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Amendments to Canada's *Trademarks Act* to Come Into Force June 2019

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Several long awaited amendments to the *Trademarks Act* will come into force on June 17, 2019, as Canada moves to accede to international treaties. With these amendments come several changes that will impact rights holders and potential rights holders. Of these numerous changes some key highlights include:

- **Nice Classification.** Applicants will now be required to classify goods and services listed in their application in accordance with the Nice Classifications, the international standard for classifying goods and services. This will be convenient for applicants filing in multiple jurisdictions, but comes with a new cost system with a fee charged per class claimed.
- **No Use.** The "use" requirement will be eliminated. Applicants will no longer be required to claim a date of first use or file a declaration of use in order to secure a registration. This change will be applied retroactively to pending applications. This amendment will not change the law regarding prior use establishing rights and entitlement. While this change may initially attract squatters/trolls, the hope appears to be that the new added costs related to classes described above and remedies available to remove trademarks for non-use that remain unchanged will subdue this practice in the long run.
- **No Filing Basis in Application.** Applicants will no longer have to specify a filing basis in their applications, such as prior use of a mark in Canada or intent to use a mark in Canada.
- **10 Year Term.** The term of a trademark registration has been reduced to 10 years. The old 15 year term will be grandfathered for marks registered prior to June 17, 2019. Renewal fees will also be increased and will also be subject to a per-class fee system.
- **Non-traditional Marks.** The *Trademarks Act* will now recognize non-traditional marks such as scents, sounds, tastes, textures, holograms, and moving images.
- **Divisional Applications.** Applicants can now "divide" their application by separating goods and services to create new applications. Applicants can do this for a variety of reasons including to overcome obstacles in the registration process. This will streamline the application process, permitting unchallenged aspects of the application to proceed to registration and providing a more efficient path for parties to secure rights.
- **Madrid Protocol.** Canada will join the Madrid Protocol, giving Canadian trademark applicants the ability to file an international application covering multiple jurisdictions through the World Intellectual Property Organization (WIPO), rather than filing separately in each foreign country. Likewise, entities from other Madrid Protocol countries will be able to file applications in Canada using the same process.

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We Can Help

The Intellectual Property Group at Cassels has considered the impact of the new amendments and has prepared several strategies and recommendations to address the issues raised by these changes. Any member of brand management team would be happy to assist you in navigating these changes and how they impact your specific situation to ensure fulsome and efficient protection of your rights in Canada and abroad.

This publication is a general summary of the law. It does not replace legal advice tailored to your specific circumstances.