

### **The right resulting from an industrial design**

The recordation of an industrial design (or model) gives to its owner the exclusive right, privilege and liberty to 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 from it has been applied. The right has a maximum term which varies from country to country. In Canada, the maximum term is 10 years from the registration date. In the United States, the maximum term is 14 years while it is 25 years in Europe.

Through creative industrial designs, a company may reach out to and appeal to a specific target group or market. A product having attractive shapes and style is likely to sell more than the same product from a competitor having ordinary shapes or style. The recordation of an industrial design may then provide an important advantage on the market.

If the design is an artistic work, it is automatically protected by copyright and may be so registered. However, in the case where the design is used as a model or pattern to produce 50 or more manufactured articles, it is protected only by an industrial design registration, unless exceptions.

### **The form and content of an industrial design**

An industrial design takes the form of a document made up of drawings or photographs illustrating the finished article as well as all its original visual aspects. The drawings are generally preferred because they are usually clearer than photographs. Also, the negligible aspects of the article may be omitted in the drawings, thus avoiding them being considered among the features of design.

The industrial design also contains a designation identifying the finished article to which the design is applied, an indication of the visual features to be protected, and a short description of the views represented in the drawings.

An application for registration of an industrial design must be limited to only one design and its "variants". Variants are designs which do not differ substantially from one another. To be accepted as variants, the designs must be applied to the same article, and must possess the described features without substantial variation

### **Originality criteria**

All designs are not necessarily registrable. Certain conditions apply.

The features of the design must be of visual nature, for example by relating to the configuration (form), the pattern or the decorative elements of a manufactured article or a part of it.

To be registrable, a design must be original. A design that is identical with another one already registered, or that so closely resemble it as to be confounded with it will be rejected. The design must also be new on a worldwide scale. To be new, the design must not have been publicly presented or disclosed. Thus, the offer for sale of an article according to the design or its presentation during a tradeshow may destroy its novelty. Exceptionally, only some countries like Canada, the United States and Mexico grant a grace period of one year from the moment that a design no longer satisfies the novelty criterion to start the procedures for registering it, without affecting the validity of the eventual design registration certificate.

The object of the design must not be part of those excluded by Law or jurisprudence such as, for example:

- designs that are utilitarian only and which are not intended to provide visual appeal;
- designs that have no fixed appearance (for example, holograms);
- designs for components that are not clearly visible (for example, features that are hidden from view or features that are too small to have appeal to the eye);
- designs contrary to moral or to the law and order;
- a method of construction;
- an idea;
- materials used in the construction of an article;
- the useful function of the article (see discussion of patents in The Basics); or
- the color as such (although a pattern created by an arrangement of contrasting tones may be protected).
- features of an article presented in an isolated way (the registration of a design protects only the features of a finished article).

An electronic icon embodied in a finished object may however be registrable.

Requirements with respect to acceptability of the designs which lead to their registration vary from country to country so that what may be registrable in one country may be not in another one.

### **Ownership**

Only the owner of a design may apply for an application and obtain registration of an industrial design. Usually, the creator or author of the design is considered as being the owner. However, if the creator has been hired under contract to develop a design for someone else, then that person is the owner and is the only one entitled to apply for registration. Thus, if an employee of a company develops a design as part of his/her employment, then

the employer may be the owner. If the ownership of the design has been acquired by a person, it is this person who may apply for registration of the design.

The owner of the design registration certificate has the right to decide who can, and who cannot, use the object of the design during the term of the protection. He/she can, under the terms of a licence, allow third parties to use the design according to mutually agreed conditions. He/she may also sell its right in the design to a third party, who at his/her turn becomes the owner of the registration certificate.

## Steps

Industrial design registration certificates are issued by national patent offices, or by regional offices acting for several countries, for example the Office for Harmonization in the Internal Market (OHIM) for the community designs or models in Europe.

Obtaining industrial design registration certificates in various countries thus implies to prepare registration applications satisfying the form and content requirements typical to each country, to file them in the countries where the designs must be protected, and to prosecute the respective examination procedures in each country until issuance of the certificates. With some exceptions, applications must be written in the official languages of the countries where they are filed.

Before initiating these steps, it is highly recommended to carry out a preliminary novelty search relating to the existing designs and patents (considered as prior art to the design). The results of such a search generally allow reducing the risk that a relevant document be opposed by an examiner during the examination procedures of the applications, a possible result of which could block obtaining registration certificates for the design. The search results also allow assessment of the state of the art protected in the field and to better determine the original features which could be asserted in the applications, which is likely to improve the degree of protection for the design.

## Procedures

When an application for registration of an industrial design is filed in a country, an examiner makes his own prior art search before issuing a decision regarding the acceptability of the application. If he/she considers that the application has formal defects or that the asserted design is not original, the examiner issues an office action reporting the nature of each one of his/her objections. The applicant must then prepare and file a written response within the time period granted by the examiner so that the examination of the application continues. In his/her response, the applicant may bring corrections deemed appropriate in the application provided that these

corrections do not constitute a prohibited addition of subject matter, and may submit an argumentation in support of the originality of the design if he/she considers that the objections raised by the examiner are unwarranted. For lack of responding to the office action, the application is considered to be abandoned and the procedures are then terminated. Subsequent to a response, the examiner may come back again and issue a new office action if he/she deems it necessary, in which case a new response must be prepared and filed. The cycle goes on until the examiner is satisfied with the submitted responses and allows the application, or that he/she issues a final office action rejecting the application. In the event where an application is rejected, the applicant may appeal from the examiner's decision if he/she considers that the examiner is mistaken. In the case where the application is allowed, a registration certificate is issued. Regulatory fees for maintaining the certificate in force or for its renewal when applicable are required by certain national patent offices, in most cases by time slices of a number of years (usually 5).

## Convention priority

In most of the countries, an industrial design registration certificate will be granted to the first person or company who applies for it, insofar as the design has not been usurped to a third party. It thus means that by not registering an industrial design, an owner runs the risk that a third party creating an identical or similar design later registers it and legitimately excludes the owner from the market, limits the activities of the owner or asks for payment of royalties for using the design.

The filing of an application for registration of an industrial design thus establishes a priority right on any other applicant who would subsequently file an application for the same design. This priority right is acknowledged on a worldwide scale (Paris Convention) with the exception of certain rare countries. As a result of this priority right, an applicant may file a first application in a country and benefit from a 6 month grace period after the filing of the first application in order to file applications for the design in other countries while preserving his/her priority right provided that the priority is claimed. The subsequent applications are then considered so to speak as if they would have been filed on the same (priority) date as the first application.

## Publications

Applications for registration of industrial designs usually remain secret until their registration.

It is said that an application is pending when it is in force (has not been abandoned) and as long as the design has not been registered.

## Costs and time limits

It takes generally around 6 weeks to have the results of a novelty search, including an opinion in this respect. Costs in the order of 1800 \$ to 2800 \$ depending on the number of prior art references to be examined are to be expected for this step.

The preparation of a regular application for registration of an industrial design takes generally from 2 to 3 weeks, depending on the amount of information and the extent of the documents to be processed, and the number of figures required to illustrate and protect the design properly. The costs to be expected are directly related to these factors and are seldom lower to 800 \$ for an application of a few pages with some simple figures.

The costs for filing the applications fairly vary from country to country, depending on whether a foreign agent is involved or not, and depending on the amount of the various regulatory fees to be paid before the intellectual property offices. In Canada, the minimum costs to be expected for the filing of an application are around 500 \$ whereas the costs amount to around 2500 \$ for a US application.

The costs to be expected during the examination procedures also fairly vary from country to country, depending on the degrees of intervention required to have the applications allowed and the regulatory fees to be paid for the issuance of the design certificates if any. It is generally necessary to plan a budget varying between 1000 \$ and 4000 \$ to succeed through the examination procedures and obtaining a design certificate in each country. The examination procedures are usually short and registration of the design may be obtained in about 1 to 1½ year unless non-trivial objections are raised against the design during the process.

Costs for maintaining the design certificates in force in the form of payments of regulatory fees to the patent offices must also be expected. These fees are generally paid periodically (for example, on a 5 year basis after registration of the design) so as to maintain the registration in force. Such is the case in Canada and Europe, but not in the Unites States.

## Infringement

The right resulting from an industrial design is confirmed only when the certificate is issued. It is thus not possible to sue an infringer while the application is pending and the registration has not been confirmed yet. It is however usually possible to request an accelerated examination of the application (involving payment of a regulatory fee in this respect) to try obtaining the registration of the design more quickly.

It is generally recommended to mark the products in conformity with the design to indicate that it acts of a design recorded (this can even be obligatory in certain countries). Such marking can allow the granting of measurements of rectification (for example, one compensation) if somebody is shown and found guilty to have it counterfeits design. Suitable marking is the letter "D" inside one ring and the name or the abbreviation of the name of the owner of the design on the object, the label or its packing.

It is generally recommended to mark products in conformity with the design to indicate that it is a registered design (this may even be mandatory in certain countries). Such a marking may allow the award of a remedy, such as financial compensation, in the event that someone is charged and found to be infringing the design. The proper marking is a capital "D" inside a circle and the name, or abbreviation thereof, of the design's owner on the article, its label or packaging.

## Other available resources

Additional information on industrial designs and the other types of intellectual property are available for reference on the websites of the Canadian Intellectual Property Office (CIPO), the United States patent and trademark Office (USPTO), the World Intellectual Property Organization (WIPO) and the Office for Harmonization in the Internal Market (OHIM) at the following addresses:

CIPO	<a href="http://cipo.gc.ca">http://cipo.gc.ca</a>
USPTO	<a href="http://www.uspto.gov">http://www.uspto.gov</a>
WIPO	<a href="http://www.wipo.int">http://www.wipo.int</a>
OHIM	<a href="http://oami.eu.int/en">http://oami.eu.int/en</a>

## Notice

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