

# Canadian Trademark Update - We The North

**Kluwer Trademark Blog**

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For over five years, Canadian trademark practitioners have been preparing for Canada's new trademark law. We have been advising clients, writing articles, attending seminars, reviewing new Regulations & Practice Notices, and updating our internal systems preparing for the most significant changes in one hundred and fifty years.

After several delays, most sections of the new law finally came into force on June 17, 2019 - the same day Canada celebrated the Toronto Raptors NBA Championship. With over two million people attending the celebration parade in downtown Toronto, many law firms and businesses had to close early. No one could have predicted that both events would take place on the same day!

Both before and immediately after the effective date of the amendments, brand owners were able to take strategic steps to save costs and maximize rights. For example, since Nice Classification, and of course related fees-per-class on both filing and renewal came into force on June 17<sup>th</sup>, thousands of Canadian registrations were renewed before that date to avoid Nice Classification and class fee payments. Similarly, immediately after the in-force date, brand owners could register allowed applications without having to file a declaration of use in Canada - resulting in thousands of new registrations for marks that have not yet been used in Canada.

The new online filing systems operated by Canadian Intellectual Property Office

("CIPO") have had a few glitches – but CIPO is working diligently with practitioners to fix them as soon as possible. For example, data from amended applications still in prosecution may not be immediately accessible, and online filings for Madrid Protocol applications did not originally work. However, by now, many of the technical glitches have been addressed and we are enjoying simplified filing requirements and getting used to the new fee structure.

While the new law is in effect, and there are many changes to the Trademarks Act, Regulations and practice to learn about, what hasn't changed is CIPO's lengthy backlog of unexamined pending applications, which currently averages fourteen months. In addition, CIPO remains very particular with respect to the identification of goods and services, which continues to frustrate applicants, as there is often a lack of consistency with previous examination practices or internationally accepted terminology. Lastly, while the CIPO database looks a little different, it still doesn't have copies of examiners' reports or applicant responses. Assignments and other changes (owner names and addresses) cannot be recorded electronically and while opposition status is available online, other opposition documents, such as pleadings, evidence or arguments, are not yet available online.

Stay tuned for more updates from Canada and hopefully more NBA Championships for Canada's Raptors.