



ARE Trademark Law Alert: Canada Introduces Sweeping Changes in its Trademark Law

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(July 3, 2014). Canada's Economic Action Plan 2014 Act, which amends the Trade-marks Act to allow Canada to accede to various international trademark treaties, has received royal assent and passed into law as of June 19, 2014. The Act introduces sweeping changes in Canada's trademark law that will have a significant impact on brand owners. The majority of the new trademark provisions will come into force later this year.

Most importantly, the Act changes Canada's trademark use requirements. Up to now, trademarks were eligible for registration only if they were used in Canada or, for foreign applicants, registered outside of Canada. This requirement has now been eliminated, and will likely lead to a flood of new applications.

Accordingly, U.S. brand owners who have not yet used their marks in Canada or applied for registration in Canada may soon be at a tactical disadvantage, since any party may apply to register its marks once the use threshold is removed. Brand owners with marks not yet protected in Canada may therefore wish to file applications before the current regulations change.

Furthermore, brand owners will soon have to group the goods and services in their applications according to the International Classification System laid out in the Nice Agreement. Canada will also allow multi-class applications. This will likely lead to a significant increase in the cost of applying for trademarks covering multiple classes of goods or services.

Another key change shortens the period of protection offered by a registration from 15 to 10 years. Trademark registrations secured before the new regulations come into force will retain their present 15 year term. However, they, as well as existing registrations, will only be renewed for 10 year terms after the new regulations come into effect.

This ARE Trademark Alert highlights only the most important changes being made to Canada's trademark law. Given the sweeping scope of these changes, now is a good time for brand owners conducting business in Canada to review their trademark portfolio to ensure their brands are protected. Please feel free to contact us to learn more about these changes and their impact on your trademark rights in Canada.

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