

Protecting Product Designs –

How Best to Approach This in Canada?

By Ekaterina Tsimberis, Partner

SMART & BIGGAR



Case Study – Seventh Heaven Designer Handbag



Question:

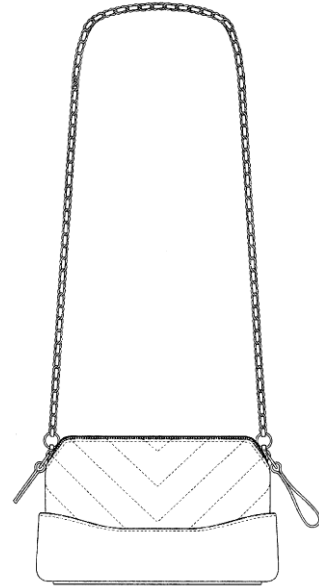
How best to utilize industrial design, copyright and trademarks to effectively protect a designer's product design in Canada?



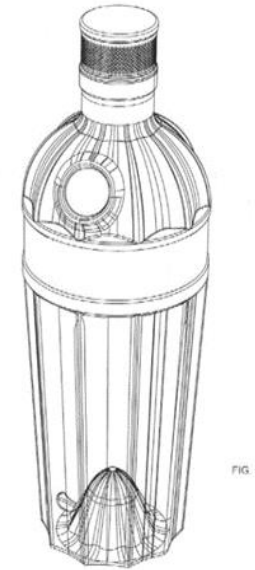
1. Industrial Design Protection

Protects the shape of a product or its container while it becomes a distinctive sign.

Examples:



Title: PURSE
Registration No: 179889



Title: BOTTLE
Registration No: 155283



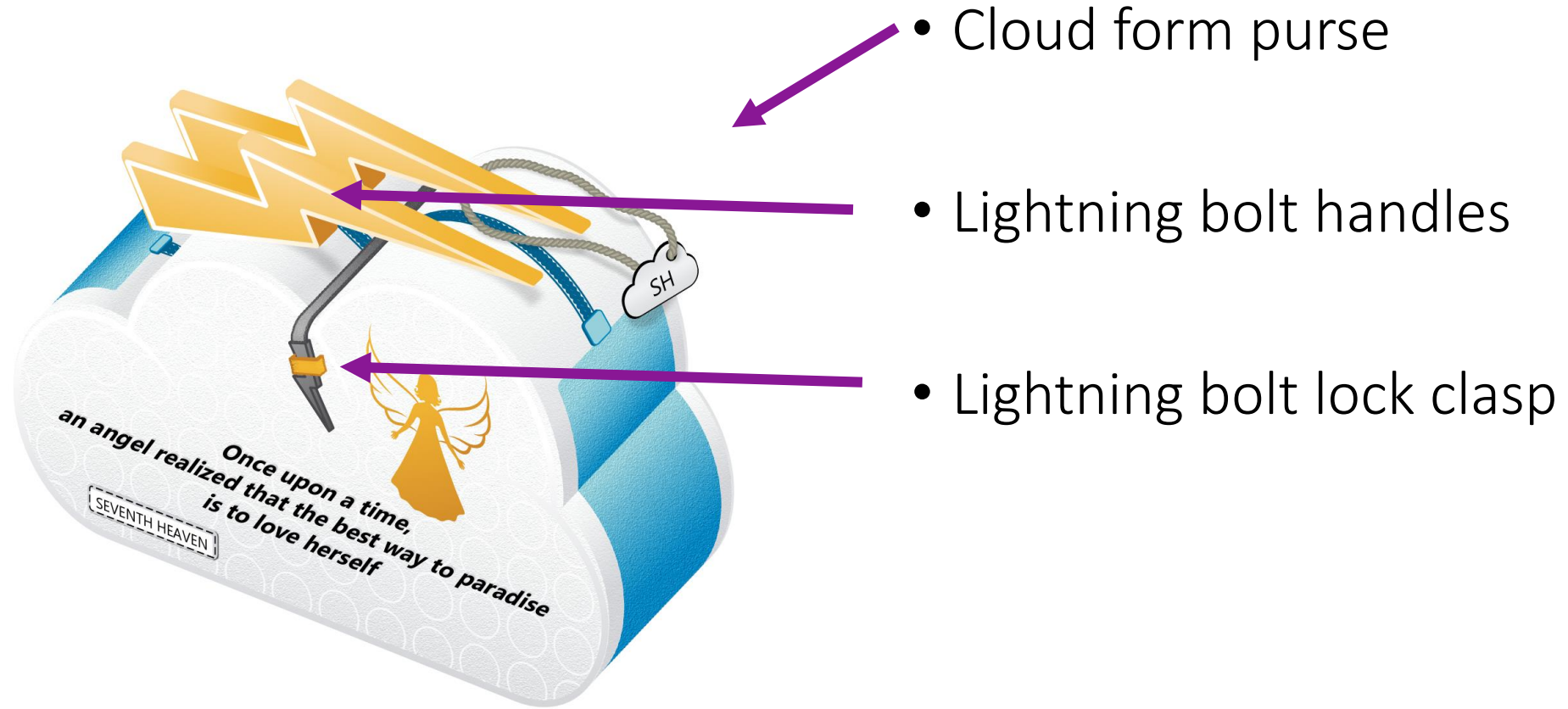
1. Industrial Design Protection

Several conditions:

- Must fall within the definition of “design”:
 - 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

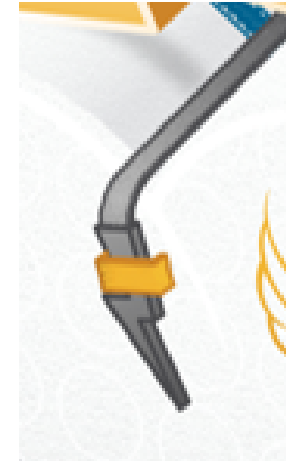


1. Industrial Design Protection -



1. Industrial Design Protection – Conditions

- Must not be purely dictated by an utilitarian function of the finished article



- Features may be simultaneously useful and visually appealing. Such features of a product that fulfill both a aesthetic and utilitarian function can be protected by the *Industrial Design Act*.

Zero Spill Systems (Int'l) Inc. v Heide, 2015 CAF 115, at paras 24-25

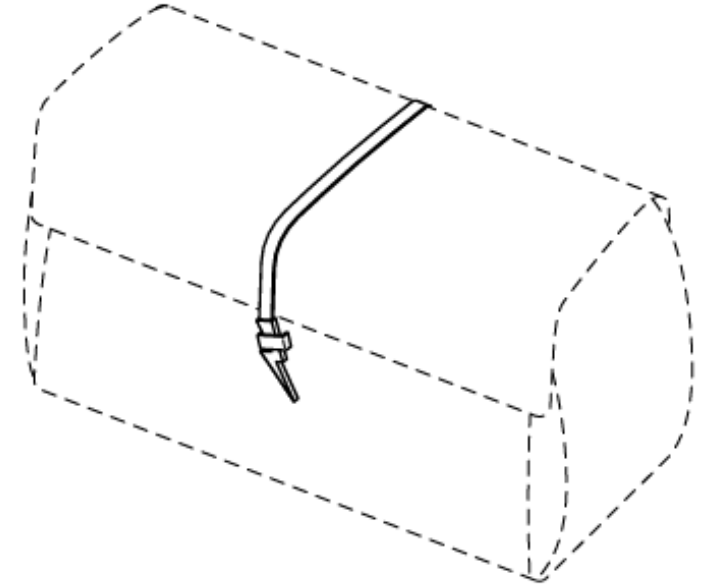
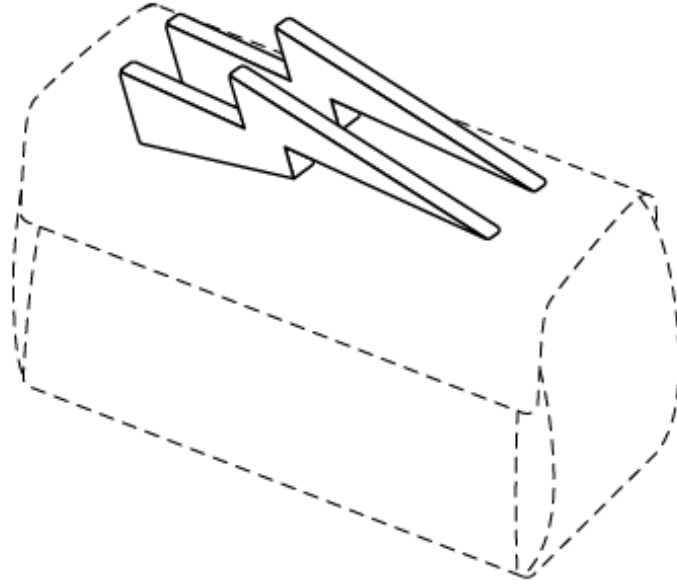
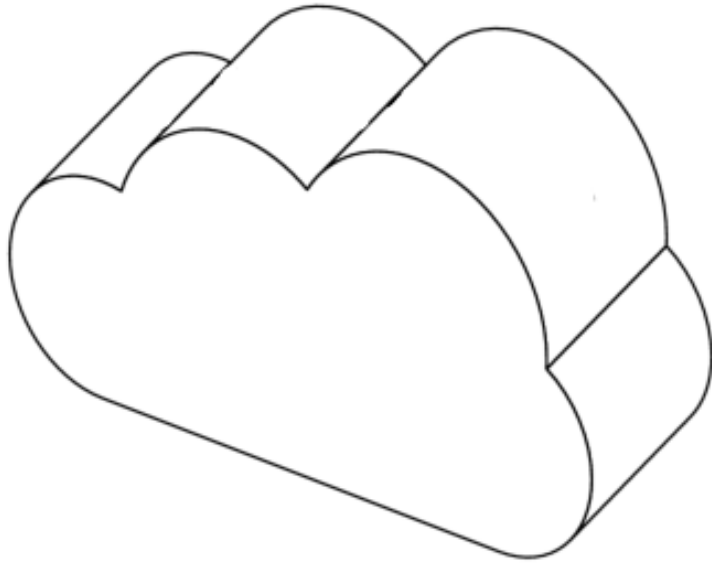


1. Industrial Design Protection - Conditions

- Must be novel: Must not have been published more than one year before the filing of the application
- Be original: Must not be identical to, or similar to, a previously registered design
- Not be contrary to public morality or public order



1. Industrial Design Protection -



1. Industrial Design Protection - Effects

- Protection by industrial design lasts for a maximum of 10 years after date of registration (or 15 years after the filing date of the application).
- Protection by industrial design is limited to the object for which the design is registered.
- Provides some protection during the development of the sign as a source indicator.



2. Copyright Protection



The shape of a product could qualify as an artistic work, which if original, could benefit from copyright protection.



2. Copyright Protection - Conditions

The purse and certain elements of the purse could benefit from copyright protection :

If either literary, dramatic, musical or artistic works :

literary work includes tables, computer programs, and compilations of literary works;

artistic work includes paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works

-and-

If original



2. Copyright Protection

One issue: In order to eliminate the overlap between the *Copyright Act* and the *Industrial Design Act*, the Parliament enacted section 64 of the *Copyright Act*



2. Copyright Protection – Overlap between Copyright, Industrial Design and Trademark



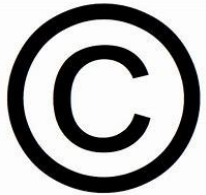
If a design (the shape of which is original) is applied to a useful article or in an artistic work and is reproduced in a quantity of more than 50 → the reproduction of the product will not constitute copyright infringement.



2. Copyright Protection – Exceptions to « More than 50 » Exclusionary Rule

Unless it is, among other things:

1. a graphic or photographic representation that is applied to the face of an article;
2. a trade-mark or a representation thereof or a label;
3. material that has a woven or knitted pattern or that is suitable for piece goods or surface coverings or for making wearing apparel;
4. an architectural work that is a building or a model of a building;
5. a representation of a real or fictitious being, event or place that is applied to an article as a feature of shape, configuration, pattern or ornament;
6. articles that are sold as a set, unless more than fifty sets are made; or
7. such other work or article as may be prescribed by regulation.



2. Copyright Protection –



1. The Angel artistic work:
immediately
2. Once upon a time Slogan literary
work (if original enough):
immediately
3. 3D Cloud Shaped Purse
Trademark:
available only when becomes a
source identifier

2. Copyright Protection - Conclusion

- Copyright protection is immediately available for original literary or artistic works found on the purse.
- Copyright protection for the shape of the purse or its parts will not occur initially as it requires that the product's shape act as a source indicator (i.e. as a trademark).
- As such, no immediate protection offered by copyright for the shape of a purse or its parts, unless another exception applies.



3. Trademark Protection -

The *Trademarks Act* provides for the protection of a shape of a product:

Trademark means:

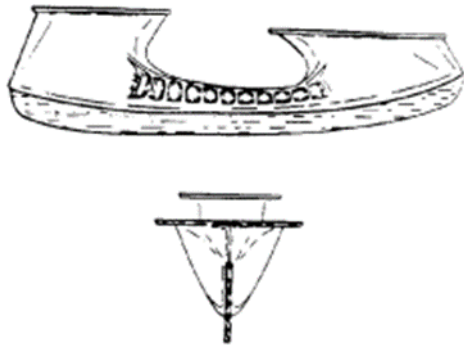
1. A sign or combination of signs;
2. That is used or proposed to be used by a person;
3. For the purpose of distinguishing or so as to distinguish their goods or services from those of others.

(1) A sign includes a word, a personal name, a design, a letter, a numeral, a colour, a figurative element, a **three-dimensional shape**, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture and the positioning of a sign

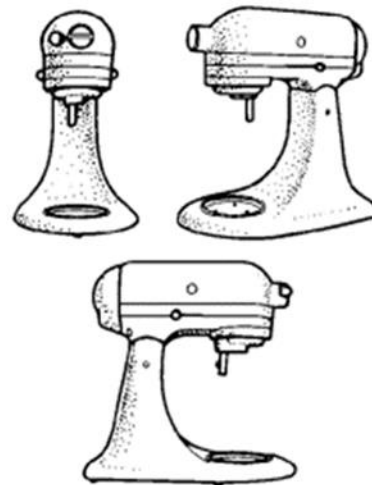


3. Trademark Protection -

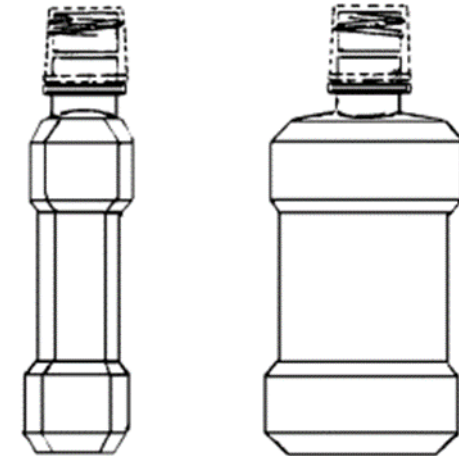
- As of September 2019, **under 400** distinguishing guises or 3D marks were registered in Canada
- Some examples:



LMC512,683 - SKATE-BLADES DESIGN



LMC525,815 – ELECTRIC BEATING AND MIXING MACHINE



LMC664,689- LISTERINE BOTTLE DESIGN



3. Trademark Protection -

Why so few registered distinguishing guises and 3D marks?



3. Trademark Protection -

2 main conditions :

- 1) Demonstration that the 3D mark became distinctive at the date of filing an application for its registration; and
- 2) The shape of the 3D mark may not be wholly or primarily functional.



3. Trademark Protection

(1) Proof of acquired distinctiveness of the shape:

- Required even if the shape of the sign has a strong inherent distinctiveness.
- Affidavit of applicant establishing significant sales, advertising and promotion in Canada and the non-use of such a shape by other actors in the industry.
- Additional Evidence (Affidavits from Distributors / Buyers / Retailers) sometimes required, for example, if:
 - Main evidence deemed insufficient;
 - Weak inherent distinctiveness.
- Survey



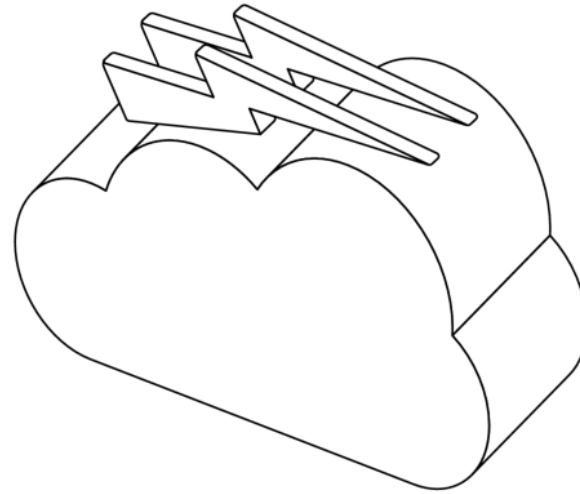
3. Trademark Protection -

(2) A shape is not registrable as trademark if, in relation to the goods or services in association with which it is used or proposed to be used, its features are dictated primarily by a utilitarian function.

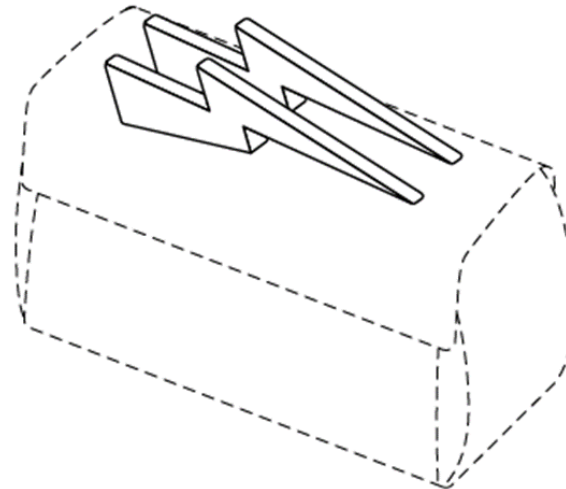


3. Trademark Protection - Examples

- 3D Cloud-shaped purse with handles



- 3D Lightning bolt handles



3. Trademark Protection -

TO REMEMBER:

Avoid highlighting, with advertising and promotion, the utilitarian characteristics of the sign, their technical advantages and the aesthetics or the beauty of the sign.



3. Trademark Protection - Conclusion

- For a shape to function as a source indicator, it usually takes years of well-targeted marketing, advertising and promotion.



*Only the most cared for olives
make it to the Lucini bottle™*



- In other words, trademark protection, just like copyright protection, not available instantly for shape of product.



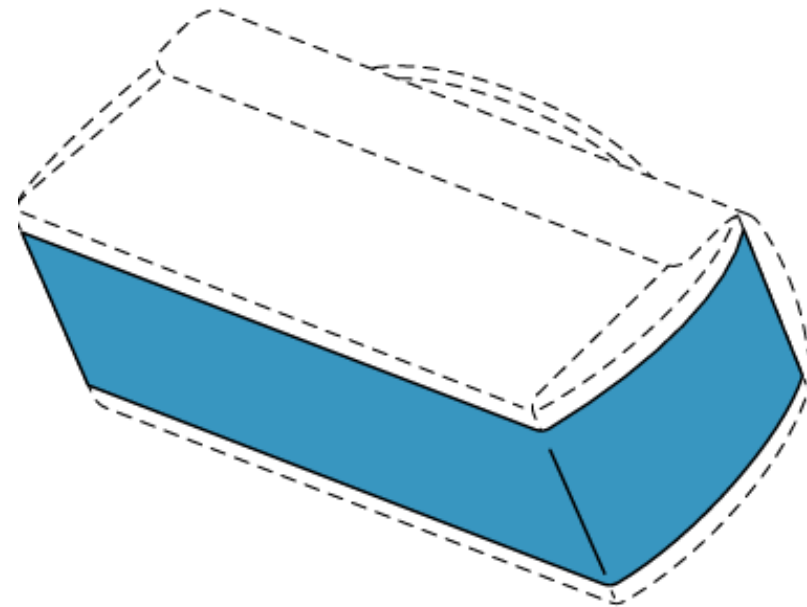
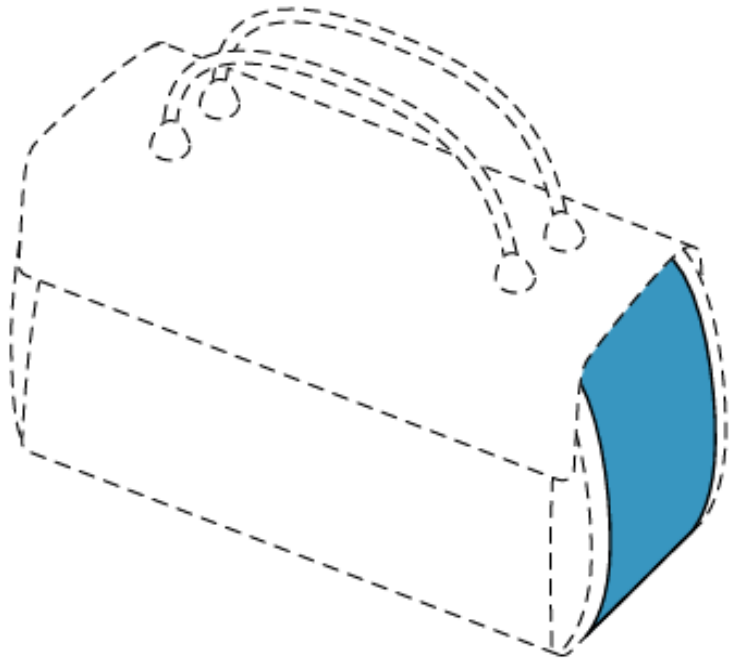
3. Trademark Protection – Other Examples



- SEVENTH HEAVEN Word mark
- SH Cloud Design Mark
- Angel Design Mark

3. Trademark Protection –Examples

- Blue Position Mark



3. Trademark Protection - Conclusion

- What to do during this critical period during which the product develops as a source indicator?
 - Industrial Design
 - Copyright
 - Unfair Competition



3. Unregistered Mark/Unfair Competition

Canada offers some protection to unregistered trademarks, including for the packaging of products, which includes their shape or that of their container, in the context of an action for unfair competition.

7.No person shall

- b) direct public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his goods, services or business and the goods, services or business of another;
- c) pass off other goods or services as and for those ordered or requested;



3. Unregistered Mark / Unfair Competition

- The plaintiff must prove:
 1. That a distinctive element of a product has become recognized by the Canadian public as indicative of a particular source (Goodwill);
 2. Public deception due to misrepresentation; and
 3. That it has suffered actual or potential damage.



3. Protection - Unfair Competition

Difficulties:

- Demonstration of goodwill in the shape of a product or its container when it has just been adopted.
- All of the surrounding business circumstances are relevant in assessing the likelihood of confusion for unregistered marks
 - *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 CPR (3d) at para. 11 (FCA)



Conclusion & Recommendations

- With significant sales and well-targeted promotion, the first 5 years of industrial design protection may be enough to allow the shape of the product to become distinctive to consumers as a sign.
- This will allow the sign/3D mark to be registered as a trademark *and, thus, to benefit from copyright protection.*
- This may also allow the unregistered 3D mark to develop enough goodwill to enforce using unfair competition.



Benefits of multiple forms of protection

- Owner benefits from wider scope of protection :
 - **Industrial Design:** Protection limited to 10 years (or 15 years after the filing date of the application), targeting only the specific product being registered.
 - **Copyright:** Protection limited to 50 years after the death of the author, whatever may be the mode or form of its expression.
 - **Trademark:** Potentially eternal protection, targeting anything that may be confusing with the product.



Benefits of multiple forms of protection

- The owner will benefit from several remedies under the *Trademarks Act*, the *Copyright Act* and the *Industrial Design Act*.
- **Copyright:** Seizure before judgement of infringing copies of work in the province of Quebec





Thank you

Ekaterina Tsimberis

Ektsimberis@smartbiggar.ca

SMART & BIGGAR