

History & Fundamentals of Canada Trademark Law

“As a country Canada has existed since 1867. Canadian trademark legislation was first enacted the next year in 1868 under the Trademark and Design Act 1868. With that being said, the very first trademark in Canada was granted in 1866 to The Colonial, a Cigar company. This registration was granted 2 years prior to the act and unbelievably, this is still a registered mark on the Canadian registry. Likely, the registration was granted in anticipation of the Trademark and Design Act being enacted.”

Conversational adjustments:

Hi, and welcome to Witmart’s video series exploring all things IP! To kick things off, we’ll give you a quick overview of the history and fundamentals of Canadian trademark law. So let’s get started!

Trademarking in Canada is almost as old as the country itself. As we know, Canada became a country in 1867. One year later, Canadian trademark legislation came into effect under the Trademark and Design Act of 1868.

Oddly enough, the first ever Canadian trademark was actually granted in 1866 — two years *before* the trademark act even existed. How? Most likely, the government approved the registration in anticipation of creating the Trademark and Design Act.

So who holds the first ever registered Canadian trademark? A cigar company, of all things, called The Colonial — which, unbelievably, is still registered to this day.

“Currently, trademarks in Canada are governed by the Trademarks Act, which was adopted in 1954. Naturally the Trademarks Act lays out the rules and regulation related to trademarks. Who can hold a trademark, what can be a trademark and even the application requirements for registration are set out in the Trademarks Act.”

Fast-forward to modern day Canada, where trademarks are now governed by the Trademarks Act. Adopted in 1954, the Trademarks Act is exactly what it sounds like — a legal document listing the rules and regulations of trademarking in Canada. The act includes guidelines on everything from who can hold a trademark to what types of things can be trademarked and even gets down to the nitty-gritty application requirements for registration.

According to the Trademark and Design Act of 1868 the Minister of Agriculture was responsible for the keeping of books denominated as Trademark Register and The Register of Industrial Designs. Currently that obligation has been taken up by CIPO, the Canadian Intellectual Property office which was established in 1991. The database maintained by CIPO has trademark information dating back until at least 1866 as evidenced by The Colonial Cigar company registration # ATM127.

So who regulates the trademark registration process? We thought you might ask. Historically speaking, the Trademark and Design Act of 1868 mandated that the Minister of Agriculture was responsible for keeping the books for the Trademark Register and the Register of Industrial Designs — which, yes, was a bit random.

These days, though, the process is maintained by CIPO — otherwise known as The Canadian Intellectual Property Office, established in 1991. Gotta love twentysomethings. CIPO's database has trademark information dating as far back as 1866, including "The Colonial" cigar company trademark registration #ATM127 we mentioned earlier.

"In 2014 significant amendments were proposed to change the Trademarks Act. Despite minor changes to the act and regulations over the years this will be the first major overhaul since 1954. The changes, some of which will be discussed later, are aimed at bringing Canadian trademark law into the 21st century as well as aligning the Canadian system with international best practices already employed by several countries."

Despite the historical age of our trademark system, Canada's legal landscape for intellectual property protection has definitely changed since its inception.

In 2014, for example, CIPO proposed to make significant amendments to the Trademarks Act. Marking its first major overhaul since 1954, these changes aim to modernize Canadian trademark law to bring it into the 21st century. Plus, it should align the Canadian system with international best practices too — which have been in use around the world for decades already.

Agreement on Trade-Related Aspects of Intellectual Property Rights – Signed 1994 or TRIPS

An international legal agreement, signed in 1994, between all the member nations of the World Trade Organization (WTO). It sets down minimum standards for the regulation by member nations of many forms of intellectual property (IP) as applied to citizens of other WTO member nations. Ratification of TRIPS is a compulsory requirement of World Trade Organization membership.

Speaking of which, let's take a look at some of the international treaties and agreements currently governing how we register trademarks worldwide.

First up, TRIPS, the Agreement on Trade-Related Aspects of Intellectual Property Rights, signed in 1994 by all United Nations countries of the WTO (or World Trade Organization). This agreement establishes the minimum standards for regulating intellectual property across all member nations. All countries included in the World Trade Organization must sign and adopt the requirements of agreement to maintain WTO membership.

Paris Convention – 1883

Adopted in 1883, the Paris Convention applies to industrial property in the widest sense, including patents, trademarks, industrial designs, utility models, service marks, trade names, geographical indications and the repression of unfair competition. The Paris Convention is also one of the oldest international treaties on intellectual property.

Moving on to the Paris Convention. Established in 1883, the Paris Convention applies to protecting industrial property in the widest sense of the term, including patents, trademarks, industrial designs, utility models, service marks, trade names, geographical indications and the repression of unfair competition. Fun fact: The Paris Convention is one of the world's oldest international treaties on intellectual property.

NAFTA – Signed 1993

The North American Free Trade Agreement (NAFTA), signed in 1993, was the first international trade agreement to include obligations to protect intellectual property rights. NAFTA features a three-prong approach. The first sets forth minimum standards for protection of intellectual property. The second prong requires effective enforcement of intellectual property rights at the borders of NAFTA signatory countries to ensure that intellectual property rights holders are protected from infringement by imported products. The final prong is a dispute resolution procedure which can include damages payable to intellectual property rights holders or even trade related sanctions.

Next up, NAFTA. You've probably heard this one discussed in the news a lot over the last little while because of all the political discussions between Canada and the U.S. so forgive us for talking about it even more, but it's a big one that you should know about.

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[really wish we could make a trump joke here]

Once the amendments come into effect Canada will join some other international treaties governing Trademarks. These include:

Madrid system for the international registration of marks – original 1891 – Protocol Relating to the Madrid Agreement - 1989

The Madrid System is a convenient and cost-effective solution for registering and managing trademarks worldwide. Filing a single application and paying one set of fees allows an applicant to apply for protection in up to 118 countries. The Madrid Protocol will also allow applicants and trademarks holders to modify, renew or expand their global trademark portfolio through one centralized system. It should be noted that once registered the owner does not hold a single trademark registration for the countries applied to but rather a bundle of trademark registrations.

Beyond involvement with NAFTA and the WTO, CIPO aims to join forces with even more international trademark treaties to simplify global IP processes for Canadian businesses.

With changes to Canada's Trademarks Act fast approach in June 2019, there's definitely some updates your business needs to be aware of. So we'll give you a brief overview.

One of the upcoming changes will be CIPO's joining Madrid Protocol – Madrid's system for the international registration of marks. Originally named the Protocol Relating to the Madrid Agreement of 1989, The Madrid System is a convenient and cost-effective solution for registering and managing trademarks worldwide. Filing a single application and paying one set of fees allows an applicant to apply for protection in up to 118 countries. The Madrid Protocol will also allow applicants and trademarks holders to modify, renew or expand their

global trademark portfolio through one centralized system. It should be noted that once registered, the owner does not hold one single trademark registration for each country they've applied to, but rather a bundle of trademark registrations.

The Nice Agreement - 1957

The Nice Agreement sets forth a classification system of goods and services for the registration of trademarks and service marks. It is a requirement of signatory countries to indicate, in official documents and publications in connection with each registration, the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong. The adoption of the Nice agreement greatly streamlines applications for trademarks in foreign jurisdictions of signatory countries.

Additionally, CIPO's amendment will include joining the NICE Agreement of 1957. The Nice Agreement sets forth a classification system of goods and services for the registration of trademarks and service marks. It is a requirement of signatory countries to indicate, in official documents and publications in connection with each registration, the number of classes the goods or services associated with the desired mark belong. The adoption of the Nice agreement greatly streamlines applications for trademarks in foreign jurisdictions of signatory countries.

Singapore Treaty on the Law of Trademarks –2009

Building on the Trademark Law Treaty of 1994, the Singapore Treaty on the Law of Trademarks seeks to establish a modern international framework related to the administrative trademark registration process. This too will streamline trademark applications in foreign jurisdictions that have ratified the treaty.

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All in all, CIPO's proposed amendments mean good things for businesses – both domestic and international. Whatever happens, you can trust us to keep you informed on all things trademarking!

That's all we have for today, but stay tuned for our next video exploring the upcoming changes to Canada's trademark law in more detail. Thanks for listening!