

## Opportunity or Difficulty?

As a result of the government of Canada tabling five treaties on intellectual property law in the House of Commons on January 27, 2014, the government has initiated the process to make the provisions of these treaties part of Canadian law. Legislation to implement the necessary changes to the *Trade-marks Act*, *Industrial Design Act* and *Patent Act* can be expected as early as March.

While Canada's intellectual property laws have undergone significant change in the last several years, implementation of these five treaties will likely have a greater impact than the changes that have taken place since 2000. As Winston Churchill observed: "The pessimist sees difficulty in every opportunity. The optimist sees opportunity in every difficulty." While the transition will not be without difficulty, it presents a significant opportunity for Canadian business.

Three of the treaties deal with trade-marks: namely the Madrid Protocol, the Singapore Treaty, and the Nice Agreement. The Madrid Protocol establishes an international system for filing trade-mark applications in several jurisdictions at once. Once the mark is registered, changes, such as changes in ownership, can also be addressed in a single filing. At present Canadian businesses must file separately in each jurisdiction in which it seeks protection. The Singapore Treaty seeks to bring the practice and procedure of the trade-marks offices in each country that joins in line with a common standard. While in the short term this will mean learning a new system, in the long run it will mean less time and effort spent dealing with differences among relevant offices. The Nice Agreement is a standardized system for classifying wares and services that should simplify searching for

relevant trade-marks and preparation of applications. Adoption of the Nice Agreement for classification is a prerequisite for participation in the Madrid Protocol and the Singapore Treaty.

The fourth treaty, the Geneva Act of the Hague Agreement establishes a system for the international registration of industrial designs (which corresponds to a design patent in the United States). In this it is similar to the Madrid Protocol for trade-marks and the Patent Cooperation Treaty system presently in force in Canada for patents.

The fifth treaty, the Patent Law Treaty, corresponds in its intent to the Singapore Treaty for trade-marks, and aims to bring patent law practice of member states in line with a common standard. Again, while in the short term it will mean learning a new system to prosecute Canadian patent applications, it will also mean that the differences between patent offices should diminish over time.

The greater uniformity of international intellectual property laws and registry systems should reduce the logistical challenges and cost of maintaining an international intellectual property portfolio. This is the opportunity. Once Canada implements these treaties, it will of course remove a barrier to foreign businesses protecting their intellectual property in Canada. This is the difficulty. Both the opportunity and the difficulty will need to be addressed by fresh thinking, and long-standing business processes will have to change. Planning for these changes will position a business to compete effectively. Regardless, change is coming, and businesses will fall into one of two categories: those that manage the change, and those that have it thrust upon them.

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[a cautionary note](#)

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