

**GUIDELINES ISSUED BY CANADIAN TRADE-MARKS OFFICE REGARDING
EXTENSIONS OF TIME ARE NOT BINDING, RULES FEDERAL COURT IN OPPOSITION
CASE THAT NEVER WAS**

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In what appears to be a cautionary tale as to the enforcement of guidelines that many Canadian trade-mark practitioners appear to take for granted and have come to rely on, the Federal Court of Canada recently ruled that guidelines issued by the Canadian Trade-marks Office which allow extensions of time to file a statement of opposition are simply that, *i.e.* guidelines which have no force of law and should accordingly be requested with eyes wide open. (*Sadhu Singh Hamdard Trust v. Registrar of Trade-marks and Ajit Newspaper Advertising, Marketing and Communications Inc.*, 2006 FC 171 (F.C. von Finckenstein, J., February 9, 2006)).

On January 20, 2004, Ajit Newspaper Advertising, Marketing and Communications Inc. ("Ajit Newspaper") filed an application with the Canadian Trade-marks Office to register the design trade-mark AJIT WEEKLY ("AJIT WEEKLY") in association with wares and services described as printed and electronic publications namely newspapers and magazines as well as the operation of an online website devoted to the promotion of Indian business and culture and the provision of an online electronic newspaper, the whole on the basis of use of the trade-mark in Canada since October 15, 1993. The prosecution of the AJIT WEEKLY trade-mark application appears to have been uneventful and the Trade-marks Office eventually advertised the trade-mark for opposition purposes in the *Canadian Trade-mark Journal*, on November 10, 2004.

On December 23, 2004, within the statutory two month deadline to oppose the application, Sadhu Singh Hamdard Trust ("Sadhu Trust") filed an application with the Registrar requesting a three month extension of time (beyond the statutory two month deadline) to eventually oppose the AJIT

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WEEKLY trade-mark. The two month deadline within which to file a statement of opposition is provided for by subsection 38(1) of Canada's *Trade-marks Act* (R.S.C. 1985, c. T-13) which reads as follows: "Within two months after the advertisement of an application for the registration of a trade-mark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar." For its part, the request for a three month extension of time appears to find support in a Practice Notice issued by the Trade-marks Office, regarding proceedings before the Trade-marks Opposition Board. This Practice Notice has been relied upon by practitioners to request extensions of time beyond the two month deadline set out in subsection 38(1) of the *Trade-marks Act*. Indeed, the aforementioned Notice provides for specific extensions of time at various stages in an opposition process and more specifically, for an additional three month extension of time to file a statement of opposition, which extension is usually granted through a notice sent out by the Registrar to both the trade-mark applicant and the entity requesting the extension of time; it is to be noted, however, that the possibility of obtaining a three month extension beyond the two month deadline to file a statement of opposition is not statutorily grounded; this being said, section 47 of the *Trade-marks Act* does allow the Registrar to grant extensions of time but without specifying the length of these extensions.

Sadhu Trust's December 23, 2004 request for a three month extension of time was indeed received by the Registrar; however, it is unclear what eventually happened to it as no acknowledgement nor response was ever issued by the Trade-marks Office to Sadhu Trust. In any event, the Registrar did not act in any fashion upon Sadhu Trust's request. Consequently, as it appeared to the Registrar that no opposition was filed by January 10, 2005, at the expiry of the two month statutory deadline provided for by subsection 38(1) of the *Trade-marks Act*, the Registrar proceeded to register the AJIT WEEKLY trade-mark on March 3, 2005. As the trade-mark AJIT WEEKLY was now registered, Sadhu Trust's request for an extension to oppose (or for any application to file a statement of opposition for that matter) was now without object.

A few months later, on September 27, 2005, Sadhu Trust brought an application before Canada's Federal Court under section 56 of the *Trade-marks Act* in order to obtain an extension of time to issue and serve a notice of application appealing the Registrar's March 3, 2005 decision to register the AJIT WEEKLY trade-mark. Section 56 upon which Sadhu Trust's application was founded reads in part: "An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months."

For its part, Ajit Newspaper opposed Sadhu Trust's application and argued that since the AJIT WEEKLY trade-mark was now registered, the only avenue available for Sadhu Trust was judicial expungement proceedings under section 57 of the *Trade-marks Act*, which reads in part: "The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark."

After considering the parties' respective positions, the Court came to the conclusion that section 56 of the *Trade-marks Act* was not applicable under the circumstances and dismissed Sadhu Trust's application. In the Court's view, section 56 implies a decision affecting the rights of a party. However, in the case before the Court, there was no decision of the Registrar vis-à-vis Sadhu Trust. Though it made an application for an extension of time to file a statement of opposition, Sadhu Trust never received a reply from the Registrar. When the January 10, 2005 deadline came and went, Sadhu Trust could not have expected that its request for an extension of time would automatically be granted because the Registrar is not legally bound by the guidelines that the Trade-marks Office has put into place. As there was no decision of the Registrar affecting Sadhu Trust's rights to appeal or review, the only alternative for it was to commence expungement proceedings under section 57 of the *Trade-marks Act*. (Under Canada's *Trade-marks Act*, opposition proceedings against the AJIT WEEKLY trade-mark would have been more appealing to Sadhu Trust because it is a trade-mark applicant – here, this would have been Ajit Newspaper – which must establish its right to registration during opposition proceedings while in judicial expungement proceedings, the onus of establishing that an entry in the register must be expunged rests with the person or entity seeking expungement, which role would presumably be taken up in this case by Sadhu Trust, should it initiate such proceedings).

The Court's decision can be seen as a warning for trade-mark practitioners who have come to rely on the possibility of obtaining various extensions of time based solely on guidelines issued by the Trade-marks Office. Obviously, because the guidelines have no legal force, any administrative problem which causes the Registrar to overlook or disregard a request for an extension of time does not have its automatic legal remedy with the Court as the latter will consider itself bound by the deadlines chosen by Parliament and set out in the *Trade-marks Act*. If practitioners are to rely on extensions of time (which are still sought and granted), they should make sure that the Registrar has granted any such requested extension before the expiration of a statutorily set deadline, or at least monitor their files closely.

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