

INFORMATION SHEET

Obtaining design protection

Design laws may be used to protect aesthetic features of shape, configuration, pattern or ornament applied to a mass-produced article. In the United States and Canada, design protection can also be used to protect computer icons.

Canada. In Canada, design protection is acquired by obtaining an industrial design registration from the Canadian Intellectual Property Office. In order to obtain such a registration, an application must be filed within one year of first publication of the design anywhere in the world. Publication includes distribution of the article itself or of brochures or pamphlets showing the design.

A "proprietor" of a design may be named as applicant. Where the author creates the design as an individual in his or her own right, he or she is the first proprietor. Where the author has created the design for another person for good and valuable consideration, that other person is the first proprietor. Therefore, when the author creates the design pursuant to normal duties as an employee, the first proprietor is the employer, and when the author has been commissioned to create the design, the first proprietor is the person retaining his or her services.

An application for an industrial design registration includes a short written description of the novel ornamental features of the design and drawings (or, rarely, black and white photographs) of appropriate size and format.

After an industrial design application is filed, an Examiner at the Canadian Intellectual Property Office reviews the application and searches for similar designs. If the Examiner has no objections, the industrial design is registered. If similar designs are located, we may be required to amend the description and present arguments to distinguish over the similar designs.

A Canadian industrial design registration has a term of 10 years, provided a maintenance fee is paid before the expiry of five years from the date of registration.

Articles that are protected by design registrations, or associated packaging or labels, should be marked with a "D" in a circle followed by the name of the proprietor to advise the public that the design is protected.

United States. In the United States, design protection is obtained by filing an application for a design patent.

A design patent application must be filed within one year of the first printed publication of the design anywhere in the world and within one year of the first public disclosure of the design in the United States.

The "inventor" of the design must be named in the application, and an assignment may be filed so that the design patent will show the assignee as the owner.

An application for a design patent includes drawings (or, rarely, black and white photographs) of appropriate size and format.

After a design patent application is filed, an Examiner at the United States Patent Office reviews the application and searches for similar designs. If the Examiner has no objections, a Notice of Allowance is sent out calling for a fee to be paid in order to obtain the design patent. The design patent usually issues about three months after the fee is paid. If the U.S. Examiner does locate similar designs, we may be required to present arguments to distinguish your design over the similar designs.

Once a United States design patent issues, it has a term of 14 years, and no maintenance fees are

OTTAWA

55 Metcalfe Street Suite 900
PO Box 2999 Station D
Ottawa ON K1P 5Y6
Canada
t. 613.232.2486
f. 613.232.8440
ottawa@smart-biggar.ca

TORONTO

Box 111 Suite 1500
438 University Avenue
Toronto ON M5G 2K8
Canada
t. 416.593.5514
f. 416.591.1690
toronto@smart-biggar.ca

MONTREAL

Suite 3300
1000 De La Gauchetière Street West
Montreal QC H3B 4W5
Canada
t. 514.954.1500
f. 514.954.1396
montreal@smart-biggar.ca

VANCOUVER

2300-1055 West Georgia Street
PO Box 11115
Vancouver BC V6E 3P3
Canada
t. 604.682.7780
f. 604.682.0274
vancouver@smart-biggar.ca

smart-biggar.ca

SMART & BIGGAR

FETHERSTONHAUGH

Barristers & Solicitors • Patent & Trade-mark Agents

required. Articles protected by United States design patents (or packaging or labels associated with the articles) should be marked with "patent Des." or "pat Des.," followed by the design patent number, to advise the public that the design is protected in the United States.

Other countries. In general, most countries have some form of design protection regime. Many foreign countries require that the design not be made public until after an application for design protection has been filed.

Consequently, the best approach is to keep the design secret until you establish where to seek design protection, so your right to file applications for design protection outside of North America can be preserved. If the design is secret at the time the first application for design protection is filed in a country (such as Canada

or the U.S.) that is party to the International Convention for the Protection of Industrial Property, you may defer filing in all other countries that are party to this Convention for up to six months from the filing date of the first filed application. Thus, making the design available to the public within this six month period after the first-filed application will not bar you from filing in other countries that are party to the Convention. Most countries are party to this Convention.

Smart & Biggar/Fetherstonhaugh has an extensive network of associates in foreign countries with whom we regularly conduct business. We would be pleased to provide you with any further information you may require regarding seeking design protection in Canada, or around the world.