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# Canada: New Trademark Regime

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## Registration

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- a per-class fee structure

## More

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## Registration

- classification of goods and services based on the Nice Classification;
- a per-class fee structure (\$330 CDN for the first class and \$100 CDN for each additional class for applications filed online; paper filings will cost more)
- a registration term of 10 years (as opposed to the prior 15-year term, still applicable, though, to registrations with a renewal date prior to June 17, 2019)
- elimination of requirement to claim a specific use basis for trademark applications (all applications will be filed on the basis of “use or proposed use in Canada”)
- elimination of Declarations of Use requirement to secure registration, including for currently pending proposed use applications
- adoption of the Madrid Protocol (see further comments below)

## Practice Points

*New Applications:*

- With respect to applications filed on or after June 17, 2019, examiners will determine whether or not additional classes are required to cover the specifications in the application, and applicants will have to pay class fees for each additional class required by the examiner; deleting or amending the goods/services for any added class(es) will not be an option. Accordingly, applicants should review their specifications carefully before filing, to avoid any \$100 additional per class fee(s) for goods or services which may not be of principal interest.

*Pending Allowed Applications:*

- Applications which matured to registration prior to June 17th will have a 15-year term (as opposed to 10 years under the new regime).
- Any application that was not advertised before June 17th will not be approved for advertisement or advertised on or after that date if it has not been classified. The Trademarks Office assigns classes on filing if they have not been included; also, about a year or so ago, the Office added class details to all registrations. These are not substitutes for applicant/registrant classification.

*Renewals (fee structure, classification, and timing):*

- Fee structure: The official fee for renewals that were processed before June 17th remained a flat fee of \$350 CDN (about \$265 USD), regardless of the number of classes. As of June 17th, however, renewals are subject to a fee of \$400 CDN (approximately \$305 USD) for the first class, and an additional \$125 CDN (approximately \$95 USD) for each additional class.
- Term: The renewal term will depend on whether the registration was due before June 17, 2019 or after. As of that date, the renewal term was shortened from 15 to 10 years for all marks due for renewal as of June 17th. If the actual renewal date was on or after the “coming into force” date of June 17th, it was not possible to stretch the renewal to 15 years even if processed before that date.
- Classification: As of June 17th, goods/ services in registrations will need to be classified before renewal will be processed. To save the per-class fees, registrants may wish to pare down coverage as appropriate to their business, prior to renewing.

**Other changes**

- expanded coverage for nontraditional marks

- a “bad faith” basis for opposition/ expungement
- possible registrar-initiated non-use proceedings
- potentially more rigorous examination for distinctiveness, including for nontraditional marks
- enhanced customs and anti-counterfeiting provisions
- elimination of documentary proof requirement when recording assignments and mergers (although the CIPO may request such documentation later)
- repeal of associated marks provision, such that it will no longer be necessary to record changes such as assignments and mergers against all associated marks
- a new option of drawing attention to prior applications/registrations during Examination, analogous to U.S. Letters of Protest

### **Division of applications/registrations**

In addition, it will now be possible to divide a pending application or existing registration. The scope of goods/services covered, however, will depend on when a divisional application is filed. If filed before the original application is published, the divided goods must fall within the specifications of the original application. If filed after publication, the scope must be within the original application on the date the original application is published.

It will also be possible to sub-divide divisional applications, and merge divided applications back together after they have registered.

### **Madrid Protocol Considerations**

As was the case when the U.S. joined Madrid, there are certain important features of the Canadian registration system which should be borne in mind when considering whether to rely on a Madrid Protocol filing including, but not limited to, the following:

- While use is not required at filing or to secure a registration, applicants filing based on proposed use may still be called on to demonstrate an intent to use the mark in Canada.
- The owner of an unregistered mark may oppose an application and/or object to use of a third-party mark, based on common law rights.

- Applicants for non-traditional, or other marks that may not be considered inherently distinctive, should expect more rigorous examination, including especially the need to prove acquired distinctiveness in Canada.
- Bad faith has been added as a basis for opposition.
- Specifications of goods and services must be more detailed than in many other jurisdictions, and applications may be refused, or in certain circumstances possibly even considered to indicate bad faith, if specifications are overly broad.

While there are clearly cost savings to be gained from filing based on the Madrid Protocol, as with any local filing, strategies should include prior clearance for registered and unregistered rights, as well as considerations relating to coverage and distinctiveness. –[JLH](#)

## **Primary Contacts**

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