

Kluwer Trademark Blog

Canada – an Update from the North

Janice Bereskin (Bereskin & Parr LLP) · Monday, March 2nd, 2020

Much has changed since the new Canadian *Trademarks Act* came into effect on June 17th 2019. Although practitioners were advised well in advance of the legislative and regulatory changes, there were many surprises, some unwelcome. Below are a few noteworthy changes that applicants should be well aware of before filing in Canada.

New “Non-Distinctive” ground of examination

Canadian examiners now frequently raise this objection at the same time as descriptiveness objections. This objection not infrequently is raised against geographical names of obscure towns or villages having no connection with the origin of the goods, tag lines, numbers and letters. It’s hard to say whether the reason is due to relatively inexperienced examiners, or whether this is the result of a direction by more experienced Office staff. The *Act* contains numerous provisions dealing with the registrability of marks having questionable inherent distinctiveness, so the widespread use of this objection-often in disregard of common sense- is believed to be unnecessary, costly and plain wrong.

Madrid Protocol – Designating Canada

Seeking protection under the Madrid Protocol and designating Canada has been warmly embraced abroad as the number of Canada designated Madrid filings was over 13,000 as of the end of February, 2020, far exceeding CIPO’s expectations and contributing to the current inordinate delay for examination, as mentioned below. Using Madrid to obtain protection in Canada will convey the same rights as a regular application. Applicants should be prepared for multiple technical and substantive objections so local counsel generally will be needed.

Examination & Extensions

All pending applications which had not been advertised as of June 17, 2019 were to be re-examined under the new *Act*. This combined with the flood of new filings under Madrid (not to mention hundreds of bad faith filings prior to June 17th when there were no Nice Classification fees), CIPO’s already slow examination has worsened to 22 months. Madrid filings will likely be a little faster in order to comply with WIPO compliance requirements. In an effort to speed up the prosecution process CIPO has eliminated the “freebie” six-month extension of time for any Office Actions issued on or after January 17, 2020. Generally, CIPO now will not allow extensions in respect to merely technical objections. However, a “special circumstances extension” is available

in respect to a variety of scenarios including ongoing opposition or cancellation proceedings involving a cited mark, gathering evidence in respect to a distinctiveness/descriptiveness objection, change of trademark agent of record, etc. CIPO has also hired many new examiners. It may take some time for the new hires to speed up examination due to the necessary training involved and current backlog.

Classification & Renewals

Prior to June 17, 2019, Nice Classification amendments were accepted on a voluntary basis. However, Nice Classification is now mandatory and CIPO has sent out numerous letters to trademark owners requiring classification, failure of which will result in expungement. A number of examiners have been dedicated to classification, which has contributed to the delay of examination of new applications as discussed above.

Performing renewals online is difficult because CIPO's current IT system isn't able to both renew and classify and renewing on paper results in higher government fees (and delays). Registrants are only permitted to renew one class of goods/services online until the registration has been officially classified. Classification applications are taking at least one month (and often more). Once classification has been completed, a notice is to be sent indicating additional renewal fees to be paid. Trademark owners should carefully consider the arrangements they have with renewal services and local counsel. It may be beneficial to classify an entire portfolio at once or consider classification of registrations of interest which are due for renewal in the next few years.

What's Next?

CIPO is trying to update its systems and practices to make the registration and renewal processes smoother. Examiners are now much more responsive and available by phone to discuss objections and there are a number of new initiatives being planned to which I will discuss in my next report.

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