

Newsletter



Robinson Sheppard Shapiro
Avocats • Lawyers

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What you must know about intellectual property law as we start 2019

Intellectual property rights such as trade-marks, patents, industrial design registrations are often the most important assets which a company owns. As such, it would be prudent for owners to take advantage of the following recent legislative amendments to protect these assets.

Trade-marks Act

After years of uncertainty, it has recently been announced that the implementation of Canada's new trademark law will come into force on June 17, 2019. Some of the more significant changes are outlined below:

- The drafting of trademark applications will be simplified as it will no longer be necessary to identify a date of first use. Likewise, details of use and registration of the mark abroad will also no longer be required.
 - It will no longer be necessary to file a declaration of use in order for a certificate of registration to issue. This will apply to all new applications as well as all pending applications.
 - The definition of a trademark has been expanded to cover anything that functions as an indication of source. Accordingly, protection will be available for a colour, a sound, a taste, a scent, a three-dimensional shape, a mode of packaging goods, a hologram and a moving image.
- The term of registration will be shortened from 15 years to 10 years for new registrations. The 15-year terms for existing registrations will not be altered.
 - The registration fee of \$200 will be eliminated for new applications.
 - It will become possible to divide trademark applications to accelerate the registration process, especially where there is opposition to specific goods and services.
 - Since Canada will become a member of the Madrid Protocol, applicants will be able to file trademarks in multiple countries (members of the Madrid Protocol) by way of a single Canadian application.
 - All goods and services will have to be classified on the basis of the Nice Agreement



Richard Uditsky
514 393-4006
ruditsky@rsslex.com

A lawyer and a trademark agent, Richard has over 35 years' experience with all areas of intellectual property. His practice includes both transactions and litigation.

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classification system which exists in most countries of the world.

- Filing fees and renewal fees will be calculated based upon the number of classes that the trademark is associated with.

As such:

- The filing fee of a trademark will be \$330 for the first class plus \$125 for each additional class, instead of the current fee of \$250 regardless of the number of classes.
- The renewal fee will be \$400 for the first class plus \$125 for each additional class, instead of the current fee of \$350 regardless of the number of classes.

Recommendations to be considered before implementation of the new Trademark Law

- Since it will become more expensive to apply to register trademarks in more than one class, owners should consider filing multi-class applications before the new Act becomes in force.
- As it will become more expensive to renew registrations, regardless of the number of classes, in order to reduce fees, trademark owners should consider renewing their registrations prior to June 17, 2019.
- Since it will no longer be necessary to file declarations of use prior to obtaining Canadian trademark registrations, it might be expedient at this time for owners to add goods and services to their existing registrations to enlarge the scope of their monopoly.

Patent Act

The *Budget Implementation Act, 2018, No. 2*, SC 2018, c. 27, received Royal Assent on December 13, 2018. Effective that date, the following changes have been made to the *Patent Act*:

- The prosecution history of a Canadian patent application (written communications between the applicant and the Patent Office) can be admitted as evidence

to rebut a representation made by a patentee regarding to claim construction.

- There has now been codified into the *Patent Act* that any act carried out for the purpose of experimentation relating to the subject matter of a patent shall not be considered an infringement of the patent.
- The scope of prior use rights has been expanded such that if, before the priority date, a person, in good faith, committed an act that would otherwise constitute an infringement of the patent, it will no longer be an infringement of the patent if such person commits the same act on or after the priority date.

Industrial Design Act

On November 5, 2018 the *Industrial Design Act* and Industrial Design Regulations were amended to include:

- The term of protection is either:
 - 10 years from the date of registration; or,
 - 15 years from the filing date, whichever is the later, and in each case is subject to a single renewal fee.

Previously, the term of protection was limited to 10 years from the date of registration.

- The rules relating to the content of applications have been substantially eased. A description of the design or statement of limitation is now optional. Without a statement of limitation, the application is deemed to relate to all of the features of shape, configuration, pattern and ornament shown in the representation of the design, unless an exclusion has been indicated, such as the use of dotted lines in the drawings to exclude features from the claimed design.
- Canada can now be designated in international applications filed under the Hague System for the International Registration of Industrial Designs.



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Copyright Act

Should the *United States-Mexico-Canada Agreement* (“USMCA”) be ratified by all three countries, the term of copyright protection will be increased from the life of the author plus 50 years to the life of author plus 70 years.

For more information on intellectual property, please contact the author.



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