



SUMMARY AND EXPEDIENT NATURE OF ADMINISTRATIVE EXPUNGEMENT PROCEEDINGS IN CANADA REFLECTED IN A NEW PRACTICE NOTICE

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The Canadian Intellectual Property Office has recently announced that, starting September 14, 2009, the Trade-marks Opposition Board will be changing its practice in its administrative expungement proceedings, known as section 45 proceedings.

Section 45 of the Trade-marks Act grants to the Registrar the power to give notice "at any time" to the owner of a registered trade-mark to provide evidence showing whether the trade-mark was used in Canada during the three year period immediately preceding the notice and, if not, the last date when it was used and the reason(s) excusing non-use since then.

This notice is usually given further to the written request of an interested party, unless the Registrar sees good reason to refuse issuance of the notice. Even though this determination is made on a case-by-case basis, the new practice notice now expressly indicates that if (i) the trade-mark is already the subject of proceedings; (ii) the request from the requesting party is within three years of the date of issuance of a previous section 45 notice; or (iii) the request is frivolous or vexatious, the Registrar could consider these circumstances as good reasons not to issue a notice.

Furthermore, to ensure compliance with Article 19 of the TRIPS Agreement, the Registrar will refrain from issuing a section 45 notice *proprio motu* if the concerned trade-mark has been registered for less than three years.

When the new practice notice will be in effect, the Registrar (i) will generally consider only one extension of time (up to four months) for the registered owner to file its evidence of use, (ii) will not grant requests to extend the new administrative deadline of four months to each party to file written representations (which was previously of two months); and (iii) will generally not grant requests for retroactive extensions of time to file additional evidence after the requesting party has filed its written representations. The fact that parties are negotiating a settlement or that they both consent to an extension of time will no longer suffice to obtain it.

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Among the circumstances that could nevertheless justify additional extensions of time are (i) a very recent change in the party's instructing principal or trade-mark agent; (ii) illness, accident, death, bankruptcy or other serious and unforeseen circumstances; or (iii) assignment or cancellation of the registration or amendment to the statement of wares or services.

In addition, in a case where a hearing was requested and the parties consented to having the hearing rescheduled, the Registrar will generally accept to reschedule it only once from now on.

All these changes pertaining to extensions of time and scheduling are meant to reflect the fact that section 45 proceedings should be an expedient statutory mechanism.

Lastly, it is also worth noting that, in determining if the evidence filed may provide sufficient reasons to justify the absence of use, the Registrar, based on previous decisions from the Federal Court of Appeal, confirms that it now considers all three of the following criteria: (i) the length of time during which the trade-mark has not been used; (ii) whether the reasons for the absence of use were due to circumstances beyond the control of the owner; and (iii) whether there exists a serious intention to resume use of the trade-mark shortly.

This practice notice in which the above-mentioned changes are specified will replace the previous practice notice dated December 21, 2005.

Practice notices are meant to provide guidance on the practice and interpretation of the Trade-marks Act ("TMA") by the Canadian Intellectual Property Office. If any inconsistency between the notice and the legislation is found, the legislation must be followed.



