

TOP TWELVE THINGS TO KNOW - NEW CANADIAN TRADEMARKS ACT JUNE 17, 2019

Posted on June 4, 2019

Categories: [Insights](#), [Publications](#)

On June 17, 2019 major changes to Canada's *Trademarks Act* will come into force. We have created a list of some of the highlights below, but these are by no means the only significant amendments.

1. A person may file an application if they are using or propose to use, and are entitled to use, the trademark in Canada. However, there will no longer be any requirement to provide a date of first use or to expressly claim actual use (domestic or foreign) or proposed use (i.e. no filing bases will need to be provided).
2. The requirement to file a declaration of use before the mark can be registered has been eliminated. An application that is allowed will be registered automatically (although for marks filed before the coming into force date ("CIF") a \$200 registration fee will be payable). However registered trademark owners will be prevented from obtaining relief in a proceeding alleging infringement or depreciation of goodwill during the first three years of registration unless the trademark was in use during that period or special circumstances exist that excuse the absence of use^[1].
3. Applications can be divided at any stage of the application process and, once registered, merged again. This will be useful when dealing with office actions and oppositions.
4. Goods and services will have to be classified using the Nice classification system.
5. Government fees will now be based on the number of classes (application fee of \$330 plus \$100 for each additional class, renewal fee of \$400 plus \$125 for each additional class.)
6. The registration period has been reduced from 15 years to 10 years.
7. Canada has acceded to the Madrid Protocol so international applications can be extended to Canada and Canadians can use the Madrid Protocol for foreign filings.
8. The definition of a trademark has changed (it is now a "sign or combination of signs that is used by a person for the purpose of distinguishing" their goods and services from others). So it includes a variety of non-traditional trademarks including scents, tastes, textures, a colour per se, as well as the non-traditional marks permitted before such as moving images, sounds, holograms, colour applied to a 3D object, a 3D object (we will no longer use the term "distinguishing guise" but they are included in this category of marks). The mark must not be functional (i.e. one cannot register a scent mark for perfume).

9. Every mark will be examined for distinctiveness as of the filing date. If the examiner's preliminary view is that the trademark is not inherently distinctive, then the applicant will be asked to submit evidence that it has acquired distinctiveness throughout Canada (or argue that it is inherently distinctive). Any mark not advertised at the CIF could be subject to review on this basis.
10. A third party can submit a letter to CIPO claiming that a pending application is confusing with a registered mark or a prior pending application, or that the application refers to a registered trademark in its statement of goods and services. No arguments or evidence will be allowed. This will be noted on the mark's "action history" but otherwise there will be no acknowledgement from CIPO. This correspondence can be filed at any time but it is best to do it before advertisement for maximum effect.
11. There will no longer be the concept of "associated marks", which referred to marks which were so similar to each other that the Registrar of Trademarks could not recognize split ownership. Any change to ownership of any of these marks had to be made to all the associated marks. As of June 17 these marks may be assigned individually, but care should be taken not to divide ownership of confusingly similar marks as this may render them non-distinctive for failing to indicate a single source.
12. When recording an assignment of a trademark no documentary proof will be required if the assignment is being filed by the existing owner (assignor), but will be required if being filed by the new owner (assignee).

by Sharon E. Groom and Peter Giddens

[1] The ability to enforce a mark that is less than three years old only after demonstrating use is referred to in Bill C-86 which received royal assent in December 2018 but which still does not have a date for coming into force.[ps2id id='1' target='']

A Cautionary Note

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

© McMillan LLP 2019