

DO'S and DON'TS of ORAL ADVOCACY Before the TRADE-MARKS OPPOSITION BOARD

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FORMALITIES

Do Request a Hearing

Oral hearings are not mandatory, but are of significant strategic importance. The advantage of an oral hearing is that it provides an opportunity to:

- reply to points and arguments made in the written arguments filed by the adverse party;
- respond to any questions or concerns of the hearing officer;
- update the jurisprudence and take advantage of any favourable decisions rendered since the written arguments were filed or to address and distinguish any unfavourable developments in the law.
- resile from a position taken in the written argument; and/or
- further advance your client's case.

When Would You Not Request a Hearing?

An oral hearing may not be necessary in proceedings in which:

- the adverse party has clearly lost interest in the opposition;
- the adverse party has filed no or inconsequential evidence, and/or has elected not to file written arguments;
- the adverse party has not requested a hearing itself; and/or
- after reviewing the adverse party's written arguments you conclude that there is absolutely nothing more you can add to the written arguments filed on behalf of your client. In other words, if you can be reasonably confident your client will prevail in the opposition without the benefit of an oral hearing, then you may recommend against requesting one.

Other reasons why an oral hearing may not be requested:

- the client has lost interest in either the trade-mark application or the opposition;
- the client cannot afford the costs of counsel's preparation for and attendance at the hearing.

Do Comply With the Formalities

It all begins with a Notice from CIPO under Rule 46(3), accompanied by a copy of the written argument filed by the adverse party, advising that an oral hearing may be requested. The parties then have ONE month to advise the Registrar that they wish to be heard. If neither party responds to the Notice within this timeframe, the oral hearing will be cancelled.

In addition to advising whether or not your client wishes to participate in a hearing, you must also advise the Registrar of the following:

- who will be attending;
- whether representations will be made in person or by telephone;
- whether the representations will be in English or French;
- whether simultaneous translation will be required; and
- if the parties consider that they will require more than 2½ hours (½ day) for the hearing, reasons for an extended hearing must be provided.

If you wish to make any changes regarding the hearing, you are required to advise the Registrar as soon as possible and no less than three weeks prior to the scheduled hearing.¹

Date, Time, Duration and Place - Formalities

In response to your request for an oral hearing, CIPO *will issue an acknowledgement and subsequently issue* a Notice advising of the date, time duration and place of the hearing.

Unlike a proceeding in the Federal Court, you have *little if any* input into any of these matters.

The date and time are assigned without consultation with counsel, and the place is usually the Hearing Room, 4th Floor, Phase 2, Place du Portage, Gatineau, Quebec.

The Registrar issues a Notice advising the parties of the scheduled hearing date *about* 90 days in advance of the assigned date, and *until recently*, gave the parties one month to confirm attendance. *Now attendance is assumed, unless one party or both parties advise the Board otherwise.*

Rescheduling or Postponing Hearings

In cases where one or both of the parties who have requested to be heard are not available on the scheduled date, and both parties consent to having the hearing rescheduled, the Registrar is prepared to reschedule the hearing date "as soon as administratively possible"² In reality this means being moved to the bottom of the list.

Opposition hearings generally will be rescheduled only once.³

¹Practice in Trade-mark Opposition Proceedings, March 31. 2009; Section X.4

²Ibid., Section X.2

³Ibid

Once the hearing date is fixed, the Registrar generally will **not** grant any postponements of the hearing date. In particular no postponements will be granted on the basis of consent between the parties and/or the fact that settlement negotiations are underway.⁴

Cancellation of Hearings

A hearing will be cancelled on the consent of both parties. If the parties agree they no longer wish to be heard, the parties must advise the Registrar as soon as possible.⁵

Do Provide Opposing Counsel and the Board with a List of All the Case Law You Intend to Rely upon at the Hearing at Least Five Working Days Prior to the Hearing Date:

The Notice setting down the date of the hearing requires that this be done and compliance is encouraged. If you have last minute additions to your authorities, advise the Board and opposing counsel as soon as possible. The Board will generally permit you to hand up copies of one or two additional cases at the hearing provided opposing counsel does not object. Even in the face of an objection, the Board may allow counsel to rely on additional jurisprudence, and if so, opposing counsel will also be given a few minutes to review the decision and make submissions thereon.

Attending via Telephone?

Counsel may appear in person or via telephone. The Board is quite accustomed to holding hearings via telephone, and are equally attentive to submissions made this way.

While there may be a slight advantage in appearing in person, notably the ability to read the body language of the Hearing Officer, this advantage may not merit the costs to the client of attendance in person.

⁴Ibid, X.6

⁵Ibid, X.7

PREPARATION

Do Prepare Fully for the Hearing

You cannot be "too" prepared. Be very familiar with your material - the Statement of Opposition, Counterstatement, Written Arguments filed by both Opponent and Applicant, and last but not least, the evidence filed by both sides. *Consider preparing an "oral hearing brief" for your use at the oral hearing. The Hearing Officer will not accept it, however, if offered. Be cautious about relying on it slavishly. If acting for the Opponent, be attentive to the Applicant's submissions and flexible enough to make reply remarks.*

Do Focus on the Key Grounds of Opposition

It is standard practice to plead any and all grounds of opposition that appear remotely feasible at the outset. But it is neither desirable nor necessary to address each and every ground of opposition at the oral hearing. Ultimately you should focus the oral submissions on the strongest and best grounds of opposition, based on the evidence adduced and an up-to-date assessment of the law.

Should You Withdraw a Ground of Opposition?

Grounds of opposition may be withdrawn in the Written Arguments or/and at the hearing. For example, it is not uncommon to see grounds based upon s. 30 withdrawn in cases where no evidence has been adduced to support such a ground. Doing so, however, automatically limits the client's options on appeal.

A strategic withdrawal of a ground of opposition may be recommended when:

- a decision on this ground may have adverse consequences for the client (for example, you've alleged descriptiveness, but due to a change in circumstances, such a finding may now be prejudicial to your client);
- you've alleged confusion but the evidence discloses that the applicant's use pre-dates that of the opponent; or
- the grounds have been pleaded in the alternative and the evidence unequivocally points in one direction only.

Review the Written Arguments

Typically your client's written arguments have been filed some 12-18 months before the date of the hearing. Review your client's arguments and note any that may have been bolstered or weakened by subsequent developments in the law.

Review the adverse party's written arguments with a view to replying, countering and distinguishing. Note any facts or cases that appear to be misrepresented as you will definitely want to point this out at the hearing.

Review and Organize the Evidence

The members of the Board are very knowledgeable on the law of trade-marks and rarely require any elucidation on trade-marks law. The primary role of counsel is to review and present the evidence in a fair yet favourable manner and to tie the evidence and law together.

Confirm Material Dates

Before beginning a review of all the evidence, confirm what the material dates are for each of the grounds of opposition⁶ and organize your presentation of the evidence accordingly.

Do Organize the Evidence in a Manner That Facilitates Your Presentation

Be prepared to pin-point for the Hearing Officer exactly where you are in the evidence, whether it is found in:

- paragraphs of the affidavits;
- exhibits and pages of exhibits;
- portions of any transcripts of cross-examinations; or
- answers or information provided in response to undertakings or advisements.

State of the Register evidence may be summarized in a table or chart. If the adverse party has overreached and filed voluminous state of the Register evidence, some or all of which is irrelevant, prepare a chart indicating what marks in the state of the Register are pertinent, and which are not, and why.

Don't Be Disorganized

Fumbling through your materials at the hearing creates a negative impression. Organize your materials any way that works for you. Create a compendium of key documents or excerpts; cut and paste all documents you intend to refer to into your brief; use different colour cover pages and/sticky notes; highlight key passages, etc. What is important is that your presentation flows seamlessly.

Hold a Dress Rehearsal

If this is your first oral hearing, hold a dress rehearsal before an experienced trade-mark agent or lawyer in your firm. Ask your colleague:

⁶The material dates vary, and depending upon the grounds of opposition pleaded, may include the date of filing the application, the claimed date of first use, the date of filing the statement of opposition and/or the date of the Registrar's decision.

For example the material date for s. 38(2)(a)/30 ground is the date of application; a s. 38(2)(b) /12(1)(b) ground is the date of the application; a s. 38(2)(b) /12(1)(d) ground is the date of the decision; a s. 38(2)(c)/16(1) ground is the claimed date of first use; a s. 38(2)(c)/16(2) and (3) ground is the date of application; and a s. 38(2)(d) ground is the date of filing the opposition.

- to be brutally honest about the clarity, flow and cohesiveness of your arguments; and
- to identify potential questions from the hearing officer.

As Mr. Justice Rothstein says "*a dry run through questions is always better than having to think of the answer for the first time in court.*"⁷

PROCEDURE

Who's on First

Counsel for the Opponent speaks first, followed by counsel for the applicant. Counsel for the Opponent then has the right of reply. In exceptional cases, Counsel for the Applicant may be given the right of rejoinder - to speak to an issue raised in reply, but this is rare.

Don't Expect a High-Tech Hearing Yet

Opposition hearings are typically low-tech. The Hearing Officer comes prepared with the pleadings, evidence and written arguments files, and takes written notes. While some counsel are bringing lap tops into the hearing, the Board is not yet equipped for hearings with electronic presentations.

Do Hand Up an Organized and High-lighted Book of Authorities

You must provide copies of the authorities you intend to rely upon at the hearing to the Board and opposing counsel. Highlight the key passages.

Handing Up a Compendium of Documents?

While a compendium of key documents to be referred to at a hearing is often handed up to a Judge in court proceedings, this is not a common practice at an opposition hearing. It may well be useful in oppositions where the evidence is voluminous, and given the new time frame for hearings, we may see more of this.

Breaks/recesses

As with any hearing in Court, if you require a 10 minute break you need only ask, *especially if the hearing is 1½ hours or longer.*

⁷Some Tips on Oral Advocacy from Justice Rothstein;
www.davidstratas.com/queensu/rothstein.htm

PRESENTATION

Open With an Overview Statement

Start by giving the Board a roadmap to your presentation. Outline what grounds of opposition you will be speaking to; flag what the main issues with respect to each ground are; and signal what key arguments on each ground will be. A solid framework for your presentation lets the Board know what the opposition is all about, and provides context for your review of the evidence.

Don't Read Your Written Argument

You can assume that the Board has read the written arguments. Simply showing up to read the arguments already filed is both a waste of time and the loss of an opportunity to bolster your client's position. Focus on the key issues.

Do Present Your Best Argument First

As Mr. Justice Rothstein commented, a point first presentation *"is the most important suggestion for good oral argument. You must state your proposition first and develop it. You may think that the judge needs to understand how the argument will develop or that he or she will not appreciate the point until familiar with the relevant facts; or that an anticipated conclusion will make the ultimate conclusion repetitive. Forget those concerns. State the conclusion up-front. I don't think many cases go by without me asking a lawyer, 'why are you telling us this?'. It may be obvious to the lawyer but not necessarily to the judges. So, always preface the detail with the proposition that the detail is expected to demonstrate. Point first style applies to the facts and the law. Don't quote from a statute or case without first stating what proposition it is you are putting forward and citing the law to support it. Don't refer to factual information without first saying what the information is intended to demonstrate."*⁸

Be Concise

Be brief and to the point. The Hearing Officer will thank you.

To quote Mr. Justice Rothstein once again, *"You will never be criticized by the Hearing Officer because your argument was too short or too concise. Preparing an oral argument is hard work. And preparing a concise oral argument is even harder. Being concise doesn't mean being cursory. You can't be concise unless you first prepare in detail and then eliminate what is truly unnecessary."*⁹

⁸ Some Tips on Oral Advocacy from Justice Rothstein;
www.davidstatas.com/queensu/rothstein.htm

⁹Ibid.

Don't Go Over All the Evidence From A-Z

While flagging key portions of the evidence is critically important, reviewing the evidence in meticulous, mind-numbing detail may obscure what are the key points.

Do Reply to the Adverse Party's Written Arguments

The hearing provides an opportunity to reply to the written arguments filed by the adverse party and distinguish the authorities relied upon.

Don't Ignore the Hearing Officer

Maintain eye contact with the hearing officer; stop speaking while he/she is writing notes; give them time to locate the materials you are referencing; and wait until they look up and nod before resuming your presentation. Give the Hearing Officer the precise location of the documents you are referencing, with the name of the document, as well as the page, paragraph, tab or exhibit number as applicable.

Do Deal With Questions From the Hearing Officer

Questions alert you to the concerns the Board has with your case and provide an opportunity to interact with the Hearing Officer. Deal with them immediately and responsively. Don't evade the question.

Speak Clearly

To date there are no microphones in the hearing room so it is important that you speak clearly. This is especially important if you are making submissions via telephone. Pause to make sure that the hearing officer and opposing counsel have time to take notes and to locate references in the materials.

Be True to Your Own Style

As much as we may all want to emulate *Rumpole of the Bailey*, your presentation may appear awkward if you're trying to mirror someone else's style.

Add a Little Pizzazz

Don't be afraid to throw in a little gentle humour every now and then, when appropriate. However, being Canadian means that self-deprecatory humour works best.

THE CONDUCT OF A HEARING

Do Observe Court Decorum

Trade-mark opposition hearings are much less formal in procedure than a typical court appearance. There is no call to order, no Court Registrar or clerk is present, no reporter transcribing the proceedings, no need to gown or bow, and the Hearing Officers are addressed by name, as Mr. or Ms. Doe. Having said that, the hearings are in all other respects, very similar to a court hearing. Counsel are expected to be courteous and respectful to both the Hearing Officer and their opponent.

Civility

Do be courteous and respectful to the Hearing Officers and opposing counsel. Civility is generally quite high at TMOB hearings. Discourteous exchanges between counsel, while rare, are improper. If opposing counsel engages in personal attacks or other unacceptable conduct, the Hearing Officer may, of his/her own volition, advise discourteous counsel to refrain. It is also appropriate to request that the Hearing Officer invite discourteous counsel to cease the objectionable conduct. In the unlikely event that you are faced with a hostile Hearing Officer who interrupts unnecessarily, or appears to have made up his or her mind before hearing from you, the best strategy is to politely and firmly stand your ground.¹⁰

Do Not Raise a New Ground of Opposition Not Pledged

The Board will not consider issues not pleaded.¹¹

Counsel Should Not Give Evidence

Just as a law firm should not simultaneously be representing a client and providing contentious evidence in a matter, it is improper for counsel appearing at an oral hearing to give evidence.¹²

Be Prepared to Argue the Rules of Evidence

Understand and be prepared to speak to the rules of evidence, including admissibility, hearsay, and the best evidence rule *or necessity and reliability*.

Be Prepared to Deal With Strategic Manoeuvres by Opposing Counsel

Typical strategic manoeuvres include:

¹⁰See Reid, Robert and Holland, Richard, *Advocacy Views From the Bench*, (Toronto: Canada Law Book, 1984) Chapter 15 "*The Rude Judge and Take-over Judge*" at 89

¹¹*Imperial Developments Ltd. v. Imperial Oil Ltd.* (1984), 79 CPR (2d) 12 (F.C.T.D.)

¹²*Cross-Canada Auto Body Supply (Windsor) Ltd. v. Hyundai Auto Canada* (2006), 53 C.P.R. (4th) 286 (F.C.A.); *Bojangles' International LLC v. Bojangles Café Ltd.* (2005), 40 C.P.R. (4th) 295 (F.C.)

- as a preliminary matter at the hearing, a request to amend the trade-mark application to delete wares or services. The TMOB has no jurisdiction to refuse an eleventh hour amendment to delete wares or services listed in the application.
- as a preliminary matter at the hearing, a request to amend the Statement of Opposition.

The Board has the discretion to grant leave to amend the Statement of Opposition at any time.¹³ Any amendment to withdraw a ground of opposition should be graciously accepted.

If the Opponent seeks to amend the statement of opposition to add a ground of opposition, the Hearing Officer has the discretion to accept or refuse the amendment.¹⁴ Typically if Counsel for the Applicant objects, the amendment will be refused given the late stage of the proceedings.¹⁵

- seeking leave to file additional evidence. Handing up additional evidence, such as print-outs from the Trade-marks Register, or the Internet, is inappropriate. The Board will refuse to accept any evidence not properly filed by way of affidavit, statutory declaration or certified copies.¹⁶

Seeking leave at the hearing to file evidence, in the form of an affidavit, statutory declaration or certified copies, pursuant to Rule 44. The Board will rule on a request to file evidence under Rule 44 at the hearing. Typically if opposing counsel objects, the Board will refuse a last minute request to file additional evidence.

Make Appropriate Objections

Objections at T.M.O.B hearings are not common, however it is appropriate to object in the same manner one would in court. Typical objections include:

- inadmissibility of evidence due to:

¹³Section 40, *Trade-marks Regulations* (1996), SOR/96-195

¹⁴See *Alberta Dental Services Corp. v. John Labatt Ltd./John Labatt Ltée*, 11 C.P.R. (4th) 279 at 282 (T.M.O.B.). The Board allowed a request by counsel for the Opponent to include an additional registered trade-mark in the s. 12(1)(d) ground of opposition. The underlying application had been cited in support of the s. 16(1)(a) ground. Counsel for the applicant had no objection.

¹⁵*International Cheese Council of Canada v. Ministry of Commerce, Industry and Tourism of the Republic of Cyprus* (2008), 70 CPR (4th) 430 (T.M.O.B.) at page 435

¹⁶See *Alberta Dental Services Corp. v. John Labatt Ltd./John Labatt Ltée*, 11 CPR (4th) 279 at 282 (T.M.O.B.). The Board refused to accept print-outs from the trade-marks register as they were not in the form of a affidavit, statutory declaration or certified copies.

- hearsay¹⁷;
 - improper reply¹⁸;
 - tendered by member of law firm¹⁹;
 - technical irregularities²⁰.
- adverse counsel giving evidence;
 - an objection to opposing counsel's request to file additional evidence at the hearing, on the grounds of loss of opportunity to consider the evidence; cross-examine on the evidence, and if necessary, to reply to the evidence;
 - misstatements of evidence;
 - sufficiency of pleadings;
 - an objection to opponent's relying on trade-marks not referenced in the statement of opposition to support a non-distinctiveness ground.²¹

Don't Refer to Documents in the Pre-Opposition Record, Unless a Certified Copy of the File History Has Been Filed

The Board will only consider a document in the trade-mark application file if a certified copy of the file history has been filed as evidence in the opposition proceeding.

¹⁷See *Canadian Council of Professional Engineers v. Alberta Institute of Power Engineers*, 2008 CarswellNat 4576 at para. 32

¹⁸*Moulinsart S.A. c. 9200-2880 Québec Inc.* 2008 CarswellNat 5605 at para. 35-38. Generally evidence which is simply confirmatory of evidence already before the Board, or which ought to have been part of a party's case in chief, is not allowed.

¹⁹*Cytokinetics Inc. v. Cobalt Pharmaceuticals Inc.*, 2008 CarswellNat 3794 at para. 11-13. In this case, Opponent's evidence was tendered by members of the agency firm representing the opponent. Applicant's counsel objected, on the basis of the *Cross-Canada* decision. The Board held that "However the *Cross-Canada* case dealt with the application of Rule 82 of the Federal Court Rules to evidence submitted before the Court by a party's solicitor. In the present case, the parties are represented by registered trade-mark agents and there is no equivalent provision in the Trade-marks Regulations governing the conduct of such agents. Furthermore, if there is a remedy available to the opponent in this case, presumably it would have been by way of motion before the Federal Court seeking to substitute a new registered trade-mark agent for the one currently of record as was done in the *Cross-Canada* case. Thus, even if there is merit in the opponent's argument, it would not necessarily mean the removal of the affidavit from the record.

²⁰*C-Gem Seafoods Inc. v. Pêcheries Belle-Ile Fisheries Ltée*, 2008 CarswellNat 4339 at para 11-13: The absence of a notarization on an exhibit or an incorrectly notarized exhibit will not necessarily be fatal if there is no objection raised by the other party or if the objection is raised at such a late stage of the opposition that the party which submitted the evidence has little or no opportunity to correct the deficiency.

²¹*Restaurants Pacini Inc. v. Aulcorp Food Marketers & Distributors Inc.*, 2008 CarswellNat 4337 at para 25

Don't Refer to Privileged Communications

It is inappropriate to refer to privileged communications or documents (such as settlement negotiations or agreements) at the hearing and the Board will disregard such matters.

Don't Expect the Board to Check the Trade-marks Register

Since the Registrar is charged with the care of the trade-marks Register, the Board has the discretion to check the Register and determine whether a particular registration exists. The general position of the Board is that, in an opposition proceeding, Hearing Officers will not exercise this discretion and have regard to anything appearing on the Register that is not properly proved by evidence.

An exception to this general rules arises where reference is made in the Statement of Opposition to a specific trade-mark registration which forms the basis of an allegation that the Applicant's trade-mark is not registrable under ss. 12(1)(d) or 16, regardless of whether the cited registration belongs to the opponent or a third party.²² In short, the Board will not check the trade-mark's Register to take note of the existence of third party registrations.

Judicial Notice

Taking "judicial notice" is the acceptance by a tribunal of the truth of a fact or state of affairs without requiring the introduction of evidence to prove its truth. While it is acceptable to ask the hearing officer to take judicial notice of facts that are of such general or common knowledge that proof thereof may be dispensed with, it is important to understand where to draw the line.

For example, it is well known that the Board will take judicial notice that certain newspapers, such as the Globe & Mail and the Toronto Star have wide circulation in Canada. Beyond this, the examples in the table below may be helpful.

| Examples of Cases In Which Judicial Notice was TAKEN | |
|---|---|
| Citation | Comment |
| <i>Palmolive Canada Inc. v. Shaheed</i> (2005), 45 C.P.R. (4 th) 318 (T.M.O.B.) | Judicial notice taken that "Colgate" is a well-known house mark |

²²*Canplas Industries Ltd. v. Suntown Building Products Ltd.* (2005), 46 C.P.R. (4th) 389 at 398 (T.M.O.B.); *Les Editions Gesca Ltée v. Time4 Media, Inc.* (2007), 60 C.P.R. (4th) 55 (T.M.O.B.).

| Examples of Cases In Which Judicial Notice was TAKEN | |
|---|---|
| Citation | Comment |
| <i>Canadian Pacific Ltd. v. Yasmin Products Pty. Ltd.</i> (2004), 42 C.P.R. (4 th) 455 (T.M.O.B.) | Judicial notice taken that the letters CPR commonly used as acronym for “ <i>cardio pulmonary resuscitation</i> ” (but the Board declined to take judicial notice of fact that letters CPR also serve as abbreviation for “Canadian Patent Reporter” since significance known primarily to legal community, not general public) |
| <i>911979 Alberta Ltd. v. Purepharm Inc.</i> , 2009 CarswellNat 380 | Judicial notice taken that the public recognizes that “.ca” is the country code designating Canada. |
| <i>Heinz Italia S.R.L. v. Furlani’s Food Corp.</i> , 72 C.P.R. (4 th) 356, 2008 CarswellNat 4812 | Judicial notice taken that regardless of whether product designed for infants, the product is purchased by adults |
| <i>XS Energy LLC v. Petrillo</i> , 2007 CarswellNat 5497 | Judicial notice taken that January 1 is a stat holiday in Canada |
| <i>Maison Cousin (1980) Inc. v. Cousins Submarines Inc.</i> , 2005 CarswellNat 1125 | Judicial notice taken that a French-speaking person would not pronounce the “s” at the end of the word “cousins” and therefore its pronunciation in French is identical to the pronunciation in French of the word “cousin”. |
| <i>Boy Scouts of Canada v. Aleksiuik</i> , 2006 CarswellNat 4327 | Judicial notice taken that the beaver is one of Canada’s national emblems |
| <i>Spirits International N.V. v. SC Prodal 94 SRL</i> , 2005 CarswellNat 4461 | Judicial notice taken that Joseph Stalin is a well-known Russian historical figure and some Canadian vodka consumers may relate the first part of STALINSKAYA to the surname STALIN and the most well known individual bearing that name |
| <i>Lofaro v. Esurance Inc.</i> , 2010 TMOB 216 | Judicial notice taken that internet age arrived suddenly but no decision as to when this occurred |
| <i>Monge (Estate) v. Peace Community Church of Canada Ltd.</i> , 2010 TMOB 208 | Judicial notice taken of federal and provincial corporate name legislation |
| <i>Effigi Inc. v. ZAM Urban Dynamics Inc.</i> , 2010 TMOB 214 | Judicial notice taken of French pronunciation of FIG |

| Examples of Cases In Which Judicial Notice was TAKEN | |
|--|--|
| Citation | Comment |
| <i>"K" Line America Inc. v. Total Logistics Control Inc.</i> , 2010 TMOB 189 | Judicial notice taken of Oxford Canadian Dictionary definition for "logistics" |

| Examples of Cases In Which Judicial Notice was REFUSED | |
|--|---|
| Citation | Comment |
| <i>Desjardins Sécuritaire Financière, cie d'assurance-vie v. Bank of Nova Scotia</i> (2004), 36 C.P.R. (4 th) 358 (T.M.O.B.) | Refusal to take judicial notice of relationship between banking and insurance services - opponent required to support, by evidence, assertion of overlap in channels of trade |
| <i>Toronto Dominion Bank v. e-Funds Ltd.</i> , 71 C.P.R. (4 th) 22, 2008 CarswellNat 4347 | No evidence that the average Canadian understands the prefix "e" to be descriptive of an electronic or online application as of April 29, 1999; Opponent required to support via evidence |
| <i>St. Joseph Media Inc. v. Nygard International Ltd.</i> , 2006 CarswellNat 5007 | Refusal to take judicial notice of practice that it is common for magazines to be distributed in advance of the date that they bear |
| <i>Empresa Cubanda del Tabaco v. Tequila Cuervo, S.A. de C.V.</i> , 2008 CarswellNat 3744 | Judicial notice refused that practice of ladies retiring to the drawing room so gentlemen could remain in the dining room to partake of cigars and brandy still applicable |
| <i>Wrangler Apparel Corp. v. Big Rock Brewery Partnership</i> , 2009 CarswellNat 382 | Judicial notice refused of the fact that western and country life-style would be closely associated with beer (<i>Appeal dismissed: 2010 FC 477.</i>) |
| <i>GA Modelfine S.A. v. Di Gio' S.R.L.</i> , 2006 CarswellNat 2095 | Judicial notice refused that Giorgio Armani might be a well-known designer |
| <i>Mapei Inc. v. Kerakoll S.p.A.</i> , 2010 CarswellNat 608 | Judicial notice refused of entries in specialized dictionaries |
| <i>Quantum Electronics Inc. v. Dima's Tool & Die Ltd.</i> , 2010 TMOB 155 | Judicial notice refused of file wrappers because Applicant did not seek Rule 44 leave |

| Examples of Cases In Which Judicial Notice was REFUSED | |
|--|---|
| Citation | Comment |
| <i>Empire Comfort Systems Inc. v. Onward Multi-Corp. Inc.</i> , 2010 CarswellNat 900 | Judicial notice refused that Leamington Post is a major daily newspaper in Canada |
| <i>Hudson's Bay Co. v. Boyner Holding Anonim Sirketi</i> , 2010 TMOB 16 | Judicial notice refused of extent to which "The Bay" has become known in Canada |

Be Prepared to Speak to the Jurisdiction of the Board

The Registrar is a creature of statute and has no inherent jurisdiction. Section 38(8) delineates the powers of the Registrar in an opposition proceeding, which powers are narrowly circumscribed. The Registrar has the authority to either refuse the application or to reject the opposition, but has no power to make any amendments to the Register;²³ to make a finding that a trade-mark relied upon by the opponent is invalid;²⁴ to rule on the lawfulness of opponent's use of a trade-mark;²⁵ although the Registrar has the jurisdiction to refuse to consider opponent's prior use of trade-mark when such use has already been found to be infringing or unlawful²⁶.

Don't Threaten the Hearing Officer With an Appeal

Even if the Hearing Officer is demonstrably unimpressed with your client's case, letting them know that you will be appealing their decision will not further your cause.

Speaking in Reply

Justice George Finlayson described the reply as "*potentially the most effective, but regrettably, the most misused tool of advocacy*".²⁷ Just because you have the right to reply does not mean

²³See *Bacardi & Co. v. Havana Club Holding S.A.* (2004), 32 C.P.R. (4th) 306 (F.C.A.) at para. 24-32: Registrar has no jurisdiction to question or amend ownership of an registration

²⁴*Cognos Inc. v. Cognisys Consultants Inc.*, (1994), 53 CPR (3d) 552 (T.M.O.B.); although see *Molson Canada 2005 v. Anheuser-Busch Inc.*, 2008 CarswellNat 4577 wherein the Board found that it had the jurisdiction to limit the scope of protection accorded to Opponent's registered trade-mark in view of a cloud on the initial registration obtained in 1926 (under appeal)

²⁵*Sunbeam Products, Inc., v. Mister Coffee & Services Inc.* (2001), 16 C.P.R. (4th) 53 (F.C.T.D.) at para 17-18

²⁶*Lunettes Cartier Ltée v. Cartier Inc.* (1991), 36 C.P.R. (3d) 391 (T.M.O.B.); *McCabe & Yamamoto & Co. (America) Inc.* (1989), 23 C.P.R. (3d) 498 (F.C.T.D.)

²⁷See Justice George Finlayson, "*Appellate Advocacy in an Abbreviated Setting*" (1999), 18 Adv. Soc. J.

you should exercise it. Saying nothing in reply is rarely a mistake. If you think you need a few minutes to compose the reply, ask for a ten minute recess.

Only reply if:

- Applicant's counsel has raised a new point that you did not anticipate in your argument in chief and the point seems to have caught the attention of the hearing officer, or
- Applicant's counsel has clearly misstated the facts and you can readily establish this by pointing to a portion of the evidence.

A good reply is brief and focussed.

As a matter of practice, while Applicant's counsel is speaking, write down all the points to which you want to reply. Discard all but the top three.