WERKSMANS
ATTORNEYS

INTELLECTUAL PROPERTY

Trade marks: changes to the Canadian trade marks act

30 April 2019 *3 min read*

On 17 June 2019 the Canadian Trade Marks Act will be introducing several changes pursuant to it joining the Madrid Protocol. The most significant changes are set out in the below table:

	CURRENT	AMENDMENT AS OF 17 JUNE 2019
I	A Declaration of Use of the mark in Canada is required to attain registration.	The "Use" requirement will be removed with no requirement to state a date of first use of the mark in Canada and registration and use abroad.
II	There is no Classification system thereby allowing for wide specifications and the payment of a fee for one class.	The International Nice Classification system will be introduced, separating goods and services also requiring the payment of Government fees per class.
III	The renewal term is fifteen years.	The renewal term will be reduced to ten years subject to the following: • Assuming a trade mark has been filed prior to 17 June 2019 and it proceeds to registration the renewal period will remain at 15 years. • If a Declaration of Use is filed prior to the 17 June 2019 the renewal term is 15 years.
IV	International designations are not possible.	Canada will join the Madrid Protocol allowing international applications with a centrally administered system, designating member states in which they also want to obtain national protection. To do so the Canadian applicant must already own a domestic (i.e. Canadian) registration.
V	The Registrar does not recognise divisional applications.	It will be possible to divide applications permitting non-contentious portions of trade mark applications to proceed to registration while the remainder of the application undergoes examination.
VI	Non-use cancellation proceedings cannot be restricted to certain goods and services in a registration.	Non-use cancellation proceedings may be restricted. The non-use term remains three years from date of registration.

CONSIDERATIONS

- It is anticipated that by removing the requirement to show "Use" that there will be a significant increase in trade mark applications with the result that trade mark owners will need to be even more vigilant, possibly introducing watch services if not yet in place.
- If it is possible to file a Declaration of Use of the mark prior to 17 June 2019 this is recommended attaining a 15 year term of protection as opposed to the new 10 year term.

- Trade mark filing costs will increase if the goods and services fall within more than one class. Should Canada be a territory of interest, it may prove more cost effective to file the trade mark application prior to 17 June 2019.
- Trade marks will also include marks such as colour or a combination of colours, taste, textures, scent, sound, moving images, holograms and 3D shapes.

If you would like to learn more about Intellectual Property please visit our practice area page.



Donvay Wegierski

Director

View Profile