

CANADA
Industrial Design Act
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SHORT TITLE

1. Short title

This Act may be cited as the Industrial Design Act.

INTERPRETATION

2. Definitions

In this Act,

"article" means any thing that is made by hand, tool or machine;

"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;

"kit" means a complete or substantially complete number of parts that can be assembled to construct a finished article;

"Minister" means such member of the Queen's Privy Council for Canada as is designated by the Governor in Council as the Minister for the purposes of this Act;

"prescribed" means prescribed by the regulations and, in relation to fees, includes determined in the manner prescribed by the regulations;

"set" means a number of articles of the same general character ordinarily on sale together or intended to be used together, to each of which the same design or variants thereof are applied;

"useful article" means an article that has a utilitarian function and includes a model of any such article;

"utilitarian function", in respect of an article, means a function other than merely serving as a substrate or carrier for artistic or literary matter;

"variants" means designs applied to the same article or set and not differing substantially from one another.

PART I INDUSTRIAL DESIGNS

Registration

3. Register

The Minister shall cause to be kept a register called the Register of Industrial Designs for the registration therein of industrial designs.

4. Application to register design

(1) The proprietor of a design, whether the first proprietor or a subsequent proprietor, may apply to register the design by paying the prescribed fees and filing an application with the Minister in the prescribed form including

- (a) a drawing or photograph of the design and a description of the design;
- (b) a declaration that the design was not, to the proprietor's knowledge, in use by any person other than the first proprietor at the time the design was adopted by the first proprietor; and
- (c) any prescribed information.

Substituted applicants

(2) The application shall, subject to any prescribed terms and conditions, be considered to have been filed by a person other than the person who filed it if, before the design is registered, it is established to the satisfaction of the Minister that the other person was the proprietor when the application was filed.

5. Examination prior to registration

(1) The Minister shall examine each application for the registration of a design to ascertain whether the design meets the requirements of this Act for registration.

Report of objections

(2) Where the Minister finds that a design does not meet the requirements for registration, the Minister shall send the applicant a report setting out the objections to registration and specifying a period for reply.

Abandonment of application

(3) If the applicant does not reply in good faith to the objections within the specified period, the application shall be considered

abandoned.

Reinstatement of application

(4) An application that is considered abandoned shall be reinstated if the applicant, within the prescribed period,

- (a) makes a request for reinstatement;
- (b) replies in good faith to the objections to registration; and
- (c) pays the fees prescribed for reinstatement.

5.1 Restriction on protection

No protection afforded by this Act shall extend to

- (a) features applied to a useful article that are dictated solely by a utilitarian function of the article; or
- (b) any method or principle of manufacture or construction.

6. Registration of design

(1) The Minister shall register the design if the Minister finds that it is not identical with or does not so closely resemble any other design already registered as to be confounded therewith, and shall return to the proprietor thereof the drawing or photograph and description with the certificate required by this Part.

Exception

(2) The Minister may refuse, subject to appeal to the Governor in Council, to register such designs as do not appear to the Minister to be within the provisions of this Part or any design that is contrary to public morality or order.

Exception for late applications

(3) The Minister shall refuse to register the design if the application for registration is filed in Canada

- (a) more than one year after the publication of the design in Canada or elsewhere, in the case of an application filed in Canada on or after the day on which this subsection comes into force; or
- (b) more than one year after the publication of the design in Canada, in the case of an application filed in Canada before the day on which this subsection comes into force.

Non-application of section 29

(4) For the purposes of subsection (3), section 29 does not apply in determining when an application for registration is filed.

7. Certificate of registration

(1) A certificate shall be signed by the Minister, the Commissioner of Patents or an officer, clerk or employee of the Commissioner's office and shall state that the design has been registered in accordance with this Act.

Particulars thereof

(2) The certificate referred to in subsection (1) shall show the date of registration, the name and address of the proprietor and the registration number.

Certificate to be evidence of contents

(3) The certificate, in the absence of proof to the contrary, is sufficient evidence of the design, of the originality of the design, of the name of the proprietor, of the person named as proprietor being proprietor, of the commencement and term of registration, and of compliance with this Act.

No proof of signature required

(4) A certificate appearing to be issued under this section is admissible in evidence in all courts without proof of the signature or official character of the person appearing to have signed it.

Exclusive Right

9. Exclusive right

An exclusive right for an industrial design may be acquired by registration of the design under this Part.

10. Duration of right

(1) Subject to subsection (3), the term limited for the duration of an exclusive right for an industrial design is ten years beginning on the date of registration of the design.

Maintenance fees

(2) The proprietor of a design shall, to maintain the exclusive right accorded by the registration of the design, pay to the Commissioner of Patents such fees, in respect of such periods, as may be prescribed.

Expiration of term

(3) Where the fees payable under subsection (2) are not paid within the time provided for by the regulations, the term limited for the duration of the exclusive right shall be deemed to have expired at the end of that time.

11. Using design without licence

(1) During the existence of an exclusive right, no person shall, without the licence of the proprietor of the design,

(a) make, import for the purpose of trade or business, or sell, rent, or offer or expose for sale or rent, any article in respect of which the design is registered and to which the design or a design not differing substantially therefrom has been applied; or

(b) do, in relation to a kit, anything specified in paragraph (a) that would constitute an infringement if done in relation to an article assembled from the kit.

Substantial differences

(2) For the purposes of subsection (1), in considering whether differences are substantial, the extent to which the registered design differs from any previously published design may be taken into account.

Proprietorship

12. First proprietor

(1) The author of a design is the first proprietor of the design, unless the author has executed the design for another person for a good and valuable consideration, in which case the other person is the first proprietor.

Acquired right

(2) The right of another person to the property shall only be co-extensive with the right that the other person has acquired.

Assignments

13. Design to be assignable

(1) Every design, whether registered or unregistered, is assignable in law, either as to the whole interest or any undivided part, by an instrument in writing, which shall be recorded in the office of the Commissioner of Patents on payment of the prescribed fees.

Right to use design

(2) Every proprietor of a design may grant and convey an exclusive right to make, use and vend and to grant to others the right to make, use and vend the design, within and throughout Canada or any part thereof, for the unexpired term of its duration or any part thereof.

Licence

(3) A grant and conveyance under subsection (2) shall be called a licence, and shall be recorded in like manner and time as assignments.

Action for Infringement

15. Action by proprietor or licensee

(1) An action for infringement of an exclusive right may be brought in any court of competent jurisdiction by the proprietor of the design or by an exclusive licensee of any right therein, subject to any agreement between the proprietor and the licensee.

Proprietor to be a party

(2) The proprietor of the design shall be or be made a party to any action for infringement of the exclusive right.

15.1 Power of court to grant relief

In any proceedings under section 15, the court may make such orders as the circumstances require, including orders for relief by way of injunction and the recovery of damages or profits, for punitive damages, and for the disposal of any infringing article or kit.

15.2 Concurrent jurisdiction

The Federal Court has concurrent jurisdiction to hear and determine

- (a) any action for the infringement of an exclusive right; and
- (b) any question relating to the proprietorship of a design or any right in a design.

17. Defence

(1) In any proceedings under section 15, a court shall not award a remedy, other than an injunction, if the defendant establishes that, at the time of the act that is the subject of the proceedings, the defendant was not aware, and had no reasonable grounds to suspect, that the design was registered.

Exception

(2) Subsection (1) does not apply if the plaintiff establishes that the capital letter "D" in a circle and the name, or the usual abbreviation of the name, of the proprietor of the design were marked on

(a) all, or substantially all, of the articles to which the registration pertains and that were distributed in Canada by or with the consent of the proprietor before the act complained of; or

(b) the labels or packaging associated with those articles.

Proprietor

(3) For the purposes of subsection (2), the proprietor is the proprietor at the time the articles, labels or packaging were marked.

18. Limitation

No remedy may be awarded for an act of infringement committed more than three years before the commencement of the action for infringement.

PART II GENERAL

Clerical Errors

20. Correction

Clerical errors that occur in the drawing up or copying of any instrument under this Act respecting industrial designs shall not be construed as invalidating the instrument, but when discovered, may be corrected under the authority of the Minister.

Inspection

21. Inspection of registers

(1) Any person may be allowed to inspect the Register of Industrial Designs.

Copies

(2) Any person may obtain copies of registered industrial designs on payment of the prescribed fees.

Procedure as to Rectification and Alteration

22. Federal Court may rectify entries

(1) The Federal Court may, on the information of the Attorney General or at the suit of any person aggrieved by any omission without sufficient cause to make any entry in the Register of Industrial Designs, or by any entry made without sufficient cause in the Register, make such order for making, expunging or varying any entry in the Register as the Court thinks fit, or the Court may refuse the application.

Costs

(2) In either case, the Federal Court may make such order with respect to the costs of the proceedings as the Court thinks fit.

Questions to be decided

(3) The Federal Court may in any proceedings under this section decide any question that may be necessary or expedient to decide for the rectification of the Register.

Jurisdiction

(4) The Federal Court has exclusive jurisdiction to hear and determine proceedings under this section.

23. Application to alter design

(1) The registered proprietor of any registered industrial design may apply to the Federal Court for leave to add to or alter any industrial design in any particular not being an essential particular, and the Court may refuse or grant leave on such terms as it may think fit.

Notice to Minister

(2) Notice of any intended application to the Federal Court under this section for leave to add to or alter any industrial design shall be given to the Minister, and the Minister is entitled to be heard on the application.

24. Consequent rectification of register

A certified copy of any order of the Federal Court for the making, expunging or varying of any entry in the Register of Industrial Designs, or for adding to or altering any registered industrial design, shall be transmitted to the Minister by an officer of the Registry of the Court, and the Register shall thereupon be rectified or altered in conformity with the order, or the purport of the order otherwise duly entered therein, as the case may be.

Regulations

25. Regulations

The Governor in Council may make regulations

- (a) governing titles of designs;
- (b) respecting the form and contents of applications for registration of designs;
- (c) prescribing fees, or the manner of determining fees, to be paid for anything required or authorized to be done in the administration of this Act;
- (d) respecting the return of any fees paid under this Act;
- (e) respecting the registration of sets and of variants of a design;
- (f) respecting the making of requests for priority under section 29, including the information and documents that must be filed in support of a request and the period within which a request must be made and the information and documents must be filed;
- (g) governing the determination of the priority of applications under

section 29 and generally governing the application of that section;
and

(h) prescribing anything else that is to be prescribed under this Act and generally for carrying out the purposes and provisions of this Act.

Priority

29. Application filed in another country

(1) Subject to the regulations, an application for the registration of an industrial design filed in Canada by any person who has, or whose predecessor in title has, previously regularly filed an application for the registration of the same industrial design in or for a foreign country has the same force and effect as the same application would have if filed in Canada on the date on which the application for the registration of the same industrial design was first filed in or for that foreign country, if

(a) the application in Canada is filed within six months from the earliest date on which the foreign application was filed; and

(b) the person requests priority in respect of the application filed in Canada in accordance with the regulations and complies with any other prescribed requirements.

Definitions

(2) In this section,

“foreign country”

(a) means a country that by treaty, convention or law affords a privilege to citizens of Canada that is similar to the privilege afforded by subsection (1) with respect to the effective date of an application for the registration of an industrial design, and

(b) includes a WTO Member;

“WTO Agreement” has the meaning given to the word “Agreement” by subsection 2(1) of the World Trade Organization Agreement Implementation Act;

“WTO Member” means a Member of the World Trade Organization established by Article 1 of the WTO Agreement.

TRANSITIONAL PROVISIONS

29.1 Renewal of rights

(1) Section 10, as it read immediately before the day on which this

section came into force, applies in respect of an exclusive right acquired before that day.

Non-application of defence provision

(2) Subsection 17(1) does not apply in respect of a design registered on the basis of an application filed before this section comes into force if, after the registration, the name of the proprietor of the design appears on the article to which the design applies by being marked, if the manufacture is a woven fabric, on one end of it, together with the letters "Rd." or "Enr." or both "Rd." and "Enr.", and, if the manufacture is of any other substance, with the letters "Rd." or "Enr." or both "Rd." and "Enr." and the year of registration at the edge of it or on any other convenient part.

Method of marking

(3) For the purposes of subsection (2), the mark may be put on the manufacture by marking it on the material itself or by attaching to it a label with the proper marks on it.

TRANSITIONAL PROVISIONS

30. Prior applications

(1) Subject to subsection (3), an application for the registration of a design filed before this section came into force shall be dealt with and disposed of in accordance with the provisions of this Act as it read immediately after this section came into force.

Registrations

(2) Subject to subsections (3) to (6), any matter arising after this section came into force in respect of a design registered on the basis of an application filed before it came into force shall be dealt with and disposed of in accordance with the provisions of this Act as it reads when the matter arises.

Application requirements

(3) An application for the registration of a design shall be considered to have been made in accordance with section 4 as it read immediately after this section came into force if the application was made before this section came into force

(a) by the proprietor of the design, whether the first proprietor or a subsequent proprietor; and

(b) in accordance with section 4 as it read at the time the application was made.

Renewal of rights

(4) Subsection 10(2), as it read immediately before this section came into force, applies in respect of an exclusive right for which the term expires more than three months before this section came into force.

Non-application of defence provision

(5) Subsection 17(1) does not apply in respect of a design registered on the basis of an application filed before this section came into force if, after the registration, the name of the proprietor of the design appears on the article to which the design applies by being marked, if the manufacture is a woven fabric, on one end of it, together with the letters "Rd.", "Enr." or both "Rd." and "Enr.", and, if the manufacture is of any other substance, with the letters "Rd.", "Enr." or both "Rd." and "Enr." and the year of registration at the edge of it or on any other convenient part.

Method of marking

(6) For the purposes of subsection (5), the mark may be put on the manufacture by making it on the material itself or by attaching to it a label with the proper marks on it.