

Changes Concerning Trade-Marks in Canada by Me Isabelle Jomphe

A number of modifications have been made to the Trade-mark Rules within the last few months. This summarizes those changes.

Abolition of Certain Government Fees to Update the Trade-mark Register

As a general practice, it is recommended to always keep updated the data recorded on the Trade-mark Register, and more particularly the name of the trade-mark owner and its address.

Trade-mark owners will be happy to learn that it is no longer necessary to pay a fee to record a change of name or address, a change of legal structure or a merger. The same applies for the recordal of licenses, hypothecs, liens or other securities affecting trade-marks. Only the registration of an assignment requires the payment of a \$100 fee per trade-mark.

Shorter Deadlines in Opposition Proceedings

According to the *Trade-marks Act*, one may oppose the registration of a trade-mark for different reasons. The main grounds of opposition are based on the risk of confusion with another trade-mark or its descriptive nature.

Once an opposition is filed, the parties may file evidence, conduct cross-examinations, produce written arguments and attend a hearing before the Opposition Board.

Until recently, opposition proceedings could last several years before a decision was rendered. These delays were due in part to numerous requests for extensions of time filed with the consent of the other party.

The new rules which came into effect on October 1st should result in a more expedited process.

These rules give the Opposition Board greater control over requests for an extension of time. For example, the consent of the other party will no longer be systematically considered sufficient. The party asking for an extension will need to justify its request with reasonable grounds or exceptional circumstances in order to be accepted by the Board.

A change of pace in opposition proceedings should therefore be expected. The parties will thus have to be more proactive once the Statement of Opposition is filed, especially for the preparation of evidence.

End of Disclaimers in Canada, Well Almost... !

Certain trade-marks include terms that merely describe the products or services or include terms that correspond to the names of individuals who are alive or who have died within the last thirty years. Until recently, the Registrar requested that trade-mark owners disclaim the exclusive right to use these terms so as not to grant a monopoly which would disadvantage third parties.

Generally speaking, such disclaimers will no longer be requested. While the Registrar maintains a discretion in this regard, it remains to be seen how this discretion will be exercised. That being said, the applicant can always voluntarily disclaim the exclusive right to use such terms.

This new practice will reduce the examiners' workload and accelerate the examination process for these cases. However, this change may also give rise to more debates in opposition, especially regarding the scope of protection to be granted to a trade-mark comprising descriptive terms.