

FEE-FOR-SERVICE PROPOSAL - TRADEMARKS
SUBMISSION BY GOWLING WLG (CANADA) LLP

JULY 5, 2016

Gowling WLG (Canada) LLP is one of Canada's leading law firms and represents clients from around the world before the Canadian Intellectual Property Office. The trademark professionals at Gowling WLG have been closely following the amendments to the *Trade-marks Act* and the steps being taken by CIPO to implement the Madrid protocol, the Singapore Treaty and the Nice Agreement. As such, we welcome the opportunity to comment on the Fee-for-Service Proposal – Trademarks which flows from the amendments to the Act.

In general, we are supportive of the approach taken by CIPO as outlined in the proposal. Specifically:

1. Merging of the application and registration fees: we agree that it will simplify and streamline the process to merge the application and registration fees. However, it should be kept in mind that not all applications will proceed to registration – some will not proceed past examination, some will be opposed and some will be withdrawn because the applicant is no longer interested in the mark which is the subject of the application. Therefore, it is important that the combined fee not be excessive. In our view, the suggested fee of \$330 strikes the right balance when compared to the total of the current application fee (\$250) and the current registration fee (\$200). We have no concerns with respect to the higher fee with respect to an application filed by paper as opposed to online but we do note that an applicant filing an application to extend a registration has no alternative but to file by paper (the system does not permit an online filing of an extension application) and we question if the applicant should be penalized with the higher fee in that circumstance.
2. Implementation of the Nice Classification: it is essential that the fee structure, both at the application stage and the renewal stage, not encourage overly-broad trademark applications. To that end, we agree with the proposal to charge a fee for each individual class. This will help to preserve the integrity of the Canadian trademark register. The proposed fee of \$100 when filing a new application is reasonable.
3. Renewals: the fees proposed will encourage trademark owners to give serious thought as to whether or not a registration should be renewed and whether it should be renewed for all classes covered by the registration. The current fee of \$350 might well be viewed as too low especially given that the renewal stands for 15 years. Increasing the base renewal fee to \$400 (for a period of 10 years) is reasonable. We also agree that there should be a fee per class. The proposed fee of \$125 is reasonable.

Accordingly, we support the overall approach taken by CIPO with respect to the Fee-for-Service Proposal.