

Intellectual Property Institute of Canada (IPIC) Submission on Proposed Amendments to *Industrial Design Regulations*

Submission to the
Canadian Intellectual Property Office

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INTRODUCTION

The Intellectual Property Institute of Canada (IPIC) is the professional association of patent agents, trade-mark agents and lawyers practicing in all areas of intellectual property law. Our membership totals over 1,700 individuals, consisting of practitioners in law firms and agencies of all sizes, sole practitioners, in-house corporate intellectual property professionals, government personnel, and academics. Our members' clients include virtually all Canadian businesses, universities and other institutions that have an interest in intellectual property (e.g. patents, trade-marks, copyright and industrial designs) in Canada or elsewhere, and also foreign companies who hold intellectual property rights in Canada.

IPIC is pleased to provide comments on the proposed amendments to the *Industrial Design Regulations* reflecting the proposed amendments to the *Industrial Design Act* (not yet in force), which are required to enable Canada to accede to the *Hague Treaty*.

It is important for Canadian businesses, universities and other institutions that our intellectual property (IP) system remains competitive with those of other jurisdictions. The government's interest in modernizing and improving the IP framework is therefore noteworthy and welcome. The accession to the *Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs* (the "*Hague Agreement*") and the consequential changes to the *Industrial Design Act* and *Regulations* are a step in the right direction and are welcome by IPIC.

PROPOSED AMENDMENTS TO THE INDUSTRIAL DESIGN REGULATIONS

IPIC is encouraged by the government's interest in modernizing and improving the *Industrial Design Regulations* as exemplified by the proposed revisions to the *Industrial Design Regulations*. In particular, IPIC welcomes the steps taken by the government to accede to the *Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs*, and to modernize the language of the *Industrial Design Act*. IPIC wishes to thank CIPO for holding a pre-consultation meeting May 9, 2017, to discuss the proposed amendments to the *Industrial Design Regulations*. As a result, IPIC welcomes the positive changes made to the proposed *Regulations* adopted by CIPO, in particular relating to examination fees (maintained per application), publication (up to 30 months), extensions of time (6 months), and notice of revocation (now provided).

IPIC's comments and recommendations are set out below in order of the numbering in the proposed amended *Regulations*.

Sections 4, 6, 9, 14, 15, 27, 29 recite the term "website" in the phrase "on the website of the Office". There is a concern that this language may eventually become out of date due to technological advancements. Perhaps either more general language could be used for example, "as prescribed by the Office from time to time..." or the term "website" should be defined in the Definition Section.

Section 6. Electronic Communications.

Deeming a communication to have been sent could be problematic in unexpected situations, even if a user consents through website terms and conditions. As a result, rights could be lost. IPIC believes that this Section should be deleted or the wording amended to make it clear that communications will be posted on the website only and no physical mail or communication will be sent to the person. Query, why Section 7 is required, i.e. a postal address if the Minister or Commissioner makes all communications available on the Office's website.

Section 12. Representation Before the Office

Where an Applicant has appointed an agent, the Applicant usually expects correspondence to be sent directly to the agent. It is presumed that if the Applicant moves, correspondence will still be sent directly to the agent. However, this is not clear or spelled out in the proposed *Regulations*. IPIC has been advised that the ID Office Practices will be revised to avoid such a scenario. However, even if the Office Practices were revised to request that the Minister correspond with an agent where one has been appointed, there is a risk in electronic communications and/or human error that correspondence is sent directly to the Applicant, potentially resulting in inadvertent loss of rights, and more importantly without reasonable relief given Office practice is non-binding. IPIC recommends that the *Regulations* be amended to require the Minister and the Commissioner to correspond with only the agent where one has been appointed.

A Canadian agent is well placed to represent domestic and foreign Applicants before CIPO, e.g. in terms of familiarity with Canadian law and practice and meeting all deadlines. Accordingly, IPIC recommends requiring Canadian representation during the national refusal period, to ensure all Applicants are represented properly before CIPO. There is no requirement under the Hague Agreement that prevents or precludes a signatory to grant such representation. This will also diminish and/or prevent unauthorized practice.

Section 12(4) as presently drafted is unclear rendering ambiguous what is intended to be captured in this provision. The appointment of an agent is provided in Section 12(1) but then Section 12(4) contemplates the filing of an application (among other things) by a person who is neither the Applicant nor the agent. There is potential for confusion where the Office will automatically treat the person who files the application as the agent but the intention was to fall under Section 12(4). Limiting correspondence to Applicants and agents (other than transfers to new Applicants) would avoid such confusion.

Section 17. Features of shape, configuration, pattern or ornament

Section 17(1) and Section 17(2) as presently drafted require clarification. The wording “all of the features of shape, configuration, pattern or ornament” should read “all of the features of shape, configuration, pattern **and** ornament”. It is IPIC’s understanding that the intention is to include all of the visible features. Alternatively, language reflecting the current legislation, “all of the features of shape, configuration, pattern or ornament and any combination of those features”, would be acceptable as it is broader and thus provides Applicants with a greater scope of protection for their design(s).

Also, it is unclear how Section 17(2), entitled “Exception – statement of limitation” and Section 18, entitled “Optional description” interrelate. Both refer to a “statement”. Clarification is requested. Is the “optional description” also considered to be a “statement of limitation”?

Section 20. One Design Per Application

What constitutes the application? Section 20(3) requires that a divisional application must indicate that it is a divisional application. In contrast, the priority claim in Section 26(2)(a) may be made in the application or a separate document. Presently practitioners place both pieces of information (an indication that the application is a divisional and priority claim) in a cover letter to the Office. Under the new *Regulations*, would the divisional claim need to be integrated into an “application” document? In our view, the divisional claim should have the same flexibility as the priority claim.

Divisional applications for design disclosed but not claimed in the original application

Reducing the window to file a divisional application, from any time before registration, to one year after filing absent a unity objection, creates significant time constraint on Applicants and CIPO. Current backlogs and ongoing Information Technology (IT) barriers and constraints create unforeseeable delays. It is anticipated that turnaround times with foreign Applicants will become more of an issue once international application under *Hague* become more prevalent in Canada. Furthermore, the deadline for filing divisional applications (later of 1 year from filing or 6 months after the parent application has been restricted to a single design in response to a unity objection) seems arbitrary. Accordingly reducing the window to file a divisional application will also reduce the effective amount of time available to an Applicant. Although it is understood that CIPO is motivated to make prosecution as compact as possible, it is respectfully submitted that the *Regulations* be amended to provide additional time and flexibility for Applicants to file divisional applications to best protect their rights. The window to file a divisional should not be reduced and should continue to be limited only by the date of registration. At a minimum, the window should be up to two years after filing, as proposed by CIPO in the pre-consultation phase.

The “Exception” in Section 20(6) for filing divisional applications more than one year after the filing date is not clearly worded to extend to divisional applications for designs disclosed but not claimed in the original application. If the shortened deadline for filing divisional applications is maintained, the exception should apply to this category of divisional applications as well. Applicants typically do not turn their minds to any type of divisional application until after prosecution has commenced.

Section 25. Amendments

The scope of Section 25(2)(b), which states that an application must not be amended to add a representation of a design is limiting. It is IPIC’s understanding that Section 14 refers to “representation” as being an entire set of drawings which includes multiple “reproductions” (i.e. drawings). The term “representation” is always used in the singular form in the *Rules*. Currently, examiners will frequently request additional views to help the reader visualize the finished article, and the views are accepted on the basis that they can be inferred from the other views from the application as filed. Is the purpose of Section 25(2)(b) to put an end to this practice? Or is it to prevent an Applicant from adding a whole new design in a pending application by way of amendment? Why prohibit adding a representation (section 25(2)(b)) in situations where the representation does not add subject matter (e.g. where the representation can be inferred from the application as originally filed)? Either way Section 25(2)(b), and more generally the term “representation” as used in the *Regulations* should be clarified.

Non-application to *Hague* application

Priority

The number of the priority document is only mentioned in Section 26(3) in respect of corrections. There appears to be no due date for submitting the number of the priority document, other than the registration date by operation of Section 26(3). Is this intentional in order to comply with *Hague*?

Section 26(5). Exception

Preventing correction of a priority date after the six (6) month date from the priority date will not allow Applicants to correct obvious typographical errors under non-prejudicial circumstances. For example, if an Applicant claims priority to June 1, 3017, they should be permitted to correct the date if it is an obvious typographical error i.e. correct to read June 1, 2017. It is recommended that such corrections remain discretionary.

Extensions of Time: Sections 22(4), 22(5), 27(3) & 27(4)

As presently drafted extensions of time under the above-noted sections are three (3) months with one six (6) month extension of time upon request to the Minister, for a total of nine months. Limiting Applicants to a single extension of time, will undoubtedly place undue time constraints on Applicants, which may require more time to reach a business-critical decision such as approval of funding or considerations that must be made under potential litigation. Such decisions will often take longer than the arbitrary nine-month period as currently written in the proposed regulations. Applicants should be given the ability to request further extensions of time, i.e. more than one.

Typographical Errors

The following typographical errors were found in the document and should be corrected.

In Section 4(3) a space is required between the term “local time” and the word “of”.

In Section 8(1) a space required between the word “an” and the word “application”.

In Section 10 it appears that the phrase “except for are presentation of a design filed under Paragraph 4(1)(b) of the *Act*” should read “except for a representation of a design filed under Paragraph 4(1)(b) of the *Act*”.

OTHER MEASURES

Thank you for the opportunity to provide input on the IP-related aspects of the proposed *Industrial Design Regulations*. We look forward to working with the government as the necessary amendments to the *Industrial Design Regulations* are made to bring the changes into effect. We recommend that stakeholders be involved early, and throughout the regulation drafting process.

We also encourage the government to continue in its work to improve the Canadian IP system.

We support a robust IP system, a vibrant culture of innovation in Canada, and a strong and highly-skilled Canadian IP profession.

For industrial designs, further modernization is needed to provide protection for types of designs not contemplated when the *Act* was originally drafted, such as animated electronic icons and graphical user interfaces. There are other areas of possible protection such as unregistered designs and protection for colour. Consideration should also be given to allowing Applicants to amend applications to change the scope of protection applied for, comparable to utility patent or US design patent practice. The implementation of the design practice notices with respect to colour and animated electronic icons and graphical user interfaces has been helpful. It is hoped that the dialogue between IPIC and CIPO continues to ensure a fulsome and strong IP system in Canada.

We would welcome the opportunity to cooperate further on these and other issues.

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