

A Massive House-Cleaning: Canadian Government Tables Five New IP Treaties

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On January 28, 2014, the Government of Canada signalled its intent to transform its intellectual property regimes by [tabling](#) five intellectual property law treaties in Parliament. If implemented into domestic law, these treaties would harmonize Canada's trade-mark, patent and industrial design legislation with its major trading partners. Following a 21-sitting-day [waiting period](#), the Government will be able to introduce legislation to implement these treaties. Such legislation will transform important aspects of the trade-marks practice in Canada, and will lead to significant changes in the industrial designs field as well.

Some key points and concerns about the treaties include the following:

1. The [Madrid Protocol](#) allows trade-mark owners to file a single "international application" that can mature into a bundle of national registrations. However, filing the international application does not guarantee protection in all the listed countries, because individual member countries still have the means to refuse an application or to allow an opposition against the applied for mark. Madrid will also likely require the Canadian Trade-marks Office to accelerate certain procedures, as the standard time limit for notifying a refusal is 12 months, though it is extendable to 18 months on request by a member country. A full description of the Madrid System is provided by WIPO [here](#).
2. The [Singapore Treaty](#) is a more recent (2006) treaty that was likely the impetus for Canada expanding its definition of a trade-mark in the [Combating Counterfeit Products Act](#) to include non-traditional marks such as holograms, three-dimensional shapes, colours, position, movement, sound, scent, taste and texture marks. For practitioners, the compelling question remains how certain of these non-traditional marks will ever be prosecuted, opposed or litigated. For example, how will the Opposition Board or the Federal Court conduct a confusion analysis considering as the "confusingly similar" taste of two flavoured cigarettes or two cheeseburgers, or the "confusingly similar" scent of two lip balms? How will an examiner search the Trade-Marks Register for relevant "hits" in the course of a prosecution? How will the case law cope with functionality or proof-of-use issues in this brave new world? The Singapore Treaty also deals with certain administrative issues. Notable among them is the requirement that contracting parties provide relief measures when a party's failure to meet a time limit was unintentional or occurred in spite of due care required by the circumstances.
3. The [Nice Agreement](#) sets out a [comprehensive classification system](#) for goods and services associated with a given trade-mark. While, in theory, complying with the Nice Agreement should simplify the application process, in practice there are often complications when a given service (such as computer software or business consulting) straddles several different classes. For example, it remains to be seen whether the Trade-Marks Office will adopt the U.S. and European practice of charging higher fees on the basis of how many different classes are claimed. Canadian trade-marks owners may also find there is a learning curve in artfully adopting Nice standards to avoid office actions on the basis of overlap between classes. In the opposition and infringement fields, there will be a clear tension between the highly structured new Nice categories and case law that establishes a flexible test for confusion "whether or not the wares or services are of the same general class" (s. 6(2), [Trade-](#)

[marks Act](#)). Given the strong historical case law explaining that there are many different ways in which a “connection” might be mistakenly arrived at by an ordinary consumer, it is to be hoped that the Nice categories will not lead to an unduly technical approach to confusion. Otherwise, the flexible analysis of a case like *Mattel, Inc. v. 3894207 Canada Inc.*, [2006 SCC 22](#) at para. 30, acknowledging the “protean power” of certain brands and the product-specific fame of others, may be lost at the expense of a cut-and-dried class-based confusion analysis. Given the myriad unpredictable ways in which consumers can be actually confused in the marketplace, such a change in the law would be short-sighted.

4. Similarly to the Madrid Protocol, the Geneva Act of the [Hague Agreement](#) allows a person to receive protection for industrial designs in a number of member countries by means of a single international application. Refusals can be based on substantive requirements of domestic law, and may be withdrawn, in part or whole, at any time by the Office that communicated it.
5. The [Patent Law Treaty](#) harmonizes administrative procedures in the patent field. Like the Singapore Treaty, it requires that contracting parties provide relief measures when a party's failure to meet a time limit was unintentional or occurred in spite of due care required by the circumstances. The current Canadian time limits for remedying missed maintenance fee payments will also need to be adjusted to comply with the treaty. A [CIPO research paper](#) suggesting what changes would be required to comply with the treaty was first authored in 2002 and subsequently updated in 2012 and 2013.

Interestingly, the Government of Canada has not made much ado about this major transformation: the [tabling](#) was done by the Parliamentary Secretary to the Minister of Foreign Affairs in a very terse statement before the House of Commons, and no news release was issued by Industry Canada or the Canadian Intellectual Property Office. While the implementation will be a major effort and may prove helpful for Canada in finalizing trade negotiations with other countries, the Government has elected to fly under the radar for now, possibly until its [CETA](#) and [TPP](#) negotiations are further crystallized.

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