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Major Changes to Canada's Trademark Laws to Come into Force in June 2019

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The Canadian government introduced in 2014 the first procedural step toward ratifying and implementing five intellectual property law treaties in order to align Canadian practice with that of most other countries in the world. The government has also introduced amendments to its existing intellectual property legislation, which have not yet come into force.

Amendments to the *Trademarks Act* and related regulations will come into force on June 17, 2019. This action will coincide with Canada's accession to the *Singapore Treaty on the Law of Trademarks* (Singapore Treaty); the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (Madrid Protocol); and the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* (Nice Agreement).

Notable changes include the following:

- An expanded definition of what may qualify as "trademarks," including a word, design, colour, 3D shape, hologram, moving image, sound, scent, taste, texture and other such signs.
- The removal of the necessity to identify the date of first use of a mark in Canada in a new application or to file a declaration of use to secure registration. This amendment will likely increase the number of applications that are filed in Canada without needing show use of the mark in Canada for a certain period of time. In the absence of other factual evidence, it will also be more difficult for applicants to evaluate competing rights of third parties.
- The use of the Nice Classification for the description and classification of goods and services included in all new trademark applications and existing registrations. This amendment will affect the filing of, and renewal fees for, all trademarks because it will impose separate fees for each class of goods and services covered in an application or registration. Filing trademark applications or renewing trademark registrations before the amendments come into force may be recommended.
- The possibility of using the Madrid Agreement to file applications in certain foreign countries, through a single application originating from Canada.
- The examination of new applications for distinctiveness (not only for descriptiveness or likelihood of confusion with other marks).
- The possibility of dividing pending applications to speed up registration of part of an application.
- The reduction of the term of protection, from 15 to 10 years, from registration. Renewing trademark registrations that are due before the amendments come into force is recommended.
- Other amendments regarding the corrections of errors, the streamlining of formalities for assignments, and other similar provisions.

In addition, the government recently tabled Bill C-86, which includes other important changes to the *Patent Act*, the *Trademarks Act* and the *Copyright Act*. For a summary of these proposed changes, not yet in force, visit changes to Intellectual Property Laws.

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