

# Newsletter



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## It has finally arrived! The modifications to the *Trade-marks Act* come into force on June 17

*Outlined below are some of the more significant changes which trademark owners need to know going forward.*

### **Definition of a Trademark — Expanded**

The revised *Trade-marks Act* permits the filing of applications to cover anything that functions as an indication of source. Protection will be available to a whole range of non-traditional trademarks such as a taste, a scent, a texture, a mode of packaging goods, a three-dimensional shape or a hologram.

### **Content of Trademark Applications — Simplified**

Applications filed after June 17<sup>th</sup> need not indicate whether the applicant has already used the trademark, proposes to use the trademark or whether it is relying on use and registration abroad.

### **Nice Classification — Obligatory**

All goods and services claimed in an application will have to be classified on the

basis of the categories set out in the Nice Classification of Goods and Services.

This will equally apply to all pending applications not yet advertised in the *Trade-marks Journal* as of June 17<sup>th</sup>.

This change will bring Canada more in line with international practice.

### **Filing Fees Increased**

As of June 17<sup>th</sup>, an application will have an initial filing fee of \$330 for the first class of goods and services, with a further charge of \$100 for each additional class of goods or services.

Owners will have to be more precise on the scope of the goods and services it wants to protect, as the ultimate filing fee will be based on the number of classes which appear in the application, as of its filing date, regardless whether the applicant later decides to delete some classes.



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## **Declarations of Use — Elimination**

After June 17<sup>th</sup> there will no longer be the need to file a declaration of use. This will apply not only to applications filed after this date, but also to all applications pending as of this date. As such, if no statement of opposition is filed against an application after its publication in the *Trade-marks Journal*, a certificate of registration will issue for all the goods and services applied for.

## **Registration and Renewal Terms — Shortened**

All registrations which issue on or after June 17<sup>th</sup> will have a term of 10 years (as compared to 15 years under the old Act).

For any registrations whose expiry date falls after June 17<sup>th</sup>, the renewal term of 10 years will also apply.

When renewing registrations after June 17<sup>th</sup>, the registrant shall be required to classify the goods and services found in its registration. The failure to do so within the prescribed delay could lead to the cancellation of the registration.

## **Registration Fees — Eliminated**

The current registration fee of \$200 will no longer be applicable for any application filed after June 17<sup>th</sup>. It will apply to all applications pending as of June 17<sup>th</sup>.

## **Renewal Fees — Increased**

The renewal fee will increase from \$350, regardless of the number of classes, to \$400 for the first class of goods and services and an additional sum of \$125 for each additional class of goods and services.

## **Divisional Applications**

After June 17<sup>th</sup>, it will be possible to divide an existing application. This will enable an applicant to overcome objections

raised during prosecution or, in the case of opposition proceedings, by allowing certain categories of goods and services to proceed to registration and thereafter to concentrate on the remaining issues.

## **Madrid Applications Available**

Canadian applicants will have the option to file applications in more than 80 countries around the world by way of a single international application.

## **Section 45 (Non-use Cancellation) Proceedings**

Currently, it is only possible to request the issuance of a notice inquiring as to the use of a mark against a registration in its entirety, even if the requesting party seeks to challenge only a specific class of goods or services.

As of June 17<sup>th</sup>, it will be possible to request that a Section 45 Notice be issued against only certain classes of goods and services specified in the registration. This change should result in more efficient and quicker resolution of such proceedings.

## **Statement of Opposition — Enlarged**

After June 17<sup>th</sup>, new opposition grounds will apply including bad faith filing, which appears aimed at curtailing trademark squatting resulting from no "use" requirement.

## **Getting Ready for the Change**

Trademark owners should plan for the steps they will take after June 17<sup>th</sup> to manage their trademark portfolios.

If you have any questions about these revisions, please contact the author.

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