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Whither Industrial Design

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Article

***1 Whither Industrial Design**

Amy Muhlstein, Margaret Ann Wilkinson [\[FN1\]](#)

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The scope of the Industrial Design Act in Canada is much narrower than the concept of industrial designs, as original and unique manufactured objects, in industry. Indeed, the Industrial Design Act applies only to the aspects of industrial designs which we have described as the design aspects. Similar protection of the design aspects of industrial designs exist in Britain and the United States, although, as discussed, these protections take different forms in each jurisdiction. Although some of the aspects of industrial designs other than the design aspects receive no intellectual property protection in any of the three jurisdictions, others are protected variously through copyright, patent and trade mark. However, the extent of the intellectual property protections for industrial design and the degree of overlap between them varies considerably from jurisdiction to jurisdiction. This article looks at the development of the protection of the design aspects of industrial designs, the extent of international co-operation in the treatment of these design aspects, and the protections of all aspects of industrial designs available in Britain, Canada and the United States. This discussion leads to suggestions for the future of Canada's own design laws and treatment of industrial designs generally.

***2 CONTENTS**

1.	INTRODUCTION	3
2.	EVOLUTION OF DESIGN LAWS	8
3.	THE TREATMENT OF (A) DESIGNS AND (B) INDUSTRIAL DESIGNS WITH EXISTING CANADIAN INTELLECTUAL PROPERTY LAW SCHEMES	15
	(a) Designs	16
	(b) Industrial Designs	23
	(i) Elements protectable under the <i>Industrial Design, Act</i>	23

	(ii)	Elements protectable in copyright	23
	(iii)	Elements protectable as trademarks	28
	(iv)	Elements protectable through patents	32
	(v)	The cumulative effect of intellectual property protection of industrial designs	34
4. THE TREATMENT OF INDUSTRIAL DESIGNS ABROAD			35
	(a)	In the United States of America	35
	(i)	Designs	35
	(ii)	Industrial designs	37
	(b)	In Britain	38
	(i)	Designs	38
	(ii)	Industrial designs	41
	(c)	International agreements regarding designs and industrial designs	44

5.	THE FUTURE OF INDUSTRIAL DESIGN LAWS IN CANADA AND ABROAD	51
(a)	Intellectual property in designs	53
(b)	Intellectual property in industrial designs other than design aspects	56
(c)	Concluding observations about Canada	56

*3 1. INTRODUCTION

According to the *Industrial Design Act*, a “‘design’ or an ‘industrial design’ means 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.” [FN2] This requirement that an industrial design be “a pattern or representation which the eye can see and which can be applied to a manufactured article” [FN3] is, even today, often reduced to the single concept “ornament.” In the House of Commons debate preceding the amendments to the *Industrial Design Act* in 1993, it was stated that industrial designs “related pretty much to ornamentation applied to an article.” [FN4] The industrial design industry, on the other hand, even in 1969, had a much broader concept of industrial design:

Industrial design is a creative activity whose aim is to determine the formal quality of objects produced in industry. These formal qualities are not only the external features but are principally those structural and functional relationships which convert a system to a coherent unity both from the point of view of the purchaser and the user. Industrial Design extends to embrace all the aspects of human environment which are conditioned by industrial production. [FN5]

Further, industrial designs may be “improvements to existing products, or totally new concepts, ideas or innovations”. [FN6] A current industry definition of industrial design as follows:

*4 Industrial design is the professional service of creating and developing concepts and specifications that optimize the function, value and appearance of products and systems for the mutual benefit of both user and manufacturer. [FN7]

It is clear, then, that the legislation does not protect an industrial design *per se*, but protects only one aspect of an industrial design - its appearance. Not all industrial designs include the aspect of ornamentation and therefore some industrial designs may not have an aspect which can qualify for design protection. Indeed, it is only very limited aspects of an industrial design from a designer's perspective which receive any form of intellectual property protection. [FN8] Much more goes into the creative effort of designing than that which ultimately is protectable in a product: choice of materials, production methods, artistry, efficiency and utility, safety and ease of use, economy and simplicity in manufacturing. [FN9] Within the text of this article, therefore, the word *design* will denote the aspect of industrial design protected under the legislation whereas the term *industrial design* will be used in the broader sense common in the industrial design industry.

Industrial designs are a unique combination of invention, creativity and design. It is the blending of these elements that makes an industrial design exciting and new. On the other hand: legal protection through intellectual property devices is structured in such a way that the predominant strength of any one of the four elements in a particular facet of the industrial design determines which type of intellectual property protection applies to a particular aspect of the industrial design: copyright, patent, trade mark or design protection. Indeed, in some cases, severing the industrial design into various aspects, and scrutinizing each separately, can result in the failure of any aspect of the industrial design to qualify for intellectual property protection. Expecting the traditional schemes of intellectual property protection to protect every aspect of an industrial design is unrealistic because the innovation of an industrial design is in the blending of the elements of invention, creativity and design, not necessarily in any one particular element.

*5 This article will analyze both (a) the question of the availability and appropriateness of protection for the appearance of manufactured articles (“design”), and (b) the range of protection available to protect industrial designs. Although, as discussed above, these are separate and distinct issues, often in the literature they are confused and compounded. [FN10] This article will demonstrate that design laws have not been created with the whole concept of “industrial design” in mind. Design laws do not protect all the facets of industrial design. Indeed, industrial designs are not always granted the protection of design laws; sometimes a new industrial design is protected under patent, copyright or trademark law. Nor do these intellectual property regimes protect all the facets of industrial design.

These issues are not exclusively Canadian - nor is the confusion over terminology. Figure A sets out the relevant laws available in Canada, Britain and the United States to protect aspects of industrial designs. As is indicated in the first column of **Figure A**, each of these jurisdictions has a form of specific protection for “designs” or the way a thing looks. Thus, each jurisdiction has made available protection for designs. [FN11] In some countries, as in the United States, this protection is a facet of a larger scheme of protection. [FN12] In other jurisdictions, as in Canada, there is a distinct regime for design. However, no jurisdiction has a comprehensive scheme of protection for industrial designs. As will be discussed below, and as is intimated in **Figure A**, Britain may come closest. The prevalence of protection for appearance across jurisdictions, when contrasted with the lack of comprehensive protection for industrial designs as independent creations, reveals a consistent international policy emphasis which separates the form of an industrial *6 design from its function. This policy choice to emphasize form over function is an anathema to most modern industrial designers who emphasize unity of form and function and see design strength in that unity.

*7 **Figure A: Protecting Aspects of Industrial Design**

	Specific Design Law	Industrial Design Protection for Aspects Beyond Design	Protections That Can Be Held Simultaneously on Aspects of One Industrial Design
Canada	Industrial Design Act	Not Specifically	•Industrial Design Act or Patent or Copyright ^{FN} •Trade mark ^[FNa1]
U.S.A	“Design Patent” for sections of the Patent Legislation	Not Specifically	•Theoretically, Utility Patent & Design Patent. ^{FN} •Copyright ^[FNaa1] •Trade mark ^{FN [FNa1]}

U.K.	Registered Design Act	Unregistered Design Right	•Copyright or Unregistered Design Rights, then Registered Design Rights •Trade mark ^{FN} [FNa1]
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FNa1. Trade mark is a different type of protection for a limited range of the design aspect.

FNaa1. Copyright is theoretically available but practically limited by recent decisions.

Each of the industrialized jurisdictions examined has a set of laws aimed at protecting the “design” of something: these are laws specifically aimed at protecting its innovative appearance. In Canada, these laws are in the *Industrial Design Act*; [FN13] in the United States these *8 laws fall under the *Patents Act* [FN14] and; in Britain, they are under the *Registered Designs Act*. [FN15]

2. EVOLUTION OF DESIGN LAWS

The history of design laws may explain why these laws do not comprehensively treat the whole area of industrial design. Intellectual property, of which these design laws form a part, is the rubric used to encompass a whole series of property rights, which the law has created since the industrial and print revolutions. [FN16] These rights are private law concepts which arose historically from emerging commercial realities. [FN17] Copyright, patent and trade-mark are the earliest and most *fully* developed forms of intellectual property, [FN18] while design law is a later innovation. [FN19]

It is believed that early French law relating to the design of fabrics made the first distinction between industrial design and artistic design. [FN20] Artistic designs were covered by copyright protection. British law soon created a separate protection for aspects of the textile industry, and in 1839 this new type of protection, separate and apart from copyrights *9 (which remained a longer form of protection), was extended to articles of manufacture. The basis of design law in Canada appears to be the British *Act to consolidate and amend the Laws relating to the Copyright of Designs for the ornamenting of Articles of Manufacture* of 1842. [FN21] That Act contains a list of classes of goods upon which registered designs would be protected for various periods, ranging from nine months to three years. [FN22]

The first Canadian protection of designs occurred in the Province of Canada in 1861 with the passage of *An Act to Amend the Act Respecting Trade Marks, and to Provide for Registration of Designs*. [FN23] This was a formal scheme and the registration of registered trade-marks [FN24] and all protected designs was to be handled through a common administration. [FN25] Only expired designs were open to public examination. [FN26] Design protection is essentially an early example of a sectoral exception to the national protection provided for in the patent, copyright and trade-mark legislation. It was considered appropriate to treat artistic works applied to products produced in certain industries separately *10 from other works which enjoyed full copyright protection (the “traditional” bundle of rights under copyright) [FN27] - but these artistic works, when applied to industrial objects, were still thought to be entitled to some form of protection. [FN28] These artistic works, now called “designs,” were given “copyrights,” [FN29] with a limited duration of three or seven years depending in which of fifteen classes of articles of manufacture it was listed. [FN30]

In respect of the application of any such design to ornamenting any article of manufacture contained in the first, second, third, fourth, sixth, eighth, eleventh or thirteenth of the classes following, for the term of seven years:

- I. Articles of manufacture wholly or chiefly composed of metals or mixed metals.
- II. Articles of manufacture wholly and chiefly composed of wood, or to the ornamenting of ivory, bone, papier mache, and other solid substances not enumerated.

*11 III Articles of manufacture wholly or chiefly composed of glass.

IV. Articles of manufacture wholly or chiefly composed of earthenware

VI. Carpets, Floor or Oilcloths.

VIII. Shawls other than those in class VII [i.e. Other than solely by printing or colors upon tissue or textile fabrics].

XI. Woven fabrics, composed of Linen, Cotton, Wool, Silk or Hair, or of any two or more such materials, if design be by printing or by any other process by which colours are or may be hereafter produced upon tissue or textile fabrics, such woven fabrics being or coming within the description called furniture, and the repeat of the design whereof shall be more than 12 x 8 inches.

XIII. Lace and any article of manufacture and substance not comprised in any preceding class.

In respect of the applications of any such design to ornamenting any article of manufacture contained in the fifth, seventh, ninth, tenth, twelfth or fourteenth of the classes following, for the term of three years:

V. Paperhangings.

VII. Shawls, if solely by printing or colors upon tissue or textile fabrics.

IX. Yarn, Thread or Warp, if the design be applied by printing or other process by which colors are or may be hereafter produced.

X. Woven fabrics, composed of Linen, Cotton, Wool, Silk, or Hair, or of any two or more of such materials, if design be by printing or by any other process by which colors are or may be hereafter produced upon tissue or textile fabric, excepting articles included in class XI [i.e. Such woven fabrics being or coming within the description called furniture unless the repeat of the design is less than or equal to 12 x 8 inches].

XII. Woven fabrics not included in any preceding class.

XIV. Articles of manufacture having reference to some purpose of utility, so far as such designs shall be for the shape or configuration of such article, and whether it be for the whole or part of the shape or configuration thereof.

The decision to create these exceptions was made when copyright itself had been given a more limited duration than is now the case [FN31] and the general copyright was then dependent upon registration, whereas now it arises upon creation. [FN32] More than 100 years later, the *Industrial *12 Design Rules* still exempted certain industries from copyright protection, which was now the life of the author plus fifty years and arose upon creation of the work, and instead specifically granted to them the shorter industrial design protection dependent upon registration with a **maximum** protection of ten years. Rule 11(1) deemed a design to be within industrial design protection if the design was to be applied to, inter alia, paper hangings (3 years in 1861), carpets (7 years in 1861), cloths, textile goods (both various terms, depending on certain factors as set out above in 1861) or lace (7 years in 1861). [FN33] Even recently, at the international level, the Uruguay negotiations resulted in a specific, particular clause dealing with the protection of textile designs. [FN34]

Whereas copyright arose to protect artistic works and patents arose to protect invention, design laws did not arise to protect industrial designs. Instead, they evolved from copyright as an exception for artistic designs applied to specific classes of industrial goods, or goods within particular industries. The designs applied to these goods were thought to require some form of protection, but not of the same strength as copyright.

The 1861 “Canadian” Act was repealed and superseded by *The Trade Mark and Design Act of 1868*, [FN35] which was the first Act in the Dominion of Canada to protect designs. Under this Act, the lists of *13 classes of goods disappeared, and so did the variable periods of protection. [FN36] The term “industrial design” appears, without definition. [FN37] “The copyright acquired for an industrial design by the Registration of the same as aforesaid shall be valid for the term of five years.” [FN38] This one consistent period seems to have been chosen for purely pragmatic reasons. [FN39] The character of the protection being given was made clear:

During the existence of the right ... no person shall ... apply such design ... to the ornamenting of any article of manufacture ... for the purposes of sale, or publish, sell or expose for sale or use any article of manufacture to which such design ... shall have been applied [FN40]

Design thus became a right relating chiefly to the “ornamenting of any article of manufacture,” and was not created from the industrial *14 design process itself. [FN41] The “design” became conceptually separated from the utilitarian article to which it was applied.

This separation was less remarkable in the Victorian period. The concept of design as an art form has changed significantly since the 1800s. The concept of “decoration” in the law relating to “industrial design” was a natural extension of the artistic trends in Britain at the time the legislation was first created: “ornamentation” was the trend of the times. The Arts and Crafts Movement was just beginning and subsequent art trends glorified ornament and decorative art. John Ruskin, one of the main proponents of the Arts and Crafts Movement, stated that “ornamentation is the principle part of architecture [and *15 design].” [FN42] It involved impressing on buildings and articles characteristics which are “venerable or beautiful, but otherwise completely unnecessary.” [FN43] Today these ideas about design have been largely supplanted by ideas which follow from the Bauhaus philosophy (1919), with emphasis on formal visual structure and functional simplicity. If the form and function of a design do not complement each other, the object is not well designed. [FN44] Henry Dreyfuss, [FN45] one of the foremost designers of this century, influenced today's designers with the concept that attractive form is determined by purpose, rather than applied as external decoration. [FN46] This modern view of design is in direct contrast with that of the Arts and Crafts Movement (which arose partly as a backlash against industrialization and the machine).

The law has just begun to reflect the modern conception of design: in *Samsonite Corp. v. Holiday, Luggage Inc.* the Federal Court trial judge realized that “the essence of good design is that there be a unity of form (appearance) and function.” [FN47] Yet, our contemporary designs continue to be protected by legislation that is over 100 years old and was tailored to protect a completely different kind of design genre. As one Member of Parliament stated during the debates surrounding intellectual property law reform in the late 1980's,

while the Government has sought to bring non-controversial parts of the Copyright Act up to date with Bill C-60, the same Bill proposes only one amendment to Section 2, that is, the definition section of the Industrial Design Act, an Act which in itself is over 100 years old. [FN48]

3. THE TREATMENT OF (A) DESIGNS AND (B) INDUSTRIAL DESIGNS WITHIN EXISTING INTELLECTUAL PROPERTY SCHEMES

The intellectual property schemes for designs, trade-marks, patents, and copyright can each be used to protect aspects of industrial *16 designs depending on the qualities and merits of the industrial design in question. There are, however, as mentioned earlier, industrial designs, or aspects of industrial designs, which do not meet the requirements of, or are exempted from, these intellectual property schemes and are consequently left with no legal protection at all. Industrial designs can be simultaneously creations, works of art, inventions, distinguishing guises and designs. They can also be some, several or none of the above and as such, they do not always fall neatly into any one category of copyright, patents, trade-marks or design protection.

(a) Designs

As discussed, the legislative protection created by the *Industrial Design Act* and its predecessors is a formal one, like

the patent regime, where protection only arises upon registration. [FN49] This differs from the copyright regime, where all eligible works are automatically protected under the statute upon creation. [FN50] This immediately means; as a practical matter, that only a percentage of eligible designs, those actually registered, receive the protection of this intellectual property device.

The *Act* contained no definition of design until 1988. For over 100 years, cases were litigated and interpreted without a statutory definition of the subject matter at issue. The courts had to create their own definition:

No definition of 'design' is given in the Act. The word must, therefore, be taken in its ordinary signification which Lindley L.J. In *Re Clarke's Design* [[1896] s Ch. 38 at p. 43, stated means, "Something marked out - a plan or representation of something." A design is, therefore, a pattern or representation which the eye can see and which can be applied to a manufactured article." [FN51]

In *Cimon Ltd. v. Bench Made Furniture Corp.*, Jackett J., President of the Federal Court, later said, "[t]he sort of design that can be registered is therefore a design to be "applied" to "the ornamenting" of an article. It must therefore, be something that determines the appearance of an article, or some part of an article, because ornamenting relates to appearance." [FN52] Although courts had frequently given other articulations of the meaning of design under the *Industrial Design Act* and its *17 predecessors, these two definitions were termed the "*locus classicus*" of the definition in the *Doral Boats* case, where Mahoney J., added:

the general shape may be largely dictated by functional considerations, however, the details of shape which serve to distinguish the appearance ... from another are essentially ornamental. Those details are what make one [[object] more attractive, in the eye of the beholder, than another. [FN53]

Thus design protection did not require that the work have "beauty." The design needed only to adorn or decorate a work in a way which distinguished the appearance of the article with which it was associated. [FN54] Design was thus defined in the narrow sense in which it is used throughout this article and many industrial designs were precluded from protection as a result. [FN55] The relatively recent addition of the statutory definition has not perceptibly broadened the scope of this design protection beyond the visual, nor has it clarified matters appreciably. After the Canadian Intellectual Property Office required that applicants for "industrial design" registration make it clear which of features of shape, configuration, pattern or ornament they were claiming in their applications, L. E. Trent Home noted that "it is by no means decided how to differentiate between these terms. In fact, the terms are virtually impossible to clearly distinguish, given the overlap in their meaning." [FN56]

The manufactured articles to which a protected design is applied will most often be useful. [FN57] The design itself may be functional or not, *18 so long as it is ornamental. [FN58] The design may also be derived from, but not solely from, functional aspects of the article. [FN59] The design can protect features of the shape of the article. [FN60]

The relationship of the *Copyright Act* with the *Industrial Design Act* ensures that it is particularly for designs applied to useful articles that registration under the *Industrial Design Act* is sought. Section 64(2) of the *Copyright Act* denies copyright protection to designs "applied to a *useful* article" [emphasis added] reproduced more than 50 times. [FN61] Without the benefit of copyright protection for the life of the creator *19 plus 50 years in such works, the 10 year protection afforded by the *Industrial Design Act* may be attractive (better than no legal protection at all!).

There is an element of originality required by the *Industrial Design Act* in order to have a design registered. [FN62] Cases have actually established that the degree of originality required for industrial design protection is higher than that required for copyright (another regime under which originality is also a clearly stated element of a protectable work). [FN63] For designs, a spark of inspiration is required of the designer in creating a new design or hitting upon a new use

for an old design. [FN64] Originality can be a bar to many designs that are seen simply as improvements or variants of a design already in existence. A designer has to make something that has never been made before. In order to register the design, she or he must make sure that nothing similar to it is already registered or already in the public domain. The design must be “distinguishable from what previously existed by something that is substantially original.” [FN65] This is difficult to accomplish.

The design legislation in Canada has not seen much litigation over the years. From Confederation until 1975, a period of 108 years, there appear to have been only forty-eight cases litigated. [FN66] Since 1975, there have been almost twice as many cases in one quarter the time: ninety-one cases. This marked increase in litigation may be due to the increased jurisdiction of the Patent Appeal Board, which began after 1974 *20 to hear appeals from refusals to grant design applications. [FN67] Not only is there less litigation over industrial designs than one might expect, design registrations themselves are not sought so avidly as one would otherwise expect, given the number of registrations in other areas of intellectual property (see **Figure B**). Both the low number of design registrations, and the small amount of litigation may stem from the fact that it is very challenging to successfully make a case for design infringement.

***21 Figure B: Canadian Intellectual Property Registrations**

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

The onus is on the plaintiff to prove infringement based on substantial similarities between the designs in question. [FN68] The onus which *22 the plaintiff must meet has been expressed as a three part test: (1) would the designs be confused with one another? (if yes, then this part of the test is met); (2) would the design of the alleged infringing article exist absent the registered design? (if no, then this part of the test is met); and, (3) is the infringing article more similar to the registered design than to any other design? (if yes, then this final aspect of the test is met.). [FN69] The similarities between the designs are to be determined by the eye, [FN70] which is an inherently subjective method of decision-making. After successfully overcoming the defences to infringement which are put forward, for example that the plaintiff's design registration is invalid (as either not coming within the subject matter of industrial design, [FN71] not being original, or being published more than one year prior to registration) and thus unenforceable, or that the defendant had no reason to suspect that the design was registered, [FN72] and therefore cannot be held liable, the plaintiff must establish irreparable harm arising from the infringement. [FN73] This is a very heavy evidentiary burden. Since it is difficult to enforce the rights which registration under the legislation bestows, it is no wonder that designers do not bother to register their designs, and would rather take their chances introducing a new design in the market with no legal protection at all.

*23 Thus, although there may be intellectual property protection available for the design aspect of an industrial design in Canada, that protection is limited to those designs which are registered, and these can only include those which meet the stringent requirements for registration. It is also probable that the challenge of establishing infringement when attempting to enforce the rights given under the legislation further discourages designers from seeking intellectual property protection for their designs. It is possible, however, that the design aspects of an industrial design could attract protection as indicia which can be protected through the common law in a “passing off” action, or within a distinguishing guise registration under the *Trade Marks Act*, which is discussed further in the next section.

(b) Industrial Designs

(i) Elements protectable under the Industrial Design Act

As discussed earlier, the design aspect of industrial designs with which the *Industrial Design Act* deals is only one very narrow aspect of industrial designs. The narrow definition of design in the legislation, together with the difficulties in interpreting the definition of design and related terms; in establishing criteria for originality; in coping with the subjective element in establishing infringement and in applying legislation from an earlier age to modern designs, all indicate that industrial designs are neither protected comprehensively, nor with any great certainty of enforcement under the current *Industrial Design Act*. On the other hand, certain aspects of industrial designs may be protected under areas of intellectual property other than the *Industrial Design Act*, including aspects of designs which did not meet the registration requirements for *Industrial Design Act* protection, those which (though eligible) were never registered, or those whose registration has expired.

(ii) *Elements protectable in copyright*

Historically, there have been practical difficulties surrounding the distinction between copyright and design protection. [FN74] The gulf between *24 copyright protection and design protection has widened since copyright has become a right universally enjoyed upon creation of works which qualify for its protection. [FN75] The line of demarcation has also become increasingly important because the discrepancy between the length of protection given each has increased throughout this century. Design protection has always been a shorter term monopoly, [FN76] while the length of protection given for copyright has steadily been increased. [FN77] In 1988, Parliament amended the *Copyright Act* in an attempt to completely sever design protection from copyright protection. [FN78]

The distinction between the two is currently legislated in s. 64 of the *Copyright Act*. [FN79] Section 64 demonstrates the theoretical overlap between copyright and design explicitly in that the operative subsection, s. 44(2), begins “*Where copyright subsists in a design applied to a useful article or in an artistic work from which the design is derived ... [Italics added].*” The policy choice separating the two is then set out.

***25** When

(a) the article [with the design in which copyright has arisen applied or derived from an artistic work which enjoys copyright protection] [FN80] is reproduced in a quantity of more than fifty [by or under the authority of the copyright holder, whether the copyright is held in Canada or elsewhere], or

(b) [if] the article is a plate, engraving or cast, [and] the article [with the design in which copyright has arisen applied or derived from an artistic work which enjoys copyright protection] is used for producing more than fifty useful articles [that is, articles that have a utilitarian function], [FN81]

there will be no copyright protection. Specifically

it shall not thereafter be an infringement of the copyright or the moral rights for anyone

(c) to reproduce the design of the article or a design not differing substantially from the design of the article by

(i) making the article, or

(ii) making a drawing or other reproduction in any material form of the article, or

(d) to do with an article, drawing or reproduction that is made as described in paragraph (c) anything that the owner of copyright has the sole right to do with the design or artistic work in which the copyright subsists. [FN82]

***26** The legislation also chooses to protect certain designs within copyright which might otherwise have become part of the ambit of industrial design: [FN83]

- (a) graphics or photographs applied to the face of an article;
- (b) trade-mark or representation thereof or a label;
- (c) material that has a woven or knitted pattern or that is suitable for piece goods or surface coverings or for making wearing apparel;
- (d) architectural works or buildings;
- (e) representations of a real or fictitious being, event, or place that is applied to an article as a feature of shape, configuration, pattern or ornament, [FN84]
- (f) articles that are sold as a set unless more than fifty sets are made.
- (g) other such works or articles as may be prescribed by the regulation. [FN85]

Section 64 of the *Copyright Act* has been made deliberately to dovetail with the *Industrial Design Act* so that those articles denied the protection of copyright by s. 64 will be eligible for design protection should their creators apply. [FN86] For example, the definitions in s. 64(1) are exactly mirrored in s. 2 of the *Industrial Design Act*. [FN87] It may be noted that subsection (g) of s. 64(3), quoted above, allows policy making to be shifted to the executive, away from the exclusive provenance of the legislature. [FN88]

*27 *Magasins-Greenberg Ltée v. Import-Export René Derhy (Canada) Inc.* [FN89] was the first case to be litigated under the current sections which were implemented in 1988. [FN90] *Magasins-Greenberg* applied to have Derhy's registration for copyright in the design of a jacket struck. The applicant argued that by virtue of ss. 64(1) and (2) of the *Copyright Act*, Derhy could have protected its jacket only by registration under the *Industrial Design Act*, and not by copyright (because more than 50 jackets had been made). [FN91] In his decision, Richard J., declined to strike the registration determining:

s. 64 does not have the effect of precluding or removing copyright from designs Instead s. 64 merely establishes limits to the protection conferred by copyright in certain designs thereby providing a defence that may be raised in a copyright infringement action. Artistic works in the nature of designs for useful articles can still be registered under the *Copyright Act*, notwithstanding these limits. [FN92]

In other words, the design can be registered for copyright protection if it meets the criteria for a copyrightable work but, if more than 50 copies of an article bearing the design are subsequently made (again with the owner's consent or authority), that copyright will not be enforceable with respect to such articles (and the registered owner of the copyright could not succeed in an infringement action). [FN93] The only protection which can be obtained for an otherwise copyrightable work once fifty copies are made (with the owner's consent or authority - otherwise this is copyright infringement) is under the *Industrial Design Act*, so long as an industrial design registration has been obtained. However, any registration under this *Act* must be applied for within one year after the first publication of the design, [FN94] or else the designer will forfeit any kind of protection for the design at all.

The *Copyright Act* clearly excludes all aspects of industrial design from its ambit, not just design aspects, since all industrial designs deal with manufactured, useful articles, and are generally produced in quantities of more than 50 because they are intended for commercial use and sale. [FN95] In any event, the aspects of an industrial design which would otherwise qualify for copyright are virtually the same as those which would qualify for design protection.

(iii) *Elements Protectable as Trade-marks-*

There is potential for protection of industrial design as a distinguishing guise in the trade-mark legislation, even for that protection to overlap with the design protection created by the *Industrial Design Act*. The *Trade-Marks Act* defines a distinguishing guise as:

(a) a shaping of wares or their containers or

(b) a mode of wrapping or packaging wares the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others. [FN96]

As a registered trade-mark, [FN97] a distinguishing guise will potentially enjoy continuous protection, as long as it remains distinctive in the marketplace, [FN98] so long as “[n]o registration of a distinguishing guise *29 interferes with the use of any utilitarian feature embodied in the distinguishing guise.” [FN99] This provides for exclusive use throughout Canada far longer than the ten years registered design protection lasts. The protection given, however, is expressed differently from the limited term monopoly conveyed by design registration, which is to make, import or sell any article to which the design has been applied. [FN100] The protection of the distinguishing guise as a trade-mark is “the exclusive right to the use throughout Canada of the trade-mark in respect of those wares or services [for which the mark is registered].” [FN101] Even so, it is possible to use trade-mark protection of a design to protect the right to manufacture it, because the exclusive right to “the use” of the distinguishing guise is infringed where a person not entitled to its use under the *Act*, sells, distributes, or advertises wares or services in association with a confusing trade-mark or trade-name. [FN102] Protection from the unauthorized manufacture and sale of design wares falls within the scope of protection afforded to a registered distinguishing guise by the *Trade Marks Act*, in addition to the protection to which the design will be entitled if it is also registered under the *Industrial Design Act*.

Whereas Parliament deemed it necessary to separate industrial design and copyright protection explicitly and make them generally mutually exclusive, as discussed above, Parliament apparently did not feel it necessary to state explicitly the same mutual exclusion for trade-marks and industrial designs. [FN103] The issue of the distinction between trade-mark protection and design protection does not appear to be clarified by the wording in the *Copyright Act*. Section 64(3) of that Act provides that the suspension of copyright rights in favour of the more limited registered design protection in the situations described in s. 64(2), discussed above, is not operative in the case of a work used as “a trade-mark or representation thereof or a label.” [FN104] Registered *30 trademarks, if potentially capable of design registration, therefore also retain the longer protection of the *Copyright Act* as artistic designs. [FN105] Even if the trade-mark protection is not renewed after the first period of fifteen years (the registered design protection having expired at the end of ten), the work will continue to receive copyright protection for the life of its creator and seventy years after. No definition of trade-mark is included in the *Copyright Act*, thus it must be presumed to include both the common law conception of a trade-mark and the statutory mark. [FN106]

These policy choices to allow overlapping protection for trade marks, which can also qualify as designs and artistic works, are directly contrary to the policy decision made where design protection potentially overlapped with copyright: in the former case, creators can achieve virtually perpetual protection for their creativity; in the latter case, designs have been excluded from the longer term protection of copyright, and creators (unless they have independently acquired trade mark protection for their designs) must be content with the ten year period of protection, for which they must register under the *Industrial Design Act*.

The potential for the distinguishing guise form of the trade-mark to act as a permanent barrier to industrial development because of its potential for perpetual renewal was specifically identified by Parliament, and the *Trade-Marks Act* contains provisions to guard against this. First, the requirements for registration of the distinguishing guise as a trade-mark are more stringent than those required for other types of trade-mark:

A distinguishing guise is registrable only if

*31 (a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration, [FN107] and

(b) the exclusive use by the applicant of the distinguishing guise in association with the wares or services with which it has been used is not likely unreasonably to limit the development of any art or industry. [FN108]

Subsection (b) of this section was applied by the Registrar in rejecting an application for registration of a particular shape of key head since granting the trade-mark would preclude others from manufacturing replacement keys, and would thus unreasonably limit the development of, and established practice in, the key manufacturing and replacement industry. [FN109] The potential for perpetual protection of a design under the *Trade-Marks Act* has, then, been made subject to certain caveats.

It may be that it was felt that the Federal Court's jurisdiction to expunge a distinguishing guise (where, on the application of any interested person, the Court decides that the registration has become unlikely to reasonably limit the development of any art or industry) was sufficient protection of the public interest from the industrial implications of continuing trade-marks. [FN110]

The definition of a distinguishing guise under the *Trade-Marks Act* (like the common law notion of a get up) is so narrow that only design aspects of an industrial design (and even not every design aspect) are capable of receiving this intellectual property protection. At common law, a wider range of indicia is protectable using the tort of passing off, and therefore a larger range of designs could receive protection, but goodwill in the design would have to be actually established in every geographical area for which protection is claimed and the other elements of the tort would need to be established. [FN111] Other aspects of industrial design must look for protection under the other areas of intellectual property discussed herein.

*32 Recently a Federal Court judge, in reviewing a decision on a motion to dismiss an action, described the intricate nature of the relationships between these areas of law as follows:

The statement of claim which Mr. Justice Rouleau found confusing alleges, among other things, copyright infringement of a two-dimensional artistic work through the defendants' manufacture and sale of a hand-held wooden massage tool may, in part, have come about by the fact that the plaintiffs have a copyright on what may well be an industrial design, or perhaps the plaintiffs cannot obtain industrial design protection because either the shape of the device is dictated by its mechanical function or the design is one applied to a long-established, wellknown form, or indeed it may be an example of the fact that copyright, trade mark and industrial design are not mutually exclusive incorporeal property rights, but rather may shade into each other and as a result neat questions may arise when a trial judge considers whether the massage tool falls within the plaintiffs claimed copyright and trade mark protection, or into industrial design where the plaintiffs have no protection. [FN112]

(iv) *Elements Protectable Through Patents*

Designs as defined by the *Industrial Design Act* do not receive any protection through patents because the *Industrial Design Act* exempts any aspect derived solely from utility [FN113]... whereas the Patent Act specifically requires utility for registration. [FN114] There is a dear and unmistakable separation between these two forms of intellectual property protection.

The schemes for protecting designs and that for patents, however, are not without similarities: the limited term monopoly given the registered industrial design holder looks more like the protection afforded by a patent than like the rights given a copyright holder. This has led one commentator to point out that the design “partakes of both art and industry, it sits astride the Berne and Paris Conventions, which otherwise purport to subdivide the world's intellectual property system into mutually exclusive spheres dominated by the copyright and patent *33 paradigms. Empirically, ornamental

designs of useful articles (or 'appearance designs' as they are called today) seldom behave like the subject matter that either of these paradigms typically governs." [FN115]

Registration under the *Industrial Design Act* confers the following right:

During the existence of an exclusive right, *no person shall*, without the license of the proprietor of the design, (a) *make, import* for the purpose of trade or business, or *sell, rent* or offer to expose for sale or refit, *any article* in respect of which the design is registered and to *which the design* or a design not differing substantially therefrom *has been applied ...* [FN116] [emphasis added].

This may be compared with the *Patent Act* which gives the registered patent holder "the exclusive right ... of making, constructing and using the invention and selling it to others" [FN117] It is thus with respect to the right given the registered design holder that the protection of design as intellectual property appears closer to patent than to the modern form of its progenitor, copyright. [FN118] The requirement of a formal registration before the limited monopoly can be enjoyed also brings industrial design closer conceptually to patent than to copyright. Whereas the subject matter of patent protection and of design protection are completely separate conceptually, Parliament had to specifically enact the separation of design protection from copyright.

On the other hand, industrial designs, in aspects other than the design aspect capable of *Industrial Design Act* registration, are often inventions and improvements to existing inventions, and as such can be sufficiently innovative to receive patent protection. [FN119] Where the claims in a patent define the features of the invention in the alternative, each alternative is considered as a separate claim. [FN120] Ultimately, the claims can protect variations on the main idea of the invention, and this can sometimes involve changes in the appearance of the "preferred embodiment" of the invention disclosed. In this way, a patent can *34 protect both the utility and, to some degree, the appearance of an invention.

The main problem for the industrial designer is in meeting the high threshold required for a patent, particularly the requirements of non-obviousness and novelty. Patent protection is limited to significant advances in invention. This is often fatal to industrial designers because their work focuses on the artistry and refurbishment of well known techniques and items. [FN121] One test for registration of any patent, including one covering industrial design, is non-obviousness to a "person skilled in the art." [FN122] By definition then, patents exclude many improvements and advancements in the industrial design industry. [FN123]

(v) *The cumulative effect of the intellectual property protection of industrial design*

Cumulative protection of industrial designs - that is, protection of various facets of an industrial design under a number of intellectual property regimes - is not specifically contemplated by our existing intellectual property framework. In fact, as discussed above, at least one policy decision has been explicitly made which has exactly the opposite effect: articles that are made in quantities greater than 50 are explicitly exempted from copyright protection regardless of whether the artistry involved in the article deserves such protection.

On the other hand, trade-mark and design protection are not made explicitly mutually exclusive by their respective statutes, although it may well be difficult in fact to demonstrate the requisite reputation for either common "trade mark" protection, or statutory distinguishing guise registration while still moving to obtain registration of the design within one year of publication. Indeed, the common law notion of protectable indicia, including "get-up," and the statutorily defined concept of distinguishing guise, when related to an industrial design, would cover only design aspects (appearance and shape) of that industrial design. Patent and design registrations, on the other hand, are mutually exclusive in terms of the aspects of an industrial design which they can protect, but may be held simultaneously on different aspects of the same

industrial design.

*35 The Canadian *Industrial Design Act*, therefore, actually protects only the design aspect of industrial designs. The *Act* is not the only avenue for intellectual property protection of the design aspect, despite the fact that Parliament has specifically precluded the option of copyright protection for these facets of design. Trade-mark protection can exist for those same elements of design, both at common law and under the *Trade Marks Act*. Other aspects of an industrial design can receive protection through patents. Still other aspects of an industrial design may not be eligible for any intellectual property law protection. [FN124] Furthermore, the *Industrial Design Act*, while it may be attractive mostly to industrial designers, actually can protect designs which are not industrial designs. [FN125]

4. THE TREATMENT OF INDUSTRIAL DESIGNS ABROAD

(a) In the United States of America

(i) Designs

In the United States, designs are protected under the patent legislation. The *United States Code*, Title 35, states: “whoever invents any new, original and ornamental design for an article of manufacture, may obtain a patent therefore, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.” [FN126] The term of this “design patent” is 14 years. [FN127] The purpose of this intellectual property protection is to stimulate the exercise of people's inventive faculties to improve the appearance of articles of manufacture [FN128] in order to increase their saleability and satisfy purchasers' aesthetic senses. [FN129]

*36 The purpose of design patents is to encourage and promote ornamentation, while utility is the dominant feature of other patents. [FN130] In the former, therefore, invention must be established in the design or ornamentation of the article, whereas in the latter, utility must be established. The registration requirements are otherwise the same for the two types of patents: novelty, originality and inventive character. [FN131]

Sometimes copyright may attach to a design and the copyright has been extended in the United States to such items as: jewelry, candlestick holders, salt and pepper shakers, fish bowls and ash trays. [FN132] Only those designs which can be physically or conceptually separated from functional features can have copyright protection:

pictorial, graphic, and sculptural works include ... works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design ... shall be considered ... [such a] work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article. [FN133]

In such cases, both the design patent and copyright may be held simultaneously, although, of course, the design patent protection will end much sooner. [FN134] The threshold requirements for copyright are lower, as they are in Canada, and so a wider range of designs theoretically may be protected in this way as compared to those which succeed in receiving design patents. However, the “separability test” in the copyright law, set out above, is tough to meet: a designer must convince the judge that the item to be protected under copyright is either not useful or the useful part of the item is separable from the artistic part. [FN135] One commentator has described the situation in the United States as one “where the existence or not of copyright seems to some extent to depend which side of the bed the judge got out of in the morning.” [FN136] There have been a series of cases which have narrowed the availability *37 of copyright to designers - prefer-

ring that designers seek design patents. [FN137] As in Canada, copyright protection will arise automatically upon creation of the design, whereas design patents must be applied for. It would appear that the thresholds to obtain design patent protection, being taken directly from those applicable to other patents, are higher than the requirements for obtaining design registration in Canada. Design patents are said to be “effectively useless for most designs.” [FN138] Even if a design patent is granted, the statistics show that at least two-thirds of issued design patents are struck down as invalid in litigation. [FN139]

(ii) *Industrial Designs*

Theoretically, the dual protection of both a utility patent and a design patent in the United States should protect the totality of an industrial design. In practice, however, patents fail to provide adequate protection for most industrial designs because of the high threshold requirements of novelty and non-obviousness for both the utilitarian and appearance aspects. [FN140] On the other hand, the United States has, at least in the past, recognized a very broad range for trade-mark registration of industrial designs “but courts are becoming increasingly hostile toward the use of these laws to protect industrial design.” [FN141] Registered trade-marks are protected under the *Lanham Act*. [FN142] As is also the case in Canada, the American federal statute specifically recognizes and preserves unregistered trade-marks. [FN143] The subject-matter for which trade-mark protection will be available has been limited in three ways through case law. The first limitation, the doctrine of functionality, means that trade-mark cannot protect the functional aspects of an article [FN144] - thus separating those elements of an industrial design eligible for utility patent protection from those eligible for trade-mark protection. This doctrine has a counterpart in Canadian law, as discussed *38 above. The second limitation, the doctrine of aesthetic functionality, has no counterpart in Canadian law - and it is this doctrine which can limit the trade-mark protection available to even the design aspects of industrial design. Under it, American courts can consider ornamental or design aspects of industrial designs to be functional and thus falling outside trade mark. As Dratler describes this judicial thinking: “If features assist marketing through their intrinsic aesthetic appeal, they are functional and therefore ineligible for protection.” [FN145] The third limitation is again a limitation which also exists in Canadian law: in order to be a trade-mark, an industrial design must be distinctive in the marketplace. This area of trade-mark protection becomes particularly relevant to the discussion of industrial design in the Canadian context when, as described above, the concepts of distinguishing guise under the registered regime and get-up at common law are considered. In the American regime, it is the concept of “trade dress” within trade-mark which is most relevant when considering protection of industrial design. This has been an expanding area of protection through the jurisprudence. [FN146]

Despite all these areas wherein aspects of industrial design may find protection in American law, there has been a steady demand for special legislation to protect industrial designs from unauthorized copying. [FN147] To date this demand has not been acted upon.

(b) In Britain

(i) *Designs*

In 1988, the United Kingdom enacted the *Copyright Designs, and Patents Act*, which was created specifically to “remove the overlap between copyright and designs once and for always.” [FN148] However, as Cornish writes “A degree of uncertainty infects the penumbra of s. 51 [of the *Copyright, Designs and Patents Act, 1988*], as can be seen if each of its requirements is further examined.” [FN149] There had been a decision of the House of Lords in the mid-seventies which made it *39 clear that not all drawings for designs are artistic works subject to the protection of the Brit-

ish *Copyright Act*. [FN150] The artistic threshold to qualify as a “work of artistic craftsmanship” within the concept of an artistic work in Britain, therefore, appears to be higher than that to qualify for similar protection in Canada. [FN151] Certainly in Britain there is recognition of two distinct categories of manufactured articles: those manufactured from artistic works, and any others. The latter are now excluded from copyright protection by s. 5 1(1) of the *Copyright, Designs and Patents Act, 1998*:

It is not an infringement of any copyright in a design document or model recording or embodying a design for anything *other than an artistic work* or a typeface to make an article to the design or to copy an article made to the design [emphasis added]. [FN152]

The wording of this section seems to contemplate continuation of copyright protection for the design drawings, if they can be considered artistic works themselves, but the following section, s.52, makes other provisions “where an artistic work has been exploited ... by (a) making by an industrial process articles ... and (b) marketing such articles ...”. It seems to follow from this that the underlying drawings for articles covered in s.51(1) cannot themselves enjoy copyright protection as artistic works, since to do so would be to bring them into s.52(1). The exploitation of an artistic work, on the other hand, means that:

After the end of the period of 25 years from the end of the calendar year in which such articles are first marketed, the work may be copied by making articles of any description, or doing anything for the purpose of making articles of any description, and anything may be done in relation to articles so made, without infringing copyright in the work. [FN153]

It would appear, then, that all the copyright holder's rights in the underlying artistic work in s. 52(1) would continue for the usual full term of copyright except the rights specifically limited to 25 years by s.52(2).

***40** Whether or not the designs invoke s.51(1) where no copyright protection is available against the manufacturing of articles derived from the design, or s. 52(1) where only 25 years protection is available against the manufacturing of articles derived from the design, there is also the potential for protection of the designs under the *Registered Designs Act, 1949*. Designs are defined as:

features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye, but does not include -

- (a) a method or principle of construction, [FN154] or
- (b) features of shape or configuration of an article which -
 - (i) are dictated solely by the function which the article has to perform, or

(ii) are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part. [FN155]

This legislation is successor to the British Acts from which the Canadian design legislation is descended. [FN156] In order for a design to be registered, it must be new [FN157] and it must be demonstrated that the aesthetic appearance of the article is of importance to users and purchasers. [FN158] These appear to be higher requirements than Canada imposes for design registration.

There will be advantages to registering the design in Britain rather than simply relying on the “design right” since the registered design receives 25 years of protection [FN159] (longer than both the Canadian ten year term and the British unregistered design term of up to 15 years) from the date of registration. If the design is also eligible for copyright protection, however, the registered design protection will realistically ***41** be eclipsed by the 25 year period under copyright, discussed above, which runs from the first marketing of the goods. It is difficult to conceive of a design which meets the

aesthetic requirement of the *Registered Design Act*, as expressed in the 1988 amendment, [FN160] but does not meet the requirement to qualify for copyright protection as an artistic Work. [FN161]

(ii) *Industrial Designs*

In 1988, Britain created an unregistered design right. [FN162] It requires no formalities [FN163] and can run 15 years from the creation of the design [FN164] (longer than the formal design right in Canada, but shorter than the British registered design right). It appears to be designed specifically to provide a period of protection for technical works, [FN165] rather than artistic. [FN166] The unregistered “design right” in the United Kingdom is a concept that does not exist in Canadian law. The design right subsists in an original “‘design’ which means the design of any aspect of the *42 shape or configuration (whether internal or external) of the whole or part of an article.” [FN167] The design rights do not subsist in

- (a) a method or principle of construction, [FN168]
- (b) features of shape or configuration of an article which -
 - (i) enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function, or
 - (ii) are dependent upon the appearance of another article of which the article is intended to form an integral part, or
- (c) surface decoration. [FN169]

The design rights can cover articles whose form is dictated solely by function, [FN170] and also the internal and external shapes and the configuration of articles. [FN171] Paradoxically, while the Canadian *Industrial Design Act* actually protects designs only, the British unregistered “Design Right” in Part III of the *Copyright, Designs and Patents Act* actually protects facets of industrial designs other than design! In Canada, designs which cannot be the subject of copyright, and yet are not registered for industrial design protection, receive no protection as intellectual property at all: they fall into the public domain unless they can muster enough reputation to be protected under trade-mark law. The British have a protective scheme for these designs because “[e]xpense, labour and skill are needed to produce it [[[the design] even where the design does not merit a patent, and we believe that some protection should be given to encourage investment in design effort ... On the one hand protection must be sufficient to act as an incentive to innovation, but on the other hand it must not act to stifle competition or prevent the wider use of technology.” [FN172]

The design aspects of industrial designs appear to enjoy an automatic intellectual property protection through copyright as artistic designs, although the period of copyright protection is shortened in these cases. Thus copyright has been legislatively altered for designs, just as it has been in Canada, although the mechanisms differ. Registered *43 protection for designs is still available in Britain and will enhance the enforceability of the design rights. Protection for articles not derived from artistic works has also been made available without formalities through the unregistered design right, but not through copyright. This unregistered design right is shorter (at a maximum of fifteen years) than even the shortened copyright for production of articles from artistic works (twenty-five years). Given the title of this new unregistered design right, it is paradoxical, however, that it appears to protect not design (with its emphasis upon ornamentation), [FN173] but the wider range of industrial design beyond the design aspects. Insofar as industrial designs protected by the unregistered design legislation can meet the stringent requirements for registration as designs, they are entitled to that protection as well, [FN174] although it seems likely, given those requirements, that more design registrations will emerge from copyrighted artistic works origins than from unregistered designs.

The unregistered design right, together with the registered design right, and copyright, provide a wider range of protection and thus include more industrial designs within Britain's intellectual property protection framework than the Canadian model. Britain also affords more aspects of industrial design protection without the formalities of registration (see **Figure C**).

***44 Figure C: U.K. Protection**

TABULAR OR GRAPHIC MATERIAL SET FORTH AT THIS POINT IS NOT DISPLAYABLE

(c) International Agreements Regarding Designs and Industrial Designs

Internationally, copyright has been contemplated as one forum where designs might be appropriately protected. Indeed, the *Berne Convention* provides, in Article 2(7), that

***45** it shall be a matter for legislation in the countries of the Union to determine the extent of the application of their laws to ... industrial designs ..., as well as the conditions under which such works, designs and models shall be protected. Works protected [by special legislation] ... shall be entitled in another country of the Union only to such special protection as is granted in that country to designs ...: however, if no such special protection is granted in that country, such works shall be protected as artistic works.

That Article is subject to Article 7(4) which provides that

It shall be a matter for legislation in the countries of the Union to determine the term of protection of ... works of applied art in so far as they are protected as artistic works: however this term shall last at least until the end of the period of twenty-five years from the making of such work.

Each of the three countries discussed has chosen to create a special, formal regime for the protection of designs. Each has chosen to provide for that registered right a period of protection of less than twenty-five years (in the case of Canada, the TRIPS minimum of ten years, in the case of the United States, fourteen years, and in the case of Great Britain, a five year term [FN175] which they have made renewable for up to twenty-five years.) The TRIPS Agreement also leaves an option, in its requirements for the protection of textiles, that the countries may work either through their industrial design law or through copyright law. [FN176]

The first international agreement regarding industrial designs was the *Paris Convention* [FN177] which was initiated in 1883 with under a dozen signatory countries. [FN178] Even though that *Convention* states "industrial designs shall be protected in all the countries of the Union," [FN179] an ***46** international standard has yet to emerge. [FN180] This is because implementation of design protection has differed markedly between jurisdictions, and makes design laws difficult to harmonize. This is amply illustrated in the different schemes which have developed in Canada, Britain and the United States. Thus, applications for protection must be made separately in each member country under that country's legislation. By relying on the Paris Convention, however, an applicant for "industrial design" protection can begin by applying for protection in one member country and then rely on that date as the effective date of filing (the priority date [FN181]) for all subsequent member countries in which application is made. [FN182] For industrial design, this priority can only be relied upon for six months after the date of the initial filing. [FN183] Britain, Canada and the United States are all signatory to the Paris Convention. [FN184]

A further international co-operative effort to harmonize procedures involving designs is the *Hague Agreement Concerning the International Deposit of Industrial Designs*. [FN185] It allows a single deposit of a design to provide protec-

tion in multiple countries, and reduces the *47 number of formalities required and reduces expenses or costs. Registration of a design can be made in a national office or through the World Intellectual Property Organization [WIPO], depending upon the country from which it originates. However, registration in each jurisdiction will be dependent upon meeting the substantive requirements of that country. Although the treaty has been operative since 1934, this Agreement has not been ratified by Canada, the United States [FN186] or Great Britain. [FN187]

In an attempt to model a harmonization scheme for the member countries of the European Union, including Great Britain, the EC Commission published a *Green Paper on the Legal Protection of Industrial Designs* in 1991, which proposed a directive for the harmonization of the Community's design laws. [FN188] In 1999, the European Union still has no harmonization of its design laws in place. [FN189]

Canada and the United States are party to another multi-lateral treaty which involves obligations with respect to intellectual property: the *North American Free Trade Agreement* [NAFTA] (the third member is Mexico). NAFTA provides at Article 1713 that "Each Party shall provide for the protection of independently created industrial designs that are new or original." The parties also agreed that the term of *48 protection for these industrial designs would be no less than ten years. [FN190] The Canadian statute was amended accordingly to a ten year period, rather than the previous five year period, with an opportunity to renew for a further five years. [FN191]

The perceived need for an effective multi-lateral enforcement mechanism, and a more universal standardization for intellectual property rights resulted in the addition of the *Trade Related Aspects of Intellectual Property Rights* [[[TRIPS] Agreement as Annex I C of the *Agreement Creating the World Trade Organization* at the 1994 Uruguay Round of trade talks. The TRIPS agreement sets out substantive obligations respecting copyright, patents, trade marks, and industrial designs. [FN192] It also sets out basic non-discrimination requirements between member countries, [FN193] and requirements for members to comply with specific provisions of other major intellectual property conventions, such as the Paris Convention for the Protection of Industrial Property (1967), mentioned above. [FN194]

The TRIPS Agreement sets out "norms" or minimum standards to be provided by each member country for specific categories of intellectual property. The Agreement states that each member shall provide protection for independently created industrial designs that are new or original, [FN195] subject to limited exceptions. [FN196] The protection is to last a minimum of ten years. [FN197] Each country is to provide protection for owners against others (without the owner's consent) making, selling or *49 importing articles bearing or embodying a design which is copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes. [FN198] TRIPS, therefore, does not seem to impose any higher obligations on Canada and the United States in this area than are imposed upon them under the NAFTA agreement.

Britain, Canada and the United States are all members of the World Trade Organization [WTO] and are all signatory to the *TRIPS Agreement*. Therefore, each of the regimes of protection for industrial designs described earlier should be in conformity with the requirements of the *TRIPS Agreement*. Canada appears to have made only a very modest change to its *Industrial Design Act* in 1994 in order to ensure compliance. [FN199] Presumably the earlier 1993 amendments had already enabled Canada to be in substantial compliance.

One problem in interpreting these international agreements is that they all lack a definition of the term "industrial design." The World Intellectual Property Organization, which administers the Paris and Berne Conventions, states

An industrial design is the ornamental aspect of a useful article. This ornamental aspect may be constituted by elements which are three-dimensional (the shape of the article) or two dimensional (lines, designs, colors) but must not be dictated solely or essentially by technical or functional considerations. [FN200]

This definition of “industrial design” is in fact a definition of the narrower design right discussed throughout this article. It is a fair inference that the member countries, when considering their obligations under these agreements for the treatment of “industrial designs,” are actually contemplating the protection of designs, rather than the protection of the larger concept of industrial designs. As outlined above, Britain, Canada and the United States would have difficulty establishing compliance with their international obligations under these treaties *50 if the protection of industrial designs, rather than designs, was actually intended.

A foreseeable problem with both TRIPS and NAFTA is with the national treatment principle, whereby a country cannot treat another country's nationals any less favourably than its own nationals. [FN201] In terms of design protection, this means that an American who has failed in his own country to be issued with a design patent for an aspect of an industrial design, when he applies in Canada for an industrial design registration, must be given that registration if the aspect of the industrial design qualifies for it under Canadian law. Similarly, having received an industrial design registration in Canada does not give a Canadian any advantage in terms of applying for a design patent registration in the United States. If, however, the design *meets* the high threshold requirements of the design patent, then the patent will be issued to the Canadian just as it would have been if an American had applied. Thus compliance with these international obligations does not create harmonization of the various treatments being given to designs in the three countries examined here.

If intellectual property is to be looked at as a form of scarcity, as pointed out by Jack Roberts, the law must first create the scarcity and then, having done so, allocate that scarcity. [FN202] In the contest of industrial design as a form of scarcity, jurisdictions vary on delineating that scarcity, and also on how to allocate it. In each case, the scarcity created is achieved both through identification of the rights associated with the protection being created, and through the length of monopoly which the law has created. If a particular creation falls outside the parameters of the protection, no scarcity exists which can be allocated to any individual.

The diversity of local schemes to protect design will no doubt serve to frustrate attempts at worldwide standardization, as it seems to have done within the European Union. How much more daunting is the effort which would be required to harmonize the protection available across the world for the wider concept of industrial design? As has been demonstrated in the cases of Canada, Britain and the United States, this would require harmonization of aspects of patent, trade mark, copyright and design laws across jurisdictions.

***51 5. THE FUTURE OF INDUSTRIAL DESIGN LAWS IN CANADA AND ABROAD**

Design legislation has been said to have been created more or less by accident. [FN203] If this is a correct interpretation, however, it was an “accident” which appealed to the legislators of all the emerging industrialized nations. [FN204] It is true, on the other hand, that this form of protection has not been as universally adopted as copyright, patent and trade-mark. [FN205] The fact that there is no substantive international convention specifically for industrial designs also reflects the wide spectrum of attitudes toward industrial design protection.

Indeed, “design” as a topic has received a surprising lack of treatment in dissertations purporting to be surveys of all the intellectual property schemes. [FN206] Discussion of design has also been avoided in the *52 Canadian *House of Commons Debates* and the *Senate Debates*, [FN207] even when amendments affecting design law in the *Industrial Design Act* and *Copyright Act* were in the process of being read and passed in Parliament. [FN208] The endeavours of the industrial design sector are an indicator of the commercial and creative health of an economy. Legislation in this area from early days recognized the effect that encouragement of this form of activity could have on the progress of a nation. It is therefore surprising that it appears to be so overlooked of late. [FN209]

This article set out to discuss the availability and appropriateness of protection for the appearance of manufactured articles as an element of intellectual property protection. In compliance with the international agreements to which they are each a party, Canada, the United States and Britain have each been demonstrated to have available some form of legal protection for designs. In Canada and in Britain, this protection is embodied in a dedicated, *sui generis* scheme. In the United States, this protection is a distinct element of the patent regime. In addition, it has been demonstrated that each of the three has some overlapping protection for designs through trade mark law. However, these protections for designs vary significantly between jurisdictions and so designs will not be protected uniformly throughout their marketing areas, if any international sales are contemplated. Moreover, in each jurisdiction, there are aspects of design which remain unprotected.

The second enquiry undertaken in this article was an examination of the range of intellectual property protection that each of the three *53 jurisdictions canvassed has made available for the aspects of industrial design beyond the design aspect. Protection for these aspects of industrial design is not the subject of international agreements, and it has been demonstrated that the three jurisdictions differ markedly in both the availability of protection for these aspects of industrial design and the locus of those protections which have been created. These protections are uneven and scattered across various areas of traditional intellectual property law. This had led to a compartmentalization of what professional industrial designers consider to be a monolithic enterprise. There are also significant aspects of the industrial designer's realm which remain unprotected: the designer can maintain no monopoly or control of reproduction of those areas of his or her creative effort.

(a) Intellectual Property in Design

Registered design laws in Canada and Britain protect only the ornamental aspect of articles “which appeal to and are judged solely by the eye.” The American design patent, created as a distinct part of its patent legislation, is also limited to the appearance of articles. It is not surprising that the Canadian legislative scheme, which is descended from the British, treats only the design aspect of industrial design, since its roots lie in very pragmatic attempts to stimulate various specific industries by creating sectoral exceptions to the longer monopoly protection of copyright. The creation of this unique protection for ornamentation was also not inconsistent at the time of its inception in the nineteenth century, when the Arts and Crafts Movement glorified ornamentation literally “applied” to manufactured objects by artists and craftsmen. However, modern industrial design no longer involves ornamenting and decorating objects, but rather emphasizes the unity of form, appearance, and function. It would now be far preferable, from the designer's point of view, to enlarge the range of aspects of industrial design protection covered by the design schemes, rather than to leave the protection of aspects other than ornamentation, where such protection has even been provided, through entirely separate areas of intellectual property. Ideally, the whole concept of an industrial design should receive protection.

None of the international agreements involving design protection give a substantive standard for protection of industrial designs. However, the *TRIPS Agreement* has suggested certain criteria in the protection of “industrial designs”: Members may provide that designs are not new or original if they do not significantly differ from known designs *54 or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.” [FN210] All three countries discussed here provide protections which satisfy these suggestions, However, the United States, in requiring the novelty of patent, differs significantly from Canada (originality of design [FN211]) and Britain (newness [FN212]), in the level of creativity demanded of the designer in order to receive protection on the design. The United States also requires non-obviousness in order to receive its design protection - a requirement not mentioned in the TRIPS Agreement.

Historically, all three jurisdictions have protected elements of design through their copyright laws. Having now developed other design protections, however, Britain and Canada have consciously acted to remove the possibility of overlapping protections. Canada's attempt to remove the overlap, refined in the 1988 amendments, seems to be effective. Britain's copyright jurisprudence had created confusion over a designer's access to copyright law, *however*, the recent statutory attempt at clarification of the boundary between copyrightable artistic work and design capable of registration in the *Copyright, Designs and Patents Act, 1988* has not been very successful. However, where artistic copyright remains available to a designer in Britain under the 1988 legislation, the period of protection is limited to twenty-five years (the minimum under the *Berne Convention*). The United States continues to allow a potential overlap between the subject matter of design patents and copyright as artistic works, but, the requirement for recognition as an artistic work that the artistic portions of the work be conceptually separated from the functional aspects, renders the likelihood of design protection under copyright low. As industrial designs are usually an "elusive blend of form and function, quality and style, art and engineering" [FN213] such that their aspects of ornament and utility are blended, it is not an easy task to separate out the purely artistic elements in order to qualify for copyright. Where copyright protection is achieved in the United States, it is for the normal full length of copyright.

Although recognizing that the creativity of designers should be rewarded, therefore, these three countries have each chosen to grant a *55 limited monopoly in the creation of a design for a lesser period of time than is available to other creators of copyrighted works. This policy choice *was* left open by the international agreements to which they are all party. To be consistent, it would appear that Britain and the United States should clarify the distinction between this shorter design right (which must have been chosen to encourage the faster dissemination of creative ideas and consequent fostering of industrial and creative growth), and the longer protection for other kinds of works under copyright. Overlapping protection would not appear to serve any policy interest.

It has been observed that a certain measure of intellectual property protection for some designs in all three countries may be obtained through trade-mark law. The possibility of overlapping protection between trade-mark and the other forms of intellectual property protection for designs has not been addressed either domestically in any of the three countries, or in any international agreements. Thus, if a design can achieve and maintain a distinctiveness in the marketplace, then the possibility of ongoing protection of the trade-mark exists. In all three countries, trademark law has developed protection for shape and configuration, which are the elements of trademark which could potentially protect design. [FN214]

Particularly in the United States, where the requirements for the design patent appear to be somewhat stringent, it is interesting to note that there has apparently been a wide recognition given to trade-marks in designs. Because the term of protection for the trade-mark is completely dependent upon the product remaining distinctive in the marketplace, it would be difficult to demonstrate that this form of protection gives designs the minimum ten year protection which countries have agreed to provide to designs under TRIPS. It would also be difficult to argue that this form of protection constitutes a "special" protection for designs such as the *Berne Convention* [FN215] requires if the twenty-five year copyright protection is not going to be required.

***56 (b) Intellectual Property in Industrial Designs, Other than the Design Aspects**

Where an industrial design can meet the statutory requirements for a patent, patent protection is available for the design in Canada as well as Britain and the United States. Indeed, by having the design patent available for the design aspects of an industrial design under the same legislative scheme as the protection for other patentable inventions, the United States has created the opportunity for consistent protection of all the elements of an industrial design. But this

protection is only available if the relatively high standards for both types of patents are met, which renders these protections unavailable for most industrial designs. Most industrial designs cannot meet the tests of novelty and unobviousness required for either the design or the utility patent.

In cases where the industrial design is not also an “invention” eligible for patent, only Britain seems to provide intellectual property protection for the creative aspects other than design. Britain has initiated the unregistered design right, which gives a relatively short period of protection to technical designs upon creation.

(c) Concluding Observations About Canada

In Canada, the *Industrial Design Act* could be reformed to be more all-encompassing of industrial designs. However, the period of protection under this Act is very short when compared to the lengths of protection available under other intellectual property regimes. Industrial designers may prefer to leave the protection of their creations somewhat fragmented in order to take advantage of longer monopoly control of aspects of their designs where available. Moreover, those elements of design, which can achieve protection under the patent and copyright regimes, will enjoy far wider consistent protection internationally than is available at present under design regimes. [FN216] If Canada does not decide to enlarge the scope of the *Industrial Design Act*, then it would be more appropriate to rename the statute: perhaps the Aesthetic Design Act, or Registered Design Act, or Appearance Designs Act?

Canada may wish to consider adopting a concept similar to that proposed for the European Union - an informal design right for a term *57 of two or three years. [FN217] This would protect products with a shorter market life, such as in the fashion or toy industries. This proposal differs from the British “design right” in that its subject-matter would be more the traditional realm of design, whereas, as discussed, the British right paradoxically seems to exclude that subject matter (such as surface decoration) and to apply to other industrial design aspects instead. The European Union Green Paper proposal would give designs some form of copyright-like protection, at least in the early stages of marketing the product, where such protection could be very valuable. Further, it would prevent designers who do not apply for registered industrial design protection within one year, from having their designs fall into the public domain, as is currently the case. This sort of “design right” could be broadened in scope to include internal and external features and some functional designs as well (like the British design right). Whether conceived narrowly or broadly, such a right would not disturb the registered design right now enshrined in the *Industrial Design Act*. That Act could continue to protect just design rights, and designers would presumably continue to seek registration under it because it would offer a longer term of protection.

Although the dual patent system in the United States could serve as a model for Canada, and might be attractive because of the comprehensive coverage it appears to offer to many aspects of an industrial design, American commentators have expressed dissatisfaction with it. [FN218] The high thresholds that patent seems to demand would appear to create a barrier for industrial designers, rather than an intellectual property protection which is attractive and rewards their creativity in a way that acts as an incentive to advancement. Alternatively, Canada might simplify its current administrative procedures and permit one application for both design registration for the visual aspects, and patent for the utilitarian aspects of a single industrial design. This approach, coupled with the unregistered design right just discussed, would more comprehensively protect industrial designs in Canada without radical change to the existing framework.

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[FN2]. *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended [hereinafter referred to as “the Act”], s. 2.

[FN3]. *Clatworthy & Son Ltd. v. Dale Display Fixtures Ltd.*, [1929] 3 D.L.R. 11 at 12, [1929] S.C.R. 429 at 431 (S.C.C.).

[FN4]. House of Commons Debates (March 16, 1993) at 17089 [Speaker: Mr. Philip Edmonston, (Chambly): discussion of the effects of Bill S-17.].

[FN5]. International Council for Societies of Industrial Design (ICSID) definition from http://www.icsid.org/*eddefinition.html. It may be noted that the authors indicate that the definition is still used as a guideline but “changing economic, industrial, social and cultural factors have significantly influenced the context in which design exists today” and they are currently working on a collection of new definitions to be added to this one.

[FN6]. Website of Carleton University, Industrial Design, at: http://www.carleton.ca/ca/cu/edu4life/brochures/ind_desn.html.

[FN7]. The Industrial Designers Society of America, “Comprehensive Description of Industrial Design” (1996) at <http://www.idsa.org/whatis/definition.htm>.

[FN8]. As will be discussed below, in addition to possible protection as designs, some aspects of industrial designs may be protected under copyright, patent and trademark.

[FN9]. Dratler Jr., “Trademark Protection for Industrial Designs” (1988) 4 U. Illinois L. Rev. 887 at 890.

[FN10]. The Canadian Royal Commission on Patents, Copyright, Trade Marks and Industrial Design asked itself the apparently threshold question “should industrial design be protected at all?” It is, however, apparent in context that the Commission was referring to the design right rather than the larger concept of industrial design. They continue: “We ask this question because we have previously considered recommending the repeal of the present act [the *Industrial Design Act*] with the substitution of nothing in its place.” See “Report on the Protection of Industrial Designs,” (1985) at 10.

[FN11]. As discussed in an earlier footnote, The Canadian Royal Commission did ask itself in 1958 whether such a design protection was necessary but, as will be discussed below, such a question is now moot in light of the international agreement that it is. Therefore, we will assume protection is desirable and continue, as set out above, to ask whether it is appropriate.

[FN12]. 35 U.S.C. ss. 171-173.

[FN13]. *Industrial Design Act*, R.S.C. 1985, c. 1-9.

[FN14]. 35 U.S.C., ss. 171-173.

[FN15]. *Registered Designs Act* 1949, (U.K.) 12, 13 & 14 Geo. VI, c. 88. The more recent *Copyright, Patents and Designs Act*. (U.K.) 1988, c. 48, will be discussed further below but the “unregistered design right” created under it ap-

pears to actually be about facets of industrial designs other than design.

[FN16]. See Chromecek, M., McCormack, S.C., and Chisum, D.S., *World Intellectual Property Guidebook: Canada* (New York: Matthew Beder & Co., 1991) at 1-4 to 1-12, particularly 1-8. See also Elizabeth L. Eisenstein, *The Printing Revolution in Early Modern Europe* (New York: Cambridge University Press, 1983) at 14.

[FN17]. A point recently reaffirmed by Teitelbaum, J., in *Cie Generale des Etablissements Michelin-Michelin & Cie v. C.A.W.-Canada et al.*, (1996) 71 C.P.R. (3d) 348 (F.C.T.D.) at 349.

[FN18]. Indeed, these are the only three included by David Vaver in his recent work on *Intellectual Property Law, Essentials of Canadian Law* (Concord, Ontario: Irwin Law, 1997). In his Preface he calls them “the three main branches of modern intellectual property law.”

[FN19]. The precursors to patent and copyright were developing in England in the sixteenth and seventeenth centuries, culminating for copyright in the Statute of Anne of 1709. See Lyman Ray Patterson, *Copyright in Historical Perspective* (Nashville: Vanderbilt University Press, 1968). The first semblance of industrial design protection in England was created in the late eighteenth century (1787) for textile designers (see Cornish, *infra*, note 149 at 299).

[FN20]. Jane Johnston, “Industrial Design Protection in Canada - Present and Future,” (1976) 23 C.P.R. (2d) 97.

[FN21]. (U.K.) 5 & 6 Vict. c. 100 (1842).

[FN22]. See s.3, *ibid.* The Canadian statute called *An Act to amend the Act respecting Trade Marks and to provide for the Registration of Designs*, 24 Vict., c. 21, uses virtually the same language to describe the subject matter of the designs protected, see s. 11, as was used in the 1842 British Act, see s.3 of the British Act, *ibid.*, including the words “and that whether such Design be so applicable for the Pattern, or for the Shape or [the (in the Canadian version)] Configuration, or for the Ornament thereof”. It is interesting to note that the British Parliament subsequently passed a second statute in 1843, *An Act to amend the Laws relating to the Copyright of Designs*, (U.K.) 6 & 7 Vict., c. 65, in which the preamble states that the 1842 Act goes on to create a design right “so far as such design shall be for the Shape or Configuration of such Article ... whether it be for the whole of such Shape or Configuration or only for a Part thereof” (s.3). Although the language of the 1843 Act does not seem to appear in the subsequent Canadian enactment, which, if the British Parliament in the 1843 preamble is correct, means the Canadian law never covered shape or configuration because the 1842 British Act using the same language did not. Myra Tawfik indicates, however, that both the 1842 and the 1843 British Acts are usually taken to be the source of the Canadian law: “The Law of Copyright and Industrial Design in Canada,” (1991) 7 C.I.P.R. 130 at 134.

[FN23]. (1861) 24 Vict. c. 21.

[FN24]. *Ibid.*, s. 13.

[FN25]. *Ibid.*, s. 3 and 15.

[FN26]. *Ibid.*, s. 26

[FN27]. The most salient of the copyright owner's rights can be summarized briefly as the right to first public distribution, to reproduction, abridgement, translation, adaptation to another medium, to public performance, to publicly exhibit an artistic work and to communicate the work by telecommunication. See the *Copyright Act*, R.S.C. 1985, c. C-42, as amended, s. 3.

[FN28]. Although this exception was set out in a statute which also dealt with trade-marks, the term used in the act for the design protection being given is “copyright.” The recital to the design registration portion of the statute provided this description of the protection being created:

copyrighting, protecting and registering of new and original designs, whether such designs be applicable to the ornamenting of any article of manufacture, or of any substance, artificial or natural, or partly artificial or partly natural, and that whether such designs be so applicable, for the pattern, or for the shape, or for the configuration, or for the ornament thereof, or for any two or more such purposes, and by whatever means such designs may be so applicable, whether by printing or by painting, or by embroidery, or by weaving, or by sewing, or by modelling, or by casting, or by embossing, or by engraving, or by staining, or by any other means whatsoever, manual, mechanical, or chemical, separate or combined.

See the 1861 Act, *supra* note 23, s. 11, in part.

[FN29]. The term designated in the legislation itself, see s. 11 of the 1861 Act, *supra* note 23.

[FN30]. *An Act to amend the Act respecting Trade Marks, and to provide for the Registration of Designs, (1861) 29 Vict., c. 21, s. 12* - re-arranged for the convenience of the reader. It may be noted that these periods of protection are generally longer than the protections given under the 1842 British Act, *supra* note 21. The 1861 “Canadian” Act was repealed and superseded by *The Trade Mark and Design Act of 1868*, 31 Vict., c. 55 which was the first Act in the Dominion of Canada to protect designs.

[FN31]. For example, the Canadian statute of 1875, *An Act respecting Copyrights*, (1875) 38 Vict., c.88, approved and ratified by the Imperial Act, *The Canada Copyright Act, 1875*, 38-39 Vict., c.53, provided for a general copyright term of 28 years.

[FN32]. Britain was forced to accept both the longer term of protection of life plus 50 years for copyright and the concept of subsisting rights rather than rights arising upon registration in order to be able to adhere to the *Berne Convention 1908 Revision* (see Cornish, *infra*, note 149 at 301-302). It made these changes to its own legislation in 1911 but that statute never came into effect in Canada (see Normand Tamaro, *The 1995 Annotated Copyright Act* (Toronto: Carswell) at 6). The 1921 revision to the Canadian *Copyright Act*, which came into force in 1924, brought to the Canadian legislation many of the changes made in British law in 1911 (Tamaro, *supra*, at 3, 7).

[FN33]. *Industrial Design Rules*, C.R.C. 1978, c. 946, R.11(1)(b) - since repealed by 1993 S.C. c.44, s: 164. In *Royal Doulton Tableware Ltd. v. Cassidy's Ltd.-Cassidy's Ltée* (1984), [1986] 1 F.C. 357 (Fed. T.D.) the judge took Rule 11(1) literally and decided that a pattern applied to porcelain was protected under copyright, even though more than 50 articles had been made, because neither porcelain nor china was listed under Rule 11(1) as articles to which Industrial Design could be applied. A similar decision was made in *Interlego AG v. Irwin Toy Ltd.* (1985), 4 C.I.P.R. 1, 3 C.P.R. (3d) 476 (Fed. T.D.), at 486 (C.I.P.R.).

[FN34]. *Agreement on Trade-Related Aspects of Intellectual Property Rights, A Multilateral Agreement [TRIPS]* set out in Annex 1C of the *Agreement Creating the World Trade Organization [WTO]*, 15 April: Article 25.2: “Each member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law.”

[FN35]. 31 Vict., c. 55. This Act still combined trade-mark protection and design protection in the one piece of legislation. The registration apparatus is still combined, now under the Ministry of Agriculture, see ss. 3 (providing for possibility of registering a trademark), 14 (requiring registration of a design mark) and 16 (Minister of Agriculture responsible).

[FN36]. The origins of this radical change in approach to design protection in Canada are shrouded in some mystery. The British 1842 Act, discussed above, was amended several times during the 1850's (see *The Copyright of Designs Act*, 1858 and the Schedule thereto), but none of these amendments swept away the variation in periods of protection by types of goods set out in the 1842 Act. It therefore appears unlikely that the 1868 Canadian legislation had its genesis in England. The Act dates from the 1st Parliament, u 1st session, whereas Hansard begins with the following session (actually 1869). Other sources, however, indicate that the Bill came to the House of Commons from the Senate. Within seven days from Friday, May 15, 1868, the Bill passed through both Houses and received Royal Assent the following Friday. No debate has been reproduced (although there appears to have been brief committee discussion at one stage on an aspect of the Bill unrelated to this issue).

[FN37]. Indeed, as discussed elsewhere, no definition of “industrial design” appears in the statute for 120 years.

[FN38]. *Supra* note 23, s. 13.

[FN39]. The Solicitor's *Journal and Reporter* for April 28, 1883, described the former system at some length and then reported (vol. 26, at 429)

All this complicated system is now to be abolished, and one uniform period of protection of four [sic] years is to be established for all designs of whatever description registered under the Bill. The principle opposition to the proposal seems likely to proceed from the persons engaged in the trades in which, at present, only a nine months' protection is allowed, and who will, therefore, be prevented from using registered designs for more than five times as long as at present. However, ... [i]t would be a curious thing if, in the law of patents, a distinction were made between inventions in different classes of cases, and a patent were granted for fourteen years, say, in the case of a mechanical invention, but only for five in the case of a chemical discovery.

[FN40]. *Supra* note 23, s. 17.

[FN41]. *The Trade Mark and Design Act of 1879*, (1879) 42 Vict., c. 22, repealed the Act of 1868, see s. 38, but refers to the continuation of the Province of Canada statute of 1861, see s. 39, “so far as the same remains in force after the passing of this Act.” The 1879 Act created the possibility of a five year renewal for industrial design registration (see s. 22). In 1891, the new Exchequer Court of Canada was given jurisdiction over disputes involving either trade mark or industrial design registrations - see An Act further to Amend the Act respecting *Trade-Marks and Industrial Designs*, 54-55 Vict., c. 35. See also Ian Bushnell, *The Federal Court of Canada: A History, 1875-1992* (Toronto: The Osgoode Society for Canadian Legal History, 1992) at 78. The 1879 and 1891 provisions for industrial designs were continued in the 1906 Consolidation of the Act, including the common administration for industrial designs and registered trade-marks (see Part III of the *Trade Mark and Design Act*, R.S.C. 1906, c. 71). The industrial design portion of the Act continued virtually unchanged in the 1927 Consolidation: *Trade Marks and Design Act*, R.S.C. 1927, c. 201. Although *The Unfair Competition Act*, 1932 (22-23 Geo. V., c. 38) repealed the trade marks portion of the *Trade Marks and Design Act* (except the union label provisions), it did not affect the industrial design portions (see s.61(2)). The industrial design and union label provisions, all that remained in force from the 1879 Act after 1932, were consolidated unchanged into the *Industrial Design and Union Label Act*, R.S.C. 1952, c. 150. *The Unfair Competition Act* 1932, had clarified that fact that the “union label” sections of the 1879 Act governed “a registered trade mark adopted for the purpose of indicating that the wares bearing it have been produced under defined working conditions or by a defined class of persons.” (S.61(3)). Perhaps not surprisingly, then, these provisions were shifted into the trade marks legislation in An Act relating to Trade Marks and Unfair Competition, (1953) 1-2 Eliz. c. 49. The industrial design portions of the legislation remained unchanged through the subsequent federal consolidations of 1970, see the *Industrial Design Act*, R.S.C. 1970, c. 1-8, and 1985, see the *Industrial Design Act*, R.S.C. 1985, c. 1-9.

[FN42]. Nikolaus Pevsner, *Pioneers of Modern Design* (London: Penguin Books, 1991) 12, quoting John Ruskin, *The Seven Lamps of Architecture* (New York, 1849) at 7.

[FN43]. *Ibid.* at 19.

[FN44]. Duane and Sarah Preble, *Artforms* (New York: Harper & Row, Publishers, 1989) at 207.

[FN45]. Designer of the Honeywell thermostat, interior of DC-10 jet, Hoover vacuum cleaner, and the Singer sewing machine.

[FN46]. *Supra* note 44.

[FN47]. (1988), 20 C.P.R. (3d) 291, 21 C.I.P.R. 286, 19 F.T.R. 161 (Fed. T.D.), at 308 (C.P.R.).

[FN48]. Government Debates, June 26, 1987: Ms. Sheila Finestone, at 7690.

[FN49]. *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended, s. 9.

[FN50]. *Copyright Act*, R.S.C. 1985, c. C-42, as amended, s. 5: "... copyright shall subsist ..."

[FN51]. *Clatworthy & Son Ltd. v. Dale Display Fixtures Ltd.*, *supra* note 3.

[FN52]. (1964), [1965] 1 Ex. C.R. 811, 48 C.P.R. 31 (Can. Ex. Ct.).

[FN53]. *Bayliner Marine Corp. v. Doral Boats Ltd.*, 67 N.R. 139, 9 C.I.P.R. 311, 10 C.P.R. (3d) 289, [1986] 3 F.C. 421 (Fed. C.A.), leave to appeal refused (1986), 9 C.I.P.R. 311 (note), 75 N.R. 158 (note), 14 C.P.R. (3d) 446 (note) (S.C.C.); see also *Algonquin Mercantile Corp. v. Dart Industries Canada Ltd.* (1984), 1 C.P.R. (3d) 75, 5 C.I.P.R. 134, 55 N.R. 291 (Fed. C.A.), leave to appeal refused (1984), 5 C.I.P.R. xlvi, 57 N.R. 392 (note) (S.C.C.), where the same two quotations are cited as defining the elements of industrial design.

[FN54]. *DRG Inc. v. Datafile Ltd.* (1991), 117 N.R. 308, 35 C.P.R. (3d) 243, 43 F.T.R. 239 (note) (Fed. C.A.).

[FN55]. "Presentation of the Board of Trade of the City of Toronto on Industrial Designs": Quick Law database C.P.R. (c. 1953).

[FN56]. "Industrial Design Applications: New Requirements, New Uncertainties" (1997) 14 C.I.P.R. 85 at 89.

[FN57]. The *Industrial Design Act* does not explicitly state that the article to which a design is applied must be useful, it only states that it must be "finished." Since the *Copyright Act* s. 64(2) will not protect designs applied to a useful article, or those derived from artistic works where more than 50 articles are produced, it is presumed that designs applied to useful articles fall under the protection of the *Industrial Design Act*. It has been held that a registrable design cannot be applied to an article whose sole function is to carry that design: the article to which the design is applied must also have some other purpose, see: (1991), 117 N.R. 308, 35 C.P.R. (3d) 243, 43 F.T.R. 239 (note) (Fed. C.A.), at 250-51 (C.P.R.), relying on *Re Application of Littlewoods Pools, Ltd., to Register a Design* (1949), 66 R.P.C. 309 at 310.

[FN58]. *Wells v. Attache Case Manufacturing Co.* (1932), 49 R.P.C. 113 at 119.

[FN59]. R.S.C. 1985, c. 1-9, s. 5.1 (a) : -"No protection afforded by this Act shall extend to (a) features applied to a useful article that are dictated solely by a utilitarian function of the article." See *Goodyear Tire & Rubber Co. of Canada v.*

Canada (Patent Commissioner), [1979] 2 F.C. 558, 43 C.P.R. (2d) 219 (Fed. C.A.). On the other hand, in *Industrial Design Registration by Robin R. Bryan, Re* (1977), 56 C.P.R. (2d) 134 (Can. Pat. App. Bd. & Pat. Commr.) a protective shield similar to a fireplace screen was registrable.

[FN60]. *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended, s. 2. Prior to the 1988 amendments, which clearly identified shape as a possible subject of industrial design protection, the courts were divided over whether shape was protectable as a design. The following shapes were found to be protected under the Act: shape of a sofa, tent pegs, stacking chairs, knife handles, frying pans and warmers, (see, respectively: *Cimon Ltd. v. Bench Made Furniture Corp.* (1964), [1965] 1 Ex. C.R. 811 (Can. Ex. Ct.); *Carr-Harris Products Ltd. v. Reliance Products Ltd.* (1969), 42 Fox Pat. C. 9, 58 C.P.R. 62 (Can. Ex. Ct.), affirmed (1970), 65 C.P.R. 158 (note) (S.C.R.); *Global Upholstery Co. v. Galaxy Office Furniture Ltd.* (1976), 29 C.P.R. (2d) 145 (Fed. T.D.); *R. v. Premier Cutlery Ltd.* (1980), 55 C.P.R. (2d) 134 (Ont. Prov. Ct.); *Algonquin Mercantile Corp. v. Dart Industries Canada Ltd.* (1983), [1984] 1 F.C. 246, 71 C.P.R. (2d) 11 (Fed. T.D.), affirmed (1984), 1 C.P.R. (3d) 75, 5 C.I.P.R. 134, 55 N.R. 291 (Fed. C.A.), leave to appeal refused (1984), 5 C.I.P.R. xlvi, 57 N.R. 392 (note) (S.C.C.).

But, a display stand, rubber overshoes, toy sink, building blocks and tire treads were not found to be protectable shapes (see, respectively: *Clatworthy & Son Ltd. v. Dale Display Fixtures Ltd.*, [1928] Ex. C.R. 159 (Can. Ex. Ct.), affirmed [1929] S.C.R. 429, [1929] 3 D.L.R. 11 (S.C.C.); *Renewal Manufacturing Co. v. Reliable Toy Co.* [1949] Ex. C.R. 188; *Angelstone Ltd. v. Artistic Stone Ltd.*, [1960] Ex. C.R. 286, 19 Fox Pat. C. 175, 33 C.P.R. 155 (Can. Ex. Ct.); *Goodyear Tire & Rubber Co. of Canada v. Canada (Patent Commissioner)*, [1979] 2 F.C. 558, 43 C.P.R. (2d) 219, 28 N.R. 243, 102 D.L.R. (3d) 467, 43 C.P.R. 219, 102 D.L.R. (2d) 467 (Fed. C.A.).

[FN61]. *Copyright Act*, R.S.C. 1985, c. C-42, as amended, s. 64 (2).

[FN62]. The *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended, ss. 4(1), 6(1) and 7(3).

[FN63]. *Copyright Act*, R.S.C. 1985, c. C-42, as amended, s. 5(1) “subject to this Act, copyright shall subsist in Canada, for the term hereinafter mentioned, in every original literary, dramatic, musical and artistic work if any one of the following conditions in met ...”; in the *Industrial Design Act*, R.S.C. 1985, c. 1-9, s. 7(3) provides “The certificate [of registration of the design] ... is sufficient evidence of the design, of the originality of the design.” [emphasis added in each case].

[FN64]. *Bata Industries Ltd. v. Warrington Inc.* (1985), 5 C.I.P.R. 223, 5 C.P.R. (3d) 339 (Fed. T.D.).

[FN65]. *Paramount Pictures Corp. Industrial Design Application, Re* (1981), 73 C.P.R. (2d) 273 (Can. Pat. App. Bd. & Pat. Commr.): the design for a starship toy was too similar to that of the “Star Trek Enterprise” design. The case does not disclose whether the Star Trek design had ever received industrial design protection. Even if it had, that protection would have been long expired. Nevertheless, the existence of the Star Trek design, even in the public domain, rendered the applicant's design unoriginal.

[FN66]. This statistic comes from counting the cases listed in R. T. Hughes, *Copyright and Industrial Design* (Toronto: Butterworths, 1984-97) at 1511-1520.

[FN67]. Announcement by the Patent Office Record of July 2, 1974.

[FN68]. *Industrial Design Act*, R.S.O. 1985, c. 1-9, s. 11(2):

“... in considering whether differences are substantial, the extent to which the registered design differs from any previously published design may be taken into account.”

[FN69]. *R. v. Premier Cutlery Ltd.* (1980), 55 C.P.R. (2d) 134 (Ont. Prov. Ct.), at 143-44. See also, *Mainetti S.P.A. v. E.R.A. Display Co.* (1984), 80 C.P.R. (2d) 206, 2 C.I.P.R. 275 (Fed. T.D.).

[FN70]. Examples of infringement cases: *Cimon Ltd. v. Bench Made Furniture Corp.* (1964), [1965] 1 Ex. C.R. 811 (Can. Ex. Ct.), at 848-9 (sofas found to be substantially the same design); *House of Faces Inc. v. LeBlanc* (1984), 2 C.P.R. (3d) 177, 4 C.I.P.R. 43 (Ont. H.C.) (infringement of rounded corner design for make-up trays and containers); *Carr-Harris Products Ltd. v. Reliance Products Ltd.* (1969), 42 Fox Pat. C. 9, 58 C.P.R. 62 (Can. Ex. Ct.), affirmed (1970), 65 C.P.R. 158 (note) (S.C.R.) (copying of a “fraudulent nature” of the design for a tent peg.).

[FN71]. *Mainetti SPA v. ERA Display Co.* (1984), 80 C.P.R. (2d) 206, at 222 (F.C.T.D.). Court found the registered design to be of a functional nature and decided the registration should be expunged, otherwise, there would have been a finding of infringement.

[FN72]. *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended, s. 17(1).

[FN73]. In *Bazz Inc. v. Distributions Nadair Inc.* (1990), 35 C.P.R. (3d) 152 (Fed. T.D.): irreparable harm was not shown and therefore no damages were awarded. On the other hand, in *SklarPepler Inc. v. Decor-Rest Furniture Ltd.* (1990), 34 C.P.R. (3d) 76 (Fed. T.D.), on an interim injunction application, the plaintiff successfully demonstrated that the defendant closely emulated the design and caused the plaintiff irreparable harm. The plaintiff was granted the interim injunction.

[FN74]. Designs were held not covered by copyright because they would have been capable of being registered as industrial designs. See; *Jeffrey Rogers Knitwear Productions Ltd. v. R. D. Int. Style Collections Ltd.*, [1985] 2 F.C. 220, 6 C.I.P.R. 263, 6 C.P.R. (3d) 409 (Ont. T.D.) and *Doral Boats Ltd. v. Bayliner Marine Corp.* (1986), 9 C.I.P.R. 311 (F.C.A.).

[FN75]. There are jurisdictions which recognize a common law design right that arises on the introduction of the design to the public, such as in Britain.

[FN76]. Historically, this has been divided into a five year period with a five year renewal available: some industrial designs are still in effect under these time periods - s. 29.1(1) *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended. Effective in 1994, the period was amended to provide simplicity for ten years of protection (s. 10(1) S.C. 1993, c. 44, s. 163).

[FN77]. The original protection in copyright under English law was a relatively short period of years: 21 under the Statute of Anne of 1709 (8 Anne c. 19). The *Berne Convention for the Protection of Literary and Artistic Works*, to which Canada adhered in 1923, requires its members to provide copyright in most works throughout the life of the author and for 50 years thereafter (see Article 7(1) of the 1971 version to which Canada is currently signatory). Since 1993, there has been increasing pressure to increase the period of protection to run for 70 years after the author's death. The longer period is provided for countries of the European Union in the *Directive on Harmonizing the Term of Protection of Copyright and Certain Related Rights*, Council Directive 93/98, 1993 O.J. (L. 290/9). The United States has now adopted the longer period of protection: The *Sonny Bono Copyright Term Extension Act* of 1995, passed by Congress October 7, 1998, and signed by President Clinton October 28, 1998.

[FN78]. The *Copyright Act*, R.S.C. 1985, c. C-42, s.46, and *Industrial Design Rules*, C.R.C. 1978, c. 964, s. 11(1), provided substantial, but not complete, separation between the two areas of protection, prior to 1988.

[FN79]. Added by *An Act to amend the Copyright Act and to amend other Acts in consequence thereof*, S.C. 1988, c. 15, s. 11.

[FN80]. The explanation in square brackets is taken from the preamble in s. 64(2), *Copyright Act*.

[FN81]. The quoted sections are from s. 64, the portion in the square brackets after “useful article” is taken from the definition of that phrase given in s. 64(1).

[FN82]. Quoted from s. 64, *Copyright Act*. It may be noted that the wording of this section is closer to that of R. 11(1) of the *Industrial Design Rules*, C.R.C. 1978, c. 946 than it is to the wording of its predecessor section in the *Copyright Act*, s. 46 (R.S.C. 1970, c. C-30). The Rules deemed a design to be used as a model or pattern where it was intended to be reproduced in quantities of more than fifty (R. 11(1)(a)) and where the design was to be applied to various paper hangings, carpets, cloths, textile goods and lace (R. 11(1)(b)). Section 46 of the 1970 consolidation of the *Copyright Act* read:

This Act does not apply to designs capable of being registered under the Industrial Design Act, except designs that, though capable of being so registered, are not used or intended to be used as models or patterns to be multiplied by any industrial process.

For example, the design for a toy truck was found not copyrightable in *Eldon Industries Inc. v. Reliable Toy Co.*, [1966] 1 O. R. 409, 48 C.P.R. 109, 54 D. L. R. (2d) 97 (Ont. C.A.). In *Guy Vidal v. Arthro Inc.*, [1976] C.S. 1155 (Que. S.C.), mass produced “works of art” made of tin were found to be ineligible for copyright protection.

[FN83]. It may be noted that although the copyright legislation provides rights holders with a “bundle” of protectable rights, primarily in s. 3 of the *Copyright Act*, as mentioned elsewhere, these rights are subject to a number of significant statutory exceptions which permit certain uses by non-rights holders (see *Copyright Act*, R.S.C. 1985, c. C-42, as amended, ss. 29, 29.1, 29.2, 29.4, 30.7, for example).

[FN84]. Cartoon characters that are later made into toys may fall under this heading.

[FN85]. *Copyright Act*, R.S.C. 1985, c. C-42, as amended in 1988, s. 64 (3).

[FN86]. S. 9 of the *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended, requires registration.

[FN87]. All four definitions in s. 64 (1) of the current *Copyright Act*: “article”, “design”, “useful article,” and “utilitarian function” are among those included in s. 2 of the current *Industrial Design Act*.

[FN88]. The House of Commons was almost completely uninterested in industrial design from the beginning. A review of the Debates indicates that although debate has occurred on various other aspects of intellectual property, until recently, there has been no time during the passage of bills relating to industrial design when there was discussion around industrial design issues. See Sessions 1861, 1868 (handwritten and unindexed); Session 1879 vol. 1, 1292, 1293 and 1594: amendment to increase fees for registration; Session 1926-27, Trademarks and Design Amendment Act Bill: 1r 1285, 2r 1591, 2228; Session 1932, Trademark and Design Act, proposed amendment and Unfair Competition Act Bill: 12, 1541-2; Session 1952-53 Trade Marks Bill No. 316: 1r 3572, 2r 4192-94, 3r 4710 proc. 5302 Bill passed: no discussion or mention of industrial designs. Session 1986-88 there is some discussion in the House around issues of industrial design: 7669, 7689-90, 7692: is copyright protection appropriate for industrial design; 15522: *Bayliner Marine Corp. v. Doral Boats Ltd.* decision discussed at 7689; functional items at 12586-8 (copyright does not extend to purely functional articles, discussion of s. 46(1) and 24 of *Copyright Act*, Bill C-60). Session 1991 - 93, 17086, “it is important to protect our industrial designers”, “there have been no significant amendments to improve the legislation,” 17089: “industrial designs, which relate pretty much to ornamentation applied to an article” and designating an assignee to file an applica-

tion; and 1994: industrial design again is not mentioned.

[FN89]. (1995) 61 CPR (3d) 133 (F.C.T.D.).

[FN90]. *An Act to Amend the Copyright Act and other Acts in Consequence Thereof*, S.C. 1988, c. 65.

[FN91]. *Magasins Greenberg Ltée et al. v. Import-Export René Derhy (Canada) Inc.* (1995) 61 CPR (3d) 133 at 135.

[FN92]. *Ibid.* at 136.

[FN93]. Thus, in **Figure A**, above, the last column indicates that *Industrial Design Act* protection cannot be held at the same time as protection under copyright in Canada.

[FN94]. *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended, s. 6(3). It must also be noted that the pre-1988 provisions were of more than historical interest until recently because subsections (2) and (3) of s. 64 applied only to designs created after the current sections came into force - see s. 64(4). There are, however, no longer any designs surviving from before 1988.

[FN95]. It has already been noted above that the requirement that the design must be useful is not actually articulated in the *Industrial Design Act*. Rather, the effect of the exclusion from copyright protection of all designs applied to mass-produced useful articles means that designs used in such contexts can only be protected under the *Industrial Design Act*.

[FN96]. *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended, s. 2, definition of “distinguishing guise.”

[FN97]. A distinguishing guise is included in the statutory definition of a trade-mark, *Trade-marks Act*, R.S.C. 1985, c. T13, as amended, s. 2 definition of “trade-mark.”

[FN98]. *Trade-Marks Act*, R.S.C. 1985, c. T-13, as amended, s. 46.

[FN99]. *Trade Marks Act*, R.S.C. 1985, c. T-13, as amended, s. 13(2).

[FN100]. *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended, s.11(1).

[FN101]. *Trade Marks Act*, R.S.C. 1985, c. T-13, as amended, s. 19.

[FN102]. *Trade Marks Act*, R.S.C. 1985, c. T-13, as amended, s. 20(1).

[FN103]. A distinguishing guise might not be registrable as a trade-mark immediately (because it must be shown to be distinctive in the marketplace: s. 13(1) *Trade Marks Act*). However, it is arguable that the time before it does become distinctive is minimal. At common law, the equivalent of the distinguishing guise - the “get-up” - may become distinctive almost immediately upon its introduction into that market. The common law “get-up” may well include shape [*Source Perrier S.A. v. Canada Dry Ltd.* (1982), 36 O.R. (2d) 695, 64 C.P.R. (2d) 116 (Ont. H.C.).]

[FN104]. *Copyright Act*, R.S.C. 1985, c. C-42, as amended, s. 64(3)(b).

[FN105]. *Copyright Act*, R.S.C. 1985, c. C-42, as amended, s. 64(3)(b): Subsection (2) does not apply ... [to remove] the copyright or the moral rights in an artistic work so far as the work is used as or for (b) a trademark or a representation thereof or a label.”

[FN106]. The continuing existence of the common law trade-mark is specifically recognized in s. 10 of the *Trade-Marks Act*: “Where any mark has by ordinary and bone fide commercial usage, become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services, no person shall adopt it as a trade-mark in association with such wares or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefore.”

[FN107]. Whereas other types of trade-marks can be registered in advance of use as “proposed marks” under the *Trade-Marks Act*, R.S.C., 1985, c. T-13, as amended, s. 16(3). See also inclusion (d) “a proposed trade-mark” in the definition of “trade-mark” in s. 2 of the *Trade-Marks Act*.

[FN108]. *Trade Marks Act*, R.S.C., 1985, c. T-13, as amended, s. 13(1).

[FN109]. *Dominion Lock Co. v. Schlage Lock Co.* (1962), 38 CPR 88, at 89.

[FN110]. *Trade-Marks Act*, R.S.C. 1985, c. T-13, as amended, s. 13(3).

[FN111]. *Ciba-Geigy Canada Ltd. v. Apotex Inc.* (1992), 44 C.P.R.(3d) 289 (S.C.C.).

[FN112]. *Tender Loving Things Inc. v. Doctor Joy* (1995), 66 C.P.R. (3d) 12 (Fed. T.D.), at 15-16.

[FN113]. *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended, s. 5.1(a).

[FN114]. *Patent Act*, R.S.C. 1985, c. P-4, as amended, s. 2: definition of invention: “means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.”

[FN115]. J.H. Reichman, “Design protection and the new technologies: the United States experience in a transnational perspective” (1989) 19 *Baltimore L.R.* 6, at 8 [Footnotes omitted].

[FN116]. *Industrial Design Act*, R.S.C. 1985, c. 1-9, as amended s. 11(1).

[FN117]. *Patent Act*, R.S.C. 1985, c. P-4, as amended, s. 42.

[FN118]. *Supra*, note 115.

[FN119]. *Patent Act*, R.S.C. 1985, c. P-4, as amended, ss. 42 (inventions) and 32 (improvements).

[FN120]. *Patent Act*, R.S.C. 1985, c. P-4, as amended, s. 27(5).

[FN121]. Dratler, Jr., *supra* at 892.

[FN122]. *Patent Act*, R.S.C. 1985, c. P-4, as amended, s. 28.3

[FN123]. It may be noted that there are few exceptions to the monopoly right to manufacture which the patent endows, but the public must be given full disclosure of the invention itself (*Patent Act*, R.S.C. 1985, c. P4, as amended, s. 10).

[FN124]. For example, internal aspects of the design or purely functional designs which do not meet the, threshold for patent.

[FN125]. For example, industrial design registrations may be available for stuffed toys which would not meet the criteria to be considered industrial designs within the field of industrial design.

[FN126]. *United States Code Annotated*, 1998, Title 35, Patents, s. 171.

[FN127]. *United States Code Annotated*, 1998, Title 35, Patents, s. 173.

[FN128]. *Hueter v. Compco Corp.* C.A. III. 1950, 179 F.2d 416.

[FN129]. *Forestek Plating & Manufacturing Co. v. Knapp-Monarch Co.*, C.C.A. Ohio 1939, 106 F.2d 554.

[FN130]. *Re Faustmann*, 1946, 155 2d 388, 33 CCPA, Patents, 1065.

[FN131]. *Capex Co. v. Swartz*, C.C.A. III. 1948, 166 F.2d 5.

[FN132]. Roy Jackson, "Problems and Prospects in Design Laws in 1989" (1989) 6 C.I.P.R. 267 at 270: Citing *Re Cho*, 813 F 2d 378 (1987).

[FN133]. 17 U.S.C., s. 101.

[FN134]. *Application of Yardley*, Cust. & Pat. App. 1974, 493 F. 2d 1389.

[FN135]. Richard G. Frenkel, "Intellectual property in the balance: Proposals for improving Industrial Design Protection in the post-TRIPS era", (1999) 32(2) Loyola of Los Angeles Law Review 531-581.

[FN136]. Richards, *infra*, at 256.

[FN137]. Frenkel, *supra* note 135, at 559-60.

[FN138]. Dratler Jr., *supra* note 9 at 892: citing Professor W. T. Fryer, III, University of Baltimore Law School, in a letter to Sen. DeConcini.

[FN139]. Lindgren, "The Sanctity of the Design Patent: Illusion or Reality? Twenty Years of Design Patent Litigation Since *Compco v. Day-Brite Lighting Inc.*, and *Sears, Roebuck & Co. v. Stiffel Co.*" (1985) 10 Okla City U. L. Rev. 195 at 208.

[FN140]. Dratler Jr., *supra* note 9 at 891.

[FN141]. Frenkel, *supra* note 135, at 533-34.

[FN142]. The "Lanham Act" or Trademark Act of 1946, 15 U.S.C. ss. 1051-1127.

[FN143]. 15 U.S.C. s. 1125(a).

[FN144]. See Dratler, Jr., *supra* note 9 at 899.

[FN145]. Dratler, Jr., *supra* note 9 at 900-901. He points out that this limitation has been criticized.

[FN146]. Dratler, Jr., *supra* note 9 at 898.

[FN147]. Dratler, Jr., *supra* note 9, at 904.

[FN148]. John Holyoak, Paul Torremans, *Intellectual Property Law* (London: Butterworths, 1995) at 252.

[FN149]. W.R.Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 3rd ed. (London: Sweet and Maxwell, 1996) at 495.

[FN150]. *Hensher v. Restawile*, [1976] A.C.64, [1975] R.P.C.31. John Richards provides a succinct summary of the four separate definitions of a work of artistic craftsmanship which were advanced by the Lords in that case: see “Industrial Design Protection: the U.K. Initiative,” (1989) 6 C.I.P.R. 250 at 255-56.

[FN151]. *Cuisinaire v. South West Imports*, [1968] 1 Ex. C.R. 493, affirmed [[1969] S.C.R. 208.

[FN152]. *Copyright, Design, and Patent Act*, 1988.

[FN153]. *Copyright, Designs and Patents Act*, 1988, s. 52(2).

[FN154]. See the commentary in *Halsbury's Statutes of England and Wales* (4th ed.) which disapproves early case law permitting registered design protection and patent protection to co-exist.

[FN155]. *Registered Design Act*, s. 1(1).

[FN156]. See discussion above.

[FN157]. *Registered Design Act*, S.1(4)

[FN158]. *Registered Design Act*, S.1(3) provides: “A design shall not be registered in respect of an article if the appearance of the article is not material, that is, if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description, and would not be so taken into account if the design were to be applied to the article.”

[FN159]. That is, a potential for 25 years of protection; the registration is actually for a five year period, renewable five times (see s.8(1),(2) *Registered Design Act*, 1949).

[FN160]. S. 1(3) set out above.

[FN161]. Cornish, *supra* note 149, remarks at 337 “Some types of works are treated as artistic only if they bear a distinctive element of aesthetic creativity, others gain protection simply because labour and capital ought not to be freely appropriable.” If there are works which are not artistic works but meet the requirements to be protected under the *Registered Design Act*, it would appear that, unless they are “surface decoration,” they would be protected *ab initio*, without registration, under the unregistered design right provisions of the *Copyright, Designs and Patents Act*, 1988 which will be discussed in the next section.

[FN162]. It prohibits “copying the design so as to produce articles exactly or substantially to that design” (s. 226(2) of the *Copyrights, Designs and Patents Act*, 1988).

[FN163]. *Copyright, Designs and Patents Act*, 1988, s. 213(b).

[FN164]. *Copyright, Designs and Patents Act*, 1988, s. 213(a). If articles made from the design are made available for

sale or hire within five years from the end of the year in which the design was first recorded or an article first made from it, then the period is shortened to run only ten years from the year in which the items were first made available for sale or hire: see s. 213(b).

[FN165]. Cornish, *supra* note 9 at 498.

[FN166]. Indeed, it was seen as providing protection for those designs removed from copyright protection in the 1988 amendments, see s. 51(1) above (Preliminary Note on the Design right, *Halsbury's Laws of England and Wales* (4th ed.)). Note also that the effect of s. 236 of the *Copyright, Designs and Patents Act*, 1988 appears to be that if there is any design covered by the unregistered design right which consists of or is included in a copyrighted work, the right to enforce the design right is not effective and the copyright holder must pursue the infringer in copyright.

[FN167]. *Copyright, Designs, and Patents Act*, 1988, s. 213(2).

[FN168]. It may be noted that this subsection would clearly make it impossible to hold a design right in the subject matter of a patent. See the note to this effect about in 33 *Halsbury's Statutes of England and Wales* (4th ed.).

[FN169]. *Copyright, Designs, and Patents Act*, 1988, s. 213(3).

[FN170]. Richards, *supra* note 150 at 258.

[FN171]. *Copyright, Patents and Designs Act*, 1988, s. 213(2).

[FN172]. Richards, *supra* note 150 at 257: Citing notes and comments of Lord Beaverbrook for introducing the bill in the House of Lords.

[FN173]. Indeed, the unregistered design rights cannot even include surface decoration. See s. 213(3)(c) of the *Copyright, Patents and Designs Act*, 1988.

[FN174]. See *Copyright, Patents and Designs Act*, 1988, s. 224.

[FN175]. Query whether this is in strict compliance with TRIPS? Article 26 requires countries to provide at least ten years of protection and this legislation requires a renewal to obtain ten years protection (see [Agreement on Trade-Related Aspects of Intellectual Property](#), (1994) 33 I.L.M. 1197).

[FN176]. TRIPS, Article 25.2

[FN177]. The *Convention for the Protection of Industrial Property*, made in Paris, March 20, 1883, made effective July 7, 1884; revised at Brussels, December 14, 1900; revised at Washington, June 2, 1911; revised at the Hague, November 6, 1925; revised at London, June 2, 1934; revised at Lisbon, October 31, 1958; revised at Stockholm, July 14, 1967; amended in 1979.

[FN178]. Great Britain was one of the original signatories (the others included Belgium, Brazil, France, Italy, Netherlands, Portugal, Spain, Switzerland, Tunisia). The United States joined in 1887 and Canada in 1925.

[FN179]. *Paris Convention*, Article 5 Quinquies. This article and Article 5 B are the only articles in the Convention which involve substantive requirements for industrial design. Article 4 deals with procedural questions such as priority in applications.

[FN180]. At an international symposium in Grenoble in 1977, no national representative was prepared to put forward their scheme for industrial design protection as a model for the European Community. See Roy Jackson *supra* note 32 at 268.

[FN181]. The application in the second and subsequent member countries would be considered by the administrations of those countries as though it had been filed with them on the date of actual filing in the first member country. Thus the application in the second or subsequent countries would take priority over all applications filed after the date of the actual filing in the first member country.

[FN182]. Paris Convention, Article 4A and 4B.

[FN183]. Paris Convention, Article 4C(1).

[FN184]. As mentioned, Canada, the United States and Britain have long been members of this Convention. It is also a requirement of their adherence to the TRIPS Agreement, discussed below, that comply with Articles 1 through 12 and 19 of the Paris *Convention* (Article 2.1) - and for Canada and the United States, also a requirement under *NAFTA* (Article 1701.2(c)) that they give effect to the *Paris Convention*. Although a long-time member, Canada actually only became a party to the Stockholm version of the Convention (1967, as amended by 1979), with respect to Articles 1 to 12 on May 26, 1996 - spurred on by its obligations internationally (with respect to Articles 13-30, Canada had already adopted the Stockholm version in 1970). The United Kingdom had been party to the Stockholm version since 1970. The United States had also been party to the Stockholm version from the seventies (Articles 1-12 in 1973, Articles 13-30 in 1970). See www.wipo.org/eng/ratific/d-paris.htm.

[FN185]. The *Hague Act* of November 28, 1960. See The World Intellectual Property Organization Website for full text of the Agreement at <http://www.wipo.org/eng/iplex/wo-hahO-htm>.

[FN186]. For a discussion of the difficulties which the Americans perceive with this Agreement, see William T. Fryer, III, "Seeking a Benefits Balance in the Industrial Design Treaty Revision (Hague Agreement): Fifth Meeting of Experts, Held June 13-16, 1995," (1995) 12 *Journal of the Patent and Trademark Office Society* 931. He identifies the seven European Union countries who are members of the Hague Agreement as its principal users: Belgium, France, Germany, Italy, Luxembourg, Netherlands and Spain (at 940).

[FN187]. The *TRIPS Agreement*, to which all three are party, and the *NAFTA*, to which Canada and the United States belong, require adherence to a number of other intellectual property treaties, including the *Berne* and *Paris Conventions*, as mentioned above, but not the *Hague Agreement*. Of course, it would still be open to any of the three to have adhered of their own volition, but none of them have chosen to do so, see <http://www.wipo.org/eng/ratific/h-hague.htm>.

[FN188]. Cornish, *supra* note 149 at 309; Audrey A. Horton, "Industrial Design Law: The Future for Europe" [1991] 12 *E.I.P.R.* 442; Herman Cohen Jehoram, "The EC Green Paper on the Legal Protection of Industrial Design. Half Way down the Right Track - A View from the Benelux" [1992] 3 *E.I.P.R.* 75; Jon Holyoak and Paul Torremans, *supra* note 148 at 286-288.

[FN189]. See, for example, Mark Miller, "The TRIPS Agreement and Direct Effect in European Community Law: You Can Look ... But Can You Touch?," (1999) 74(2) *Notre Dame L.R.* 610.

[FN190]. *NAFTA*, Article 1713, s. 5.

[FN191]. *Industrial Design Act*, R.S.C. 1985, c. I-9, s. 10(1), as amended by *Intellectual Property Improvement Act*, S.C.

1993, c. 15, s. 17 and the *North American Free Trade Agreement Implementation Act*, c. 44, s. 163.

[FN192]. Jon R. Johnson, *International Trade Law* (Toronto: Irwin Law (Essentials of Canadian Law Series), 1998) at 195.

[FN193]. TRIPS Articles 3, 4, and 5.

[FN194]. TRIPS Article 2.1.

[FN195]. Although, “Further, members may provide that designs are new and original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.” TRIPS Article 25.1.

[FN196]. “Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.” TRIPS Article 26.2.

[FN197]. TRIPS Article 26.5.

[FN198]. TRIPS Article 26.1. TRIPS also provides in Article 25.2 that “Each member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law.” This provision was discussed above with respect to the sectoral nature of industrial design.

[FN199]. See the definitions under “Priority” at s. 29(2) of the *Industrial Design Act*, R.S.C. 1985, c. I-9, as amended by *World Trade Organization Agreement Implementation Act*, S.C. 1994, c. 47.

[FN200]. World Intellectual Property Organization, “International Protection of Industrial Property” at <http://www.wipo.org/eng/general/ipip/intro.htm>.

[FN201]. TRIPS Agreement, Article 3.

[FN202]. Roberts, R.J., “Is Information Property?” (1987) 3 I.P.J. 209.

[FN203]. Jane Johnston, [Director of Industrial Design], “Industrial Design Protection in Canada - Present and Future: Notes for an address to the Annual General Meeting of the Patent and Trademark Institute of Canada,” October 24, 1976, 23 CPR (2d) 97. “Stephen Ladas once said that the formation of a special branch of industrial property for designs was an historical accident.”

[FN204]. Article 2 of the 1908 Berlin Revision of the 1886 Act of the *Berne Convention for the Protection of Literary and Artistic Works* provided, for the first time, that “Works of art applied to industrial purposes shall be protected so far as the legislation of each country allows.” See Pierre Maugue, “The International Protection of Industrial Designs under the International Conventions.” (1989) 19 Baltimore L.R. 393 at 400. Maugue terms this category of works “controversial” (Ibid). The reluctance of the developing nations to recognize certain forms of intellectual property is pointed out by Chromecek et al, *supra* note 16 at 1-9. J.H. Reichman observes “With the notable exception of France [which permits both copyright and industrial design protection in many instances] courts and legislators in most *industri-*

alized countries [emphasis added] limit copyright protection of three dimensional appearance designs in order to defend the capacity of their industrial property systems to mediate between innovation and competition on the general products market.” [Footnotes omitted] [“Design protection and the new technologies: the United States experience in a transnational perspective,” (1989) 19 *Baltimore L.R.* 6 at 9].

[FN205]. In fact, the dispute regarding which of these sources of protection [copyright or specific industrial design legislation] should be utilized has been the subject of many studies and legislative experiments particularly in commonwealth countries, such as Great Britain and Australia.” Robert E. Mitchell, “Protection of Industrial Designs in Canada,” (1989) 19 *Baltimore L.R.* 403 at 404. See also Cornish, *supra* note 9 at 9.

[FN206]. See Robert M. Sherwood, “Intellectual Property in the Western Hemisphere,” (1997) 28 *University of Miami Inter-American L.R.* 565, where he developed an approach meant to weigh the intellectual property protections of various jurisdictions in order to rank countries in terms of their strength in this area. Unfortunately, protection of industrial designs does not appear to have been discussed or included in his analysis, which gave points for intellectual property administration and enforcement, adherence to international treaties, and protection of copyrights, patents, trade-marks, trade secrets, and life forms.

[FN207]. A survey of the Senate Debates to date reveals only a few minor references to industrial design (see for example May 18, 1868 which notes the passage of the *Act respecting Trade Marks and Industrial Design*), but nothing substantial.

[FN208]. Even in 1883, the article “The Proposed Legislation on Designs and Trademarks,” (1882-83) 27 *The Solicitors Journal and Reporter* [London] 428-430 at 429, began: “The subject of copyright in registered designs does not appear to excite so much interest as that of patents for inventions ... and it is hardly to be wondered that this should be so, seeing how limited in their scope and importance are registered designs when compared with patented inventions ...”.

[FN209]. The Report of the Expert Panel on the Commercialization of University Research, “Public Investments in University Research: Reaping the Benefits,” which was presented to the Prime Minister's Advisory Council on Science and Technology on May 4, 1999 and released on May 31, 1999 never once mentions industrial design in the entire text. See [http:// acst.ccst.gc.ca/acst/comm/paper/final-e.html](http://acst.ccst.gc.ca/acst/comm/paper/final-e.html).

[FN210]. TRIPS, Article 25.1, in part.

[FN211]. *Industrial Design Act*, see s. 4(1), 6(1) and 7(3).

[FN212]. *Registered Design Act*, 1949, s. 1 (2).

[FN213]. Dratler, Jr., *supra* note 9, at footnote 18, citing Nussbaum.

[FN214]. In Canada, the definition of “distinguishing guise” under the *Trade-Marks Act*, as discussed above, is very specifically limited to shape or the wrapping or packaging of a product. The common law action for passing off protects a wider range of indicia.

[FN215]. See the *Berne Convention*, Article 2(7), quoted above.

[FN216]. Further policy consideration should probably be given to the implications of overlap between other forms of intellectual property protection for industrial designs and trade-mark protection. Canada has moved to eliminate overlap in other areas of intellectual property protection as discussed above.

[FN217]. Horton, *supra* note 188.

[FN218]. Dratler, Jr., *supra* note 9; Frenkel, *supra* note 135.
14 Intell. Prop. J. 1

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