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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.

What's New in this Update:

This release features updates to Chapter 9 (Objections Related to "Descriptiveness" and "Misdescriptiveness"), Chapter 10 (Objections Based on the Likelihood of Confusion) and Chapter 19 (Pleadings Practice and Procedure in Opposition Proceedings).

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Highlights:

Part III. (Examination Objections/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*)—§ 9:4 (Descriptiveness Objection Based on Paragraph 12(1)(b)—Languages Other than English or French)—The following is an excerpt from this section —

... on a plain reading of paragraph 12(1)(b) [of the *Trademarks Act*], Parliament specifically used the words “in the English or French language”. It would appear that if Parliament had intended that clearly descriptiveness or deceptively misdescriptive assessment include words other than those actually in vs recognized by the English or French language, it could easily have said so or used the expression “by”. As such, merely providing evidence that a word is familiar to Canadian consumers is insufficient to meet the bar set by Parliament for paragraph 12(1)(b).

Furthermore, in paragraph 12(1)(b), the limitation set by Parliament is strictly as to the meaning in the English or French language. In considering what is in the English or French language, regard must be had to the Federal Court of Appeal’s strictures in *Thorkelson v. Pharmawest Pharmacy Ltd.*,

[15] What remains to support the judge’s decision is his own impression of the meaning of the words “Canada” and “drugs” when used in association with an online pharmacy business, and the inferences he drew, without any evidence, about what consumers would or would not understand. There is a place in cases of this kind for a judge to apply his own common sense, with the assistance of dictionaries, as to the meaning of ordinary words and phrases. However, it cannot fairly be said that on May 20, 2003, the phrase “Canada Drugs”, which is the phrase at the core of both of the trade-marks in issue in this case, had a known meaning. [emphasis added].

Part III. (Examination Objections/Office Actions)—Chapter 10 (Objections Based on the Likelihood of Confusion)—V. (Rebuttal Based on the Surrounding Circumstances of Subsection 6(5) of the *Trade-marks Act*)—D. (Paragraph 6(5)(c)—Nature of Goods or Services)—§ 10:49 (Different Goods or Services—Same Broad Category)—The following is an excerpt from this section—

The mere fact the parties’ goods can be found within a building does not make them similar; however, electronic locks that can be integrated with home energy management and automation devices were held to indirectly overlap with temperature controllers and control interfaces and displays for household apparatus and installations. [*Spectrum Brands, Inc. v. Schneider Electric Industries SAS*, 2019 CarswellNat 5850, 2019 CarswellNat 5851, 2019 TMOB 94, 174 C.P.R. (4th) 222 (T.M. Opp. Bd.) at paras. 48 to 56; affirmed *Schneider Electric Industries SAS v. Spectrum Brands, Inc.*, 2021 CarswellNat 3221, 2021 CarswellNat 1604, 2021 FC

518, 185 C.P.R. (4th) 36 (F.C.).] However, if one is able to establish that the goods/services are not sold in the same sort of retail business, it is likely that one may conclude that the channels of trade do no overlap. [*Glen Raven, Inc. v. Pharma Cosmetics Laboratories Ltd.* 2025 CarswellNat 5608 at para 35]. Even if the channels of trade overlap, one may still be able to distinguish between the nature of the parties' business such that one cannot be considered to be an extension of the other. [*Panda Restaurant Group, Inc. v. Fetch Panda Ltd.* 2025 CarswellNat 4766 at para 44, 45 & 58].

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