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

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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 “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?