



IMPORTANT CHANGE OF PRACTICE IN CANADA WITH RESPECT TO THE GRANTING OF EXTENSIONS OF TIME TO RESPOND TO EXAMINER'S REPORTS

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The Canadian Intellectual Property Office (CIPO) has officially followed through on contemplated changes that will now give rise to shortened time frames for responding to examiner's reports. On September 30th, 2009, CIPO had announced a consultation period for its proposed Practice Notice concerning extensions of time in examination. After consideration of all comments received during the consultation process held throughout the month of October 2009, on January 11th, 2010, CIPO announced the new Practice Notice entitled "Extensions of Time in Examination" was to take effect as of March 11, 2010.

Responses to examiner's reports are initially due within six months of the date of their issuance (which is paper based and delivered by postal mail). Effective **March 11th, 2010**, CIPO will generally grant an applicant only one further *justified* extension of time (beyond the initial six-month allotment) up to a maximum of six months to file a response to an examiner's report. It is unclear what will constitute a justifiable request under these new rules. However, the Practice Notice does indicate that no requests for any further extensions of time will generally be considered.

Upon the expiry of the twelve month period (calculated from the date of issuance of the examiner's report), further extensions of time may be granted only if the applicant demonstrates *exceptional circumstances* justifying why it is not yet possible to file a *proper* response to an outstanding examiner's report. CIPO considers a proper response as one wherein all objections/requests raised in the report have been addressed, thereby putting an end to a common practice of filing partial responses and requesting further extensions of time.

As for pending applications as of March 11, 2010 for which applicants have already been granted an extension of time (beyond the initial automatic six month time frame allotted starting from the date of issuance of the examiner's report), CIPO intends for the Practice Notice to have a retroactive effect. Therefore, in order to obtain a further extension of time, an applicant should demonstrate exceptional circumstances.

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CIPO has provided an illustrative and seemingly non exhaustive list of examples of what could constitute an *exceptional circumstance* that would justify a further extension of time:

1. Recent change in Trade-mark Agent to allow the latter to become familiar with the file.
2. Circumstances beyond the control of the person concerned such as illness, accident, death, bankruptcy or other serious and unforeseen circumstances.
3. A very recent assignment of the trade-mark.
4. The copy of the registration certified by the office in which it was made has not yet been issued since the foreign application has yet to proceed to registration.
5. The cited co-pending and confusing mark is possibly going to be abandoned within the next two months or is subject to an opposition proceeding initiated by the applicant.
6. The cited registered mark is subject to a Section 45 proceeding initiated by the applicant.
7. The applicant is negotiating for a consent from the holder of an official mark.

Certain elements contained in this Practice Notice remain unclear: there is no mention of what time frame CIPO considers as “recent” with respect to changes in agent or “very recent” concerning an assignment of the mark. It is also uncertain if CIPO will require “proof” of negotiations between an applicant and the holder of an official mark.

If at the expiry of this twelve month period, the applicant fails to file a response that covers all objections raised by an examiner and CIPO considers the reasons put forth in an extension of time request do not justify a further extension, the applicant will be considered in default in the prosecution of its application, triggering the issuance of a Notice of Default.

By limiting the number of obtainable extensions of time, this change is consistent with other recent changes that CIPO has introduced in an attempt to streamline matters related to opposition proceedings and summary expungement proceedings. However, as per some of the uncertainties pointed out above, this new Practice Notice may raise more issues than it answers. Nevertheless, only time will tell if CIPO’s implementation of these new measures will result in the more effective prosecution of applications in Canada or if the intended remedy will instead give rise to other setbacks.

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