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Protection By Design: Industrial Design Law In Canada

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Bodum – a maker of popular coffee-press and glass products – wanted to protect their design for a double-walled drinking glass in a competitive marketplace. Apple wanted to protect the design of their popular handsets like the iPhone and iPad. Both companies turned to industrial design protection.

Industrial designs are like the shy cousins of patents and copyright. Patents and copyright get all the headlines, but industrial design can be a very reliable, useful tool in the intellectual property (IP) toolbox. Industrial designs (in the US, known as "design patents") will protect the visual features of a product (shape, configuration, pattern or ornament). It's important to remember that functional, utilitarian or useful elements cannot be protected. Industrial design protection expires after 10 years, so it does not extend as long as patents or copyrights, but can provide protection for articles that are not eligible for either copyright or patent protection.

Two recent cases illustrate the importance of this type of IP: In *Bodum USA, Inc. v. Trudeau Corporation*, Bodum sued Trudeau for infringement of its double-walled drinking glass design, (which was registered as an industrial design). In comparing the two designs the Court discarded utilitarian function. Since the double-walled feature keeps hot drinks hot and cold drinks cold, it could not be assessed in the infringement analysis. As described in the judgement: "The court has to decide only whether the alleged infringement has the same shape or pattern, and must eliminate the question of the identity of function, as another design may have parts fulfilling the same functions without being an infringement. Similarly, in judging the question of infringement the court will ignore similarities or even identities between the registered design and the alleged infringement which arise from functional matters included within the design."

According to the Court, the competing product must be characterized as "substantially the same" for there to be infringement. This question must be analyzed by the Court from the point of view of how the informed consumer would see things. In the end, the Court decided that there was no infringement between Bodum's design and the competing product.

Regarding registrability, the court in Bodum confirmed that to be registrable, an industrial design must be substantially different from prior art. A simple variation is not enough. For a design to be considered original there must be some "substantial difference" between the new design and what came before. In this case, the Court reviewed a number of other existing designs for double-walled glasses (some dating back to 1897) and decided that Bodum's design was not original. To come to this conclusion, the Court set aside the utilitarian functions, the materials used, and colours applied, and looked merely at the visual or ornamental features. Bodum's design did not satisfy the requirement of "substantial originality", and the registration was expunged by the Court.

In the famous case of *Apple vs. Samsung*, Apple used 7 industrial design registrations to attack Samsung's Galaxy-line of smartphones and tablets. These design patent registrations protected the features of the iPhone and iPad, and one design registration even protected the user interface of the iPhone. In the end, Apple's design registrations were upheld and Samsung was found to have infringed a number of the iPhone and iPad design patents, including the D'305 design for the graphical interface, shown above.

Contact one of the lawyers in our experienced Intellectual Property & Technology Group for advice on protecting your products through industrial design.