

The Canadian Trademarks Opposition Board Reduces Deadlines and Available Extensions of Time

The Canadian Intellectual Property Office (CIPO) implemented significantly reduced deadlines and more limited extensions of time in trademark opposition and section 45 proceedings. These changes, effective December 1, 2023, and described in detail in the practice notices *Practice in trademark opposition proceedings* and *Practice in section 45 proceedings*, include shorter cross-examination periods, reduced benchmark extensions of time and cooling-off periods, and changes to the availability of extensions based on extraordinary circumstances, as summarized below. Any orders, deadlines, or extension of time requests submitted before December 1, 2023, are unaffected.¹

Given the very significant delays in prosecution, summary expungement, and opposition proceedings at CIPO and the Trademarks Opposition Board (TMOB), these changes are intended to improve, streamline, and enhance efficiency, with a goal to expedite hearing dates and TMOB decisions.

Overview of Changes

Trademark Oppositions

The *Trademarks Act*, RSC 1985, c T-13 (the Act) and *Trademarks Regulations*, SOR/2018-227, authorize the Registrar of Trademarks (Registrar) to approve and modify extensions for any deadlines set out in the Act and Regulations. These extensions, termed “benchmark extensions of time,” are subject to change at the Registrar’s discretion.

The new changes significantly reduce the benchmark extensions of time available in opposition proceedings as follows:

Stages of Proceeding	Extensions Available before December 1, 2023	Extensions after December 1, 2023
Statement of Opposition	4 months	2 months
Counterstatement	2 months	1 month
Opponent’s or Applicant’s Evidence	Up to 3 months with the other party’s consent	Up to 2 months with the other party’s consent
Reply evidence	Up to 4 months with the other party’s consent	Up to 1 month with the other party’s consent
Written representations	Up to 2 months with the other party’s consent	Up to 1 month with the other party’s consent



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Related Practice Areas

- Intellectual Property
- Patents

Additional notable changes include:

1. **Shortened cross-examination order extensions:** If a party requests a cross-examination order within two months of the filing of the adverse party's evidence, the requesting party is also entitled to extend its own deadline for filing evidence. The amendments reduce this extension of time to file evidence by half – from four to two months. If the requesting party fails to complete the cross-examination, the extended deadline for submitting evidence is further reduced from two months to one month.
2. **Reduced "cooling off period:"** The "cooling off period," which allows each party to request a one-time extension of time to consider and negotiate settlement, is reduced from a maximum of nine months to a maximum of seven months for each party.

Section 45 Cancellation Proceedings

The new changes also reduce the benchmark extension of time in summary cancellation proceedings under section 45 of the Act (Section 45). Section 45 proceedings are intended as a summary procedure to clear trademarks from the Register that have fallen into disuse. Upon receipt of a notice issued under Section 45, a trademark owner has three months within which to file evidence of use. Under the new practice notice, this deadline can be extended by only two additional months, a significant change from the previously available four-month extension of time.

Extensions Based on Extraordinary Circumstances

In both trademark opposition and summary cancellation proceedings, the Registrar has the discretion to grant an extension of time beyond the benchmark extension provided the Registrar determines that exceptional circumstances exist justifying a further extension of time.

Effective December 1, 2023, parties seeking an exceptional circumstance extension will need to include sufficient details regarding the length of delay sought and the timeline and steps planned to meet the proposed extended deadline.

The amendments also introduce a new exceptional circumstance: **the inability to meet an upcoming deadline despite acting diligently**. Any party relying on the new circumstance will need to be able to demonstrate a consistent overall pattern of reasonable effort, promptness, and diligence in their efforts to meet the upcoming deadline. In addition, any request must set out why it is not possible to meet the upcoming deadline and the previous actions taken to meet the impending deadline. Notably, settlement efforts will not be considered. Parties delayed by settlement negotiations will instead need to rely on settlement-specific extensions, such as the "cooling off" extension or the finalizing settlement exceptional circumstance, as set out in the practice notices.

Conclusion

Based on the new, much more limited extensions of time, we recommend that intellectual property stakeholders consider the impact of the revised practice notices for Section 45 and opposition proceedings while planning current, pending, and future proceedings with Canadian counsel.

¹ Please note any request made **on (or after) December 1, 2023**, will be subject to the new imposed timelines.

If you have any questions about the information summarized in this article or if you require assistance navigating CIPO's schedule changes, please feel free to contact any member of our Canadian Intellectual Property team.