

Industrial design protection becomes more animated and colourful in Canada

JANUARY 16, 2017 4 MIN READ

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In what may be the biggest update to Canadian industrial design practice in years, long-awaited changes have finally arrived in Canada. Following consultations with stakeholders and industrial design practitioners, on January 16, 2017, the Canadian Intellectual Property Office (CIPO) announced six new office practices aimed at improving service to stakeholders, applicants and practitioners alike by reducing administrative burdens and aligning Canadian industrial design practice with Canada's international trading partners.

The six practice changes are directed to:

1. computer-generated animated designs
2. colour – now recognized as forming part of the design
3. shorter time limits to respond to office actions
4. earlier examination through earlier prior art searches
5. new notices of possible refusal
6. increased certainty for requests to delay registration

These six notices are briefly summarized in greater detail below.

Computer-generated animated designs:

The previous practice was to examine the different states of a computer-generated animated design as distinct designs rather than variants. Now, the Industrial Design Office (IDO) will consider the drawings as one design, viewed as a sequence of frames.

All newly filed applications that have not already been divided will be examined according to this practice. If an application is pending, applicants may petition the IDO to re-examine it in view of the new practice.

This change modernizes Canadian practice consistent with international practices, and is reflective of new technologies.

Colour as registerable design feature:

Until now, in Canada colour was not considered a design feature and therefore was not registerable as industrial design subject matter. The only exception was images of tartans (usually a fabric). This practice limited the scope of industrial design protection for many applicants.

With this practice change, the IDO will consider colour as a part of a *combination* of features that constitute a design. However, if colour is the only feature of the finished article itself, colour, *per se*, still will not be registrable.

This is a key change for applicants in Canada, expanding the allowable subject matter consistent with international practice. Our clients will now be able to file applications in Canada that previously were not allowable.

Time limits to respond to office actions:

The period of time to respond to office actions has been reduced from four to three months, unless otherwise specified by the IDO. This deadline conforms to international standards, and will result in a more timely issuance of industrial designs.

Timing of search to assess the originality:

Again, to reduce the time for examination, prior art searches will be conducted by the IDO as early as six months from the date of priority (rather than the Canadian filing date), in the case where the applicant voluntarily submits a certified copy of the foreign application upon which the priority claim is based. Previously, the IDO conducted a prior search no earlier than six months from the Canadian filing date.

Our clients will be able to take advantage of this practice change to obtain earlier examination, and earlier registration, of their designs.

Issuing notices of possible refusal:

Previously, following issuance of a Final Report, if no response was filed by the due date and no steps were taken to reinstate the application after six months from the date the response was due, the application was considered inactive. However, no notice was provided by the IDO to the applicant.

Effective January 16, 2017, the practice of issuing a "Final Report" will cease and be replaced by a "Notification of Possible Refusal." Once the notification of possible refusal has been issued, the applicant will have three months to request a review of the file by the Patent Appeal Board (PAB). If no response is received within three months of the notice, the application will be considered for refusal and the decision, taken on behalf of the Minister by the PAB, will be communicated to the applicant by way of an office letter.

It is hoped that this will provide more certainty to applicants and third parties in the marketplace regarding the status of applications in Canada.

Delaying registration:

Until now, a request to delay registration commenced when the request was received by the IDO. This raised some uncertainty for stakeholders as to when the period of delay would take effect and how long it would last.

Starting January 16, 2017, upon payment of the delay of registration fee, registration will be delayed for up to six months, commencing on the latest of the following dates:

- (i) the date of allowance of the subject application;
- (ii) the date a previous delay of registration has expired; or
- (iii) the date the request was received.

The implementation of these new practice procedures by the IDO should result in more timely industrial design registrations, more efficient prosecution, at less cost and with greater certainty. These changes should increase the number of clients seeking design registrations in Canada as part of their international strategy.

If you have any questions or wish to discuss the new CIPO industrial design practice notices, please contact J. Bradley White (Chair of Osler's Intellectual Property Department) or Clark P. Holden, Ph.D. (Patent Agent, Ottawa).

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