

# CANADA'S NEW *TRADEMARKS* ACT:

## TOP TEN THINGS YOU NEED TO KNOW

Canada's new trademark Regulations are a complex blend of the Canadian Regulations and the Common Regulations for the Madrid Protocol, and provide for our adherence to the Singapore Treaty and the Nice Agreement. The Regulations will implement a number of significant changes in Canadian trademark practice, including the following:

1. **Adherence to the Madrid Protocol.** For Canadians, the Madrid Protocol will provide the ability to secure international registration of a mark through a single application in a more cost and administratively efficient manner. In turn, foreign applicants will now be able to secure protection in Canada under the Madrid Protocol.
2. **The elimination of use as a prerequisite to registration in Canada.** There will be no more Declarations of Use. Nor do the new Regulations introduce any use-based maintenance requirement for Canadian registrations. This should reduce overall timing to registration for a standard application. Importantly, use will remain a crucial element for protection and enforcement of marks in Canada following the three-year protection period.
3. **The elimination of the requirement to declare a specific filing base for applications.** The new Regulations eliminate the requirement to claim existing Canadian use at the time of filing and the reliance on a foreign registration as a basis for a Canadian application. Applications will include a standard statement that the applicant has used or intends to use the mark in Canada.
4. **Introduction of a “per class” application and renewal fee structure.** While single class applications will enjoy a slight reduction in government fees, multiple class filings will see an increase. Similarly, government renewal fees for multi-class registrations will be more expensive than for renewals filed before the coming into force date. Multi-class applications filed now before the coming into force date will pay only a single government fee.
5. **Renewal requests accepted only six months before or six months after a renewal deadline.** Registrations with a renewal deadline that falls after the coming into force date can be renewed now — but will be allocated a 10-year renewal term. Currently, renewal requests may be filed at any time. You may wish to consider renewal requests now to avoid the per class renewal fee structure.
6. **Reduction of term of registration from 15 to 10 years for new registrations issued after the coming into force date.** Existing registrations will be converted at their next renewal date.
7. **Introduction of Nice Classification.** Implementation of the requirement to group and class goods and services according to the Nice Classification before approval of a new application and as part of the renewal process, or in response to a CIPO issued notice requesting classification for registered marks. CIPO currently provides the ability to classify applications and registrations in preparation for this on a voluntary basis.



8. **Introduction of Letters of Protest.** The proposed Regulations provide the ability to correspond with an Examiner to raise registrability concerns about a third party application at any point from filing to publication.
9. **Division of Applications.** The Regulations introduce the ability to divide goods and services in an application into two or more applications during examination and opposition to provide the ability to advance applications for certain goods and services, if others remain challenged.
10. **Changes in Opposition Practice.** For opposition proceedings, we will now have sequential filing of Written Arguments ending with the applicant's submissions and shared responsibility in cross-examination with the examined party to be responsible for submission of undertakings by the deadline.

The Canadian Intellectual Property Office continues to demonstrate its willingness to collaborate with the agent community and brand owners on these important changes to Canadian trademark practice. If you have any concerns or questions, please reach out to your Gowling WLG professional. In the meantime, we will continue to share further information and developments with you.

For more information, visit: [gowlingwlg.com/canadian-trademark-changes](http://gowlingwlg.com/canadian-trademark-changes)