

Mr. Justice Kellen of the Federal Court did not find that a simple statement of the sort described in the practice notice would be sufficient, rather he concluded that a combination of facts led to the conclusion that adequate control existed. It is therefore inaccurate to convey to parties to s. 45 proceedings that in all cases a simple statement will be sufficient.

Furthermore, when indicating what evidence might lead to a conclusion of adequate control Mr. Justice Kellen stated one option as being “They can clearly swear to the fact that they exert the requisite control”. We believe that stating that adequate control was exerted is NOT the same as making a statement that an owner had, under license, direct or indirect control. If a license arrangement provided for control but none was taken, an affiant could validly state he or she had,



under license, direct or indirect control and be compliant with what is suggested in the practice notice. However absent wording that attests to control being exerted, under the Empress case, requirements have not been met.

We would suggest that what constitutes adequate control under s. 50 (1) is not as settled as what is specified in the practice notice and this portion should be rewritten to include language that better reflects the Empresa decision. It might suffice to simply revise the last sentence to state:

A statement in the affidavit or statutory declaration that the registered owner had exerted the requisite direct or indirect control of the character or the quality of the subject goods or services may under some circumstances be sufficient.

IV.6 Consequence for registered owner's failure to furnish evidence

Given that valuable rights are at stake and that it is possible for CIPO forwarded mail to be directed other than to the intended recipient we would urge the Registrar to grant leave to file evidence if it can be shown that the correspondence did not reach the trademark owner or the trademark owner's representative for service. A letter indicating the registration will proceed to expungement before actual expungement would go a long way towards ensuring trademark owners who are currently using their marks in Canada are not stripped of rights merely because of faulty correspondence handling. We would encourage the Registrar to do everything possible to ensure this does not occur by whatever means are possible.

VII.7 Jurisprudence

Under current practice there is considerable variation amongst practitioners as to how notification of case law relied upon during the Hearing must be identified and when this had to be provided to the other party and the Board. What resulted was a situation wherein some Agents respected the intent of the practice, namely to allow a party opportunity to research and prepare a response to any additional jurisprudence that would be discussed at during the hearing, whereas others ignored it with no apparent ramification. The revised practice notice does not address this issue and in fact further obfuscates this aspect of the proceedings.

We suggest that the practice notice should be revised to make it clear that failure to provide notification in advance could result in the submissions surrounding the particular case not being considered and/or an adjournment of the Hearing to allow the other party sufficient time to respond.



We also suggest a better description of what “The Common List of Authorities” is and what the “Registrar’s database of decisions comprises. It might be useful for the notice to provide for the option of a party requesting copies of decisions from opposing counsel if they wish.

We also suggest removing the ambiguity in the last sentence of this section which might suggest to some that no advance notification is required and that it will suffice to merely bring a copy along the day of the Hearing, raising the case for the first time on that day.

VIII Extensions of Time

We advocate the inclusion of benchmark extensions of time available on consent. While in the past the Registrar has not made these available on the basis that the process is not truly an *inter partes* proceeding, in reality it is not at all rare that there are two parties involved with competing interests. Frequently parties can reach agreement that both can live with. A very common problem encountered today is that parties do not have sufficient time to negotiate such an arrangement and there is no recourse available such as extensions on consent. Since negotiated settlement offers a less expensive means of resolving a case, this option should be facilitated, not discouraged, as is the case with current practice as well as the proposed new practice.

We also advocate for a final 3-month extension to conclude settlement, as is available in Opposition.

While on the face the amount of time awarded to parties to prepare written representations is the equal, in fact this is not the case. The Requesting Party’s deadline runs from a CIPO created date, namely the date of the notice calling for written representations, while the Registrant’s deadline runs from receipt of the Requesting Party’s representations. It is not unheard of for mail to take 2 weeks to reach a party’s representative, leaving six weeks. While under normal circumstances this should be sufficient time to report out the content of the representations received, counsel the client regarding an appropriate response and prepare and file that response, there are times when two months will simply not suffice. If for example a foreign associate is involved this means the information both outgoing and incoming must flow through another entity. Holidays and summer can cause delays. This puts unnecessary pressure on trademark owners and their representatives.



We recommend including a short benchmark extension of one month be available either on consent or with good reasons. Examples of acceptable justification should be set out and should include factors such as dealing with an intermediary such as a foreign associate and/or holidays.

The substantial delays awaiting a hearing and/or decision, combined with an inflexible procedure that does not accommodate parties to the proceedings does not serve either trademark owners or those challenging existing rights. It is not infrequent to hear complaints about this aspect of practice from our clients. We would urge the Registrar to reduce waiting times for decisions and ensure that parties have time to either negotiate or to properly consider and respond to representations

We invite the Registrar to explain the circumstances under which retroactive extensions of time to file additional evidence will be granted to the Registrant. While in the past such a grant was rare, it seems there might be increased reliance on this. If such grants are being made, all Registrants should be made aware of the availability and be told what justifies such a grant.

* * *

FICPI Comprises The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a regional Andean Section comprising our membership in Colombia, Ecuador, Peru, Venezuela and Bolivia, a provisional national section in Poland and individual members in a further 41 countries and regions. This submission is made on behalf of FICPI CANADA

[End of document]



FICPI Canada Comments on the Pilot project on registrar initiated section 45 proceedings Practice Notice

14 January 2019

FICPI (Federation Internationale des Conseils en Propriété Intellectuelle), comprises more than 5000 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI. FICPI represents not only the interests of Canadian patent and trade mark professionals but also our clients who span all technologies, commercial fields and sizes. FICPI has a long history of study and work aimed at improving IP systems nationally and globally. Our membership includes senior professionals at most major Canadian intellectual property firms and many smaller firms. We invite CIPO to consider the comments we have set out below in response to the Public Consultation opened from November 26, 2018 to December 21, 2019 and made on behalf of FICPI Canada.

Pilot project on registrar-initiated section 45 proceedings

It is incontrovertible that the pending changes to Canadian Trademark legislation have resulted in a greater number of applications covering a large number of classes of goods and services. These claims have no tie to commercial reality and may be termed “register clutter”. Having such registrations on record increases the cost for new businesses of acquiring IP rights. There are several ways in which this manifests. First, a company attempting to acquire rights will be faced with more complex and therefore expensive clearance efforts. Skipping clearance altogether won’t save cost as citations are more likely given registrations are covering more goods and services- again increasing costs. A new business might require attempts before finding and protecting a mark – that represents an unnecessary tax on new businesses. The cost is even higher for Canadian new businesses who are far more likely to have relied on common-law use-based rights to delay filing an application. These businesses could face the high cost associated with formal challenges to others blocking their way, or might have to rebrand, again at a substantial cost and potential loss of goodwill. FICPI members have long advocated for a means of ensuring that overly broad registrations are circumscribed such that these reflects real commercial rights. To do this registrants must be called upon to prove the rights they have claimed are in fact supported by actual use in Canada. We therefore thank the Registrar for including in the new practise, a registrar-initiated section 45 proceeding.

FICPI members believe that to be truly effective at removing the current and future barriers to new business the Registrar-initiated cancellation proceedings should apply to, ideally, all registrations but if not then a very substantial number. We believe abusive claims to non-existent rights will be directly correlated to the frequency of registrar-initiated s. 45 proceedings. If only a small fraction of



registrants can expect to be called upon to prove use, then clutter will prevail. This is not a supposition- it reflects what clients are now being advised to do. While our practitioners have a healthy concern for and interest in a well-balanced IP system, the fact remains we are required to offer our clients the best advice possible. If the current system permits registrants to acquire rights in no way tied to commercial use in Canada, it does not matter whether we believe this harms the system, or businesses in general, we are ethically obligated to advise our clients as to the availability of such registrations and the risks associated therewith. If only a small number of registrar-initiated notices are sent, our advice will be that it is unlikely a registrant will ever face challenge. That changes if we are able to say many or most will be challenged. We therefore urge CIPO to issue such notices in respect of most or all registration, especially targeting those filed since the new legislation passed as that was when overly broad claiming first began in earnest.

I Selection of registrations

FICPI members are in strong agreement that targeted registrations should include those with wide and varied listings of goods and services. We consider these to be far more problematic and likely to raise the cost of entry into the IP system of new businesses than old registrations and therefore suggest CIPO focus solely on these.

II Review and option for discontinuance

We believe the provisions set out in the practice notice governing the sending of these notices and requirements the recipient must meet are generally well thought out, reasonable and fair to all. We welcome in particular the ability to file evidence electronically as this represents a saving of otherwise unnecessary cost to trademark owners.

IV.4 Evidence of licensed use

We would urge caution in stating that it is not necessary to furnish a copy of any license agreement in a section 45 proceeding and “A statement in the affidavit or statutory declaration that the registered owner had under license, direct or indirect control of the character or the quality of the subject goods or services is sufficient. [Empresa Cubana Tabaco v Shapiro Cohen, 2011 FCA340].” While it is true that a license is not always necessary, we do not believe that it is settled law that a mere statement that the owner had direct or indirect control will in all cases suffice.

Mr. Justice Kellen of the Federal Court did not find that a simple statement of the sort described in the practice notice would be sufficient, rather he concluded that a combination of facts led to the



conclusion that adequate control existed. It is therefore inaccurate to convey to parties to s. 45 proceedings that in all cases a simple statement will be sufficient.

Furthermore, when indicating what evidence might lead to a conclusion of adequate control Mr. Justice Kellen stated one option as being “They can clearly swear to the fact that they exert the requisite control”. We believe that stating that adequate control was exerted is NOT the same as making a statement that an owner had, under license, direct or indirect control. If a license arrangement provided for control but none was taken, an affiant could validly state he or she had, under license, direct or indirect control and be compliant with what is suggested in the practice notice. However absent wording that attests to control being exerted, under the *Empress* case, requirements have not been met.

We would suggest that what constitutes adequate control under s. 50 (1) is not as settled as what is specified in the practice notice and this portion should be rewritten to include language that better reflects the *Empresa* decision. It might suffice to simply revise the last sentence to state:

A statement in the affidavit or statutory declaration that the registered owner had exerted the requisite direct or indirect control of the character or the quality of the subject goods or services may under some circumstances be sufficient.

IV.6 Consequences for registered owner's failure to furnish evidence

Given that valuable rights are at stake and that it is possible for CIPO forwarded mail to be directed other than to the intended recipient we would urge the Registrar to grant leave to file evidence if it can be shown that the correspondence did not reach the trademark owner or the trademark owner’s representative for service. A letter indicating the registration will proceed to expungement before actual expungement would go a long way towards ensuring trademark owners who are currently using their marks in Canada are not stripped of rights merely because of faulty correspondence handling. We would encourage the Registrar to do everything possible to ensure this does not occur by whatever means are possible.

VI.6 Jurisprudence

Under current practice there is considerable variation amongst practitioners as to how notification of case law relied upon during the Hearing must be identified and when this had to be provided to the other party and the Board. What resulted was a situation wherein some Agents respected the intent of the practice, namely to allow a party opportunity to research and prepare a response to any additional jurisprudence that would be discussed at during the hearing, whereas others ignored it with no



apparent ramification. The revised practice notice does not address this issue and in fact further obfuscates this aspect of the proceedings.

We suggest that the practice notice should be revised to make it clear that failure to provide notification in advance could result in the submissions surrounding the particular case not being considered and/or an adjournment of the Hearing to allow the other party sufficient time to respond.

We also suggest a better description of what “The Common List of Authorities” is and what the “Registrar’s database of decisions comprises. It might be useful for the notice to provide for the option of a party requesting copies of decisions from opposing counsel if they wish.

We also suggest removing the ambiguity in the last sentence of this section which might suggest to some that no advance notification is required and that it will suffice to merely bring a copy along the day of the Hearing, raising the case for the first time on that day.

* * *

FICPI Comprises The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a regional Andean Section comprising our membership in Colombia, Ecuador, Peru, Venezuela and Bolivia, a provisional national section in Poland and individual members in a further 41 countries and regions. This submission is made on behalf of FICPI CANADA

[End of document]



FICPI Canada Comments on the Practice notice involving Opposition to Protocol Applications and section 45 cancellation proceedings against Protocol registrations

14 January 2019

FICPI (Federation Internationale des Conseils en Propriété Intellectuelle), comprises more than 5000 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI. FICPI represents not only the interests of Canadian patent and trade mark professionals but also our clients who span all technologies, commercial fields and sizes. FICPI has a long history of study and work aimed at improving IP systems nationally and globally. Our membership includes senior professionals at most major Canadian intellectual property firms and many smaller firms. We invite CIPO to consider the comments we have set out below in response to the Public Consultation opened from November 26, 2018 to December 21, 2019 and made on behalf of FICPI Canada.

1.2 CIPO will notify the IB of all Protocol Applications yet to be advertised 10 months after the deemed filing date

We would like to be assured that protocol applications will not be preferentially examined so as to meet the 10-month deadline. All applicants should be treated equally, and all applications should undergo rigorous examination in respect of formalities, substantive and relative rights to ensure Canadian registrations are meaningful representations of true commercial rights.

1.3. Extension limitations when filing a statement of opposition

We welcome the recommendation to rely on the on-line window when requesting extensions of time to oppose, however service interruptions to CIPO's on-line services are not only frequent but seemingly increasing in duration. We would welcome all efforts on the part of CIPO to ensure this service is available at all times during business hours, across Canada.

1.4 Filing a statement of opposition

It is essential that an Opponent be permitted to frame its pleadings in the manner it wishes to do so without being restricted in any way. For this reason the "on-line" system referred to must facilitate additional or replacement framing of the grounds. In light of the coming legislative changes



associated with Bill C-86 that should result in more reliance on Opposition to determine relative rights, it is even more essential that an Opponent have the freedom to structure its pleadings in a way that allows it to put forward the best case under the legislation and jurisprudence of the day. That flexibility is not offered in a “tick the box” format.

The Schedule A sample form does not allow sufficient scope to allow Opponents to tailor grounds and should be revised so as to allow an opponent to enter the exact wording it wishes for each ground as well as to allow an Opponent to include additional information to the proposed wording should the Opponent wish to do so. There are many examples of how the restrictive wording could add complexity, increase interlocutory challenges and perhaps even deny the Opponent a ground of Opposition and/or result in loss of rights.

One example is the current wording relating to 38(2)(a) and 30(2)(b) which seems to preclude the Opponent from claiming that the goods or services are not defined specifically as required by s. 29 of the Regulations.

Another example relates to the 38(2)(a) and 30(2)(c) ground which is ambiguous and invites a challenge in respect of the sufficiency of these pleadings. Opponents should retain the right to plead in a manner that reduces or eliminates the likelihood of interlocutory challenge that will increase costs for parties to these proceedings.

S. 38(2)(b) and 12(1)(b) seems to require an Opponent to define the ground according to whether the Applicant used or proposed to use the mark, yet is the Applicant- not the Opponent, with knowledge of this. Allowing the Opponent to draft the precise wording could reduce the likelihood that in ticking both boxes the Opponent invites a challenge on the basis the ground has been insufficiently pleaded.

1.10 No new ground of Opposition

FICPI members believe that it is contrary to principles of natural justice to preclude an Opponent from adding a ground that only comes to light later in the proceedings, perhaps on review of the Applicant’s evidence. The obvious, if partial, remedy is to anticipate that an Opponent will plead all available grounds at the outset. This will undoubtedly also lead, in turn, to an increased use of interlocutory proceedings aimed at striking grounds for lack of support. We are strongly of the view that the practice notice should make it clear that an Opponent will not be considered to have added a ground of opposition provided, provided the ground was contained in the Statement of Opposition at the expiration of the period for filing pleadings, even if such a ground was subsequently struck.



Presumably the opponent would have to justify any request to reintroduce the ground and as such there is a check against abuse. The Bill C-86 proposed changes render Opposition proceedings more “final” as it will not be guaranteed that leave to file additional evidence will be granted. As such, it is all the more important that principles of natural justice be respected. FICPI members are of the view that this solution recognizes our treaty obligations but preserves principles of natural justice, including the right of an Opponent to bring its full case.

Our international colleagues in Australia have advised that grounds may be added in the course of their Opposition proceedings and as such, other common law jurisdictions have chosen to preserve this right.

We believe this is a very important clarification as without it, SME’s who might not have had the resources to conduct exhaustive research in advance of filing the Statement of Opposition will be prevented from making their best case if, for example, something comes to light in the proceedings that justify re-introducing a ground that had been struck for lack of support. It is unclear whether on appeal an additional ground could be added, so it is doubly important to preserve all ability to do this in the course of Opposition proceedings.

* * *

FICPI Comprises The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a regional Andean Section comprising our membership in Colombia, Ecuador, Peru, Venezuela and Bolivia, a provisional national section in Poland and individual members in a further 41 countries and regions. This submission is made on behalf of FICPI CANADA

[End of document]