



Proposed New Canadian Industrial Design Regulations: Our Detailed Review – Part 2

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As we first reported on June 20, 2017, the Canadian Intellectual Property Office (CIPO) has recently published proposed new Industrial Design Regulations. The Regulations are intended to implement and complement amendments to the Industrial Design Act that were passed by the Government of Canada in 2014 and which are expected to come into force next year. The amendments will enable Canada to accede to the Hague Agreement which provides a system for filing international design applications designating any of over 60 member countries.

The new Regulations have specific provisions that apply only to international applications that designate Canada, and other general provisions that apply to both Hague applications and national applications. This two part article will examine only the general provisions; the Hague related provisions will be reviewed subsequently.

Amendments to Applications

The new Regulations preserve the principle that an application can be amended before it has issued to registration, provided that the amendment does not “substantially” alter the design. Unfortunately, the new Regulations also preserve the problem of not having any objective standard for assessing whether an amendment “substantially” changes the design.

The language used in the new Regulations is similar to that of Section 11 of the Act dealing with infringement, namely “a design not differing substantially”, that is to say the new Regulations prohibit amendments that result in “a design that differs substantially”. However, whereas Section 11 of the Act 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 new Regulations have no such provision. Accordingly, it is expected that the CIPO examiners will continue to raise objections to amendments somewhat arbitrarily, on the basis that the amendment results in “a design that differs substantially” from the original design.

The new Regulations not only prohibit amendments to the drawings or photographs that result in “a design that differs substantially”, but also amendments to a written statement or description that would result in “a design that differs substantially”.

There are several other limitations being introduced in the new Regulations that may have significant consequences. It will no longer be possible to amend an application “to add a representation of a design”. As noted above, a representation may be one or more photographs or “reproductions”. It would appear that the proposed new limitation may prohibit an applicant from adding an additional view, or even changing photographs to drawings or vice versa, though CIPO’s consultation document indicates that the intent may be only to prevent the addition of a representation that shows a new design or new features.

The proposed new Regulations also prohibit an applicant from adding an indication that an application is a divisional of an earlier application more than three months after the filing of the intended divisional application. Apparently, if no such indication is included and the three month period has expired, the application would lose the filing date of the parent (or earliest application in the chain) because it would not meet the requirements to qualify as a divisional application.



If a pending application has been published 30 months after its filing date or priority date, it will also not be permissible to change the name of the article to which the design pertains to a “substantially different article”.

Potential Term Extension to 15 years From Filing Date

The new Industrial Design Act establishes a maximum term of protection of 10 years from the date of registration or 15 years after the filing date of the application, whichever is longer. The proposed new Regulations indicate that regardless of which maximum term applies, there will be a single maintenance fee due 5 years after the registration issues.

In the case of a registration resulting from a Hague application, the term of protection also requires that the international registration continue to be in force.

Advanced Examination and Delayed Registration

The new Regulations will preserve an applicant’s ability to request both advanced examination and delayed registration. Curiously, while the current Regulations set out the government fees for requesting either service, there are no provisions that expressly authorize CIPO to provide them. The new Regulations will provide authority for these procedures.

However, whereas CIPO’s current practice is to permit repeated requests for delayed registration in time periods up to six months, the new Regulations will permit only a single request for delayed registration for a period of up to thirty (30) months after the filing date or priority date.

Holiday Provisions

The current Act and Regulations do not include provisions to address deadlines arising when the Office is closed. The new Act specifies that if a time period for doing anything ends on a prescribed day or a day designated by the Minister, then the time limit will extend to the next day on which CIPO is open.

The proposed new Regulations specify that those prescribed days include: weekends; specific recognized holidays; and any other day that CIPO is closed to the public.

Prosecution by non-Canadian Representatives

The proposed new Regulations state that a person may be represented by any person authorized by them for the purpose of filing an application, paying a fee, or making a request or providing evidence relating to assignments and licensing. There is nothing in the Regulations that restricts the identity, qualification or residency of a person so authorized, which appears to permit actions to be taken by persons who are neither registered intellectual property professionals nor Canadian residents.

Fees

The standard fees payable in relation to a design application in Canada remain unchanged. The new Regulations authorize the Commissioner to refund any fees paid in excess of the fee prescribed, but only if a request for a refund is received within three (3) years of the day on which the excess fee was paid. The new Regulations also authorize the Minister to waive the payment of a fee “if the Minister is satisfied that the circumstances justify it”; however, no direction is provided as to what circumstances may justify the waiver of a fee.

Transitional Provisions

As with the new Act, the proposed new Regulations set out transitional provisions. For the most part, registrations that have already issued and applications that have a filing date earlier than the day on which the new Act and Regulations come into force will be governed and dealt with in accordance with the current Act and Regulations.

If you have any questions, please do not hesitate to contact any member of our design law review team: [Robert Storey](#), [Sam Frost](#), [Stephen Beney](#), [Ken Bousfield](#), [James Raakman](#), [Tony Orsi](#), [Matt Graff](#) and [Kevin Shipley](#).



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