

New Canadian Trademark Rules Go Into Effect June 17, 2019

December 10, 2018

The Canadian Intellectual Property Office has issued new Trademark Regulations that will go into effect on June 17, 2019. These new regulations implement significant amendments in the Canadian Trademarks Act adopted by the Canadian Parliament in 2014.

These changes will affect all companies who have existing trademark registrations or pending applications in Canada, or who sell products and conduct business in Canada or anticipate doing so in the future.

The changes in Canadian trademark law are intended to bring Canada into line with several international treaties, including the Madrid Protocol, providing a system for filing a single international application with the World Intellectual Property Organization, and the Nice Agreement, establishing the International Classification of Goods and Services.

Notable upcoming changes in Canadian trademark law as of June 17, 2019, will include:

- Use of Nice Classification - All new trademark applications and renewals of existing registrations must use the Nice Classification for the description and classification of goods and services. This will affect the cost of all applications and renewals filed after June 17, 2019.
- Filing Fees - The filing fee for a new trademark application will be \$330 CAD for the first class, and \$100 CAD for each additional class. (The current filing fee is \$250 CAD, regardless of the number

of classes.) Applicants may want to consider filing an application prior to June 17, 2019, especially if they will file in multiple classes.

- Renewals - The renewal fee for existing trademark registrations will be \$400 CAD for the first class, and \$125 CAD for each additional class. (The current renewal fee is \$350 CAD, regardless of the number of classes.) Owners of existing registrations will also be required to re-classify their goods and services according to the Nice Classification System. Again, owners of existing registrations may want to consider filing renewals prior to June 17, 2019.
- "Use" Requirement - Declarations of use and dates of first use in Canada will no longer be required (even for pending applications filed before June 17, 2019). In view of the elimination of the "use" requirement, applicants may want to consider filing applications "pre-emptively" to protect their trademark rights, in anticipation of activity by trolls and squatters.
- Term - The term of trademark registrations and renewals will be 10 years. (The current term is 15 years.)
- Definition of Trademark - The definition of what constitutes a "trademark" will be significantly expanded, and will now include: word, personal name, design, letter, numeral, colour, figurative element, three-dimensional shape, hologram, moving image, mode of packaging goods, sound, scent, taste, texture and the positioning of sign. Accordingly, trademark owners and applicants may want to consider reviewing their trademark portfolios to ensure all important elements of their brand are protected.
- Distinctiveness - New applications will include examination for "distinctiveness," not only descriptiveness and likelihood of confusion with other marks.
- Divisional Applications - Applications may be "divided," so that portions, such as certain goods and services, may be handled separately. This is expected to expedite the handling of applications.

We encourage all clients with existing trademark registrations and pending applications in Canada, or who either already are or contemplate doing business in Canada, to consider how these upcoming changes may affect them. We would be glad to have one of Lathrop Gage's trademark professionals discuss any specific issues and concerns. Please feel free to contact either Amy Brozenic (913-451-5103, abrozenic@lathropgage.com) or William Scofield (857-300-4032, wscofield@lathropgage.com).