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Future changes to Canada's Trade-Marks Act

October 8, 2014

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Significant modifications to the Canadian trade-mark system are expected in the near future. According to the Canadian Intellectual Property Office ("CIPO"), the amendments should come into force at the end of 2015 or early 2016.

Said changes arise from the negotiation of a free trade agreement between Canada and Europe (Comprehensive Economic and Trade Agreement) during which Canada agreed to adopt three international treaties (Madrid Protocol, Nice Agreement and Singapore Treaty). As a result, the registration process will be simplified and the Canadian system will, to a certain extent, be harmonized with the European system and many other foreign countries.

The most significant changes are:

abolition of the filing basis: the only filing requirement will be an intent to use the mark in Canada;

abolition of the declaration of use: no declaration of use will have to be filed to obtain a registration;

Nice classification: goods and services will have to be classified according to the Nice classification. It remains to be seen whether CIPO will require only one fee per application (as the current situation) or require a fee per class or group of classes. Another outstanding issue is whether CIPO will remain as demanding in terms of details for the description of goods and services;

term: registration will be valid for 10 years instead of 15 years;

divisional application: under the new law, it will be possible to divide the application into divisional applications;

international application: Canada will be part of the Madrid system, thus allowing Canadians to extend their rights in the member states via an international application and allowing foreigners to file directly in Canada.

Despite the abolition of the filing basis and the requirement to file a declaration of use, it will still be possible to file an opposition or challenge third parties' rights on the basis of prior use in Canada. Indeed, Canada will remain a country where rights arise from use.

Before implementing these provisions which have been sanctioned in Bill C-31 last June, new trade-mark regulations must be adopted. In this respect, CIPO is now conducting pre-consultations concerning amendments to the current regulations until November 30th, 2014. CIPO will also have

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to update its IT systems before the coming into force of the new provisions.

In light of these changes, it is expected that the number of filings will increase in Canada since (1) mere intention to use the mark will be sufficient to obtain a registration and (2) the international filing system will allow foreigners to file directly in Canada.

As a consequence, it is more than ever recommended to be proactive and to file applications to protect trade-mark rights in order to avoid opposition proceedings and litigation.

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