

IP roadmap — Your path through a trademark opposition proceeding

Representing yourself before the Trademarks Opposition Board (TMOB)?

While it's recommended to consult a registered trademark agent, certain legal clinics at Canadian law schools offer free or low-cost legal information to help you understand TMOB procedures, prepare documents or get ready for a hearing.



1 File a statement of opposition

To start an opposition proceeding, the opponent must file a statement of opposition with the Canadian Intellectual Property Office (CIPO) that includes the following:

- the reasons, in detail, for their objection to the registration of the trademark (grounds of opposition)

The statement of opposition must rely on at least 1 of the grounds of opposition set out in subsection 38(2) of the Trademarks Act or section 104 of the Trademarks Regulations.

- the opponent's address in Canada (or their address abroad and the name and address of a person or a firm in Canada for the service of documents)
- payment of the prescribed fee

The opponent must file a statement of opposition within 2 months after the advertisement of the trademark application in the Trademarks Journal.

The statement of opposition will be forwarded to the applicant within 1 month if filed electronically or 5 weeks if filed in paper format.

What does it mean to "serve a copy"?

"Serving" is a special way of sending documents to the other party. For more information on how to serve your documents, please see section 46 of the *Trademarks Regulations*.



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Counter statement

Within 2 months of receiving the statement of opposition, the applicant must file a counter statement and serve a copy on the opponent. Otherwise, the application will be deemed abandoned. The counter statement can simply state that the applicant intends to respond to the opposition.



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Forwarding the statement of opposition

CIPO will review the statement of opposition to make sure that it raises a substantial issue and that the prescribed fee has been paid, and will forward a copy of it to the owner of the trademark application (applicant). CIPO will communicate with the opponent if there are any issues.



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Evidence

Within 4 months of receiving the counter statement, the opponent must submit evidence supporting the statement of opposition and serve a copy on the applicant. The evidence must be in the form of an affidavit or a statutory declaration.

The opponent can choose not to submit any evidence, in which case they must submit a statement to that effect and serve it on the applicant.



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Evidence

Within 4 months of receiving the opponent's evidence (or statement), the applicant must submit evidence (or a statement that they do not wish to submit evidence) and serve a copy on the opponent.



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Reply evidence

Within 1 month of receiving the applicant's evidence (or statement), the opponent may submit more evidence (if any) and serve a copy on the applicant.



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Written representations

The opponent has 2 months from the date of the notice to submit written representations and serve a copy on the applicant.

The opponent may choose not to submit written representations, in which case a statement that no representations will be submitted is optional. However, if the opponent submits a statement, a copy must be served on the applicant.



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Notice for written representations

CIPO will give the parties notice that they may submit and serve written representations.

Cross-examinations

After a party submits evidence, the other party may request the cross-examination under oath of any person who testified in an affidavit or declaration. This must be done before the notice for written representations is sent to the parties.



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Written representations

The applicant must submit their written representations and serve a copy on the opponent within 2 months of the earlier of:

- the date of service of the opponent's written representations (or statement)
- the expiry of the opponent's deadline to submit and serve written representations

The applicant may choose not to submit written representations, in which case a statement that no representations will be submitted is optional. However, if the applicant submits a statement, a copy must be served on the opponent.



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Hearing

Either party may request an oral hearing within 1 month of the earlier of:

- the date of service of the applicant's written representations (or statement)
- the expiry of the applicant's deadline to submit and serve written representations



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Decision

CIPO will issue a written decision in accordance with its service standards. All decisions are published on CIPO's website and are appealable to the Federal Court.

Is an oral hearing required?

No, an oral hearing is not necessary. If neither party requests an oral hearing, CIPO will issue a written decision without holding a hearing.