

# Newsletter



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Avocats • Lawyers

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## What you should consider doing before Canada's new Trademarks Act comes into force

*While Canada's new Trademarks Act was adopted in 2014, it is still not yet in force. Before it can be implemented, two goals must be achieved. First, new regulations under the Act must be finalized by the government and the Trademarks Office. Second the information technology (IT) system at the Trademarks Office must be updated to accommodate the modifications to the law.*

The first goal should be met before the end of the year, in light of the release on February 10, 2018 of the final draft of the new *Trademark Regulations*. Although there exists a 30-day consultation period, it is most unlikely that the Trademarks Office will consider any major modifications to the draft Regulations except where there are errors or omissions. The Trademarks Office is predicting that the new Regulations will be published in their final form in October of this year.

If the publication of the new regulations proceeds as planned and the upgrade of the IT system is completed on schedule, it is anticipated the new *Trademarks Act* will be in force by early 2019.

Some of the major modifications to Canada's *Trademarks Act* and the impact thereof are outlined below:

- Trademark applications will be simplified in that it will no longer be necessary to identify a date of first use. Details of use and registrations in foreign jurisdictions will likewise no longer be required.

While these modifications should result in a quicker and less expensive process, it opens the door to squatters and trolls. It can therefore be expected that oppositions and non-use cancellations will significantly increase.

- The definition of a trademark will be greatly enlarged to include any "sign or combination of signs" that serve the purpose of identifying the source of the goods and services. By way of examples a three-dimensional shape, a hologram, a



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mode of packaging goods, a sound, a scent and a taste will now be protectable.

- The Nice Classification of goods and services will be adopted. You will no longer be able to file an application without classifying your goods and services into given categories.
- Instead of a flat filing fee of CAN\$250, fees per class will be implemented as is the case worldwide. There will be CAN\$330 fee for the first class plus CAN\$100 for each additional class.

To avoid these significant fee increases, multiclass applications should be filed promptly.

- It will become possible to divide pending applications which will allow for immediate protection for these goods and services which have already been sold and provided.
- A declaration of use will no longer have to be produced.

- The government registration fee of CAN\$200 will be dispensed with.
- The term of registration will be reduced to 10 years.
- The renewal fee will be CAN\$400 for a first class plus CAN\$125 for each additional class.

This will replace the current fee of CAN\$350 regardless of the number of classes.

To avoid these increases, registrants should renew their registrations before the end of the calendar year. By so doing the term of renewal will be 15 years instead of 10.

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