



## Are You Ready? Countdown to Implementation of Canada's Amended Trademarks Act

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Long-awaited and much discussed amendments to Canada's *Trademarks Act* will come into effect on June 17, 2019 (the "coming into force date", or "CIF"). In order to avoid surprises, here's what you need to know about existing applications, new applications filed as of the CIF, renewals, oppositions and registrations. In addition, as discussed below, the Canadian Intellectual Property Office ("CIPO") will be temporarily deactivating all online services for several days prior to June 17 – making it important to plan in advance for processing of any steps that should be completed before the CIF.

### Applications filed before June 17:

- Any application that had not been approved as of April 18 will be reassessed after the CIF. At that time, Examiners in the Trademarks Branch of CIPO may reexamine applications for compliance under the amended Act, including with classification of goods and services and new distinctiveness examination criteria.
- Classification will not be required for any application already advertised by June 17. However, CIPO may require classification at a later date. Class fees are not applicable to applications filed before the CIF.
- Outstanding requirements to complete filing grounds, namely the filing of certified copies of foreign registrations and declarations of use, will not apply after the CIF.
- Any application advertised before the CIF can be opposed based on current opposition grounds. That would include any application advertised before June 17 with an extension to oppose that expires after the CIF.
- Applications advertised after the CIF will be subject to opposition on amended grounds, which include "bad faith filing" in addition to existing registrability, entitlement and distinctiveness grounds.
- As of the CIF, advertisements will not display filing grounds, and errors in filing grounds will generally not form a ground of opposition.
- Allowed applications may issue solely upon payment of the registration fee, regardless of the original filing basis (declarations of use will not be required).
- Any registration that issues up to June 16 will have a 15-year term. If an application has been allowed, it is recommended to process registration requirements before the CIF to take advantage of a longer term. That may mean dropping a proposed use claim, if other filing grounds included use in Canada, or use and registration abroad. Alternatively, if the mark is not in use on all of the goods/services of interest, the applicant can wait until after CIF so that the filing of a declaration of use is not required. In that case the registration will have a 10-year term.

**NOTE – if an applicant wishes to file a declaration of use now, it is recommended to do so as soon as possible, to ensure processing by CIPO before the CIF.**

### Applications filed on or after June 17:

- Filing grounds will no longer be required. Applicants may file if they are using, or propose to use, and are entitled to use their marks in Canada.
- Classification and class fees will apply to all applications filed on or after the CIF. Government filing fees will be \$330 CA for the first class, and \$100 CA for each additional class.

**NOTE - class fees will be payable for all classes included in the application at the time of filing.** Unlike other jurisdictions, such as the United States, an applicant cannot include many classes in the original application, pay a single



fee, and reassess inclusion of multiple classes after examination. While an applicant will receive a filing date upon payment of a single fee, total fees for all included classes will be required, and failure to pay all fees will result in abandonment of the application. That means applicants must be sure which classes to include when filing.

- Filings for a broader range of non-traditional marks will be possible, including taste, scent and texture. Generally speaking, non-traditional marks will require evidence of distinctiveness at the filing date in Canada.
- Examiners may also require evidence of distinctiveness should they view a mark as not inherently distinctive.
- New opposition grounds will apply – and will include bad faith filing.
- Registration fees will no longer apply. All fees are payable on filing.

#### **Renewals processed before June 17:**

- The current renewal term is 15 years. That term will apply to any registration due for renewal up to the CIF. Also, any registration due for renewal before the CIF, but renewed in the grace period after June 17, will issue for a 15-year term.
- A single government renewal fee of \$350 CA is payable until the CIF, regardless of the number of classes of goods/services. It is recommended, if possible, that multi-class registrations due for renewal after the CIF be processed before June 17 to take advantage of lower fees. While that will not impact the renewal term (all renewals due as of the CIF will have a 10-year term), it may result in cost savings for multi-class registrations.
- Classification of registrations is not required for renewal before the CIF. However, CIPO may require classification of goods/services at a later date.

#### **Renewals processed after June 17:**

- The renewal term will be 10 years.
- On renewal, goods and services must be grouped and classified, and class fees must be paid. Government renewal fees will be \$400 CA for the first class, and \$125 CA for each additional class.

**NOTE - renewal fees will be calculated based on the number of classes of goods/services in the registration at the time of renewal.** Registrants may not pay class fees based only on the number of classes they wish to maintain. Instead, prior to renewal, registrations should be reviewed, not only to ensure that goods and services are grouped and classified, but that any unwanted classes are specifically removed before the renewal is processed.

#### **Changes to oppositions and non-use cancellation (s. 45) proceedings:**

There are many changes to opposition and s. 45 procedures, ranging from service rules to extensions of time, impacted by the amended Act and Regulations, as well as many new Practice Notices. As a general rule, apart from the transitional provisions impacting opposition grounds (noted above), new regulations and procedures will apply to all opposition and s. 45 proceedings as of the CIF date.

#### **Madrid Protocol:**

As of June 17, Canadians may take advantage of the *Madrid Protocol* to broaden their international trademark protection. Similarly, trademark owners from other countries will be able to designate Canada in an application for an international registration, or in any subsequent designation using the *Madrid Protocol*.

#### **CIPO's online services will be temporarily unavailable before June 17:**

- CIPO has advised that all online services, including filing, confirmation of use and payment of registration fees, filing of a statement of opposition, and access to the Trademarks Database, will be unavailable from June 13 to 6:00 AM on June 17.
- On June 13 and 14, it will be possible to conduct business with CIPO by using approved local government offices for the filing of documents. However, if certain steps, such as payment of registration fees, are not processed (vs. filed) by June 17, the "new" law will apply.

**NOTE – in order to avoid delays or the loss of any rights, CIPO has encouraged that communications with the Trademarks Branch be filed in advance of June 13.**

As of June 17, there will be new online forms and procedures, new fees and a different trademark search interface.



Bereskin & Parr's trademark team is here to help with all questions relating to the amended *Trademarks Act*, including all transition issues.

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