

Publisher's Note

An Update has Arrived in Your Library for:

Please circulate this notice to anyone in your office who may be interested in this publication. <i>Distribution List</i>
<input type="checkbox"/>
<input type="checkbox"/>
<input type="checkbox"/>
<input type="checkbox"/>

CANADIAN TRADEMARKS ACT ANNOTATED Robic Release No. 11, December 2024
--

This comprehensive reference work sets out the original purpose and application of the Act, administrative policies, case law and secondary sources.

What's New in this Update:

§ 38. Statement of Opposition has been completely rewritten in this release.

THOMSON REUTERS®	Customer Support 1-416-609-3800 (Toronto & International) 1-800-387-5164 (Toll Free Canada & U.S.) E-mail CustomerSupport.LegalTaxCanada@TR.com
-------------------------	---

This publisher's note may be scanned electronically and photocopied for the purpose of circulating copies within your organization.

Highlights

§ 38. Statement of Opposition—§ 6.6 Filing Evidence—
Below in an example of the recent cases added to this section:

The Spirit Bear Coffee Company Inc v. Kitasoo Band Council, 2023 CarswellNat 3371 (F.C.; 2023-09-06) Lafrenière J. [affirming 192 C.P.R. (4th) 323 (T.M.O.B.; 2021-11-26)]. [42] The TMOB held that once Kitasoo met its evidential burden, SBCC bore the legal onus of establishing, on a balance of probabilities, that its application complied with the requirements of the Trade-marks Act. This onus meant that if a determinate conclusion could not be reached in favour of SBCC after a consideration of all of the evidence, then the issue would have to be decided against it: *John Labatt Ltd v Molson Companies Ltd.* (1990), 30 CPR (3d) 293 at 298 (FCTD).

§ 38. Statement of Opposition—§ 6.12 Miscellaneous—
Below in an example of the recent cases added to this section:

Promotion in Motion Inc. v. Hershey Chocolate & Confectionary LLC, 2024 FC 556 (F.C.; 2024-04-09) Tsimberis J. [affirming 178 C.P.R. (4th) 249 (T.M.O.B.; 2020-03-27)] [148]?In its Decision, the Board considered the evidence before it and held that it was insufficient to conclude that the term “KISS” was generic as of the material dates in the opposition proceeding in relation to chocolate products specifically, which was the more specific and relevant question before it (not candy in general). The Board first considered the KISS and KISSES Trademark Registrations registered in association with chocolate products, which are presumed valid (TMA s 19; see for example *Group III International Ltd v Travelway Group International Ltd*, 2020 FCA 210 at para 12), and that the Board does not, in the context of an opposition proceeding under section 38 of the TMA, have the jurisdiction to expunge or otherwise declare these registrations invalid. The Board then considered the evidence of third party use of the term “KISS(ES)” in Canada in association with chocolate and concluded that it appears to be very limited, both in terms of the number of such products and the lack of evidence of the volume of sales in Canada. The Board wrapped up this point at paragraphs 58 and 59 of the Decision by finding that, while the word “kiss” may indeed have had a generic meaning with respect to candy in general,

“kiss” with respect to chocolate has acquired its own distinctiveness from Hershey’s extensive sales and advertising using their KISS and KISSES Trademarks over several decades.

ProView Developments

Your ProView edition of this product now has a new, modified layout:

- The opening page is now the title page of the book as you would see in the print work
- As with the print product, the front matter is in a different order than previously displayed
- The Table of Cases and Index are now in PDF with no searching and linking
- The Table of Contents now has internal links to every chapter and section of the book within ProView
- Images are generally greyscale and size is now adjustable
- Footnote text only appears in ProView-generated PDFs of entire sections and pages