

## Canadian Trademarks: A Great Time to File (Part 2)

May 27, 2019

By Ralph Kroman

In [Part 1 of this article](#), we noted that the *Trademarks Act (Canada)* will be overhauled on June 17, 2019. We highlighted that in certain situations it may be advantageous to file applications for registrations earlier rather than later.

June 17th will be upon us soon. In this article, we will describe some key benefits of the new system that will become available on June 17th that may prompt trademark owners to take action to expand and protect their rights.

### **International Registrations by Canadians under the Madrid Protocol**

Effective June 17th, the Madrid Protocol will enable individuals and companies who qualify as Canadian nationals under the Protocol, to file a single application for trademark registrations in the more than 100 countries that adhere to the Madrid Protocol. The application under the Madrid Protocol is based upon a Canadian application or registration, and is filed in one language with the World Intellectual Property Organization. One set of fees is paid to avoid having to pay fees separately for each country.

The application process is simple and quick; powers of attorney or translations are not required at the time of filing.

The Madrid Protocol provides new benefits to Canadian trademark owners who wish to extend the reach of their brand into other countries.

### **New Opportunities with Non-Traditional Trademarks**

On June 17th, registration of “non-traditional marks” will be extended to holograms, moving images (motion), scent marks, taste marks, colour, 3D shapes, mode of packaging, texture marks, and positioning of a sign. The addition of numerous non-traditional trademarks presents new opportunities for the expansion of registered trademark rights in Canada.

Other countries have recognized various types of non-traditional marks for many years, and the expansion of rights in Canada for such marks provides good food for thought for companies. For example, the following scent mark was registered in 2018 in the U.S. (which already recognizes scent marks) by Hasbro Inc. in association with toy modelling compounds (i.e. the iconic “Play-Doh” brand): “the mark is a scent of a sweet, slightly musky vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough.”

It is an apt time for a business to consider its branding efforts with a view to determining whether applications should be made for one or more non-traditional trademark registrations in Canada.

### **Divide and Conquer is a Good Thing**

Under the current system, a trademark application proceeds on an “all or nothing” basis. If any issues arise after the application is filed, the entire application is not permitted to proceed to registration until all of the issues are resolved. For example, the examiner of the application may take the position that the mark for which application has been made is confusing with an existing registered mark. It may take several rounds of submissions to the examiner to resolve all of the issues (and issues that arise at different stages may delay an application for years).

Under the new system that takes effect on June 17th, if an application hits a roadblock with respect to a portion of it, it may be divided into separate divisional applications so that the uncontentious portion may proceed as a separate application.

If divisional applications and the initial application become registrations, the registrations may be merged into a single registration.

On the whole, the new rules regarding divisional applications are an important tool to help applicants expedite applications for trademark registrations.

Based on these new benefits that will become available to trademark applicants, it is a great time for businesses and other trademark owners to consider and update their trademark and branding strategies.

***The information and comments herein are for the general information of the reader and are not intended as advice or opinion to be relied upon in relation to any particular circumstances. For particular application of the law to specific situations, the reader should seek professional advice.***

For more information or inquiries:



Ralph Kroman

Toronto

416.947.5026

Email:

[rkroman@weirfoulds.com](mailto:rkroman@weirfoulds.com)

Ralph Kroman brings broad experience and high-level expertise to his business law practice with an emphasis upon contract negotiations, intellectual property, information technology and commercial transactions.

**WeirFoulds**<sup>LLP</sup>

[www.weirfoulds.com](http://www.weirfoulds.com)

**Toronto Office**

4100 – 66 Wellington Street West  
PO Box 35, TD Bank Tower  
Toronto, ON M5K 1B7

Tel: 416.365.1110  
Fax: 416.365.1876

**Oakville Office**

1320 Cornwall Rd., Suite 201  
Oakville, ON L6J 7W5

Tel: 416.365.1110  
Fax: 905.829.2035