EXTENSION OF TIME FOR THE FILING OF THE DECLARATION OF USE REQUIRED BY SECTION 40(3) OF THE CANADIAN *TRADE-MARKS ACT* – PART I

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DECLARATION OF USE. When an application for registration of a proposed trade-mark is allowed to registration, the issuance of the registration is subject to the prior filing of a declaration stating that, since the filing of the application for registration, the applicant has commenced using the trade-mark in Canada.

When must this declaration be filed? Generally, it is filed once the notice of allowance has issued.

The declaration of use must therefore be made either within six (6) months of its allowance, or within three (3) years of the application for registration depending on whichever term proves more advantageous for the applicant.

If an application for registration is made on January 1, 1998 and is allowed for registration on January 1, 1999, the applicant will therefore have until January 1, 2001 to file the declaration of use (that is, three years from the time the application for registration was made). On the other hand, if an application for registration is made on January 1, 1998 but is only allowed on January 1, 2002 (that is, over three years after the initial application for registration was made), the applicant will have until July 1, 2002 (that is, six months after the allowance) to file it.

FAILURE TO FILE THE DECLARATION. If the applicant fails to file the declaration of use within the prescribed time period, the application shall be deemed to have been abandoned without any further notice from the Registrar.

EXTENSION. An applicant who is unable to file the declaration of use provided for by subsection 40(2) of the *Trade-marks Act* within the delay prescribed by subsection 40(3) may nevertheless request an extension of time, in accordance

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with subsection 47(1) of the Act, by paying the required fees.

WITHIN THE FIRST THREE YEARS. The Registrar must be convinced that the circumstances justify such an extension. A simple «We were informed by the departments concerned that the applicant is unable to produce the declaration of use contemplated by subsection 40(2) of the Act because the trade-mark is not as of yet fully used in Canada in association with all the wares and services mentioned in the application» will simply not suffice. The Trade-marks Office has revised its policies and as of April 14, 1998 an applicant must give a real reason to obtain an extension and not merely a statement that the trade-mark is not yet in use and that more time is needed to market it. This reason need not be, at least during the first three years after the application for registration is allowed, a «significant and substantive» one; nonetheless, some sort of reason must be provided.

As of yet, the Trade-marks Office has not established any fixed policies regarding the nature of the reasons required. However, all good reasons, even those that are simple or general, are likely to be accepted without the questioning of any facts or the requesting of supporting documents. What reasons would justify the granting of an extension? The Act, the Regulations, and all directives are silent. Nonetheless, it is interesting to observe that in the United States, the USPTO recognizes, amongst others, the following as being justifiable reasons for an applicant in an analogous situation to obtain an extension: product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities. In the alternative, a satisfactory explanation for the failure to make such efforts must be submitted.