

IP monitor

Better by design: significant changes coming to Canada's industrial design legislation

July 2018

Intellectual property

Canada's industrial design regime will be changed substantively with the coming into force of new legislative provisions on November 5, 2018. The new legislation will modernize the regime by implementing the Hague Agreement, aligning Canada with international practice in various respects, and simplifying and codifying various rules.

These changes will coincide in date with amendments to the *Patent Rules* and *Trade-marks Regulations* relating to requests for reinstatement and automatic extension of time limits.

Industrial Design Act and Industrial Design Regulations: changes

In addition to many formal changes, certain changes are of note and briefly described below:

Application to Register

- **Interpretation of Design Features** – Guidelines are now explicit in the legislation: absent statements of limitation, an application relates to all features of shape, configuration, pattern, and ornament shown in the representation of the design that, in the finished article, appeal to and are judged solely by the eye, excluding features shown in dotted or broken lines or by means of blurring or colouring indicating that the application does not relate to the feature.
- **Representation of a Design** – You must provide “photographs, graphic reproductions, or any other permissible visual reproduction” and at least one “photograph or reproduction” that shows the design or finished article in isolation. You are no longer restricted to a “drawing or photograph” of the design.
- **Description** – You no longer need a description.

Office Action Responses – In an effort to prevent intentional delay, you now have three months (with one extension of six months) to respond to an office action.

Application Amendments – There are now clarifications on the rule that amendments cannot substantially alter the design. For example, after publication, the name of the finished article cannot be changed to the name of a substantially different finished article.

Divisional Applications

- **Content** – You can now file a divisional for designs merely disclosed in the original application, rather than only certain designs that were applied for in the original application. Accordingly, voluntary divisional applications can now be filed even when no lack of unity objection has been raised, to pursue designs and/or design features not originally claimed (e.g., features shown in broken lines or as part of an environmental view).
- **Timing** – You must file a divisional within two years after the earliest original application (i.e., a chain of divisional applications to extend this deadline is not permitted). Divisionals filed in response to a unity objection are not subject to this two-year limit.

Grace Period – An applicant-derived public disclosure will not be novelty destroying if made within 12 months of the priority date of an application. Also, in order to address previous self-collision issues, an earlier Canadian application will not be novelty destroying for a later Canadian application by the same applicant if the second application is filed within 12 months of the first.

Publication – A design application is no longer published only upon registration, but at 30 months after its filing date or priority date (as applicable) if that date is earlier.

However, the publication date of a Hague application will be the publication date of the international registration, which is generally six months after its registration.

Term – This is no longer simply 10 years from the registration date. Instead, the term:

- **begins** at the later of: 1) the registration date and 2) the publication date; and
- **ends** on the later of: 1) 10 years after the registration date and 2) 15 years after the filing date.

As a result, design protection for almost 15 years after registration may be possible if there is minimal delay between filing and registration.

Delayed Registration – This is limited to a delay of 30 months after the earliest filing date.

Hague Applications

Although Canada is not yet a contracting party to the Hague Agreement, the new regulations set out the framework for when Canada accedes to the Hague Agreement. Once this occurs, a single international application can be used to register an industrial design in multiple member countries, including Canada. It will also encourage foreign applicants to apply for protection in Canada.

How it works – An international application is filed at the International Bureau (IB), which checks for formalities. The IB publishes the design six months after its registration, unless you request otherwise (subject to restrictions). After publication, each designated country can begin substantive examination and grant or refuse protection.

Filing – The filing date in Canada is the date that the corresponding international application is registered.

Registration – The registration date in Canada is the earlier of: 1) the date a statement of grant is sent by the minister and 2) if the minister does not send a notification of refusal, 12 months after the international registration is published.

Term – You have the exclusive right in Canada for your design up to a maximum of 15 years from the filing date.

Patent Rules and Trade-marks Regulations: changes

Changes to the *Patent Rules* and *Trade-marks Regulations* also come into force on the same day as the changes to the industrial design regime and are summarized below.

Requests for Reinstatement – A single request for reinstatement of a patent application may be submitted in respect of all failures to take action if that request is made within 12 months after the abandonment due to the first failure to take action. On requesting reinstatement, a separate fee must be paid for each failure to take action. Presumably, you can still reinstate an application in respect of only a single failure while remaining abandoned for one or more other failures.

Time Limits Extended – Time limits expiring when the office is simply closed to the public for all or part of that day during ordinary business hours are extended to the next day on which the office is open for business. This change allows correspondence to be considered timely received even if it arrives on the deadline and the office is unexpectedly closed, such as during the ice storm of 1998.

We are happy to guide you through obtaining protection for your patents, trade-marks, and industrial designs. Contact us if you have any questions.

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For more information, please contact your IP professional at Norton Rose Fulbright Canada LLP.

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