

EXAMINATION EXTENSIONS

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The trademarks examination branch of Canada's Intellectual Property Office (CIPO) has issued a new practice notice, in effect since March 11, pertaining to the granting of extensions for examining applications. This suggests that Canada is setting the stage to eventually become a party to the Madrid Protocol.

An applicant for a trademark is given a six-month initial deadline to make a full response to all matters raised in the examiner's report.

Under the new practice, "the Office will generally grant an applicant one extension of time of up to a maximum of six months to file a response to an examiner's report, if the request is justified. No requests for any further extensions of time will generally be considered." After that first extension, and "upon the expiration of twelve months from the initial date of the examiner's report, the Office will require that the applicant demonstrate exceptional circumstances justifying why it is not yet possible to file a proper response to an examiner's report".

The new practice notice also itemises examples of what would be considered the "exceptional circumstances" that would justify a further extension of time, including a pending action against a cited mark, the issuance of a home registration to support a Section 16(2) claim, a pending assignment, a consent negotiation with an official mark owner or a recent change in the applicant's agent. While this is the first time that CIPO has ever identified to the public what are considered "exceptional circumstances", these are indicated as "examples" and therefore should not be considered exhaustive. However, it is too early to tell what other reasons may or may not be considered acceptable in the eyes of CIPO, or how many times an applicant may use such "exceptional circumstances" against one application.

In the past, CIPO would allow an applicant the opportunity to request at least two six-month extensions before "exceptional circumstances" would need to be specifically identified.

The new practice notice coincides with CIPO's consultation period, ending March 15, 2010, wherein it is calling for comments from the public on proposed amendments to the Trade-marks Act, which would include aligning Canada's act with the Madrid Protocol. The new restrictions set out in the new practice notice on extension requests would appear to allow CIPO to meet the Madrid Protocol's implied requirement for an 18-month examination period.

The Intellectual Property Institute of Canada (IPIC) is making submissions to CIPO with respect to the proposed amendments. Any submissions made by IPIC, and the public at large, are expected to be published before any proposed changes to the act are brought before Parliament.

"UNDER THE NEW PRACTICE, 'THE OFFICE WILL GENERALLY GRANT AN APPLICANT ONE EXTENSION OF TIME OF UP TO A MAXIMUM OF SIX MONTHS TO FILE A RESPONSE TO AN EXAMINER'S REPORT, IF THE REQUEST IS JUSTIFIED. NO REQUESTS FOR ANY FURTHER EXTENSIONS OF TIME WILL GENERALLY BE CONSIDERED.' AFTER THAT FIRST EXTENSION, AND 'UPON THE EXPIRATION OF TWELVE MONTHS FROM THE INITIAL DATE OF THE EXAMINER'S REPORT, THE OFFICE WILL REQUIRE THAT THE APPLICANT DEMONSTRATE EXCEPTIONAL CIRCUMSTANCES JUSTIFYING WHY IT IS NOT YET POSSIBLE TO FILE A PROPER RESPONSE TO AN EXAMINER'S REPORT'."

In the meantime, applicants should be made aware of these new restrictions in examination and guide themselves accordingly in their overall strategy of prosecuting applications in Canada.

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