

A New Design Law – a New Office Manual

September 28, 2018

By Robert Storey

On September 27, 2018, the Canadian Intellectual Property Office published its new Industrial Design Office Practice Manual. The new Manual sets out the procedures and practices that will be followed by the Design Office when Canada's new *Industrial Design Act* and *Industrial Design Regulations* come into force on **November 5, 2018**. The new *Act*, *Regulations* and Manual will provide a comprehensive new regime for the protection of industrial designs in Canada.

The new *Act*, which was passed by the Canadian government in 2014, includes a number of fundamental changes. For one thing, Canada will become part of the *Hague Agreement*, which provides a system for filing international design applications designating any of over 60 member countries.

Equally importantly, if not more so, the new *Act* will abolish the current confusing novelty requirement for a registrable design and replace it with a novelty requirement that is straightforward - and analogous to the novelty requirement for a patentable invention in Canada.

Many of the details of the new design registration scheme are set out in the new *Regulations*. These have been addressed by us in earlier postings: see [here](#) and [here](#).

In this article we will focus on the upcoming changes that are included in the new Manual. As with the new *Act* and *Regulations*, many of the changes coming from the Manual will be very welcome by practitioners and users of the system, while a few others may not be.

Variants

One of the first significant changes in the new Manual relates to the treatment of so-called “variants”. A Canadian design application can include two or more designs, but only if they qualify as variants, meaning designs that do not differ “substantially”. Traditionally, the Canadian Design Office has interpreted this strictly - and somewhat arbitrarily.

One aspect relates to designs that differ from each other as to which portions of the article are included as defining the design.

In many other jurisdictions, it is common practice to protect a design with a varying scope by depicting multiple embodiments in which portions of the article are shown in different combinations of solid and stippled lines. However, this has not been considered acceptable by the Canadian Design Office.

In an unexpected reversal of longstanding policy, the new Manual presents an example of acceptable variants that includes two embodiments of a design with different portions shown in solid and stippled lines. See below:

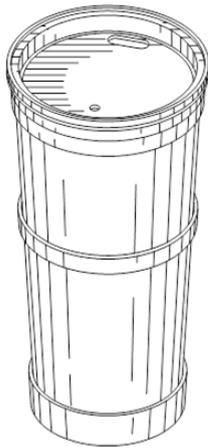


Fig. 1.1

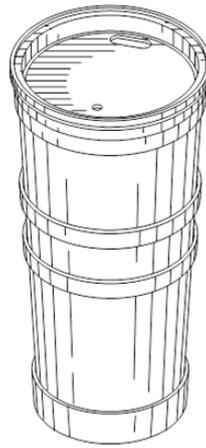


Fig. 2.1

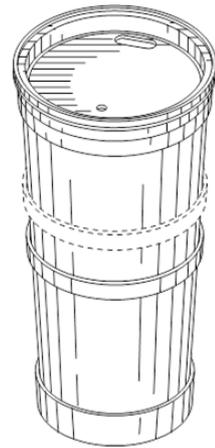


Fig. 3.1

This has the potential for providing much more flexibility to Canadian design applicants.

Unfortunately, the problem will remain that neither the new *Act* nor the new *Regulations* nor the new Manual provide any objective criteria for assessing whether two designs differ “substantially” for the purpose of qualifying as variants, which can be included in a single application. Whereas section 11 of the *Act*, dealing with infringement, expressly indicates that “in considering whether differences are substantial, the extent to which the registered design differs from any previously published design may be taken into account”, the definition of “variants” has no similar provision.

Descriptions

In another major departure from over a century of design practice in Canada, written descriptions will become optional in design applications under the new regime. The new *Regulations* establish a presumption that “an application is deemed to relate to all of the features of shape, configuration, pattern or ornament shown in the representation of the design”, except where the representation includes features shown in stippled lines which will be presumed not to be part of the design. These presumptions can be overcome by an appropriate written statement.

The new Manual provides that any written statement “must clearly describe which features are claimed and must not create alternatives that may lead to ambiguity...” Surprisingly, the Manual states that the following statement would not be acceptable: “The design is the visual features of the entire article shown in the reproductions, whether those features are features of one of shape, configuration, ornament or pattern or are a combination of any of these features.”

Prohibiting such a statement is surprising because for many years the Office’s previous practice manual indicated expressly that such a description statement was acceptable, based on the definition in the *Act* and a decision of the Patent Appeal Board in 1999.

Other Changes

The following additional changes provided in the new Manual will offer greater flexibility than the current policies and practices of the Canadian Design Office:



- photographs and drawings will be acceptable together in the same application;
- more than one environmental view may be included, as long as there is at least one view showing the article in isolation;
- an article that opens and closes or extends and retracts can be shown in intermediate positions as well as fully open/extended and fully closed/retracted positions, provided that the article is normally seen and used in all such positions;
- it will be permissible to show electronic icons in isolation, that is, without any need for a display screen depicted in stippled lines;
- further guidance is provided with respect to the Office's relatively recent acceptance of computer-generated animated designs and colour as a design feature;
- the Office will also accept contrasting colour tones, and stippled or coloured boundary lines, and also partial blurring to distinguish design and non-design portions of an article, all of which can be particularly useful in dealing with CAD images. (Note though that the presumption in the *Regulations* mentioned above regarding stippled lines does not apply.)

Interestingly, the Manual addresses a drafting problem in one section of the new *Regulations* which prohibits an application from being amended "to add a representation of a design". A straightforward reading of this new limitation would prevent an applicant from adding an additional view, or changing photographs to drawings or vice versa, even when no new matter would be added - in contrast to current Office practice. However, notwithstanding the language of the *Regulations*, the Manual sets out expressly that: "The addition of a photograph or reproduction of the design in the application is acceptable provided that it does not add new subject matter."

Somewhat less welcome to users and practitioners will be a reduction in the time permitted for Office action responses, down to three months from the current four months.

The new Manual also has sections dealing with the examination and registration of international Hague Applications, as well as a section dealing with transitional provisions, for example, the examination of applications that are pending on November 4, the day before the new *Act* and *Regulations* come into force.

Conclusion

While some may be disappointed that the new *Act* and *Regulations* and Manual fail to address the issue of objectively assessing whether designs differ "substantially" in the context of novelty, variants, and application amendments, there should be no doubt that Canada's new industrial design regime is a significant improvement.

Information on this website is for information only. It is not, and should not be taken as, legal advice. You should not rely on, or take or not take any action, based upon this information. Professional legal advice should be promptly obtained. Bereskin & Parr LLP professionals will be pleased to advise you.