

Bereskin & Parr LLP

Canada

Three-dimensional shapes can be protected under trademark, industrial design and/or copyright law in Canada. To obtain immediate and comprehensive rights, brand owners should consider an integrated strategy combining all three protection schemes

In Canada, certain types of non-traditional mark, including sound, olfactory and moving image marks, are not currently accepted for registration, while other types of non-traditional mark, such as the shape of products and their packaging, are registrable only if acquired distinctiveness can be shown.

This article focuses on the protection of three-dimensional product configurations and packaging, and the strategic use of trademark, design and copyright regimes to acquire immediate and comprehensive rights.

Trademark protection

Trademark registration

In Canada, 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.

As a general rule, three-dimensional product shapes and packaging are likely to fall within the definition of distinguishing guise. Examples of well-known product shapes and packaging that have been registered as distinguishing guises include the tread design of the TOBLERONE chocolate bar and its triangular packaging, and the wrapper design for the HERSHEY’S KISS chocolate.

Special rules apply to the registration of distinguishing guise trademarks.

First, 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 provided in the form of an affidavit or statutory declaration. A distinguishing guise registration may be limited geographically to those areas of Canada where acquired distinctiveness is shown. Therefore, it is important to show acquired distinctiveness throughout Canada if possible.

Another statutory restriction that applies to the registration (and enforcement) of a distinguishing guise stipulates that the exclusive use of the guise cannot be likely to limit unreasonably the development of any art or industry. Further, the registration of a distinguishing guise will not prohibit the use by third parties of any utilitarian feature embodied in the distinguishing guise.

A distinguishing guise may also be barred from registration on the basis of functionality. In assessing whether the registration of a guise is barred due to functionality, regard will be had to any past patent obtained for the guise (see *Thomas & Betts Ltd v Panduit* (2000) 4 CPR (4th) 498 and *Kirkbi AG v Ritvik Holdings Inc* (2005) 43 CPR (4th) 385 (SCC)).

While jurisprudence leaves some uncertainty, it appears that the test for functionality is whether the trademark is “primarily” functional. In other words, not every trademark that displays some functional features will be barred from registration (see *Remington Rand Corp v Philips Electronics NV* (1995) 64 CPR (3d) 467 (FCA); *Kirkbi AG v Ritvik Holdings Inc* (as above); and *Crocs Canada Inc v Holey Soles Holdings Ltd* (2008) 64 CPR (4th) 467), a summary judgment decision in which the Federal Court noted that the language of the statutory provisions relating to distinguishing guise trademarks clearly suggest “a policy choice to permit some functional (or utilitarian) features in a mark so long as they do not create a monopoly of the function”).

Registration of a distinguishing guise as a trademark carries certain benefits.

First, the term of protection is potentially indefinite. Like an ordinary trademark registration, a distinguishing guise registration has an initial term of 15 years and can be renewed indefinitely for further terms of 15 years.

Trademark registration also provides multiple possible causes of action, including:

- the right to prevent the sale, distribution or advertising of goods or services with a confusingly similar trademark by another in Canada; and

- the right to prevent the use of the registered distinguishing guise in such a way as to depreciate the value of the goodwill attaching to the guise.

Unregistered trademarks

It may be possible to establish trademark rights in unregistered three-dimensional product shapes or packaging, provided that the shape is not purely or at least primarily functional.

In Canada, one can establish common law trademark rights simply through use and/or advertising of a trademark. Common law rights are restricted to the geographical region where a reputation in the trademark has been established and are enforced through an action for passing off at common law and/or Section 7(b) of the Trademarks Act.

Industrial design protection

Protection for three-dimensional product shapes and packaging may also be obtained through registration as an industrial design.

The Industrial Design Act provides a scheme 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”.

To qualify for registration as an industrial design, a design must meet a two-prong novelty test:

- The design must not be identical to, or so similar as to be confounded with, a registered design; and
- The design must be original (the design must not only originate with the author, but also be more than a mere trade variant of an old design).

Also, a design cannot be dictated by utilitarian function. 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”. While functionality is a hurdle for both trademark and industrial design protection, it would appear that the permitted threshold for

functionality is higher for industrial designs.

However, design protection is available only if sought quickly. An application to register the design must be filed within one year of its publication or public disclosure anywhere.

Also, design protection is limited in term. A design registration lasts for a maximum of 10 years, provided that a maintenance fee is paid at the five-year anniversary.

In terms of enforcement, industrial design registration grants the owner the exclusive right to prevent another from making, importing, selling or renting 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 clearly established that:

- industrial design protection does not preclude protection of the same design as a distinguishing guise; and
- acquired distinctiveness as a trademark can be established during the 10-year monopoly granted by industrial design registration (see *WCC Containers Sales Ltd v Haul-All Equipment Ltd* (2003) 28 CPR (4th) 175).

Copyright protection

It may also be possible to obtain copyright protection for three-dimensional product shapes and packaging.

Copyright is a statutory right that automatically arises upon the creation of an original work. Registration is not required. However, certain criteria must be met, including that the work be in fixed form and qualify as a protected work (eg, an artistic or literary work). The threshold for originality for copyright protection is lower than that for industrial designs.

Copyright grants the owner the right to prevent the unauthorized production or reproduction of the work or a substantial part thereof.

The general term of protection for copyright is the life of the author plus 50 years, but other terms may apply to particular types of work.

Sections 64 and 64.1 of the Copyright Act create some exceptions to copyright protection, which are intended to address the interface between copyright and industrial design protection. Certain acts do not constitute copyright infringement, including the application to useful articles of features that are dictated solely by utilitarian function. Also, if a design is applied to a useful article that is reproduced more than 50 times, it will not constitute



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copyright infringement for another to reproduce the design (or a substantially similar design) by making the article, or making a reproduction in any material form of the article, unless one of the enumerated exceptions apply. One enumerated exception applies to trademarks.

The issue of copyright in a design applied to a useful article is currently before the courts in the *CROCS Case* discussed above.

Integrated protection strategies

Immediate and comprehensive protection of three-dimensional product shape and packaging in Canada requires strategic use of all three schemes.

For new product shapes and packaging, the first step that should be considered is to file an industrial design application. As noted above, the application must be filed within one year of public disclosure or registration will be statute barred, but the threshold for novelty is relatively low and the threshold of permitted functionality is relatively high. Moreover, successful industrial design registration will provide a 10-year monopoly, during which trademark distinctiveness can be acquired.

The second step should be to establish common law trademark rights in the product or packaging shape. To do so, the shape of the product or packaging should be treated as a trademark. This can be done through the use of appropriate marking and trademark notices and identifying the product or packaging shape as a trademark on packaging and in advertising. An additional step to consider is filing regular trademark applications for two-dimensional depictions of the product or packaging shape (such applications could be filed based on proposed use).

Then, once acquired distinctiveness throughout Canada or in a significant region of Canada can be shown, a distinguishing guise application should be filed. Trademark registration will provide potentially indefinite protection for the product shape or packaging. Trademark protection also will ensure that copyright in the shape of the product/packaging can be claimed and enforced.

A coordinated strategy that employs trademark, industrial design and copyright schemes will grant an overlay of rights in a product or packaging shape, and multiple legal grounds on which to enjoin would-be imitators. [WTR](#)