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NEW ADDITION REGARDING *TRADE-MARKS REGULATIONS* IN CANADA – DIVISIONAL APPLICATIONS

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On February 10, 2018, the Canadian government introduced the new version of the *Trade-Marks Regulations* (the “Regulations”) which, with the exception of some minor modifications, will come into force during 2019.

In light of the future changes that will be brought to the *Trade-marks Act* and, coincidentally, to the general practice of trade-mark practitioners, this new version of the Regulations is much denser than the previous one, the number of articles having more than doubled from 61 to 162. Among the new dispositions to be included in the Regulations are provisions related to the Madrid Protocol, the Nice Agreement as well as the Singapore Treaty, three international instruments Canada wishes to join in 2019.

Of all the changes that will take place with the coming into force of the new version of the Regulations, one of the most significant is certainly the addition of divisional applications. Indeed, it will now be possible for the owner of an application to “divide” said application into one (or more) separate applications.

It is reasonable to think that this new practice will offer advantages, in some instances strategic, most notably with regard to opposition proceedings. To that effect, under the current regime, when a third party decides to oppose a trade-mark application, it has no choice but to oppose the entire application even if the allegedly confusing goods represent only a portion of the goods or services contained in the application. With the upcoming changes being brought to the Regulations and upon becoming aware of the claims contained in a statement of opposition, the owner of an opposed application will now be able to file a divisional application in order to separate the potentially confusing goods alleged in the statement of opposition from the rest of the goods or services contained in the application. By doing so, the remaining goods and services will be able to continue the registration process without further hindrance or delay and the opposition proceeding will be limited to the goods and services contained in the divisional application.

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Under the new version of the Regulations, an applicant will be able to divide his application at any given moment prior to registration. Once an application is split, the divisional application will receive a new application number and will be processed independently of the original application. However, it is to be noted that any deadline imposed on the applicant at the time of division of the original application will also apply to the new divisional application. Lastly, in the event that a divisional application would mature to registration, the Regulations also provide that the Registrar will be able to amend the register in order to consolidate the registrations resulting from the same original application.

Of course, the attraction of this new addition to the trade-marks practice will not be limited only to opposition proceedings. For example, in the event that an application would be the subject of an examiner's report, it will be possible for an applicant to divide its application so that only the goods or services being the subject of the examiner's report be contained therein, thus allowing the remaining goods and services to proceed normally towards registration. The contribution of trade-mark professionals will therefore be all the more important given that the latter will be called upon to develop filing or opposition strategies tailored to the particular circumstances and needs of clients.

The possibility of filing divisional applications is only an overview of the upcoming changes that are set to take effect in Canada within the coming year. Indeed, several other changes, including the duration of a registration, the costs related to filing an application, the registration process as well as the very definition of a trade-mark, will disrupt the trade-mark practice in Canada.

If you have any questions regarding divisional applications or the implementation of the new version of the Regulations in general, please do not hesitate to contact one of our team members.