

Canada, the Nice Agreement and the Madrid Protocol

Canada has recently made amendments to its Trade-marks Act which will bring it into more line with the majority of the rest of the world and will enable accession to the Madrid Protocol. The Canadian government has been updating its IP regime and classification system in order to attract foreign investment, some of which may come when it becomes a fully-fledged member of the Madrid Protocol.

The current trade mark filing system in Canada requires applications to be filed with the specification grouped into 'wares' and 'services'. This is at odds with the rest of the world which uses the 45 classes of the Nice Agreement classification (34 goods classes and 11 service classes). There is also a requirement for applicants to prove that the mark has been used in Canada before a registration certificate can be issued whereas, in the UK for example, no such proof of use is required (albeit third parties can apply to cancel a mark for non-use five years after the registration date). This is all about to change.

This is a major change in practice and we expect the Canadian registry to take some time to update its practice and IT systems in order to begin to accept trade mark applications with the goods and services classified under the Nice classification, replacing the former categories of wares and services. Further proposals are to make the definition of a trademark broader (allowing for the filing of non-traditional trade marks such as 3-D marks and sound marks), to reduce the term of a registration from 15 years to 10 years and to abandon the requirement to declare use of a trade-mark before registration.

Under the new law a trade mark will be defined as "a sign or combination of signs that is used or proposed to be used by a person for the purpose of distinguishing or so as to distinguish their goods or services from those of others..." and a "sign" includes a word, a personal name, a design, a letter, a numeral, a colour, a figurative element, a three dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture and the positioning of a sign.

The Canadian registry suggests that it will take some 'months' until the new law comes into force and only after the regulations have been amended. Expect some delays to Canadian trade mark applications filed during the changeover period.

The Madrid Protocol

For an explanation about the advantages of International Registration under the Madrid Protocol see our [Winter 2014 Trade Mark update](#).

Canada looks to join the current 91 members of the Madrid Protocol. New Zealand, the Philippines, Colombia, Rwanda, Tunisia, India and Mexico all joined within the last three years. Rumours are that Brazil, Cambodia, Brunei, Indonesia, Laos, Malaysia, Myanmar and Thailand are also waiting in the wings. For a list of current Madrid members, see here: www.wipo.int/madrid/en/members/.

For further details on these matters please contact your usual Forresters Trade Mark Attorney.