



IP Update

## Consider Canada: Why you should designate Canada - and a Canadian agent - in your next Madrid application ■

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More than a year has passed since Canada overhauled its trademark legislation and acceded to the Madrid Protocol, making it easier than ever to protect trademark rights in Canada.

In this IP Update, we explore some of the key reasons why international brand owners should consider designating Canada in international trademark applications. We also outline the importance of appointing a Canadian agent to monitor and oversee international applications designating Canada.

Smart & Biggar **does not charge** to be appointed as agent in Canada for your international trademark application. Complete this form to appoint us as the Canadian agent for your Canadian filings.

### Canada is an important market for international brand owners

Brand protection in Canada is economically critical for most trademark owners.

Canada's economy has long been at the top of the G7, and Canada is experiencing record population growth. Canada has especially strong economic ties with the United States, with the two countries enjoying the largest trading relationship in the world. Canada is the United States' largest customer and buys more goods from the United States than China, Japan, and the United Kingdom combined. Canada also continues to play a major role in international trade relations through the *Comprehensive Economic and Trade Agreement* (CETA) with the European Union, the *Trans-Pacific Partnership* (TPP) with ten other Pacific Rim countries, and most recently, the *United States-Mexico-Canada Agreement* (USMCA).

Canadian consumers are also regularly exposed to spillover advertising and are well aware of international brands, making Canada an important market for foreign brand owners looking to protect their brand in an economically important market and across North America.

Finally, brand owners seeking protection against the import and export of counterfeit goods can leverage a Canadian trademark registration, and record it with Canada's customs authorities for monitoring, for heightened cross-border protection.

### Missing correspondence and lost rights

It is important to remember that, for international applications designating Canada, CIPO will not deposit all correspondence with WIPO nor will it send correspondence to a foreign representative. Rather, CIPO will *only* send correspondence to the applicant or an appointed Canadian trademark agent.

For foreign agents or representatives, that means important communications with critical deadlines - which may be unwanted or misunderstood by clients - will only come to your attention if your client forwards them to you. To avoid undue risk and the potential loss of rights, we strongly recommend appointing a Canadian agent on all Canadian applications, to ensure that you receive all relevant correspondence (e.g. Examiner's Reports, approvals, default notices) and that all due dates are docketed.

This is particularly vital as CIPO examines all applications on both absolute and relative grounds, and commonly issues Examiner's Reports, such as in connection with goods and services objections, citation of confusing marks, and descriptiveness and/or non-distinctiveness objections.

For more information on this topic, see our previous articles "Where is my CIPO mail?" and "Yes, CIPO really will be writing to your client instead of you".

## Appoint Smart & Biggar as your Canadian Agent at no charge

Smart & Biggar does not charge to be appointed as agent in Canada for your international trademark application. This has been our practice since Canada acceded to the Madrid Protocol, and we offer this service to our clients as a courtesy to ensure the protection of rights in Canada that could be lost inadvertently without proper monitoring and guidance.

Once appointed, we will:

- Become your Canadian agent for the Canadian application;
- Enter the Canadian application into our file management system;
- Docket and report (in accordance with our fee schedule) all correspondence received from CIPO; and
- Once registered, docket the registration and forward to you all notices received from CIPO during the term of the registration, including section 45 non-use cancellation notices and renewal reminders.

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*The preceding is intended as a timely update on Canadian intellectual property and technology law. The content is informational only and does not constitute legal or professional advice. To obtain such advice, please communicate with our offices directly.*

## RELATED PEOPLE



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