

Trademark Updates for Canada

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CANADIAN INTELLECTUAL PROPERTY OFFICE FEE INCREASE

As of January 1st, 2021, the Canadian Intellectual Property Office (CIPO) will increase certain fees related to trademarks and other intellectual property rights by 2%. For example, the fees for filing a trademark application will increase from \$330.00 to \$336.60 for the first class and from \$100 to \$102 per additional class.

This is not a significant increase that could affect the decision of whether or not to file an application, such as the United States Patent and Trademark Office increasing the regular electronic filing fee from US\$275 to US\$350. CIPO's decision to adjust some official fees each year for inflation is entirely new. In fact, the official fee for filing an application for registration has been \$250 regardless of the number of classes for more than a decade, before it was increased in 2019 with the reform of the law and Canada's accession to the Madrid Protocol.

CANADA'S ACCESSION TO THE MADRID PROTOCOL

Canada is very unique in its implementation of the Madrid Protocol. Here are some of the important elements to know.

Only a Canadian trademark agent can represent the applicant in Canada. In the absence of an appointed Canadian trademark agent, certain notices from the Canadian Intellectual Property Office will not be sent to the representative designated on the international application but rather only to the applicant.

Those include among others, any second and further office actions issued by CIPO and notifications of certain deadlines. The certificate of registration will also be mailed directly to the client. As a foreign agent, you will not be notified of these important steps. Please note that, except for the 1st office action, WIPO will not be notified by CIPO as to the confirmation of a total refusal or the declaration as to the protection being granted. Your client and your firm are therefore subject to important risks of being informed too late to act and faced with abandonment of the application.

Please note that no POA is required for the appointment. And, although it is possible to appoint a Canadian trademark agent after receiving the courtesy letter issued by CIPO or the 1st provisional refusal, it would be wise to designate Canadian agents when filing under Madrid because of possible important processing delays for the recordal of such appointments by CIPO.

A NEW CANADA-UNITED STATES- MEXICO AGREEMENT

On July 1, 2020, the new Canada-United States-Mexico Agreement (CUSMA) entered into force. A free trade region has existed between these countries since 1994 which at that time replaced the one in place between Canada and the US in force since 1989. This new agreement should reinforce the Canada economy. These three countries are also members of the Madrid protocol. Products sold in the United States and in Mexico have a good chance of making their way to Canada. Consequently, applicants doing business in United States or Mexico must consider filing a trademark application in Canada through the Madrid protocol or directly.

BACKLOG AT THE CANADIAN TRADEMARKS OFFICE

The popularity of the Madrid system, significant amendments to the Canadian trademark legislation and the COVID-19 pandemic have an important impact on the examination process. CIPO must examine Madrid applications within 18 months according Article 5(2)(b) of the Protocol. For national applications however, the 2020-2021 target for examination is 22 months. Currently, it is usually taking more than 24 months to receive the first office action or the notice of approval. CIPO hired several new examiners last year, so we hope that this unusual delay will be reduced in the near future.

For more information, please contact:



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A Montreal Lawyer and Trademark Agent, Caroline has been working in the field of intellectual property for almost twenty years. She is a registered Canadian trademarks agent and has a network of correspondents around the world to support her in her efforts. Her very diverse clientele has allowed her to gain experience in various industries giving her the capacity to provide you with relevant advice concerning your intellectual property portfolios.

Caroline also focuses her practice on administrative trademark litigation. She represents her clients in opposition processes and expungements. In the context of these disputes, she is often called upon to negotiate agreements.