



## RECENT GUIDANCE ON THE CRITERIA FOR ORIGINALITY IN CANADIAN INDUSTRIAL DESIGNS

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The Patent Appeal Board and Patents Commissioner from the Canadian Intellectual Property Office (CIPO) has rendered a rare decision on the originality required to register an industrial design. The examiner considered that this application lacked originality given two designs already filed by the same applicant, *Victor Stanley Inc.*

The Appeal Board recalled the criteria developed by the Canadian jurisprudence [*Re Paramount Pictures Corp Industrial Design Application* (1981) 73 CPR (2d) 273 (PAB)]:

- The degree of originality required to register an original design is greater than that laid down by Canadian copyright legislation, but less than that required to register a patent. The originality of a design is a question of fact that must be assessed in accordance with the nature and character of the article to which the design refers and constraints must be considered when originality is asserted [*Rothbury International Inc v Canada (Minister of Industry)*, 2004 FC 578].
- The articles being compared should not be examined side by side, but separate so that imperfect recollection comes into play *Jones v Teichman*, [1930] Ex CR].
- One is to look at the design as a whole [*Lewis Falk Ltd v Jacobwitz* (1944), 61 RPC 116 (ChD)].
- Any change must be substantial. It must not be trivial or infinitesimal [*Simmons v Mathieson & Co* (1911), 28 RPC 486 (CA)].

The Appeal Board then discussed the issues raised by the applicant to justify the registration of his design:

- During the prosecution, the applicant has received a notice from the examiner to inform him that the application was for two series of drawings and that it could not be maintained in a single application: a trash can with a lid and a trash can without lid. On this basis, the applicant alleges that the standard demonstrated by the examiner in requiring restriction to a single design is the standard that ought to be applied in assessing originality, especially since the

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examiner withdrew said rejection during prosecution, considering them rather as variants.

According to the Appeal Board, the novelty of the design lies within three aspects that are not connected to the lid, which are bar width, bar texture, and the presence or lack of feet. Therefore, the decision that was taken to limit the request to one set of drawings with or without lids, should not be considered a factor in assessing the originality of the article.

- The applicant has stressed that the CIPO had previously registered two designs based on the fact that the texture of the bars that appeared on both articles was sufficient to confer an original character to the designs, allowing their registration. The applicant alleges that his application therefore meets the criterion of originality because the texture of the bar differs from the prior art.

The Appeal Board has explained this difference by the fact these designs were both registered on the same day and have the same owner. If the owners had been different, the design with the earlier filing date would have gone to registration and then it would have been cited, barring the registration of the second design.

- The applicant has also submitted two other designs had been registered based on a single application where differences in bar width were considered by the examiner to be sufficient to constitute substantially different designs, the Examiner requiring the applicant to file a divisional application, leading to the registration of two separate designs.

The Appeal Board argued that a decision taken by an examiner in a previous case does not establish practice. In assessing originality of design, each case must be assessed on its own facts.

The Appeal Board then gave its analysis regarding originality.

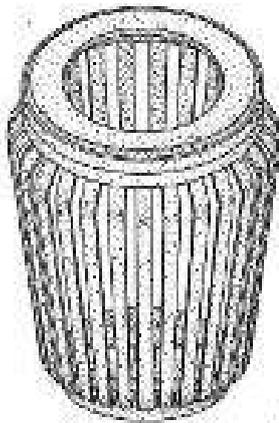


FIG. 1



FIG. 5

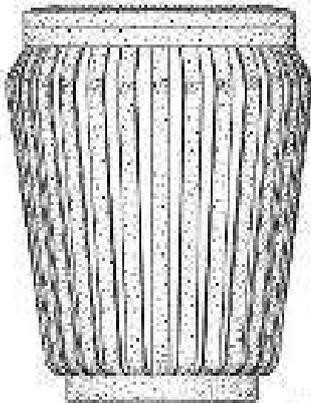


FIG. 2



FIG. 6

The Board first looked at the design to see which features “appeal to the eye”. However, the differences identified by the applicant (Fig.1 and 2) with the cited designs (Fig. 5 and 6), namely, bar width, bar texture, and the presence or lack of feet, do not attract the eye on first impression, but are only seen when a side-by-side examination of the two designs is conducted. Since the differences are only seen by making such a comparison, the Board did not characterize them as being substantial.

Thus, based on the facts surrounding the application, it was determined that the design as presented by the applicant lacked originality when compared to the cited documents. No appeal of this decision has been filed in Federal Court.

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