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## Big Changes Coming to Canadian Trade-mark Law

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Canada's new *Trade-marks Act* and *Regulations* are expected to be proclaimed into force towards end of 2015 or early 2016. Some of the more significant changes are set out below.

- **INTERNATIONAL TRADE-MARK APPLICATIONS** - It will be possible to file international trade-mark applications based on Canadian trade-mark applications and to designate multiple countries from the base international application. This simplifies the process for Canadian trade-mark owners wanting to register their marks in multiple jurisdictions. It will also be possible for foreign applicants to designate Canada on their International trade-mark applications.
- **NO REQUIREMENT FOR USE BEFORE REGISTRATION** - There will be no requirement to claim use in Canada in order for applications to proceed to registration. Registrations will issue automatically once the opposition period expires.
- **GOODS AND SERVICES WILL HAVE TO BE CLASSIFIED** – Under the new system, all goods and services will have to be grouped according to the Nice Classification.
- **REGISTRATIONS WILL HAVE TO BE RENEWED EVERY TEN YEARS** – Registrations will have to be renewed every ten years instead of the current fifteen. Renewal is effected by simply paying the renewal fee (i.e.: no use requirement).
- **PRIORITY CLAIMS NO LONGER RESTRICTED TO APPLICATIONS IN APPLICANT'S HOME COUNTRY** – Priority claims can be based on applications filed in any Paris Convention country.
- **DIVISIONAL APPLICATIONS** - Applicants will be able to divide applications.
- **DISTINCTIVENESS WILL BE ASSESSED IN EXAMINATION** - Currently, lack of distinctiveness, *per se*, can only be brought up in the context of opposition proceedings. Under the new system, Examiners will be able to refuse applications for a general lack of distinctiveness.
- **REGISTRAR WILL HAVE ENHANCED POWER TO CORRECT ERRORS** – The Registrar will be able to withdraw applications from advertisement and correct errors in registrations, if advised within six months of registration. The Registrar



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will also be able to withdraw registration if a timely filed extension of time to oppose was overlooked.

- ASSIGNMENTS - There will be no requirement to submit copies of assignment documents in order to have assignments recorded with the Trade-marks Office.
- REGISTRATIONS CAN BE CANCELED ON THE BASIS THAT THEY ARE LIKELY TO UNREASONABLY LIMIT THE DEVELOPMENT OF ANY ART OR INDUSTRY - if a court decides that a registration is likely to unreasonably limit the development of any art or industry, the registration will be cancelled.
- ASSOCIATED MARKS – Currently amendments to the Register in relation to associated marks (confusing marks owned by a single entity) are prohibited unless the same amendment is made to each of the trademarks in the group. The new legislation removes this restriction.
- NON-TRADITIONAL TRADEMARKS - The new legislation expressly recognizes the following as possible subject matter for trade-mark registrations: personal names, a design, a letter, a numeral, a colour, a figurative element, a three-dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture and the positioning of a sign.
- UTILITARIAN FEATURES - Registration will not prevent the use of any utilitarian features embodied in the trademark.

*As part of the Intellectual Property Group at Perley-Robertson, Hill & McDougall, Jennifer's expertise dealing with both national and international trade-mark portfolios make her an asset to the firm's team. Her extensive experience includes registration, licensing, opposition, litigation, availability opinions, transfers, domain names and summary cancellation proceedings. She can be reached at (613)-566-2819 or [jmckay@perlaw.ca](mailto:jmckay@perlaw.ca).*