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# Fast Track your Trademark Applications in Canada.

Expediting Canadian Trademark Examination

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April 20, 2022

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## Our Speakers



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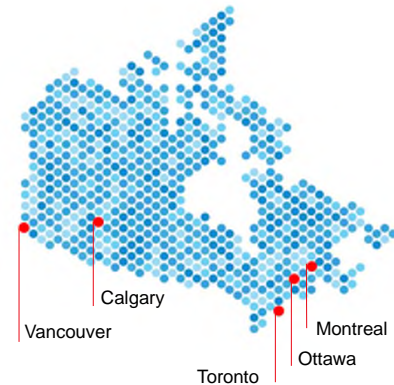
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## Who we are

Canada's **leading IP law firm** with expertise at the interface of **technology** and **business law**

- Expertise in all areas of IP
- 130+ years serving clients
- 100+ lawyers, agents and technical consultants
- 8,000+ patents & trademarks filed annually
- Litigation bench strength and record of success



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## Overview

Crisis at the Canadian Trademarks Office

How did we get here?

What are the current delay times to examination?

What is the TMO doing about the crisis?

Options for expedited examination:

- Specific scenarios requiring affidavit support
- All goods & services from the pre-approved list from Goods and Services Manual

Questions

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## Crisis at the Trademarks Office

### The Perfect Storm

#### New Trademarks Act

- Canadian *Trademarks Act* overhauled in mid-2019
  - More complicated examination requirements
  - Need for examiners to raise new objections

#### Madrid Protocol

- New delays while Trademark examiners come up to speed
- Increase filings at CIPO
  - More than anticipated
  - Canada was #3 / #4 in number of Madrid designations last year
  - Not enough examiners to handle

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## Crisis at the Trademarks Office

### The Perfect Storm continued

#### Impact of the Pandemic

- TMO is paper-based
- All Examiner's Reports for nationally-filed applications are printed and mailed
- During the several pandemic lockdowns, NO Examiner's Reports were issued

## Huge Backlog!



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## Prosecuting Applications - Key Differences

### For nationally filed applications

About 38 months from filing to examination

### For Canadian designations of IRs

Just under 18 months from filing to examination\*



*\*while faster for initial examination, much slower for subsequent examination*

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## What is the TMO doing about the Crisis?

**Ongoing hiring of new trademark examiners**

*Slow process*

**Digitizing Files**

*Slow*

*No timeframe to become paperless*

**Increasing the number of applications examined per year**

**Adding online e-service tools**

*But not for examination or prosecution*

**Increasing the number of pre-approved terms in the Goods and Services Manual**

**Encouraging applicants to use pre-approved list of goods and services**

**Hiring consultants to try to make the TMO more efficient**

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## Brief History of Expedited Examination in Canada

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- **More than 10 years ago** >> expedited examination available
- **Prior to about 4 years ago** >> relatively short wait times, no expedited examination
- **December 14, 2020** >> expedited examination in context of COVID-19 pandemic
- **May 3, 2021** >> expedited examination for other reasons, to address long wait times



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## Expedited examination in context of COVID-19 pandemic

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Eligibility >> Application must include:

- **pharmaceuticals, medical devices** (such as diagnostic tests, ventilators), or **medical protective equipment** (such as sanitary masks for protection against viral infections, disposable gloves for medical purposes) that prevent, diagnose, treat, or cure COVID-19;
- OR
- **medical services** or **medical research services** for the prevention, diagnosis, treatment, or cure of COVID-19.

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## Expedited examination in context of COVID-19 pandemic

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Specific circumstances and reasons for request:

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

**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;

An **approval** for use of the goods or services listed in the application has been submitted to, or has been obtained from, **Health Canada** under the same name as the trademark.  
•e.g., a Medical Device Licence (MDL)

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## General requests for expedited examination

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- A **court action** is expected or underway in Canada with respect to the applicant's trademark in association with the goods or services listed in the application;
- 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;
- The applicant requires registration of its trademark in order to protect its intellectual property rights from being **severely disadvantaged on online marketplaces**; or
- 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.

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## How to file request

- **Affidavit or statutory declaration** setting out how criteria are met
  - No fee
  - One request per trademark application
  - Submitted by mail or fax (no online form)



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## What happens next?



Currently, requests reviewed very quickly (~ 2 weeks to examination, if granted)



If denied, reasons given and applicant can try again



If accepted, application expedited throughout prosecution

- BUT: if any deadlines missed or extension requested, application could lose advantage of expedited examination

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## Summary of Expedited Examination



- For applicants who have a **pressing need** to obtain a registration, expedited examination offers a significant benefit of cutting the wait time from **three years** down to **two weeks**.

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## Amending Goods & Services to be compliant

### **Accelerated examination** - *only for nationally-filed applications*

- If all Goods and Services are from the pre-approved list in Goods and Services Manual
  - Examination will happen sooner
- If not all goods and services in pre-approved lists from the Manual
  - Time to examination: **38 months from filing**
- If all goods and services in the pre-approved lists from the Manual
  - Time to examination: **22 months**

*Note: Delays continue to get worse by about 1 week every month*

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## Benefits of using the Goods and Services Manual

- If all Goods and Services descriptions in an application are drawn from the pre-approved lists in the Manual
  - Examination accelerated automatically
  - Will be accelerated *even if* terms are subsequently “retired” from Manual
- Descriptions of goods and services do not have to be drawn from the pre-approved lists in the Manual to be acceptable
  - However, descriptions drawn from the pre-approved lists in the Manual **will benefit from accelerated examination** under this option

Goods and Services Manual available online here:

<https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03968.html>

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## Benefits of using the Goods and Services Manual

Examples:

- “wheelchairs” in pre-approved lists from the Manual
- “wheelchairs and parts therefor” not in pre-approved lists from the Manual
- Accordingly, “wheelchairs and parts therefor”
  - No accelerated examination
  - even though acceptable

### Tip:

If you want accelerated examination – but don’t want to amend all descriptions from pre-approved lists?

Consider divisional application

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# Questions?

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