Improving timeliness in Canadian trademark examination

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The Canadian Intellectual Property Office (CIPO) is taking action to improve timeliness in issuing trademark rights.

Higher-than-anticipated filings of Canadian trademark applications, and the country's successful accession to the Madrid System for registering international trademarks, led to increased wait times to first examination. CIPO considers it a priority to improve timeliness in examination. Measures intended to reduce the delay were proposed in a recent practice notice. They include:

a) When issuing an examiner's report, examiners will provide fewer examples of goods or services that would be considered acceptable.

In Canada, there is a requirement to describe goods and services in "ordinary commercial terms." This requirement tends to be for a more specific description than in other countries.

CIPO recently developed a *Goods and Services Manual* setting out acceptable terms, which examiners were encouraged to use to suggest acceptable wording in their reports. Now they will no longer provide such examples in the first report, unless amendments to the statement of goods or services can be made by way of a telephone amendment.

b) Applications filed with CIPO that have statements of goods or services selected from a preapproved list will be examined faster and, in some cases, before those that did not use this option.

Applicants may use CIPO's preapproved list to potentially expedite the examination process. However, it may not be helpful if the applicant wants to maintain a somewhat broader statement of goods and services, or if the specific goods and services of interest are not on CIPO's preapproved list.

c) Examiners will reduce the number of reports issued and CIPO will, where reasonable, refuse trademarks in a timelier manner. To this end, examiners will only be required to maintain a particular submission or argument once. The

applicant should, therefore, make every effort to ensure it provides a complete argument.

In order to avoid refusal, this policy may incentivize applicants to ensure the arguments made in the first response to the examiner are as complete as possible.

In addition to the above, in an effort to improve timeliness in examination CIPO will, on a weekly basis, expand the number of entries in the Goods and Services Manual. To this end, approximately 100 entries will be added to the manual each week. By expanding the Goods and Services Manual, CIPO expects to improve consistency and quality in examination, while providing more certainty to applicants when filing or amending a trademark application.

The delays in examination mentioned above have led to concerns that applicant's rights are being compromised. Currently, only applications covering certain COVID-related goods and services qualify for expedited examination. CIPO is now accepting requests on broader terms for expedited examination of trademark applications.

Some effort is required to take advantage of this new, expedited examination procedure. Requests for expedited examination must be in the form of an affidavit or a statutory declaration, and must clearly set out how one or more of the following criteria are met:

a) A court action in Canada is expected or underway with respect to the applicant's trademark in association with the goods or services listed in the application;

b) The applicant is in the process of combating counterfeit products at the Canadian border with respect to the applicant's trademark in association with the goods or services listed in the application;

c) The applicant requires registration of its trademark in order to protect its intellectual property rights from being severely disadvantaged on online marketplaces; or

d) The applicant requires registration of its trademark in order to preserve its claim to priority within a defined deadline and following a request by a foreign intellectual property office. Note that in such cases the request will need to be attached to the affidavit or statutory declaration.

Currently there is no government fee for such a request. The request can only be made by fax or mail.

Madrid applications are required to have first examination within 18 months of filing. As indicated above, national applications are in some cases not being examined until 30 months from filing. These new provisions for expedited examination will create another tier of examination, with the timeliness dependent in part on the popularity of such requests.

Reach out to any of the key contacts below or any member of our Trademarks practice group if you have questions regarding these changes.

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