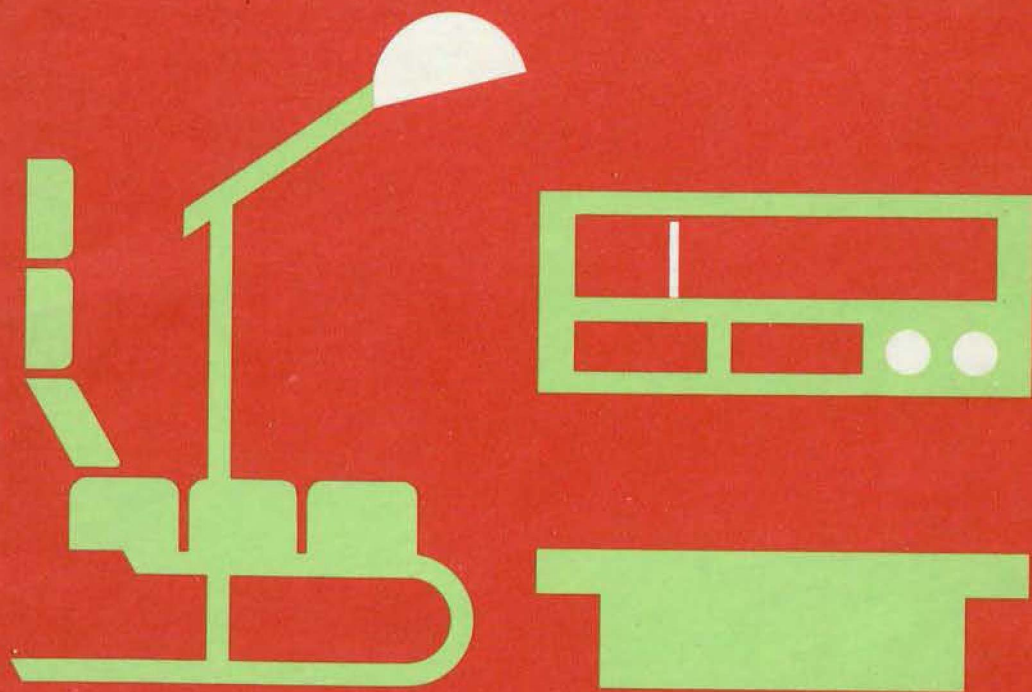


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Industrial Design: Questions and Answers



Consumer and
Corporate Affairs
Canada

Canada

Bureau of
Corporate Affairs

Consommation
et Corporations
Canada

Bureau des
corporations

Questions and Answers
about Industrial Design



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1

Q. What is an industrial design?

- A. An industrial design is any original shape, pattern or ornamentation applied to an article of manufacture, such as the shape of a table, the pattern of a fabric, or the decoration on the handle of a spoon. The article must be made by an industrial process.

2

Q. How can I differentiate industrial designs from copyright, patents, and trade marks?

- A. Copyright deals with original literary, musical, dramatic and artistic works. The term of a copyright is generally for the life of the author plus 50 years. Patents deal with inventions; that is, new and useful processes, machines, manufactures, compositions of matter or any new and useful improvements thereof. A patent is a grant by the Government of Canada giving an inventor the right to exclude others from making, using or selling his invention within Canada for a period of 17 years, and is given in exchange for a full and complete disclosure of the invention. A Trade Mark is a word, symbol or picture or a combination of these used to distinguish the wares or services of a person or organization from those of others in the market place. A Trade Mark is valid for a period of 15 years from the date of registration.

3

Q. How long is an industrial design effective?

- A. An industrial design registration lasts for an initial period of five years from the date of registration and may be renewed for up to five years.

4

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

- A. Yes, for there is no protection without registration.

5

Q. How much does it cost to register?

- A. The fee is \$100.00 for the initial five-year period.

6

Q. Once I have obtained registration, are any further fees necessary?

- A. No, unless you request a renewal, for which the fee is \$200.00.

7

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

- A. No. Protection in foreign countries can only be obtained by filing in each country.

8

Q. Is there any time limit within which an application for registration must be filed?

- A. No, provided the design has not been disclosed to the public. However, once a design has been made public in Canada, it must be registered within 12 months.

9

Q. Who may register an industrial design?

- A. The author of the design is the only person who may register it unless it was created in the course of employment for someone else.

10

Q. If more than one person co-operates in making the design, which one owns it?

A. If they both participated in the creation of the design they are joint proprietors and should file a joint application. The certificate of registration will then be issued to them jointly.

11

Q. What happens if two or more persons apply for essentially the same design?

A. The applications are examined on a "first come, first served" basis. The earliest application will be registered and the second one refused.

12

Q. If I create a design while working for someone else, who owns it?

A. If someone has hired you to create the design, your employer is its owner and the only one authorized to request registration.

13

Q. What papers are necessary to apply for an industrial design registration?

A. You must send in drawings of your design as well as a written description of the original features of the design. In addition, you must sign a statement saying that you are the owner of the design and that, to your knowledge, no one else was using the design when you adopted it. The application will be in accordance with the sample application form shown on page 10.

14

Q. What type of description is required in an application?

A. The description need not be a detailed word picture of every particular of the design, but it must indicate with reasonable certainty what the design is and what the applicant believes to be its original visual features. The description should relate only to the ornamental features of shape, pattern or ornamentation applied to a particular article and may not include any reference to the function the article performs or how it is constructed. Geometric terms can be used to describe the design.

15

Q. What type of drawing is necessary?

A. Two copies of the drawing on good quality 8½ x 11 or 8 x 13 paper or tracing cloth and one additional copy on 2 or 3 ply, pure white, 8 x 13 Bristol Board sheet are required. All views must be clearly drawn in permanent, black, unbroken lines and on a sufficiently large scale to be easily read. While doubt has been expressed by the courts as to the validity of photographs filed in lieu of drawings, for the convenience of applicants the Office will accept five photographs. One copy must be 8 x 13 and the other four copies either 8 x 13 or 8½ x 11, unmounted.

16

Q. May the term of an industrial design be extended by making minor changes to the original one?

A. No. (See question and answer 30)

17

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

A. Yes. Once a design is registered, each article must bear the name of the proprietor, the letters "Rd." and the year of registration. If the article is physically difficult to mark, the information can be on an accompanying label.

18

Q. What happens to industrial design rights if I die?

A. The rights acquired by registration will become part of your estate and are passed on to your heirs.

19

Q. What happens if I die before registration has been completed?

A. Examination of the application will be continued with the executors of your estate.

20

Q. After the design has expired, can anyone use it?

A. Yes. Once the design has expired, anyone may make, use or sell the design in Canada.

21

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

A. No. A design registration may only be obtained by the true owner and not by someone who has copied another person's design.

22

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

A. If the examiner discovers in the course of the search that the design is not original, the application will be refused. If this search does not disclose a similar design, the applicant's declaration as to its originality will be accepted and the design will be registered. The courts have the power to overturn an invalid registration at a later date.

23

Q. Will the Industrial Design Office give me an opinion on whether or not my design is good?

A. No. The Industrial Design Office cannot express an opinion regarding the aesthetic or commercial merits of a design.

24

Q. Will the Office give an opinion as to whether my industrial design is likely to be accepted?

A. No, not until a formal application is submitted.

25

Q. Can anyone make a search of the Industrial Design Office records to see what has been protected previously?

A. Yes. Assistance will be provided to anyone wanting to make a search of the records. Copies of drawings and other documents may be obtained at a nominal fee.

26

Q. How much does the search cost?

A. Anyone may make a search, free of charge.

27

Q. Will the Industrial Design Office conduct searches for the public?

A. No, but the office will assist persons wishing to make their own searches.

28

Q. Is it necessary to visit the Industrial Design Office to process an application?

A. No. Business with the office is conducted by correspondence. Interviews with examiners can be arranged if necessary; however, any oral representation or statement must be confirmed in writing.

29

Q. After I have filed my application for registration, can I still make changes to it, or do I have to file a new application?

A. Voluntary amendments can be made to an application at any time prior to registration, on condition that the subject-matter is not substantially changed. If it is changed substantially, a new application must be submitted.

30

Q. What happens if I want to vary my design before or after I have filed my application? How much more will it cost?

A. At any time prior to registration and free of charge, other representations of the design may be added to an application. Such representations will only be accepted if the original design features in each representation do not differ sufficiently to render any representation original over another and if the article or articles are of a similar nature. Once registration has been obtained, no further representations may be added.

31

Q. What can I do if the Industrial Design Office refuses to register my design?

A. If any problems are found with your application while it is being examined, you will be given the opportunity to make changes to your application to overcome these problems. If you cannot solve them to the satisfaction of the Industrial Design Office, you may ask the Patent Appeal Board to review your case. If you are still not satisfied, you may appeal to the Federal Court of Canada.

32

Q. May foreigners register their designs in Canada?

A. Yes, provided that Canadian requirements are met. Procedures from other countries have no effect in Canada.

33

Q. How long does it take to have a design registered?

A. The Industrial Design Office attempts to register industrial designs within 30 days of receiving the application in the Office. However, the length of time will vary in cases where changes to descriptions or drawings are required.

34

Q. Can I sell or assign my design to someone else?

A. Yes, you may sell all or any part of your interest in the design. However, this arrangement must be in writing.

35

Q. If I sell my rights to a design to someone else, should the assignment be recorded?

- A. 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. The new owner should ensure that the assignment is registered with the Industrial Design Office. Registration fees are \$25.00 for the first design and \$10.00 for each subsequent design.

36

Q. Are there any forms available to register an assignment?

- A. No. Any legal form of transfer is acceptable on condition that the original document or a copy certified by a notary is submitted.

37

Q. What is the difference between an assignment and a licence?

- A. With an assignment, you give up *permanently* all or part of your interest in your design to someone else. With a licence, you temporarily permit someone to make, use and sell your design. You should specify where in Canada this is to be done and for what period of time. You may also allow that person to permit a third person to make, use and sell the design.

38

Q. Will the Industrial Design Office stop someone else from infringing my design?

- A. No. This responsibility rests with the owner of the industrial design. It is imperative that any legal action be started within twelve months of the offence.

39

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

- A. Protection provided by the Industrial Design Act is frequently confused with protection under the Copyright Act. Many designs, being works of art, are automatically protected under the Copyright Act. But once the original artistic work is used or intended to be used as a model or pattern to produce more than 50 single articles or sets of articles, the artistic work then becomes 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 proper legal advice on this question.

40

Q. Good design is often tied in with the function the article performs. Why does the Industrial Design Act not recognize this?

- A. The Industrial Design Act provides protection for the ornamenting of articles of manufacture. Whether a design is functional or attractive is immaterial for the purpose of registration. Disclosure of functional features in an application does not prevent the design from being registered. However, an industrial design that pertains solely to functional or utilitarian features of an article in which no visual appeal is intended is not registrable.

41

Q. Can I register ideas for future designs?

- A. No. Each design must be applied to a specific article of manufacture.

Q. What subject-matter is not protectable by an industrial design?

- A. — a process of manufacture,
 — 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 (colour would be acceptable if it is one of the characteristic features of the design *and not the sole feature*)
 — ideas.

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

- A. Yes. The Industrial Design Office will provide assistance related to the procedural aspects of filing an application. Also, there are agents that you may hire who have experience in this area. They will carry out any necessary correspondence with the Industrial Design Office. You can find these agents by looking in the yellow pages of the telephone book under Registered Patent Agents or by writing to the Industrial Design Office.

Q. Where can I obtain copies of the Industrial Design Act and Rules?

- A. Copies of the Industrial Design Act and the Industrial Design Rules are available from Supply and Services Canada, Publishing Centre, Ottawa K1A 0S9.

Q. Where can I obtain further information on designs?

- A. Write the Commissioner of Patents, Consumer and Corporate Affairs Canada, Ottawa-Hull, K1A 0C9 or telephone (819) 997-1725. If you want to visit the Industrial Design Office, the address is Place du Portage 1, 50 Victoria Street, Hull, Québec.

Preparing an Industrial Design Application

Application Form

An application for registration of an industrial design is required in duplicate, and should conform to the sample application form shown on page 10.

Appointments of agent and claims for priority are to be made separately from the form.

Applications are to be made only in the name of the author or the proprietor, as provided by Section 8 and 12 of the Act.

The title of the design must identify a particular article of manufacture, or a set of articles.

An application may contain the original design and other representations of the design if the original design features in each representation do not differ sufficiently to render any representation original over another and if the article or articles are of a similar nature.

A description, stating with reasonable certainty what the design is and what the Applicant believes to be its original, visual

features, is required in addition to the drawing. The description should relate only to ornamental features applied to and or residing in the shape or configuration of the particular article of manufacture and should not contain references to non-registrable subject-matter, such as principles of construction, a process or method of manufacture, a functional feature, the useful purpose that the design is intended to serve, or does serve, etc.

Drawings

Two copies of the drawing on good quality 8½ x 11 or 8 x 13 white paper or tracing cloth and one additional copy on 2 or 3 ply, pure white, 8 x 13 Bristol Board sheet are required. The two soft copies form part of the registration itself and the third copy is used for classified search files.

For the convenience of applicants the Industrial Design Office will accept five photographs filed in lieu of drawings. However, applicants may wish to consider that doubt has been expressed by the courts as to the validity of photographs filed in lieu of drawings.

Drawings must be prepared with clear permanent black lines and should show the article of manufacture named in the title in full lines. At the discretion of the examiner broken or stippled lines are accepted in some instances, e.g. to distinguish surrounding structure from the designed article.

Stippled or broken lines which disclose hidden structural or functional details which do not form part of the design should not be included.

Cross-sectional views

The Industrial Design Office will allow cross-sectional views. Such views should be intended to disclose the exterior profile of the design of an article at any given place. The exposed cut surface should be indicated by oblique parallel sectional lines and should not suggest a specific type of material by way of symbolic section lines. The exposed cut surface may also be shown by a solid black area. However, the description may not refer to anything that can be seen only by means of such lines.

Drawings should relate to one particular design and, where applicable, to further representations thereof.

Where an article is made up of a number of components the drawing should disclose the completely assembled article. Exploded views should not be included.

Any letter or word appearing in the drawings must either be shown in stippled lines or disclaimed in the descriptive portion of the application.

Neither the title of the industrial design nor any descriptive matter or name shall appear on any part of a drawing sheet, but each sheet may bear in the lower right-hand corner the signature of the proprietor or his agent.

Under section 14 of the act, registration of a design must be completed (not merely filed) within one year of publication in Canada.

Applications are normally examined in chronological order of filing. However, when a request is made for early examination because of prior publication (section 14), such requests will be acted upon if the applicant states the date of first publication of the design in Canada and provides proof of same.

APPLICATION FOR REGISTRATION OF AN INDUSTRIAL DESIGN
(to be made in duplicate)

I, (we) _____

whose full post office address(es) is (are) _____

hereby request you to register in the name(s) of _____

_____ whose full post office address(es) is

(are) _____

an Industrial Design for a _____

of which I (we) am (are) the _____ proprietor(s).

I (we) declare that the said Industrial Design was not in use to my (our) knowledge by any other person than myself (ourselves) at the time of my (our) adoption thereof.
The said Industrial Design is characterized by

A drawing of the said Industrial Design is hereunto annexed.

Signed at _____ this _____

day of _____ 19____, in the presence of the two undersigned

witnesses:

Signature

Witnesses:

(1) _____

(2) _____

Address to:
The Commissioner of Patents,
Ottawa-Hull,
K1A 0C9

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