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Changes to Canada's Trademark Law

2019 marked a major change for trademark law in Canada which has impacted businesses seeking trademark protection. The registration processes for trademarks within Canada have recently changed in order to align with international trademark laws.

The updated trademark law is now aligned with international standards, including the Madrid protocol, Singapore Treaty, and Nice Agreement. In practice this means that Canadian trademarks are now more internationally recognized and allows an applicant to file in Canada and have trademark protection in over a hundred countries. These changes have had a wide-spreading impact on businesses seeking to file and protect their trademarks. Business owners must ensure that they are aware of the changes particularly regarding the renewal period and government fees associated with trademarks. Important changes are listed below.

Classification of goods in alignment with the Nice Agreement

- Applicants are required to classify their goods or services in alignment with the Nice Agreement. This refers to a classification system where goods are divided into 34 classes and services are divided into 11 classes of services.

Changes to the filing system:

- A significant change impacting business is the change from the "first to use" system to the "first to file" system. This means that businesses do not have to test out the subject of the trademark prior to filing the trademark application.

Eligibility of goods and services:

- Trademarks have been expanded in their definition to include elements such as scent, taste and texture. These elements will be examined to determine if they are distinct as an indicator of source.

Fees:

- Fees have increased for both new applications and renewals. The government filing fee has increased to \$330 with an additional fee of \$100 for each additional class of goods or services. The fees are higher (initial fee of \$430 and \$100 for each additional class) if applicants file a paper copy of the application.
- Renewals of trademarks will now cost a government fee of \$400 and every additional class will be charged \$125.

Terms:

- The term for trademarks has decreased from 15 years to 10 years. Thus, if a trademark holder is seeking a renewal of a trademark, they will have to file a renewal every 10 years instead of every



15 years. Trademark holders may only pay renewal fees 6 months before expiry and may not file any earlier.

Need requirement:

- Applicants are no longer required to specify the “need” element of the trademark application. This has further eliminated the requirement for the applicant to assert that they will be intending on selling, trading or using the product in a public domain. There is also no requirement to provide a date of use. This is a distinct departure from the first to use system which previously existed in Canada as the “use” element is no longer applicable to the trademark application.

Amending and editing applications

- Greater flexibility has been provided to correct errors made in applications. There is also the ability to divide applications and merge them.