

# INDUSTRIAL DESIGNS IN CANADA

An industrial design registration is a mechanism for protecting the appearance of manufactured articles. In many cases, the “look” of a product makes the difference in its appeal to the consumer. While design registrations are most commonly used in conjunction with retail consumer goods, they may also be useful in protecting the visual appeal of industrial and commercial products and even machinery. Registrations may be obtained for designs applied to furniture, electronic goods, automobile tires (tread patterns) and clothing. The range is almost unlimited.

## **The Canadian Law**

Industrial designs are registered under the *Industrial Design Act*. Early versions of the *Act* have been criticized as being “flimsy and incomplete, ill adapted for its intended purposes, and ... seriously in need of amendment”<sup>1</sup>, and likened to the writings of Lewis Carrol<sup>2</sup>. Amendments have overcome a number of the more difficult problems with the *Act*.

## **Definition of “Industrial Design”**

The current version of the *Industrial Design Act* includes a definition of “design”. According to s.2 of the *Act*,:

“design” or “industrial design” means features of shape, configuration, pattern, or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye... .”

The *Act* also provides that protection shall not extend to features dictated solely by a “utilitarian function” of a “useful article”, or to a method or principle of manufacture

## **ADE & COMPANY INC.**

2157 Henderson Highway  
Winnipeg, Manitoba R2G 1P9  
Canada

Telephone (204) 947-1429  
Fax (204) 942-5723  
e-mail info@adeco.com

Web site: [www.adeco.com](http://www.adeco.com)

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or construction. The terms “utilitarian function” and “useful article” are defined in the *Act*. The meanings are consistent with normal usage.

Industrial designs are thus ornamental in nature, dealing with the appearance of an article, what it looks like.

### **The Effect of a Design Registration**

An industrial design registration provides the owner of the registration with the right to stop any unlicensed person from making, importing for the purposes of trade or business, or selling, renting, or offering or exposing for sale or rent, any article in respect of which the design is registered and to which the design has been applied. The prohibited uses extend to kits from which the article may be assembled and to designs that do not differ substantially from the registered design.

Importation for personal use is apparently permitted, while manufacture for personal use is not.

The proprietor of the design may bring an action for infringement. The remedies granted by a court may include injunctive relief, recovery of damages or profits, punitive damages and the disposal of any infringing article.

It is a defence to a charge of infringement that the infringer was not aware, and had no reasonable grounds to suspect, that the design was registered. If this defence is made out, only injunctive relief is available. This defence is not available if the proprietor's articles or packaging are marked with an upper case D in a circle (D) and the proprietor's name.

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The limitation period for infringement actions is three years.

### **Duration of the Registration**

A design registration has a maximum term of ten years, beginning on the date of registration. To maintain the registration in force for the full term, the proprietor must pay a maintenance fee (\$350) within five years of the date of registration. A late maintenance fee payment will be accepted within six months after the expiry of the initial five year period, on payment of a supplementary fee (\$50).

### **Requirements for Registration**

In order to register a design it is necessary to file an application for registration.

The *Act* requires the registration of any design that is not identical with or that cannot be confounded with a design that is already registered. Exceptions to this general rule are designs that do not appear to be within the provisions of the *Act* and designs that are contrary to public morality or order. In addition, the application must be filed within one year of the first publication of the design anywhere in the world. "Publication" should be interpreted broadly as including any act that would make the design available to the public.

The design must be "original" in order to be registrable. "Originality" can be considered the design equivalent of "inventive" in patents.

### **Requirements of an Application for Registration**

An application to register a design must be in the proper form and must include:

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- (a) a drawing or photograph of the design;
- (b) a description of the design;
- (c) a declaration to the effect that the design was not, to the proprietor's knowledge, in use by any person other than himself or his predecessors in title when the design was adopted by the first proprietor;
- (d) the name and address of the applicant;
- (e) a title identifying the article to which the design is applied; and
- (f) the requisite fee (\$400).

The description of the design must, according to current Designs Office practice, include an indication whether the design relates to the appearance of the entire article or only a portion of the article. It must indicate the relevant portion of the article where appropriate. In addition the description must make it clear whether the design features consist of shape, ornamentation, pattern, configuration or a combination of those features. The Designs Office will accept descriptions that are, in our opinion, probably not sufficient to meet the requirement for a description in the *Act*.

The Industrial Design Office will accept an application signed by the applicant's agent. It is not clear, however, whether the declaration required under item (c) above can be made by the agent. We therefore recommend that applications be signed by the applicant whenever possible.

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<sup>1</sup> Per Maclean, J. in *Clatworthy & Son v. Dale Display Fixtures* [1928] Ex. C.R. 159 at 162

<sup>2</sup> "Current Canadian Industrial Design Practice", G. L. Conway and R. F. Delbridge (1976) 36 PTIC Bull. 502

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