

## **Alert** | Trademark & Brand Management



May 2021

### **Canada Intellectual Property Office (CIPO) Announces Expedited Examination Procedure for Trademark Applications**

Anyone who has filed a trademark application in Canada over the past number of years has probably noticed the extraordinary length of time it takes to obtain an examination report, allowance, and registration. With the move to online electronic filing of applications and state-of-the-art technology, why is there such a delay in Canada for the prosecution of trademark applications?

Even before the pandemic hit, there was a lack of trademark examiners in Canada in proportion to the number of filings, and the COVID-19 crisis has only served to exacerbate delays. As a consequence, it is taking a considerable amount of time for an examiner to review a newly filed application; therefore, new applications are building up into a seemingly insurmountable mountain of backlog awaiting review. Currently it takes about 18 to 24 months or more from the application filing date for an examiner to review a new trademark application and to issue either an examiner's report or a notice of approval, and this can severely impact the ability of trademark owners to address and take action against instances of infringement, piracy, and counterfeiting of their goods/services, as well as hamper efforts of these owners to register and protect their trademarks on online marketplaces and other platforms. Not surprisingly, the delays have been a source of frustration for trademark owners.

To address the above problems and to ease somewhat the impact of the significant trademark prosecution delays, the Canadian Intellectual Property Office (CIPO) announced on May 3, 2021, that it will begin

accepting requests for expedited examination of trademark applications along with other new measures. It is important to note that while there are no associated additional fees, the new expedited processing is not available across the board and is limited to trademark owners who fit certain circumstantial criteria.

According to the CIPO announcement, expedited examination can only be requested if:

- 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; and/or
- 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; and/or
- The applicant requires registration of its trademark in order to protect its intellectual property rights from being severely disadvantaged on online marketplaces; and/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.

Those with concerns about the trademark prosecution delays in Canada and who wish to explore expedited application processing should consult with counsel.

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