Consultations are open: CIPO proposes amendments to the Trademarks Regulations

June 27, 2024

Canadian Intellectual Property Office's (CIPO) proposed amendments to the *Trademarks Regulations* were published in the Canada Gazette, Part I on June 8, 2024. These amendments are intended to implement changes made to the *Trademarks Act* (the Act) in the *Budget Implementation Act*, 2018, that have not yet come into force because these corresponding amendments to the *Trademarks Regulations* (the Regulations) are needed.

A Regulatory Impact Analysis Statement (RIAS) is included in respect of the *Trademarks Regulations*. However, it should be noted that this statement is not part of the *Regulations*.

The proposed amendments cover the following areas:

- Costs awards
- Confidentiality provisions
- Case management
- Official Marks

The changes are intended to promote a more efficient and cost-effective manner of proceeding before the Trademarks Opposition Board (TMOB) and to allow those applying for trademark registrations to efficiently overcome objections raised on the basis of official Marks.

Costs Awards

The proposed amendments provide the circumstances under which the Registrar may award costs, including in the case where a party engages in unreasonable conduct that causes undue delay or expense in the proceeding. This appears to be a broad circumstance that will likely be the subject of many submissions until the Registrar issues decisions providing guidance as to the parameters. The proposed amendments also set out the manner and timing of a request for costs.

The costs awards are provided as a multiplier of a fee set out in a specified item of the schedule to the Regulations. For example, costs of $2775 can be awarded in a

proceeding under section 45 of the *Trademarks Act* where a party engages in unreasonable conduct which causes undue delay or expense in the proceeding. It is possible that costs awards calculated under these Regulations may be higher than costs awards in some trademark proceedings in Federal Court.

The proposed amendments provide a costs regime that is different than that of the Federal Courts, in which costs are awarded to the successful party. The proposed amendments appear to make it the objective of the costs awards to discourage inappropriate conduct, rather than to compensate a successful party for a portion of their legal expenditure. Inappropriate conduct in Federal Court tends to be sanctioned by an increase or decrease in the amount of costs, and in exceptional circumstances, a refusal to award costs to a successful party.

Confidentiality Orders

In terms of Confidentiality Orders, the proposed amendments seek to provide a process by which a party to a proceeding before the TMOB can request an Order that some evidence be kept confidential.

The proposed amendments set out the information that would need to be provided in order to support a request for a Confidentiality Order, including a description of the evidence that the party wishes to be kept confidential, and the reasons why the evidence should be kept confidential.

Protective orders and confidentiality orders have been the subject of many decisions in the Federal Court and Federal Court of Appeal. In many cases, an affidavit from a representative of a party is required to convince the Court of the true confidential nature of the evidence and the expected (i.e., not speculative) harm if the evidence were not to be kept confidential in order for a Confidentiality Order to be granted.

Case Management

As drafted, the proposed amendments provide to the Registrar a seemingly broad power to give any direction or make any order to deal with certain proceedings in a cost-effective and efficient manner, as considerations of fairness permit.

Official Marks

Finally, with respect to Official Marks, the proposed amendments provide that the Registrar may on its own initiative or at the request of a person who pays a prescribed fee, to give public notice that the provision related to Official Marks does not apply with respect to a particular mark in specific circumstances.

Consultation Period

The consultation is open until 11:59 EDT on July 8, 2024. Comments can be provided directly in the Canada Gazette, Part I. There are fields after each section in which to input comments of no more than 20,000 characters. It should be noted that all comments will be posted in Canada Gazette's website following the consultation period.

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