



## Canada's New Design Law Offers Enhanced Grace Period

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On November 5, 2018, Canada's amended legislation governing the protection of industrial designs came into force. Among other things, the new regime enables Canada's accession to the *Hague Agreement*, repairs the novelty provisions, and extends the potential term of protection to 15 years from filing. Recent commentary on changes to Canadian design law and practice can be found [here](#), [here](#) and [here](#).

Applicants should take note of a subtle yet welcome improvement to how the grace period is applied. In design law, a 'grace period' operates to permit an application to be filed after the applicant has publicly disclosed the design. If the application is filed within the grace period, a prior disclosure by the applicant (or a predecessor in title or someone who obtained knowledge of the design from the applicant) is not considered prior art to the application and novelty is maintained.

Under the old regime, Canada offered a 12 month grace period, but it was calculated from the actual filing date of the Canadian application, not the priority date. This was discussed in an earlier article [here](#). The effect was that, if there was a prior disclosure, it was critical to file in Canada by the one year anniversary of the disclosure. It was not enough to file elsewhere and rely on that priority date; despite the priority claim, the design would lack novelty.

The new law preserves novelty for designs that have not been disclosed, more than 12 months before the priority date of the design in the application, in such a manner that it became available to the public in Canada or elsewhere<sup>[1]</sup>. Compared to the old regime, the new law essentially gives applicants an extra 6-months of grace period for cases where a foreign application was filed within 12 months of an earlier disclosure<sup>[2]</sup>

The change now aligns Canada's design law with other jurisdictions, notably the United States, in which the 12 month grace period is measured according to the priority date of the application. However, Canada's patent law still measures the grace period according to the Canadian filing date.

The observations herein come with the usual recommendations for applicants looking to secure design protection; namely, the safest course of action is to file an application before any public disclosure of the design, and professional advice should be obtained before filing.

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[1] Section 8.2 of the *Industrial Design Act*.

[2] On the basis of the foreign application, the applicant now has the right of priority to file in Canada within 6 months in accordance with the Paris Convention.

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