Managing Canada's Changing Trademark Landscape: Madrid Protocol

April 17, 2019

In a previous bulletin, "Save the Date: Preparing for Canada's New Trademark Regime Coming Into Force on June 17, 2019", we reported that significant changes to Canada's trademark law will come into effect on June 17, 2019. Over the next two months, BLG will prepare and circulate a bulletin series to provide some tips and practical considerations on how trademark owners may tailor their trademark and brand protection strategies in view of these upcoming changes.

This second bulletin focuses on filing international applications using the Madrid Protocol.

What is the Madrid Protocol?

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, or Madrid Protocol, is an international registration system that offers the opportunity to obtain protection for trademarks in a number of countries through a single international application. Changes in Canadian trademark law coming into force on June 17, 2019 include acceding to the Madrid Protocol. This integration of the Madrid Protocol in Canadian law will bring Canada's law in line with all of our major trading partners.

Madrid Protocol applications are filed with the International Bureau of the World Intellectual Property Organization (WIPO). Under the Madrid Protocol system, a trademark owner has to file only one international application with WIPO, in one language, and pay one fee in one currency. A knowledgeable Canadian trademark agent, such as those at BLG, can file international applications and select each member country that the applicant wishes to file an application in. Local agents in each jurisdiction must be engaged to assist with national applications in certain circumstances such as when there are objections raised by the local trademark office, oppositions or other such contentious issues.

How Will the Madrid Protocol Impact Your Trademark Strategy?

Currently Canadian firms cannot take advantage of the international trademark filing system and have to file separate applications in each jurisdiction in which they want to protect their trademarks. Once Canada accedes to the Madrid Protocol and the changes in the law come into force, Canadians will be able to use the international filling system to streamline their international trademark application process. Trademark applicants in other Madrid Protocol countries will also be able to use the system to file applications selecting Canada as one of the jurisdictions for protection of their trademarks. For Canadian companies considering using Madrid to file in other jurisdictions it is worth considering preparing a Canadian application now as a national application is required to access the Madrid system.

Some examples of how Canadian applicants can benefit from the system include: lower expenses related to translation, currency exchange fees and fees for local representatives and a more streamlined and simple process to make changes to existing registrations filed using the Madrid Protocol system where an applicant need only inform WIPO of any changes to trademark registrations, such as a change of address, and not each of the countries where they hold a registration.

One of the potentially significant disadvantages for Canadian companies using the Madrid Protocol is the goods and services claimed by an applicant must be within the scope of the basic application for each jurisdiction. If an applicant chooses to file national applications separately in each jurisdiction there is an opportunity to file a much broader scope of goods and services and tailor such filings to the individual jurisdictions.

Trademark owners considering expanding or launching new international brands after June 17, 2019 should discuss the advantages and costs of using the Madrid Protocol system for new applications in multiple jurisdictions, particularly where the planned launch is in more than three or four countries. BLG is well positioned with significant experience and inter-jurisdictional understanding to assist law firms and trademark agents in Madrid jurisdictions, who select Canada as a jurisdiction under an international application, to navigate the Canadian examination and opposition processes.

BLG has trademark professionals in Vancouver, Calgary, Toronto, Ottawa and Montréal who are happy to help you with your trademark strategy and answer your questions on navigating the changes to Canadian trademark law. View the full list of our trademark team.

Watch for the next bulletin in our series on the topics of filing strategy, pending applications under examination and non-traditional trademarks.

By

Jacky Wong, Matthew Boyd, Mekhala Chaubal

Expertise

Intellectual Property, Trademarks

BLG | Canada's Law Firm

As the largest, truly full-service Canadian law firm, Borden Ladner Gervais LLP (BLG) delivers practical legal advice for domestic and international clients across more practices and industries than any Canadian firm. With over 800 lawyers, intellectual property agents and other professionals, BLG serves the legal needs of businesses and institutions across Canada and beyond – from M&A and capital markets, to disputes, financing, and trademark & patent registration.

blg.com

BLG Offices

Calgary

Centennial Place, East Tower
520 3rd Avenue S.W.
Calgary, AB, Canada
T2P 0R3

T 403.232.9500
F 403.266.1395

Ottawa

World Exchange Plaza
100 Queen Street
Ottawa, ON, Canada
K1P 1J9

T 613.237.5160
F 613.230.8842

Vancouver

1200 Waterfront Centre
200 Burrard Street
Vancouver, BC, Canada
V7X 1T2

T 604.687.5744
F 604.687.1415

Montréal

1000 De La Gauchetière Street West
Suite 900
Montréal, QC, Canada
H3B 5H4

T 514.954.2555
F 514.879.9015

Toronto

Bay Adelaide Centre, East Tower
22 Adelaide Street West
Toronto, ON, Canada
M5H 4E3

T 416.367.6000
F 416.367.6749

The information contained herein is of a general nature and is not intended to constitute legal advice, a complete statement of the law, or an opinion on any subject. No one should act upon it or refrain from acting without a thorough examination of the law after the facts of a specific situation are considered. You are urged to consult your legal adviser in cases of specific questions or concerns. BLG does not warrant or guarantee the accuracy, currency or completeness of this publication. No part of this publication may be reproduced without prior written permission of Borden Ladner Gervais LLP. If this publication was sent to you by BLG and you do not wish to receive further publications from BLG, you may ask to remove your contact information from our mailing lists by emailing unsubscribe@blg.com or manage your subscription preferences at blg.com/MyPreferences. If you feel you have received this message in error please contact communications@blg.com. BLG's privacy policy for publications may be found at blg.com/en/privacy.

© 2026 Borden Ladner Gervais LLP. Borden Ladner Gervais LLP is an Ontario Limited Liability Partnership.