

College of Patent Agents & Trademark Agents

Trademark Agent Skills Examination Component B Sample Exam Key

Purpose statement: The sample exam and sample answers are for informational and preparatory purposes only. They are intended to offer prospective test-takers a general understanding of the type and format of questions that may appear on the skills examination, as well as to demonstrate the level of detail expected in responses. For more information, refer to: <https://cpata-cabamc.ca/en/become-an-agent/information-trademark-agent-qualifying-examinations/>

Representation: The sample exam does not represent the full range of topics, difficulty levels, or types of questions that may be encountered on the actual exam. The actual exam may contain questions that differ significantly in form and content.

Predictive value: Performance on this sample exam should not be taken as an indicator of future performance on the corresponding skills examination. This sample is not intended to predict exam outcomes and should not be used as a test-taker's sole preparation material.

Answer key: The sample answers provided are for illustrative purposes only. They represent one of several possible approaches to answering these sample questions. Actual exam responses may vary, and there may be multiple valid ways to address a question.

Updates and changes: Exam content and policies are subject to change. While we aim to keep our preparation materials up-to-date, the sample exam and answers may not reflect the most current version of the actual examination.

No guarantee: Using these sample materials does not guarantee success in the actual skills examination. Examinees are encouraged to engage in comprehensive study and preparation to enhance their understanding of the subject matter.

Confidentiality: The actual examination content is confidential.

Feedback: Feedback on these sample materials is welcome. However, please be aware that individual responses or specific guidance on exam preparation cannot be provided.

Examination information

The *Trademark Agent Skills Examination* takes place over two (2) days. Test-takers have three (3) hours on one day to complete Component A, which focuses on registrability and strategy. Test-takers have three (3) hours on a subsequent day to complete Component B, which focuses on prosecution and on opposition and s. 45 proceedings. Each component is worth 75 marks; the two (2) components are scored together as a single examination worth 150 marks in total.

This is Component B. It consists of 14 questions worth a total of 75 marks.

Component B will be scored together with Component A.

During this examination, test-takers have electronic access to the *Trademarks Act*, RSC 1985, c T-13 (“Trademarks Act”) and *Trademarks Regulations*, SOR/2018-227 (“Trademarks Regulations”), in addition to other background information or resources necessary to respond to the examination questions.

Instructions for test-takers

Review any background information provided. Answer the questions.

Avoid extraneous commentary not directly relevant to the question. Do not assume facts that are not provided.

When asked to support an answer, include relevant discussion or reasoning. While relevant source references (e.g., to case law, statutory provisions, or regulatory provisions) may be helpful to include, separate marks are not provided for such references unless specified in the question.

Point-form answers are acceptable.

Trademark Agent Skills Examination Component B (3 hours, 75 marks)

Question 1 [4 marks in total]

You received an office action regarding your client’s trademark application for ATTITUDE. The deadline to respond is April 11, 2023. The examiner cited the trademark registration, ATTITUDE, TMA693662 as being confusing with your client’s application. The examiner has not attached the information sheet regarding the cited registration. You do a search in the trademark registry and find the following information:

ATTITUDE - 1222836	
Registration number TMA693662	Index headings ATTITUDE
Type(s) Word	Goods (Nice class & Statement) jewellery
Category Trademark	Services (Nice class & statement) Computerized on-line retail store services and direct mail services in the field of jewellery
CIPO Status Live	Classification data
TM5 status Live/Registered	Disclaimer
Filed 2004-07-07	The classification data is provided for information and searching purposes only. CIPO does not warrant the accuracy of the classes assigned to the trademark. This data has no legal value of any kind. 14- Precious and semi-precious metals, and jewellery 35- Advertising, marketing, promotional and business
Registered 2007-08-08	Claims Declaration of Use filed July 16, 2007
Expiration date 2022-08-08	
Registrant	

ATTITUDE, Inc. a Delaware corporation, 11, East 25th Street, 15 th Floor New York, NY, 10010, UNITED STATES OF AMERICA	
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Action History

Action	Action date	Due Date	Comments
Filed	2004-07-07		
Created	2004-07-08		
Formalized	2004-07-08		
Search recorded	2004-11-08		
Examiner's First Report	2004-11-08	2005-03-08	
Correspondence Created	2004-12-21	2005-04-21	
Note to file	2005-03-20		No further response required to letter dated March 16, 2005. Agent will send a revised application.
Approved	2005-10-14		
Advertised	2005-11-16		Vol. 52 Issue 2664
Allowed	2006-02-03		
Allowance Notice Sent	2006-02-03	2007-07-07	
Registered	2007-08-08	2022-08-08	
Agent changed	2022-05-25		From/De: 2975 To/A:
Renewal Notice Sent	2022-08-31	2023-02-08	

Analyze the trademark file history to identify the information that will help your client overcome the objection of confusion. **[4 marks]**

Sample Response

The following sample answer would receive full marks.

The deadline to renew the cited trademark registration was August 8, 2022, and the owner benefits from a six-month grace period, i.e., having until February 8, 2023, to renew the registration.

In addition, the owner has not grouped the services in accordance with the Nice Classification.

Therefore, I would suggest that the client monitor the status of this registration. If no request for renewal is filed by the deadline of February 8, 2023, the cited registration will be expunged and will no longer constitute an obstacle to the client's registration.

Once the registration has been expunged, the client could file a response to the Examiner's report by requesting that the Examiner withdraw its objection.

Question 2 [12 marks in total]

You have filed an application for the registration of the mark "1000Watt" on behalf of your Canadian client, MI Ltd., on January 2, 2019, for:

"Goods: A computer-aided ranking system ranking the difference between the actual amounts of energy loss in buildings in comparison with the standard amount under various building codes;

Services: Providing energy consulting services for bench marking energy loss in buildings"

Your client is a high-tech consulting firm in green technology active only in Ontario and has developed a computer program and provides the services which use that program in Ontario. At the time of the filing, Nice Classes were not specified for the goods and services.

The application has been examined and the Examiner has issued an Office Action requesting specifications to the list of goods and services and to group the goods and services according to the classes of Nice Classification. [Refer to the exam aid.]

- (a) Draft a statement in ordinary commercial terms of the goods and/or services in association with the proposed trademark **[5 marks]** and classify these goods and/or services according to the classes of the Nice classification **[2 marks]**.

Sample Response

The following sample answer would receive full marks.

Class 9: Computer software for use in the field of building energy efficiency, namely, computer-aided ranking system for assessing and comparing energy loss in buildings in comparison to standard requirements prescribed by building codes.

Class 42: Providing energy consulting services in the field of bench marking energy loss in buildings.

- (b) Provide the appropriate Nice class for each of the following goods and/or services: **[5 marks]**
1. graphic t-shirts
 2. promotional t-shirts
 3. retail and online retail store services featuring t-shirts
 4. adhesives for use in the motor vehicles industry
 5. animal adoption services

Sample Response

The following sample answer would receive full marks.

1. graphic t-shirts: 25
2. promotional t-shirts: 25
3. retail and online retail store services featuring t-shirts: 35
4. adhesives for use in the motor vehicles industry: 1
5. animal adoption services: 45

Question 3 [12 marks in total]

On March 5, 2023, you file an application for the registration of the mark BONAVENTURE on behalf of Comfort Clothes to Hike Inc. for hiking shirts, pants and boots.

The application has been examined and the Examiner has issued an Examiner's report that includes the following:

"The mark which is the subject of this application is considered to be primarily merely the surname of an individual who is living or who has died within the preceding thirty years. In this respect, please note that a search on Canada411.ca has yielded 10 search results for the surname BONAVENTURE. In view of the provisions of paragraph 12(1)(a) of the *Trademarks Act*, this mark does not appear to be registrable."

"Moreover, the mark which is the subject of this application is considered to be either clearly descriptive or deceptively misdescriptive of the place of origin of the applied-for goods contrary to paragraph 12(1)(b) of the *Trademarks Act* as BONAVENTURE is the name of a town in the Gaspé Peninsula in the Bonaventure Regional County Municipality of Québec, as well as both the name of a Regional County Municipality and a river.

Answer the following:

- (a) Provide the best option for responding to the objection to the registration of the mark pursuant to section 12(1)(a) of the *Trademarks Act* [**1 mark**]; and
- (b) List three (and only three) available options for responding to the clearly descriptive AND deceptively misdescriptive objections as to the place of origin of the goods pursuant to section 12(1)(b) of the *Trademarks Act*, citing relevant provisions of the *Trademarks Act* in support of your answer, as applicable. [**6 marks**]

Sample Response

The following sample answer would receive full marks.

- (a) The best option is to file an argument that the mark is not primarily merely a surname because it has other meanings.
- (b)
 1. File an affidavit of acquired distinctiveness, claiming the benefit of Section 12(3) of the *Trademarks Act*, as the trademark has been used in Canada for at least eight years. The client would have to provide evidence of acquired distinctiveness, in terms of use and advertising, of the trademark BONAVENTURE throughout Canada in association with hiking shirts, pants and boots so that BONAVENTURE would have acquired a secondary meaning for the average Canadian consumer as a trademark, but the registration will be restricted to the provinces of British Columbia and Alberta.
 2. Challenge the objection pursuant to Section 12(1)(b) of the *Trademarks Act*, by filing arguments to the effect that BONAVENTURE would not be perceived as clearly descriptive of the place of origin of the goods as BONAVENTURE is not known for the applied-for clothing and footwear by the average Canadian consumer. For the same reason the mark cannot be perceived as deceptively misdescriptive of the place of origin of the goods.
 3. Abandon the trademark application and file a fresh application adding distinctive elements, word or design, to the term BONAVENTURE, so that the trademark would no longer be considered as being primarily merely a surname, or clearly descriptive or deceptively misdescriptive of the place of origin of the goods due to the other distinctive element(s).

Note: If more than 3 options are provided, only the first 3 options presented by the test-taker are marked.

Assume that the client has informed you that the BONAVENTURE mark has been extensively used since September 7, 2015, in the provinces of British Columbia and Alberta.

Draft a response to the Examiner's report addressing the issues raised by the Examiner. **[5 marks are allocated for how your response is written, including but not limited to the clarity of your response].**

Sample Response

The following sample answer would receive full marks.

Attention: Examination Section

Dear Examiner,

We refer to your Examiner's report and would like to submit the following observations in response to the office action. We respectfully submit that BONAVENTURE is not primarily merely a surname since it has an alternate meaning as geographical designations as a town, Regional Country Municipality and a river and is not merely a surname. The search results showing only 10 instances of BONAVENTURE as a surname in the Canadian directory is insufficient to conclude that the predominant meaning of the term BONAVENTURE among the average Canadian consumers would be a family name. Therefore, it cannot be alleged that the primary meaning of BONAVENTURE would be a surname, and we respectfully request that you reconsider your position.

Kind regards,

Question 4 [5 marks in total]

Your client's trademark, TARGET RECRUITEMENT, has been opposed on the basis of confusion by the owner of the trademark, BULLS-EYE RECRUIT, also for use with an employment agency specializing in IT and network security. On further investigation, you realize that your client's services are directed only to the IP community, namely matching IP firms with patent and trademark agents and specialized IP assistants with no interest in expanding beyond this area. You are considering pursuing settlement of the opposition.

Assume that you are considering pursuing settlement of the opposition, and you are supporting the preparation and negotiation of a consent and co-existence agreement. Answer the following: **[5 marks]**

- (a) explain why settlement of the opposition on the basis of consent may be an option; **(1 mark)**
- (b) name 2 (two) elements that need to be present in a consent agreement for it to receive favourable consideration by the Examiner (only the first 2 (two) elements will be marked); **(2 marks)** and
- (c) describe how to amend the client’s statement of services to reflect their specific area of use. **(2 marks)**

Sample Response

The following sample answer would receive full marks.

- (a) Even if the nature of the services is overlapping (employment agency services), the area of use is different and therefore the nature of the trade greatly differs.
- (b) additional information on the field and business area of each party and the market conditions.
- (c) The applicant suggests an amendment of the statement of its services so as to (1) specify that the services are employment agency services intended for the IP community, and (2) add exclusionary language for IT and network security.

Question 5 [4 marks in total]

Congratulations, you have now a new client, HouHou Inc., a Canadian corporation located at 2222 South Avenue, Ottawa, K1A 0A1. You received the following information regarding your client’s trademarks in Canada:

HOUHOU App. No. 2345670	Opposed	Statement of opposition filed on 2024-08-30
IMPACT TMA1456456	Registered 2015-12-12	

ZOOM App. No. 2347899	Office action Received 2024-05-13	
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Identify next steps regarding the management of this portfolio, along with any associated deadlines. **[4 marks]**

Sample Response

The following sample answer would receive full marks.

- Appoint yourself as trademark agent for the three trademarks.
- Request from the client the history of the files OR consult the trademark register online for additional information.
- Review the trademark application HOUHOU and statement of opposition filed and assess the interest of the client in this trademark, and opportunity to file a counterstatement by the deadline of October 30, 2024.
- Review the office action, discuss the matter with the client and docket a deadline of November 13, 2024, for filing a response.

Question 6 [5 marks in total]

On behalf of your client, you requested the issuance of a section 45 notice against registration No. TMA135,246 for the trademark GOAT in association with the goods "watches, ankle bracelets, sunglasses, t-shirts", and the services "restaurant services." In response to this notice, which was issued by the Registrar on July 5, 2019, the owner of the registration, ABC Inc., filed the following affidavit:

TO: The Registrar of Trademarks

IN THE MATTER OF a Section 45 Proceeding regarding Canadian Registration No. TMA135,246 for the trademark GOAT in the name of ABC Inc.

AFFIDAVIT OF JOHN JONES

I, John Jones, of the City of Ottawa, in the Province of Ontario, in Canada, hereby

MAKE OATH AND SAY:

1. I am the President of ABC Inc. (the "Registrant"), an Ontario corporation whose principal place of business is located at 23 Acorn Street, Ottawa, Ontario, Canada.
2. I have held this position since 2009.
3. I am authorized to make this affidavit, and all statements I make herein are either from my personal knowledge or derived from the records of the Registrant which are maintained in the ordinary course of business.
4. During the period from July 5, 2016, to July 5, 2019 (the "Relevant Period"), ABC Inc. sold watches bearing the trademark GOAT to retailers in Canada. Attached as Exhibit A to my affidavit is a photograph of a watch that is representative of the watches that ABC Inc. sold during this period [Exhibit A shows a watch with the word GOAT printed on the middle of the watch face]. ABC Inc. also sold ankle bracelets. Attached as Exhibit B to my affidavit is a photograph that is representative of ABC Inc.'s current line of ankle bracelets [Exhibit B shows an ankle bracelet with the word GOAT etched on the clasp of the bracelet].
5. ABC Inc. has sold its watches and jewellery, including the watches shown in Exhibit A, and various ankle bracelets, to local Ottawa-area jewellery stores. Attached as Exhibit C is a spreadsheet displaying sales transactions to these jewellery stores during the Relevant Period [Exhibit C shows over 300 sales transactions and details including the dates of sale, names of the Ottawa-area retailers that purchased the watches and ankle bracelets, invoice numbers for the watches, and pricing. All transactions are dated during the Relevant Period].
6. Since 2014, ABC Inc. has been advertising its sunglasses in various newspapers, including the local Ottawa area newspaper. Attached as Exhibit D is a representative sample of these advertisements [Exhibit D shows a newspaper advertisement that reads "GOAT sunglasses - get on over and pick up a pair!"].
7. ABC Inc. has had sales in excess of \$100,000 CAD of its GOAT t-shirts to Canadian retailers during the Relevant Period. Attached as Exhibit E to my affidavit is a photograph of a t-shirt that is representative of the type of shirt sold during the Relevant Period [Exhibit E shows a t-shirt bearing a label with the word GOATEE as one word and in capital letters in the same size and font.] No other markings appear on the shirt.

8. ABC Inc. also operates a number of GOAT vegetarian restaurants in the Ottawa area. Attached as Exhibit F to my affidavit are representative photographs of the restaurant signage and restaurant uniforms worn by the waiting staff during the Relevant Period [Exhibit F consists of 1) a photograph of restaurant signage displaying a drawing of a goat, and 2) a photograph of a restaurant uniform with the word GOAT printed clearly on the front and back of the uniform].

For each of the goods and services listed, assess whether the registration is likely to be maintained, expunged, or amended for lack of use, supporting your answer with the information provided in the affidavit. **[5 marks]**

- (a) "watches"
- (b) "ankle bracelets"
- (c) "sunglasses"
- (d) "T-shirts"
- (e) "restaurant services"

Sample Response		
<i>The following sample answer would receive full marks.</i>		
Good	Likelihood of expungement	Rationale
Watches	Likely to be maintained	The goods were sold to Canadians during the relevant period, and the trademark appears in association with the goods at the time of the transfer of property.
Ankle bracelets	Likely to be expunged	The affidavit is not clear on whether the photographs in Exhibit B are representative of the ankle bracelets sold during the relevant period, making it impossible to assess whether the trademark appears in association with the goods at the time of transfer of property.
Sunglasses	Likely to be expunged	The affidavit does not demonstrate that the goods were sold, but merely advertised. Advertising, as opposed to sales, does not count as use of the trademark in association with goods, and therefore there is no use of the

		trademark in Canada during the relevant period.
Shirts	Likely to be expunged	The photographs do not show use of the trademark GOAT, but GOATEE, which is not a minor variation of the trademark and results in a different trademark.
Restaurant services	Likely to be expunged	The photographs of the restaurant signage are not relevant as they do not show use of the trademark GOAT. While photographs of the restaurant menu displaying the trademark GOAT would have been acceptable evidence of use, the photographs of the restaurant uniforms only show a distant connection and do not establish use in connection with restaurant services.

Question 7 [7 marks in total]

On September 5, 2018, a statement of opposition was filed by Abragio Inc (Abragio), owner of trademark registration No. TMA382,493 for ABRAGIO, against application No. 1,829,493 for the trademark ADAGIO, the particulars of which are below:

<p>Applicant:</p> <p style="padding-left: 40px;">Adagio Ltd</p> <p>Filing date:</p> <p style="padding-left: 40px;">March 8, 2017</p> <p>Date of advertisement: July 5, 2018</p> <p>Goods:</p> <p style="padding-left: 40px;">pizza, breadsticks, garlic bread, tomato sauce</p> <p style="padding-left: 40px;">pasta</p> <p>Services:</p> <p style="padding-left: 40px;">restaurant services</p>
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Each ground of opposition below is deficient in one or more ways. Identify the deficiencies and suggest a remedy for each. Cite a relevant section of the *Trademarks Act*, if applicable.

- (a) Ground #1: "The application does not comply with sections 38(2)(b) and 12(1)(d) of the Act because it is confusing with Abragio's registration No. TMA382,493 for the trademark ABRAGIO and Abragio's registration for the trademark ABRAGIO EXPRESS in association with restaurant services;
[3 marks]
- (b) Ground #2: "The application does not comply with section 38(2)(b) of the Act because it is confusing with Abragio's application for the trademark ABRAGIO NORTH in association with pizza. **[4 marks]**

Sample Response

The following sample answer would receive full marks.

- (a) The trademark registration number for ABRAGIO EXPRESS is not listed.
Remedy: The application does not comply with Sections 38(2)(b) and 12(1)(d) of the *Trademarks Act* because the applicant's trademark is not registrable, as it is confusing with Abragio's registration No. TMA382,493 for the trademark ABRAGIO and registration no. TMA XXXXXX for the trademark ABRAGIO EXPRESS, both in association with restaurant services.
Section 12(1)(d) of the *Trademarks Act*
- (b) The application number is not mentioned. The statement does not mention whether the Opponent's application was pending at the date of advertisement of the applicant's application.
Remedy: The application does not comply with Sections 38(2)(c) and 16(1)(b) of the *Trademarks Act* because the applicant is not entitled to the registration of the mark as it is confusing with Abragio's application no. XXXXX for the trademark ABRAGIO NORTH, in association with pizza, previously filed in Canada by the opponent, which was pending at the date of advertisement of the applicant's application.
Sections 38(2)(c) and 16(1)(b) of the *Trademarks Act*

Question 8 [4 marks in total]

You represent the Applicant in a trademark opposition proceeding. You have been served with the affidavit below from the agent for the Opponent, 1234 Canada Inc. This affidavit forms the entirety of the opponent's Rule 50(1) evidence. The Affidavit has two exhibits but only one (Exhibit A) is reproduced in the context of this question; assume that Exhibit B was properly included.

An issue in this opposition proceeding is confusion between the Applicant's trademark CLOUD CLOTHING in respect of athletic clothing and the Opponent's trademark CLOUD COATS in respect of winter coats.

Exhibit A

AFFIDAVIT OF ROBERTA JONES

I, ROBERTA JONES, of the City of Winnipeg, Province of Manitoba, Canada, MAKE OATH AND SAY:

1. I am the Director of Marketing and an officer of 1234 Canada Inc. ("my company"), a position which I have held since 2003. I am authorised by my company to make this affidavit in support of this opposition.
2. 1234 Canada Inc. developed and owns patented technology for synthetic insulation used in winter coats. 1234 Canada Inc.'s Canadian patent CA 2,000,000 for this technology expires in 2029 ("Patented Technology"). 1234 Canada Inc. licenses this Patented Technology to various outerwear manufactures inside and outside of Canada. This popular Patented Technology is used in 17 different coat brands sold by 28 different retailers across Canada.
3. In addition to the licence for this Patented Technology, 1234 Canada Inc. has a licence with one outerwear retailer in Canada, namely, THE HARBOUR, for use of the trademark CLOUD COATS in association with winter coats for arctic expeditions using Patented Technology. 1234 Canada Inc. has registered the trademark CLOUD COATS as word mark in the United States of America.
4. THE HARBOUR, with its head office in Toronto, has 88 retail locations in 8 provinces in Canada including British Columbia, Ontario and Prince Edward Island according to the Canadian president of THE HARBOUR, Susan Hébert.

THE HARBOUR sells branded CLOUD COATS in most of those locations pursuant to a licence agreement with my company since at least as early as 2010. The suggested retail price of the coat is \$650 plus applicable taxes. This price is generally adopted by THE HARBOUR retail stores across Canada.

Identify two (2) clear deficiencies in the extract from the affidavit. Clearly identify where in the affidavit each deficiency is found and briefly explain why the deficiency is problematic. The deficiencies to be identified may be substantive to the issues at hand or technical in nature. Only the first two (2) deficiencies will be marked.

[4 marks]

Sample Response

The following sample answer would receive full marks.

Deficiency 1: In paragraph 4, Susan Hébert's statement about The Harbour retail locations constitutes hearsay and is not admissible as evidence because the affiant must possess direct personal knowledge of the information mentioned in the affidavit.

Deficiency 2: The affidavit is not signed and is not sworn, affirmed or solemnly declared.

Question 9 [5 marks in total]

Your client, Sweet Aroma Inc., an Ontario-based company, owns the trademark SWEET AROMA, registered in Canada under registration number TMA666,777 in association with perfumes and colognes. Your client has been using its trademark SWEET AROMA in Sudbury since 2015 in association with perfumes and colognes, as well as its identical trade name to identify its business of manufacturing and selling of its goods.

The President Sweet Aroma Inc. contacts you today because the following application, advertised in the October 21, 2020, edition of the Trademarks Journal, has just been brought to his attention:

1,777,888 – April 22, 2019. Fragrance World Canada Inc., 155 Riverside Road, Calgary, ALBERTA T1X 1T1

SWEET SCENT

GOODS: scented massage oils; scented bath salts. Proposed use in CANADA.

PRODUITS: huiles de massage parfumées; sels de bain parfumés. Emploi projeté au CANADA.

Your client is of the view that SWEET SCENT is confusingly similar to its trademark and trade name SWEET AROMA and is concerned that use of both marks and names may create confusion in the marketplace, especially given that Sweet Aroma Inc. has serious expansion projects across the country.

Some preliminary searches on the applicant's website revealed a press release announcing that Fragrance World Canada Inc. launched the SWEET SCENT line of scented massage oils and bath salts in January 2019 in Calgary.

Further to your discussion with your client and, based on your recommendation, you receive instructions to prepare and file a statement of opposition against application number 1,777,888 filed by Fragrance World Canada Inc.

Assume the grounds of opposition are based on the following:

1. confusion with the client's registered trademark
2. confusion with the client's trademark that has been previously used in Canada
3. confusion with the client's trade name that has been previously used in Canada

For each ground of opposition, identify the nature of the supporting evidence that you will eventually be required to file, as well as who bears the evidential burden in this situation. **[5 marks]**

Sample Response

The following sample answer would receive full marks.

1. Certified copy of trademark registration TMA666,777 SWEET AROMA *or* let the Registrar exercise its discretion and consult the Canadian Trademarks database
2. File Evidence of use of the trademark SWEET AROMA in association with perfumes and colognes in Canada before April 22, 2019 (SWEET SCENT application date). The Opponent has to prove that the trademark was not abandoned at the date of advertisement of the applicant's trademark application (section 16(3) of the *Trademarks Act*)
3. File evidence of use of the trade name Sweet Aroma Inc. in Canada before April 22, 2019 (SWEET SCENT application date). The Opponent has to prove that the trade name was not abandoned at the date of advertisement of the applicant's trademark application (section 16(3) of the *Trademarks Act*).

In all cases, there is an initial evidentiary burden on the opponent to adduce sufficient admissible evidence supporting each ground of opposition.

Question 10 [5 marks in total]

You represent the opponent in a trademark opposition proceeding. A few weeks after the filing of the opponent's evidence in chief, your client provides you with important new evidence that was not previously available. This evidence would strongly assist your client's position in the proceeding. The applicant has not yet filed its evidence and your affiant is set to be cross-examined next month. On behalf of your client, you need to prepare a request to the Registrar seeking leave to submit additional evidence.

Draft a request seeking leave to submit additional evidence. In your request, include the appropriate criteria that will be considered by the Registrar and apply them to the fact scenario. The request can be in point form but must include an opening statement. **[5 marks]**

Sample Response

The following sample answer would receive full marks.

Request for leave to submit additional evidence.

Please find enclosed a draft affidavit which is proposed to be submitted. The opponent respectfully requests to be allowed to submit additional evidence that was not previously available, and which is crucial to support its position. Since the applicant has not yet filed its evidence, it will not be prejudiced by the opponent's request. The opponent will be made available for cross-examination at the request of the applicant.

Question 11 [3 marks in total]

During a cross-examination, the agent representing the applicant requests that accounting records for the last ten years be provided for the product sold under the trademark that is the basis for the opponent's grounds of opposition relating to confusion. The affidavit already includes a statement to the effect that "global sales figures for the opponent's goods over the last ten years exceed \$5,000,000."

Complying with this request would be particularly onerous.

Considering the interests of your client, state whether you should object to the request. Briefly explain why or why not. **[3 marks]**

Sample Response

The following sample answer would receive full marks.

Yes, object to the request.

Any evidence filed with the Registrar is public and for confidential reasons, the client does not want to provide the accounting records for the last ten years. In addition, gathering all the required information would be onerous for the client, whereas the applicant's request is frivolous and abusive in that it would deliberately extend the length of the proceedings.

Question 12 [3 marks in total]

You represent the opponent in an opposition proceeding. You desire to make representations at a hearing by videoconference. You direct your Trademark Agent in Training to draft a request to the Registrar for a hearing. The following is the draft request.

“The Opponent respectfully requests a hearing via videoconference at our below contact.”

For the purposes of the request, assume the letterhead includes all relevant information to permit a hearing via videoconference.

Predict whether the Registrar will grant the request for a hearing. Briefly explain why or why not. **[3 marks]**

Sample Response

The following sample answer would receive full marks.

The Registrar will not grant the request, as several elements are missing: the request must specify whether the opponent will make representations in English or in French and if an arrangement for simultaneous interpretation will be required if the other party makes representations in the other language. See section 58(1) of the *Trademark Regulations*.

Question 13 [3 marks in total]

You represent an opponent in an opposition proceeding. You submitted a request for leave to file additional evidence but now the deadline to submit and serve written representations is fast approaching.

Identify the options you have available to ensure the opponent’s representations will be considered. **[3 marks]**

Sample Response

The following sample answer would receive full marks.

- Request an extension of time to submit the written representations with the consent of the other party (section 47 of the *Trademarks Act*).

- Request an extension of time to submit the written representations based on exceptional circumstances.
- Request an extension of time for a cooling off period with the consent of the other party.

Question 14 [3 marks in total]

You represent an opponent in an opposition proceeding. The proceeding is at the evidence stage. You have not yet submitted and served the opponent's evidence since you are still at the evidence gathering stage. The applicant's agent reaches out to you to discuss a possible settlement. You inform your client who asks if there is any way to "pause" the proceedings to avoid further costs at this point.

Identify a course of action that will help ensure your client does not miss its deadline to submit and serve its evidence. **[3 marks]**

Sample Response

The following sample answer would receive full marks.

Request an extension of time for a cooling-off period with the consent of the other party, which can last up to nine months but knowing that the evidence must be filed by the end of the cooling off period if the opposition proceeding is not settled.