



International IP Rights – Tips and Tricks International Trade-mark Applications

FICPI 17th Open Forum
Venice, Italy
October 27, 2017



Canada





Change is in the air...

- New requirements for signage in the province of Quebec.
- Impending Implementation of International Treaties.
- Adoption of the Nice International Classification System.
- Adoption of a new *Trade-marks Act*.



Some things Never Change

- The frustration of Section 9 (aka Official Marks).
- Potential invalidation of proposed use claims in oppositions if actual use at the time of filing.



New Quebec Signage Requirements

- Charter of the French Language and underlying Regulations set specific rules for the use of the French language in the Province of Quebec.
- Applicable to advertising, packaging, public signage etc.
- Regulations generally require public signage displayed in Quebec French to be the “markedly predominant” language.
- Exception for “recognized trade-marks” registered only in English.
- However, new regulations in force as of November 2016 require signs with English trade-marks to also include a French language description of the business, or some other “sufficient presence in French”.
- New rules are quite specific requiring equitable sizing of the French portions of the sign, as well as lighting for the French portions of the sign if the non-French portions should be lit.



Adoption of International Treaties

- Canada has passed legislation that will enable it to accede to the Nice Agreement, Singapore Treaty and the Madrid Protocol.
- Will require adoption of the Nice Classification system.
- Expected to come into force in Spring 2019.



Things to Know About Nice

- Canada plans to move to a pay per class system.
- This will apply both during the application stage and renewal stage.
- TM owners can already add Nice classifications on a voluntary basis – highly encouraged by CIPO at this time.
- Once implemented, renewals will not be possible unless the classes have been designated.



Other Changes to Note

- Renewal periods will be shortened from 10 to 15 years.
- Renewals will only be possible in the 1 year window surrounding the renewal date.
- No more “use” requirement – TM owners will need to be more diligent in monitoring their marks.
- Option to create divisional applications.



The Unloved-Section 9/Official Marks

- Section 9 of the *Trade-marks Act* allows, *inter alia*, allows public authorities to secure essentially unlimited rights in marks.
- No restriction on associated Goods and Services.
- Minimal options for challenging the grant of the Official Mark.
- Official Marks will be cited against any application where the mark “so closely resembles as to likely be mistaken for” the Official Mark.
- Consent of Official Mark Holder will overcome the objection – but no obligation to grant consent.



Tips and Tricks

- Get your applications on file asap to secure the 15 year registration term and avoid per class filing fees.
- Consider renewing marks sooner rather than later to secure the 15 year renewal term and avoid per class renewal fees.
- Consider more rigorous watch services to catch “trade-mark trolls”.



QUESTIONS?