

INDUSTRIAL DESIGN PROTECTION IN CANADA: CHANGES BEFORE THE OFFICE JANUARY, 2017

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Industrial design registrations under the *Industrial Design Act* (the "**Act**") are similar to design patents in the US. They protect the features of a product that are visually appealing and not purely utilitarian. They can consist of a shape, configuration or composition of pattern or color, or combination of pattern and color in three-dimensional form, such as the design of a table or the shape of a computer monitor.

The Canadian Intellectual Property Office (CIPO) published six new practice notices on January 13, 2017 regarding the industrial design registration process under the Act. Each notice came into effect immediately and affects both pending and future design applications. According to CIPO, the changes will improve client service, reduce administration and modernize Canadian practices in order to align those practices with international standards. These changes may also impact registrable subject matter (see below).

1. Computer-Generated Animated Designs

With this practice notice, the objective of the Industrial Design Office ("**the Office**") is to recognize that a computer-generated animated industrial design is registrable subject matter. Under the new practice, the Office will consider computer-generated animated designs as one design. Drawings for a design will be viewed as a sequence of frames. Applicants may petition the Office to re-examine any pending application. This practice is intended to keep pace with new technologies.

2. Colour as a Registrable Feature

With this practice notice, colour will now be recognized by the Office as forming part of a combination of features of an industrial design. Previously, colour has not been recognized as registrable subject matter. This practice keeps pace with international norms.

3. Reducing Time Limits to Respond to Office Actions

The deadline for applicants to respond to an examiner's report is now three months (previously four). The intention of the Office is that this will lead to timelier issuance of industrial design registrations.

4. Search to Assess Originality Where There is a Priority Claim

The Office will conduct prior art searching as early as six months from the date of priority when an applicant voluntarily submits certified priority documents that support the priority claim. The previous practice was to initiate the search for prior art six months from the filing date of the application. If possible, certified priority documents should now be submitted with the application.

5. New Notices of Possible Refusal

The Office will issue a notice of possible refusal informing an applicant that its industrial design application may be refused as it does not meet the requirements for



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registration. This will improve conformity with the Act, which states that the Minister may refuse an application that does not meet the criteria for registration. Previous practice was to issue objections to registration and if no response was received, an application would be abandoned. After six months, the abandoned application would become inactive.

6. Delaying the Registration of An Application

The Office will grant a delay of registration of up to six months from the date of allowance. This delay allows an applicant to enter the market in a timely manner and have the full duration of the registration for the protection of its design.

These practice changes affect both registrable subject matter and practise before the Office, thereby giving applicants for industrial design registration benefits and certainty in the application process. However, the last arbiter on subject matter in respect of any particular design is always the Courts so we will have to see if any new jurisprudence comes out of these changes.