

Practice Update: Amendments to Canada Trademark Law to Take Effect June 17, 2019

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The long awaited date for implementation of Canada's amended Trademarks Act has been announced. The amendments will come into force on June 17, 2019, creating significant changes for trademark practice in Canada.

The amendments to the Trademarks Act, announced in 2014, were made to allow Canada to join five international IP treaties, including the Madrid Protocol, Singapore Treaty, and Nice Agreement. Some of the major

changes include the following:

- Applicants will be required to use the Nice Classification administered by the World Intellectual Property Organization (previously there was no class system or identification of class necessary in Canada). As a result, applicants will now be required to pay registration fees per class identified, as opposed to a single application fee of \$250 CAD that is presently used. Given this significant increase, it may be worthwhile to consider filing multi-class applications now, to avoid the increase in filing fees.
- Applicants will no longer be required to identify a date of first use at the time of filing and Declarations of Use will no longer be required for registration (both for new applications and pending applications). Notably, practitioners in Canada anticipate this will lead to an increase in the number of trolls and squatters applying to register trademarks in Canada. There have already been reports of a sharp increase in 2017 in the number of applications filed in Canada covering all 45 classes of the NICE Classification, something that was relatively rare in Canada before 2017.

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- It will be possible to divide an application in Canada which will allow applicants to manage the speed at which applications are registered when there may be challenges to only some of the identification of goods or services in an application.
- The government registration fee will be eliminated from the application process, though application filing fees and renewal fees will be increased. The application filing fee will be \$330 CAD for the first class plus \$100 CAD for each additional class (v. current \$250 CAD filing fee). The registration renewal fees will be \$400 CAD for the first class plus \$125 CAD for each additional class (v. current fee of \$350 CAD).
- The term of registration in Canada will be reduced from 15 years to 10 years (the 15-year term for existing registrations will not change).
- Canada will officially accede to the Madrid Protocol, meaning Canada may be designated in an International Registration filed with WIPO.

Given the significant changes that will impact trademark registration and enforcement procedure in Canada, now is the time to consider Canadian registration strategy for important brands. Expansion of existing registered protection to guard against the likely onslaught of trolls and squatters should be prioritized, as well as consideration of filing of multi-class applications now, before fee changes take effect.

We will post further updates as implementation of the amended law progresses. Stay tuned to The TMCA.