



**Date** June 30, 2018

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Todd Hunter  
Director, Copyright and Industrial Design Branch  
Canadian Intellectual Property Office  
50 Victoria Street  
Gatineau, Quebec  
K1A 0C9

Dear Mr. Hunter:

**Re: Comments from FICPI Canada on Proposed Revisions to the Industrial Design Office Practice Manual (IDOP)**

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the proposed revisions to the Industrial Design Office Practice Manual (IDOP).

As you know, FICPI (the Federation Internationale des Conseils en Propriété Intellectuelle), comprises more than 5000 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI and represents the interests of Canadian patent and trade mark professionals. Our membership includes senior professionals at most major Canadian intellectual property firms. Our clients span all types and sizes of businesses, including multi-national corporations, small and medium size enterprises, and individuals.

We appreciate that the new IDOP is intended to provide more information and guidance than the current version and applaud the Office for including details on new requirements, procedures and deadlines for national applications (i.e., those filed directly with CIPO) as well as information on how CIPO will treat applications received through the Hague System.

FICPI Canada is in general agreement with the proposed new IDOP, but has *specific concerns* about **Section 8.06.01**, which states:

For example, the following statements **would not** be acceptable: “The design is the visual features of the **entirety of the article shown in the reproductions**, whether those features are features one of shape, configuration, ornament or pattern or are a combination of any of these features.”

First, the statement proposed by the Office runs completely contrary to the decision in *Re Industrial Design Application No. 1997-1768 (1999)*, 3 CPR 4<sup>th</sup> 254 (Patent Appeal Board).

Second, statement proposed by the Office represents a complete reversal of existing Office practice as stated in Section 6.4.6 of the current IDOP, which states that the following is an acceptable description: “The design is the visual features of the **entire kettle shown in the drawings**, whether those features are features of one of shape, configuration, ornament or pattern or are a combination of any of these features.”

FICPI Canada proposes that the wording be changed to:

For example, the following statements **would be** acceptable: “The design is the visual features of the **entire article shown in the reproductions**, whether those features are features of one of shape, configuration, ornament or pattern or are a combination of any of these features.”

FICPI Canada also *requests clarification* on the proposed revisions to Sections 13.01, 13.03.02 and 16.01.04.01, as follows:

### **Section 13.01**

It is unclear to FICPI Canada what the parameters of an assessment of whether a design was created by the applicant or the applicant’s predecessor-in-title would entail. The Office states that such an assessment may be required “in exceptional circumstances when the Industrial Design Office has information according to which the applicant or its predecessor-in-title did not create the design.” Is the Office contemplating full-blown interference proceedings between conflicting applicants, including affidavit evidence, cross-examination, etc.? FICPI Canada is uncertain as to whether the Office has jurisdiction to entertain such an assessment. If the Office intends to conduct such assessments, the legislative or regulatory authority to do so should be referenced and a clear explanation of the process provided.

### **Section 13.03.02**

This section seems to suggest that any design that incorporates an 11-point maple leaf may be contrary to public order. FICPI Canada questions whether the apparent position of the Office is supported by the legislation (e.g. the *Industrial Design Act* does not contain any prohibitions analogous to s. 9 of the *Trade-Marks Act*).

#### **Section 16.01.04.01**

FICPI Canada notes that the Office takes the position that an earlier application will not be considered prior art against a later applicant if the filing date of the later filed application is no later than 12 months after the filing date of earlier filed application (i.e. self-collision). We also note that s. 8.2(1)(c) refers to “an application filed in Canada”, with no exception for a design filed by the same applicant. We further note the preamble to s. 8.2(1)(c), which states: “subject to the regulations...” FICPI Canada therefore suggests that the wording be changed to include the legal basis for excluding such an earlier application as prior art.

In addition to the specific concerns and requests for clarification noted above, FICPI Canada offers the following suggestions for possible improvement of the language and style of the proposed revisions.

First, in general the section headings in the proposed manual are difficult to locate because they are indented and are in regular font. FICPI Canada suggests that these headings be Right Justified, Bold, Italicised and Underlined, so they can be distinguished from the surrounding text and easily located.

For example:

#### **37.02.05 – Amendments**

Turning to the Sections themselves:

#### **Document Overview**

For consistency with the Foreword, which states “changes to the *Industrial Design Act*<sup>1</sup> (the Act)”, amend the 3<sup>rd</sup> bullet to change “the current Act” to “the Act”.

#### **Section 1.01**

For consistency, change “received on the day when CIPO is next open” to “received on the day when CIPO is next open to the public”.

For consistency, change “fees delivered to the above location” to “fees delivered to the above address”.

### **Section 1.03**

For consistency, change “received on the day when CIPO is next open” to “received on the day when CIPO is next open to the public”.

### **Section 1.04.01**

To avoid the use of personal pronouns, change “The facsimile electronic transmission report will constitute your acknowledgment receipt” to “The facsimile electronic transmission report will constitute acknowledgment of receipt”.

Similarly, change “If there is a fee associated with your correspondence” to “If there is a fee associated with the correspondence”.

### **Section 1.06**

For gender neutrality, change “from his home address” to “from the applicant’s home address”.

For consistency, change “to act as the address of correspondence” to “to act as the address for correspondence”.

For greater certainty, change “the Industrial Design Office will send communications only to the applicant or that authorized person” to “the Industrial Design Office will send communications only to the applicant or that authorized person in respect of that action”.

### **Section 1.07**

For clarity, change “this communication forms part of the file and will be made available to the public with the application or registration” to “this communication forms part of the file and will be made available to the public on the earlier of the date of registration of the design and the day that is 30 months after the filing date of the application or from the earliest priority date of any design in the application”.

### **Section 2.01.01**

Question re “When the Industrial Design Office receives this information, it will send a confirmation of appointment to both the applicant and the appointed agent”: Will the Office notify the applicant directly when an agent is appointed at the time of filing? This is not current Office practice.

### **Section 3.02**

Will the Office need to revise the IDOP if the \$100 transfer registration fee changes by operation of the *Service Fees Act*?

### **Section 5.01**

Change “The applicant or any person authorized by them may pay fees” to “The applicant or any person authorized by the applicant may pay fees”.

### **Section 6.01**

For clarity, change “While confidential, applications are available only to the applicant or the applicant's agent, unless the Industrial Design Office receives written authorization from the applicant or the applicant's agent allowing someone else to obtain them” to “Prior to being made available to the public, an application is available only to the applicant or the applicant's agent, unless the Industrial Design Office receives written authorization from the applicant or the applicant's agent to make the application available to someone other than the applicant or the applicant's agent”.

### **Section 7.01**

For clarity, change “the Industrial Design Office will notify the applicant and invite them to submit” to “the Industrial Design Office will notify and invite the applicant to submit”.

### **Section 7.03**

Change “is provided in sections 25 of this manual” to “is provided in section 25 of this manual”.

### **Section 8.01**

To avoid the use of personal pronouns, change “content you may wish to include in your application” to “content that can be included in an application”.

### **Section 8.03**

Will the Office need to revise the IDOP if the \$400 examination fee or \$10 additional page fee changes by operation of the *Service Fees Act*?

### **Section 8.04.02**

The following does not seem to be a complete sentence: “For example, a cutlery set with the same design being applied to a fork, a knife and a spoon.”

### **Section 8.05.05.01**

For clarity, change “Regardless of where an article is cut, the cross-section must remain identical and there is no surface pattern and no three-dimensional (3D) features” to “Regardless of where an article is cut, the cross-section must remain identical and there must be no surface pattern and no three-dimensional (3D) features”.

#### **Section 8.05.05.05**

The following sentences are difficult to understand: “There is a repeating pattern on the surface of the article that does not affect the article’s cross-section. A statement referring to indefinite length or width must be included in the application.” The wording in Sections 8.05.05.07 and 8.05.05.09 is clearer.

#### **Section 8.05.05.06**

The following sentences are difficult to understand: “The cross-section is not constant throughout; however, the 3D features repeat at regular intervals throughout the article’s length or width. A statement referring to indefinite length or width must be included in the application.” The wording in Sections 8.05.05.07 and 8.05.05.09 is clearer.

#### **Section 8.05.05.10**

The following sentence is difficult to understand: “The cross-section is not constant throughout the relevant portion as 3D features repeat at regular intervals throughout its length.” The wording in Sections 8.05.05.07 and 8.05.05.09 is clearer.

#### **Section 8.05.07**

Clarification of “An electronic icon design can be shown applied to the finished article (Fig. 1.1 of Example 29) or in isolation (Fig 1.2).”: Will the Office accept a single view of an electronic icon that does not include the article (e.g. an application containing only Fig. 1.2).

#### **Section 27.01**

To aid in comprehension, in line 2 add “of final refusal” after “notice”. In the same line remove “final” prior to “judgment”.

#### **Section 28.01**

To aid in comprehension, in line 4 change “statement” to “statement of grant”.

#### **Section 29.01**

The jurisdiction of the Federal Court of Canada is limited to Canada and Canadian rights. To aid in comprehension amend the paragraph to read:

The Federal Court of Canada has exclusive jurisdiction to grant an order invalidating a Hague registration, in so far as it relates to Canadian rights. Any person may petition the Federal Court for an order invalidating a Hague registration. Once an invalidation order is no longer subject to appeal, the Industrial Design Office will notify the International Bureau in order for the invalidation to be recorded in the International Register. Invalidation revokes or cancels the effects, in Canada, of a Hague registration.

### **Section 31.02**

To aid in comprehension:

- in line 3 replace “a national of Canada or, has a domicile, a habitual residence” with “a Canadian citizen or resident”,
- in line 3 insert “has a” prior to “real”,
- line 4, add a “,” after “Canada”, and
- line 5, reverse the order of “evidence satisfactory”.

### **Section 32.02**

To aid in comprehension:

- In line 2, after “correction” add “, together with detailed reasons,”,
- In line 5 change “the date of the notification” to “the date the notification is forwarded to the holder by the International Bureau”.
- At the end of the paragraph add “Insofar as a refusal affects Canadian rights, a refusal by the International Bureau to recognize a correction is appealable to the Federal Court of Canada”.

### **Section 33.02**

To account for potential changes to the tariff of fees, in line 5 change “which is \$350” to “is that”.

### **Section 33.03.01**

To aid in comprehension:

- In line 1 change “At the five-year mark” to “Within five years of the date of international registration”, and
- In line 1 of the second paragraph change “at the ten-year mark” to “within ten years from the date of international registration”.

### **Section 33.03.02**

To aid in comprehension:

- In line 1, after “the five-year period” add “from international registration”,
- In line 3, change “within that period” to “within the six-month period”, and
- In line 4, change “at the five-year mark” to “five years from the date of the international registration”.

#### **Section 34.02.02**

To correct a clerical error, in line 6 change “outline that such request” to “outlines that such a request”.

#### **Section 36.02.02**

To correct clerical errors, in line 1 add “13” after “Section”, and in line 7 change “outline” to “outlines”.

#### **Section 37.02.01**

To correct clerical errors, add a “,” after “Regulations” in line 1 and after “French” in line 2.

#### **Section 37.02.05**

To correct clerical errors, add a “but” after “amendments” in line 2.

#### **Section 37.02.07**

To aid in comprehension, in line 6 delete “in the”.

#### **Conclusion**

FICPI Canada wishes to thank CIPO for the opportunity to provide these comments and invites CIPO to contact the undersigned should it have questions about them.

Yours truly,

FICPI Canada  
per Coleen Morrison, President  
and Serge Shahinian, Secretary