

Canada's proposed Trademark Regulations

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On June 19, 2017, the Canadian Intellectual Property Office (CIPO) released its draft Regulations under Canada's new Trademarks Act.

Regulations are the rules used to carry out the intent of the Act and are approved by the Federal Cabinet. Typically, regulations contain more specific rules than Acts.

The draft Regulations are open to public comment until July 21, 2017. This is the next step leading up to the enactment of the amended *Trademarks Act*, which is expected to occur in 2019.

The proposed amendments to the *Regulations* are intended to facilitate Canada's adherence to three international trademark treaties, namely the Singapore Treaty, the Nice Agreement, and the Madrid Protocol. The amendments also clarify procedures regarding the prosecution of trademark applications, oppositions and summary expungement proceedings (Section 45 notices.)

The proposed amendments will implement a number of key changes in Canadian trademark practice. These changes will also impact foreign applicants and include the following:

- Adherence to the Madrid Protocol: Canadians will be able to secure international registration of a mark through the Madrid Protocol. In turn, foreign applicants will be able to include Canada in their international applications.
- Trademark applications in Canada:
 - A fee per class (CAD \$330 for the first class and CAD \$100 for each additional class). This represents an increase in official fees for an application which covers more than 3 classes but a reduction for an application covering 1 to 2 classes.
 - Applications will not have to include dates of first use and the proposed Regulations eliminate the reliance on a foreign registration as a registration basis.
 - New applications will need to comply with the Nice classification system.
 - It will now be possible to correct the name of an applicant in a trademark application.
 - It will be possible to file an application in the name of more than one person.

- It is to be noted that the “specificity” requirement was removed from the Trademark Act. A provision is included in the proposed Regulations that will necessitate that the statement for the goods and services clearly describe each of the listed goods and services in a manner “that identifies a specific good or service”.
 - The requirement to provide a “drawing” will be replaced with the broader concept of “representation” and/or “description”.
 - The requirements for the representation of trademarks and especially non-traditional trademarks are modernized.
 - Declarations of use and registration fees will be eliminated.
- Divisional applications: the proposed Regulations introduce the ability to divide the goods and services in an application into two or more applications and merge them later.
 - Letter of protest: an interested party may correspond with the Office to question the registrability of a third party application at any time before publication.
 - Renewals: the prescribed period to pay the renewal fee begins 6 months before the registration expires, and ends either 6 months after the day on which the registration expires or two months after the date of a notice to renew the trademark is sent by the Registrar. The new term of registration will be ten (10) years for trademarks registered after the coming into force of the new Act. The renewal fee will be CAD \$400 for the first class and CAD \$125 for each additional class.
 - Oppositions:
 - The sequential filing of Written Arguments will be permitted.
 - Evidence may be provided to the Registrar in electronic form or by electronic means. It will be possible for parties to file copies of affidavits or statutory declarations rather than originals provided that the original document be retained for one year following the deadline to appeal.
 - The responsibility in the cross-examination of an affiant is split between the parties so that the party conducting the cross-examination will be responsible for the service and filing of the transcript and the party whose affiant has been cross-examined will be responsible for the service and filing of the responses to undertaking.

The consultation period provides a rare opportunity to individuals, trademark professionals and organizations to give feedback or raise concerns.

For more information, please contact:



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