

TRADEMARK OPPOSITIONS IN CANADA

What is an Opposition Proceeding?

A trademark opposition is a complex adversarial proceeding. It is commenced by a third party who objects to the registration in Canada of a trademark that is the subject of a still-pending application. The purpose of an opposition proceeding is to determine whether the mark should be registered as a trademark for the applicant in Canada.

In most cases, a trademark registration grants the registrant the exclusive right to use the trademark across Canada. A valid trademark registration is also considered an absolute defence to any claims of infringement that may be brought by another party respecting a similar mark. However, the refusal of a trademark application does not necessarily mean that the applicant cannot use the trademark in Canada. Only the courts can issue orders against parties prohibiting the use of a trademark.

Most oppositions are resolved during the opposition proceeding, but completing all the available steps may take more than two years.

Who can Oppose a Trademark?

Any person may oppose a pending trademark application. If desired, any number of persons can be named jointly as opponents. All joint opponents must be identified in the statement of opposition when filed.

What are the Grounds of Opposition?

A pending trademark application may be opposed on the following grounds:

- the form of the **application does not conform** to regulatory requirements
- the applied-for-mark is **not registrable** in Canada, usually in that:
 - ✓ the mark is a generic term for the associated goods or services (in any language);
 - ✓ the mark is primarily merely a surname;
 - ✓ the mark is confusing with another trademark, official mark, an Olympic mark or a geographical indication registered in Canada;
 - ✓ the mark may be mistaken for an official crest, flag or symbol adopted by any level of government in Canada, the government of another country, the Red Cross (and other equivalent organizations) or the Royal family; or
 - ✓ the mark is scandalous, obscene or immoral.
- the applicant is **not the person entitled to registration** of the trademark in Canada, usually in that:
 - ✓ another party had prior use of the mark or a confusingly similar mark in Canada; or
 - ✓ the applicant used the mark only as a licensee of another party.
- the trademark is **not distinctive** of the applicant, usually in that:

- ✓ another party had prior use of the mark or a confusingly similar mark in Canada; or
 - ✓ multiple parties had prior use of the mark or confusingly similar marks in Canada.
- the applicant was **not entitled to use the trademark in Canada in association with the identified goods or services**, usually in that the goods or services are unlawful or the applicant is not authorized to sell them in Canada.
 - the applicant had **not used the trademark** in Canada **and did not propose to use the trademark** in Canada as of the filing date.
 - the trademark application was **filed in bad faith**, usually in that the applicant had a former business relationship with the opponent or has record of filing speculative trademark applications.

When & How is an Opposition Commenced?

An opposition cannot be commenced until after the trademark application has been advertised in the *Trademarks Journal*. After advertisement, there is a two-month period within which a potential opponent can: (a) file a statement of opposition; or (b) request a four-month extension of time to do so.

With sufficient reasons and the payment of the required fee, a retroactive extension of time may be granted to file a statement of opposition after the two-month period of time has elapsed. However, no opposition proceeding may be initiated for any trademark application after a notice of allowance or registration has been issued.

An opposition is formally commenced by the filing of a statement of opposition together with the required fee with the Trademark Opposition Board. At present, the prescribed fee is **\$1,115.08 CAD**.

WHAT ARE THE STEPS IN AN OPPOSITION PROCEEDING?

	When...	What...
1	Within 2 months after advertisement...	Opponent files: (a) statement of opposition; or (b) a request for 2-month extension of time to do so.
2	Within 1 month after statement of opposition is filed...	Opposition board reviews statement of opposition and, if approved, forwards copy to the applicant.
3	Within 2 months after statement of opposition is forwarded to the applicant...	Applicant files: (a) counter-statement; or (b) request for 1-month extension of time to do so.
4	Within 4 months after counterstatement is filed...	Opponent files: (a) evidence; (b) a statement that it intends to file no evidence; or (c) with the consent of the applicant, a request for 2-month extension of time to do so.
5	Within 2 months after opponent's	Applicant may simultaneously request: (a) an

	evidence is filed...	order for cross-examination of the opponent's affiants; and (b) an order extending the time period for filing its own evidence until 2 months after said examination is complete.
6	4 months after opponent files evidence...	Applicant files: (a) evidence; (b) a statement that it intends to file no evidence; or, (c) with the consent of the opponent, a request for 2-month extension of time to do so.
7	Within 1 month after opponent serves affidavit evidence...	Opponent may simultaneously request: (a) an order for cross-examination of the applicant's affiants; and (b) an order extending the time period for filing its reply affidavit evidence until 2 months after said examination is complete.
8	1 month after applicant files evidence...	Opponent files: (a) reply evidence ; or

		(b) with the consent of the opponent, a request for 1-month extension of time to do so.
9	After all evidence is filed...	Opposition board will issue notice inviting the submission of written argument.
10	2 months after invited to submit written argument ...	Opponent files: (a) written argument; or (b) with consent of applicant, a request for 1-month extension of time to do so.
11	2 months after opponent files written argument...	Applicant files: (a) written argument; or (b) with consent of opponent, a request for 1-month extension of time to do so.
12	1 month after applicant files written argument... party...	Applicant or opponent may request an oral hearing to be conducted in either English or French. Hearing date may be scheduled as much as be 12 – 18 months after request is filed.

13	No less than 90 days before the hearing date...	Notice of hearing date issued.
14	Within 30 days after notice of hearing date...	Applicant and opponent required to confirm attendance at hearing. With sufficient reasons, hearing may be rescheduled once to accommodate counsels' schedules.
15	No less than 2 weeks prior to oral hearing...	Applicant and opponent file list of case law to be relied upon in oral argument together with copies of any unpublished cases.
16	No less than 90 days after notice of hearing date issued...	Oral hearing conducted: (a) in person at Ottawa; (b) by videoconference; or (c) by telephone conference call. Simultaneous translation may be requested where required.
17	No less than 14 days after oral hearing...	Parties may file submissions requesting an award of costs .

18	Within 6 months after oral hearing...	Opposition board releases written decision .
19	Within 2 months after decision is released...	Notice of appeal served and filed, if any.

Are other Extensions of Time Available?

Finalizing Settlement: If the parties agree in principle to resolve the opposition, the opposition board will grant a single 3-month extension of time to finalize the terms of agreement. This extension will be granted only once during an opposition proceeding.

Cooling Off Period: With the consent of the opposing party, the opposition board will grant each party one extension of time of up to seven months at any stage of an opposition proceeding to allow the parties to negotiate a settlement of the dispute. This extension is especially intended to assist party's negotiating trademark disputes in multiple jurisdictions.

Is Evidence Confidential?

In the absence of a confidentiality order, all documents filed with the opposition board are available for public inspection. The opposition board has the authority to grant confidentiality orders restricting access to certain records where there is a serious risk to an important interest, such as avoiding breach of a contractual obligation.

Can Legal Costs be Recovered?

Yes, the opposition board has the authority to award legal costs to any party involved in an opposition proceeding in exceptional circumstances, including unreasonable

conduct by a party, a finding of bad faith, and late cancellation of an oral hearing.

What are the Settlement Options?

The parties are strongly encouraged to consider settlement options at every stage of an opposition proceeding. Indeed, most opposition proceedings settle prior to a decision.

An opposition proceeding may be resolved in a variety of ways, the most common being:

- a. the express abandonment of the application, with or without prejudice;
- b. the express abandonment of the opposition, with or without prejudice;
- c. the abandonment of the application by failing to file a counterstatement or evidence by the stipulated deadlines;
- d. the abandonment of the opposition by failing to file evidence by the stipulated deadlines;
- e. the negotiation of a co-existence agreement wherein the parties agree to terms upon which both may continue to use their respective marks, including an agreement to either (i) expressly abandon the application or (ii) withdraw the opposition.

Note that the Canadian Intellectual Property Office provides little deference to co-existence agreements. It is therefore important to ensure that there is no overlap in the associated goods and services, or that both registrations are amended to include restrictions on the respective lines of trade. We strongly recommend that global co-existence agreements be reviewed by qualified Canadian counsel before finalization.

Where Can I Get More Information?

You can get more information by visiting the website for:

Canadian Intellectual Property Office
www.cipo.ic.gc.ca

Or by contacting:

BLAZE IP
McMaster Innovation Park
175 Longwood Road South, Suite 102
Hamilton, Ontario L8P 0A1

T: 905-572-9300

www.blaze-ip.ca

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