

February 17, 2016

Why You Should Act Now to Protect Your Intellectual Property in Canada



By [Lisa Statt Foy](#)

Significant amendments to Canada's *Trademarks Act* (the "Act") have been passed, but are not yet in effect. The legislative changes are rumored to come into effect sometime in early 2018, which - if filed soon - may be sufficient time to allow an application to proceed to registration.

We believe there are several benefits to Canadian business owners applying now:

1) Lower Application and Registration Fees

Applications under the new regime will require goods and services to be divided into Nice classification categories. Canada currently has a one-time filing fee of \$250 and a one-time registration fee of \$200 - irrespective of the numbers of international classes. It is unknown whether "per class" fees will be introduced under the new legislation - but it seems likely.

2) Longer Registration Term

Canada currently enjoys a 15 year renewable term - but the new legislation reduces registration to a 10 year renewable term. However, if an application proceeds to registration prior to the coming into force of the new legislation, it is believed that the Registry will honour the 15 year registration period. However, only applications filed at least 12 - 18 months before the amendments come into effect have any chance of still obtaining a 15 year registration term.

3) No Uncertainty from Applications Being Caught Midstream in the Changeover

We expect that currently pending or about-to-be-filed applications, that are even one day short of being advertised when the amendments come into effect, may have to be amended, including categorizing the goods and services claims into the Nice classifications. (However, it is unclear how such amendments would take place in the event that the application is already approved for publication, but not yet advertised.)

4) Reduced Cost for Availability/Freedom to Operate Searches

The requirement to claim and demonstrate "use" of the trademark as a basis for registration, either in Canada or as part of application/registration and use in the home country, is eliminated under the new legislation. This may fill the register with frivolous registrations, for which there is no helpful use information. This would have the unfortunate effect of making availability/freedom to operate searching in Canada more expensive and less certain, as it may not be as easy to discover if a potentially-conflicting mark was or is being used, without significant marketplace investigation.

For these reasons, it is wise for business owners to file trademark applications now. Even where your trademark is not currently being used in Canada, filing a prospective (proposed) application now would secure the benefit of an earlier "placeholder" application date for a mark that you may wish to use in the future.

If you wish to further discuss whether your business would benefit from securing IP rights now, please contact us to specifically discuss if trademark registration is right for your business.

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