

# EXPEDITED EXAMINATION OF CANADIAN TRADEMARK APPLICATIONS: 6 MONTH RECAP

Posted on November 2, 2021

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This bulletin is a brief report on our experiences with requesting expedited examination of Canadian trademark applications.

It has been six months since the Canadian Intellectual Property Office (“**CIPO**”) began accepting requests for expedited examination of Canadian trademark applications. The practice notice governing such requests is entitled “Requests for expedited examination” and may be found by clicking this [link](#) (the “**Practice Notice**”).<sup>[1]</sup> Pursuant to the Practice Notice, expedited examination of a trademark application may be granted if one or more of the following criteria are met:

1. a court action is expected or underway in Canada with respect to the applicant's trademark in association with the goods or services listed in the application;
2. 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;
3. the applicant requires registration of its trademark in order to protect its intellectual property rights from being severely disadvantaged on online marketplaces; or
4. the applicant requires registration of its trademark in order to preserve its claim to priority within a defined deadline and following a request by a foreign intellectual property office. Note that in such cases the request will need to be attached to the affidavit or statutory declaration.

As of the date of this bulletin, CIPO is currently examining Canadian trademark applications filed on or around December 19, 2018 (*i.e.* trademark applications filed about 34 months ago).

In contrast, trademark applications approved for “expedited examination” proceed relatively expeditiously. Particularly, and as of the date of this bulletin:

- if there are no identifiable defects in a trademark application for which expedited examination has been requested, the trademark application may be approved within two to three weeks of the request for expedited examination;
- if an Examiner identifies a defect in a trademark application for which expedited examination has been

requested, the Examiner may issue a first Examiner's Report (or reach out to the agent of record by phone) within one to three weeks of the request for expedited examination;

- if an applicant responds to the first Examiner's Report in a manner that overcomes the Examiner's objections raised in the first Examiner's Report, then a notice of approval may be issued within two to four weeks of the date that the response to the first Examiner's Report was filed.

That being said, we anticipate that delays may occur in the future as more applicants request for "expedited examination" of their Canadian trademark applications.

*Take-away:* Consider whether you are in a position to benefit from expedited examination of your Canadian trademark application(s), and how expedited examination may factor into your trademark portfolio management and enforcement strategies. Expedited examination potentially removes years from the regular trademark prosecution timeline in Canada, and may assist you in reaching certain business goals in a much more timely manner.

by [Pablo Tseng](#) and [Lisa Moore](#)

[1] CIPO Practice Notice "[Request for expedited examination](#)" dated May 3, 2021.

### **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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