

Developments in the field of industrial design in Canada (by Jean H. Dubuc and Me Julie Gauvreau)

1. Protection of a design and its variants : potential cost reduction?

A recent decision¹ has clarified a section of the *Industrial Design Regulations* (« *Regulations* »).

Section 10(2) of the *Regulations* [old section 12(2) cited in the decision] stipulates that an application must relate to a single design or to variants of this design. The decision shed light on the notion of “variants”. In this case, the submitted application contained 14 illustrated embodiments of a burner. The examiner rejected the application on the basis that the embodiments were separate designs and not variants of a single design. Each illustration showed a burner exhibiting a number of spaced fingers that extended outwardly from the centre, the fingers having convergent sides and rounded outer ends. The number of spaced fingers, the angle formed by the fingers’ sides and other details differed between the embodiments. The applicant requested that the Examiner’s rejection be reviewed by the Patent Appeal Board arguing that, even if the embodiments differed with regard to details, they were variants of a single design because they all had in common the essential design features creating the uniqueness of the design. The Patent Appeal Board concurred with the applicant and concluded that the embodiments presented significant similarities and were therefore variants of a single design that should be included in one registration.

This decision should assist applicants in obtaining a registration for multiple variants of a design within a single application. This should reduce the number of separate applications required to adequately protect a design.

2. Legislative amendment proposal

Significant amendments to the *Industrial Design Act* (« *Act* ») may well be included in a future bill. According to the current *Act*, registration may be refused for a design that is identical to or so closely resembles another **registered** design as to be confounded therewith (« confusingly similar »). The current *Act* does not provide for any basis upon which to refuse the registration of a design that is identical or confusingly similar to a design that is not yet registered but **that is the subject of a previously filed application**. Consequently, according to the current *Act*, registration certificates (and therefore rights) may be granted to more than one party for a single design (or for confusingly similar designs) if the parties had at one time concurrently pending applications for this (these) design(s). One of the suggested amendments seeks to prevent this situation from occurring by providing that a design that is identical or confusingly similar to a pending application will be denied registration.

Another of the proposed amendments provides that a design will be rejected if it is identical or confusingly similar to a design that has been published more than one year before filing of the application in Canada. The current *Act* relating to the prior publication of designs expressly precludes the registration of a design only if an identical design was so published.

¹ *Re Industrial Design Application No. 1998-0950* (2001), 14 CPR (4th) 213 (Patent Appeal Board)