



Canadian Intellectual Property Office launches Consultation on Trademark Filing/Renewal Fees

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As promised, the Canadian Intellectual Property Office (“CIPO”) has just released information on the proposed new fees that will apply when amendments to the *Trademarks Act* are put into effect, and has set a deadline of July 5, 2016 for comments. The main impact of the proposal is to implement fees per class, in keeping with other amendments to the *Act*, and with international treaties that will also become effective when the *Act* amendments are implemented. Those require applicants and registrants to provide Nice Classification of goods and services, and the new fee proposal reflects fees per class, both at filing and renewal. Registration fees will be eliminated for applications filed after the coming-into-force date of the amendments, and other fee-based activities, such as filing certified copies of registrations, and extensions of time to file declarations of use, will also no longer apply, making filing and renewal fees the only government fees applicable for obtaining and maintaining a registration. The latest estimate for implementation of these changes is spring, 2018.

CIPO is required to publicly consult on fee changes, and the consultation document ([available here](#)) not only includes details of the proposed new fees, but also some background on the impact of the fee change.

The proposed new fees for online filing and renewal are as follows:

Filing in 1 class: \$330 (online filing)

Additional fee/class: \$100

Renewal: 1 class - \$400 (online)

Additional fee/class - \$125

(All numbers in Canadian dollars).

Additional fees will apply if filings/renewals are filed by paper vs. online.

Currently, the trademark filing fee is \$250 regardless of the number of goods/services, and the registration fee is \$200, for a total of \$450 for an application based on actual use in Canada. Extra costs could be incurred if applications are based on use and registration abroad, or if the applicant needs an extension of time to file a declaration of use. The current renewal fee is \$350, and the term is 15 years. Under the amendments, the term will shorten to 10 years, in keeping with international norms.

CIPO has concluded that these new per class fees are not expected to have a “significant impact”. They note that on average, over the last 5 years, 49% of applicants now file for goods/services that would fall into just one class, and for these, total government fees

will now be lower. However, for the rest, the costs to obtain registrations may be higher. As an observation, since the *Trademarks Act* amendments were first proposed in 2014, and applicants became aware of the likelihood of new fees per class, lists of goods and services appear to have increased, making it likely that more than 50% of all applicants now file for goods and services that fall into multiple classes.

The setting of higher renewal fees is partly to address a likely result of eliminating use as a registration requirement, namely more registrations for longer lists of goods and services that are not in use. Concerns have been expressed about the impact on trademark clearance, use and enforcement of permitting registrations with no use in Canada or abroad, and no additional use requirements during the registration term or on renewal. The potential for such “cluttering” of the Register of trademarks is acknowledged with CIPO’s suggestion that higher fees will dissuade renewal of less valuable marks, and “ensures” renewal of marks actually in use in the Canadian marketplace, thus improving the quality of the Register information. However, with no Canadian use requirements at registration or renewal, the Register will still partially reflect the rights of companies prepared to pay for registration and renewal as a sound business strategy to maximize their rights.

Canadian trademark filing and renewal fees will continue to be generally lower than comparable costs in other countries. Canadians now file applications at a lower rate than nationals of many other countries, and it is hoped that higher fees will not challenge Canadian businesses. For applicants and registrants from other countries, direct filing costs in Canada will be more in line with expectations in many other countries, supporting CIPO’s suggestion that the fee changes are not likely to have a significant impact.

One final point: current government fees for filing and registration are, as noted, \$450 combined for application and registration, regardless of the number of classes. While registration fees will continue to apply for applications filed before the coming-into-force date, it is not expected that any per class fees will be charged for applications pending at that date. So, for now, filing in multiple classes remains a great Canadian bargain.

For more information, please contact the [author](#).