



## Significant changes to Canada's trademark laws now in effect

### Intellectual Property and Technology Alert

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The most significant amendments to the Federal Canadian trademark statute finally came into effect June 17, 2019. Some of the changes align Canada's trademark laws with that of other jurisdictions and allow, for the first time, the inclusion of Canadian trademark rights in international applications. The following is a summary of the key changes:

- **Madrid Protocol:** Canada has now implemented the Madrid Protocol, allowing foreign applicants to extend their international applications into Canada such that a single international application can be used to file in more than 80 countries around the world. This change also allows Canadian applicants to similarly extend their applications internationally starting June 17, 2019.
- **Nice:** Canada has now implemented the Nice Agreement, requiring applicants to group their goods and services into international classes and pay additional government fees for each of those classes listed in an application. This brings Canada into line with the classification practice in many jurisdictions globally. Previously, a single fee was charged per application, without regard to the breadth of the application.
- **Registration Term:** The length of a trademark registration in Canada is now 10 years, reduced from 15 years.
- **New Types of Marks:** Trademarks beyond words and designs, such as holograms, scents, sounds, tastes, textures,

moving images and colour *per se*, are now expressly defined in the statute as registrable in Canada.

- **Use:** Use of a trademark in Canada is no longer required for an applicant to register a mark in Canada. Previously, an intention to use could support an application but actual use (or registration and use abroad) was required before a trademark could actually be registered. This change is expected to significantly increase the number of conflicting marks on the Canadian register. It will also increase the number of objections, oppositions and disputes in Canada, and may make trademark clearance more difficult and expensive. Accordingly, it will become more important for brand owners to use trademark watching services to monitor the register for conflicting applications. Trademark “squatting” may become more of an issue in Canada.
- **Opposition:** There are now new grounds of opposition, some of which are aimed at slightly softening the impact of the changes to the “use” requirements. In particular, an opponent will now be able to oppose an application based on bad faith filing, or on the basis that the applicant wasn’t using the mark and didn’t intend to use the mark in Canada.
- **Distinctiveness:** Examiners will now be able to object to an application on the basis of a lack of distinctiveness, and can require that applicants submit evidence of a mark’s distinctiveness. This is most likely to happen for non-traditional types of marks, such as sound, scent, and taste trademarks.
- **Divisional Applications:** Applicants can now “divide” their applications after filing. This is particularly useful if an examiner raises objections to some but not all of the goods and services in the application. The applicant may choose to create a second “divisional” application for those goods and services (and in doing so remove them from the original application). The divisional application will retain the same filing date as the original application.
- **Priority:** Eligible applicants will be able to claim priority based on a prior application for the same mark in association with the same goods and services in other eligible countries, even if the applicant doesn’t have a real and effective commercial establishment in those countries.
- **Assignments and Mergers:** Recordal of assignments and mergers may now be filed by the existing owner of a mark and will no longer require documentary proof, unless requested by the Canadian Trademarks Office.
- **Notifying office of third-party Rights:** Third parties can now notify the Trademarks Office (CIPO) of information that may impact the registrability of a pending application, such as confusion with a registered trademark or a prior filed application.

The most important and immediate action that brand owners and users should take is to police their rights and set up trademark watching services to monitor the register for conflicting applications. Please note that the Canadian Trademarks Database was last updated on June 11 and will not be updated again until after June 26. As such, the search results are not current, and caution should be used when reviewing the database search results during this time period.

For further information on the upcoming changes to trademark laws please contact a member of our Canadian trademark team.

This article provides only general information about legal issues and developments, and is not intended to provide specific legal advice. Please see our [disclaimer](#) for more details.

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