

# **INDUSTRIAL DESIGN**

## **OFFICE PRACTICES**

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## **1. CORRESPONDENCE**

### **1.1 Delivery to the Commissioner**

Mail delivered to CIPO's offices in Gatineau during business hours, or to one of Industry Canada's regional offices, will be considered to be received on the date of reception in that office.

Mail delivered to a regional office on a day when CIPO's offices in Gatineau are closed will be considered to be received on the next working day for CIPO.

Mail delivered through Canada Post's Registered Mail Service will be considered to be received on the date stamped on the envelope by Canada Post Corporation.

For a list of "designated establishments" see the CIPO Web site under "About Us" at: [http://strategis.gc.ca/sc\\_mrksv/cipo/corp/mod\\_cor\\_proc-e.html](http://strategis.gc.ca/sc_mrksv/cipo/corp/mod_cor_proc-e.html)

For practices regarding statutory holidays and time limits for filing documents, see the CIPO Web site at: [http://strategis.gc.ca/sc\\_mrksv/cipo/corp/gi\\_dies\\_non-e.html](http://strategis.gc.ca/sc_mrksv/cipo/corp/gi_dies_non-e.html)

### **1.2 Transmission by electronic means**

Industrial design applications may be e-filed through the CIPO Web site. The date of receipt will be considered to be the date of receipt by Strategis if that date is a business day. Otherwise, it would be the next business day.

Industrial design applications may be delivered by facsimile to the Industrial Design Office. The date of receipt will be considered to be the date of receipt of the fax transmission if that date is a business day. Otherwise, it would be the next business day.

### **1.3 General rules**

The Industrial Design Office will correspond with the applicant unless an agent has been appointed, in which case the Office will correspond only with the agent.

If the applicant decides to appoint an agent after the application has been submitted, an "Appointment of Agent" will be required.

If there is a change of agent during the prosecution of the application, a "Revocation of Agent" and a new "Appointment of Agent" will be required.

The correspondence will be in the language of the application, either English or

French.

#### **1.4 Third party correspondence**

The Industrial Design Office will not correspond with a third party. The Office will correspond only with the applicant or their agent.

For a third party protest: The third party will be advised in writing that the letter was received but no response or comments will be made concerning the design.

## **2. FILING DATE REQUIREMENTS**

### **2.1 Name/address of the applicant and if agent, the name/address of agent**

The Industrial Design Office requires a mailing address to send correspondence to. If the applicant has an agent, the Office requires at least the agent's address. If there is no agent and the applicant has not provided a mailing address, the application will not have a filing date.

### **2.2 Title identifying the finished article**

The applicant is required to provide a title that identifies the article.

### **2.3 Description identifying features that constitute the design**

The applicant is required to provide a description that describes the features that the design is comprised of, or at a minimum, that identifies the design as that which is disclosed in the drawings, e.g., "The design is as shown in the attached drawings."

### **2.4 Drawings and Photographs**

At least one drawing or photograph is required that is of sufficient clarity to see the article and the design.

## **3. OTHER FILING INFORMATION**

### **3.1 Filing date for a divisional**

In the case of a design initially disclosed in an application, i.e., "parent" application that is later filed as the subject of a separate application, i.e., "divisional" application, the filing date for the divisional will be the same as the filing date for the "parent" application.

### **3.2 The fee as per Item 1 of the Tariff of fees**

For filing date purposes, the fee is not required. However, after the application has a filing date and the filing certificate has been sent, no further office action will take place until the fee is received.

### **3.3 Form set out in Schedule 1 of the *Regulations***

For filing date purposes, the application does not need to be in the prescribed form as long as the information prescribed by Section 11 is provided in the documentation filed (which includes the covering letter).

### **3.4 Priority**

#### **3.4.1 Canada's obligation under the Paris Convention**

Canada is a signatory to the Paris Convention. One provision of the Convention provides for a six-month period within which an application to register a design in a Convention country may be filed in other Convention countries. If filed during the six-month period, the application has the same force and effect as if it had been filed in the second country on the first date.

The Industrial Design Office meets the priority obligations of the Paris Convention and complies with Section 29 of the *Industrial Design Act* by waiting to register a design until the six-month anniversary date of the filing of the application or of the priority date, whichever is earlier.

Applicants should be aware that some countries might reject an industrial design application because the design has already been registered in another country. To help owners of designs in Canada avoid this, the Office allows applicants the option of delaying registration so that the applicant may file the application in another country. (*See 11. Delay of Registration.*)

#### **3.4.2 Requirements for claiming the benefit of Convention priority**

In accordance with section 29 of the *Industrial Design Act*; in order for an applicant (proprietor) to make a request for priority based on an earlier filed application in or for a foreign country, the foreign application must be the earliest filed application for the registration of the same industrial design, and the request must be filed

with the Commissioner of Patents within a period of six months from the date of filing of the foreign application.

Subsection 20(1) of the *Industrial Design Regulations* requires that a request for priority be made in writing including:

- the name of the country in or for which the application was filed
- the foreign application number
- the filing date of the foreign application

The Office considers that in order for an applicant (proprietor) to make a claim for priority based on an earlier filed application, both the request for priority and all of the priority information required by subsection 20(1) of the *Industrial Design Regulations* must be filed within a period of six months from the date of filing of the foreign application. Therefore, if any or all of the required priority information (as listed above: a request in writing, the foreign application number, the name of the country and the filing date) is not provided, it cannot be rectified by the Office after the expiry of the six-month period specified in subsection 29(1) of the *Act*.

If the Office is advised that a clerical error was made in the priority request or priority information concerning the name of the country, the application number, or the filing date of the earlier application, the Office may permit an amendment to correct the clerical error appearing in the priority information under section 20 of the *Act* either before or after the six-month period specified in subsection 29(1) of the *Act*.

Foreign country – A definition of “foreign country” is provided in subsection 29(2) of the *Act*. The countries in or for which an earliest application may serve as the basis for priority are as follows:

- i) any country that is a member of the Union for the Protection of Industrial Property constituted under the Paris Convention;
- ii) any member of the World Trade Organization (established by Article 1 of the WTO Agreement);
- iii) Benelux (since the *Uniform Benelux Design Law* came into effect); and
- iv) any country for which there is an international deposit in the International Bureau of the World Intellectual Property Organization (WIPO) made under the Hague Agreement. In this case, the request must indicate that the basis for priority is an international deposit and must name the country or countries for which it has been filed. Wording such as the following is suggested: “International deposit for (*name of country/ies*).”

The Office will accept the name of the foreign country, e.g., FRANCE or the twoletter

code, e.g., FR from the WIPO standard (Standard ST.3). The WIPO code list is available through the WIPO Web site.

Note: The European Community is a member of the WTO and a priority request may be based on an application filed with the OHIM (Office for Harmonization in the Internal Market) for a European Community design. In this case, the priority request must be clear that the application was filed for the European Community.

### **3.4.3 Priority right in respect of only certain figures in the drawings**

In the case of an industrial design application with a priority claim where the applicant specifies that priority is claimed with respect to only certain figures in the application (not all figures):

- if all of the figures in the application are considered to disclose the same design (either one design or variants): the priority right is considered to apply to the entire application, i.e., the entire Canadian application is deemed to have the same force and effect as if filed on the filing date of the priority application.
- on the other hand, if the figures in respect of which priority has been claimed disclose a design that is substantially different from the design disclosed by the other figures: the latter figures must be removed from the application and could be made the subject of a divisional application. The priority right is considered to apply to the "parent" application, but would not apply to the divisional, i.e., the divisional is not deemed to have the same force and effect as if filed on the filing date of the priority application. The filing date of the divisional application would be the same as the filing date in Canada of the parent.

### **3.4.4 Priority right in the case of citation of a pending design**

If prior to the registration of a design with a priority claim another application is filed for a design, which is considered to be similar (a citation), the Office will notify the applicant requesting priority that a similar pending design exists and will also request a certified copy of the foreign application and a certificate from the foreign office showing the date of filing in that country (refer to Section 20.2 of the *Industrial Design Regulations*).

- If the certified copy shows that the foreign application does not include all of the figures shown in the Canadian application, but those figures disclose variants, the priority will apply to the entire Canadian application.
- If the certified copy shows that the foreign application relates to a different design than that of the Canadian application, the priority right will not apply to the Canadian application.



#### **4. REQUEST FOR ACCELERATED EXAMINATION**

The Industrial Design Office will process a request for accelerated examination in cases where an applicant has knowledge of someone infringing on the applied-for design and wishes their application to be examined and registered as quickly as possible in order to protect the exclusive right in the design.

In order to accelerate examination in such a case, the Office requires a written request providing a brief explanation regarding the suspected infringement as well as payment of the fee under Item 12 of the Tariff of Fees.

If these requirements are met, the application will be pulled from its routine order in the pending inventory and will be processed and examined on an expedited basis. It is important to note that if the application is in compliance with formal requirements it will move more quickly through the process. Applicants are also reminded that an application can be registered no earlier than six months after filing due to priority obligations under the Paris Convention.

#### **5. CLASSIFICATION AND SEARCH**

##### **5.1 Classification**

Each design is classified according to the Canadian classification system in order to provide a means for searching designs. Classes are assigned based on the particular type of article to which the design is applied, e.g., a design for a hockey helmet would be classified in the head-wear sub-class of the apparel class.

It is important that the application indicate clearly what the article is so that the design can be accurately classified. For articles with a very specialised area of use or of a very technical nature, it is helpful if the applicant can provide information about the nature of the article and its area of use. Such information can be provided in a covering letter. In cases where it is not clear what the article is and how it should be classified, the Office will request further information from the applicant.

##### **5.2 Search**

In order to assess the originality of a design, a search is done of registered designs and published art in the appropriate class(es) according to the Canadian classification system.

A search will only be conducted if it is clear from the title, description and drawings what the design is. A preliminary examination of the application will

determine whether or not the design is clear. If it is not, the examiner will issue a report notifying the applicant that the search will be delayed until an amended application is received which is clear as to what the design consists of. Any deficiencies in formal requirements will also be brought to the attention of the applicant.

## **6. EXAMINATION**

### **6.1 Industrial design subject matter**

Industrial design means:

Features of shape, configuration, pattern, ornament, or any combination of these features that are applied to a finished article.

This includes:

designs applied to articles that are sold separately, even if they are not normally used on their own. For example, a zipper is sold as a separate article, but in normal use, it is part of another article such as a piece of clothing or a handbag;

designs applied to combined articles consisting of two or more components which come apart and are separate articles in themselves, provided that such components combine to make a finished article, e.g., tray with lid;

electronic icons embodied in a finished article;

designs applied to “sets” as defined in section 2 of the *Industrial Design Act*;

designs applied to finished articles assembled from a kit, as per the definition of “kit” in section 2 of the *Industrial Design Act*;

designs applied to portable buildings and structures — preformed, portable and delivered to purchasers as finished articles, or in sections to be put together by a simple operation such as bolting; and

designs applied to articles of indefinite length such as fabric and wallpaper.

Industrial design does NOT apply to:

design features in isolation — protection can only be obtained for design features that have been applied to a particular finished article;

the functional characteristics of an article, e.g., what the article does and how;

methods or principles of construction, e.g., what the article is made of and how it is assembled;

ideas or general concepts — only a specific design applied to a particular finished article can be protected;

the colour of an article — Note: In the case of tartan designs, it is acceptable to submit additional colour drawings or photos to aid the examiner in more clearly discerning the pattern in order to assess registrability. However, such additional drawings or photos will not be part of the register, nor are the colours considered to be registrable design features;

features of an article that do not have a fixed appearance, e.g., holograms; and

buildings and structures to be constructed on site — this does not include structures that are preformed, portable and delivered to purchasers as finished articles, or in sections to be put together by a simple operation such as bolting.

## 6.2 Elements of an application

- **The prescribed fee**
- **The prescribed form, which includes:**
  - the name and address of the applicant;
  - a title that identifies the finished article to which the design has been applied;
  - a description identifying the features that constitute the design;
  - the name and address of the agent, if applicable; and
  - the name and address of a representative for service in Canada, if applicable.
- **Drawing(s) or photograph(s) of the design as applied to the finished article**

## 6.3 Prescribed fee

The prescribed fee for examination of an application to register a design according to the Tariff of Fees of the *Industrial Design Regulations* must be paid. There is a basic fee as well as an additional fee for each page of drawings in excess of 10 pages.

## Refund

A refund for any fees submitted for an application or request will be issued **only** if a request for withdrawal is received from the client prior to any processing of the application or request.

### **6.4 Prescribed form**

Although the exact wording and format of the prescribed form do not have to be followed, it is unacceptable to deviate from it in any way that is misleading or affects its substance.

The application must be clear and legible and be printed on one side of the paper only. The paper must be at least 21 x 28 cm or 8 x 11 inches but not more than 22 cm x 35 cm or 8.5 x 14 inches.

The application must be in either French or English.

#### **6.4.1 Applicant name/address**

The name and complete address of the applicant(s) must be included in the application.

#### **6.4.2 Agent name/address**

If the applicant has an agent, the agent's name and address is required.

#### **6.4.3 Canadian representative for service**

If the applicant's residence and place of business is not in Canada, the name and address of a representative for service in Canada is required.

#### **6.4.4 Title identifying the article to which the design is applied**

The title must clearly identify the finished article to which the design is applied. It should be identified by its common name generally known and used by the public.

Limited references to function or construction principles, including material, and registrable features will be accepted provided that:

- a) the common name has been provided; and
- b) such references are not excessive or long-winded.

With respect to the preceding paragraph, it is important to note that the protection afforded by registration appears to be limited to the specific article and any wording other than that which clearly identifies the article may limit protection (refer to section 11 of the *Industrial Design Act*).

The title should identify the complete finished article and not its component parts.

When a design is embodied in an article having multiple functions or multiple independent parts that assemble to form one finished article, the title must clearly identify a single entity. Any title that implies that the application includes more than one design will not be accepted.

Titles should include the word “set” when a design is applied to multiple articles of the same general character ordinarily sold together or intended to be used together, e.g., “set of golf clubs.”

For electronic icons, the title must identify the finished article in which the icon is embodied, e.g., “computer monitor,” “washing machine.”

#### **6.4.5 Description identifying the features that constitute the design**

##### a) Design applied to the entirety or a portion of the article

The description must indicate whether the design relates to the appearance of the entire article or to the appearance of a portion of the article. Further, if the design relates only to a portion, that portion must be clearly identified.

##### b) Which visual features

The description must make clear which of the visual features shown in the drawings comprise the design. For example, does the design consist of all of the visual features of the article or only certain specific features, e.g., only shape.

Any feature of the design referred to in the description must be visible in the drawings or photographs.

An application may include a more detailed description provided that the additional detail accurately describes design features visible in the drawings or photographs.

##### c) Highlighting important features

It is acceptable to highlight a particular feature that is considered to be an important feature of the design.

#### d) Words or letters

When letters or words are included in the drawings or photographs as features of the design, any description of those features must relate to their visual appearance. Words and letters per se are not registrable subject matter of industrial design.

#### e) Variants

An application must relate to one design or to designs that constitute variants. To be accepted as variants, the designs must be very similar and possess the described features without substantial variation. Where the drawings or photographs in an application show variants, the description should indicate the number of variants and indicate which figures relate to which variant.

#### f) Sets

It should be clear in the description when the design applies to a set and the description should refer only to the design features common amongst all pieces of the set, e.g., the identical design or variants applied to each piece of the set. It is acceptable to indicate the location of these features on each piece of the set.

#### g) Figure reference

It is recommended that a figure reference be inserted at the end of the description when more than one drawing or photograph has been provided. The figure references should be restricted to describing the views seen in the drawings, i.e., perspective, front, back, top, bottom, left side, right side.

When an article is shown in an opened and closed position or in an extended and retracted position, the figure references should also make that clear, e.g., Figure 1 is a bottom view of the kettle, Figure 2 is a top view of the kettle showing the kettle with the lid in open position.

### **6.4.6 Examples of acceptable descriptions**

#### Specific feature(s) applied to entire article:

The design is the shape of the entire kettle as shown in the drawings.

#### Specific feature(s) applied to a portion:

The design consists of the features of ornament of the handle of the spoon shown in the drawings.

The design is the shape of the back of the chair as shown in the drawings.

Specific feature(s) applied to a portion of the article – where drawings show design in solid lines and the rest of the article in stippled lines:

The design consists of the features of shape of the portion of the chair shown in solid lines in the drawings.

All features applied to the entire article:

The design consists of the features of shape, ornament, pattern and configuration of the entire bookcase as shown in the drawings.

The design is the visual features of the entire kettle as shown in the drawings.

The design is the visual features of the entire kettle shown in the drawings, whether those features are features of one of shape, configuration, ornament or pattern or are a combination of any of these features.

Highlighting important features

The design consists of the shape of the kettle shown in the drawings. The most significant feature of the design is the shape of the spout.

Variants

The design consists of the ornamentation applied to the handle of the spoon shown in the drawings. The drawings show two variants. Figures 1 and 2 show the first variant and Figures 3 and 4 show the second variant.

Sets

The design consists of the features of ornament of the handles of the set of cutlery articles shown in the drawings.

## **6.5 Drawings or Photographs**

### **6.5.1 General requirements**

Show entire article –The drawings/photographs must show the entire finished article to which the design is applied, even though the design may relate to the appearance of only a portion of the article.

Show fully-assembled article – Only the fully assembled view of the finished article will be accepted. Parts that are not visible in the completely assembled

article are not registrable and should not be shown or labelled.

Show article in isolation –The article must be shown in isolation. The only subject matter that will be accepted aside from the illustration of the article is: figure numbers, the names of the views, and the applicant's name/signature. Such written matter must not hinder the clear disclosure of the article.

Clearly disclose design features –The drawings/photographs must clearly disclose all the design features identified and described in the description portion of the application.

It is acceptable to submit photocopies or scanned images if the article and the features of the design are clearly shown.

Views – The drawings/photographs must include a sufficient number of views to show the features of the design clearly and accurately. The views must not overlap and should be to the same scale and oriented the same way.

Two-dimensional, plan and elevation views are accepted, and it is recommended that a perspective view of the design be included since it discloses the article in three dimensions.

Views of the article in open and closed, or extended and retracted positions, may be included when it is necessary to reveal design features visible when the article is used in those positions.

Flexible articles – Articles such as clothing and cushions that are flexible may be shown flat or as they appear in use, provided that the features of the design are shown clearly and accurately.

Sets – All pieces of the set must be shown in the drawings or photographs.

Variants – It is preferable to group views of each variant together, i.e., consecutively. A sufficient number of views are required for each variant to clearly and accurately disclose the design features.

## **6.5.2 Requirements for drawings only**

### **a) Illustrating the design applied to the article**

It is acceptable to illustrate the article in one of two ways:

1. Show the whole article in solid lines.
2. Show the portion of the article embodying the design in solid lines,



and show the other parts of the article that are not part of the design in stippled lines. (Stippled lines are broken lines formed by evenly spaced short dashes, evenly spaced dots, or a combination thereof.)

Shading techniques – Techniques that are used to better illustrate the shape of the design are acceptable provided they do not distort or hide the design. Shading should be consistently shown throughout the drawings. Shading should not be shown in any non-design portions of the article shown in stippled lines.

Transparency – This can be illustrated by the use of thin shade lines. Portions of the design and article that would be visible through the transparent section must be shown. Transparency should not be shown in any non-design portions of the article shown in stippled lines.

Repeat pattern for articles of indefinite length – For articles such as fabric and wallpaper, it is acceptable to simply show stippled or broken lines around the pattern to be repeated.

Articles of indefinite length – For articles such as pipes, mouldings, wires, etc., indefinite length should be shown by the use of break lines. It should be obvious that the line indicates a break in the drawing and is not part of the design.

Methods to illustrate indefinite length with break lines –

- by double sinusoidal lines;
- by a sharp jagged line; and
- by a pair of angled straight parallel lines broken occasionally by a zigzag.

For showing indefinite length for repeat pattern designs on fabric and paper products, stippled or broken lines around the pattern to be repeated will suffice.

## **b) Different types of views**

Cross-sectional views – A cross-section may be included in order to better disclose described exterior features of the design.

Method to illustrate a cross-sectional view

- The cut surface of the article may be shown either as solid black or as alternating black and white diagonal lines.

- The location of the cross-sectional view should be marked on one of the conventional views using arrows and letters.

Fragmentary view – A fragmentary view may be included to show a portion of the design on a larger scale in order to better disclose small detail.

Methods to illustrate a fragmentary view

- On a conventional view, mark with a circle the portion shown in the fragmentary view and number it with the same figure number as the figure showing the fragmentary view.
- An arrow near a conventional view points to the area shown in the fragmentary view.

**One View Showing Environment:** The applicant may provide **one** view on a drawing that includes environment (meaning subject matter that is not part of the finished article and that is illustrated only for the purpose of showing the article in context) provided that:

- 1) the application contains more than one view and all other views show the article in isolation;
- 2) the environment is shown in stippled lines;
- 3) inclusion of the environment in the application helps to provide a better understanding of what are the features of the design and what is the finished article to which the design is applied; and
- 4) it is clear from the combination of the drawings, the description and the title what is the environment, what are the features of the design and what is the finished article to which the design is applied.

Note: The view that includes environment does not have to be the last view.

**6.5.3 Requirements for photographs only**

If photographs rather than line drawings are submitted, they must be of a quality suitable for clear reproduction by photography, electrostatic processes, photo-offset and microfilming as required by paragraph 13(4)(d) of the *Industrial Design Regulations*. The Office will request new photographs if those submitted are not reproducible.

Photographs should be numbered in sequence. It is suggested that the numbers

be written, stamped or typed on the back of the photograph with permanent ink.

## **6.6 Originality**

A design must be original in order to be entitled to registration. Section 7(3) of the *Industrial Design Act* states that the certificate of registration is evidence of the originality of the design. Section 6 of the *Act* also specifies that a design will not be registered if:

- the design is identical to or closely resembles any other design already registered; or
- the design was published more than one year prior to the date of filing in Canada.

If a search discloses the existence of an identical or substantially similar design, the examiner will issue a report raising an objection on the basis of lack of originality. A copy of the cited design and its title and description will be forwarded to the applicant. Unless the applicant can establish that the new design has original design features beyond those seen in the cited design, the objection will be maintained and a final report will be issued.

Over the years, the Courts have set out principles that have been applied in reaching decisions about what constitutes an original design. To read more about these guiding principles, see Annex A.

## **6.7 Divisional and similar designs filed by the same applicant**

### **6.7.1 More than one design**

The application must relate to one design applied to a single article or set, or to variants of one design applied to an article or set.

If, after examination, it is considered that the application relates to more than one design, the examiner will notify the applicant who will be requested to limit the application to one design.

The examiner will also advise the applicant that one or more separate or divisional application(s) may be filed for any of the remaining design(s) disclosed. Such divisional applications will have the same filing date as the initial (or parent) application once the proper documentation and fees are filed.

The parent application and any divisional(s) will be registered at the same time if requested by the applicant. The examiner may also consider it necessary to register these at the same time to prevent a possible citation if the features of

one design form part of another design. Failure to do so could result in one or more such designs being registered prior to the other(s) and the registered design being cited against the still-pending design.

### **6.7.2 Subject matter for filing a divisional**

Any design disclosed in an application as initially filed may be made the subject of a divisional application if the divisional is filed before the registration of a design based on the original application.

For the purposes of filing a divisional, a design is considered to be disclosed in the initial application if it is shown in the drawings or photographs as initially filed regardless of whether it is shown in continuous or stippled lines and regardless of whether it is identified in the description as being a part of the design.

### **6.7.3 Related designs**

When the same applicant, at or about the same time, files two or more applications for similar designs or related designs, such applications should be processed and examined at the same time. It is the responsibility of the applicant to notify the Office of such co-pending applications. Otherwise, one or more such designs could be registered prior to the other(s). In that case, any design that is still pending could be objected to for lack of originality if the design features closely resemble or form part of a design already registered.

### **6.8 Amendment of an application**

An application may be amended any time before registration. However, it is not acceptable to amend the application in a way that constitutes a substantial change to what has been identified as the design. In particular, changes to the description or drawings that describe or disclose a substantially different design will not be accepted.

## **7. EXTENSION OF TIME**

Upon receipt of a written request, the Industrial Design Office will grant an extension of time from the expiration date of the specified time limit to respond to a report.

Each extension will be for a maximum of 4 months and may be less if the client specifies a shorter period. If the client does not specify a period of time, 4 months will automatically be granted. Generally, the Office will not extend the period of reply beyond 12 months.

## **8. ABANDONMENT**

If there is no response to a report within the specified period for reply, the application will be considered abandoned as of the date of expiry of the specified period for reply.

Once the application has been abandoned, the Office will send a 'Notice of Abandonment' to the applicant as a courtesy. The notice will set out the reason for abandonment and the requirements for reinstatement. No fees will be refunded.

## **9. REINSTATEMENT**

In accordance with subsection 5(4) of the *Act* and section 17 of the *Regulations*, an abandoned application may be reinstated if the applicant submits a request for reinstatement within six months after the date of abandonment. The request must include a response to the outstanding report and the prescribed fee for reinstatement. If these requirements are not met within the prescribed period, the application will become 'inactive.' No further office action will be taken. No refund will be issued for any fees paid.

## **10. WITHDRAWAL**

Applications and requests to record agreements or maintenance may be voluntarily withdrawn by written request.

Upon receipt of a written request to withdraw a design application, the application will be made 'inactive' and a confirmation notice will be sent to the client. No further office action will be taken. The applicant may re-apply, if the design was not published more than one year prior to the second filing.

Upon receipt of a written request to withdraw a request for recordal of an agreement or maintenance, the action will simply not be done.

A refund will only be issued in respect of any fees submitted if the request for withdrawal was received prior to any processing of the application or request.

## **11. DELAY OF REGISTRATION**

Some countries might reject an industrial design application because the design has already been registered in another country. For this reason, applicants may wish to delay registration to allow time to file the application in another country.

The Industrial Design Office will process such requests at any time before registration. The Office requires a written request accompanied by the required fee (Item 9 of the Tariff of Fees). A six-month delay will be granted beginning on the day the request is received. The same fee will be required for any further requests. During any six-month period of delay, the applicant may request that the application proceed to registration prior to the end of the six-month period.

The above will apply only in cases when an applicant requests to delay the registration of an application which otherwise would normally proceed with registration. This will not apply in situations relating to parent/divisional applications or similar designs filed by the same applicant provided that the applicant has notified the Industrial Design Office of the existence of such co-pending applications. In these situations, the usual practice of the Office is to register such applications on the same day.

## **12. REGISTRATION**

Once the examiner has determined that the application is in an allowable state, it can proceed to registration. Upon registration the client will receive a:

- registration certificate;
- copy of the application;
- covering sheet summarizing the information about the design; and
- notice explaining the requirements for maintenance of the registration.

Upon registration, the design will be open for public inspection.

## **13. AMENDMENT OF A DESIGN REGISTRATION**

The Industrial Design Office will correct any clerical error in respect of a design registration upon receipt of a written request and will provide confirmation by issuing a correcting certificate. In the case of correction of an error not committed by the Office, a fee is required (Item 11 of the Tariff of Fees).

The Office will record any amendment ordered by the Federal Court and will provide confirmation by issuing a correcting certificate.

When the Office is notified of other types of changes that occurred subsequent to registration and not affecting the design itself, the Office will make a recordal of

the change in the DesignPlus system, e.g., a change of address of the owner, a change of representative for service. In such cases the application as registered will not be amended.

## **14. MAINTENANCE**

Registered designs are valid for ten years provided that the required maintenance fees are paid. Design protection ends ten years after the registration date and cannot be extended.

If the owner of an industrial design wishes to maintain the protection beyond five years, the fee set out in Item 2 of the Tariff of Fees must be submitted before the fifth anniversary of registration. If the fee is not received before expiry of the five year period, the additional fee set out in Item 3 of the Tariff of Fees will also be required. If the design is not maintained within the five years plus six months, protection ends as of the next day.

## **15. ASSIGNMENTS AND OTHER AGREEMENTS**

### **15.1 Recordal**

Assignments and licenses will be recorded in the Industrial Design Office upon receipt of an affidavit or a copy of the document effecting the assignment or license and the prescribed fee.

The Office will check the chain of title to ascertain that the assignor is the current owner of record. The Office will contact the client if the documentation is unclear in this regard; further documentation or clarification may be required.

The Office will record an assignment (or other agreement) against only the design(s) that have been identified in the assignment document. If there are not enough fees to cover all the designs identified, the Office will request the additional fees before doing the recordal.

### **15.2 Notice of Omission**

Where an application to register an assignment (or other agreement i.e. license) affects a registered or pending design and does not meet the requirements of section 19 of the *Industrial Design Regulations*, the Industrial Design Office will send out a Notice of Omission setting out the outstanding requirements.

Affecting a registered design: If a response is not received within the specified period for reply in the notice, the agreement will not be registered. No documents

will be returned and no refund will be issued for any fees that were paid in accordance with item 4 of the Tariff of Fees, Schedule 2 of the *Regulations*.

Affecting a pending design: If a response is not received within the specified period for reply in the notice, the application to which the agreement relates will be registered in the name currently on record. No documents will be returned and no refund will be issued for any fees that were paid in accordance with the abovementioned item 4 of the Tariff of Fees.

After expiry of the specified period for reply to the Notice of Omission, any applicant still wishing to record the assignment or other agreement (for either a pending or registered design), must re-apply.

### **Annex A – ORIGINALITY: GUIDING PRINCIPLES**

- When comparing designs to determine whether they are “substantially” different, it is a matter of impression to be judged solely by the eye.
- One must consider whether the originality of a design is substantial having regard to the quantity of prior art. The standard of originality varies from class to class depending on the degree of possible changes and on the quantity of registered designs in the field.
- In assessing originality, one must also consider the nature of the article and the constraints or limitations to which a designer is subjected when designing an article. Few changes are required to make a design “original” when an article has a very small range within which design creativity can be exercised. On the other hand, an article that has a very large range within which creativity can be exercised will require a higher standard of originality.

Supreme Court of Canada decision *Clatworthy & Son v. Dale Display* (1929), S.C.R. 427, that to constitute an original design there must be some substantial difference between the new design and what previously existed.

*Bata Industries Ltd. v. Warrington Inc.* (1985) 5 C.P.R. 339 “It seems to involve at least a spark of inspiration on the part of the designer either in creating an entirely new design or in hitting upon a new use for an old one. It should be noted that one of the dictionary definitions of ‘original’ is ‘novel in character or style, inventive, creative’ (*The Concise Oxford Dictionary*, 6<sup>th</sup> ed., 1976).”

Russell-Clarke on Copyright in Industrial Designs, Michael Fysh 5th,



Sweet & Maxwell (London) 1974 at p. 36-38., and Re Paramount Pictures Corporation Industrial Design Application (1981), 73 C.P.R. (2nd) 273: One must look at each design as a whole, and the test should not be only a side-by-side comparison of the differences. One should also consider the appeal to the eye of each design when they are seen separately, taking into account imperfect recollection.

Dover Ltd. v. Nurnberger Celluloidwaren Fabrik Gebruder Wolff (1910), 27 R.P.C. 175 p. 179, that, for a design to be registered, it “must be new or original with reference to the kind or article for which it is registered; meaning, by kind of article, not the class of article... but the kind of article having regard to its general character and use. A design may be new for a coalscuttle but not for a bonnet. On the other hand, a design for a shade of a gas lamp can hardly be new if it was old for an oil lamp.” This narrows somewhat the parameters of the search that is performed. For example, if an application is received for a coalscuttle, a search of the container class is performed but the apparel class (bonnets) is not searched.

See Re LeMay v. Welch (1884), 28 Ch. D. 24., Canadian Wm. A. Rogers, Limited v. International Silver Company of Canada, Limited Ex. Cr. (1932), p.66., and Angelstone Ltd. v. Artistic Stone Ltd. C.P.R. Vol. 33; 156 at p. 170.: There must be substantial originality in the design having particular regard to the nature of the article, and mere changes in size or proportion do not necessarily render a design original and may limit other designers in the same trade.

See Phillips v. Harbro' Rubber Co (1920), 37 R.P.C. 233., and Kaufman Rubber Company, Ltd. v. Miner Rubber Company Limited Ex. C.R. 26.: The inclusion of mere trade variants in an old design is not sufficient to render a design original. A variation that is known in connection with a particular article or class of articles does not constitute a substantial difference.