



October 30, 2009

Canadian Intellectual Property Office  
Copyright and Industrial Design Branch  
50 Victoria Street  
Place du Portage II  
Gatineau QC K1A 0C9

Attention: Rita Carreau

Dear Ms. Carreau:

**Re: Proposed Practice Notice – Industrial Design Extensions of Time in Examination**

On behalf of the Industrial Design Committee of the Canadian Bar Association's Intellectual Property Section (CBA Committee), I am pleased to comment to the above-noted consultation. We understand the need to streamline the examination process, while still serving the needs of clients. However, the CBA Committee believes that the potential hardship that could arise with the implementation of the proposed Practice Notice would outweigh any advantages. Our reasons for this position are set out in detail below.

**Current system**

Under the current practice, as detailed in the Practice Notice of June 13, 2002 and the *Industrial Design Office Practices*,<sup>1</sup> the Office will permit multiple requests for extensions of time, granting an extension of up to four months per request. If a further extension is sought to extend the period for reply beyond the expiration of twelve months from the deadline to respond to an Examiner's Report, CIPO will require significant substantive reason(s) which clearly justify a further extension of time and which set out in detail the reason why it is not possible to respond to an Examiner's Report.

**Proposed practice**

Under the proposed practice, a single extension of time will be entertained. The extension period granted will be six months. Failure to respond within this six-month period will result in the

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<sup>1</sup> Online: <[http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/vwapj/diPratiquesAdministratives-idOfficePractices-eng.pdf/\\$FILE/diPratiquesAdministratives-idOfficePractices-eng.pdf](http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/vwapj/diPratiquesAdministratives-idOfficePractices-eng.pdf/$FILE/diPratiquesAdministratives-idOfficePractices-eng.pdf)>.

application becoming abandoned. Abandonment and reinstatement are governed in accordance with sub-ss. 5(3) and 5(4) of the *Industrial Design Act*

### **Detriments to Applicants**

Under the current examination practice, the initial period to reply to an examination report is four months. As proposed, an applicant may request a single extension to obtain an additional six months, for a total of ten months to reply and avoid abandonment. While in the majority of instances this period is likely sufficient, it is for the exceptional matters that a more flexible extension practice ought to be in place.

There is likely to be detriment to applicants in at least some of the following instances:

- when the examination report raises drawing compliance issues and the applicant is represented by a Canadian agency who is instructed by applicant's local counsel;
- when there is a change in owner of an application close to the deadline for responding to the Examiner's Report; and
- when there is a change in the agent or representative for service for the application in question or a change in the instructing principal for the application close to the deadline for responding to the Examiner's Report.

This list is meant to provide examples only and is not exhaustive of the situations where an extension of time beyond a ten-month period would be warranted. In our view, such circumstances would justify at least one further extension. Under the proposed practice, no discretion to grant a further extension would be available.

### **Impetus for Change**

We do not believe that there was any pressure from the public, applicants and practitioners, for a change to the current Office practice relating to extensions. If this change is seen as necessary or desirable from the perspective of the Office, we would appreciate more information about the reasons that would justify the potential negative effect on applicants. The effect will be felt particularly by those applicants on behalf of whom foreign associates are providing instructions to Canadian practitioners.

Moreover, the desire to adopt an approach that is consistent with other product lines of CIPO is not understood and is not shared by applicants or the profession. Why should the extension period harmonize with other lines of business? Each property type has its own requirements and compliance difficulties. These differences should not be treated equally purely for the sake of administrative convenience. Equality is not about treating unlike things equally, but recognizes differences and treats each fairly and proportionately.

### **Alternative Proposal**

If the goal of the proposed change is to expedite the examination process, an alternate proposal may be to utilize a warning system in cases where further extensions of time do not seem warranted. This will result in applicants giving due consideration before filing extension

requests while still ensuring that applications do not enter into default in situations where clearly applicants are actively engaged in moving the applications forward.

If the current practice must change such that only a single six month extension will be automatically granted, a residual discretion to grant further extensions ought to be retained where the circumstances justify such a request. At the very least, the initial period of reply should be changed from four months to six months so that the total time for a response with extensions is 12 months.

We would appreciate the opportunity for further dialogue before any implementation of a change in the practice regarding the grant of extensions of time in examination occurs.

Yours very truly,

*(Original signed by Kerri Froc for James Longwell)*

James Longwell  
Chair, Industrial Design Committee  
National Intellectual Property Section