

CLIENT ALERT

January 10, 2022

1

CANADIAN TRADEMARKS

by Sanjukta Tole

GOOD NEWS!

In 2021, applications filed in Canada went up 13.7%, partly due to Canada's accession to the Madrid Protocol.

When Canada is designated via the Madrid Protocol, the Canadian Intellectual Property Office (CIPO) will communicate directly with the applicant if a Canadian trademark agent is not appointed.

Correspondence from the CIPO, such as office actions, default notices, opposition notices, and non-use cancellation proceedings, is sent directly to the applicant and not the foreign agent. In our experience, the appointment of a Canadian trademark agent can assist with managing this correspondence and the risk of inadvertently missing any due dates or consequential loss of rights.

If you are looking to appoint a Canadian trademark agent, DW does so for no charge.

FILING STRATEGIES FOR FASTER RESULTS

There is considerable delay in the examination of applications lodged with the TMO. The current wait times are as follows:

Type	Delay (in months)
Applications designated via Madrid Protocol	~17
National applications with pre-approved list of goods and services	~25
All other national applications	~36

CIPO is actively encouraging the use of its pre-approved list of goods and/or services at the time of filing national trademark applications. CIPO has advised that it is placing a greater proportion of such applications in queue for examination and expects the wait time for examination of such applications to fall significantly over the next few months.

The pre-approved list of goods and services is set out in the Goods and Services Manual (the "Manual"), a living document. Although CIPO has added hundreds of new terms to the Manual over the last two years, the Manual has limited coverage, and an applicant may

need to rely upon descriptions outside its ambit.

DW can guide you on filing strategies to minimize delays in examination.

EXPEDITING EXAMINATION

DW can also navigate the various other initiatives introduced by CIPO to accelerate examination of trademark applications, such as:

- Using the latest online tools launched by CIPO
- Filing requests for expedited examination in limited circumstances, largely related to litigation
- Telephone amendments for minor clerical matters
- Limited extensions of time available in examination
- Fewer chances to overcome objections and greater rate of refusal
- Liaising with management at CIPO to provide constructive feedback and improve client service

While there is no guaranteed timeline for examination associated with these initiatives, CIPO has advised that requests for expedited examination have been approved almost 70% of the time as of early December 2021.

CLASSIFICATION

Canada also acceded to the International Nice Classification System in 2019. As a result, goods and services in all registrations issued before 2019 must be classified around the time of their renewal.

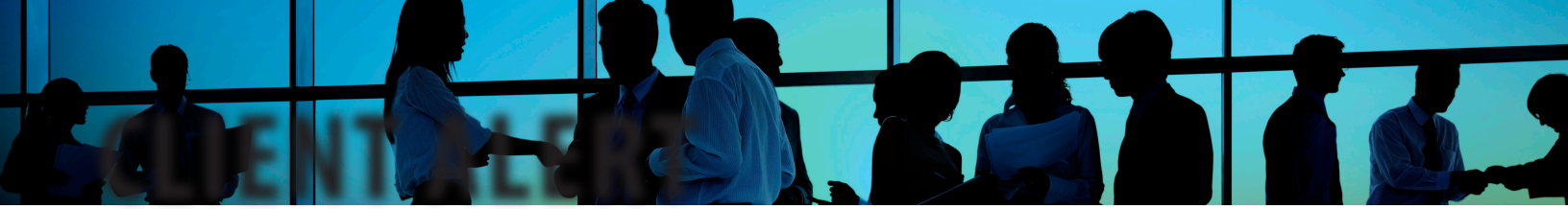
Registrants face up a five-month delay in having their classification requests reviewed. DW recommends filing voluntary classification requests early on to save on costs by avoiding CIPO's formal classification process and liability of renewal fees for classes that you may no longer want to maintain in the registration.

[Contact us](#) for more information on our renewal and classification fees in Canada, and discount packages.

COMING SOON! AUTOMATED RECORDALS

CIPO is automating the processing of recordals of assignments, name changes, address changes, changes of agent, and recordals of mergers and amalgamations. This will eliminate the current four-month delay in processing such requests.

CIPO plans to utilize AI and other software tools to process applications throughout 2022. DW is involved in providing CIPO feedback and remains committed to better service for its clients.



[Subscribe to our client alerts](#) to keep up with the changes. Any other questions or concerns about Canadian trademark law? Contact [Sanjukta Tole at DW](#) any time.

KEY CONTACT



Sanjukta Tole is a Partner in Dickinson Wright's Toronto office. She can be reached at 416.644.2828 or tole@dickinsonwright.com.