

INDUSTRIAL DESIGN APPLICATIONS IN CANADA

An Industrial Design registration provides protection with respect to the appearance of an article. The maximum term of protection is ten years from the registration date, although a maintenance fee is payable by the end of the fifth year. It is very important to ensure that the application is filed within one year of the date on which the design was first made available to the public anywhere in the world. The convention term is six months.

The application must be filed in the name of the "proprietor", that being the owner of the design at the time of filing. An assignment is not required for filing, but one may be submitted thereafter to reflect a change in ownership.

The application will include identification of the proprietor, identification of any priority claim, a brief description of the design, and a description of the drawings or photographs that depict the design. Drawings are preferred, but photographs are acceptable if they are in black and white and capable of being photocopied. The applicant should provide at least the minimum number of views to disclose all design features. The drawings or photographs should be on letter size or A4 size paper.

We usually prepare the description of the design and in the application form we can appoint ourselves as agent and representative for service.

The Office will accept variants of a design within a single application as long as there is a common theme tying the variants together and as long as the different embodiments do not differ substantially from each other. Should the Office require restriction to a single design then the non-elected embodiments may be pursued in one or more divisional applications. A divisional application benefits from the filing date of the parent and from any convention claim associated therewith.

Usually an application will be pending for twelve months or more before examination takes place. The examiner will determine whether the design exhibits sufficient originality with respect to the prior art to support a registration. If several applications

relating to closely-similar subject matter are filed, such that one, if registered, could be construed as prior art against another, then it is essential that the Office be advised and instructed to prosecute the applications with a view to obtaining simultaneous registration of all affected cases.

It is possible to amend an application and/or to argue against a negative position taken by the examiner. It is also possible to appeal a final decision to the Patent Appeal Board.

Insofar as litigation is concerned, the procedures are very similar to those that would be taken in a patent infringement suit. However, in order to obtain damages for infringement that took place before specific notice is given to the infringer, all articles sold under the registration must carry the name of the owner and the designation (D).

The government fee for an industrial design application is \$400.00 as of January 1, 2004 and our minimum charge for preparing and filing the application is \$500.00. These are in Canadian dollars and are subject to change.

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