

Have you updated your trademark strategy since the 2019 amendments to Canada's Trademarks Act?

It's time to update your trademark strategy. Sweeping changes to Canadian trademark law came into force on June 17, 2019, that could impact your organization financially or legally. We recommend identifying registrable trademarks and to proactively review your trademark portfolio. We've put together this resource to help educate you on trademarks and provide you with actionable steps.

What changes were made? Since June 2019, Canadians (and those seeking to protect trademarks in Canada) have a new set of regulations to adhere to when it comes to trademark protection. The list of amendments to the Canadian Trademarks Act is a long one, with a number that could impact how businesses implement their trademark strategy. Of the changes, here are the ones that we want to highlight:

- Canada implemented the Madrid Protocol, which affects foreign trademark applications. The Protocol allows applicants to extend one international application to file in more than 80 member countries. As a member state, international applicants can select Canada and Canadians applicants can now similarly extend their applications using the same process.
- You will now need to renew your trademark registration every 10 years rather than the previous 15 years.
- Canada has introduced new types of marks – now eligible for trademark protection are holograms, scents, sounds, tastes and moving images.
- Applicants are no longer required to provide the date of first use at filing of a trademark application, nor do they need to submit a declaration of use before registering a trademark application (if filed based on proposed use).
- Expect your trademark registrations to cost a little more. Canada has implemented the Nice Agreement which means changes to the way trademarks are classified. With this

update, applicants are required to assign international classes to their goods and services and will be required to pay fees for each category that is selected. This brings Canada's trademark policy in alignment with most jurisdictions around the world.

Why are trademarks important?

Your brand is at the heart of your corporate image. It can be a driver of culture and serves as your identity to clients and the public. The best way to protect your brand is to register your trademarks.

What is the difference between a trademark and a trade name?

A trade name is the name under which a company does business. Registering your trade name is not the same, however, as registering a trademark. The purpose of requiring companies to register their trade names is to create a public record that allows consumers to identify who is behind a certain trade name. It does not give you the same right to exclusive use that a trademark registration does.

Which trademarks can be registered in Canada?

Trademarks can be almost anything you use to distinguish your goods and services from your competitors. They can be letters, digits, words, images, symbols, or even shapes and sounds, or combinations thereof. On June 17, 2019, the definition of a registrable trademark in Canada has expanded to include non-traditional classifications such as scents, tastes, textures, holograms, and three-dimensional and moving images (gifs).

What should you do?

Identify your trademarks. Do you have anything in your brand portfolio that falls within the newly allowed categories that are eligible for trademark protection? We recommend doing regular audits to identify new intellectual property. What makes you and your products recognizable? What are the trade names, brand names, logos, slogans, proprietary colour schemes or designs you are currently using and what is in the pipeline? Are there specific goods and services that you use these marks on?

File promptly! There is an expectation by some industry experts that by omitting the obligation to provide information on use, there will be an increase in the number of applications, thereby increasing the chances of conflicting marks or disputes. It is not unheard of for “squatters” to register for popular trademarks in anticipation of negotiations and payments. In view of these changes, being the first to file in Canada is more important than ever.

Consider filing an international application. Filing for trademark protection in foreign jurisdictions is now easier than ever! Under the Madrid Protocol, if you want to protect your trademark in other jurisdictions outside of Canada, you now have the option to file an international trademark application through the Madrid Protocol, as opposed to filing separately in different countries. This could save you money on foreign agent fees in the countries where you want to file your trademark applications.

Monitor your trademarks. If you already have trademarks within your portfolio, we recommend doing regular searches online and in national trademark databases. With the expected increase in applications, it is possible that some may include registrations for trademarks that are similar to your own. If you discover your competitor has filed a trademark application, you can send a third-party notification to CIPO to point out your earlier trademark application/registration, to ensure that CIPO will take this into account.

How can we help?

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