

Kluwer Trademark Blog

Coming Soon to Canada – Madrid

Janice Bereskin (Bereskin & Parr LLP) · Wednesday, March 27th, 2019

It was a long and cold winter in most of Canada – more so than usual and during that time, the Canadian IP community kept busy shoveling snow and preparing for the many amendments to Canada’s *Trademarks Act*, finally confirmed to be in force on June 17, 2019 (the “coming into force” or CIF date). Those changes will simplify filing procedures by removing filing grounds and use requirements. Simultaneously, Canada will accede to the Madrid Protocol, and foreign applicants will finally be able to designate Canada in international applications.

Deciding to extend protection to Canada using the Madrid Protocol, as opposed to national filings, will involve many of the same issues that are already analysed in making that decision for other countries. Cost and convenience factors generally drive the use of the Madrid Protocol, since applicants can avoid local agent fees for preparing and filing applications, as well as future local agent fees for renewals, assignments and other changes to the registration. The specific fee to add a designation of extension of rights to Canada has not yet been published, but in fact, Canadian government fees are already low, and will remain low, by international standards, even after the changes come into force (national filing fees will be \$330 CAD for the first class, and \$100 CAD for each additional class). Furthermore, Canadian filing formalities will be further simplified after the CIF date.

All foreign applicants should be aware of several notable features of Canadian trademark law and practice. Currently, the Canadian Intellectual Property Office (“CIPO”) examines for both inherent registrability and relative rights, as well as technical requirements, and will continue to do so after the CIF date. In fact, a new examination ground of “inherent distinctiveness” has been added. It is now tough to register many non-traditional marks in Canada, and that will continue to be the case under the new trademark law regime.

Canada (unlike the United States) has high standards for specificity of goods and services. This, combined with a new classification regime that becomes mandatory along with the ability to use the Madrid Protocol, raises the likelihood of many goods and services objections. Online filing systems for national applications have been developed to encourage the use of pre-approved descriptions and classification – it is not clear that those resources will be used by the International Bureau following the designation of Canada by foreign applicants, but the potential differences may lead to complications.

All applicants, including those thinking of using the Madrid Protocol, should expect that examination, and extension of registration rights to Canada will likely take longer than in many

other countries. CIPO's examination is anything but fast – currently many applications aren't examined until 14 months from filing. As a result, Canada has elected an 18-month term within which to notify the International Bureau of both a total refusal, and a provisional refusal based on an opposition. CIPO has hired new examiners, and it is expected that all Madrid Protocol filings will be examined by a specialist team, which will hopefully shorten current delays.

Before filing in Canada, foreign applicants should note that Canada recognizes “common law” rights, and owners of unregistered trademarks and tradenames may not only oppose applications, but can also rely on those rights to seek injunctions preventing use and advertising. In addition, the *Trademarks Act* contains specific provisions for protection of special rights without registration, for example by public authorities and universities, which can prevent registration without consent of the owner of such rights.

Before using the Madrid Protocol to extend rights to Canada, and possibly exposing an applicant to the risk of not only refusal of its application, but also an injunction preventing use, it is advisable to seek advice of local counsel, who may be able to offer risk-avoidance strategies, including searches for third party rights (registered and unregistered), amendments to the mark, or the goods and services covered in any application. Once that advice is obtained, a more informed decision on use of the Madrid Protocol will be possible.

While use is not required for registration in Canada, it is for both enforcement and maintenance of rights. Pending legislation will require “use” to enforce rights in Canada, meaning that unlike many countries, registration alone (either resulting from national filings or through the Madrid Protocol) does not provide an automatic right to sue for infringement in Canada. Also, Canadian registrations of all types are vulnerable to non-use expungement three years after the registration date (for Madrid Protocol filings that is the “Canadian registration date” and not the date of the International Registration).

The potential for cost savings with Protocol filings may be a welcome addition for many companies, but they do not replace the benefits of sound advice from local counsel. Particularly in the early days of Protocol filings in Canada, careful assessment of which marks to file, and when, is recommended.

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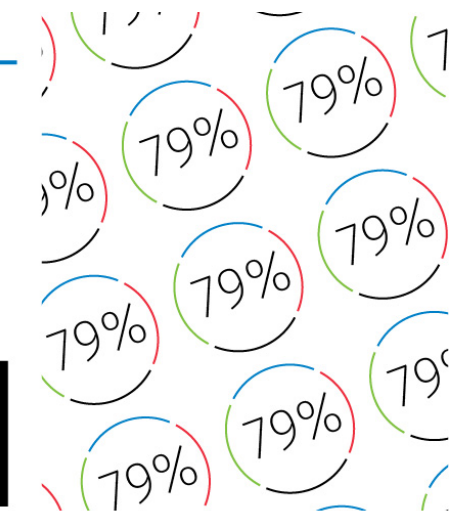
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