

# COVID-19: EXPEDITED EXAMINATION OF CANADIAN TRADEMARK APPLICATIONS

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On December 14, 2020, the trademarks and industrial design branch of the Canadian Intellectual Property Office (“CIPO”) published a practice notice entitled “Requests for expedited examination”. The practice notice can be found by [clicking here](#).<sup>[1]</sup>

## **Criteria**

Per the practice notice, and effective December 14, 2020, CIPO will accept requests for expedited examination of trademark applications associated with medical goods or services related to COVID-19, provided that the request (which is made in the form of an affidavit of statutory declaration) meets one or more of the following criteria:

- a court action is underway in Canada with respect to the applicant's trademark in association with the goods or services listed in the application;
- the applicant is in the process of combating counterfeit products at the Canadian border with respect to the applicant's trademark in association with the goods or services listed in the application;
- an approval for use of the goods or services listed in the application has been submitted to, or has been obtained from, Health Canada under the same name as the trademark.

In addition, the trademark application for which expedited examination is requested must include at least one of the following types of goods or services:

- pharmaceuticals, medical devices, or medical protective equipment that prevent, diagnose, treat, or cure COVID-19;
- medical services or medical research services for the prevention, diagnosis, treatment, or cure of COVID-19.

Requests must include the name of the applicant and, if known, the trademark application number. Each request must relate to one application only.

There is no government fee associated with a request for expedited examination under this initiative.

### **Acceptance of Request**

If the request for expedited examination is accepted, CIPO will examine the application out of the order in which it was received and as soon as possible. Note, however, that it is possible to lose the advantage of the expedited examination if the applicant requests an extension of time or misses any deadline related to the application.

### **Effective Period**

CIPO has advised that the option of requesting that the examination of an application be expedited under this initiative is available for a limited time period only. Namely, this initiative is currently scheduled to continue until August 31, 2021, or until the Registrar of Trademarks deems appropriate.

### **Why is this of interest?**

Those who are familiar with the current Canadian trademark practice are likely aware that it is not uncommon for an applicant to receive a first Examiner's Report from CIPO anywhere between 24 to almost 30 months after the filing date of the application. The expedited examination procedure afforded to these COVID-19 related applications will most certainly assist some applicants circumvent the current time delays in processing trademark applications for which expedited examination is not available.

For more information on whether your trademark application qualifies for expedited examination under this initiative, please contact a member of McMillan's Intellectual Property Group.

by Pablo Tseng

[1] "[Requests for expedited examination](#)", published December 14, 2020.

### **A Cautionary Note**

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

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