

Bereskin & Parr LLP

Creating the complete package

Obtaining the most comprehensive protection for designs and trade dress in Canada often requires a coordinated strategy that relies on trademark, copyright and design protection

Two-dimensional designs, including two-dimensional designs applied to three-dimensional objects, may be registrable as regular trademarks. The rules that apply to the registration of word marks apply to such designs, with some additional requirements: applications to register two-dimensional designs must include a drawing of the design and, if colour is claimed as a feature of the design, a specific description of the colour(s). An example of a trademark consisting of a two-dimensional design applied to a three-dimensional object is the subject of Registration TMA678,679, which covers the cap colour and labels of a Smirnoff vodka bottle, but not the shape of the bottle itself.

Three-dimensional designs may be treated as regular trademarks or as distinguishing guises – trademarks consisting of the “shaping of wares or their containers” or “a mode of wrapping or packaging wares” fall within the statutory definition of a “distinguishing guise” trademark. The ‘tread design’ of the Toblerone chocolate bar (TMA164,635) and its triangular packaging (TMA562,648) are well-known examples of product shapes and packaging that have been registered as distinguishing guises. Another example is the Bic ballpoint stick pen (TMA363114).

A distinguishing guise trademark is registrable only if it has been used in Canada so as to have become distinctive at the date of filing. Evidence of acquired distinctiveness must be filed with the Trademarks Office; the office may restrict the registration to the defined territorial area in Canada in which the distinguishing guise is shown to have become distinctive. The requirement to prove acquired distinctiveness has presented a significant hurdle to the registration of distinguishing guises consisting of combinations of the

size, shape and/or colour of pharmaceutical pills, since the evidence rarely supports a finding that physicians, pharmacists or patients associate the size, shape or colour of pills with any given single source.

A distinguishing guise will not be registrable if its exclusive use by the applicant is likely to “unreasonably limit the development of any art or industry”. In addition, the registration of a distinguishing guise will not prohibit the use by third parties of any utilitarian feature embodied in the distinguishing guise.

The utilitarian and ornamental (aesthetic) functionality of the distinguishing guise will be considered, and a guise will not be registrable or enforceable if it is primarily functional (see *Kirkbi AG v Ritvik Holdings Inc* (2005), 43 CPR (4th) 385 (SCC), which dealt with a passing-off claim based on a distinguishing guise consisting of the studs on the top surface of Lego building blocks and *Remington Rand Corp v Philips Electronics NV* (1995) 64 CPR (3d) 467, which dealt with a distinguishing guise consisting of a representation of triple-headed rotary electric head assembly).

While an application to register a distinguishing guise must clear a number of hurdles, registration of a design as a trademark secures several benefits, including a potentially indefinite term of protection, since the initial term of 15 years can be renewed indefinitely for further 15-year terms.

The registration of a guise also gives its owner additional causes of action, including the right to prevent others from selling, distributing or advertising wares or services in association with a confusing trademark, contrary to Section 20 of the Trademarks Act, or from using the guise in a manner that is likely to have the effect of depreciating the value of the goodwill attached thereto, contrary to Section 22 of the act.

Unregistered trademarks

In Canada, common law trademark rights can be established through the use and/or advertising of a trademark. Accordingly, it may be possible to establish trademark rights in designs and trade dress without a trademark registration. Common law rights are enforced through an action for passing off, which requires the plaintiff to establish the existence of goodwill or reputation in the trade dress; wilful, negligent or careless misrepresentation by the defendant; and actual or potential damage to the plaintiff. Proving all three elements of a passing-off action is generally very difficult, and it is especially difficult to prove the existence of goodwill in trade dress. Functionality is also a hurdle: unregistered distinguishing guises cannot be protected in a passing-off action if the guise is primarily functional.

Industrial design protection

Designs and trade dress may also be protected in Canada under the Industrial Design Act, which provides for the registration of designs that consist of, or incorporate, “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”.

In order to qualify for registration as an industrial design, a design must not be identical to, or so similar as to be confused with, a registered design. It must be original and “involve at least a spark of inspiration on the part of the designer either in creating an entirely new design or in hitting upon a new use for an old one” (see the decision of the Federal Court, Trial Division in *Bata Industries v Warrington Inc* (1985), 5 CPR (3d) 339).

Industrial design registration does not protect “features applied to a useful article

that are dictated solely by a utilitarian function of the article”, or “any method or principle of manufacture or construction”. Thus, while the doctrine of functionality applies to both trademark and industrial design protection, a higher degree of functionality is permitted under the industrial design regime.

Industrial design protection will be available only if the application to register the design is filed within one year of publication or public disclosure of the design. Unlike the potentially indefinite term afforded trademark registrations, a design registration lasts for a maximum of 10 years (and only then if a maintenance fee is paid on the five-year anniversary of registration).

Industrial design registration grants the owner the exclusive right to apply the registered design to any article in respect of which the design is registered throughout Canada, as well as the right to prevent another from making, importing for the purpose of trade or business, selling, renting or offering or exposing for sale or rent any article in respect of which the design is registered and to which the registered design (or a design not differing substantially therefrom) is applied.

Canadian jurisprudence has established that industrial design protection and trademark protection are not mutually exclusive (see *WCC Containers Sales Ltd v Haul-All Equipment Ltd* (2003), 28 CPR (4th) 175). Thus, if it fits within the constraints of the Trademarks Act, a design that has already enjoyed protection as an industrial design can be registered as a trademark, and distinctiveness acquired during the 10-year monopoly afforded by an industrial design registration can be relied upon in seeking a trademark registration.

Copyright protection

Designs and trade dress may also qualify for copyright protection, which is a statutory right that automatically arises upon the creation of an original work that is in fixed form and that qualifies as a protected work. The category of protected work most likely to apply to designs and trade dress is that of artistic works, which includes paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works and compilations of artistic works.

Canadian courts have held that the threshold for originality for copyright protection is lower than that for industrial designs.

The rights granted by copyright include the sole right to reproduce a protected work



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and to prevent the unauthorised reproduction of the work or a substantial part thereof.

The term of protection for copyrights in artistic works is generally the life of the author plus 50 years.

While industrial design and trademark protection can overlap, industrial design and copyright protection are mutually exclusive. The Copyright Act creates exceptions to copyright protection: notably, it will not constitute copyright infringement to apply to useful articles features that are dictated solely by the utilitarian function of the article. Also, if copyright subsists in a design applied to a useful article or in an artistic work from which the design is derived, and the article is reproduced in a quantity of more than 50, it will not constitute copyright infringement for someone to reproduce the design of the article or a design not differing substantially from the design by making the article or making a drawing or other reproduction of the article, unless one of the enumerated exceptions applies. The mutual exclusivity of industrial design and copyright protection means that the subject matter of copyright in Canada differs from that of other countries, and advice should be sought to ensure that copyright protection is available for the subject design or trade dress.

The enumerated exceptions cover, among other things, graphic or

photographic representations applied to the face of an article, material that has a woven or knitted pattern and architectural works; but of greatest pertinence is the enumerated exception that covers trademarks, representations thereof and labels. This exception can be seen as explicitly permitting concurrent trademark and copyright protection of certain works. In *Kraft Canada Inc v Euro Excellence Inc*, 59 CPR (4th) 353, a majority of the Supreme Court of Canada confirmed that artistic works appearing on product packaging – in this case, logos appearing on chocolate bar wrappers – could receive both trademark and copyright protection. The logos on the wrappers were not merely incidental to the items being sold and were entitled to copyright protection.

Integrated trademark, design and copyright protection strategies

The overlap between trademark and industrial design protection and between trademark and copyright protection can be exploited to broaden the protection available for designs and trade dress.

For newly developed designs and trade dress, the first step should be to consider whether protection is available in the form of an industrial design registration (keeping in mind that an application for such a registration must be filed within a year of public disclosure). Securing an industrial design registration will provide a 10-year monopoly during which trademark distinctiveness can be acquired. Once acquired distinctiveness can be shown, consideration may be given to applying to register the design as a distinguishing guise.

Other designs and trade dress – such as logos on product packaging – may be afforded both trademark and copyright protection. The differing rights and remedies provided by each of those respective schemes of protection can be relied upon to maximise the options available to enjoin would-be infringers – for example, copyright may provide a more effective means of stopping the importation and sale of grey-market goods than the trademark regime. [WTR](#)