



INDUSTRIAL DESIGN LAW IN CANADA: Finally some clarifications!

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May 18, 2013

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INDUSTRIAL DESIGN LAW IN CANADA

- *Bodum USA vs Trudeau* (FCTD)
- Best Practices & Practical Tips



Bodum USA vs Trudeau

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Why are Canadians so excited?

- *Bodum* is the first industrial design infringement decision on the merits from any level of Federal Court since 1993 amendments
- Bad facts, but clarifies the law of both infringement and validity



Infringement in the Act (s. 11)

➤ Pre-1993:

- Prohibits “fraudulent imitation” of a registered design

➤ Post-1993 amendments:

- Prohibits use of design “not differing substantially” from registered design



Infringement in the Act (s. 11)

- Post-1993 amendments also added:
 - “the extent to which the registered design differs from any previously published design” may be taken into account when deciding whether differences are “substantial” (s. 11(2))



Split in Previous Case Law

- “Three-part” test
 - *Mainetti v. ERA*
 - *Regina v. Premier Cutlery*
- “Eye of the court” test
 - *Algonquin Mercantile v. Dart Industries*



“Three-part” test

1. Whether one design would be confused with the other
2. Whether the alleged infringing article would have any existence but for the registered design
3. Whether the alleged infringing article was nearer original design than prior designs (originality decided by the eye)

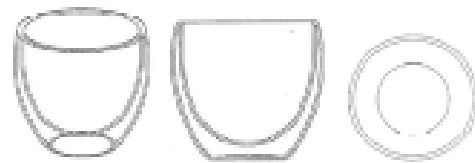


“Eye of the Court” test

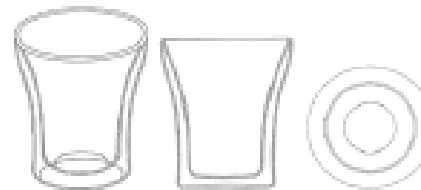
- “Eye of the court as properly instructed by expert witnesses”
- Essentially a side-by-side comparison



PI Design Registrations



Industrial Design Reg. No. 107,736



Industrial Design Reg. No. 114,070

Trudeau Glasses



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Infringement: applicable test

- Whether the allegedly infringing article differed substantially from the registered design
- To be assessed by the Court through the eyes of the informed consumer



Infringement: functional aspects

- Functional aspects not considered
 - Double-wall aspect of glasses not relevant
 - Ignore the construction, colour and material
- Look at the ornamentation, pattern, design, shape and configuration



Infringement: importance of the description

- PI registrations referred to “entirety of the drinking glass shown in the drawings”
- Court said: “Where emphasis is on the entirety of the design, to establish infringement, article in question must be quasi identical” to the designs

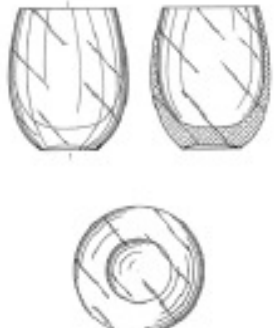


The Prior Art

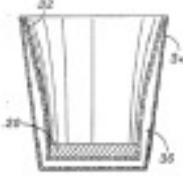
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BODUM INDUSTRIAL DESIGNS	PRIOR ART	
 Industrial Design Reg. No. 107,736	 Fig. 315. (One third.) (1897)	 (2000)
	 (2001)	 (circa 1750-1800)



 Industrial Design Reg. No. 114,070	 (1897)	 (1915)	 (1991)
	 (circa 1919)	 (1834)	 Assam no. 4553-16 (pre- 2003)



Trudeau does not infringe

- Configuration of the glasses (concavity and convexity and outside lines of glass walls) was considered
- Trudeau more similar to prior art than to the designs in issue
- Trudeau “differs substantially” from industrial designs – no infringement



BODUM INDUSTRIAL DESIGNS	PRIOR ART (BLUE DOUBLE-WALL GLASS)	TRUDEAU GLASSES
 Industrial Design Reg. No. 107,736		
 Industrial Design Reg. No. 114,070		



Invalidity: originality standard

➤ Originality in the Act (s. 6(1)):

- To be registered, Minister must be satisfied that design is not:
 - identical to prior art; or
 - “so closely resembling” prior art “as to be confounded therewith

➤ Presumption in the Act:

- Registration is evidence of originality (s. 7(3))



Invalidity: attacking originality

➤ *Bata Industries v. Warrington:*

- Mere “trade variant” of what has gone before
- Need “spark of inspiration”

➤ *LeMay v. Welch:*

- For articles in constant and daily use, there must be “some clearly marked and defined difference” from that which has gone before
- Not mere novelty of outline, but “substantial novelty”



Bodum/PI Designs are invalid

- Bodum/PI designs did not “vary substantially” from the prior art
- No “spark of inspiration”
- Glassware had existed for a long time and majority of possible shapes already explored
- Registrations ordered expunged



Prosecution Take-aways from *Bodum*

- “Marked and substantial originality” – high standard
 - In practice, CIPO not looking at prior art in most cases
 - Consider filing prior art to defang its impact?



Prosecution Take-aways from *Bodum*

➤ Good drawings

- Consider use of strategic solid line/broken line practice to focus the Court's attention
- Detail / enlarged portion views?
- Sectional views to show interior areas?

➤ Description

- Avoid use of “entirety”



Litigation take-aways from *Bodum*

- Expert witnesses!
- Relevant consumer looks at details:
 - Relative dimensions
 - Proportions
 - Curvature
 - Lines
 - No “imperfect recollection” hedge



Come litigate in Canada and your design case could become legendary!

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Best Practices & Practical Tips

- Registrability
- Required Form of Application
- Requirements for filing date
 - Proprietor, title, description, drawing
- Abandonment & reinstatement
- Self-collision & delay of registration
- Accelerated examination



Registrability

- The Minister shall register the design if the Minister finds that it is not identical with or does not so closely resemble any other design already registered as to be confounded therewith, and shall return to the proprietor thereof the drawing or photograph and description with the certificate required by this Part. (*Industrial Design Act*, s. 6(1))
- The Minister shall refuse to register the design if the application for registration is filed in Canada more than one year after the publication of the design in Canada or elsewhere... (*Industrial Design Act*, s. 6(3))



Required Form of Application

- **APPLICATION FOR THE REGISTRATION OF AN INDUSTRIAL DESIGN**
- The applicant, _____ whose complete address is _____ hereby requests the registration of a design for a _____ of which the applicant is the proprietor. The design was not, to the proprietor's knowledge, in use by any person other than the first proprietor at the time the design was adopted by the first proprietor. Description of the design: _____



Requirements for Filing Date

- Proprietor (including a Canadian address)
- Title
- Description
- Drawing(s)



Who May Apply?

Proprietor:

- The author of a design is the first proprietor of the design, unless the author has executed the design for another person for a good and valuable consideration, in which case the other person is the first proprietor. (*Industrial Design Act*, s. 12(1))



Title & Description

Title

- Must use the common name of the article
- Must indicate the entire article (e.g. Bottle and Cap)

Description

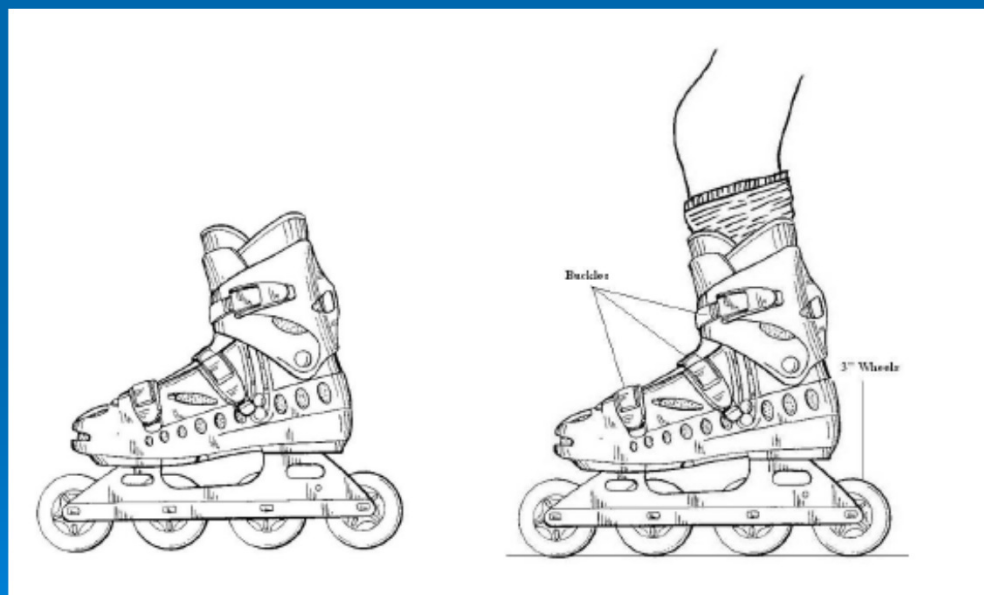
- Shape, configuration, pattern and/or ornament
- May indicate the article or a portion of the article
- May disclaim unimportant features or highlight important features



Drawings

Drawings

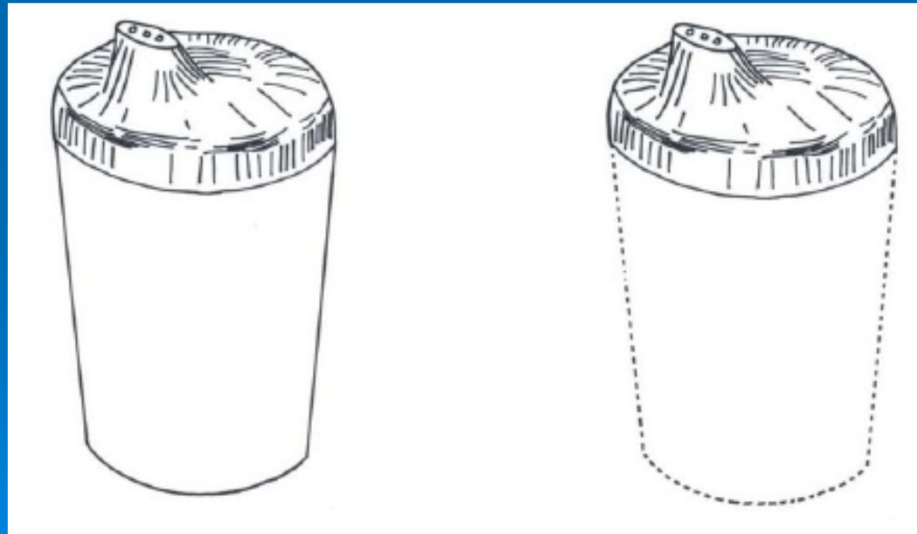
- Must show the entire article in isolation





Drawings

- Must show the entire article
- Stippled lines in one view to show environment





Drawings

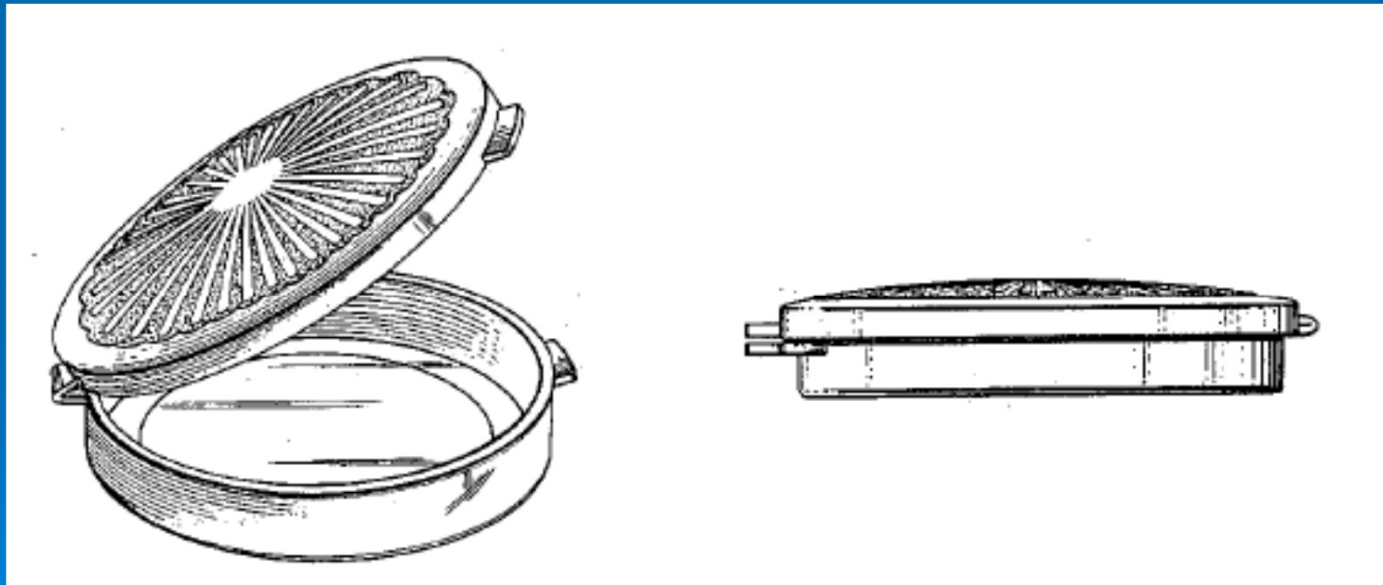
- Black and white only, but shading can be used to show contrast





Drawings

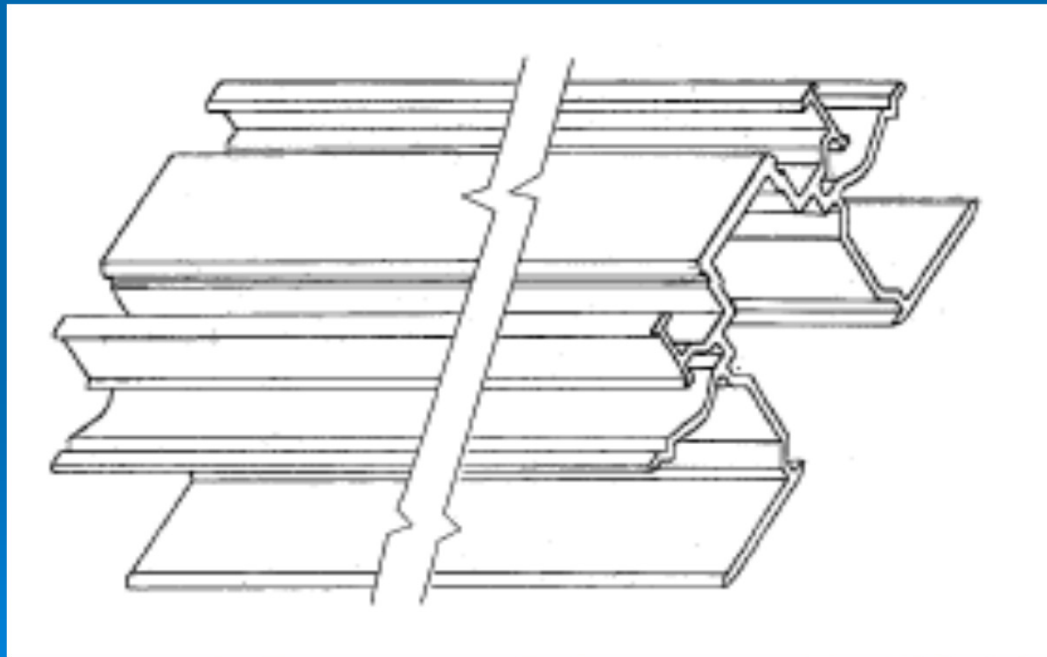
- Open and closed positions acceptable





Drawings

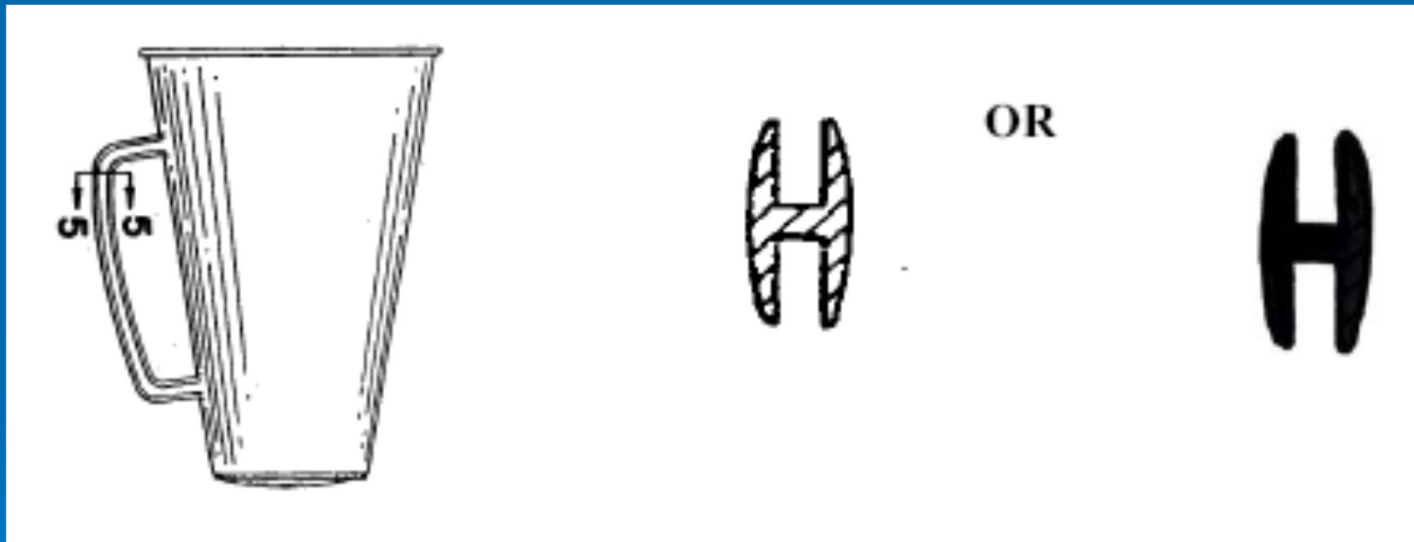
- Break lines for indefinite length





Drawings

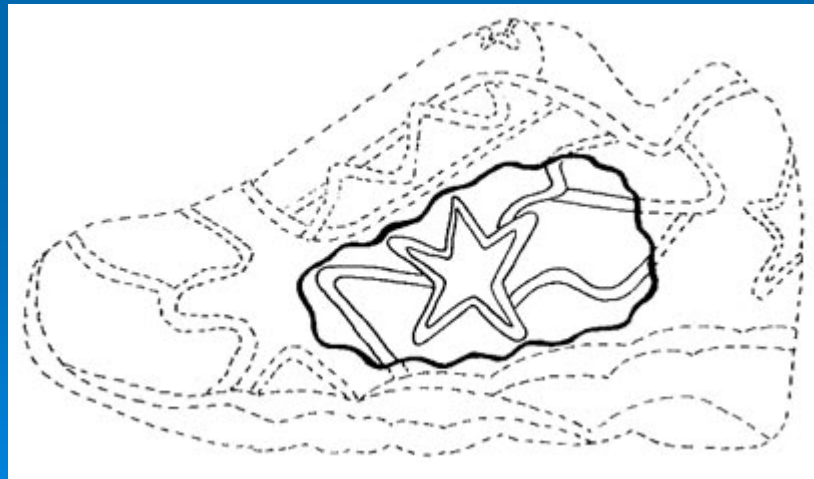
- Cross-sectional view for detail





Drawings

➤ Although stippled lines handle the majority of cases, there are exceptions that might warrant using bold wavy lines to define a boundary between the design and non-design portions of the article where the use of solid and stippled lines alone does not clearly show the design as applied to the article.

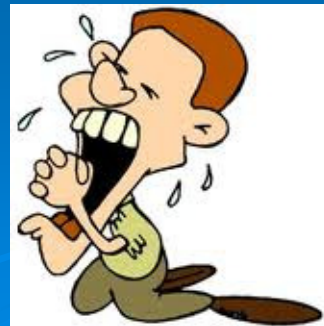




Abandonment & Reinstatement

An application that is considered abandoned shall be reinstated if the applicant, within the prescribed period,

- (a) makes a request for reinstatement;
 - (b) replies in good faith to the objections to registration; and
 - (c) pays the fees prescribed for reinstatement.
- (Industrial Design Act, s. 5(4))*





More than One Design

➤ Section 10 of the *Industrial Design Regulations* requires that the application must relate to one design applied to a single article or set or to variants of one design applied to an article or set.



More than One Design

- A divisional must be filed before the registration of the parent. **It is the responsibility of the applicant to notify the Office when an application is being filed as a divisional of another application.**
- The Office will register the parent and divisional(s) on the same date.



Co-pending Applications

When the same applicant files two or more applications on the same date or on different dates for similar designs¹ or related designs², **it is the responsibility of the applicant to notify the Office of such co-pending applications so that the Office can associate them and examine them together.**

¹ **Similar designs:** designs that are so similar that one could be cited against the other.

² **Related designs** designs usually in a series or grouping of an applicant's designs in similar or identical classes; for example, designs where one is for the entire container, one is for just the handle portion of the same container, and one is for an accessory for the same container.



Co-pending Applications

Failure on the part of the applicant to notify the Office could result in missed associations and the registration of one or more such designs prior to the other(s), which in turn could result in the citation of one design against another.



More than One Design

- **No issue fee. If design registers before divisional application filed it is too late to file!**
- **Be sure to request delay of registration if you intend to file a divisional applications**



Delay of Registration

Delay of registration may be requested accompanied by the required fee (Item 9 of the Tariff of Fees)

- six-month delay will be granted beginning on the day the request is received
- Additional requests may be filed with additional fees

Registration of multiple designs on same (voluntary divisional applications)



Delay of Registration

CIPO is considering a practice change:

- The Office is proposing to start the delay on the date of allowance
- Upon receipt, the Office would acknowledge the request for delay.
- Upon allowance, the Office would send a notification that the delay is beginning.



Accelerated Examination

Accelerated examination available upon filing written request and payment of the fee under Item 12 of the Tariff of Fees

- No application can be registered earlier than six months after the Canadian filing date due to priority obligations under the Paris Convention.
- CIPO is considering a practice change:



Accelerated Examination

CIPO is considering a practice change:

- The new practice will be to do an earlier search in the case of priority, where a certified copy of the priority filing certificate has been voluntarily submitted, which supports the claim to priority.



On the Horizon

- Canada is an observer at Locarno Union Pilot Working Group
- Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)
- Hague Agreement