

NEW!

CANADA'S NEW TRADEMARK REGIME:

*The Practical, Tactical Guide to
Navigating the Sweeping Changes*

The law is changing. Are you ready?

Get critical guidance and practical advice through interactive discussions and a problem-solving approach using real world examples.

Need a thorough and concise understanding of the trademark law changes and impacts to practice and advising clients? Whether you're in law, business or finance, this intensive, one-day program is for you.

- How will brand clearance, filing and prosecution differ in a "use-less" regime?
- What to do about the "universal" Madrid Protocol and the new rules for Official Marks and Geographical Indications
- How will prosecutions, oppositions and Section 45 proceedings differ in the new regime?
- A walk-through of enforcements and expungements, including the expanded scope of "infringement" (new defences and assertions)

Register today at:

osgoodepd.ca/trademarks

Program Chairs

John McKeown
Goldman Sloan Nash & Haber LLP

Cynthia Rowden
Bereskin & Parr LLP

Date and Time

April 30, 2019
8:30 a.m. – 5:00 p.m. EDT
In Person or Webcast

Online Replay:
May 27, 2019
8:30 a.m. – 5:00 p.m. EDT

Location

**Osgoode Professional
Development**
1 Dundas St. West, 26th Floor
Toronto, ON



Canada's New Trademark Regime:

The Practical, Tactical Guide to Navigating the Sweeping Changes

In June 2019, sweeping legal reforms will transform the Canadian trademark landscape.

As a legal professional, trademark agent, business or financial professional, you must have a clear grasp on how to protect your clients' interests and satisfy your new obligations.

Developed and led by an expert faculty, this one-of-a-kind **practical OsgoodePD** program features **interactive discussions** and a **problem-solving approach** using real world examples, to highlight key reforms and practice changes in a zero-consequence environment.

You'll walk away with the strategies, tips and insights you need to confidently approach trademark matters and navigate the new regime.

Topics Include

- Strategies for searching, filing and advising clients
- Comprehensive overview of renewals, prosecutions and oppositions
- Enforcement and litigation tactics
- Trademark refresher – how did we get here and why is it important?
- Impacts to brand strategy and portfolio management

Who Should Attend

- Lawyers, paralegals and law clerks engaging in corporate/commercial or financial services transactions involving IP
- Counsel, advisors and professionals working in related areas who need a solid understanding of the new trademark regime and its implementation
- Insolvency, litigation or government counsel seeking to gain a greater understanding of the new trademark regime and its implementation
- Junior or mid-level IP lawyers, Trademark Agents, and other professionals who advise clients or investors that own or have interest in IP
- In-house counsel, executives and other legal, business and finance professionals working with companies or investors that own or have interest in IP
- Executives, management, risk managers and analysts involved in negotiating or overseeing IP deals
- Procurement professionals
- Technology transfer/commercialization professionals
- Owners, licensees or licensors of IP
- Venture Capital/Investment Analysts/Angel Investors
- Consultants
- Anyone who needs a solid understanding of the new trademark regime and its impact across practice areas

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Agenda

8:00 a.m.

Registration

8:30 a.m.

How Did We Get Here? Understanding the Amendments

John McKeown, Goldman Sloan Nash & Haber LLP

Cynthia Rowden, Bereskin & Parr LLP

- Overview and refresher of key concepts, issues and things to watch out for
- Summary and impacts of key Treaties and harmonization (domestic and foreign)
- *Economic Action Plan 2014 Act, No.1* – Major changes to be implemented on June 17, 2019
- *Combating Counterfeit Products Act* – Enacted January 1, 2016
- *Economic Action Plan 2015 Act, No.1*
- *Canada's Intellectual Property (IP) Strategy*
- *Bill C-86* – Further changes to the *Trade-marks Act*, and the *College of Patent Agents and the Trade-mark Agents Act*
- *Canada-United States-Mexico Agreement (NAFTA 2.0)*
- Brand Restriction Legislation – Cannabis, Tobacco and Advertising to Children

9:15 a.m.

How Will Brand Clearance, Filing + Prosecution Differ in a "Use-less" Regime?

Philip Lapin, Smart & Biggar/Fetherstonhaugh

Henry Lue, Wilson Lue LLP

Cameron Weir, Senior Counsel, Reckitt Benckiser (Canada) Inc.

- Clearance – impact of elimination of filing grounds on determination of

entitlement, clearance uncertainty, search opinion limitations, investigation costs and procedure

- Filing – prerequisites, communication, new marks, forms, Nice Classification, fees
- Predicting prosecution obstacles
- Transition Rules – impact on applications, registrations, renewal, oppositions

10:15 a.m.

Refreshment Break

10:30 a.m.

The Madrid Protocol: Practical Strategies to Filing a “Universal Application”... or Not

Christopher Aide, Baker & McKenzie LLP

Matthew Asbell, Ladas & Parry LLP
(New York, USA)

Kathryn Yung, EVP, Chief Legal, Ethics & Compliance Officer, Canadian Standards Association (CSA)

- What is it?
- When to use it? When not to use it?
- Costs, procedures
- Advantages and disadvantages

11:30 a.m.

The New Rules for Official Marks + Geographical Indications

May Cheng, Osler Hoskin & Harcourt LLP

Stephanie Vaccari, Baker & McKenzie LLP

- Limitations on Official Marks – impact in clearance and prosecution
- What is a Geographical Indication?
- The *Canada-European Union Comprehensive Economic and Trade Agreement* (CETA)
- Implementation
- Schedule 6 Indications
- The Prohibition
- The Exceptions
- Objections

12:15 p.m.

Networking Lunch

1:00 p.m.

How Will Prosecution of Applications Differ?

Meghan Dillon, Bereskin & Parr LLP

Sanjukta Tole, Marks & Clerk Canada and Marks & Clerk Law LLP

- New examination criteria – Distinctiveness
- New Marks
- Utilitarian features
- Divisional applications – when to use?
- Letters of protest
- Renewals
- Recording transfers and changes of name
- Associated marks
- Correcting errors

2:00 p.m.

The New Opposition Grounds + Section 45 Proceedings

Susan Keri, Bereskin & Parr LLP

Donna White, Osler Hoskin & Harcourt LLP

- Section 45 of the *Trade-marks Act* – opposition grounds under the new regime
- “Bad faith” – how to prove? Onus?
- Changes to proceedings – evidence, cross-examination, written arguments and hearing procedure
- Section 45 proceedings – changes to procedure
- Pilot project on Registrar-initiated Section 45 proceedings

3:00 p.m.

Refreshment Break

3:15 p.m.

Enforcement + Expungement

Monique Couture, Gowling WLG

Kelly Gill, Gowling WLG

- How will the amendments impact litigation?

- Use requirements
- Caution before asserting rights without “use” details
- Expanded scope of “infringement” (new defences and assertions)
- Bad faith expungement
- Impact of *Combating Counterfeit Products Act*

4:00 p.m.

Expert Roundtable: Branding – How do these Changes Impact Brand Management Strategy?

Moderators:

John McKeown, Goldman Sloan Nash & Haber LLP

Cynthia Rowden, Bereskin & Parr LLP

Panel speakers:

Sean Brandreth, Corporate Lawyer, Nestlé Canada Inc.

Kikelomo Lawal, Chief Legal Officer & Corporate Secretary, Interac Corp.

Jennifer MacInnis, Legal Counsel and Senior Director, Applied Research & Commercialization and Research Grants, Executive Director, Ontario Centre for Workforce Innovation, Office of the Vice President, Research & Innovation, Ryerson University

Stephen Spracklin, Legal Counsel, Information Technology & Intellectual Property, City of Mississauga

Essien Udokang, Senior Director, Legal Affairs, McKesson Canada

- Types of marks selected?
- More or less searching/investigation/watch systems?
- Registration or not?
- Impact on volume of oppositions and Section 45 proceedings?
- Impact on volume of litigation?
- Top tips + strategies for moving forward

5:00 p.m.

Program Concludes

Chairs

John McKeown
Goldman Sloan Nash & Haber LLP

Cynthia Rowden
Bereskin & Parr LLP

Faculty Includes

Christopher Aide
Baker & McKenzie LLP

Matthew Asbell
Ladas & Parry LLP
(New York, USA)

Sean Brandreth
Corporate Lawyer, Nestlé Canada Inc.

May Cheng
Osler Hoskin & Harcourt LLP

Monique Couture
Gowling WLG

Meghan Dillon
Bereskin & Parr LLP

Kelly Gill
Gowling WLG

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Bereskin & Parr LLP

Philip Lapin
Smart & Biggar/Fetherstonhaugh LLP

Kikelomo Lawal
Chief Legal Officer & Corporate Secretary,
Interac Corp.

Henry Lue
Wilson Lue LLP

Keltie Luft
Smart & Biggar/Fetherstonhaugh LLP

Jennifer MacInnis
Legal Counsel and Senior Director,
Applied Research & Commercialization
and Research Grants, Executive Director,
Ontario Centre for Workforce Innovation,
Office of the Vice President, Research &
Innovation, Ryerson University

Stephen Spracklin
Legal Counsel, Information Technology &
Intellectual Property, City of Mississauga

Sanjukta Tole
Marks & Clerk Canada and Marks & Clerk
Law LLP

Essien Udokang
Senior Director, Legal Affairs, McKesson
Canada

Stephanie Vaccari
Baker & McKenzie LLP

Cameron Weir
Senior Counsel, Reckitt Benckiser
(Canada) Inc.

Donna White
Osler Hoskin & Harcourt LLP

Kathryn Yung
EVP, Chief Legal, Ethics & Compliance
Officer, Canadian Standards Association
(CSA)

Here's what a participant at our recent IP program had to say:

"[E]xcellent program [and] all the information was very useful. There were a lot of practical examples used [which] is extremely important for lawyers as it helps us understand the practical aspects."

Meenakshi Tewari
Sole Practitioner, Jham Law Office

Registration Details

Fee per Delegate

\$695 plus HST

Fees include attendance, program materials, lunch and break refreshments. Group discounts are available. Visit www.osgoodepd.ca/group-discounts for details. Please inquire about financial assistance.

Program Changes

We will make every effort to present the program as advertised, but it may be necessary to change the date, location, speakers or content with little or no notice. In the event of program cancellation, York University's and Osgoode Hall Law School's liability is limited to reimbursement of paid fees.

Cancellations and Substitutions

Substitution of registrants is permitted at any time. If you are unable to find a substitute, a full refund is available if a cancellation request is received in writing 14 days prior to the program date. If a cancellation request is made with less than 14 days notice, a \$75 administration fee will apply. No other refund is available.



OsgoodePD has been approved as an Accredited Provider of Professionalism Content by the LSO.



Eligible CPD Hours: LSO (ON): 7h CPD (6h Substantive, 45m Professionalism, 15m EDI).



This program is approved for LAWPRO Risk Management Credit.

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