

INDUSTRIAL DESIGN PROTECTION IN CANADA

What is an Industrial Design?

In Canada, an industrial design is a statutory monopoly granted by the federal government to a proprietor in a shape, configuration, pattern, ornamentation (or any combination thereof) that, in a finished article, appeal to and are judged solely by the eye. In general, industrial designs are intended to protect designs for useful articles like furniture, wallpaper, carpets, automobiles, cutlery, clothing, etc. In the United States, industrial designs are referred to as “design patents”.

An industrial design protects only the visual appearance of a finished article manufactured by hand, tool or machine. An industrial design registration does NOT protect any functional features of the article or any method or principle of its manufacture or construction.

In Canada, copyright in industrial designs becomes unenforceable after more than 50 copies have been made. Instead, an industrial design registration must be sought to preserve exclusive rights in these mass produced designs.

Until the industrial design expires, the proprietor has the exclusive right in Canada to prevent others from making, importing, selling, or renting any article with a design not substantially different from the registered design.

What is eligible for protection as an Industrial Design?

To be eligible for an industrial design registration, the design must be new. This means that it cannot be previously known to other third parties and that the applicant cannot disclose the design to the public prior to filing an application or the expiry of any available grace period. In Canada, there is a one year grace period within which to

file an industrial design application after public disclosure.

Who is entitled to an Industrial Design Registration?

The author of a design is the first proprietor unless they created the design for another person for good and valuable consideration as either an employee or an independent contractor. Prior to registration, the proprietor of design may assume title to any application for the design that was improperly filed by a third party.

When does an Industrial Design Registration Expire?

Industrial design registrations expire 10 years after the date of registration in Canada. A single maintenance fee must be paid on the 5th anniversary to maintain the registrations.

Can Industrial Designs be Sold or Licensed?

Yes, industrial designs can be assigned or licensed wholly or partially by written agreement. Such agreements may be subject to a virtually unlimited variety of limitations as to territory, term and conditions of sale.

To be effective against third parties, all assignments and exclusive licenses affecting an industrial design registered in Canada must be recorded with the Canadian Intellectual Property Office.

What are the Steps to Obtain an Industrial Design Registration in Canada?

1. Registrability Search & Opinion

While not required, it can be useful to have a registrability search be conducted before drafting and filing an industrial design application. Such a search usually involves a search of the registered industrial designs and pending industrial design applications filed for related articles. Clients are strongly encouraged to assist in this process by

identifying any references already known to them, including any relevant material appearing in the market, trade publications and/or web sites.

A registrability search provides: (a) guidance as to whether the design is likely to be entitled to registration; (b) guidance as to the potential scope of the monopoly that may be granted; and (c) guidance as to how the application should be prepared to highlight the new features of the design over what was previously known.

Upon receipt, the search results are reviewed and analyzed and, where requested, a written opinion prepared. The cost of such a search and an opinion depends on the complexity of the design and the number of the references located in the search.

2. Preparation and Filing the Application

A single Canadian industrial design application can be filed for designs applied to the same finished article which do not differ substantially from each other.

The application will generally include the following parts:

- a title which identifies the finished article;
- a description which identifies the features of the design; and
- drawings or photographs which show the features of the design clearly and accurately as they appear on the finished article shown in isolation (including all variants).

Industrial designs can be complex documents that employ obscure language conventions in the manner in which they are drafted. Errors cannot always be corrected and can be fatal to the success of the application or the validity of any resulting registration. It is therefore recommended that a patent agent be retained to file all industrial design applications.

3. Examination

After filing, an examiner will first review the application to determine whether it's in the proper format. The examiner will then conduct and review a search of other industrial designs registered and industrial design applications pending in Canada for relevant references. Based on this review, the examiner may issue one or more reports including objections to the application.

The examination process typically takes anywhere from 6 – 12 months after filing. The cost of responding to the examiner's objections, and amending the application as necessary, will depend on the number and nature of the objections.

4. Registration

Once the industrial design application is found to be in compliance with all of the requirements of the *Industrial Design Act*, a Certificate of Registration will be issued.

5. Filing in Other Countries

A Canadian industrial design only grants a monopoly to the proprietor in Canada. To obtain similar monopolies in other countries, corresponding applications must be filed in each relevant jurisdiction. In the United States, industrial designs are referred to as "design patents".

Most countries in the world adhere to an international treaty which regulates the orderly filing of industrial design applications in multiple countries. This treaty stipulates that if an industrial design application is filed in one or more additional countries within 6 months after the first application is filed for the same design, these additional applications will be effectively backdated to the filing date of the first application.

We file industrial design applications in other countries through associate law firms located in those jurisdictions whom we know are qualified in this specialized area of the law.

Where Can I Get More Information?

You can get more information by visiting the web sites for:

Canadian Intellectual Property Office

www.cipo.ic.gc.ca

United States Patent & Trademark Office

www.uspto.gov

Or by contacting:

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