

IP roadmap

Your path through a trademark expungement (section 45) proceeding



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Requesting a section 45 notice

If a registered trademark has not been used in Canada for 3 years or longer since its registration, anyone can request that this trademark be removed from the trademark register by:

- sending a written request to the Canadian Intellectual Property Office (CIPO) for a section 45 notice to be issued to the owner of the trademark
- paying the prescribed fee



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Issuance of a section 45 notice

CIPO will issue a section 45 notice to the owner of the trademark within 2 weeks of receiving both the request and the fee.

CIPO will review the request to make sure that it's complete and that the prescribed fee has been paid. CIPO will communicate with the requesting party if there are any issues.



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Evidence

Within 3 months of receiving the section 45 notice, the owner must submit evidence that demonstrates the use of the trademark in Canada during the relevant period and serve a copy on the requesting party. If the trademark was not used, the evidence should describe the special circumstances that explain the absence of use. The evidence must be in the form of an affidavit or a statutory declaration.

What if the owner does not submit evidence?

If the owner does not submit evidence, the proceeding will move directly to the "Decision" stage and the trademark will be expunged.



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Notice for written representations

Once the owner has submitted evidence, CIPO will give the parties notice that they may submit and serve written representations.

What does it mean to "serve a copy"?

"Serving" is a special way of sending documents to the other party. For more information on how to serve your documents, please see section 71 of the *Trademarks Regulations*.



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Written representations

The requesting party has 2 months from the date of the notice to submit written representations and serve a copy on the owner.

The requesting party may choose not to submit written representations, in which case a statement that no representations will be submitted is optional. However, if the requesting party submits a statement, a copy must be served on the owner.

Why submit written representations?

Written representations are **optional**. However, they are an opportunity to present in writing arguments whether or not the evidence shows use or shows special circumstances explaining the absence of use. Written representations may refer to jurisprudence that the party wants CIPO to take into consideration.



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Written representations

The owner must submit their written representations and serve a copy on the requesting party within 2 months from the earlier of:

- the date of service of the requesting party's written representations (or statement)
- the expiry of the requesting party's deadline to submit and serve written representations

The owner may choose not to submit written representations, in which case a statement that no representations will be submitted is optional. However, if the owner submits a statement, a copy must be served on the requesting party.



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Decision

CIPO will issue a written decision in accordance with its service standards. All decisions are published on CIPO's website and are appealable to the Federal Court.



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Hearing

Either party may request an oral hearing within 1 month of the earlier of:

- the date of service of the owner's written representations (or statement)
- the expiry of the owner's deadline to submit and serve written representations

Is an oral hearing required?

No, an oral hearing is not necessary. If neither party requests an oral hearing, CIPO will issue a written decision without holding a hearing.