



Countdown to Canada's New Trademark Laws: Make Sure You Take Advantage of Cost Savings While You Can

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Canada's long-awaited amendments to the *Trademarks Act* are now confirmed for June 17, 2019. Trademark owners still have several months to prepare for the changes, which, [as we have written about before](#), will impact many trademark steps from searching and filing to registration and enforcement. Key changes include elimination of use as a registration requirement, implementation of the Nice Classification system and related fees-per-class for both filing and renewal, and shortened renewal terms. Transition rules, some of which are very complex, will also impact costs and procedure.

There are a few steps all brand owners should consider NOW that may permit cost-savings and broader rights:

1. FILE NOW TO AVOID HIGHER FEES FOR MULTI-CLASS APPLICATIONS

The combination of mandatory Nice Classification of goods and services and new filing fees will increase the cost of registration for entities seeking protection in multiple classes. Currently, total government fees are \$450 CAD – namely a single filing fee of \$250 CAD for applications filed online regardless of the number of goods and services, plus a registration fee of \$200 CAD payable following allowance. As of June 17th, filing fees will increase to \$330 CAD for the first class, plus \$100 CAD for each additional class. By way of example, total government fees for a mark covering foods, beverages, and clothing and entertainment services will increase from \$450 CAD (filing + registration fees) to at least \$630 CAD, depending on how those goods and services are classified. While separate registration fees will not apply to any application filed on or after June 17th, total government fees for a 4-class application will increase by at least 50%. If brand owners are considering filing in Canada, they should do so before June 17th to avoid these increases.

2. RENEW NOW TO AVOID HIGHER FEES FOR ALL REGISTRATIONS

Currently, Trademarks Office practice offers opportunities for cost-savings on renewal that will disappear on June 17th.

As of June 17th, government renewal fees will increase from the current \$350 CAD per registration, regardless of the number of goods/services/classes, to \$400 CAD for the first class of goods/services and \$125 CAD for each additional class. As above, that will impact multi-class registrations significantly. Using a 4-class registration as an example, government fees will increase from \$350 CAD to \$775 CAD. In addition, renewal terms will shorten from 15 to 10 years for all registrations due for renewal on or after June 17th.

Under current Trademarks Office practice, there is no limit on how early a renewal request may be processed. While most businesses arrange for renewals within a year of the renewal deadline, it is possible to renew two, three or more years in advance. Under the new amendments, renewal will only be possible 6 months in advance of the deadline. While it may not be possible to predict, now, if marks will still be of interest a year or more from now, for major marks due for renewal in the next several years, there can be considerable cost savings to renewing now. For that reason, check upcoming renewals, not just in 2019, but in 2020 or even 2021, and consider renewing before June 17th to take advantage of these cost savings.



3. DECLARATIONS OF USE – FILE NOW, OR WAIT?

Since “use” as a registration requirement will disappear as of June 17th, applicants with allowed applications that require the filing of a declaration of use in Canada might want to keep those applications pending, especially if the mark is now used only on a small sub set of the filed goods/services. As of June 17th, those pending applications will no longer require a declaration of use, and may be registered for the full list of filed goods/services upon payment of the current government registration fee (\$200 CAD).

On the other hand, since any registration that issues after June 17th will have a 10 (vs. 15) year term, applicants who are in a position to complete their registration requirements *before* June 17th should do so to get the benefit of the longer registration term. For example, applicants who must file a declaration of use and have already used the mark, or have used for most of the filed goods and services and are unlikely to use on the others, or have another acceptable filing ground such as registration and use abroad, might want to complete the registration process now. Practically, getting protection for a broad list of goods/services may outweigh getting a longer term, but for applications with completed filing grounds and/or use on the key goods/services, taking steps before June 17th may be advisable.

4. PREPARE STANDING INSTRUCTIONS TO PAY REGISTRATION FEES

Owners of allowed applications, and those with many pending applications should consider providing instructions now to pay the registration fee on June 17th, to obtain registration as soon as possible under the new “no use” regime.

5. CANADIAN APPLICANTS CAN INITIATE INTERNATIONAL BRAND PROTECTION UNDER THE MADRID PROTOCOL

Starting on June 17th, Canadian companies will be able to request that their trademark rights be extended to other countries under an international filing system called the Madrid Protocol, designed to bring cost-savings for international brand protection especially relating to foreign filing fees. Requests for international protection will be submitted by the Canadian Trademarks Office to the International Bureau of the World Intellectual Property Organization, who, in turn, will forward brand protection extension requests to national trademark offices for examination under national rules. For Canadian companies, use of this system requires a Canadian application or registration for the specific goods/services as a prerequisite. Canadian businesses can prepare to take advantage of this system as soon as possible by ensuring they have Canadian applications or registrations in place, along with a list of preferred foreign countries for extended protection. [Read our related article here.](#)

The changes to the *Trademarks Act* bring not only new challenges and some uncertainty, but also opportunities for businesses and trademark owners. In the few remaining months leading up to implementation of the changes, we urge businesses to focus on, and take advantage of, those opportunities. Bereskin & Parr’s [Trademark Team](#) is here to help.

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