

How do design and copyright interact?

The treatment of design and copyright varies substantially between countries, with much of it driven by jurisprudence rather than legislation. Attorneys in six jurisdictions offer their advice

Canada

1 What design and copyright protection is available for industrial products in your country?

In Canada, the visual aspects of industrial products may be protected under two different regimes, industrial designs and copyright (and potentially trade marks). Though both regimes can be used to obtain a monopoly over the trading of products bearing specific aesthetic characteristics, the overlap is subject to strict rules and exceptions.

Industrial design protection extends to the aesthetic aspects of a product: its shape, configuration, pattern or ornament. These features must be judged solely by the eye, and any aspect of the design that is solely dictated by function will not be protectable by industrial design.

To attract protection, a design must show a “spark of inspiration”; it must be sufficiently original and novel that it differs substantially from already existing designs, and registration must be sought within one year of its first publication anywhere in the world. Once industrial design protection is acquired, its owner obtains a 10-year monopoly over the right to make, import, sell, rent or offer for sale the same type of product bearing the design or one that is not substantially different. Protection therefore extends beyond the design as registered, though the exact scope of protection will vary on a case-by-case basis depending on multiple factors, including pre-existing designs.

Copyright law protects every original “literary, dramatic, musical and artistic work”. With respect to industrial products, the most relevant types of artistic works are drawings, photographs, sculptures and works of artistic craftsmanship. Copyright subsists in and of the work itself; there is no need to obtain a copyright registration.

The originality requirement for copyright is lower than that of industrial designs: the work must not be a copy of a previous work, and the author must have exercised “skill and judgment” in its creation.

The term of protection for copyright is generally 50 years following the author’s death, during which period the owner will have the sole right to produce or reproduce the work or any substantial part of it in any material form. Most types of commercial dealings in copies of the work by third parties will also lead to copyright infringement, essentially granting to the owner a monopoly over trade in the work.

2 Is cumulative protection possible?

In some cases it will be possible to obtain cumulative copyright and industrial design protection for aspects of an industrial product. If the originality requirement for both regimes is satisfied, an artistic work applied to a product could be an industrial design if it is a shape, configuration, pattern or ornament. However, cumulative protection may only be concurrent and cannot be used to extend protection.

If a useful article is reproduced more than 50 times, it will not be copyright infringement for a third party to copy the article

One-minute read



Design rights are a relatively new route for IP protection, but have become increasingly popular following high-profile cases over Apple’s designs for its phones and tablets. The length of copyright protection can make it attractive for industrial products as well, and dual protection with a design right is possible in most countries. Others, however, limit that protection by setting a higher bar of creativity for copyright, or limiting copyright to a certain volume of goods.



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It is important to note that if a useful article is reproduced more than 50 times, it will not be copyright infringement for a third party to copy the article (this is the so-called more-than-50 rule). In such cases, while copyright in the work may still exist and be registered, it cannot be enforced against the third party unless it falls under one of the exceptions described below to the more-than-50 rule. In such cases where the exceptions do not apply, only industrial design protection will be available to enforce one's rights against a third-party infringer.

There are, however, certain exceptions to the more than 50 rule, notably if the copyrighted work is used as:



A graphic or photographic representation applied to the face of a product (see Cirque du Soleil T-shirt, left);



A trade mark or a label, including a three-dimensional trade mark or distinguishing guise (such as the Coca-Cola bottle shape);



A material that has a woven or knitted pattern or that is suitable for piece goods or surface covering or for making wearing apparel (such as the floor tiles opposite); and



A representation of a real or fictitious being, event or place applied to the product as its shape, configuration, pattern or ornament (like the Flintstones-shaped vitamins shown).

In these cases, concurrent copyright and industrial design protection will be possible even if more than 50 copies of the useful product are made.

3 How have the courts dealt with the two rights? What are the key cases?

The Canadian statutory framework dealing with the overlap between copyright and industrial designs, including the more-than-50 rule, is relatively recent. As such, there have been very few decisions on the merits on the issue.

In *Pyrrah Design v 623735 Saskatchewan*, a jewellery designer had sued the defendant for copyright infringement for having copied its jewellery designs. The defendant brought a motion for summary judgment, arguing that because the jewellery was a “useful article” and thus subject

to the more-than-50 rule, it could not infringe copyright by copying the plaintiff’s jewellery. The motions judge accepted that argument and summarily dismissed the action. On appeal, the Federal Court of Appeal concluded that it was unclear whether jewellery was a useful article and as such subject to the more-than-50 rule, or whether it was merely a carrier for artistic matter and thus not subject to that rule. This case was sent back for trial and eventually settled without a final decision. Nevertheless, it serves as an indication that courts should hear all relevant evidence before deciding whether an article to which a copyrighted work is applied is useful, and hints that a useful article must have a “practical use in addition to its aesthetic value”.

4 What practical advice would you have for producers of such products? What rights should they seek and would it vary by product?

If copyright subsists in an aspect of your product, protection will run from the date of creation and will exist on its own; there is no need to obtain copyright registration, which is unnecessary and can be obtained very quickly (within a week or so) and at little cost to benefit from evidentiary/procedural advantages should litigation become necessary.

If in doubt, obtain an industrial design registration for the most important aspects of the product, keeping in mind that it must be filed within one year of the first publication of the design. Obtaining an industrial design is relatively inexpensive (compared to a patent) and expeditious.

If the product you seek to protect is or may become an important part of your business, you should consider deploying marketing efforts during the 10-year industrial design monopoly to make the product’s design known to consumers as a source identifier to your business. Once consumers associate the product’s design with your business (the product design has acquired distinctiveness), it could qualify for trade mark protection as a distinguishing guise (for instance, shaping of wares or containers, or a mode of wrapping or packaging). Once registered, this protection will not only last for a longer period of time (possibly indefinitely, as long as the guise is used and is registered), but will also trigger the trade mark exception to the more-than-50 rule and thus ensure concurrent copyright protection.



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