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ODUTOLA ON CANADIAN TRADEMARK PRACTICE

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Release No. 7, August 2025

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.

What's New in this Update:

This release features updates to Chapter 6. Amendments to Applications or Requests for Publication, Chapter 16. Introduction to Summary Cancellation Practice, Chapter 18. Commencement of Opposition Proceedings and Chapter 19. Pleadings Practice and Procedure in Opposition Proceedings.

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Highlights:

- **Chapter 6. Amendments to Applications or Requests for Publication—II. Pre-Advertisement Amendments—§ 6:20.1. Amendment to Statement of Goods and/or Services—Exclusionary Wording**—A new section has been added to Chapter 6 in this release. The following is an excerpt from this new section—

Exclusionary wording in the statement of goods/services is form of limitation. Exclusionary word must be specific and cannot include language that is vague, indefinite or ambiguous. [Catherine Sidonio v Chanel Limited, 2024 TMOB 189 at para 73]. Failure of the applicant to provide a clear understanding of the scope of the applied-for services covered by the limitation is sufficient ground to refuse an application. [Catherine Sidonio v. Chanel Limited, 2024 TMOB 189 at para 77].

The Registrar will generally not accept the exclusion of goods/services to overcome an objection that the trademark is clearly descriptive under paragraph 12(1)(b) of the Act, as any exclusion would likely cause the trademark to be deceptively misdescriptive. [Practice Notice, Exclusionary wording in statements of goods or services, published July 19, 2021 and amended December 19, 2022].

- **Chapter 16. Introduction to Summary Cancellation Practice—I. Expungement/Non-Use Proceedings—B. Who May Initiate a Notice and When?—4. Hearing; Decision; Appeal—§ 16:23 Appeal**—

The following is an excerpt from this newly updated section—

Prior to April 1, 2025, a registered owner on appeal to the Federal Court had the automatic right to file additional evidence under s. 56(5) of the *Trademarks Act*. Effective, April 1, 2025, the amendments to the *Trademarks Act*, in particular, section 226 removes the automatic right to file additional evidence in appeals of the Registrar's decisions at the Federal Court.

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The consequence of this amendment is twofold. First registered owners will now be required to put their best foot forward in terms of providing evidence given that the ability to course correct on appeal will not be a matter of course. Second, registered owners will have to meet the high bar set by the requirement to seek leave as set out by the Federal Court Rules rather than the *Trademarks Act* or Trademarks Opposition Board practice.

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While s. 56(5) of the *Trademarks Act* does not specify the test for leave, the Federal Court has an established jurisprudence setting out the test for leave, which will, equally be applicable to the *Trademarks Act*.

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