

# U.S. Companies Selling Into Canada: It Will Soon be Easier to Protect Your Trademarks in Canada, Which Joins the Madrid Protocol Treaty in June, 2019



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"America borders on the magnificent: Canada." So said a very clever tourism ad campaign a few years ago about America's second largest trading partner.

But for companies looking to protect their brands in Canada, our Northern neighbor has been a bit slow to bring its trademark protection laws (while robust in their own right), procedures, and goods and services classifications in line with current international standards.

This will change on June 17, 2019, when Canada joins the Madrid Protocol ([https://www.wipo.int/treaties/en/registration/madrid\\_protocol/index.html](https://www.wipo.int/treaties/en/registration/madrid_protocol/index.html); see also [https://www.wipo.int/madrid/en/news/2018/news\\_0009.html](https://www.wipo.int/madrid/en/news/2018/news_0009.html)), an international treaty which provides a streamlined mechanism for trademark[1] owners in the U.S. and in other treaty member countries to protect their trademarks in Canada and elsewhere. (On the same date, Canada will also join the Singapore Treaty and Nice Agreement (the latter provides a uniform goods and services classification scheme) to further harmonize its trademark laws with those of other countries - see [http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04260.html?Open&wt\\_src=cipo-tm-main&wt\\_cxt=activity](http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04260.html?Open&wt_src=cipo-tm-main&wt_cxt=activity). This article will highlight the Madrid Protocol.)

The Madrid Protocol registration system (the "Madrid System") provides an online, cost-effective mechanism through which *a trademark owner can protect its trademarks in multiple countries, including the entire EU, through a single application for registration* filed with the World Intellectual Property Organization (WIPO). While filing fees are based, in part, on the number of countries in which protection is sought, this saves trademark owners significant time and the expense of having to file separate applications in each country.

When WIPO receives an application through the Madrid System, it reviews it for adequacy and forwards it to the trademark offices in the countries designated by the applicant. There is no need to hire separate foreign legal counsel unless a national trademark office objects to the application after review and resolving the issue requires specialized knowledge of that country's laws.

If your company has a pending U.S. or other Madrid Protocol member country trademark application or existing registration (having this "basic application" or "basic registration" is a prerequisite to use of the Madrid System), that will serve as the foundation for an application under the Madrid Protocol – whether in Canada beginning June 17, or in any other Madrid Protocol member country. For U.S. trademark owners, the Madrid system application can be filed through the U.S. Patent and Trademark Office, further simplifying the process.

If you are a U.S. business that sells into Canada, or hopes to (prior use of your trademark in Canada

risk. Fortunately, it will soon be much easier to address this issue. Way to gO CANADA![2]

Note: Trademark law is complex and nuanced and the procedural aspects of filing for registration and prosecuting applications through to completion can be daunting. This article is provided as free information, not as legal advice, and is not intended to be relied upon as legal advice. The assistance of an attorney experienced in this complicated area of the law is strongly recommended.

Thanks for reading. Please contact me if you'd like to learn more. Eric Freibrun, FREIBRUN LAW. 847-562-0099; [eric@freibrunlaw.com](mailto:eric@freibrunlaw.com); [www.freibrun.com](http://www.freibrun.com). Copyright © 2019 Eric Freibrun, FREIBRUN LAW. All rights reserved.

[1] Trademarks and service marks are essentially the same thing. Trademarks are used on tangible goods and products. Service marks are used for services. What's written above applies equally to both, although the words "trademark" or "mark" are sometimes used in this article for simplicity. Trademarks and service marks are intended to distinguish the owner's products or services from those of others in the marketplace and create a unique association in purchasers' minds between the goods and services sold and the unique source of those goods and services (e.g., your company). Trademark law is intended to prevent consumer confusion and unfair trade practices by affording trademark owners the exclusive right to use a particular mark with specific goods and/or services. These rights are secured by obtaining registration of the mark in a governmental trademark office.

[2] <https://www.youtube.com/watch?v=6GmM17-F9Lw>. See also, 'O Canada' Will Become Gender Neutral With New Lyrics, NY Times, Feb. 1, 2018 - <https://www.nytimes.com/2018/02/01/world/canada/o-canada-lyrics-gender-neutral.html>. Alternatively, "There is a town in North Ontario..." - <https://www.theloop.ca/tour-neil-youngs-canada-11-songs/>.



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