

THE FILING OF THE DECLARATION OF USE REQUIRED BY SUBSECTION 40(2) OF THE TRADE-MARKS ACT: PART II

Laurent Carrière*
LEGER ROBIC RICHARD, L.L.P.
Lawyers, Patent and Trademark Agents
Centre CDP Capital
1001 Square-Victoria – Bloc E – 8th Floor
Montreal, Quebec, Canada H2Z 2B7
Tel. (514) 987 6242 – Fax (514) 845 7874
www.robic.ca – info@robic.com

In a previous newsletter, we saw that the prescribed time period for the filing of the declaration of use under subsection 40(2) of the *Trade-marks Act* could be extended.

Standard extension of time

The standard extension of time is six (6) months. However, if the use of the trade-mark is delayed because the applicant is awaiting a governmental approval, the extension will be twelve (12) months long.

In the latter case, the Trade-marks Office will require that the name of the department in question be given but will not necessarily demand a copy of supporting documents. This policy applies to all governmental approvals (not only Canadian) required, regardless of the number of wares or services in the application to which the approval pertains; just one ware or service is sufficient for obtaining the 12-month extension. Furthermore, contrary to popular belief, the governmental approvals in question are not limited to those concerning pharmaceutical or related products, but include *any* governmental approval.

After three years

Requests for extensions of time for filing the declaration of use after the expiration of three years from the initial deadline are subject to more stringent conditions. The administrative practice of the Trade-marks Office requires

© CIPS, 1999.

* Of LEGER ROBIC RICHARD, L.L.P., a multidisciplinary firm of lawyers, and patent and trademark agents. Published in the Spring 1999 issue (Vol. 3, No. 2) issue of our Newsletter. Publication 068.019E.

that “considerable and substantive reasons” (or, if one prefers, “raisons considérables et substantielles”) be given.

Even if initially misunderstood by the staff of the Trade-marks Office, it is now clear that this requirement of “considerable and substantive reasons” only applies with respect to requests for extensions made more than three years after the initial deadline for filing the declaration of use. Once again, if justified, the extensions will be granted for periods of 6 or 12 months, depending on the situation. What remains to be seen is what exactly constitutes “considerable and substantive reasons”. Even if the Trade-marks Office intends, at least at the beginning, to proceed on a case-by-case basis, one can already speculate that what would constitute special circumstances justifying non use in an administrative expungement notice under section 45 of the Act would be accepted by the Registrar as “considerable and substantive reasons”. However, these reasons must transcend mere marketing efforts, such as a quest for business partners.

Finally, it should be noted that when the Trade-marks Office is not satisfied with the reasons provided in support of the request for extension, a notice of refusal will be sent, outlining the possibility for the applicant to give better reasons within a two-month delay. If these better reasons are accepted, the extension of time will then be of 6 or 12 months, depending on the case, from the time that the refurbished reasons are submitted. This policy applies irrespective of whether the request for extension was made within the first period of three years or subsequently to it.

Summary

Within the 6 months of the notice of allowance or before the 3 years following the filing of the application: no explanations/reasons/justifications need be provided;

During the 3 years following the expiration of the 6 months of the notice of allowance or the 3 years following the filing of the application: circumstances convincing the Registrar that the extension should be granted must be given;

Once the 3 years following the expiration of the 6 months of the notice of allowance or the 3 years after the filing of the application have elapsed: the reasons provided must be significant and substantive.

