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ODUTOLA ON CANADIAN TRADEMARK PRACTICE

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Release No. 7, November 2024

This landmark practitioner's treatise provides an insightful analysis of trademark law practice and procedure before the Canadian Trademarks Office and Trademarks Opposition Board. It remains the most comprehensive text of its kind. The publication is supported by extensive references to case law, statutes, annotated cross-references to the *Trademarks Act* and *Trademarks Regulations*, Trademarks Office and Trademarks Opposition Board practice notices, and other source materials.

This release includes updates to the case law and commentary in Chapter 16 (Introduction to Summary Cancellation Practice) and Chapter 19 (Pleadings Practice and Procedure in Opposition Proceedings).

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Highlights

- **Chapter 16—Introduction to Summary Cancellation Practice—I. Expungement/Non-Use Proceedings—B. Who May Initiate a Notice and When?—2. Responses to a Section 45 Notice and Extensions of Time—b. Evidence in the Form of Affidavit or Statutory Declaration—16:9. Who Can Swear on Affidavit or Make a Declaration on behalf of Registered Owner?**—Below is an excerpt from this section which has been updated in this release—

Any person who has personal knowledge of the registered owner’s operations may file evidence in response to a section 45 notice. There is no requirement that the affidavit be filed by the registered owner nor a prohibition preventing an unrecorded successor-in-title from doing so either. (*2Performance Apparel Corp. v. Uvex Toko Canada Ltd.*, 2002 CarswellNat 4835, 25 C.P.R. (4th) 284 (T.M. Opp. Bd.), reversed 2004 CarswellNat 938, 2004 FC 448 (F.C.) at 286–287 [C.P.R.] (Trade-marks Hearing Officer)). However, this does not mean that the requesting party is entitled to file evidence or provide the Registrar with research not forming part of the registered owner’s evidence. As such, the Registrar will disregard any information from the requesting party. (*Gowling WLG (Canada) LLP v. JCorp Inc.*, 2024 TMOB 168 at para 11).

- **Chapter 19—Pleadings Practice and Procedure in Opposition Proceedings**—Significant changes have been made to Chapter 19 in this release. § 19:4.50. Types of Applications: Divisional vs Original Application (Non-Divisional) has been added to the chapter: Section 40 of the Trademarks Regulations provides that any action taken in respect of an original application on or before the day on which a divisional application is filed is deemed to be an action in respect of the divisional application. As such any statement of opposition filed by the Opponent against a parent application will be deemed to have also been filed against any each of the resulting divisional application(s). (*Wolf Appliance, Inc. v. Procorp Canada Sourcenter Inc.*, 2024 TMOB 130 at para 8).

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