

Major changes to Canadian trademark law and practice coming into force June 17, 2019 — Are you ready?

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The Canadian Parliament passed legislation back in 2014 which made sweeping and significant changes to the *Trademarks Act*. Many of the changes were welcomed, while others were unexpected and generated controversy and debate. The five-year delay in implementation has permitted the Canadian Intellectual Property Office (CIPO) to undertake significant changes internally, train staff and, more importantly, make necessary upgrades to CIPO's IT systems. The amendments and the new "regime" will come into force June 17, 2019, and, while that date is imminent, there is still time to take action to benefit from the coming changes. The most important changes to Canadian trademark law and practice are summarized below.

Applications

- Applications will no longer need to specify a basis for filing or dates/details of use.
- Goods and services will need to be classified according to the Nice Classification system.
- The government filing fee will be increased to C\$330 for the first class and an additional fee of C\$100 will be payable for each class of goods/services covered by the application. *Accordingly, in the case of multi-class applications, there is a significant cost incentive to file prior to June 17, 2019, to avoid government "per class" fees.*
- Canada will join the Madrid Protocol. Provided that they have a "home country" application, Canadians will be able to file Madrid applications with the World Intellectual Property Organization (WIPO) and CIPO will accept and examine applications filed by foreign Madrid applicants seeking Canadian registrations.
- Declarations of use will be eliminated. Applications pending as of the coming into force date will also benefit from the elimination of this requirement and can issue to registration once the goods/services have been properly classified and the government registration fee has been paid.
- The definition of "trademark" will be expanded (to include new non-traditional marks such as scent, taste, texture) and will cover anything that functions as an indicator of source. However, these marks will be subject to examination for distinctiveness and it may be

difficult to obtain registrations of non-traditional marks unless the applicant can furnish evidence of extensive use and promotion.

- It will be possible to divide applications (and also to merge registrations which resulted from a divided application).

Assignments

- Documentary proof of mergers, assignments, changes of name or other changes in title will no longer be required (unless requested by CIPO).
- The “associated mark” provisions of the Act will be repealed and the “associations” deleted from the Register. This will remove impediments to the recordal of changes affecting some, but not all, marks that had been “associated” with each other by CIPO by reason of shared elements.

Registrations

- Registrations which issue after June 17, 2019, will have a term of 10 years (rather than the current 15-year term).
- There will be no government registration fee payable where the registration issues from an application filed after June 17, 2019.

Renewals

- Any registration coming due for renewal and/or renewed after June 17, 2019, will need to be amended to classify the goods and/or services according to the Nice Classification system.
- The renewed term of any registration coming due for renewal and/or renewed after June 17, 2019 will be 10 years (rather than the current 15 years).
- Any registration renewed after June 17, 2019, will be subject to increased fees. The government fee to renew in one class will be C\$400. The government fee for each additional class of goods/services to which the request for renewal relates will be C\$125. Registrations can be amended on renewal to delete one or more classes of goods/services.
- Registrations due for renewal after June 17, 2019, can be renewed early (for a 10-year term). The current government renewal fee will be payable and no “per class” fees will be incurred. *Accordingly, particularly in the case of multi-class registrations, there may be a significant cost savings associated with classifying and renewing prior to June 17, 2019, to avoid the increased government “per class” fees.*

In addition to the changes highlighted above, a great many other changes to examination, opposition and to technical requirements of the Act will be implemented as of the coming into force date. Some of these changes should simplify the registration process somewhat and may encourage brand owners to take steps to protect their marks in Canada and abroad. However, the race to avoid “per class” filing fees coupled with the elimination of the requirement to assert or prove use in order to obtain a trademark registration has already precipitated speculative filings and other types of objectionable behaviour. The “new” marketplace imposes increased pressure on brand owners to be vigilant in identifying misleading and fraudulent third-party solicitations relating to the acquisition and

maintenance of trademark rights and monitoring CIPO filings for potentially conflicting third-party marks.

Please feel free to contact any member of Osler's IP group for further information or advice as the coming into force date approaches.