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Newsletter

Intellectual Property

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Changes to Canada's Trade-marks Act come into force on June 17, 2019

On June 17, 2019, the long advertised changes to Canada's *Trade-marks Act* (the "**Act**") will come into force.

Canada recently acceded to three conventions, the *Nice Agreement*, the *Madrid Protocol* and the *Singapore Treaty*. These changes will modernize Canadian trademark legislation and bring us closer to trademark practice in numerous jurisdictions around the world.

The definition of a trademark will be expanded to include a sign, which can be a three-dimensional shape, a hologram, a sound, a scent, a colour, a taste, a texture and a moving image.

Changes to the Application Process

A major change for applicants will be the requirement to classify their applications according to the *Nice Agreement* and specify the goods and services according to class.

In addition, applicants will no longer have to declare whether the goods and services are based on use or proposed use. They will no longer be able to rely on use and registration abroad as a ground for registration. However, it will still be possible to claim convention priority.

Prior to June 17, 2019, applications may be filed for the government fee of \$250 independent of the number of classes of goods or services and do not have to be classified

according to Nice. As of June 17th, the government fees to file an application will be \$330 for the first class and \$100 for each additional class, if submitted online. There will be no fees payable at registration.

Applications that have not been examined and published for opposition before the new rules come into force may be re-examined under the new rules.

As well, for those applications that are allowed and require a declaration of use to be filed, the requirement to file the declaration of use prior to registration will be eliminated on June 17, 2019. Only the \$200 registration fee will be required to register the trademark.

Existing applications that were not classified according to Nice will have to be classified according to Nice.

Changes to the Renewal Process

The renewal system will also change. Until June 17, 2019, owners of registered trademarks in Canada will be able to renew their marks based on the current government fee of \$350 if submitted online (\$400 in any other case). The renewal period will be 15 years if the renewal date is June 16, 2019 or earlier.

If the renewal date is June 17, 2019 or later, then the renewal term will be 10 years. The government fees will be \$400 for the first class and \$125 for each additional class if submitted online.

Starting June 17th, as stated earlier, registrations will have to be classified according to Nice. CIPO has indicated that registrations that are not classified can be renewed by paying the \$400 registration fee for online submissions (or \$500 in other cases) for the first class, and it is our understanding that CIPO will invoice the balance due for the additional classes later.

Canada has indicated it will be following the WIPO classification system under Nice and therefore, there may be differences in how a good or service is classified in the U.S. and Canada.

Another important change is Canada will accede to the *Madrid Protocol* and Canadians will be able to file international applications.

In light of these changes, now is the time to review your portfolio and decide which trademarks you should be filing and renewing in advance of the upcoming June 17, 2019 deadline.

The content of this newsletter is intended to provide general commentary only and should not be relied upon as legal advice.

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