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### CANADIAN TRADEMARKS ACT ANNOTATED

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Release No. 4, April 2022

#### Publisher's Special Release Note 2021

The pages in this work were reissued in November 2021 and updated to reflect that date in the release line. Please note that we did not review the content on every page of this work in the November 2021 release. We will continue to review and update the content according to the work's publication schedule. This will ensure that subscribers are reading commentary that incorporates developments in the law as soon as possible after they have happened or as the author deems them significant.

Changes to chapter and heading numbering may have occurred. Please refer to the Correlation Table in the front matter if you wish to confirm references.

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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:**

This release features updates to Appendix J. CIPO including the addition of the Goods and Services Manual – Main Features, Goods and Services Manual – Class Headings, and the addition of the Trademarks Guide. This release also features the addition to Appendix P1. Nice Classification of the Nice Classification – 11th Edition – Version 2022 – List of Classes with Explanatory Notes. This release also includes updates to Appendix PS. Procedural Summaries VI. Summary of Procedure for the Resolution of Disputes under the CIRA Domain Name Dispute Resolution Policy.

### **Highlights:**

- **Nice Classification—11th Edition—Version 2021—List of Classes with Explanatory Notes—** A new version of the eleventh edition of the International Classification of Goods and Services for the Purposes of the Registration of Marks came into force on January 1, 2022. The International Bureau of WIPO will apply the 2022 version of the eleventh edition of the Nice Classification to: any application for international registration that is received by the Office of origin on or after January 1, 2022; any application for international registration that is received by the International Bureau of WIPO on or after January 1, 2022, when the said application is received by the International Bureau of WIPO after the two-month time limit referred to in Article 3(4) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. For all international registrations for which the list of goods and services has been classified according to the 2021 version of the eleventh edition of the Nice Classification, the International Bureau of WIPO will insert the abbreviation “NCL (11-2022)” next to the list of goods and services in the notifications sent to designated Contracting Parties, registration certificates and publications. The International Bureau of WIPO will not reclassify, in accordance with the 2022 version of the eleventh edition of the Nice Classification, the list of goods and services in international registrations with a date earlier than January 1, 2022.
- **Summary of Procedure for the resolution of disputes under the *CIRA Domain Name Dispute Resolution***

**Policy—Case Law—Notice to the Registrant—** The identity of the Registrant was not published in the public WHOIS database. Therefore, the Registrant’s name was not included in the Complaint. The Complainant did not file any further submissions with respect to the issue of the Registrant’s legitimate interest in the disputed domain name. The Registrant failed to file its response by the due date. The Panel explained that the Registrant’s failure to participate raised the question of whether he or she in fact received the complaint. Although CDRP proceedings are designed as summary in nature, basic natural justice demand that the Panel be satisfied the Registrant received, or was afforded an adequate opportunity to receive, notice of the complaint. Based on the material provided, the Panel was satisfied the CIIDRC forwarded a copy of the Transmittal Letter and a copy of the Complaint to the Registrant at the address set forth in the registration information. Pursuant to the CDRP Rules, the Registrant was thus deemed to have received sufficient notice to allay any natural justice concerns: *Skechers USA, Inc. II and Berling, Re*, 2021 CarswellNat 2933 (C.I.R.A.).

- **Summary of Procedure for the resolution of disputes under the CIRA Domain Name Dispute Resolution Policy—Case Law—Complainant Had Rights—** The disputed domain name was termodeck.ca. The Complainant is the owner of the Canadian trademark registration TermoDeck. Where the Complainant relies upon a trademark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use. In cases where a trademark registration matured to registration after the domain name registration date, or the Complainant is relying on common law rights, it must establish rights that predate the domain name registration. The Domain Name was registered on June 24, 2004. The TERMODECK Trademark issued to registration before the registration date of the Domain Name. Therefore, the Complainant established rights that preceded the registration of the Domain Name: The disputed domain name was termodeck.ca. The Complainant is the owner of the Canadian trademark registration TermoDeck. Where the Complainant relies upon a trademark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use. In cases where a trademark registration matured to registration after the domain name registration date, or the Complainant is relying on common law rights, it must establish rights that predate the domain name registration. The Domain Name was

registered on June 24, 2004. The TERMODECK Trademark issued to registration before the registration date of the Domain Name. Therefore, the Complainant established rights that preceded the registration of the Domain Name: *RLI Byggdata AB and Laken, Re*, 2021 CarswellNat 2463 (C.I.R.A.).

### **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
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- 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
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