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SIGNIFICANT CHANGES TO THE TRADEMARKS ACT OF CANADA

Bill C-31 received Royal Assent in June, 2014 and will finally come into force June 17, 2019 which will result in substantial changes to the Trademarks Act of Canada. The following documents provide key updates on what these changes mean for you.

1. Overview of changes to the Trademarks Act of Canada
2. Canadian Government filing fees comparison
3. Canadian Government renewal fees comparison

For more information on these changes or other trademark issues, please contact any member of our Trademark team.

Bill C-31 received Royal Assent in June, 2014 and will finally come into force June 17, 2019 which will result in substantial changes to the *Trademarks Act* of Canada. Some of the noteworthy changes include:

1. The "use" requirement in Canada will be eliminated. Stating a date of first use in an application, claiming registration and use abroad, and the filing of a Declaration of Use prior to registration will no longer be required.
2. Canada will join the Singapore Treaty and Nice Agreement and adopt the Nice classification system. Goods and services still will need to be described in "ordinary commercial terms" (greater specificity compared to most other countries).
3. Canada will join the Madrid Protocol.
4. Government filing fees will now be \$330 Cdn Funds for the first class and \$100 Cdn funds for each additional class.
5. The renewal period will be reduced to 10 yrs from 15 years. The government fees will change based on the number of classes - \$400 Cdn Funds for the first class and \$125Cdn Funds for each additional class thereafter.
6. Trademark applications can be divided to separate goods and services.
7. The Registrar may require goods and services in existing trademark applications or registrations to be grouped according to the Nice classification system.
8. Section 14 Declarations showing that a mark is "not without distinctive character" will no longer be a valid claim to registration. New Section 12(3) of the Act will provide the ability to claim that a mark is *distinctive*. However, treatment of this new section is not yet known.
9. Section 45 cancellation proceedings may be restricted to certain goods or services in a registration (there still will be a three year waiting period from the date of registration before such proceedings can be initiated).
10. The term "trade-mark(s)" will be referred to as "trademark(s)", the term "wares" will be referred to as "goods" and the term "trade-name" will be referred to as "trade name".
11. Trademarks will include non-traditional marks, such as a colour or combination of colours, 3D shapes, holograms, moving images, sound, scent, taste, texture, etc. (however, *distinctiveness* will need to be shown).

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Canadian Government filing fees comparison

<u>Prior to June 2019</u> <u>Old Regime:</u>	<u>After June 17, 2019:</u>	
<u>**Not based on classes**</u>	<u>**implementation of Classification**</u>	
\$250 Cdn Government Filing Fee	\$330 Cdn \$100 Cdn	Government Filing Fee Cdn for first Class; Each additional class of goods/services;
	One class of goods/services Example: \$330.00 Cdn	
	Two Classes of goods/services Example: \$330.00 Cdn <u>\$100.00 Cdn (second class)</u> \$430.00 Cdn total	
	Three Classes of goods/services Example: \$330.00 Cdn <u>\$200.00 Cdn (2nd and 3rd class)</u> \$530.00 Cdn total	
	Four Classes of goods/services Example: \$330.00 Cdn <u>\$300.00 Cdn (2nd, 3rd and 4th class)</u> \$630.00 Cdn total	
	Five Classes of goods/services Example: \$330.00 Cdn <u>\$400.00 Cdn (2nd, 3rd, 4th and 5th class)</u> \$730.00 Cdn total	
\$200 Cdn Registration Fee	0.00	
NOTE: all applications filed prior to June 17, 2019 will be subject to paying the final government registration fee of \$200 Cdn	NOTE: Final registration fee removed - no longer applicable after June 2019	
\$450 Cdn Total Gov. Fees on all apns filed prior to June 17, 2019		

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Canadian Government Renewal fees comparison

<u>Prior to June 2019</u> <u>Old Regime:</u> <u>**Not based on classes**</u>	<u>After June 17, 2019:</u> <u>**implementation of Classification**</u>	
\$350 Cdn Government Fee with <u>no changes</u> to owner info \$400 Cdn Government Fee with <u>changes</u> to owner info	\$400 Cdn \$125 Cdn	Government renewal Fee for first Class; Each additional class of goods/services;
	One class of goods/services Example: \$400.00 Cdn Two Classes of goods/services Example: \$400.00 Cdn <u>\$125.00 Cdn (second class)</u> \$525.00 Cdn total Three Classes of goods/services Example: \$400.00 Cdn <u>\$250.00 Cdn (2nd and 3rd class)</u> \$650.00 Cdn total Four Classes of goods/services Example: \$400.00 Cdn <u>\$375.00 Cdn (2nd, 3rd and 4th class)</u> \$775.00 Cdn total Five Classes of goods/services Example: \$400.00 Cdn <u>\$500.00 Cdn (2nd, 3rd, 4th and 5th class)</u> \$900.00 Cdn total	
	<u>NOTE:</u> Services fees are billed at an hourly rate to classify goods/services for renewal purposes and will depend upon the complexity and number of classes.	

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