Changes to extension of time requests in Canadian trademark examination

January 31, 2020

On January 17, 2020, the Canadian Intellectual Property Office (CIPO) issued a new Practice Notice detailing changes to extension of time requests for responding to examiner's reports. This is the first Practice Notice issued by CIPO since the amendments to Canada's *Trademarks Act* came into force last June.

Under the previous practice, an applicant was generally entitled to one extension of time, up to a maximum of six months, to respond to an examiner's report so long as the request was 'justified' with a reason. Under the new practice, exceptional circumstances will be required to justify any request for an extension of time for any Examiner's reports issued on or after January 17, 2020.

However, CIPO has also expanded on the examples that could amount to exceptional circumstances that would justify an extension of time. The full list of examples provided by CIPO includes:

1. **Trademark Agent** – A recent change in trademark agent;
2. **Circumstances Beyond the Control of the Person Concerned** – Circumstances such as illness, accident, death, bankruptcy, or other serious and unforeseen circumstances;
3. **Transfer** – Transfer of an application or registration that would overcome a confusion objection;
4. **Opposition** – A cited confusing trademark is the subject of a pending opposition proceeding;
5. **Section 45** – A cited registration is the subject of a pending non-use cancellation proceeding;
6. **Official Mark** – The applicant is in the process of negotiating the consent from the holder of an official mark;
7. **Divisional of a Protocol Application** – The applicant has filed a request for the division of an international registration and is waiting for notification that a divisional international registration has been created;
8. **Substantive Objections** – An objection was raised which could lead to a refusal related to registrability, entitlement, or distinctiveness; and
9. **Evidence of Distinctiveness** – The applicant requires additional time to compile sufficient evidence to show the trademark was distinctive as of the filing date.

With respect to requests relating to substantive objections and compiling evidence of distinctiveness, an applicant may request an extension for either reason only once during the entirety of the prosecution of the application. Under the old practice, a request for an extension of time was generally granted per Examiner's report, regardless of the type of objection raised.

An overview of the changes, as they relate to common objections raised by Examiners, is provided in the table below:

Objection	Examiner's Reports Issued Before January 17, 2020	Examiner's Reports Issued as of January 17, 2020
A Statement in Ordinary Commercial Terms of the Goods and Services – 30(2)(a) of the *Trademarks Act*	Generally entitled to **one extension** of time, up to six months, **per Examiner's report** absent exceptional circumstances.	**No extension of time available** to respond absent exceptional circumstances.
Classification of the Goods and Services according to *Nice* – 30(3) of the *Trademarks Act*		**No extension of time available** to respond absent exceptional circumstances.
Primarily Merely a Surname - 12(1)(a) of the *Trademarks Act*		Generally entitled to **only one extension of time**, up to six months, **throughout the entirety of the prosecution of the application.***
Clearly Descriptive or Deceptively Misdescriptive – 12(1)(b) of the *Trademarks Act*		Generally entitled to **only one extension of time**, up to six months, **throughout the entirety of the prosecution of the application.***
Confusion with a Registered or Co-pending Trademark – 12(1)(d) and 37(1)(c) of the *Trademarks Act*		Generally entitled to **only one extension of time**, up to six months, **throughout the entirety of the prosecution of the application.**
Not Distinctive – 37(1)(d) of the *Trademarks Act*		Generally entitled to **only one extension of time**, up to six months, **throughout the entirety of the prosecution of the application.***

*An additional extension of time based on exceptional circumstances may be available if the applicant plans to file evidence of distinctiveness in response to the objection raised.

Applicants should make note of these changes to ensure responses to Examiner's reports are filed in a timely manner absent exceptional circumstances justifying an extension of time.

By

Peter C. Cooke, Matthew Boyd, Clara Chow

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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

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