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CANADA: Restrictions on Extensions of Time in Examination

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The Canadian Intellectual Property Office's Trade-mark Branch (TMB) has issued a new Practice Notice, effective March 11, 2010, governing extensions of time to respond to examiner's reports.

As of March 11 the TMB generally will grant applicants only one extension of time, up to a maximum of six months, to respond to an examiner's report. The TMB will now generally refuse requests for further extensions of time unless the applicant can demonstrate exceptional circumstances justifying a further extension. If the applicant does not demonstrate such circumstances, the application will be considered in default and subsequently become abandoned if the applicant does not cure the default within the allotted time.

Circumstances that the TMB may consider exceptional include circumstances beyond the applicant's control, such as a bankruptcy, or a very recent assignment of the applicant's mark. If a mark cited against the application is the subject of opposition or summary expungement proceedings initiated by the applicant, those proceedings may also be considered an exceptional circumstance. Because Canadian applications can be based on use and registration abroad, awaiting the issuance of the underlying foreign registration likely will also qualify.

The new Practice Notice represents a potentially significant change in Canadian trademark prosecution, because for many years the TMB has routinely granted multiple extensions of time to respond to an examiner's report. Now, with the adoption of this more restrictive approach, applicants should be prepared to substantively address Canadian examiner's reports more quickly than in the past.

Although every effort has been made to verify the accuracy of items carried in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.

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