



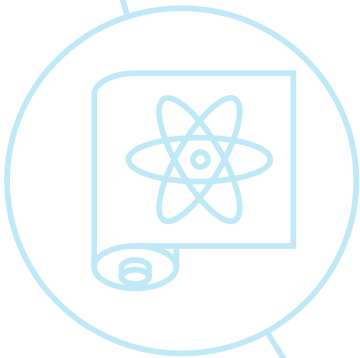
## DESIGN PRIMER

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Have a design worth protecting?  
This will help you get started.

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INTELLECTUAL PROPERTY LAWYERS



## WHAT IS AN INDUSTRIAL DESIGN?

An industrial design registration in Canada (referred to in the United States as a “design patent”) protects the aesthetic features of an article such as its shape, configuration, pattern, and/or ornamentation.

Traditionally, industrial designs have protected the look of physical articles, but more recently, design protection has been extended to graphical user interfaces, animated designs, and electronic icons.

Industrial designs only protect the way an object looks, not its function.

A registered design can be used to prevent other people from copying and profiting from your design. However, design registrations are territorial, meaning that you have to file a design application in each country of interest in order to obtain rights in those countries. The grant and enforcement of design registrations are governed by national laws, and while the laws of most countries are at least somewhat similar, the laws of each country are unique.

It is not necessary to have a registered design to sell a product. Further, having a registered design does not give you any express right to make and sell your product. Your product must still comply with all applicable laws and regulations. For example, even with a valid registered design, making and selling your product may infringe rights (such as patent rights, trademark rights and/or copyright) owned by third parties. Thus, the issue of whether you can make and sell your product is separate from the issue of obtaining protection for your design.

## WHY SHOULD I APPLY FOR DESIGN PROTECTION?

Design registrations are potentially valuable assets. If you have come up with a new design that has features that your competitors may want to copy, you should consider applying for design protection. Without design protection, your competitors are free to copy and benefit from your design, even though they did not incur the costs of creating or developing that design.

Design protection can be useful when patent protection for the article may be difficult to obtain. For example, a new water jug is unlikely to receive patent protection if its functional characteristics (such as the container, handle, spout, etc.) are not new. However, if the visual appearance of the water jug is new and differs from the appearance of prior water jugs, then the new appearance may be protected by an industrial design registration.

Design protection can also be useful for products where sales are driven by aesthetic considerations, such as consumer electronics, sports equipment, and vehicles.



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In addition to preventing your competitors from copying your design, design protection can also provide you the option of selling or licensing the design rights to interested parties. This may allow you to benefit financially from the design even in countries or markets where you are not going to manufacture or sell the product yourself.

If you are seeking investment from other people to fund the development of your products, you will likely find that potential investors are very concerned about your intellectual property strategy. This is because having a strong intellectual property strategy can be key to recovering investment in and profiting from the development of a product. Design registrations can be an important part of your intellectual property strategy and may increase the chance that your investors will obtain a good return on their investment.



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### WHO CAN APPLY FOR DESIGN PROTECTION?

The “proprietor” of a design is the person entitled to register the design in Canada. The proprietor of the design is presumed to be the author of the design, unless the author was paid to create the design for another person, in which case the other person may be the first proprietor. We recommend that formal agreements specifying ownership of designs should always be executed where an author is being paid to create a design for another person.

### WHAT IS INCLUDED IN A DESIGN APPLICATION?

Design applications primarily consist of a number of illustrations that show the article that is the subject of the design. These illustrations will generally be in the form of line drawings and should include a sufficient number of views of the article (for example, a perspective view, a front view, a rear view, a top view, a bottom view, a side view, etc.) to accurately depict the features of the design. In some cases, photographs may also be acceptable. Features of an article that are not part of the design or only form part of the environment for the article may be disclaimed by showing those features in broken lines.

Design applications may also include one or more variants. Variants are designs that are very similar to each other and that are applied to the same article or a set. A set is defined as a number of articles of the same general character sold together or used together and to which the design is applied (for example, a knife, a fork, and a spoon may form a set).

### WHEN SHOULD I APPLY FOR AN INDUSTRIAL DESIGN REGISTRATION?

One of the requirements for obtaining a valid design registration in Canada is that the design has to be novel. If the design has been publicly disclosed, it is no longer considered novel. Publication includes distributing samples or



*Typically, preparing an industrial design application begins with preparing drawings illustrating the features of the design.*

making public use of an article incorporating the design, selling or exhibiting such articles for sale, or publishing the design in advertising or other printed material of any sort. This includes disclosures by the author of the design.

Some countries have a grace period for filing applications even after a public disclosure. In Canada, an industrial design application must be filed no later than one year after the earliest date of public disclosure of the design. The United States and Europe have a similar one-year grace period for public disclosures, but many other jurisdictions have no grace period whatsoever. In countries with no grace period, any public disclosure of the design by any person before filing a design application destroys novelty. In such countries, once the design has been publicly disclosed, you can no longer obtain a valid design registration.

There may be situations in which you must discuss your design with someone else before filing a design application. For example, you may need to employ a manufacturer to produce a prototype of a product. To avoid having such disclosures be considered a public disclosure that could destroy your design rights, it is important to have a non-disclosure agreement (“NDA”) in place.

### **WHAT ARE THE STEPS AND COSTS INVOLVED TO OBTAIN AN INDUSTRIAL DESIGN REGISTRATION IN CANADA?**

Typically, preparing an industrial design application begins with preparing drawings illustrating the features of the design. The cost of drawing preparation varies depending on the complexity of the design, the number of views required to adequately show the design, and the number of variants. Typical costs to have a draftsman prepare drawings may range from \$1,500 to \$4,000. Once the drawings are ready, the preparation and filing of the application costs approximately \$2,750. Further costs may be incurred as the Canadian Intellectual Property Office examines the application to ensure that it is registrable. It is reasonable to budget \$500 to \$2,000 for the examination process where no substantial objections are raised. If substantial objections are raised, then these costs could increase. If no objections are raised, or all objections are overcome, the application will then proceed to registration.

### **SHOULD I CONDUCT A SEARCH BEFORE APPLYING TO REGISTER A DESIGN?**

Time and budget permitting, it may be wise to conduct a search before applying to register a design. If the same or a very similar design has already been disclosed anywhere in the world, it may not be possible to obtain a valid registration for the design. However, in some cases the cost of conducting a search may exceed the cost of filing an application to

register the design, and relatively small differences in the design may be sufficient to secure registration in Canada. Thus, the costs and benefits of conducting a search must be carefully considered. No search will guarantee the registrability of any design.

### HOW LONG DOES DESIGN PROTECTION LAST?

In Canada, the term of industrial design protection can last up to fifteen years from the original filing date, subject to payment of a maintenance fee after the first five years. United States design patents have a fifteen-year non-renewable term, counting from the date of grant of the design patent, and no maintenance fees are required. In contrast, a design registration covering the European Union has a term of twenty-five years, subject to payment of a maintenance fee every five years.



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### WHAT ABOUT INTERNATIONAL APPLICATIONS?

In the industrial design context, protection must be obtained separately in each country of interest. For example, a Canadian industrial design registration protects the design only in Canada. To protect the same design in the United States, a separate United States design patent is required.

There are a few strategies for obtaining design protection in multiple countries.

For example, most countries have signed the Paris Convention, which allows a design applicant to claim priority to an industrial design application filed within the previous six months. As a result, in most countries, it is sufficient to file within six months of the date on which the earliest application was filed, provided that the earliest application is itself filed before any public disclosure of the design anywhere in the world. A few countries are not members of the Paris Convention, and special consideration must be given to filing applications in such countries to avoid loss of design rights there.

Another option is to use the Hague System for the International Registration of Industrial Designs. The Hague System provides a simplified procedure enabling applicants to obtain design protection in multiple countries through a streamlined process. Canada, as well as many major industrial countries and regions, are members of the Hague System.

Filing under the Hague System requires filing a single international application through the World Intellectual Property Office. Applications in various countries are then filed by “designating” foreign member jurisdictions. In each of the designated foreign member countries, the



application will be substantively reviewed for compliance with local laws.

One significant advantage of the Hague System is that administrative matters after registration (e.g., updating ownership of the design, paying maintenance fees) can usually be processed in a single procedural step across all designated countries. This greatly simplifies the management of industrial design portfolios.

Another advantage associated with the Hague System is that if there are no substantive objections raised by the designated states, there can be significant cost savings relative to filing individual national applications through local counsel.

One disadvantage of filing under the Hague System is that you are unable to defer the decision of which countries to file in. Instead, states are designated at the time of the international application. Additional designated states cannot be added to an existing international application.

Another disadvantage of filing under the Hague System is that several large markets, such as India and Australia, are not members. Consequently, separate regular national applications would need to be filed in such countries to obtain industrial design protection.

We invite you to speak to a member of our team if you are interested in pursuing protection through the Hague System.



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