

## CHANGING CANADIAN TRADEMARK LAWS – THE NEXT STEPS

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As part of the implementation of various changes to Canadian Trademark Laws, the Federal Government of Canada released in June, 2017 the new proposed Trademark Regulations for public consultation.

Canada has been modernizing its trademark law, including by moving to join three International Treaties administered by the World Intellectual Property Organization (WIPO) dealing with trademarks. These include the Madrid Protocol, the Singapore Treaty and the Nice Agreement. Canada has amended the *Trade-marks Act* to comply with the requirements of the treaties. It is now taking other steps toward implementation of the changes. One of these steps is these new proposed Trademark Regulations.

The proposed changes to the Trademark Regulations are intended to compliment the amendments that were made to the *Trade-marks Act*. The Regulations provide details relating to procedures and time frames for filing, prosecution and registration of trademarks with the Canadian Trade-marks Office.

The Madrid Protocol allows owners the possibility of obtaining trademark protection in a number of countries by filing one single international application in one language with WIPO. The new Trademark Regulations align Canada's processes with those of the International Bureau of WIPO. One of the key goals of the Regulations is to minimize the differences between a domestic trademark application and one filed through the Madrid system.

The Singapore Treaty simplifies and standardizes many formalities and procedures relating to the trademark process. It makes procedures more consistent internationally. It also covers new types of trademarks such as holograms, colour *per se* and scent. The new Trademark Regulations will change a number of procedures, including standardizing the process of obtaining a filing date and providing applicants with certain relief measures should they fail to comply with certain deadlines.

The Nice Agreement is a classification systems used to categorize goods or services, according to 45 general classes, for purposes of registering a trademark. The primary purpose of adding the classification information to the Register is to assist in the electronic searching of trademarks. Under the new Trademark Regulations, the applicant will be required to classify the goods or services in its trademark application, according to the latest version of the Nice classification. In Canada, it is intended that the Nice classification will be implemented in a manner that will not have any substantive effect upon examination, confusion, Section 45 cancellation proceedings, opposition proceedings or other questions relating to the extent of trademark protection.

In Canada, at the current time, using the Nice classification with CIPO is optional and non-mandatory. Since the Fall of 2015, CIPO has been accepting applications which include the grouping of goods and services according to the classes. However, such filings are not mandatory until the coming into force of the revised *Act* and the Regulations.

Use will no longer be a prerequisite to registration in Canada. There will be no need to file Declarations of Use in order to obtain registration. There will also no longer be a requirement to declare a specific filing base for application. It will not be necessary to claim existing or proposed Canadian use. Applications will include a standard statement that the applicant has used or intends to use the mark in Canada.

Currently, the government filing fee for a Canadian trademark application is \$250.00, regardless of the number of classes. The Regulations specify fees per class. Therefore, the government filing fee will be \$330.00 for the first class and \$100.00 for each additional class. The registration fee will be eliminated.

Currently, the government filing fee for the renewal of a trademark is \$350.00, regardless of the number of classes. Under the new Trademark Regulations the government filing fee will be \$400.00 for the first class and an additional \$125.00 for each additional class.

Third party correspondence is not permitted on any trademark application file. The new Regulations will permit Letters of Protest by third parties during prosecution of the trademark application. This correspondence will be for the purposes of raising registrability concerns as to why the mark should not be registered.

There is no procedure in Canada to divide or merge applications or registrations. The new Trademark Regulations prescribe such a procedure, which will allow for the dividing or merging of applications and/or registrations.

There will be other modernizations dealing with opposition proceedings. These new Regulations will permit the parties in opposition proceedings to file their evidence electronically. Timing for cross-examination will be different. Written Arguments will be filed in sequence, rather than in parallel. There will also be a simplification of certain other procedures before the Opposition Board.

Most importantly, the term of registration will be reduced from the current 15 years to 10 years. This is in respect of any new registrations issued after the new law is fully implemented.

The public consultation period has expired with respect to these new Regulations. We must now wait to see when the Federal government will release the final version of the Trademark Regulations. The next step may be the release of proposed Practice Notices or proposed updates to the Trademark Examination Manual. There will be more to report between now and early 2019.

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