



No more guaranteed extensions of time in examination

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- **CIPO has changed its practice with respect to extensions of time to respond to an examiner's report during examination**
- **CIPO's prior practice had been to grant one six-month extension of time essentially as a matter of course**
- **CIPO has now dispensed with the 'guaranteed exception' and will only grant a six-month extension of time with the demonstration of exceptional circumstances**

The Canadian Intellectual Property Office (CIPO) has changed its practice with respect to extensions of time to respond to an examiner's report during examination, with the stated goal of reducing the time it takes for an application to proceed to registration. Pursuant to an updated practice notice, published on 17 January 2020, entitled "Extensions of time in examination and to respond to a Section 44.1 notice", CIPO will generally only grant an extension of time where there are exceptional circumstances justifying the extension.

CIPO's prior practice had been to grant one six-month extension of time, essentially as a matter of course, and regardless of the nature of the objection raised (the 'guaranteed extension'). In other words, if needed, an applicant would have up to 12 months (including the initial six-month response period and the six-month extension) to respond to an examiner's report. Further six-month extensions were available only with the demonstration of exceptional circumstances justifying the extension.

CIPO has dispensed with the guaranteed exception, and for any examiner's report issued on or after publication of the updated practice notice, will only grant a six-month extension of time, with the demonstration of exceptional circumstances. For any examiner's report issued prior to 17 January 2020, applicants will still be able to obtain the guaranteed extension of time.

Although CIPO will determine what constitutes an exceptional circumstance on a case-by-case basis, to the previous list of examples of what could amount to an exceptional circumstance justifying an extension of time, CIPO has added the following:

- Where the application has encountered a substantive objection on the basis that:
 - the trademark is not registrable (eg, it is clearly descriptive/deceptively misdescriptive, primarily merely a name or surname, or confusing with a registered trademark);
 - the applicant is not the person entitled to registration because the trademark is confusing with another trademark that is the subject of an earlier-filed co-pending application; or
 - the trademark is not distinctive.
- Where the applicant will be filing evidence of distinctiveness (either to overcome a substantive objection or to support an application for a non-traditional trademark).

It is noteworthy that CIPO will consider a request for an extension of time based on the above two reasons only once during the prosecution of an application. Once used, these reasons are not available again, even with the issuance of a fresh examiner's report.

Previous examples of "exceptional circumstances" justifying further extensions are still available to applicants, and these may be obtained more than once during the prosecution of an application (and even more than once in response to the same examiner's report), provided the circumstances are still applicable, namely:

- very recent change in trademark agent (to permit time for the newly-appointed agent to become familiar with the file);
- circumstances beyond the control of the person concerned (eg, illness, accident, death, bankruptcy, or other serious and unforeseen circumstances);
- a pending request filed with CIPO for recordal of a transfer of an application or registration that would overcome a confusion objection;
- opposition against a cited mark;
- cancellation proceedings against a cited mark;
- negotiation for consent with an official mark holder; and
- division of a Madrid Protocol application, in respect of Canada.

Generally, an extension of time will not be granted (in the absence of other exceptional circumstances) for responding to technical objections (eg, objections to the description of goods and services). However, where an examiner's report covers both technical and substantive objections, an applicant can obtain an extension of time (on the basis that a substantive objection has been raised), and the extension will apply to both the substantive and technical objections.

If an extension request is refused, the application will be considered in default, and the applicant will be given two months to rectify the default by filing a response to the examiner's report.

With the dispensation of the guaranteed extension of time, it will be crucial for applicants to provide timely instructions to respond to an examiner's report, particularly where the objections raised are exclusively technical in nature.

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