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Fast tracking trademark applications in Canada.

Expediting Canadian Trademarks Examination

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Our Speakers

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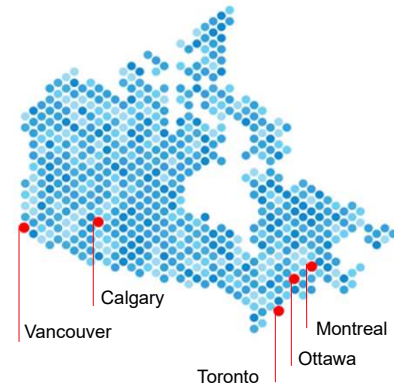
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Who we are

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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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Vancouver
Montreal
Ottawa
Toronto

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Overview

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| Delays 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 delays? |
| Options for speeding things up: |
| - Specific scenarios requiring affidavit support (expedited examination) |
| - Goods & services from the pre-approved list (accelerated examination) |
| Questions |

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Delays at the TMO: Perfect Storm

New Canadian *Trademarks Act*
- Completely overhauled in 2019
- Significant substantive and procedural changes

Madrid Protocol
- Delays while Trademark examiners came up to speed
- The top five recipients of designations: the U.K., the E.U., the U.S., China, and **Canada**

COVID-19 pandemic operational disruptions
- TMO was paper-based
- No Examiner's Reports were issued during several lockdowns

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Current Delays

Government of Canada   Gouvernement du Canada

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Canada.ca > Canadian Intellectual Property Office

Trademarks

Make the switch to electronic trademark correspondence!

Dates of Trademark Applications being distributed for Examination

Applications not using the Pre-approved List of Goods and Services: **March 27th, 2019**   } **50 months**

Applications using the Pre-Approved List of Goods and Services: **October 21st, 2021**

Madrid (based on date of WIPO notification of designation): **February 3, 2022**   } **16 months***

Note: faster initial examination, but much slower subsequent examination

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What is the TMO doing about the Delays?

Ongoing hiring of new trademark examiners *Recruitment + hiring nationwide*	Digitizing Files *TMO is 100% paperless as of January 2023*	Revamping Examiner's Reports	Improvement of IT tools

Expansion of pre-approved list of goods and services in Goods and Services Manual	Encouraging applicants to use pre-approved list of goods and services	Increasing the number of applications examined per year

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Expedited examination

- The **FASTEST** way to have a Canadian trademark application examined
- If granted, examination typically takes place within **1-2 weeks** of the request
- **Affidavit evidence** from the applicant is required, demonstrating that the applicant is:
    - Contemplating or has commenced **court action in Canada**;
    - Combating **counterfeit products** at the **Canadian** border; OR
    - Seeking to protect its rights from being **severely disadvantaged** on **online marketplaces**.

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A court action

- A court action is **expected** or **underway in Canada** with respect to the trademark in association with the goods or services in the application

- Affidavit must refer to the **litigation** that has been **commenced** or which is **expected** to be commenced in respect of the trademark

- CIPO was initially **lenient** with respect to the meaning of "**expected**" court action

- However, CIPO's stance has **tightened**, and if relying on an expected court action, **details** need to be provided in the affidavit
  - Factual background – no need to identify parties by name
  - Steps taken in anticipation of litigation

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Combating counterfeit products

- The applicant is in the process of combating **counterfeit products** at the **Canadian** border with respect to the trademark in association with the goods or services in the application

- Affidavit should state that the applicant requires a **registration** to record its rights with the **CBSA** (which only **records** registered marks)

- Affidavit may refer to the **anti-counterfeiting** actions taken by the applicant
  - If the applicant has a **history** of dealing with counterfeit activity and/or an **established anti-counterfeiting program**, the details may be useful to include – while **not required** (and we have been successful without such details), it can be beneficial to an applicant's request

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Disadvantaged on online marketplaces

- The applicant requires registration of its trademark in order to protect its intellectual property rights from being **severely disadvantaged** on **online marketplaces**

- Common **examples** include infringers / counterfeiters on **Amazon** and **Ebay**, but other examples can be used

- Affidavit should provide a **background** and **history** of the applicant's online commerce business, the **activities of the infringer**, and the **steps taken by the applicant**

- **Screenshots** of the objectionable listings / posts / sites **advertising** the counterfeit goods may be appended as **exhibits** to the affidavit

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COVID-19 products and services

- The goods or services are **medical** goods or services that **prevent, diagnose, treat or cure COVID-19**
  - Includes pharmaceuticals, medical devices and protective equipment, medical services, medical research services

- Application must include **at least one** of these goods / services

- Applicant must also have **obtained approval** or **submitted a request for approval** for use of the goods or services listed in the application to **Health Canada** under the same name as the trademark.
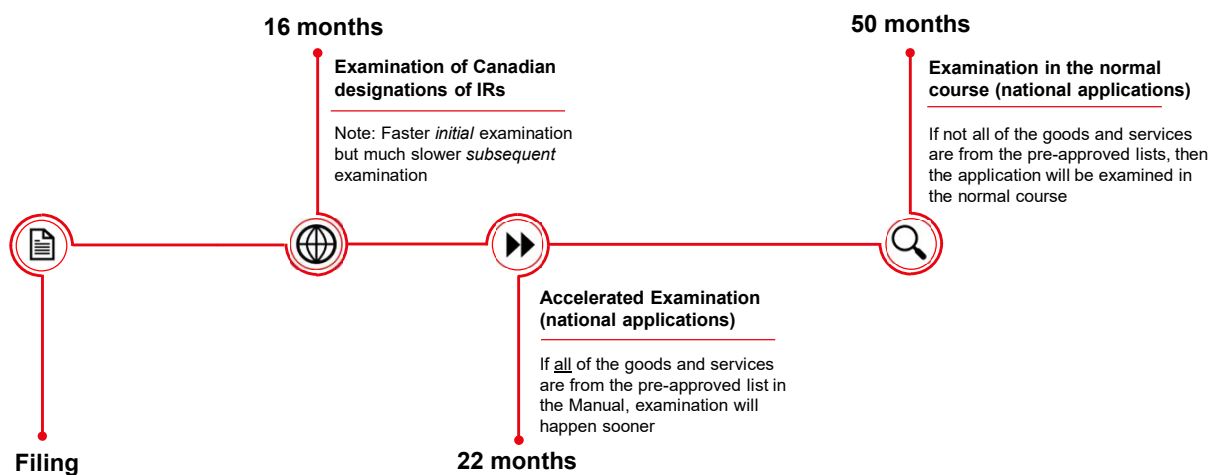
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Conclusion on expedited examination

- While it is the **fastest** way to examination, it is **likely not available** to the majority of brand owners

- However, given the **massive benefit** which it offers, applicants are well-advised to consider whether **any of the aforementioned criteria** apply to their cases

- Cost is **not prohibitive** in most cases; there is **no official fee**, but does require **legal fees** for preparation of the affidavit and submission of the request

- **Success** rate is currently very high – **90+%** of requests we have submitted have been **approved** for expedited examination!

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Accelerated Examination

16 months

Examination of Canadian designations of IRs

Note: Faster *initial* examination but much slower *subsequent* examination

50 months

Examination in the normal course (national applications)

If not all of the goods and services are from the pre-approved lists, then the application will be examined in the normal course

Accelerated Examination (national applications)

If all of the goods and services are from the pre-approved list in the Manual, examination will happen sooner

Filing

22 months

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Benefits of using the G&S Manual

✓ Examination accelerated **automatically**

✓ Examination is accelerated *even if* terms are subsequently retired from Manual

✓ May avoid the issuance of an Examiner's Report

Goods and Services Manual available online here:
https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03968.html

Select (All / None)	Term ⬆⬇	Status ⬆⬇	Category ⬆⬇	Nice Class ⬆⬇	Source ⬆⬇
☐	auxiliary fluids for use with abrasives for cleaning and polishing silver	⊘ Active	Goods	1	CIPO
☐	auxiliary fluids for use with abrasives for the oil well industry	⊘ Active	Goods	1	CIPO
	auxiliary fluids for use with abrasives ⓘ	◼ Retired - cannot be added to the list.	Goods	1	CIPO
☐	chemical additives for cleaning and removing abrasive materials from engines and transmission fluids	⊘ Active	Goods	1	CIPO
☐	abrasive bands	⊘ Active	Goods	3	WIPO
	abrasive blasting materials ⓘ	◼ Retired - cannot be added to the list.	Goods	3	WIPO

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Improvements in Accelerated Examination

• The list of pre-approved goods and services has been **significantly expanded**

• CIPO's software has been updated to improve functionality

  For example:

  • The terms **"t-shirts"** and **"pants"** are on the pre-approved list in the Manual, but **"clothing, namely, t-shirts and pants"** is not

  • Previously, examination of an application covering **"clothing, namely, t-shirts and pants"** would *not* be accelerated

  • Now, examination would be **accelerated** since updated software can detect that the terms after "namely" are on the pre-approved list

• Pre-assessment letters will identify which goods and services are on the pre-approved list

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Accelerated Examination

- Descriptions of goods and services **do not** have to be drawn from the pre-approved lists in the Manual to be acceptable, for example:

  - "**snowblowers**" on the pre-approved list in the Manual → examination **accelerated**

  - **"snowblowers and parts therefor"** not on the pre-approved list → acceptable, but **no accelerated examination**

  > **Tips:** If you want accelerated examination – but don't want to amend or select all descriptions from pre-approved list? Consider:
  >
  > - **Divisional** application
  > - Requesting that **terms be added** to the Manual
  > - Requesting **approval for Custom List of goods or services**

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Tips for Accelerating Examination

Example:

- Application covers ten goods or services → **six** are on the pre-approved list, **four** are not on the pre-approved list

Options for accelerating examination:

- File a **divisional application** – available since June 2019

| Parent Application: **six** goods/services on the pre-approved list | ➡ | Examination **accelerated** (22 months) |
| Divisional Application: **four** goods/services not on the pre-approved list | ➡ | Examination **in the normal course** (50 months) |

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💡 Tips for Accelerating Examination

Example:

- Application covers ten goods or services → <u>**six**</u> are on the pre-approved list, <u>**four**</u> are not on the pre-approved list

Option for accelerating examination:

- Request that the goods or services be **added to the Manual**
    - TMO will consider requests for goods and services to be added to the Manual
    - Goods and services can be submitted in English or French
    - Processing time → **3 weeks** from receipt to publication in the Manual

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💡 Tips for Accelerating Examination

Example:

- Application covers a long list of goods or services, which will also be used by the applicant for future applications

Option for accelerating examination:

- Request approval for **custom list** of goods or services
    - The Office will review requests for custom lists of goods and services
    - Certain terms from the custom list may be added to the Manual
    - Note: custom list must be approved **<u>before</u>** the application is filed

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Questions?

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Thank you!

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