



GARDINER ROBERTS

Carol Hitchman
Partner
Direct Line: 416.865.8259
Direct Fax: 416.865.6636
chitchman@gardiner-roberts.com

September 20, 2010

Delivered Via Fax (819) 997-5092

Darlene H. Carreau
Chair, Trade-marks Opposition Board ("TMOB")
Canadian Intellectual Property Office ("CIPO")
50 Victoria Street, Room 4012
Gatineau, Québec
K1A 0C9



Attention: Ms. Darlene H. Carreau

Copy # 93273

Re: Proposed Amendments to the *Trade-marks Regulations* Pertaining to Opposition Proceedings

We are submitting comments in response to the TMOB's Pre-Consultation Notice dated June 28, 2010 regarding the Proposed Amendments to the *Trade-marks Regulations* Pertaining to Opposition Proceedings (the "Proposed Amendments").

1. Reply Evidence

The Proposed Amendments suggest dispensing with s. 43 of the *Trade-marks Regulations* (the "*Regulations*") which allows the opponent to file reply evidence as of right. This proposal presents an extra hurdle for the opponent in filing reply evidence should any new evidence be uncovered during the process of cross-examinations. Furthermore, the Proposed Amendments are silent on the deadline for applicants to conduct cross-examination on reply evidence filed under s. 44 ("Rule 44 evidence").

Therefore, we suggest that the requirement for obtaining leave to file Rule 44 evidence should not be too stringent. Furthermore, the deadline to file Rule 44 evidence, and to conduct cross-examinations on such evidence, should be set prior to the filing of the opponent's written arguments. We are of the view that it would be more efficient for the parties to file their written arguments once ALL of the evidence, including any reply evidence, has been filed and cross-examination(s) have been conducted. If a party seeks leave to file Rule 44 evidence, we suggest that TMOB set a deadline, e.g. 2 months, for the requesting party to file the evidence, followed by a three month period for cross-examination to take place. The filing of the transcript from the cross-examination of Rule 44 evidence would then trigger the sequential three month deadlines for the parties to file their written arguments, as contemplated by the proposed s. 46 of the *Regulations*.

GARDINER ROBERTS LLP

Scotia Plaza, 40 King Street West, Suite 3100
Toronto, ON, Canada M5H 3Y2

Tel: 416 865 6600 Fax: 416 865 6636 www.gardiner-roberts.com





GARDINER ROBERTS

2. Written Arguments

Under the proposed s. 46 of the *Regulations*, the opponent's written argument would be due within three months after the completion of cross-examinations, followed by a three month deadline for the applicant to file and serve its written argument. This means that the applicant will now have an added benefit, one that is currently not imparted under the *Regulations*, of reviewing the opponent's written argument prior to filing its own. Hence, we agree with the proposed s. 46(3) which contemplates that reply arguments may be filed with leave; however, we suggest that conditions to seek such leave should not be overly stringent. For example, the opponent should be permitted to file a reply argument to respond to new matters raised in the applicant's written argument if such matters were not raised in the opponent's originating submissions.

As discussed above, we also suggest that the deadline for the opponent to file its written argument should be set after the filing and cross-examination of Rule 44 evidence, if any.

We hope our suggestions are helpful to the TMOB in implementing the Proposed Amendments. Should you require further comments, please feel free to contact the undersigned.

Sincerely yours,

Gardiner Roberts LLP

Carol Hitchman
Partner

CH/EJ



GARDINER ROBERTS

FAX TRANSMISSION

Date: Monday, September 20, 2010

File No: 93273

From: Carol Hitchman / 416.865-8259

TO:	FAX #	PHONE #
Ms. Darlene H. Carreau Chair, Trade-marks Opposition Board CIPO	819.997.5092	

Total number of pages being transmitted, including this page 3

If transmittal is not complete, please contact **Sandy O'Donohoe** at **416.865.6680**.

MESSAGE:

Please see attached correspondence

This communication is intended only for the receipt and use of the addressee and may contain information that is privileged and confidential. If you are not the addressee, and you are not responsible for delivering messages to the addressee, you have received it by mistake. We request you not review or copy this material. Please notify us immediately by telephone at 416 865 6681 if you have received this communication in error. No privilege or confidence is intended to be waived by the facsimile transmission of this message.

GARDINER ROBERTS LLP

Scotia Plaza, 40 King Street West, Suite 3100
 Toronto, ON, Canada M5H 3Y2
 Tel: 416 865 6600 Fax: 416 865 6836
 www.gardiner-roberts.com

