

Implementation of *Trademarks Act* Amendments – Now Scheduled for 2019: What This Means For Brand Owners

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The Canadian Intellectual Property Office has confirmed that it now plans to implement the amendments to the *Trademarks Act* in early 2019. These will bring major changes to the trademark regime in Canada, including the elimination of “use” as a registration requirement, and accession to the Madrid Protocol, which will permit both Canadian and non-Canadian trademark owners to extend international registration rights through a simplified filing system.

While Nice Classification will become mandatory for new applications with implementation of the amendments, steps are underway in the Trademarks Office to have applications and registrations classified by trademark owners before implementation. The Office has, since 2015, informally classified all applications and registrations, although such class information has no legal effect. In 2016, the Office began to encourage applicants to voluntarily classify new applications, without formally examining for classification, and is now rolling out a plan to have registrants advise of class information on registrations, particularly those that are due for renewal in 2018 and 2019. Until the implementation of the amendments, classification has no impact on government fees.

Until implementation, applications relying upon “proposed use in Canada” will continue to be registered only after a declaration of use is filed. Upon implementation, that requirement will be dropped, permitting registration of any pending allowed applications immediately upon payment of the registration fee. Many applicants have postponed filing declarations of use for some goods/services, on the basis that the amendments will permit registration for all goods/services regardless of use. The Office has set benchmarks for declaration of use extensions, namely three years from allowance, or six years from filing, whichever is longest. If that deadline will now expire before the implementation of the amendments in 2019, applicants must choose whether to file a declaration of use for a limited list of goods/services, or file a new application to maintain their rights (hoping that there have been no intervening applications).

Since currently there is a single filing fee regardless of the number of goods, services or classes, and the amendments are expected to bring fees per class of goods/services, some applicants have reacted by filing applications with very long lists of goods/services now. A check of the most recent Trademark Journal (advertising marks for opposition purposes), shows many applications with goods and services lists that exceed three pages. Currently, applicants must set out filing grounds, including proposed use in Canada, use and registration abroad, and/or actual use in Canada. Applications can be successfully opposed if the applicant cannot support the filing grounds, although practically, it is very difficult to successfully show no intent to use a mark in Canada. The amendments, once implemented, provide that any applicant who has used, or intends to use its mark in Canada may file, but will impose fees per class (the amounts are still subject to confirmation). Filing now for goods/services for which there is a genuine intent to use in the future may save future class fees, and is a cost-effective strategy, but consideration should be given to the requirement for “intent to use” as a necessary element of trademark rights in Canada.

Stay tuned for more news on the amendments, including specifics of prosecution and opposition procedure that will be clarified with the release of the draft regulations.

Please direct any questions to Bereskin & Parr’s trademark team.