

INTELLECTUAL PROPERTY

TRADE-MARKS IN CANADA: PROCESSING OF APPLICATIONS

by Paul Bain

The Office of the Registrar of the Canadian Intellectual Property Office (“CIPO”) processes applications for trade-mark registration based on the steps below. All the time-frames are approximate.

1. Formalities

Once an application is filed and in good order, along with the applicable fee (\$250 if submitted online), CIPO assigns a filing date and an application number to the application and opens a file.

The application will be entered into the Canadian Trade-marks Database as well as other databases maintained by external companies. The application is labeled “Pending.”

CIPO will provide a formal Filing Acknowledgement and a proof sheet listing the information included in the application. These documents should be reviewed carefully and clients should advise immediately if there are any errors or omissions. If the application is correct and complete, the acknowledgement and proof sheet will be sent by CIPO within ten (10) days after the application is filed.

2. Examination

A trade-mark examiner will review the application and determine if the trade-mark can be approved for advertisement in the *Trade-marks Journal*. If there are any doubts about the application, the examiner will notify of the objections. The applicant’s agent will then have an opportunity to respond. If the answers still fail to satisfy the examiner, CIPO will provide a letter informing that the application has been refused and explaining the reasons why. In the event of a refusal, there is a right of appeal to the Federal Court of Canada.

CIPO will send a formal Notice of Approval once the application is approved. If the application is approved without amendments, the Approval Notice should be mailed within six (6) months. If the application contains complex problems or issues, the examiner’s report should be mailed within six (6) months.

3. Advertising

If the application is approved, it will be published in one issue of the *Trade-marks Journal*, published weekly and available by subscription and in major libraries in Canada. Within two (2) months of being advertised, others can oppose the application, which will then be removed from normal processing until the opposition has been resolved.

The applicant will not be notified at this stage unless the application is opposed by one or more parties. In this event, the Trade-marks Opposition Board (“TMOB”) will provide written notification.

The application should appear in the *Trade-marks Journal* approximately five (5) weeks after it is approved.

4. Opposition

Should the application be opposed after being published in the *Trade-marks Journal*, the TMOB will forward a copy of the Statement of Opposition. Should the applicant contest the opposition, it will have one month to serve and file a counter statement. Both parties will, in turn, have an opportunity to file affidavit evidence and written arguments, as well as to make submissions at an oral hearing. If the opposition is withdrawn or is unsuccessful, the application will proceed to allowance.

An opposition is a complicated litigation-like proceeding. Most proceedings are resolved during the course of the opposition, but a complete opposition may last more than two (2) years.

5. Allowance

If there is no opposition, or if an opposition has been decided in favour of the applicant, the application will be allowed and the Office of the Registrar will not consider any further challenges. The applicant’s agent will receive a Notice of Allowance and be required to pay the \$200 registration fee. If the application has been based on “proposed use,” the applicant may request an extension of time until the trade-mark is actually in use. There is a fee of \$125 per extension.

If the applicant does not respond to the Notice of Allowance in the indicated time, abandonment steps may be taken.

If the application is not opposed, the Notice of Allowance should be mailed by CIPO three (3) months after the application appears in the *Trade-marks Journal*.

6. Registration

The applicant must pay the registration fee and, if the application was based on ‘proposed use,’ a Declaration stating that the trade-mark is being used must be provided. The trade-mark now moves from ‘Pending’ status and becomes a ‘Registered trade-mark’.

The official Certificate of Registration will be obtained and provided to the applicant/registrant.

The Certificate of Registration should be provided between three (3) to four (4) weeks after payment is made.

7. Conclusion

The length of time to register a trade-mark varies. If the application is filed correctly, approved without changes, and is not opposed, a Notice of Allowance should be received approximately 15 months after filing. After submitting the registration fee and Declaration of use (for trade-marks applications based on "proposed use"), the trade-mark should be registered about four (4) weeks later.

FOR MORE INFORMATION CONTACT:



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