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ODUTOLA ON CANADIAN TRADEMARK PRACTICE

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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 Appendix: Procedural Summaries.

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Highlights

- **Summary of Procedure for Appeals Pursuant to Section 56 of the Trademarks Act — Case Law — Procedure —** Justice Aylen concluded that the proper interpretation to be given to the phrase "place of origin" in section 12(1)(b) of the TMA was an extricable question of law reviewable on the standard of correctness. Justice Aylen was satisfied that the TMOB erred by adopting an incorrect approach to the interpretation of section 12(1)(b) and thereafter in its determination that the trademark at issue fell short of identifying or naming a place. Further, Justice Aylen was satisfied that the TMOB erred by imposing an excessive burden on the Opponent. In an opposition proceeding, the Opponent bears an initial burden to adduce sufficient admissible evidence from which it could reasonably be conclude that the facts alleged to support the ground of opposition exists. When that evidentiary burden is met, the Applicant then bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the TMA. In this case, the TMOB found that NORTH 42 DEGREES was not the name of a place of origin and concluded that the Opponent had not met its evidentiary burden. However, the question of whether a place of origin includes a designated line of latitude is a legal question, not an evidentiary one. The onus did not lie on the Opponent to convince the TMOB as to the proper interpretation of section 12(1)(b). In light of these errors and given that the evidence was exclusively in writing and no issue of credibility arose, Justice Aylen rendered the decision that the TMOB should have rendered. The trademark NORTH 42 DEGREES contravened section 12(1)(b) of the TMA as it clearly described the place of origin of the Applicant's goods and services: *Nia Wine Group Co., Ltd. v. North 42 Degrees Estate Winery Inc.*, 2022 CarswellNat 1684, 2022 CarswellNat 563, 2022 FC 241, 2022 CF 241, 190 C.P.R. (4th) 229, 2022 A.C.W.S. 58 (F.C.).
- **Summary of Procedure for Appeals Pursuant to Section 56 of the Trademarks Act — Case Law — Cross-Examinations —** The central question on this application was whether the Board's conclusion that it was not in the interests of justice to permit Anheuser-Busch to amend the Statement of Opposition was a palpable and determinative error. Justice Walker was not persuaded that the Decision contained an error of law. The material date for determining registrability under paragraphs 12(1)(d) and 38(2)(b) of the Act is the date of decision. However, neither Anheuser-Busch's opposition nor the ultimate question of registrability of the Mark and the confusion analysis under paragraph 12(1)(d) was before the Board for determination. The Board was focused on an interim matter in the opposition. Justice Walker acknowledged that the Board's disposition of the request would affect its analysis of the opposition and the paragraph 12(1)(d) ground of opposition but distinct considerations apply to the analysis of a section 48 request to amend. As only registered trademarks can form the basis of an allegation that a mark is not registrable pursuant to paragraph 12(1)(d), this ground of opposition did not extend to the pending applications for the Budweiser Cannabis Marks. Once the applications matured to registration, Anheuser-Busch was required to file a request for leave

to amend the Statement of Opposition to have the registrations considered under the paragraph 12(1)(d) ground and they did so on June 15, 2021. The existence of an opponent's new registered trademarks and the rights they enjoy pursuant to section 19 of the Act are important factors in the assessment of an opposition and in the analysis of a Regulation 48 request to amend. However, the Board is not constrained to accept a request solely because it would otherwise make its decision on the opposition, specifically a paragraph 12(1)(d) ground of opposition, without consideration of all relevant registered trademarks on the date of decision. Justice Walker found no pure or extricable error of law in the Decision. The Board did not change the material date for assessment of registrability pursuant to paragraphs 12(1)(d) and 38(2)(b) of the Act by refusing to grant the request for leave to amend the Statement of Opposition: *Anheuser Busch, LLC v. H.O.W. Medical Solutions Ltd.*, 2022 CarswellNat 2097, 2022 FC 842, 2022 A.C.W.S. 1357 (F.C.).

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