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### **ODUTOLA ON CANADIAN TRADEMARK PRACTICE**

**Bayo Odutola, B.C.L., LL.B. and Karen Hansen**  
**Release No. 5, June 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 caselaw and commentary in Chapters 9 (Objections Related to "Descriptiveness" and "Misdescriptiveness"), 10 (Objections Based on the Likelihood of Confusion), 16 (Introduction to Summary Cancellation Practice) and to Appendix TC: Table of Concordance.

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## Highlights

- **Part III. Examination of Objects/Office Actions—Chapter 9. Objections Related to “Descriptiveness” and “Misdescriptiveness”—II. Nature and Type of Objections That May Be Raised by Virtue of Paragraphs 12(1)(b) and 12(1)(c) of the *Trademarks Act***—This section has been updated with new commentary, including commentary on establishing descriptiveness in a Canadian matter using references from other countries. While references can be made from outside Canada, since it is a question about the meaning in English and French, one may argue that the words do not have the same meaning and nor are they understood the same as they are in Canada. Such is the case between English used in England, Canada, Australia, or French between Canada, Switzerland and Belgium.
- **Part III. Examination of Objects/Office Actions—Chapter 10. Objections Based on the Likelihood of Confusion—V. Rebuttal Based on the Surrounding Circumstances of Subsection 6(5) of the *Trademarks Act*—B. Sub-paragraph 6(5)(a)—Inherent Distinctiveness, Extent Known**—Even a common work or expression can be said to be distinctive in association with a particular set of goods or services, if a party can establish the absence of evidence of common usage in association with a particular set of goods or services: *Servus Credit Union Ltd. and Meridian Credit Union Limited*, 2023 CarswellNat 4396, at para. 99.
- **Part VII. Introduction to Trademarks Opposition Board Practice—Chapter 16. Introduction to Summary Cancellation Practice—I. Expungement/Non-Use Proceedings—B. Who May Initiate a Notice and When?—2. Responses to Section 45 Notice and Extensions of Time—b. Evidence in the Form of Affidavit or Statutory Declaration**—For the purposes of establishing use, it is not sufficient that the registered owner provide evidence that goods were offered during the relevant period; some evidence of transfers in the normal course of trade is necessary. That is, there must be a transfer of possession during the relevant period. Moreover, the evidence of transfer need not be in the form of invoices or sales reports, it can also be provided through clear sworn statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars: *Borden Ladner Gervais LLP and Freedom Mobile Inc.*, 2023 CarswellNat 3975 at paras. 19-20.

## ProView Developments

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