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MODERNIZATION OF THE INDUSTRIAL DESIGN REGIME

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With Canada's accession to the Hague Agreement on November 5, 2018, not only were the *Industrial Design Act* ("Act") and the *Industrial Design Regulations* ("Regulations") amended to allow this accession, but the government also took the opportunity to modernize the industrial design regime.

Here we briefly review the main changes for a national application, the main conditions for a Hague application and some aspects of the new regime by finally noting a strategic element to consider.

Changes for a national application

It is no longer necessary for an applicant to provide as much information as before when filing a design application at the Canadian Intellectual Property Office ("CIPO").

In order to obtain a filing date, the applicant must only pay the government fee and file an application at CIPO that includes the name of the article, a representation of a design, the name of the applicant and its contact information. The filing date of the application is the date on which the Minister receives all this information. It is therefore no longer mandatory to provide a title, a description of the drawing and a declaration as to the first owner of the design.

The new Regulations nevertheless provide that the application must include at least one graphic reproduction (drawing) or a photograph showing the design alone or the finished article alone and of sufficient quality to clearly and accurately identify the features of the design.

While the applications were not previously published, the new Act provides for publication on the earliest date of the registration date and the date that falls 30 months after the filing or priority date.

The new Regulations codify the possibility of obtaining a delayed registration limited to a maximum of 30 months from the filing or priority date.

CIPO now issues a Notice of Registration on the registration date instead of a Certificate of Registration.

Conditions for a Hague application

With the Hague Agreement, a Canadian applicant can file a single application at the International Bureau of the World Intellectual Property Organization ("WIPO") by designating several jurisdictions, including Canada. In order to obtain a filing date, the applicant must pay the international fees and the Canadian designation fee for each design (product). The application

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must notably include the name and address of the applicant, the name of the product and a reproduction of the product. An international registration may cover up to 100 different products in the same Locarno class.

The filing date in Canada, the international filing date and the international registration date are the same date, which is the date on which the application is regularly filed at the International Bureau. The publication date is that of the publication of the international registration in the International Bulletin (about six months after the international filing date).

Once the international registration is published by WIPO, CIPO can start its substantive examination. If the international registration covers several products, CIPO then divides this registration into several distinct Hague applications. The new Regulations provide that the content of the Hague application is deemed to be conformed as regards to the quality, form and presentation of the reproductions and photographs, the name and address of the applicant, and the optional description (description of the design).

The registration date in Canada does not correspond to the international registration date since it rather corresponds to the date of the Statement of the Grant of Protection, if such a statement is issued by CIPO, or at the date which falls 12 months and one day after the publication date (about 18 months after the international filling date).

Some aspects of the new regime

While the duration of a design registration was 10 years from its registration, it is now the longest of 15 years from the filing date or 10 years from the registration date in Canada.

The new Regulations provide that the representation must be sufficient to fully disclose the design taking into account the name of the article or product and any statement. Note that the application may include drawings and photographs where it was not possible before to include both.

The new Regulations specify that the application is deemed to cover all the visual characteristics of the design (shape, configuration, pattern and decorative elements). The features shown in dotted lines are not part of the design and it is now possible to use blurring or colouring to illustrate features that are not part of the design.

While a description of the design is no longer mandatory, the application may nevertheless include such a description. When the application comprises a description of the design, the courts have recognized that it must be read in light of the representation to determine the validity and infringement of the registered design. The application should therefore comprise a description to better define the intended protection by identifying the important and distinctive visual features of the design.

The originality requirement is replaced by that of novelty. The new Act provides that a design is new if the same design, or a design not differing substantially from it, has not been publicly disclosed by the applicant more than 12 months before the filing or priority date. The 12-month grace period for a disclosure made by the applicant is therefore codified. The absolute novelty requirement is also codified in the new Act. In order to be registrable, a design must not have been disclosed by a third party before the filing or priority date. An applicant may now seek protection for similar designs if all applications are filed within 12 months of the first application. It is thus no longer necessary to request CIPO to associate these different applications and that all designs be

registered on the same day to prevent a previous design from being cited against a subsequent design.

Even if this option may be less useful for a Hague application, the new Regulations codify the possibility of obtaining an advanced examination.

While it was possible to obtain two six-month extensions to respond to an Examination Report, a single six-month extension is now available.

An applicant may now file a divisional application that is not limited to the content of the first application and may cover any element disclosed but not claimed in the first application, such as, for example, another design shown in full or in part in dotted lines. Unless the first application was subject to restriction, a divisional application must be filed within two years of filing of the first application.

Electronic communications are deemed to be received at any time on the same day, regardless of whether it is a holiday or a day when the CIPO is closed.

Proof of transfer (e.g. assignment) is no longer required when the request for registration or transfer is made by the applicant/owner. Proof of the transfer is however required when the request is made by the new applicant/owner.

Strategic consideration

Because the new Act provides a definition of novelty that mirrors the language of the exclusive right set out in the Act (same design or a design not differing substantially from it), a person who is sued for infringement of a previously registered design should assert in defense his own subsequent registration covering his product. More particularly, this person may argue that the product covered by his registered design cannot infringe the previous design since his design was found by CIPO to be new over the prior art, including the previous design that was normally considered by CIPO. As such, obtaining registration of a design may confer the additional advantage of constituting a defensive strategy against an eventual infringement lawsuit based on a previous registration.

To find out more about the new industrial design system or any questions regarding industrial design protection, do not hesitate to [contact](#) one of our team members.