

Limiting Extensions of Time in Examination and Other Changes to Canadian Trademark Practice

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On January 17, 2020, the Canadian Intellectual Property Office (CIPO) issued a new Practice Notice on Extensions of Time that may limit an applicant's ability to obtain an extension of time to respond to an Examiner's Report. Previously, CIPO would generally grant one six-month extension of time to respond "as of right," following which an applicant would be required to demonstrate *exceptional circumstances* to justify the granting of any further extensions.

Under the new Practice Notice, CIPO will no longer grant extensions of time as of right, but will require applicants to demonstrate exceptional circumstances justifying why it is not yet possible to file a proper response, even upon the applicant's first request. The (non-exhaustive) list of exceptional circumstances that would justify an extension of time now includes some additional examples that were not included under the previous Practice Notice, such as (i) the applicant requires more time to respond to an objection that the trademark is not registrable, not distinctive, or that the applicant is not the person entitled to registration; and (ii) the applicant requires more time to compile evidence that the trademark was distinctive at the filing date of the application. In each of these cases, the applicant may only request an extension of time for that reason *once* during the prosecution of the application. As such, the total amount of time that an applicant has to respond to these objections may be shorter. In other cases, such as where the Examiner's Report raises only technical issues (e.g., goods and services objection), and an applicant cannot demonstrate an exceptional circumstance, no extension of time will be available. If an applicant fails to provide a full response to an Examiner's Report in a timely manner, CIPO will continue to issue default notices providing applicants with a further two-month period of time within which to respond.

The new Practice Notice will apply to all Examiner's Reports issued on or after January 17, 2020. In cases where an Examiner's Report was issued prior to this date, the old practice of granting one six-month extension as of right will apply.

CIPO has also issued amended Practice Notices and guidance documents as follows:

- **Filing divisional applications:** An amended Practice Notice on Divisional Applications stating that, since the CIPO online filing system is not yet equipped to handle divisional applications, applicants may file divisional applications by either: (i) amending the original application online by limiting the goods or services and, in the closing details of the application, stating that the applicant wishes to file a divisional application; or (ii) filing by paper, on the original application, a request to file a

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divisional application. In each case, the applicant must specify which of the goods and services should appear in the divisional application.

- **Nice classification:** A provision in the old guidance document stating that CIPO would issue a notice requiring owners to group goods and services according to the Nice classification for newly registered trademarks that registered prior to June 17, 2019 (when a significant number of changes to the *Canadian Trademarks Act* came into force), has been deleted in a revised guidance document on transitional provisions. Nice classification notices will continue to be issued at the time of renewal. An amended Practice Notice on Renewals also clarifies that the Registrar does not have the authority to require owners of trademark *registrations* to be restated in ordinary commercial terms in order to ensure that the goods or services are properly classified (in comparison to trademark *applications* where the Registrar does have such authority).

This publication is a general summary of the law. It does not replace legal advice tailored to your specific circumstances.