



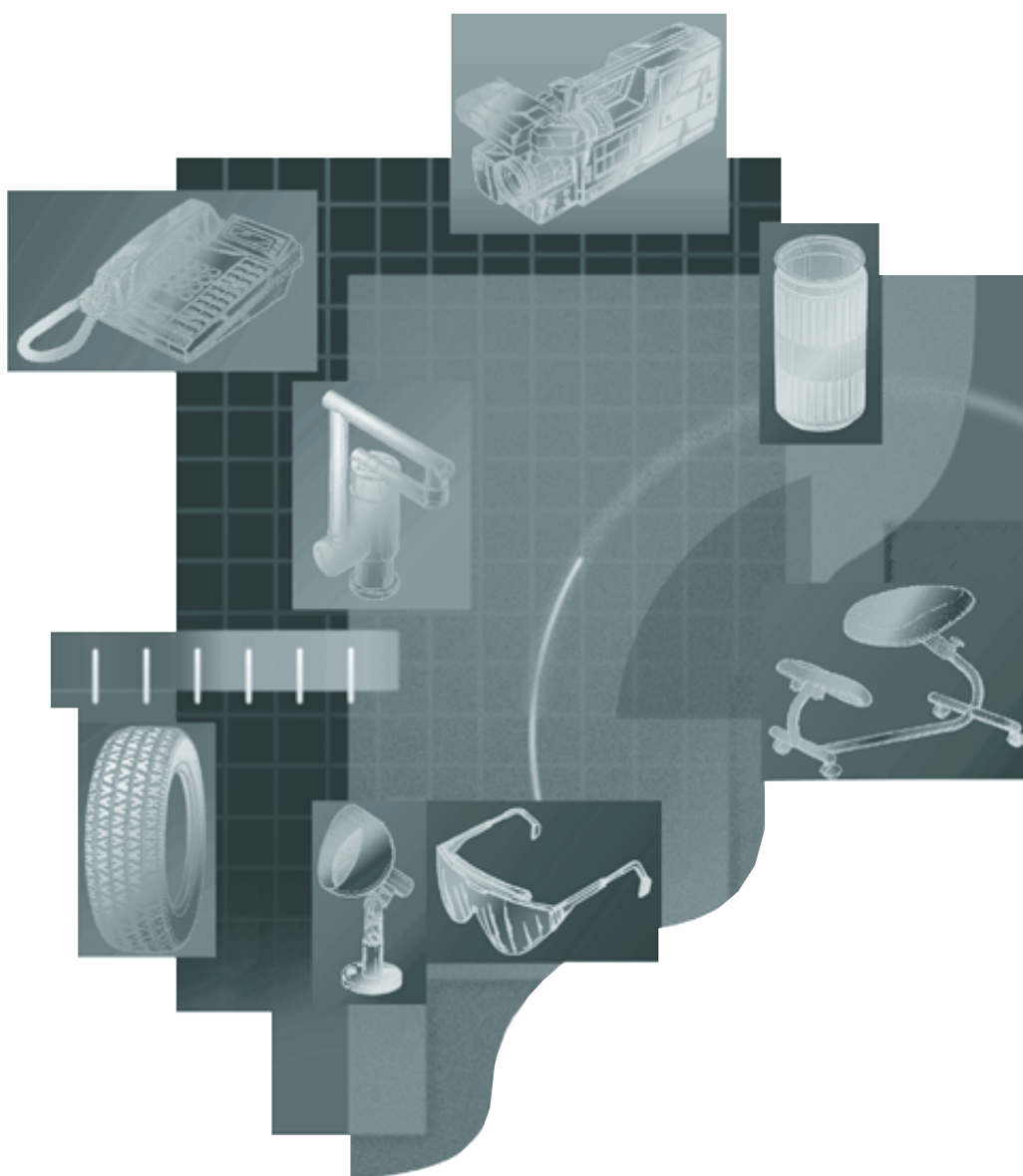
**Canadian
Intellectual Property
Office**

An Agency of
Industry Canada

**Office de la propriété
intellectuelle
du Canada**

Un organisme
d'Industrie Canada

A GUIDE TO INDUSTRIAL DESIGNS

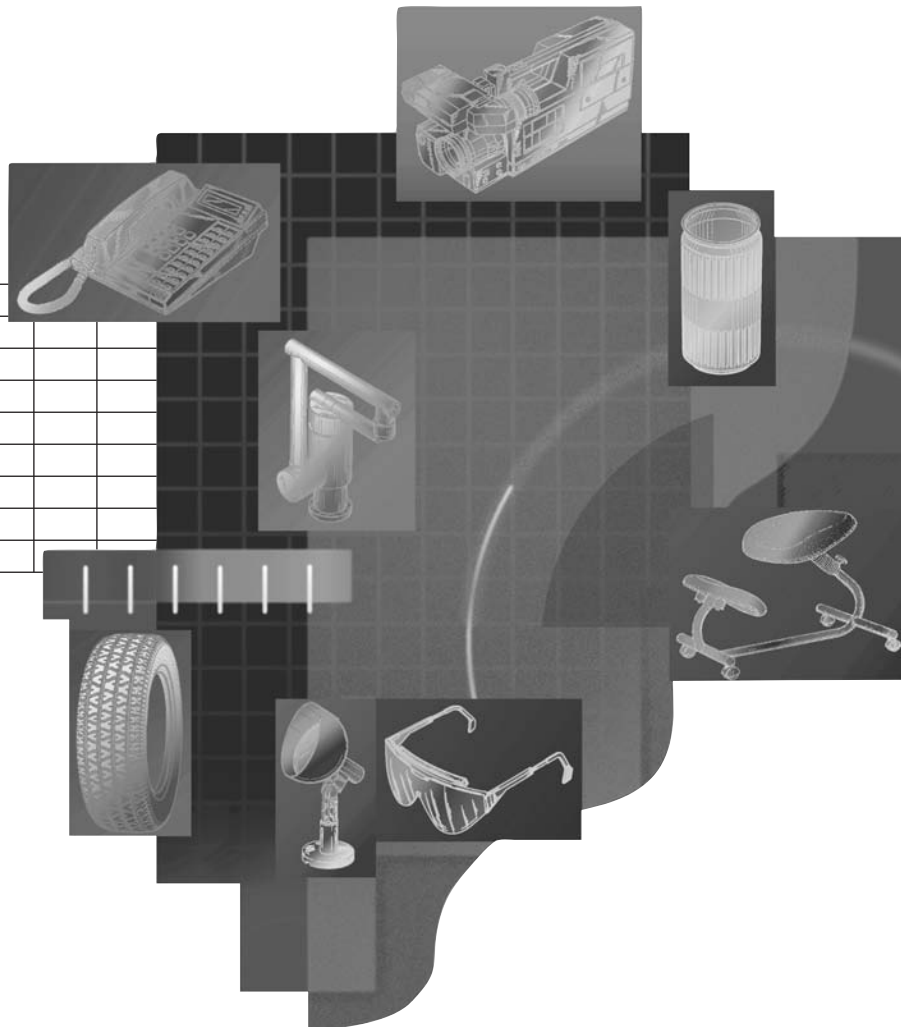


December 2003

Canada 

CIPO  OPIC

A GUIDE TO INDUSTRIAL DESIGNS



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INTRODUCTION

A well-designed chair is not just a pleasure to sit on, but a pleasure to look at as well. This can be said for almost every manufactured product: its success in the marketplace will depend not only on its functionality, but on its visual appeal as well. That is why manufacturers invest a great deal of money and know-how in industrial design and why an original design is considered valuable intellectual property.

If you are the creator of, or an investor in, an original industrial design, Canadian law offers you protection from unlawful imitation of your design. The *Industrial Design Act*, like other forms of intellectual property legislation, works to protect owners while promoting the orderly exchange of information. The way to obtain such protection is to register your design with the Industrial Design Office.

Your industrial design is worth a great deal in time and money, and it may mean the success of an entire enterprise. It pays to protect your intellectual property by knowing your rights and how to use them.

Purpose of this guide

In this guide we will look at what industrial designs are, what makes them “registerable,” the advantages of registration and how to go about it. Keep in mind that this guide offers general

information only and does not cover all the complex issues that may arise throughout the registration procedures. It should also be noted that this guide is not an authoritative guide on Canadian law regarding industrial design.

For exact definitions and detailed regulations, consult the *Industrial Design Act*, the *Industrial Design Regulations* and legal texts on intellectual property available in many libraries. The CIPO Client Service Centre can also provide further information.

The Industrial Design Office

The office responsible for registering industrial designs is the Industrial Design Office. The Office is part of a larger agency called the Canadian Intellectual Property Office (CIPO), which is part of Industry Canada. In addition to industrial designs, CIPO is responsible for other forms of intellectual property. These are:

- **patents**—cover new inventions (process, machine, manufacture, composition of matter), or any new and useful improvement of an existing invention;
- **copyrights**—provide protection for artistic, dramatic, musical and literary works (including computer programs), and three other subject-matter

known as performances, communication signals and sound recordings;

- **trade-marks**—are words, symbols, designs (or a combination of these), used to distinguish the wares and services of one person or organization from those of others in the marketplace;
- **integrated circuit topographies**—are the three-dimensional configurations of electronic circuits embodied in integrated circuit products or layout designs.

Visit CIPO's Web site

CIPO's Web site includes useful information about its product lines, services and legislative changes. The five intellectual property guides are available, as are interactive tools that explain intellectual property in an enjoyable way. You may visit the Web site at: www.cipo.gc.ca.

Also, you can now submit your industrial design application electronically via the CIPO Web site.

THE BASICS

What is an industrial design?

An industrial design is the features of shape, configuration, pattern or ornament (or any combination of these features) applied to a finished article made by hand, tool or machine. It may be, for example, the shape of a table or the shape and ornamentation of a spoon.

The design must have features that appeal to the eye and although the Industrial Design Office will not judge the aesthetic merit of those features, the Office will assess originality.

Other forms of intellectual property

People often confuse industrial designs with other forms of intellectual property.

A **copyright** is legal protection for an artistic endeavour. Often an industrial design is first created as a work of art, and as such, is originally protected by the *Copyright Act*. An artistic work is protected under the *Copyright Act* automatically, but a design is protected under the *Industrial Design Act* only if it is registered. Therefore, it may be a good idea to register your design, even if you have copyright protection for the original art. If you are in doubt about the appropriate course, it may be wise to consult a lawyer or a registered patent agent.

Patents are for new inventions or processes that offer innovative and useful functions. Canadian law regards the functional aspects and design aspects of articles quite separately. Therefore, you cannot list a function as an element of your industrial design. You may, however, be able to obtain a patent for your article's functional aspects and an industrial design for its aesthetic ones. Suppose you develop a new kind of folding chair. The way the chair folds, its lightweight construction, its strength and its durability are all functional qualities. The industrial design features could include the shape or configuration of the chair, and any patterns or ornamentation on it or any combination thereof.

Trade-marks are used to distinguish the goods or services of one person or organization from those of another. The shape of a product or its packaging can be an aspect that distinguishes it from someone else's product. You can register such a feature as an industrial design and later, in a separate process, as a trade-mark. Suppose, for example, you created a soft drink bottle with a unique shape. Initially, you could register this original shape with the Industrial Design Office, and later, once it has acquired distinctiveness, as a "distinguishing guise" (a type of trade-mark) with the Trade-marks Office. Keep in mind that for your bottle

to be considered a trade-mark, it must have been on the market for a sufficient period of time such that it has become recognized as **your** product (i.e. it distinguishes your product from others in the marketplace).

To be eligible for registration with the Industrial Design Office your design must be substantially original.

REGISTERING YOUR INDUSTRIAL DESIGN

When to file an application

There is no time limit for filing an application as long as the design has never been published. The term "published" in this context means that the design has been made public (even to your neighbours) or offered for commercial sale or use anywhere in the world. It is best to file as quickly as possible if publication has occurred. You must file within twelve months of publication or you will lose your exclusive rights to the design.

In making a decision about whether your design can be registered, the Industrial Design Office may ask for further information. Such information may be needed if it appears that:

- the design is not applied to a fully assembled finished article or set;
- users will never see the article or design in the form disclosed by the application;
- the design features are dictated solely by how the article is used; or
- the description portion of the application describes functional or manufacturing aspects rather than design features.

Why you should register

The advantage of registering your industrial design is that it gives you exclusive rights to your design. Registration enables you to prevent others from making, importing for trade or business, renting or selling or offering or exposing for sale or rent any article in respect of which the design is registered and to which the design or a design not differing substantially therefrom has been applied, for up to ten years from the date of registration. Keep in mind that, **unless you register your design**, you can make no legal claim of ownership and have no legal protection from imitation. This is different from trade-mark and copyright protection, which allow you to claim ownership even without registration.

Who can apply

Only the proprietor of a design may apply for and obtain registration for an industrial design. Usually, you are considered the proprietor if you have created the design. However, if you've been hired under contract to develop a design for someone else, then that person is the proprietor and is the only one entitled to apply for registration. If you work together with other people to create a design, you should file for

registration as joint proprietors (unless you are all working under contract or commission).

If you have acquired ownership of a design then you may apply.

If you are an employee of a company and develop a design as part of your employment, then the employer may be the proprietor. In that case only the employer may apply.

Industrial design registration is valid only if applied for and obtained in the name of the proprietor. You will save yourself time and expense by resolving the issue of ownership **before** applying for registration.

Before you file

Prior to filing an application, you may wish to conduct a search of Office records at CIPO's Client Service Centre in Gatineau, Quebec, in order to better determine whether your design is truly new and original. Staff will explain search procedures to you but will not conduct the search for you. This will give you the opportunity to see other registered designs. You should also keep your design confidential.

What you cannot register

You cannot register the following under the *Industrial Design Act*:

- designs that are utilitarian only and which are not intended to provide visual appeal;
- designs that have no fixed appearance (for example, holograms);
- designs for components that are not clearly visible (for example, features that are hidden from view or features that are too small to have appeal to the eye);
- a method of construction;
- an idea;
- materials used in the construction of an article;
- the useful function of the article (see discussion of patents in section above); or
- colour (although one can protect a pattern that may be created by an arrangement of contrasting tones).

How long the process takes

Pursuant to a provision of the *Paris Convention*, an international treaty signed by Canada, the Office does not register any design until six months after the date of filing. Normally, it takes between eight and twelve months to have your application examined.

The Office examines applications on a first-come, first-served basis. If your application is properly prepared, registration will occur as quickly as possible. But if the application is not complete or incorrectly completed, the process will take longer, in which case the speed of registration will depend very much on how quickly you respond to queries and requests for changes.

You may be granted faster service if you believe that your design has already been imitated by someone else. In such a case, the Office will proceed with examination as soon as you notify the Office in writing, providing details of the infringement.

How long registration lasts

Registration is for a ten-year term beginning on the date of registration. However, before the expiry of five years from that date, a maintenance fee must be paid or the protection will cease. Once the ten-year term has expired, anyone is free to make, import, rent or sell etc., the design in Canada.

Fees

You must pay a fee to have your application examined by the Industrial Design Office. There are additional fees for maintenance and late payment of the maintenance fee of designs.

Fees are subject to change without notice. Payment may be made by VISA, MasterCard, Interac, cheque or money order made payable to the Receiver General for Canada. (For details about Fees, see page 15.)

Getting help with your application

You may file your own application for industrial design registration, and the Industrial Design Office will give you the basic information you need to do so. The Office will not, however, prepare your application or conduct a preliminary search of existing designs for you.

The Office will not express an opinion about the aesthetic or commercial merits of your design or tell you in advance of filing whether it qualifies for registration.

Drafting an application requires much careful attention to detail and knowledge of the regulations. For this reason, you may wish to hire a patent agent to prepare and “prosecute,” that is, to follow through on your application. Most industrial design applications are done in this way. Patent agents are experienced in the field.

You may obtain a list of patent agents by contacting the Client Service Centre. The Centre will not recommend any particular agent and does not regulate their fees.

Preparing your application

An application for registration of an industrial design has three basic elements which are required by the *Industrial Design Act* and *Industrial Design Regulations*:

- the application form;
- at least one drawing or photograph of the design; and
- the required fee(s).

The application must be made in the form prescribed by the *Industrial Design Act* and *Industrial Design Regulations* which may be obtained free of charge from CIPO's Web site, the Client Service Centre or from a regional Industry Canada office. Samples of the various forms are shown at the end of this guide. If you choose to reproduce the application form, it must contain the same wording as the original.

The application form

You will find an example of a blank application form in Appendix B of this guide.

Remember the following important points when you complete your application:

- Only the current proprietor can file an application. The application form includes a declaration that you are the proprietor of the design and that, to your knowledge, no one else used the design before you or the first proprietor.

- Your application form must also include your name and complete address, the title of the article, the description, and the name and address of a representative for service in Canada, if you have no office or place of business in Canada.

- If you do not have enough room to complete your description on the first page of the application form, please continue on a separate sheet of paper. Do not finish the description on the back of the form.

Send the completed application to:

Industrial Design Office
Canadian Intellectual
Property Office
Industry Canada
Place du Portage I
50 Victoria Street
Gatineau QC K1A 0C9

Note: You can also submit your application electronically.

Any correspondence addressed to the Industrial Design Office at CIPO Headquarters in Gatineau and delivered:

1 During business hours to CIPO Headquarters, will be accorded the date of receipt that day.

2 During business hours to Industry Canada Headquarters or to one of its regional offices, will be accorded the date of receipt in that office*.

3 At any time electronically, including by facsimile, will be considered to be received on the day that it is transmitted, if received before midnight, local time, at CIPO Headquarters*.

4 Through the Registered Mail Service of the Canada Post Corporation (CPC), will be accorded the date stamped on the envelope by CPC*.

* Only if it is also a day on which CIPO Headquarters in Gatineau is open, if not, it will be considered received on the next working day.

The title

The application must include a title that identifies the finished article to which the design is applied. It should be the common name used in the trade (for example, "lighter," "chair," "spoon," "t-shirt").

The description

An industrial design is the features of shape, configuration, pattern or ornament (or a combination of these features) applied to a finished article of manufacture.

Your application must include a description which identifies the features that constitute the design.

The description, along with the drawings and title, must provide an accurate picture of the design. The following information must be clearly conveyed:

- the features of the design; and
- the article of manufacture to which the design is applied.

Your description must clearly identify the features and where they reside in the article. Only visual features of the design are to be described, i.e., features of shape, configuration, pattern or ornament (or any combination of these features). It should not refer to how the article was made, what it is made of, how it functions, its size or its dimensions.

The design may reside in the entirety of the article, or just in a portion of the article. For example, you may wish to protect the shape of the entirety of a chair, or, you may wish to protect only the shape of the arms of a chair.

You may choose to provide a detailed description which accurately describes features in detail using geometric or similar descriptive terminology. For example: “The design consists of generally rectangular arms with a convex upper surface and concave lower surface, a longitudinal groove extending the entire length of each arm on the outer side edges.”

Or, you may choose to provide a brief description which simply but clearly states what the design is comprised of by identifying the features and indicating if such features reside in the entire article or just in a portion of the article. For example: a) “The design consists of the features of shape of the arms of the chair as shown in the drawings.”; b) “The design consists of the features of shape, configuration, pattern and ornamentation of the entire chair as shown in the drawings.” (See the *Office Practice Notice* on “Descriptions” for more examples.)

Figure reference: Where the drawings or photographs contain more than one figure, a figure reference should be included at the end of the description. It serves to identify what view is seen in each figure. For example: “Figure 1 is a bottom view of the chair.”

Keep in mind that you or your agent are responsible for giving an accurate, adequate description

of your design and to ensure that it covers all of the original features of your design. The Industrial Design Office will only ensure, for the purposes of assessing registrability, that your wording is clear in conveying what the design consists of and that it accurately reflects what is shown in the drawings or photographs.

Specific things to keep in mind when writing your description:

- Reference should only be made to **visual** features, and not to features of function or construction. For example, a distinctive tread on the sole of a boot may have functional properties (to prevent slipping) as well as visual appeal (it’s in the shape of a snowflake).

- It is acceptable to highlight particularly significant features for emphasis. For example: “The design consists of the features of shape of the arms of the chair as shown in the drawings. The most significant feature is the diamond shaped recess on the top surface of each arm.”

- Whichever method you use to describe your design, it must be clear whether the features reside in the entire article or just a portion of the article.

- Since the courts may use your description to help determine the limits of protection for your design, you should word your description with care and

precision. If your description is too broad, you may overextend the scope of the design, and it may be impossible to enforce. If it is too narrow, you may limit the scope of the design or leave out features that you intended to protect.

■ More information on how to write descriptions is contained in the Office Practice Notice on “Descriptions” which is available on CIPO’s Web site and copies can also be obtained from the Client Service Centre.

Drawings and photographs

Your application must include at least one drawing or photograph of the design as applied to the finished article of manufacture.

The title, description and drawings must provide an accurate picture of the design.

A) Colour, size and quality:

Drawings must be in clear, permanent black lines on white paper. Photographs must be black and white. Colour will not be accepted. However, it is acceptable to show contrasting tone, or to use shading to give a better sense of the shape or contour.

Each sheet must be at least 21 cm x 28 cm (8” x 11”), but not more than 22 cm x 35 cm (8 1/2” x 14”). A 2.54 cm one-inch space must be left at the top and left-hand margins of each sheet.

Drawings or photographs must **not** be mounted on any other paper or surface and must be of sufficient quality for clear reproduction by photography, electrostatic processes, photo offset and microfilming. The features of the design as identified in the description portion of the application must be shown clearly and accurately.

B) Scale and orientation:

All drawings must be sufficiently large so that all features of the design are clear and apparent.

Generally, it is appropriate that all views have the same scale (except for enlargement views) and that all views appearing on the same page are oriented the same way.

Usually, the views are arranged so that the top of each view is oriented towards the top of the page. Another option, however, is to turn the page sideways and present all views with the top oriented towards one side. Different views must not overlap each other.

C) Content:

All views in the drawings or photographs must show the **complete** finished article in isolation. The article must be shown alone against a neutral (blank) background. Your drawing(s) or photograph(s) should show every feature of the design as applied to the article. You may use stippled or broken lines to disclose portions of the article that are not part of the

design, but **the design must be shown in solid lines.**

Stippled lines must **not** be used to show:

- hidden portions of the article;
- indefinite length (exception: fabric and paper products);
- a position movement of the article;
- open position of the article; or
- separation of pieces of the article.

The title, descriptive matter, dimensions or names should not be included on the drawing, but you may put your signature (as proprietor) on the lower right-hand corner of each sheet.

D) Number and type of views:

Your drawings or photographs should include as many views as are necessary to adequately disclose the features of the design. The Office will request removal of unnecessary or extraneous views which would merely clutter the Register. The conventional views are: perspective, front, back, top, bottom, right side, left side.

Each view should be numbered. They are usually referred to as: Figure 1, Figure 2, etc. (*When the drawings or photographs contain more than one figure, detailed figure references should be provided at the end of the description which indicate which view is seen in each figure, e.g., “Figure 1 is a perspective view of the design.”*)

E) Miscellaneous views:

Occasionally, you will need to include the following views to adequately disclose features that cannot be shown in the conventional views: views showing open and closed positions, cross-sectional views, fragmentary views, views showing indefinite length and repeat patterns.

Your drawings or photographs may show views of the article in both open and closed positions or in extended and retracted positions if such views are necessary to reveal design features referred to in the description, and if the article is normally seen and used in these different positions.

You may present cross-sectional or fragmentary views if this is necessary to show the exterior profile of the article not seen in other views. Indicate the exposed cut surface by oblique parallel sectional lines in the cross-sectional view. Always show where such views are taken from on the complete article. Do not use symbolic section lines to suggest a specific type of material. Indefinite length is shown by illustrating a break in the article dividing it into two portions.

If your article is made up of a number of components, the drawings or photographs should show the completely assembled article. Do not present exploded views.

Remember the purpose of the drawings or photographs is to show clearly and accurately the features of the design. More information on the requirements for drawings and photographs is available in the *Office Practice Notices* and the *Industrial Design Examination Procedures Manual* which are available on CIPO's Web site or may be obtained from the Client Service Centre.

Sample drawings

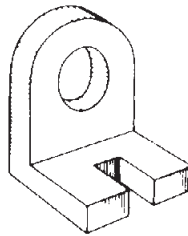


Fig. 1

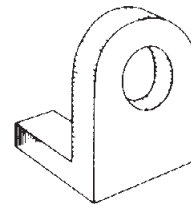


Fig. 2

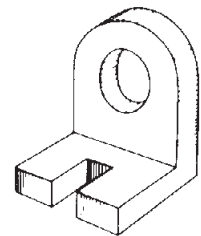


Fig. 3

(Perspective views)



Fig. 4
(side)

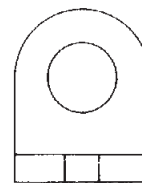


Fig. 5
(front)

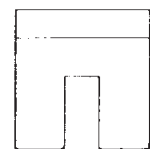


Fig. 6
(top)

Variants of the same design

Each industrial design application must be limited to a single design or to “variants.” Variants are designs which do not differ substantially from one another. To be accepted as variants, the designs must be applied to the same article, and must possess the described features without substantial variation. You may add variants of the design to your application any time before registration.

If you include designs in one application that differ to a substantial degree, an objection will be issued. You will be asked by the Industrial Design Office to choose one design and delete the rest from the application. You would then have the option to file a new application (with filing fee) for any design deleted from the initial application. In this case the filing date of the new application will be the same as the original application.

It is also important to remember that if you make amendments to your description or drawings after filing the application, you may not change the design in any substantial way. If you do, the new description or drawings will be rejected. If you wanted to proceed with the amended design, you would have to submit a new application which would receive a new filing date.

THE PROCESS

The process of obtaining a design registration is made up of three distinct phases:

- initial processing (when you first file the application);
- examination; and
- registration.

Initial processing

Your application will undergo a preliminary review by staff to ensure that basic administrative requirements have been met. If the application is complete a filing certificate will be issued; this is merely an acknowledgment that the application has been received and processed and a filing date issued. It also gives you the number assigned to your application so that you can refer to that number in later correspondence. If the application is incomplete you will also receive a report, advising you of what is required to complete it.

Every report issued by the Office will give a due date for reply. If you do not reply by that due date your application will be considered abandoned.

Examination

The first step in this phase of the process is the classification of your application according to the particular type of article to which it relates. This is followed by a

formal assessment by an examiner who will study your description and drawings or photographs. These will then be compared with previously registered Canadian designs and designs published anywhere in the world to ensure that your design is original and registrable. Your design cannot be the same or similar to a design already applied to a similar article of manufacture. The wording of the description will also be considered to see that it accurately and adequately describes the design features shown in the drawings. Following this assessment the examiner will either allow (approve) the application for registration or issue a report. The report will outline the examiner's findings and tell you what information or amendments are required.

Amendment

If the examiner does express objections about your application, you should respond by providing the requested information or making the suggested amendments. Do not think that you must abandon your application simply because an objection has been raised. If you do not understand the report completely, call the examiner for clarification. The telephone number will be given on the report. You will have four months to reply to the report, otherwise

your application will be considered abandoned. If this occurs, you can request that your application be reinstated and include a reply to the examiner's report.

Appeals

If you do not rectify deficiencies in the application or overcome any outstanding objections raised in the examiner's report(s), your application will be deemed unregistrable in a final report issued by the Office. You may appeal this final report to the Patent Appeal Board which will make recommendations to the Commissioner of Patents who will either reverse the Office decision or reaffirm it in a final rejection. If you are still not satisfied, you may appeal the final rejection to the Federal Court of Canada whose decisions are appealable, in turn, to the Supreme Court of Canada.

Conflicts

Should different people apply to register essentially the same design, the Industrial Design Office will examine the applications on a first-come, first-served basis. The application with the earlier filing date (either the Canadian filing date, or the Convention priority date, if filed earlier in another country) will be registered.

Requests for delayed registration

It is possible that you may want to delay registration. For example, you may wish to allow time to market or file your design outside Canada. In this case, you should inform the Office in writing. You may exercise the option to delay registration at the time of filing your application or at any time before it is registered.

proprietor or by the proprietor's agent and may be made at any time during the first five-year period. After the five-year point, a six-month grace period exists during which maintenance may still be requested but this requires payment of an additional fee. Your request should identify the registration by number, title and name of proprietor. (For details about Fees, see page 15.)

Registration

Once approved by the examiner your design will be registered as soon as possible provided you have not requested delayed registration. You will receive a certificate of registration which includes the completed application form and the drawing(s) of the registered design. This certificate is evidence of ownership and the originality of your design and gives you the exclusive right to make, import for trade or business, rent or sell or expose for sale or rent in Canada, any article in respect of which the design is registered and to which the design is applied.

Duration

Registered designs are valid for ten years from the date of registration subject to payment of a maintenance fee. That fee shall be paid by the registered

OTHER PROCEDURES

Marking a product

You do not have to mark your design in order to indicate that it is registered as a design, but marking does give you extra protection. The proper mark is a capital "D" inside a circle and the name, or abbreviation thereof, of the design's proprietor on the article, its label or packaging.

If your product is marked in this way, a court could award a remedy, such as financial compensation, in the event that someone is charged and found to be "infringing" (i.e. violating) your design. If there is no such mark, the court cannot award a remedy other than forbidding the other party from using your design (an "injunction").

Enforcing your rights

As proprietor, you may take legal action against anyone who infringes your design in Canada. It is your responsibility to take such action and you must do so within three years of the alleged infringement. The Industrial Design Office will not assist in legal proceedings on your behalf or police your rights in any way.

Marketing rights

As the proprietor of a registered industrial design, you have the exclusive right in Canada to

make, import for trade or business, rent or sell a product incorporating that or a similar design. You may also sell all or some of your rights to others (this is referred to as an assignment) or, you can simply authorize others to use the design subject to stated conditions (this is referred to as a licence).

Assignments

An "assignment" occurs when you sell all or part of your rights in the design permanently to another party. This party, or "assignee," assumes your ownership rights to make, import for trade or business, rent or sell, etc., products incorporating the registered design and to authorize others to do so. Usually, the arrangement involves an exchange of money. The assignment must be in writing but there are no prescribed forms for this. You may wish to seek the assistance of a lawyer in the preparation of assignment documents.

The new owner should ensure that the assignment is recorded with the Industrial Design Office. This is done by sending in a copy of the assignment document along with the fee. (For details about Fees, see page 15.)

Recording the assignment allows the new owner to sue for damages if anyone infringes the design.

Assignments may be recorded against pending or registered designs. When recorded against a pending design, a new application form in the name of the new owner must be filed.

Licences

In some cases financial benefit can come from licensing the design. When you license your design, you allow someone else to use it in accordance with the particular terms and conditions set out in the licence agreement which are negotiated between the parties. In this case you retain ownership and, you can, in some instances, license more than one party. You may, for example, license one party for Western Canada, another for Ontario and Quebec and still another for the Maritimes. Similarly, you could have an exclusive licence with one party for the first five years and another licence with a different party for the second five-year period. As with assignments, licences should be registered.

You may wish to seek the advice of a lawyer if arranging a licence agreement.

Note: If you wish to seek out Canadian manufacturers who might be interested in buying, licensing or leasing your design rights, two publications would be useful: the *Canadian Trade Index*,

issued by the Canadian Manufacturers' Association, Toronto; and *Fraser's Canadian Trade Directory*. Both are available in public libraries.

Registration outside Canada

Registering your design with the Industrial Design Office gives you exclusive rights in Canada only. To enjoy similar rights abroad, you must apply for them in each country separately. Most industrialized countries have equivalent industrial design protection. A list of our foreign counterparts is available from the Client Service Centre.

The United States uses the term “design patent” to describe what roughly corresponds to the Canadian registered industrial design. Be careful not to confuse U.S. design patents with utility patents for inventions.

Procedures for obtaining international design rights are partially governed by an international treaty called the *Paris Convention for the Protection of Industrial Property*. The *Paris Convention*, which has some 90 member countries, including Canada, allows applicants to invoke what is called “convention priority.” This means that someone who has filed for design registration in one Convention country has six

months in which to file an application for the design in another country and be accorded the same rights as if he or she had filed in the second country on the original filing date.

Suppose, for example, you apply to register a design in Canada on January 5, 2000. You then have until July 5, 2000, to file for design rights in any other Convention country and claim convention priority in that country.

It is important to note that in some countries your application could be rejected if you or someone else has previously registered the design. To assist owners of designs in Canada in avoiding this unusual situation, the Industrial Design Office gives applicants the option of delaying registration so that their application in another country can proceed at the same time as their application in Canada.

FOR MORE INFORMATION

The *Industrial Design Act* and *Industrial Design Regulations* detail the regulations that govern design rights. For electronic access: www.canada.justice.gc.ca

To obtain paper copies, contact:

Canadian Government
Publishing
Public Works and Government
Services Canada
Ottawa ON K1A 0S9

Tel.: (819) 956-4800
1 800 635-7943
Fax: (819) 994-1498

or any bookstore that sells federal government publications.

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You can also consult or obtain guides similar to this one on other kinds of intellectual property (e.g. patent, trade-mark, copyright, and integrated circuit topography), on our Web site or directly from the Client Service Centre. It may be useful to consult these guides to ensure that your work can be protected under the *Industrial Design Act* rather than copyright, trade-mark or patent laws.

For more information contact us through the CIPO Web site or contact the nearest regional Industry Canada office (shown in the blue pages of your telephone directory), or write to:

Client Service Centre
Canadian Intellectual
Property Office
Industry Canada
Place du Portage I
50 Victoria Street
Gatineau QC K1A 0C9

Should you wish to obtain information on industrial design by telephone, call the Client Service Centre at (819) 997-1936.

TARIFF OF FEES

Tariff of fees

- 1** Examination of an application to register a design pursuant to subsection 4(1) of the Act \$160
- 2** Maintenance of a registration of a design pursuant to subsection 18(1) \$215
- 3** Supplementary fee for the application for maintenance of a registration of a design pursuant to subsection 18(2) \$35
- 4** Examination of an application to register an assignment, or any other document affecting a design, including registering the assignment, or other document and issuing a certificate of registration thereof pursuant to subsection 13(1):
- (a) for the first design referred to in the assignment, or in the other document; and \$35
- (b) for each additional design referred to in the assignment, or in the other document ... \$15
- 5** Providing copies of or extracts from the Register of Industrial Designs, or copies of certificates, drawings, drawn copies of designs or other documents
- (a) for each photocopied page; and \$0.50
- (b) for each typed page \$5
- 6** Certification of documents .. \$15

NOTE: YOU DO NOT NEED TO ADD ANY TAXES TO THESE FEES.

New fees effective January 1, 2004

- 1** Examination of an application to register a design pursuant to subsection 4(1) of the Act:
- (a) basic fee \$400
- (b) plus, for each page of drawings in excess of 10 pages \$10
- 2** Maintenance of a registration of a design pursuant to subsection 18(1) or (2) ... \$350
- 3** Maintenance of a registration of a design pursuant to subsection 18(2) \$50
- 4** Recording an assignment or any document affecting a design pursuant to subsection 13(1), for each design \$100
- (a) for the first design referred to in the assignment, or in the other document N/A
- (b) for each additional design referred to in the assignment, or in the other document N/A
- 5** Providing a copy in paper form of a document, for each page:
- (a) where the user of the service makes the copy using Office equipment \$0.50
- (b) where the Office makes the copy \$1
- for each typed page N/A
(Repeal)
- *6** Providing a copy in electronic form of a document:
- (a) for each request \$10
- (b) plus, for each design to which the request relates \$10
- (c) plus, if the copy is requested on a physical medium, for each physical medium requested in addition to the first \$10
- 7** Providing a certified copy in paper form of a document:
- (a) for each certification \$35
- (b) plus, for each page \$1
- **8** Providing a certified copy in electronic form of a document:
- (a) for each certification \$35
- (b) plus, for each design to which the request relates \$10
- 9** Delaying registration \$100
- 10** Reinstatement of an abandoned application \$200
- 11** Issuance of a correcting certificate required as a result of an error not committed by the Office \$50
- 12** Processing a request for accelerated examination of an application to register a design \$500
- *Note: This service will be available in the near future for documents which already exist electronically.
- **Note: This service will be available at a later date.

APPENDIX A - COMMON QUESTIONS ABOUT INDUSTRIAL DESIGNS

Q1. What is an industrial design?

A. An industrial design is the features of shape, configuration, pattern or ornament (or any combination thereof) applied to a finished article. It may be, for example, the shape of a table or the ornamentation on the handle of a spoon. The article can be made by hand, tool or machine.

Q2. Must I register my industrial design in order to be protected?

A. Yes, there is no protection without registration. Once registered, industrial designs are available for public inspection. Keep in mind that it is best to apply for registration before marketing your product. If your design is an artistic work, it is automatically protected by a copyright, and you can register it as such. However, in most cases if you use the design as a model or pattern to produce 50 or more manufactured articles, you can protect it only by an industrial design registration.

Q3. How long does registration last?

A. Obtaining registration for an industrial design will give you exclusive rights for a period of ten years from the date of registration, subject to payment of a maintenance fee during the first five years.

Q4. What cannot be protected by an industrial design?

A. The following cannot be protected:

■ a manufacturing process;

■ functional features of an article;

■ a principle of construction, or how an article is built;

■ the materials used in the construction of an article;

■ the useful purpose the design is intended to serve or does serve;

■ colour per se; or

■ ideas.

Q5. Can I register my design as an artistic work under the Copyright Act?

A. If your design was originally created as a work of art, it would have been protected automatically under the Copyright Act. But once you use it, or intend to use it, as a model or pattern to produce more than 50 single useful articles or sets of articles, in most cases it is considered to be an industrial design, which can only be protected under the Industrial Design Act. Since the legal distinction is a fine one, it is advisable to seek legal advice on this matter (as there are some exceptions to the preceding).

Q6. If I register my design in Canada, am I protected in other countries?

A. No. You can obtain protection in other countries only by filing in each country separately.

Q7. Is there a time limit for filing an application for registration?

A. No, unless there has been “publication” (i.e. the design has been made public or offered for commercial sale or use anywhere in the world). In that case, you must file an application within twelve months of the publication date.

Q8. What do I need in order to apply for industrial design registration?

A. You should send in a completed application form, at least one drawing or photograph and the fee. Your application must be in accordance with the form entitled “Application for Registration of a Design,” which is included in Appendix B of this guide. Electronic filing is also possible via our Web site.

Q9. What type of description do I need to include?

A. The description does not have to detail every aspect of the design, but it must state clearly what the design is and what its original features are. You should describe the visual aspects of the design only, i.e., shape, configuration, pattern or ornament (or any combination thereof). Do not refer to how the article functions or performs. For a more detailed explanation of descriptions consult the “Office Practice Notice on Descriptions” available on the Web site or from the Client Service Centre.

Q10. What type of drawings or photographs are necessary?

A. Whether you submit drawings or photographs, they must be in black and white, on good quality paper or photographic paper respectively, at least 21 cm x 28 cm (8" x 11") and not more than 22 cm x 35 cm (8 1/2" x 14"). They must show the design features clearly and be easy to reproduce by photography, electrostatic processes, photo offset and microfilming.

Q11. If I have a registered design, do I have to put any marking on the articles to indicate this?

A. Marking is not required. However, it is helpful in the event of a court proceeding. If there is no mark, the court cannot award a remedy other than an injunction, which will prevent further infringement on your design. The proper mark is a capital "D" in a circle and the name, or abbreviation thereof, of the design's proprietor on the article, its label or packaging.

Q12. If I see a good design outside Canada and it does not appear to be on the market in Canada, can I register that design under my name here?

A. Yes, if you have acquired ownership of the design and it has not been published anywhere in the world for more than one year.

Q13. How will the Industrial Design Office know if I did not originate the design?

A. The examiner searches through records of registered Canadian designs and published designs from any source to determine whether anyone else already owns the design, or one so similar that yours would be considered an imitation. If so, your application will not be acceptable for registration. If the search does not disclose a similar design, your declaration of originality will be accepted and the design registered provided all other requirements are met. It should also be noted that the courts have the power to overturn an invalid declaration at a later date.

Q14. Can anyone do a search through the Industrial Design Office records to see what has been registered previously?

A. Yes, anyone can conduct a search free of charge. All materials are located in the Search Room at the Client Service Centre, in Gatineau, Quebec. Staff will give you the basic information you need to do the search. You may also obtain copies of drawings and other documents at a nominal fee (see the previous section entitled Fees).

Q15. May non-Canadians register their designs in Canada?

A. Yes, provided that Canadian requirements are met.

Registrations of other countries offer no protection in Canada although they may be used as prior art when determining originality.

Q16. If I sell or purchase rights to a design, do I need to inform the Industrial Design Office?

A. It is advisable to register the sale of rights, or "assignment," as it is known, with the Industrial Design Office. Many legal text writers have expressed the opinion that registration of an assignment would be necessary before the new owner could sue anyone for infringing the design.

Q17. Would the Industrial Design Office stop someone else from infringing my design?

A. No. This responsibility rests with the owner of the design. You must start any legal action within three years of the alleged offence.

Q18. Can I get help in filing an application for industrial design protection?

A. Yes. Information on procedures for filing an application can be obtained from the Client Service Centre. Also, there are registered patent agents you can consult who have experience in this area. Look for them in the yellow pages of the telephone book under "Patent Agents," or write to the Client Service Centre (see section entitled "For more information").

APPENDIX B - INDUSTRIAL DESIGN FORMS



**Office de la propriété
intellectuelle
du Canada**

Un organisme
d'Industrie Canada

**Canadian
Intellectual Property
Office**

An Agency of
Industry Canada

Direction du droit d'auteur
et des dessins industriels
Place du Portage I
50, rue Victoria
Gatineau (Québec) K1A 0C9
Téléphone : (819) 997-1936
Télécopieur : (819) 953-6977
Internet : www.opic.gc.ca

Copyright and Industrial
Design Branch
Place du Portage I
50 Victoria Street
Gatineau QC K1A 0C9
Telephone: (819) 997-1936
Facsimile: (819) 953-6977
Internet : www.cipo.gc.ca

DEMANDE D'ENREGISTREMENT D'UN DESSIN INDUSTRIEL

APPLICATION FOR REGISTRATION OF AN INDUSTRIAL DESIGN

Le demandeur,
The applicant, _____,
(nom du demandeur - name of applicant)

dont l'adresse complète est
whose complete address is _____

demande l'enregistrement d'un dessin pour un(e)
hereby requests registration of a design for a(n) _____
(désignation de l'objet - title identifying article)

dont il est le propriétaire.
of which the applicant is the proprietor.

À la connaissance du propriétaire, personne d'autre que le premier propriétaire du dessin n'en faisait usage
lorsque celui-ci en a fait le choix.

The design was not, to the proprietor's knowledge, in use by any person other than the first proprietor at the
time the design was adopted by the first proprietor.

Description du dessin :
Description of the design:



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d'Industrie Canada

**Canadian
Intellectual Property
Office**

An Agency of
Industry Canada

À remplir seulement si le demandeur a un mandataire
To be completed only if an applicant has an agent

Nom du mandataire / Name of agent
Adresse du mandataire / Address of agent

Lorsque le demandeur n'a pas
d'établissement au Canada, le
nom et l'adresse de son
**REPRÉSENTANT AUX FINS DE
SIGNIFICATION** au Canada
doivent être indiqués.

If an applicant has no place
of business in Canada, the
name and address of a
REPRESENTATIVE FOR SERVICE in
Canada must be provided.

Nom du représentant aux fins de signification / Name of representative for service
Adresse au Canada du représentant aux fins de signification / Address in Canada of representative for service

Direction du droit d'auteur
et des dessins industriels
Place du Portage I
50, rue Victoria
Gatineau (Québec) K1A 0C9
Téléphone : (819) 997-1936
Télécopieur : (819) 953-6977
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An Agency of
Industry Canada

Dessin industriel Industrial Design

Certificat d'enregistrement

Certificate of Registration

N° d'enregistrement :
Registration No.:

Document :
Document:

Avant trait :
Affecting:



Membre du personnel du bureau du commissaire aux brevets /
Officer of the Office of the Commissioner of Patents

Date

Canada

OPIC - CIPO 32 (11-2003)

OPIC  CIPO

APPENDIX C – GLOSSARY

Abandonment – An application for an industrial design will be considered abandoned if the applicant fails to reply within the specified time to any report which sets out objections to registration.

Application – The formal request for an industrial design. The complete application has five main elements: description, title, drawings or photographs, declaration and fees.

Assignment – The permanent transfer of design rights from the owner to another party.

Canadian filing date – The date your completed application is officially received at the Industrial Design Office (not to be confused with the registration date at the end of the process).

Canadian Intellectual Property Office (CIPO) – The federal government agency responsible for industrial designs and other forms of intellectual property, including patents, trade-marks, copyrights and integrated circuit topographies.

Certificate of registration – Official confirmation that your design has been registered.

Convention priority – A protocol that gives you six months to file for design registration outside Canada after your Canadian filing date.

Convention priority applies in countries that have signed the *Paris Convention* (see definition below).

Copyright
Provide protection for artistic, dramatic, musical or literary works (including computer programs), and three other subject-matter known as: performances, sound recordings and communication signals.

Declaration – Formal statement that you are the proprietor (see definition) of the design and that, to your knowledge, no one else was using the design when you created it.

Description – A description is a basic requirement of an application for an industrial design. It identifies the features of shape, configuration, pattern or ornament that comprise the design, and indicates whether the design resides in the entire article or a portion.

Design patent – The term used in the United States to describe a form of protection similar to that of industrial design protection in Canada.

Drawings – Drawings or photographs disclose the industrial design and are a basic requirement of a design application.

Examination – The process through which the Industrial Design Office determines whether a design warrants

registration. The main objective is to determine that the design is indeed design subject-matter, that it is original and that the documentation meets the requirements of the Act and Regulations.

Industrial design – The visual features of shape, configuration, pattern or ornament (or any combination of these features), applied to a finished article of manufacture.

Industrial Design Act – Legislation governing registration and ownership of industrial designs in Canada.

Industrial Design Office – The office within the Canadian Intellectual Property Office responsible for registration of industrial designs.

Infringement – Violation of industrial design rights through unauthorized use of a design.

Licensing – The granting from the owner of a design to another party, certain rights related to the design. This may include such things as the right to use, manufacture and sell the design.

Maintenance fee – Fee required in order to maintain the rights to an industrial design for a second five-year period.

Marking – Signalling that a design is registered by placing a capital “D” in a circle – along with the name, or abbreviation thereof, of the design’s proprietor on the object to which the design has been applied, or to its label or packaging.

Paris Convention for the Protection of Industrial Property – An international treaty on intellectual property signed by some 90 nations, including Canada.

Patent – Covers new inventions (process, machine, manufacture, composition of matter), or any new and useful improvement of an existing invention.

Prior art – The body of registered industrial designs or other published designs including catalogues, manuals and other publications throughout the world relevant to the application for registration of a design.

Proprietor – The proprietor of an industrial design is the owner of the design. This can be the person who created it or who paid to have it created or who bought the design rights from the owner.

Publication – Publication of a design is the act of making it public or available for commercial sale or use anywhere in the world.

Registration – The granting of formal recognition of an industrial design by the Industrial Design Office. This provides protection against imitation and unauthorized use of the design effective from the date of registration.

Representative for service – A person in Canada appointed by the applicant or registered proprietor to receive documents on his/her behalf.

Search – The act of searching through registered and published designs in the Industrial Design Office records to verify whether a design is original.

Trade-mark – A word, symbol or design (or a combination of these), used to distinguish the wares or services of one person or organization from those of others in the marketplace.