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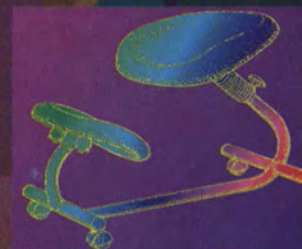
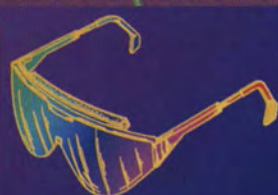


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CANADIAN INTELLECTUAL PROPERTY OFFICE

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A GUIDE TO INDUSTRIAL DESIGNS



Canada



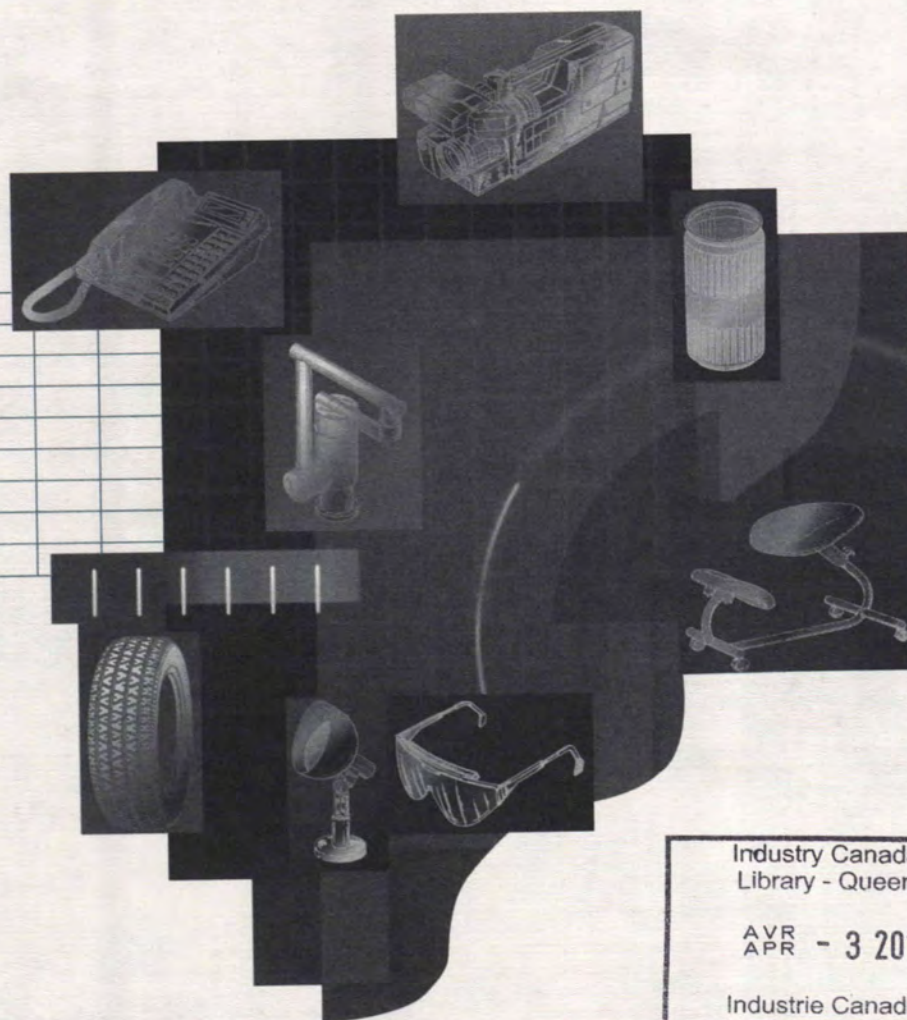
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Industrie Canada
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(819) 953-1075

A GUIDE TO INDUSTRIAL DESIGNS



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I N D U S T R Y C A N A D A

The information in this booklet is to be considered solely as a guide and should not be quoted as or considered to be legal authority. It may become obsolete in whole or in part at any time without notice. Authority must be found in the *Industrial Designs Act*, the Industrial Designs rules, and in decisions of the courts interpreting them.

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INTRODUCTION

A well-designed chair is not just a pleasure to sit on, but a pleasure to look at as well. This can be said for almost every manufactured product: its success in the marketplace will depend not only on its functionality, but on its aesthetic appeal as well. That is why manufacturers invest a great deal of money and know-how in industrial design and why an original design is considered valuable intellectual property.

If you are the creator of, or an investor in, an original industrial design, Canadian law offers you protection from unlawful imitation of your design. The *Industrial Design Act*, like other forms of intellectual property legislation, works to protect owners while promoting the orderly exchange of information. The way to obtain such protection is to register your design with the Canadian Industrial Design Office.

Your industrial design is worth a great deal in time and money, and it may mean the success of an entire enterprise. It pays to protect your intellectual property by knowing your rights and how to use them.

Purpose of this guide

In this guide we will look at what industrial designs are, what makes them "registerable," the advantages of registration and how to go about it. Keep in mind that this booklet offers general information only and does not cover all the complex issues that may arise throughout the registration procedures. It should also be noted that this booklet is not an authoritative guide on Canadian law regarding industrial design.

For exact definitions and detailed regulations, consult the *Industrial Design Act*, the *Industrial Designs Rules* and legal texts on intellectual property available in many libraries. The Canadian Industrial Design Office can also provide further information.

The Canadian Industrial Design Office

The federal agency responsible for registering industrial designs is the Canadian Industrial Design Office. The Office is part of a larger agency called the Canadian Intellectual Property Office (CIPO), which is part of Industry Canada. In

addition to industrial designs, CIPO is responsible for other forms of intellectual property. These are:

■ **patents** – for inventions, that is, new kinds of technology (process, structure and function) and, in certain circumstances, patent protection also may be available for computer software;

■ **copyrights** – for literary, artistic, dramatic and musical works and computer software;

■ **trade-marks** – words, symbols, or combinations of these, used to distinguish the goods or services of one person or organization from those of another; and

■ **integrated circuit topographies** – the three-dimensional configurations of electronic circuits embodied in integrated circuit products or layout designs found in semiconductor chips.

What is an industrial design?

An industrial design is the shape, pattern or ornamentation applied to a useful article that is mass-produced. It may be the shape of a table, the ornamentation on the handle of a spoon, and it may be made by hand, tool or machine.

The design must have features intended for visual appeal, but the Design Office will not judge the quality or merits of those features.

Other forms of intellectual property

People often confuse industrial designs with other forms of intellectual property.

A **copyright** is legal protection for an artistic endeavour. Often an industrial design is first created as a work of art, and as such, is originally protected by the *Copyright Act*. An artistic work is protected under the *Copyright Act* automatically, but a design is protected under the *Industrial Design Act* only if it is

registered. Therefore, it may be a good idea to register your design, even if you have copyright protection for the original art. If you are in doubt about the appropriate course, it may be wise to consult a lawyer or a registered patent agent.

Patents are for new inventions or processes that offer innovative and useful functions. Canadian law regards the functional aspects and design aspects of articles quite separately. Therefore, you cannot list a function as an element of your industrial design. You may, however, be able to obtain a patent for your article's functional aspects and an industrial design for its aesthetic ones. Suppose you develop a new kind of folding chair. The way the chair folds, its lightweight construction, its strength and its durability are all functional qualities. The industrial design features would include the shape and ornamentation of the chair, any patterns on it and its appearance (folded and unfolded).

Trade-marks are used to distinguish the goods or services of one person or organization from those of another. A design feature of a product or its packaging can be an aspect that distinguishes it from someone else's product. You can register such a feature as an industrial design and, in a separate process, as a trade-mark. Suppose, for example, you created a soft drink bottle with a unique shape. You could register the shape with the Industrial Design Office and later as a "distinguishing guise" (a type of trade-mark) with the Trade-marks Office. Keep in mind that for your bottle to be considered a trade-mark it must be put on the market and become associated with your product. Therefore, to ensure maximum protection, you might wish to seek industrial design registration first.

To be eligible for registration with the Industrial Design Office your design must be original and you must be producing the article in quantity or intending to do so.

When to file an application

There is no time limit for filing an application as long as the design has never been published. The term "published" in this context means that the design has been made public or offered for commercial use. It is best to file as quickly as possible if publication has occurred. You must file within 12 months of publication or you will lose your exclusive rights to the design.

In making a decision about whether your design can be registered, the Industrial Design Office may ask for further information. Such information may be needed if it appears that:

- the article is a component of a larger machine or part of another article which is purely functional;
- users will never see the article in the form disclosed by the application;

- the article is normally not visible when used; or
- the description portion of the application describes utilitarian features.

Why you should register

The advantage of registering your industrial design is that it gives you exclusive rights to your design. Registration enables you to prevent others from making, using, renting or selling your design in Canada for up to 10 years. Keep in mind that, **unless you register your design**, you can make no legal claim of ownership and have no legal protection from imitation. This is different from trade-mark and copyright protection, which allow you to claim ownership even without registration.

Who can apply?

Only the proprietor of a design may apply for and obtain registration for an industrial design. Usually, you are considered the proprietor if you have created the design. However, if you've been hired under contract to develop a design by someone else, then that person is the proprietor and is the only one entitled to apply for registration.

If you work together with other people to create a design, you should file for registration as joint proprietors (unless you are all working under commission).

If you have acquired ownership of a design then you may apply.

If you are an employee of a company and develop a design as part of your employment, then the employer may be the proprietor. In that case only the employer may apply.

Industrial design registration is valid only if applied for and obtained in the name of the proprietor. You will save yourself time and expense by resolving the issue of ownership **before** applying for registration.

Before you file

You may come to the Industrial Design Office in Hull, Quebec, to conduct a search of Office records prior to application to determine whether your design is truly new and original. The Office will explain search procedures to you but will not conduct the search for you. This may give you the opportunity to see other designs. You should also keep your design confidential.

What you cannot register

You cannot register the following under the *Industrial Design Act*:

- designs for articles that serve no useful purpose;
- designs that are utilitarian only and which are not intended to provide visual appeal;
- designs that have no fixed appearance (for example, the changing shapes of a beanbag chair);
- designs for components that are not clearly visible (for example, features that are hidden from view under a casing);
- a method of construction;
- an idea;
- materials used in the construction of an article;
- the useful function of the article (see discussion of patents in section above); or
- the colour as such (other than a pattern that may be created by an arrangement of contrasting colours).

How long the process takes

In order to meet the obligation of an international treaty signed by Canada, the Office does not register any design until six months after the date of filing. Therefore, normally, it takes between 6 and 12 months to have your application examined and registered by the Office.

The Office examines applications on a first-come, first-served basis. If your application is properly prepared, registration will occur as quickly as possible. But if the application is not complete or incorrectly completed, the process will take longer, in which case the speed of registration will depend very much on how quickly you respond to queries, requests for changes, and other information from the Office.

You may be granted faster service if you believe that your design has already been, or is about to be, imitated by someone else. In such a case, the Office will proceed with examination as soon as you notify the Office.

How long registration lasts

As of January 1, 1994, registration is for a ten-year term. Before the expiry of five years from the date of the registration of the design, a maintenance fee must be paid. Once the term has expired, anyone is free to make, use, rent sell the design in Canada.

For designs registered prior to January 1, 1994, registration is for a five-year term renewable for a further five years. Once these terms have expired, anyone is free to make, use, rent or sell the design in Canada.

Fees

You must pay a fee to have your application examined by the Industrial Design Office. There are additional fees for renewal and late renewal of a design registered prior to January 1, 1994, and for maintenance and late payment of the maintenance fee of designs registered after January 1, 1994. Fees are subject to change without notice. (For details about fees, see page 18.)

Getting help with your application

You may file your own application for industrial design registration, and the Industrial Design Office will give you the basic information you need to do so. The Office will not, however, prepare your application or conduct a registrability search of existing designs for you.

The Office will not express opinion about the aesthetic or commercial merits of your design or tell you in advance of filing whether it qualifies for registration.

However, drafting an application requires much careful attention to detail and knowledge of the regulations. For this reason, you may hire a registered patent agent to prepare and "prosecute" – that is, to follow through on – your application. Most industrial design applications are done in this way. Registered patent agents are experienced in the field.

You may obtain a list of registered patent agents by contacting the Canadian Intellectual Property Office. The Office will not recommend any particular agent and does not regulate their fees.

Preparing your application

A complete application for an industrial design has four basic elements which are required by the *Industrial Design Act*:

- a written description of the original features of the design;
- drawings or photographs of the design;
- a declaration (see following section, "The application form"); and
- the required fee(s).

In addition, foreign applicants must provide the name and address of someone in Canada who will act as their representative for service.

The application must follow the format of an official form that can be obtained free of charge from the Industrial Design Office or from your regional Industry Canada office. The Office will also provide you with a filing certificate and a checklist. Samples of the various forms are presented in Appendix B.

The application form

You will find an example of a blank application form in Appendix B of this guide.

Remember the following important points when you complete your application:

- Only the current proprietor of a design (see p.6) can file an application.
- You must sign your application. It includes a declaration that you are the proprietor of the design and that, to your knowledge, no one else used the design before you or the first proprietor.
- Your application must include a description and drawings or photographs of your design as it is, or will be, incorporated in an article of manufacture.
- If you don't have enough room to complete your description on the first page of the application form, please continue on a separate sheet of paper. Do not finish the description on the back of the form.

■ You must use the generic or common name of the article that the design is applied to in the title that appears in your application. (For example: "lighter," "chair," "spoon," "T-shirt.")

■ You must provide your full mailing address.

Send the completed application to:

Industrial Design Office
Canadian Intellectual Property Office
Industry Canada
Ottawa, Ontario
K1A 0C9

Any correspondence sent to the Industrial Design office through the priority courier service of Canada Post Corporation will be considered received by the Office on the date stamped on the envelope by the priority courier service.

The description

The description you set out in your application must be of the **design**, not the **article** to which it has been applied. For example, do not describe a chair (four legs, a seat and a back) but rather describe the design features that make your chair visually unique.

You do not need to describe every particular of the design, but you should indicate what it is and what you believe are its original visual features.

Keep in mind that you or your agent are responsible for giving an accurate, adequate description of your design. The Industrial Design Office can only ensure that your wording meets the basic requirements of the Act. It's up to you to ensure that it covers all the distinctive features of your design.

Since the courts may use your description to help determine the limits of protection for your design, you should word your description with care and precision. If your description is too broad, you may over-extend the scope of the design, and it may be impossible to enforce. It is important to describe the important features of your design to show how it is distinctive.

Keep the following in mind when you word your description:

- You should clearly define your concept of the shape, configuration, pattern or ornamentation as applied to the article of manufacture.
- If you know that similar designs already exist, you should include enough detail in your description to differentiate your design from the others.
- You should describe which design features you consider the most important.
- You should focus your description strictly on the visual aspects of the design. Do not describe the design in terms of the article's function. For example, a distinctive tread on the

sole of a boot may have functional properties (to prevent slipping) as well as visual appeal (it's in the shape of a snowflake). Registrability is based on the aesthetic (visual) aspects only.

Drawings and photographs

Your application must include drawings or photographs of the design *as applied to the article of manufacture*. You must draw or photograph your design as it appears in the product. Detailed views may be shown separately.

The function of drawings or photographs is to show the design clearly. Drawings or photographs should be consistent with, and complementary to, the description.

A) Size and Paper Quality and Mailing Instructions – Whether you submit drawings or photographs, they should be on good quality paper, sized either 22 X 28 cm (8 1/2 x 11 inches) or 20 X 33 cm (8 x 13 inches). They must be able to be clearly reproduced by photocopying equipment.

You must send all your drawings flat, not rolled, and they should be protected by a heavy sheet of cardboard.

B) Margin – There must be a clear margin of approximately 2.5 cm (or 1 inch) on the left-hand side of the paper.

C) Character of Lines/Quality of Photograph – In the case of drawings, make every line, no matter how fine, with black ink and ensure that they are permanent. All lines must be clear and full. Avoid fine or crowded lines.

You may use dotted or stippled lines to distinguish surrounding structure, but the article itself must be shown in solid lines. You have the option of highlighting the design features with heavy black lines or by other means as long as the result is clear and can be reproduced by photocopying equipment. Do not include stippled or broken lines which depict hidden structural or functional details that are not part of the design.

Photographs must show every feature of the design clearly. The angle from which the photograph is taken must not distort the true image of the article, and it must stand alone against a neutral (blank) background.

D) Scale – All drawings must be sufficiently large so that what is described can be clearly seen. They must also be consistent in terms of scale (except for enlargement views) and must be easily readable.

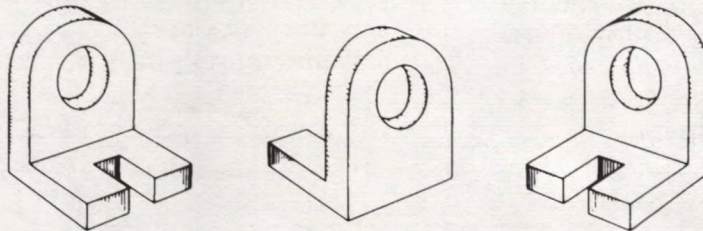
E) Content – Your drawing or photograph should show every feature of the design as applied to the article into which it has been incorporated. This may require more than one view. The Design Office will not amend your drawings.

F) Number of Views – Your drawings or photographs should contain as many views as are necessary to present your design clearly.

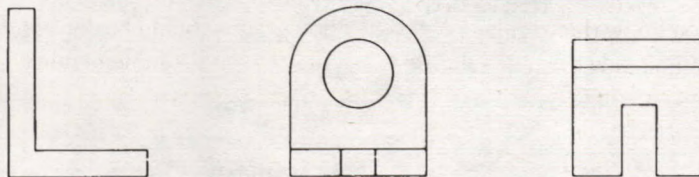
G) Arrangement of Views – All the views on one sheet should stand in the same direction and be readable in an upright position. You must not superimpose one figure on another or place it within the outline of another.

If views that are longer than the width of the paper are necessary for clear illustration of the design, you may turn the sheet on its side. The previously indicated 2.5 cm margin would then be on top.

H) Types of Views – We recommend perspective types for best presentation. Here are some examples:



Other means of illustration are also acceptable, for example:



I) **Shading** – You may use shading in drawings if you wish. Standard practice is the use of heavy lines on the shaded side of the object.

J) **Miscellaneous Features** – Occasionally, you will need to show the following features: open and closed positions, cross-sectional views (hatching), fragmentary views, flexible articles, transparent articles, and indefinite length and repeat patterns.

Your drawings or photographs may show views of the article in both open and closed positions or in extended and retracted positions *only* if such views are necessary to reveal design features referred to in the description and if the article is normally seen and used in these different positions.

You may present a cross-sectional view if this is necessary to show the exterior profile of the article. Indicate the exposed cut surface by oblique parallel sectional lines. Do not use symbolic section lines to suggest a specific type of material.

If your article is made up of a number of components, the drawings or photographs should show the assembled article. Do not present exploded views.

Further or more specific information on how to present these features is available by contacting the Industrial Design Office.

K) **Identification** – The title, descriptive matter, dimensions or names should not be included on the drawing, but you may put your signature (as proprietor) on the lower right-hand corner of each sheet.

L) **Samples** – The Office may ask you to provide a sample of the design (e.g. a swatch of textile fabric) to supplement the drawing or photograph.

Keep in mind that the purpose of the above rules is to allow the examiners to see your design clearly as consumers would see it.

Multiple representations of the same design

Your industrial design application must be limited to a single design, but you may include several representations or variations of that design. These representations must meet the following conditions:

- The original design features in each representation should not differ significantly.
- The article or articles to which the design is applied must be of a similar nature.

You may add multiple representations of a single design to your application any time *before* registration. You do not have to pay additional fees to do this. But if you change your design substantially, you will have to submit a new application. Once your design is registered, no further changes can be made.

If your series of drawings does not meet the above conditions, you will have to choose one and delete the rest from the application.

The process of obtaining a design registration is made up of three distinct phases:

- initial processing (when you file the application),
- examination (three to six months after filing)
- registration, that is, the production of the registration certificate (at least six months after filing unless there is a convention priority claim)

Initial processing

Your application will undergo a preliminary review by clerical staff to ensure that basic administrative requirements have been met. At this time a filing certificate will be issued; this is merely an acknowledgement that the application has been received and processed. It also gives you the number assigned to your application so that you can refer to that number in later correspondence. If the application is incomplete you will also receive a notice advising you of what is required to complete it.

Every notice or report issued by the Office will give a due date for reply. If you do not reply by that due date your application will be considered to be abandoned.

Examination

The first step in this phase of the process is the classification of your application according to the particular type of article to which it relates. This is followed by a formal assessment by an examiner who will study your description and drawings or photographs. These will then be compared with previously registered and published designs to ensure that your design is original and registrable. Your design cannot be the same or similar to a design already applied to a similar article of manufacture. The wording of the description will also be considered to see that it accurately and adequately describes the design features shown in the drawings. Following this assessment the examiner will either allow (approve) the application for registration or issue a report. The report will outline the examiner's findings and tell you what information or amendments are required.

Amendment

If the examiner does express some concerns about your application, you will probably be able to satisfy them by providing the information or making the suggested amendments. Don't feel that you must abandon your application simply because an objection has been raised. If you do not understand the report completely, call the examiner for clarification. The phone number will be given on the report. You have four months to reply to the report, otherwise your application will become abandoned. If this occurs, you can reinstate your application by replying to the examiner's report.

A fee for reinstatement has been proposed and will most likely be implemented about July 1994.

Appeals

If you cannot satisfy the concerns expressed in the examiner's report, your application will be rejected in a final report issued by the Director of the Office. You may appeal this rejection to the Patent Appeal Board which will make recommendations to the Commissioner of Patents who will either reverse the Director's decision or reaffirm it in a final rejection. If you are still not satisfied, you may appeal the final rejection to the Federal Court of Canada whose decisions are appealable, in turn, to the Supreme Court of Canada.

Conflicts

Should different people apply to register essentially the same design, the Industrial Design Office will examine the applications on a first-come, first-served basis. The application with the earlier filing date (either the Canadian filing date, or the Convention filing date, if filed earlier in another country) will be registered.

Requests for delayed registration

It is possible that you may want to delay registration. For example, you may wish to allow time to market or file your design outside Canada. In this case, you should inform the Office in writing. You may exercise the option to delay registration at the time of filing your application or at any time before it is registered.

Registration

Once approved by the examiner your design will be registered as soon as possible, provided that the six-month waiting period required by international convention has elapsed and you have not requested delayed examination. You will receive a certificate of registration which includes the description and a drawing of the registered design. This certificate is evidence of ownership and the originality of your design and gives you the exclusive right to make, use and sell the design, *in Canada*, in whole or in part.

Duration

Designs registered prior to January 1, 1994 are valid for five years and may be renewed for a second five-year period by sending the Office a letter of request along with the renewal fee. The Office should receive your request before the first five-year term expires, but requests can still be made up to three months after the expiry date with payment of an additional fee. Your request for renewal should identify the registration by number, title and name of proprietor.

Designs registered after January 1, 1994 are valid for ten years subject to payment of a maintenance fee. That fee shall be paid by the registered proprietor or by his/her agent. Maintenance may be requested at any time during the first five-year period upon payment of the basic maintenance fee. However, a six-month grace period exists during which maintenance may still be requested but this requires payment of an additional fee. Your request should identify the registration by number, title and name of proprietor. For details about fees, see page 18.

Marking a product

You do not have to mark your product in order to indicate that it is registered as a design, but marking *does* give you extra protection. The proper mark is a capital "D" inside a circle and the name, or abbreviation thereof, of the design's proprietor on the article, its label or packaging.

If your product is marked in this way, a court could award a remedy, such as financial compensation, in the event that someone is charged and found to be "infringing" (i.e. violating) your design. If there is no such mark, the court cannot award a remedy other than forbidding the other party from using your design (an "injunction").

Enforcing your rights

As proprietor, you may take legal action against anyone who infringes your design in Canada. It is your responsibility to take such action and you must do so within three years of the alleged infringement. The Industrial Design Office will not launch legal proceedings on your behalf or police your rights in any way.

Marketing rights

As the proprietor of a registered industrial design, you have the exclusive right in Canada to make, use, rent or sell a product incorporating that design. You may also sell all or some of your rights to others (this is referred to as an assignment) or, you can simply authorize others to use the design subject to stated conditions (this is referred to as a licence).

Assignments

An "assignment" occurs when you sell all or part of your rights in the design *permanently* to another party. This party, or "assignee," assumes your ownership rights to make, use, rent or sell products incorporating the registered design and to authorize others to do so. Usually, the arrangement involves an exchange of money. The assignment must be in writing but there are no prescribed forms for this. A sample form which meets the requirements of the Office is provided in Appendix B but that sample is a very simple one which may not adequately cover the interests of both parties should there be a dispute. For that reason it is advisable that assignments be prepared with the assistance of a lawyer.

The new owner should ensure that the assignment is recorded with the Industrial Design Office. This is done by sending in either the original or a certified copy of the assignment document along with the recordal fee (for details about fees, see page 18). Recordal of the assignment allows the new owner to sue for damages if anyone infringes the design.

Assignments may be recorded against pending or registered designs.

Licences

In many cases the greatest financial benefit comes from licensing the design. When you license your design, you allow someone else to use it in accordance with the particular terms and conditions set out in the licence which are negotiated between the involved parties. In this case you retain ownership and, you can, in some instances, license more than one party. You may, for example, license one party for western Canada, another for Ontario and

Quebec and still another for the Maritimes. Similarly, you could have an exclusive licence with one party for the first five years and another with a different party for the period of the renewal. As with assignments, licences should be registered. Licences tend to be more involved than assignments and for that reason it is even more important to consult a lawyer if you are considering a licensing agreement.

Note: If you wish to seek out Canadian manufacturers who might be interested in buying, licensing or leasing your design rights, two publications would be useful: the *Canadian Trade Index*, issued by the Canadian Manufacturers' Association, Toronto; and *Frazer's Canadian Trade Directory*. Both are available in public libraries.

Registration outside Canada

Registering your design with the Canadian Industrial Design Office gives you exclusive rights in Canada only. To enjoy similar rights abroad, you must apply for them in each country separately. Most industrialized

countries have equivalent industrial design protection. A list of foreign offices is available from the Office.

The **United Kingdom** has industrial design laws that are very similar to those of Canada, and the same term, "industrial design," is used.

The **United States** uses the term "design patent" to describe what roughly corresponds to the Canadian registered industrial design. Be careful not to confuse U.S. design patents with patents for inventions.

Procedures for obtaining international design rights are partially governed by an international treaty called the *Paris Convention for the Protection of Industrial Property*. The *Paris Convention*, which has some 90 member countries, including Canada, allows applicants to invoke what is called "Convention priority." This means that someone who has

filed for design registration in one Convention country has six months in which to file an application for the design in another country and be accorded the same rights as if he or she had filed in the second country on the original filing date.

Suppose, for example, you apply to register a design in Canada on January 5, 1994. You then have until July 5, 1994 to file for design rights in any other Convention country and claim the original Canadian filing date for that country.

It is important to note that in some countries your application could be rejected if you or someone else has already registered the design previously. To assist owners of designs in Canada in avoiding this unusual situation, the Canadian Industrial Design Office gives applicants the option of delaying registration so that their application in another country can proceed at the same time as their application in Canada.

FOR MORE INFORMATION

The Industrial Design Act and *Industrial Designs Rules* will give you the details of regulations that govern design rights as they are spelled out in law. To obtain copies, contact:

The Canadian Government
Publishing Centre
Ottawa, Ontario
K1A 0S9
or any bookstore that sells federal government publications.

You can also obtain booklets similar to this one on other kinds of intellectual property (e.g. patents, copyright and trade-marks) from the Canadian Intellectual Property Office. It may be useful to consult these booklets to ensure that your work can be protected under *The Industrial Design Act* rather than copyright, trade-mark or patent laws.

For more information contact your regional Industry Canada office (consult the blue pages of your telephone directory for phone numbers), or write to:

Industrial Design Office
Canadian Intellectual Property
Office (CIPO)
Industry Canada
50 Victoria Street
Place du Portage, Phase I
Hull, Quebec
K1A 0C9

Should you wish to contact the Industrial Design Office by telephone, call (819) 997-1936.

FEES

Service

Fee Schedule - Industrial Design

1. Examining an application to register an industrial design and issuing a certificate of registration _____ \$ 160.00
 2. Maintaining a design registered after **January 1, 1994:**
 - (a) if the request is received within five (5) years of the registration date _____ \$ 215.00
 - (b) if the request is received in the six (6) months following the five (5) year period mentioned in (a) _____ \$ 250.00
 3. Examining and registering an application to register an assignment, a licence or other document affecting an industrial design and issuing a certificate of registration
 - (a) for the first industrial design referred to in the assignment, licence or other document _____ \$ 35.00
 - (b) for each additional industrial design referred to in the assignment, licence or other document _____ \$ 15.00
 4. Providing copies of or extracts from the Register, or copies of certificates, drawings, drawn copies of industrial designs or other documents
 - (a) for each sheet, when a photocopy _____ \$ 0.50
 - (b) for each sheet, when typed _____ \$ 5.00
 5. Certification of copies of documents
certification document costs \$15.00 plus charge for photocopies of application at \$0.50 a page
e.g.: certification _____ \$ 15.00
5 pages of application _____ \$ 2.50
- TOTAL \$ 17.50**

APPENDIX A - SOME COMMON QUESTIONS ABOUT INDUSTRIAL DESIGNS

Q1. What is an industrial design?

A. An industrial design is any original shape, pattern or ornamentation applied to a useful article of manufacture. Examples include the shape of a table, the ornamentation applied to the handle of a spoon. The article can be made by hand, tool or machine.

Q2. Must I register my industrial design in order to be protected?

A. Yes, there is no protection without registration.

Q3. What cannot be protected by an industrial design?

A. The following cannot be protected:

- a manufacturing process;
- 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;
- ideas; or
- for articles that serve no useful purpose.

Q4. Can I register my design as an artistic work under the Copyright Act?

A. If your design was originally created as a work of art, it would have been protected automatically under the **Copyright Act**. But once you use it, or intend to use it, as a model or pattern to produce more than 50 single useful articles or sets of articles, it 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 legal advice on this matter.

Q5. If I register my design in Canada, am I protected in other countries?

A. No. You can obtain protection in other countries only by filing in each country separately.

Q6. Is there a time limit for filing an application for registration?

A. No, unless there has been "publication" (i.e., the design has been made public or offered for commercial use). In that case, you must file an application within 12 months of the publication date.

Q7. What papers do I need in order to apply for industrial design registration?

A. You must send in drawings or photographs of your design as well as a written description of the design's original features. You also must sign a declaration 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. Your application must be in accordance with the form entitled "Application for Registration of a Design," which is included in Appendix B of this booklet.

Q8. What type of description do I need to include?

A. The description does not have to detail every aspect of the design, but it must state clearly what the design is and what its original features are. You should describe the visual aspects of the design only (i.e. shape, pattern and ornamentation). Do not refer to how the article functions or performs. You may use geometric terms to describe your design.

Q9. What type of drawings or photographs are necessary?

A. Whether you submit drawings or photographs, they should be on good quality paper, either 22 x 28 cm (8 1/2 x 11 inches) or 20 x 33 cm (8 x 13 inches). They should be easy to reproduce clearly by photocopying equipment.

Q10. If I have a registered design, do I have to put any marking on the articles to indicate this?

A. Marking is not required. However, it is helpful in the event of a court proceeding. If there is no mark, the court cannot award a remedy other than an injunction, which will prevent further infringement on your design. The proper mark is a capital "D" in a circle and the name, or abbreviation thereof, of the design's proprietor on the article, its label or packaging.

Q11. If I see a good design outside Canada and it does not appear to be on the market in Canada, can I register that design under my name here?

A. Not unless you have acquired ownership of the design.

Q12. How will the Industrial Design Office know if I did not originate the design?

A. The examiner searches through records of registered designs to determine whether anyone else already owns the design, or one so similar that yours would be considered an imitation. If so, your application will be refused. If the search does not disclose a similar design, your declaration of originality will be accepted and the design registered. It should also be noted that the courts have the power to overturn an invalid declaration at a later date.

Q13. Can anyone make a search through Industrial Design Office records to see what has been protected previously?

A. Yes, anyone can conduct a search free of charge. All materials are located in the Industrial Design Office, in Hull, Quebec. Design Office staff will give you the basic information you need to do the search. You may also obtain copies of drawings and other documents at a nominal fee (see the previous section entitled Fees).

Q14. May non-Canadians register their designs in Canada?

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

Q15. If I sell my rights to a design to someone else, do I need to inform the Industrial Design Office?

A. It is advisable to register the sale of rights, or "assignment," as it is known, with the Industrial Design Office. 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.

Q16. Would the Industrial Design Office stop someone else from infringing my design?

A. No. This responsibility rests with the owner of the design. You must start any legal action within three years of the alleged offence.

Q17. Can I get help in filing an application for industrial design protection?

A. Yes. The Industrial Design Office will give you information on procedures for filing an application. Also, there are registered patent agents you can consult who have experience in this area. Look for them in the yellow pages of the telephone book under "Registered Patent Agents" or write to the Industrial Design Office (see page 17)

APPENDIX B - INDUSTRIAL DESIGN FORMS

OPIC OFFICE DE LA PROPRIÉTÉ INTELLECTUELLE DU CANADA	 CIPO CANADIAN INTELLECTUAL PROPERTY OFFICE	
PARTIE A - CERTIFICAT DE DÉPÔT PART A - FILING CERTIFICATE		
		N° de référence du client - Client's reference no.
← Nom et adresse du requérant ou de l'agent Name and address of applicant or agent		
Requérant - Applicant		
Article fabriqué - Article of manufacture		
<input type="checkbox"/> Le requérant invoque la prérogative relativement à une demande produite à l'étranger: Applicant claims convention priority on the basis of the following foreign application:		
Pays - Country	Date A-Y M J-D	N° de la demande - Application No.
A L'USAGE DU MINISTÈRE SEULEMENT - FOR DEPARTMENTAL USE ONLY		
N° de la demande - Application No.	Date de dépôt Filing date A-Y M J-D	Priorité de la convention demandée Convention priority claimed <input type="checkbox"/> Oui Yes <input type="checkbox"/> Non No
Motif - Reason		Approuvé - Approved <input type="checkbox"/> Oui Yes <input type="checkbox"/> Non No
PARTIE B - LISTE DE CONTRÔLE PART B - CHECKLIST Ci-joint les documents et les droits perçus - The following papers and fees are enclosed		
<input type="checkbox"/> Formulaire de demande Application Form	<input type="checkbox"/> Dessins / Photographies Drawings / Photographs	<input type="checkbox"/> Officiels Formal
<input type="checkbox"/> Droits pour l'examen Fees for examination	Montant Amount \$	<input type="checkbox"/> Autres droits Other fees
Montant Amount \$		Montant Amount \$
A compléter seulement si le requérant n'a pas une adresse Canadienne - To be completed only if the applicant has no Canadian address		
La représentation aux fins de signification est - The representative for service is:		
<input type="checkbox"/> même que le mandataire same as agent	ou or	<input type="checkbox"/> Nom - Name
Adresse / Address		
REMARQUES - REMARKS		
Signature	Cet espace est réservé pour la validation du ministère This space reserved for departmental validation	
Téléphone - Telephone	Date A-Y M J-D	
Direction du droit d'auteur et des dessins industriels 50, rue Victoria Place du Portage I Hull, Québec K1A 0C9 Industrie Canada		
Copyright and Industrial Design Branch 50 Victoria St. Place du Portage I Hull, Quebec K1A 0C9 Industry Canada		
7130-21-8056-1546 (11-92) 43 CLIENT: SÉPAREZ ET CONSERVEZ LA PARTIE B DE LA COPIE BLANCHE CLIENT: DETACH AND RETAIN PART B OF WHITE COPY FOR YOUR RECORDS		



Consumer and
Corporate Affairs Canada

Consommation et
Affaires commerciales Canada

CIPO
Canadian Intellectual
Property Office

OPIC
Office de la propriété
intellectuelle du Canada

Industrial Design

Dessin industriel

**APPLICATION FOR REGISTRATION
OF A DESIGN
DEMANDE D'ENREGISTREMENT
D'UN DESSIN**

The applicant,
Le demandeur, _____

(name of applicant-nom du demandeur)

whose complete address is
dont l'adresse complète est _____

hereby requests registration of a design for a
demande l'enregistrement d'un dessin pour un(e) _____

(title identifying article-désignation de l'objet)

of which the applicant is the proprietor.
dont il est le propriétaire.

The design was not, to the proprietor's knowledge, in use by any person other than the first proprietor at the time
À la connaissance du propriétaire, personne d'autre que le premier propriétaire du dessin n'en faisait usage

the design was adopted by the first proprietor.
lorsque celui-ci en a fait le choix.

Description of the design:
Description du dessin:

Drawing(s) / photograph(s) of the design is (are) included.
Esquisse(s) / photographie(s) du dessin est (sont) ci-incluse(s).

Signed at _____ on _____
Signé à _____ le _____
(place) (date)

(Signature of-Signature)

- ☐ Applicant-Demandeur
☐ Agent for the Applicant-Mandataire du demandeur

Copyright and Industrial Design Branch
50 Victoria Street
Place du Portage, Tower I
Hull, Québec
K1A 0C9

Bureau du droit d'auteur et des dessins industriels
Place du Portage, Tour I
50, rue Victoria
Hull (Québec)
K1A 0C9

7530-21-906-2241 (06-93) 43

N° d'enregistrement
Registration No.

Document
Document

Ayant trait
Affecting

Inscrit au Bureau des dessins industriels à Hull, Canada ce
Recorded at the Industrial Design Office at Hull, Canada on

Commissaire des brevets - Commissioner of Patents

APPENDIX C - GLOSSARY

Application – The formal request for an industrial design. The complete application has four main elements: description, drawings or photographs, declaration and fees.

Assignment – The permanent transfer of design rights from the owner to another party.

Canadian filing date – The date your completed application is officially received at the Industrial Design Office (not to be confused with the registration date at the end of the process).

Canadian Intellectual Property Office (CIPO) – The federal government agency responsible for industrial designs and other forms of intellectual property, including patents, trade-marks, copyrights and integrated circuit topographies.

Certificate of registration – Official confirmation that your design has been registered.

Convention filing date – The date that is recognized as your global filing date if you file for design registration in more than one country (provided these countries are signatories to the *Paris Convention*).

Convention priority – A protocol that gives you six months to file for design registration outside Canada after your original filing date. Convention priority applies in countries that have signed the *Paris Convention* (see definition below).

Copyright – Legal protection for literary, artistic, dramatic or musical works, and computer software.

Declaration – Formal statement that you are the proprietor (see definition) of the design and that, to your knowledge, no one else was using the design when you created it.

Description – A concise description of the original features of an industrial design. The description is a basic requirement of a registration application.

Design patent – The term used in the United States to describe a form of protection similar to that of industrial design protection in Canada.

Drawings – Drawings or photographs disclose the industrial design and are a basic requirement of a design registration application.

Examination – The procedures the Industrial Design Office undertakes to ensure that a design may be registered. The main objective is to determine that the design is indeed a design (not a function) and that it is original.

Industrial design – An original shape, pattern or ornamentation applied to a useful article of manufacture. Examples include the shape of a table or the decoration on the handle of a spoon.

Industrial Design Act – Legislation governing registration and ownership of industrial designs in Canada.

Industrial Design Office – The federal agency responsible for registration of industrial designs.

Licensing – Transferring design rights from the owner to another party on a temporary basis.

Maintenance fee – Fee required in order to maintain the rights to an industrial design for a second five-year period for designs registered after January 1, 1994.

Marking – Signalling that a design is registered by placing a capital “D” in a circle – along with the name, or abbreviation thereof, of the design’s proprietor (see definition below) – on the object to which the design has been applied, or to its label or packaging.

Paris Convention for the Protection of Industrial Property – An international treaty on intellectual property signed by some 90 nations, including Canada.

Patent – A government grant giving the right to exclude others from making, using or selling an invention.

Proprietor – The proprietor of an industrial design is the owner of the design. This can be the person who created it or who paid to have it created or who bought the design rights from the original owner.

Publication – Publication of a design is the act of making it public or available for commercial use.

Registration – The granting of formal recognition of an industrial design by the Industrial Design Office.

Renewal fee – Fee required in order to renew the rights to an industrial design for a second five-year period for designs registered prior to January 1, 1994.

Representative for service – A person in Canada appointed by the applicant or registered proprietor to receive documents on his/her behalf.

Search – The act of searching through registered and published designs in the Industrial Design Office records to verify whether a design is original.

Trade-mark – A word, symbol or design, or combination thereof, used to distinguish the goods or services of one party from those of another.

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A guide to industrial designs

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