

CLIENT ALERT

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TRADEMARK

WE ARE THE WORLD!¹ BIG CHANGES TO CANADIAN TRADEMARK LAW COMING IN 2019 (What You Need to Know)

by Paul E. Bain

Earlier this year, the federal government released the latest revisions to the *Trademarks Act* (the “**Act**”) and *Regulations* – a key step towards implementing the most significant changes to the Canadian trademarks regime in half a century. After many false starts, it was announced that Bill C-31 (to amend the Act as part of a 2014 “Economic Action Plan”), comes into force on **June 17, 2019**.

Intro (Why is this Happening?)

These sweeping changes will have a significant impact on the way brands are protected and policed in Canada. The amendments to the Act “modernize” Canada’s current trademark framework and bring Canadian practice in line with international standards. Canada will finally comply with international treaties from exotic places like the South of France, Madrid and Singapore.

The Most Important Changes are:

Use Me (not)

Trademark applications will no longer require a date of first use or a declaration of use (at the end of the process). Applications based on intent or proposed use will be no longer. Being first to file will become very important.

Make it Classy

All trademark Applications will be required to abide by the Nice Classification system in accordance with the *Nice Agreement*. Under the amended Act, trademark applications must group each good or service into one of the 45 classes of the Nice Classification system, which was updated this year: <https://www.wipo.int/classifications/nice/en/>

Money, Money, Money

While Nice may be nice, the result of the classification system will be an increase in filing fees (at present applicants can include an unlimited number of goods and services for the same fee). The fee in a single class will remain \$330.00, but will be \$100.00 for each additional class.

Mad-Dash

Most importantly, for punctuation aficionados (!), ‘Trade-mark’ will be spelled ‘trademark’ and ‘trade-name’ will be spelled ‘tradename’.

Along with the dash, the “distinguishing guise”, “Associated” marks (which allows TMs to be grouped into families) and the Allowance stage (prior to registration) will be history. Unopposed Applications will proceed directly to registration.

No Time

The initial registration period will be reduced from 15 years to 10 years; the same reduction applies to renewals.

Conclusion (What you should do)

The changes are a ‘good news/ bad news’ scenario: the application process will be streamlined and simplified, but some of the changes will make it easier for squatters, pirates and trolls (and no one likes squatters, pirates and trolls) to block legitimate rights.

- File trademark applications as soon as possible to avoid increased costs and reduced renewal terms and expand list of goods and services as a defensive measure to pre-empt squatters;
- Broaden your trademark portfolio now to avoid registration delay for marks not yet used in Canada; and
- Speak with trademark professionals at Dickinson Wright LLP about the Madrid Protocol, Nice Classification and potential broader strategies for international brand protection.

¹Gratuitous song references embedded in this alert.

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