Cassels

Amendments to Trademarks Act Introduce Changes to Official Marks Procedure

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Subsections 9(3) and 9(4) of the *Trademarks Act* (the Act) came into force on April 1, 2025. These new provisions give brand owners a new method of challenging official marks.

Official marks, otherwise known as Section 9 marks, are a special category of rights reserved for Canadian public authorities. Pursuant to subparagraph 9(1)(n)(iii), a public authority may ask the Registrar of Trademarks (the Registrar) to give public notice of the adoption and use of any badge, crest, emblem or mark by a public authority in Canada. Unlike registered trademarks, once an official mark is advertised, it can remain on the register indefinitely and prevents brand owners from subsequently registering trademarks that consist of, or so nearly resemble as to be likely to be mistaken for, the official mark without permission from the owner of the official mark.

The new subsection 9(3) provides that, despite the public notice of adoption and use of an official mark, the protection does not apply if the public authority is not, in fact, a public authority or if it no longer exists. The term “public authority” is not defined in the Act. Case law has established a two-part test for determining whether an organization is a public authority: (1) is the entity subject to government control; and (2) does the organization’s activities benefit the public?[1] Subsection 9(4) now allows the Registrar, either on its own initiative or at the request of another party, to issue a public notice confirming that official mark protection no longer applies where the owner of the official mark is no longer a public authority or has ceased to exist.

To request public notice under subsection 9(4) of the Act, the requestor must:

1. Pay the prescribed fee of C$325;
2. Identify the relevant official mark (i.e., provide the file number and the name of the owner of the official mark); and
3. Provide the Registrar with information or evidence demonstrating that the official mark owner is not a public authority or no longer exists.

If, after reviewing the request and the relevant information from the requestor, the Registrar's initial assessment is that the owner of the official mark is not a public authority or no longer exists, the Registrar will give notice to the official mark owner requesting evidence of the owner's public authority status.

If the official mark owner does not respond to the Registrar’s notice within three months, or provides insufficient evidence of its public authority status, the Registrar will issue a public notice that official mark

protection no longer applies to that official mark. The Registrar will then send a notice to the official mark owner requesting evidence of the owner's public authority status with respect to all official marks listed by the same owner.

This long-awaited amendment provides trademark owners with a cost-effective method of challenging official marks. Prior to April 1st, trademark owners could only overcome objections based on official marks by either obtaining consent from the owner of the official mark or by seeking relief from the Federal Court.

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[1] *Ontario Assn. of Architects v. Assn. of Architectural Technologists of Ontario*, 2002 FCA 218 at para. 52.

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