

NEW PRACTICE NOTICES FOR THE TRADEMARKS OPPOSITION BOARD COMING INTO FORCE APRIL 1, 2025 ON CASE MANAGEMENT, CONFIDENTIALITY ORDERS, AND COST AWARDS

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On April 1, 2025, the amendments to the Trademarks Regulations [1] (the “**Regulations**”) will come into effect. Details related to the accompanying three practice notices regarding the Trademarks Opposition Board (“**TMOB**”) can be found on the following webpages:

- [Practice notice on case management](#)
- [Practice notice on confidentiality orders](#)
- [Practice notice on costs awards](#)

The Registrar will only implement case management, issue confidentiality orders and award costs in exceptional circumstances. For convenience, we highlight some of the changes that will come into effect, as detailed on the webpages as of the date of this bulletin:

Practice Notice on Case Management

The Registrar has identified three situations where the surrounding circumstances may warrant a proceeding being designated as a case-managed proceeding:

- 1. Divisional Applications in Oppositions:** Where an application has been divided into multiple applications which have been or will be opposed by the same opponent on the basis of similar grounds, it may be most efficient to consolidate the submission of documents, rulings or hearings, as appropriate.
- 2. Corrections to Protocol Applications:** If a substantive amendment is received from the International Bureau to a Protocol application, after an opposition is commenced, and the application is re-advertised pursuant to sections 116-117 of the Regulations, it may be most efficient to deem certain documents in the opposition to have been submitted in respect of the amended Protocol application.
- 3. Proceedings in which an order has been made by the Registrar that the evidence be kept confidential:** If a confidentiality order has been made in a proceeding, case management may be used to facilitate:

- a. the efficient submission and service of documents referencing information that has been designated as confidential;
- b. any orders or directions necessary for preserving confidentiality at a hearing; and,
- c. the issuance of a decision in which information that has been designated as confidential has been redacted.

Where possible, the same Member of the Trademarks Opposition Board will have carriage over a case-managed proceeding, including giving any direction or making any order, issuing any interlocutory rulings, presiding over the hearing, and/or issuing the decision.

The Registrar **will not** use case management to make substantive rulings such as finding that a party has failed to meet their evidential burden on a ground of opposition prior to a decision.

Practice Notice on Confidentiality Orders

Because a confidentiality order is a significant departure from the open court principle, the issuance of such an order will be exceptional. Redacting documents or describing evidence broadly will be sufficient for most proceedings.

A request to keep some or all of the evidence confidential must be made prior to submitting the evidence at issue.

The request for a confidentiality order must contain the following information:

- A description of the evidence that a party wishes to be kept confidential (for example, personal medical information, terms of a settlement agreement, internal marketing plans);
- A statement that the evidence has not been made public;
- The reasons why the evidence should be kept confidential;
- An indication of whether the other party consents to the request; and,
- Any other information that the Registrar requires in order to make a decision with respect to the request.

Once a confidentiality order is issued, evidence or subsequent documentation referencing that evidence **must be submitted to the Registrar in paper (not through TMOB's online service)**, either by regular mail or by physical delivery by courier or in person directly at the Canadian Intellectual Property Office (CIPO) and pursuant to the terms set out in the confidentiality order.

These terms may require that two versions be submitted, namely:

- a public version, in which the information or references to the information that has been designated as confidential has been redacted or removed; and,

- a confidential version in which the information or references to the information that has been designated as confidential has been highlighted in yellow or is appearing on a yellow background.

Members of the public attending hearings will be excluded from the parts of the hearing where information designated as confidential will be handled.

Should a party become aware of a confidentiality breach or even a potential confidentiality breach, it would be up to that party to seek a remedy at the Court. If a party breaches the confidentiality order during the course of a proceeding, the Registrar may award costs against that party.

If a party to a proceeding appeals the decision of the TMOB to the Federal Court, the TMOB transmits the documents to the Federal Court, upon request, in a manner that attempts to preserve confidentiality. **Once transmitted to the Court, the documents become part of the Court File Annex which, absent a confidentiality order from the Court, is available to the public.** Parties may wish to refer to section 151(1) of the Federal Courts Rules^[2] concerning the motion that may be obtained from the Court so that material to be filed be treated as confidential.

Practice Notice on Costs Awards

Costs awards are intended to curtail inefficient behaviors and incentivize parties to efficiently advance proceedings before the Registrar, and the Registrar will not award costs on its own initiative.

The Registrar may award costs against a party, where any one of the following specific circumstances is found, regardless of whether that party is successful, wholly or partially, in the proceeding:

1. In opposition proceedings:

- in the case where the party's application for the registration of a trademark is refused on the ground that it was filed in bad faith with respect to one or more of the goods or services;
 - to note, the Registrar will not award costs if the ground of opposition based on bad faith is not successful
- in the case where the party files a divisional application on or after the day on which the original application is advertised under section 37(1) of the *Trademarks Act*^[3] and the costs are awarded in respect of the divisional application;
- in the case where the party withdraws a request for a hearing less than 14 days before the day on which the hearing is scheduled to take place; or
- in the case where the party engages in unreasonable conduct that causes undue delay or expense in the proceeding.

2. In section 45 and objection proceedings:

- in the case where the party withdraws a request for a hearing less than 14 days before the day on which the hearing is scheduled to take place; or
- in the case where the party engages in unreasonable conduct that causes undue delay or expense in the proceeding.

Several examples of unreasonable conduct are listed in the practice notice, including:

- Failing to attend a hearing or cross-examination without cancelling or notifying the TMOB or other parties of same;
- Failing to follow a case management order or direction or breaching a confidentiality order;
- Pursuing a ground of opposition that has no reasonable chance of success; and,
- Acting disrespectfully or maligning the character of another party.

The Registrar must give the other party notice of the request for costs and an opportunity to make written representations in response to it. There is no requirement for a response, but if one is submitted, it must be filed within 14 days after the day on which the notice is given.

Cautionary Note

Each practice notice is intended to provide guidance on the Canadian Intellectual Property Office practice and interpretation of relevant legislation. In the event of any inconsistency between the notice and the applicable legislation, the legislation must be followed. The provisions of the practice notice are general guidelines only, are not binding in any particular case and are subject to change.

Concluding Remarks

With the implementation of these new practice notices, understanding the nuances and their practical impact is essential. Successfully maneuvering through these changes requires strategic insight and experience. Our team is well-equipped to help you navigate the complexities and ensure compliance in opposition, section 45 and objection proceedings at the TMOB.

[1] Trademarks Regulations, [SOR/2018-227](#).

[2] Federal Courts Rules, [SOR/98-106](#), s 151(1).

[3] *Trademarks Act*, [RSC 1985, c T-13](#), s 37(1).

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A Cautionary Note

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

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