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## A NEW APPROACH TO PROTECTION FOR THE DESIGNS OF NEW PRODUCTS

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### I. *Introduction*

A manufacturer who has invested in the design of a new product needs protection to prevent his competitors from copying the design outright and thus taking unfair advantage of his investment. But under our present system of laws for protecting industrial property, he is faced with a serious problem when he is told by his patent attorney that the design has no broadly patentable features. His attorney may tell him that the design can be registered under the Industrial Design and Union Label Act,<sup>1</sup> but the manufacturer is usually unwilling to rely on this kind of protection when he learns that the act, based on enactments made before Confederation, is apparently designed to protect only "applied" design and ornamentation;<sup>2</sup> and that even a valid design registration will probably fail to protect the more valuable original features in the design.

For the modern product designer finds very little use for such external design or ornamentation. "The machine has rejected ornament; and the machine has everywhere established itself."<sup>3</sup>

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<sup>1</sup>R.S.C., 1952, c. 150.

<sup>2</sup>*Renwal Manufacturing Co. v. Reliable Toy Co.* (1949), 9 C.P.R. 67.

<sup>3</sup>Herbert Read, *Art and Industry* (London, Faber & Faber Limited, 1954) p. 33.

There are few new products with any important features that can be isolated as merely decorative, aesthetic or ornamental, and thus separated from those that are functional or necessary for performance.

In a case like this, the manufacturer will usually try to get a patent anyway, although it is sure to be of very narrow scope and will probably be invalid. Even if his attorney believes that there is no chance at all of securing a patent, he may file an application for the sole purpose of justifying the marking "Patent Pending", for whatever that marking is worth as a warning to his more gullible competitors. This means that the Patent Office is cluttered up with many applications that should never have been filed.

For many products with a short-term sales potential, there is another disadvantage in relying on patent protection: the time required for the prosecution of a patent application is such that a patent frequently does not issue until the idea protected is economically, if not technically, obsolete anyway.

There is thus a serious deficiency in the protection now available for new products, a deficiency that could be remedied by replacing the present design law with one that is more suited to protect what even the best system of patent law is not adapted to protect—the actual *designing process* that the manufacturer has to pay for in order to produce a new product.

If we examine this process of designing a new product, as I will do in a moment, it becomes clear that it is the same kind of process as the creation of a work of art—a painting, a statue, even a literary work, and, particularly, an architectural work of art. Each of these is a personal, individual, unique expression of ideas in some concrete form, and this is the characteristic quality of all forms of artistic creation: they are all means used by artists to express their ideas in a personal way.

An examination of the design process is likely to persuade us that the kind of protection that has long been enjoyed by other artistic works is the only suitable kind of protection for the non-patentable original features of a new product design. A design law that gave such protection could in fact be called "engineering copyright", but for the moment let me simply call it copyright-design law. Its purpose should be to prevent deliberate copying of all original design features in industrial products—ranging from concrete mixers to cutlery—in the same way that copyright now prevents the copying of literary works and works of art, thus recognizing that the original design of a concrete mixer uses human

labour, skill and knowledge in the same way as the creation of a painting, a statue, a building or a novel, and that it is no less deserving of protection against unfair appropriation. "A problem in design is a problem in design, whether it has to do with a train, a skyscraper, a national capital, a grinding machine, a housing project or a fountain pen: if the right form is evoked, the same principles and the same approach will obtain in every instance."<sup>4</sup>

In fact the copyright law apparently already protects new product designs to some extent, perhaps to a greater extent than is generally realized. But it does not protect them to the extent that section 46 of the Copyright Act<sup>5</sup> arbitrarily removes designs that are registrable under the Industrial Design and Union Label Act<sup>6</sup> from the scope of copyright if they are intended to be, or are, reproduced by an industrial process in fifty or more copies. Thus under the present law an original design of a concrete mixer intended to be produced in less than fifty units for one particular customer might be protected by copyright in the same way as the listing of names in a telephone book is protected (to take an example from the field of literary copyright that is perhaps as lacking in "artistic" quality as a concrete mixer is in the design field). But, because the manufacturer with whom we are concerned has many more customers in mind and intends to make over fifty units, he does not get copyright protection and has to rely on an inadequate (and probably invalid) design registration.

There may be some reason to believe that the Industrial Design and Union Label Act is itself based on copyright principles. Certainly it only protects against "copying". But in fact it is based more on patent-law principles than on copyright principles. All it is intended to do is to protect the "idea" of applying a particular design to the outside of certain kinds of articles: in *Pugh v. Riley Cycle Company, Ltd.*,<sup>6</sup> Mr. Justice Parker said that a design under the British Registered Designs Act is a "conception or suggestion". And under our present act this "idea" is not related in any logical way to the original labour, skill and knowledge contributed by the "author" in creating the work—which in fact is all that should be protected. The advantage of copyright is that the degree of protection is directly related to the extent of this contribution.

It is true that the British act has in some cases been construed

<sup>4</sup> Walter Dorwin Teague, *Design This Day* (New York, Harcourt, Brace and Company, 1949) p. 225.

<sup>5</sup> R.S.C., 1952, c. 55.

<sup>6</sup> (1912), 29 R.P.C. 196, at p. 202.

in such a way that the result is similar to the effect of copyright. For instance, in *Jackson v. Testar*,<sup>7</sup> Mr. Justice Astbury made an attempt to analyze the process by which the registered design was created and to determine in which of its features original labour, skill and knowledge had been expended, instead of merely making a visual comparison of the registered design with the prior art and with the infringing design. But this is contrary to the weight of authority, which is clearly to the effect that the question whether a design is new or original is a matter of fact to be decided by the eye alone.<sup>8</sup>

It is difficult to see any real possibility of adopting an effective copyright approach under legislation, like the British and Canadian acts, that refers to a design as "applied" to an article, or that uses such inapt and awkward concepts as "obvious imitation" or "fraudulent imitation". Under copyright principles, the design is the article; the protection extends only to the features that are the result of original labour, skill and knowledge; and infringement is the use by another of part or all of those features.<sup>9</sup> We cannot rely on the courts to bridge these differences and thus overcome the basic weaknesses of the present law.

## II. *How a Decision is Made*

Now let us examine the process of designing a new product. It always proceeds in two stages, and these stages represent aspects of design that can be clearly differentiated in theory, although they tend to blend together in practice. We may call them the "idea" aspect and the "expression" aspect.

The first stage in the design process is the collection and organization of basic ideas (data or facts) about the proposed new product. They are the answers to questions like these:

(1) What advantages can it offer the retailer and consumer over competing products, in terms of sales appeal, efficiency, safety, convenience?

(2) What technical (mechanical, electrical, electronic, chemical) ideas are available to achieve these advantages?

(3) Are there problems or deficiencies in production or use that can be overcome by developing new technical ideas?

(4) What production facilities can be used?

<sup>7</sup> (1919), 36 R.P.C. 289, at p. 295.

<sup>8</sup> *Dunlop Rubber Co. Ltd. v. Golf Ball Developments Ltd.* (1931), 48 R.P.C. 268, at p. 279.

<sup>9</sup> Copinger and Skone James, *Law of Copyright* (8th ed., 1948) pp. 2, 45, and 118 to 120.

## (5) What are the cost limits of the proposed article?

The second stage of the design process is the integration of all these ideas to produce a specific product that in its characteristics—shape, materials, colour, texture, dimensions, arrangement of parts—reflects or *expresses* as many as possible of the basic ideas. For instance, in the design of a new dictating machine, one of the ideas decided on may be the idea that it should fit into a brief-case like a book. So the final flat and rectangular shape will *express* this idea, but the exact shape will be determined by other considerations too, like the space required for inner components, and so it will be a sort of compromise among the various requirements. Because new ideas, and modifications in the plan, will occur continually during the second stage, the two stages will overlap, but functionally each stage still represents a distinct aspect of the process and always reflects the contributions of people in different fields—engineering, management, advertising and sales, in the first stage, the designer and his staff, in the second.

To prevent his competitors from copying this product as soon as it is on the market, the manufacturer will be able to rely on the broad protection of a patent only if one or more broadly new technical ideas were developed in the *first* stage of the design process, and this is seldom the case. So he is usually forced to seek protection in the contribution made by the designer in the second stage. This stage may involve little that is really novel, and it is not likely to produce any patentable ideas, but it will always involve *original* features, if the product is not a direct copy of an old design. For, in this second stage, the designer is responsible, like the conventional artist, for a personal and unique *expression* of ideas: "The designer is an expressionist".<sup>10</sup> In the designer's case, some of the ideas he expresses are the ones that were collected and organized, usually by other people, in the first stage of the process. And he will try out and either use or discard many other ideas during the design process.

The nature of this second stage is well expressed by Walter Dorwin Teague:<sup>11</sup>

When we have analyzed the function and materials of a product or a city, and the methods by which it must be built, and have let these factors determine the form we give it; when this form has been simplified and clarified, and knitted into an indestructible unity by creating rhythmic relations between its parts, lines and areas; when these

<sup>10</sup> Howard Robertson, *Modern Architectural Design* (London, The Architectural Press, 1952) p. 220.

<sup>11</sup> *Ante* footnote 4, pp. 204-205.

rhythms have been subjected to a dominant theme within a consistent scale, and given order and continuity by means of graduated accents; when the whole structure has equilibrium and stability, and that balance of tensions which reflects itself in our own physical satisfaction as we contemplate it—when all these things are done, the designer has used the tools that may be mastered and handled with planned intent.

Some of the ideas can be regarded as limitations, to which the designer, like the artist, is subject. Others can be thought of as objectives decided on in advance. Just as the painter cannot express his ideas with colours that do not exist in his palette, or beyond the two dimensional plane of his canvas, the designer is hedged in by inflexible properties of materials, techniques of production and mechanical laws. And just as a painter may express through his art his idea of what his patron will like, the designer if he is competent will express in his work the preference and requirements of the consumer: efficiency, safety and convenience in use, reasonable cost, pleasing appearance.

In our comparison we have on the one hand the artist bringing his objectives to terms with the requirements of his technique to produce a personal expression of his ideas and feelings. On the other hand, we have the designer bringing his objectives (based largely on what he knows about the people who will sell, buy and use the product) to terms with properties of materials, production techniques and costs, and mechanical principles. In each case there is a subtle and complex process of integration that is controlled by the personal aesthetic sense and unique approach of the artist or of the designer, as the case may be, to give the product its final individuality.

“The most typical designer of the machine age is the constructive engineer. In so far as he reconciles his functional aims with ideals of symmetry and proportion, he is an abstract artist.”<sup>12</sup> It may be objected that the comparison holds only for more “artistic” examples of industrial design, like furniture and consumer appliances, in which the designer has more “artistic choice” than he has in the design of, say, a concrete mixer. But this is purely a matter of degree and irrelevant to the question of protection. It has long been recognized that original literary works like compilations and directories are subjects of copyright, despite the limited artistic choice involved. The only relevant question is whether substantial original labour, skill and knowledge have been expended in the work, and certainly there is much more artis-

<sup>12</sup> Herbert Read, *ante* footnote 3, at p. 35.

tic choice in the design of modern heavy machinery, for instance, than there is in the literary form of a telephone directory. And industrial products can at the other extreme be art in the aesthetic sense. Herbert Read, in *Art and Industry*, says:<sup>13</sup>

Whenever the final product of the machine is designed or determined by anyone sensitive to formal values, that product can and does become an abstract work of art in the subtler sense of the term. It is only the general confusion between art and ornament, and the general inability to see the distinction between humanistic and abstract art, and the further difference between rational abstraction and intuitional abstraction, that prevents us regarding many of the existing products of the machine age as works of art, and further prevents us from conceiving the endless possibilities inherent in machine art.

It is time that the design law took into account the true nature of this "machine art". How far the Canadian and British law is from doing this can be judged by the fact that one British authority can say, "any simple shape is likely to be incapable of valid registration: it is sure to be old on some article";<sup>14</sup> when in fact it is the creative use of such "simple shapes" that is responsible for the commercial value of successful contemporary design work, and thus it is exactly the simple shapes that the manufacturer needs to protect.

### III. *Ideas and their Expression in Design*

We ask that our modern forms be *expressive* of function, and that our materials and techniques be revealed with similar candor; we also ask that line in our design, in so far as it can be separated from the form it bounds and can be considered as directional movement, shall *express* the forces active in our forms.<sup>15</sup>

These words by Walter Dorwin Teague emphasize the significance of "expression" in contemporary design; design of earlier times was equally a matter of expression, but it expressed other "design values", ones further removed from structure and function: "it was a true expression, not of the material requirements of building, but of the ideal of creating forms which in themselves might have a message, independently of a structure which had reached its technical limitations".<sup>16</sup>

But it is clear that the "expression" aspect of the creation of

<sup>13</sup> *Ante* footnote 3, at p. 37.

<sup>14</sup> T. A. Blanco White, *Patents for Inventions* (London, Stevens and Sons Limited, 2nd ed.) p. 239.

<sup>15</sup> *Ante* footnote 4, at p. 167 (*italics added*).

<sup>16</sup> Howard Robertson, *ante* footnote 10, at p. 122.

any industrial design stands completely apart from the "invention" of the functional ideas that are used in the design. A patent on a mechanical movement may be used by fifty designers in as many designs. A patent on a paint finish will be used in a hundred different fields. An idea for re-locating a spare tire of an automobile in the trunk may be patented, but each licensee of the patent may create an original design using the same idea and quite different from that of any other licensee.

In fact, the functional, mechanical and engineering ideas that are used by the designer in creating the product stand in the same relationship to the final result as do the ideas deriving from three other aspects of the product: means of production, use by the eventual consumer, and advertising and sale. That is why a designer must be extremely comprehensive in his approach. If, as is the case with most "design engineers", he is primarily an engineer, he may well under-emphasize the expression of the ideas arising from the use of the article and from other relationships between it and people. If, on the other hand, he is not an engineer, he may fail to emphasize sufficiently the mechanical operation or production aspects. In any case, whether or not the same man is responsible for both the ideas and their expression, there is a clear division between the development of the ideas (including the ideas of the kind that can be protected by patents) and the expression of these ideas in the final product.

Ideas are not personal or unique like their expression; they exist in the nature of the universe, awaiting recognition or discovery, and can never be really appropriated by anyone, not even by an inventor who happens to be the first to discover some practical application for an idea. Even if it is the kind of idea that can be covered by a patent, the inventor obtains an exclusive right, not to use the idea, but only to make, sell and use practical applications or embodiments of it. A patent is an entirely artificial creation of law, devised for a social purpose, and perhaps it is not inherently adapted for private ownership. This is why it is sometimes hard to justify the necessary consequences of the patent law except on grounds of social expediency: for example, if two inventors make the same discovery independently and almost at the same time, is there any ethical or moral justification for granting a valuable patent to one and excluding the other from protection, merely because one was fortunate enough to make his invention a few days before the other one did?

But the form of every original creation, being the uniquely



personal product of a man's mind and labour, can only be regarded as the special property of its creator. Had it not been for his efforts, *it never would have existed*. So a perpetual right of property, at least in unpublished literary and musical works, is recognized in most countries, reflecting the view of all civilized peoples that it is morally wrong to copy and use for gain the original creation of another person without his permission.

The unique and personal nature of an artistic work appears more forceably if we consider the impossibility of duplicating exactly a typical original work without copying it. Will anyone ever write a new Hamlet, word for word the same, without having read the old one? Compare this with the field of ideas, even those that have at one time been original discoveries of inventive minds: if all the great inventions were forgotten and their records destroyed in some overwhelming catastrophe, can it be doubted that they would be discovered again when the need for them arose? If Sir Frank Whittle had not discovered the principles which enabled him to make a successful jet engine, how long before someone else would have discovered them? Patent attorneys are constantly turning away would-be inventors who think they have just discovered an idea that in fact has been hidden away in patent files for twenty years. And in artistic and literary works the same ideas have been expressed over and over again: it is well known that most of Shakespeare's themes, for instance, had been used before his own day and it was only his expression of them that was new.

This is why the term "invention" should never be used both for the creation of a design and for the conception of an "inventive" idea, as it is used in the United States patent law, and as it has been used in even as perceptive an article on modern design law as "Design Patents and Modern Industrial Designs" by Duane C. Bowen in a recent issue of the Journal of the Patent Office Society,<sup>17</sup> which sets out a number of the quotations used in this article. There is similar confusion in another recent article, "The Nature of the Protection of Artistic and Industrial Design", by Leonard Michaelson in the same publication,<sup>18</sup> and it occurs in almost all earlier writings on the subject. But one recognized authority has stated the distinction between invention and artistic creation: F. E. Skone James, writing in the October issue of the Canadian Bar Review under the title "Some Proposed Changes in the Copyright Law"<sup>19</sup> (although the terms he uses are also subject to criti-

<sup>17</sup> (1955), 37 J. Pat. Off. Soc'y 744.

<sup>19</sup> (1955), 33 Can. Bar Rev. 877.

<sup>18</sup> *Ibid.*, p. 543.

cism), and this author recognizes that industrial designs are inherently suited to protection by copyright.<sup>20</sup>

The basic distinction between the universal character of ideas (some of which may be "protected" by patents) and the unique quality of the personal expression of these ideas as original works is a central fact in the problem of protecting industrial designs.

#### IV. *General Principles for a New Design Law*

If we recognize that there is a clearly defined aspect of product designing that is fully analogous to artistic creation, and that this aspect can be best protected in the same way as artistic works are protected by copyright, we have a new general approach to the question of the protection of industrial products. Instead of thinking of the patent law as granting broad or narrow protection for all the functional features of the product, and the design law as the proper source of protection for the surface, decorative or non-functional aspects, we can see the patent law as offering more or less broad absolute protection for the novel functional ideas expressed in the product and short-term copyright-design law as protection against copying for whatever is original in the over-all final form of the product.

The copyright-design protection would be particularly valuable where there is no broadly new idea that could be properly protected by a patent. In such cases, the only protection now generally sought is that given by narrow "picture" claims in a patent of doubtful validity. Like copyright, such claims in effect can give protection only against direct copying, but they affect only those who have insufficient courage or funds to attack the validity of the patent, and they cannot prevent anyone from taking only some of the claimed features, and modifying the others.

Under an adequate system of copyright-design law, a registration could be obtained which would validly give complete protection against the copying of some or all of the original features, whether or not the absolute protection of a patent could also be obtained. There would be less pressure on patent attorneys to file applications on obviously unpatentable inventions and less pressure on patent offices to grant narrow picture claims as the only available reward for novel but not really inventive features.

For instance, consider the design of a new dictating machine, expressing these three basic ideas: the idea of using a certain

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<sup>20</sup> *Ibid.*, p. 895.

known circuit arrangement, an idea for a turntable drive covered by a certain patent, and the idea of making the whole thing about the same size as a standard book. Mere reduction in size is not patentable, and the idea of making the machine this size and shape could not be protected by a patent. But proper copyright-design protection on this machine would prevent anyone from copying everything that was original in the designer's personal organization of the design features, including any original arrangement of standard components that made the size and shape possible. At the same time, it would *not* prevent another designer from using the same circuit, the same patents and all the other ideas expressed in the device and contributed by engineers and electronic experts, so long as the other designer devised or chose the components himself and arranged them himself and designed his own casing to fit them.

Automatically, what are sometimes called "purely functional features" would be excluded from the protection. For it is well established that copyright does not subsist in characteristics of a work that are the natural, mechanical consequences of the ideas, facts, methods or principles used or expressed in the work (like the individual words and idioms in a language). Such inevitable or necessary characteristics, by definition, are not original contributions of the author, artist or designer, as the case may be.

Actually, there is no such thing as a purely functional design feature: the assumption that a design feature can be "solely dictated by function" is one of the fallacies on which the British type of design law is based. Only combinations of things and relationships between them—of the kind that are defined in reasonably broad patent claims—are *dictated* by function (which is why a patent claim can *protect* a functional principle by *claiming* the combination or relationship dictated by the principle). Such combinations and relationships, being principles or ideas, are clearly beyond the scope of any of the established kinds of design law: Mr. Justice Luxmoore made this clear, in *Kestos Ltd. v. Kempat Ltd. and another*,<sup>21</sup> by quoting with approval from *Copyright in Industrial Design* (1930) by Russell-Clarke:

To say that a shape is to be denied registration because it amounts to a mode or principle of construction is meaningless. The real meaning is this, that no design shall be construed so widely as to give to its proprietor a monopoly in a mode or principle of construction.

What is more important—and difficult—is to ensure that a

<sup>21</sup> (1936), 53 R.P.C. 139, at p. 151.

projected design law shall also exclude from protection the kind of features—shape, size, material, arrangement—that *can* be altered by a designer without destroying the functional combinations and relationships, but that arise naturally, without requiring the designer to use any original labour, skill or knowledge, whenever an article is manufactured in a routine way so as to use a particular combination or relationship. One obvious example is the circular or cylindrical shape of some parts that are machined, for which the only reason is convenience in machining on a lathe. We can call these “picture-claim features”, for the limited value of a “picture claim” in a patent rests on the fact that these features can be varied only through the exercise of special effort and expense.

To distinguish “picture-claim features” from the design features that deserve protection cannot be done properly by direct definition. The British Registered Designs Act attempts without success to distinguish them by defining a design as not including features of shape or configuration that are “dictated solely” by the function the article has to perform.<sup>22</sup> The United States design patent law likewise fails to solve the problem by resorting to the foreign concept of “invention”.

The significance of “function” in design (and indeed in all art) has been stated by an authority on the fine arts:<sup>23</sup>

It has been said that the fine arts have no purpose and the applied arts have no meaning. The ideal art needs no designation save that of functional. By function, purpose and meaning are so interrelated that the one cannot exist without the other. . . . I prefer the term ‘functional design’, because such a designation implies that function and structure should govern all things in which decoration has a part. Functional approach may be applied to the ornamentation of a box of bath powder as well as the enrichment of a wall in a supreme court chamber.

In typical traditional designs, the distinction between the “picture-claim” features and the decoration or ornamentation was fairly easy to determine by a direct examination. But in the majority of contemporary designs the relationship between the original contribution of the designer and the natural results of the mechanical principles and production techniques involved in the design is a very subtle one. Teague describes this relationship as follows:<sup>24</sup>

<sup>22</sup> (1949), c. 88, s. 1(3).

<sup>23</sup> Richard Adams Rathbone, *Introduction to Functional Design* (New York, McGraw-Hill Book Co., 1950) p. x.

<sup>24</sup> *Ante* footnote 4, at pp. 177-178 (*italics added*).

A competent designer instinctively chooses a theme, or leitmotif, for a given structure, and allows it to influence all his choice of form and line within that structure. His theme usually is suggested by the problem itself: he abstracts it from the object with which he must deal, from its most essential shapes, its structural necessities, or its functional purpose, and thus it has significance and authenticity. Often his selection is not made by a careful balancing of various possibilities, but by a quick instinctive perception of what is most vital, most characteristic among these possibilities. *In many instances structural or functional necessity determines his choice of theme without his option*, and his job is simply to refine and clarify and repeat the forms and lines that are offered him by his subject.

The problem of defining the original features of this kind of design—the features that deserve protection because they were contributed by the original labour, skill and knowledge of the designer—is too complex to be solved by studying or comparing features of appearance and trying to label some of them “functional” and others “non-functional”. Instead, it is necessary to take into account the process in which the design features were derived, whether as a natural result of what Teague calls a “theme”, which is itself determined by structural or functional necessity, or by the original labour, skill and knowledge involved in choosing a “theme and following it out creatively”.

The answer of course lies in copyright, which by long-established rule cannot subsist in any feature of a work which does not result from *substantial original labour, skill and knowledge*. On this principle, “picture-claim features” are automatically excluded, because by definition such features arise naturally without original work.

Thus similarities between a registered design and an alleged infringement in respect of “picture-claim” features would not even raise a presumption that there had been copying, for by their nature the features will be recognized by any person “skilled in the art” as being the natural result or expression of the ideas or principles involved in the project rather than as being original contributions of the designer.

On copyright principles, the right of each creative worker to do original work without interference (subject to the rights of others under the patent law) would thus be guaranteed, and the only practice that would be interfered with is one that is already regarded by reputable manufacturers as being contrary to ethical business principles: deliberate piracy of original design features.

The copyright-design law would rely on established copyright wording and jurisprudence to define infringement. An original

design made without reference to a registered design could not be an infringement. A variation design, whether itself registered or not, would be an infringement if it involved a substantial use of the features of the registered design in which copyright subsisted. Thus the determination of infringement would not depend (as it does now) on a decision painfully and arbitrarily made by directly comparing the two designs (which is really a "trade-mark" test)<sup>25</sup> but rather on a meaningful determination of where the alleged original contribution was to be found, and whether it was wrongly taken in whole or in part by the alleged infringer.

On copyright principles, the onus is on the plaintiff to show that the defendant has made use of the original features of the protected work.<sup>26</sup> In most cases the design process is such a complex one, with so many interrelated factors, that if the defendant actually copied the registered design it would be relatively easy to satisfy this onus. Careful questioning would soon show that a copier, not having experienced the creative process, had no idea of the real purposes and reasons involved in the various design features.

Conversely, if the alleged infringer were actually innocent, his defence could be based on his own statement of the process of creating his design, for he would be able to explain convincingly how the similarities to the registered design occurred without use being made of the features of the registered design, for instance, as the natural consequences of the method of manufacture. Under the present British Designs Act it has been held that this logical defence is not available: the question of infringement is to be "judged solely by the use of the human eye";<sup>27</sup> "it is not the task of the Court to determine aye or nay as a matter of fact, did the author of the alleged infringing design make use of the registered design?"<sup>28</sup> This strange and unreal approach presumably is the law in Canada also.

#### *V. Recommendations for Specific Provisions in the Relevant Statutes*

##### *Copyright Act*

The Copyright Act now defines an "artistic work" in section 2(b)

<sup>25</sup> *Ante* footnote 8, at p. 282, where Mr. Justice Farwell actually refers to the "possibility of confusion" as a criterion for determining design infringement.

<sup>26</sup> *Ante* footnote 9, at p. 119.

<sup>27</sup> *Marsden Manufacturing Co. Ltd. v. The Vono Company* (1934), 51 R.P.C. 282, at p. 287.

<sup>28</sup> *Ante* footnote 8, at p. 279.

as including "works of painting, drawing, sculpture and artistic craftsmanship, and architectural works of art and engravings and photographs". The definition seems to be sufficiently broad to cover what we generally regard as "industrial designs", that is, designs of useful articles that are *usually* "intended to be used as models or patterns to be multiplied by any industrial process" (to use the words of section 46(1) of the Copyright Act). This conclusion is reinforced by the very fact that section 46(1) was apparently regarded by the drafters of the statute as being necessary to remove such articles from the scope of the Copyright Act. The first step in achieving proper protection for such articles, however, might be to amend the definition section, 2(b), so as to remove any doubt that it does cover them.

This might be done by adding the words "and designs" after "photographs" (deleting the two earlier occurrences of the word "and"), thus making section 2(b) read:

'artistic work' includes works of painting, drawing, sculpture, and artistic craftsmanship, architectural works of art, engravings, photographs and designs.

The word "design" must then be defined.

The essence of the distinction between the articles that should be protected as designs and "works of painting, drawing, sculpture and artistic craftsmanship" lies in the fact that such articles are inherently *useful* in a functional way. Thus they are subject to industrial and commercial dealings so extensive, complex and influential (in contrast with trade in most of the ordinary subjects of copyright) that ordinary copyright protection, not requiring compulsory registration and having a term of many years, would almost surely have undesirable consequences.<sup>29</sup> The test in section 46 for an industrial design "used or intended to be used as a model or pattern to be multiplied by an industrial process" is both too broad and too narrow—too broad because it covers reproductions of works of art, like prints of paintings and photographs; too narrow because in some circumstances it will not cover functionally useful articles that can be reproduced at any time by an industrial process—if they have not yet been reproduced in this way and if the designer had in the beginning no intention to reproduce them industrially. For instance, a chair that the designer intended, at the time he designed it, to be a single custom-made model should still be regarded as a design, and it should be registrable whenever it is produced industrially.

<sup>29</sup> *Ante* footnote 19, at p. 895.

A suitable definition for "design" that parallels the definition of other "artistic works" in the Copyright Act would be:

'Design' means any article having an inherent useful function and includes a drawing, model or prototype for a design.

It is also advisable to distinguish what we may call a "finished industrial article" (to adopt an expression used in the British Registered Designs Act) from a design that is merely in the planning stage or that has been made only as a custom-made prototype or model. Industrial production of the design by machinery should be regarded as a constructive "publication", after which the only protection for the finished article would be registration. It would not be necessary to remove a "published" article from the scope of the Copyright Act, but merely to provide that after "publication" industrial reproduction by others (as a "finished industrial article") would not be infringement of the copyright. Thus the owner of the copyright would have to seek protection against such industrial copying by registration under the copyright-design act, but he would still be protected under the Copyright Act against non-industrial copying. For instance, registration would not be necessary to prevent someone from making a single hand-woven copy of an original fabric, or a custom-made copy of a piece of furniture. This plan is very similar to the one recommended in paragraph 250 of the 1952 Report of the British Copyright Committee.<sup>30</sup>

A "finished industrial article" could be defined as "a design that has been produced in quantity by a machine or an industrial process". And the present section 46 might be replaced by this section:

46. It shall not be deemed to be an infringement of copyright in a design for any person to produce or reproduce the design or any material part thereof as a finished industrial article, if such person proves that the design has previously been produced or reproduced as a finished industrial article by, or with the consent or acquiescence of, the owner of the copyright in the design.

### *New Copyright Design Act*

These would be all the changes that would be needed in the Copyright Act itself, but the same concepts and definitions should be carried over into the copyright-design statute. In fact, by suitable wording, it might be possible to avoid any changes in the

<sup>30</sup> Report of the Copyright Committee (London, Her Majesty's Stationery Office, 1952) pp. 92-93.



definition section of the Copyright Act. In any case, the new statute should so far as possible avoid using legal language and legal concepts that are not already found in the Copyright Act. The intention should be to draw on established copyright precedents and jurisprudence for the interpretation of the new statute, and this can best be done by using the established language of copyright legislation.

There is, however, one more concept that should be defined in the new copyright-design statute, namely, the concept of "industrial design". This concept, narrower than "finished industrial article", would correspond to the concept of "invention" in the patent law and would mean "a finished industrial article in which copyright subsists" (under the provisions of the Copyright Act). This would be the kind of "design" that could be registered.

Thus the new statute would begin with the three definitions: "design", "finished industrial article" and "industrial design". It should then provide that "a design shall be registrable if it is an industrial design, and the registration shall give the registrant *the sole copyright* to produce or reproduce the design or any material part thereof as a finished industrial article".

And this section would define infringement in the same manner as section 17(1) of the Copyright Act:

An industrial design registration shall be deemed to be infringed by any person who, without the consent of the registrant, does anything the sole right to do which is by this Act conferred on the registrant.

All *remedies for infringement* must be conditional on *proper marking* of registered articles (although failure to mark should not affect the validity of the registration). The governing principle should be this: it is safe for anyone to copy, in good faith, any *unmarked* industrial article. This principle can be expressed by the following section:

Where proceedings are taken in respect of the infringement of an industrial design registration, and the defendant in his defence alleges that he was not aware of the existence of the registration, the plaintiff is not entitled to any remedy in respect of the infringement if the defendant proves that at the date of the infringement he was not aware, and had no reasonable grounds for suspecting that the design was registered and that one or more copies of the registered industrial design to which he had access at the date of the infringement had not been duly marked with the symbol (D) and the year of the registration.

Furthermore, the new act must contain safeguards against any possible adverse effects on retail and wholesale dealers and importers. Assuming that the new design law is effective and com-

prehensive, the number of protected articles might be expected to increase considerably. For a time at least, this might increase the number of allegations of infringement. If dealers and importers were liable under a provision like section 17(4) of the Copyright Act for selling or offering for sale designs known to infringe a registration, the burden on retailers as a result of claims for infringement might well become too great. Even to provide that dealers would not be liable except on purchases made of infringing articles after written notice of the alleged infringement would not be a satisfactory safeguard. The scope of some business operations is such that the problem of investigating the validity of such claims, and effectively communicating a list of prohibited purchases to a large number of buyers of goods might possibly be a serious burden. It is to be expected that, once a good copyright-design law becomes established, there will be very few infringements, fewer than under the present law, but it is important to avoid even a possibility of prejudicing a particular section of the public.

Thus, instead of a provision like section 17(4), there should be provisions somewhat as follows:

An industrial design registration shall be deemed to be infringed by any person who sells or lets for hire, or by way of trade exposes or offers for sale or hire any design that to his knowledge infringes the registration or would infringe the registration if it had been made in Canada, if (a) he has purchased or imported the design after receiving a certified copy of a court order forbidding some person from manufacturing or selling the design; (b) upon the request of the proprietor of the registration he refuses or fails to disclose promptly the source of his purchase of the design; or (c) if he induced or acted in collusion with a manufacturer to make or an importer to import the design, provided that purchasing or giving an order to purchase in the ordinary course of business shall not of itself constitute such inducement or collusion.

An industrial design registration shall also be deemed to be infringed by any person who imports for sale or hire into Canada any design that would infringe the registration if it had been made within Canada, after receiving personal written notice that the design would so infringe.

The owner of copyright in any design could apply for registration of the design either before or within a short time (say six months) after the design was first produced as a finished industrial article. If the application were made *before* the design was put into production, the registration would not be granted until the applicant filed a "declaration of manufacture" stating that the

design had been produced as a finished industrial article and giving the date and place of such constructive publication.

The term of copyright protection after registration should be limited to a relatively short period. A term of seven years from the date on which the design was first produced as a finished industrial article would probably give the manufacturer sufficient time to benefit from his investment in the design, based on the present average rates of product obsolescence.

The new act should provide for compulsory licensing, to ensure so far as possible that each registered design would be made available to the public on reasonable terms by manufacture in Canada.

The kind of protection granted by this proposed statute has an appealing simplicity, because the thorny question of novelty need not be considered, although, as we shall see, a simple form of examination to locate *identical* prior registration would be desirable. It is not even necessary for the registration to define what is original or "disclose" the design. A disclosure is not needed because ignorance of the design is an excuse: it means that there was no copying. Furthermore there is no absolute monopoly to be "paid for" by a full disclosure to the public. A definition of what is original or novel is not needed because what is not *original* was by definition copied by the registrant itself, and therefore is as available to the public for copying as it was to the registrant, while what is not *novel* is by definition also available to the public for copying (whether or not it represented original work by the registrant, who may never have been aware of the existence of a similar old design).

The registration therefore would only require *identification* of the article that is not to be copied. Of course, the article should be marked to indicate to the public that it is protected, but there must also be an official record demonstrating that the owner of the registration has conformed to the formal requirements with respect to that particular article. The full identification in the registration would normally include one or more photographs and a conventional trade description with any model numbers that are applicable, the date of the original commercial production being recorded as the date of the registration.

## VI. Examination of Applications

Although any applicant who conformed to the formal requirements would be entitled to registration, without reference to the

question of novelty or originality, in practice there should be a simple kind of examination to screen out obviously improper applications and to make the register of designs as informative as possible. The examination should be based on an index of well-known published designs of various countries as well as designs actually registered. We already have the Design Index of the National Industrial Design Council, and this should be added to the registrar's index. The problem of recording and indexing the more important published designs so that skilled searchers can find them easily and speedily would be a reasonably simple librarian's job.

To complete the record of each application, the registrar would record any similar designs found in his search. In the rare case where he found a design that seemed to be identical, the applicant would be required to file either a brief statement pointing out a distinction between the designs, or a statement that the design sought to be registered was original, and briefly describing, with documentation if possible, some of the circumstances leading up to the creation of the design tending to show that the applicant's design was made without reference to the earlier one.

For search purposes the photographs or other illustrations in the applications should give a reasonably clear indication of the outer appearance of the article, so that if registration were later sought for the same article, or one that was identical in appearance, it would be recognized by a searcher as being the same. Of course, if there were design differences that did not appear from the photograph, the later applicant should have an opportunity to point this out and so obtain registration on that basis, when the earlier registered design was cited by the registrar.

The effect of the examination would be to provide a warning to the public when there is actually no *novel* material and so originality is in doubt, or when the original *and* novel material is not apparent from a comparison with an earlier published design (as might be the case with internal details). Thus whenever an apparently identical earlier design has been located by the registrar, the material in the file would in effect either: (a) demonstrate to the public that the registration had little real value (except to support a "registered" marking); or (b) clarify where its originality lay.

This kind of examination would prevent abuse of the design law and would accustom the business community to it with the least possible dislocation, while building up, at low cost, a record

of published designs that would be of great value to industry. It would not delay registration appreciably and it would not result in the refusal of applications except in extreme cases.

Without an examination of this sort, deliberate re-registration of designs after the first registrations had expired, so as to extend the rights to apply the "registered" markings, would put in doubt the validity of every registration, and force interested persons to search the indexes each time the value of a registered design became a factor in dealing with it. In such cases, as well as where registrations were obtained for extremely minor variations in earlier designs—designs that could be freely copied if they were brought to the notice of the public—the registration should bear some notice of the limited value of the registration so as not to impose on the public too great a burden of searching.

To take an example: suppose an applicant wishes to register a textile design, consisting of a pattern printed on silk, when a prior registration by the same applicant is for the same pattern printed on cotton. This would be one of the few cases where a registration could be refused on the ground that the contribution made by the designer—merely changing the material—is too obviously slight for copyright to subsist in it. The existence of this kind of case would in itself justify an examination procedure. Of course, if the applicant is *not* the same as the registrant of the earlier design, and he files material tending to show that he made his silk design without reference to the cotton design, copyright principles would entitle him to a registration in any case. But of what value would the registration be when it shows on its face that it differs from the earlier one only in an obviously non-copy-rightable change in material?

But with no examination the silk design could be registered even if there were many earlier registrations of the same pattern printed on silk or other fabrics. All but the first one, even if valid, would be useless if this fact were generally known. But no limitation would appear in the subsequent registrations, and a member of the public would have to find a sample of the material made under the first registration, or make a search of the indexes, to establish the true facts and confirm his right to apply the pattern to any material. The examination would eliminate this incidental burden on the public.

## VII. *Conclusion*

It is generally agreed that the Industrial Design and Union Label

Act is obsolete. There is no general agreement on the question whether the act should be replaced by a wholly new act or should merely be amended in matters of detail so as to overcome its worst weaknesses. But a piecemeal amendment of the act would not overcome the basic incompatibility between the principles on which it is based and the actual thing that needs to be protected—the designing process that is open to piracy under the present laws except in unusual circumstances. To protect this designing process properly, a design law must have these characteristics:

(a) it must protect one man's contribution of original labours, skill and knowledge, but must in no way interfere with another man's expenditure of original labour, skill and knowledge for the same purpose;

(b) thus the protection should not extend to any design features that are the natural consequences of the ideas and principles involved in the design process;

(c) the extent of the protection should be related to the extent of the original contribution, quite apart from the novelty, artistic quality or economic value of the work produced by that contribution;

(d) the basic legal concepts involved should be so far as possible established ones derivable by simple analogy from decided cases and they should agree with the practical concepts of designers and manufacturers, so that the courts will be guided by the legislation to understand and take account of the practical problems associated with the creation of the works protected;

(e) the right to registration should not be dependent on novelty and an alleged infringer should not have to overcome a presumption of novelty; the registrant should have the onus of proving that use has been made of the original features of his design.

All these objectives are inherent in the principles underlying the Copyright Act and in British as well as Canadian copyright decisions. Thus the direct application of copyright principles in a new design act would achieve these objectives automatically.

On the other hand, it is impossible for the courts, no matter how sympathetic they may be to the need of the manufacturer for satisfactory design promotion, to provide the necessary protection within the framework of the present Canadian, British or United States statutes, however extensively they may be amended in details. The distortion of basic principles that would be required for such a result is too great.

Under any new act that gave promise of better protection, it is certain that there would be an increase in the number of worthwhile design registrations. Progressive manufacturers who do original design work might register almost every new product they produced, and the feeling of security against copying that the registrations created would tend to increase the amount of capital invested in original designing. Furthermore, the existence of the registrations would tend to reduce the amount of non-original work and this again would tend to stimulate original design work.

Where a reputable manufacturer wished to turn out an original or an adapted design, he would be free to follow the usual practice of studying competing products, and adopting any new ideas in them that are not patented, without copying the design features that his competitors have developed to embody these ideas. The existence of copyright-design registrations on the competing products would not interfere with this type of original work. Thus "trend" ideas—like the "wrap-around" look in automobile windshields, or the "new look" in dress design—could not be monopolized, but each designer's version would be protected.

Because of the ease and frequency of registration, manufacturers, dealers and the public would come to regard the fact of registration as routine and not as itself suggesting that a registered design is more than partly original. Thus one disadvantage of registrations under the present law, that they lend themselves to harassment of potential infringers because the very fact of registration is a presumption that the registered design is novel, would be eliminated. The onus on the copyright-design registrant to prove that use had been made of the original features of his design would strongly contrast with the present requirement that the registrant merely has to place his registration on record to put a heavy onus on his opponent of proving either non-infringement or invalidity.

And the retailer, protected against unproved claims for infringement, could ignore the question of design protection until he is served with a court order, and even then he could sell his stock on hand. The importer might be occasionally prejudiced if he did not keep properly informed on new designs, for once having been warned that the article he imported was an infringement, he might be faced with the necessity of cancelling unfilled orders already given, but this prejudice could be avoided by exercising reasonable care.

In a modern department store, there may be up to three hundred thousand different articles on sale. At present very few of them are registered designs. Even if the foregoing proposals for a new law were adopted, the majority of these articles would never be subject to design registration, either because they are not original or because the designs are of such temporary interest that registration would not be worth the cost. For the remaining articles, registration on those that are recognized as commercially unsuccessful designs would have no effect, because no one would wish to copy them anyway. Registrations would be of value only if they covered good designs on which a considerable amount of original work had been expended. This is the only kind of design in which copying benefits the copier, and it is the kind of design that should be encouraged. Copyright-design law would provide this encouragement, on the principles recognized nearly two hundred years ago by Mr. Justice Willes in the case of *Millar v. Taylor*:<sup>31</sup>

It is wise in any state to encourage letters, and the painful researches of learned men. The easiest and most equal way of doing it, is, by securing to them the property of their own works. Nobody contributes, who is not willing; and though a good book may be run down, and a bad one cried up, for a time; yet sooner or later, the reward will be in proportion to the merit of the work.

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## Objectives of Legal Research

For the professor of law, the problem [of electing between competing ways of applying his energies in the law] is not only how and what he shall teach, but how he shall spend his working day outside the classroom. Shall he find his chief satisfaction in the intellectual stimulation which comes from solving what is known as 'the neat case'? Or shall he undertake a pervasive inquiry into the ethical foundations of legal rules, knowing that the price of this inquiry will be the disappearance of 'the neat case'—for when rules are no longer treated in abstraction from their purposes, they cease to produce those neat antinomies which the lawyer delights to discuss with his colleagues, and the problem which seemed an intriguing test of juristic ingenuity dissolves into a prosaic question of choosing between competing ethical desiderata. What is the legal scholar's duty toward reform? Does he sufficiently prove his progressiveness by a willingness to construct tenable legal theories to support the reforms effected by judges too busy to explain adequately what they are doing, or is his role a more active one? Is it his duty to anticipate the future by giving legal form to emergent ethical values, or is he only a kind of intellectual scavenger whose function it is to clean up the conceptual debris left behind in the advance of the law? (Lon L. Fuller, *The Law in Quest of Itself* (1940) pp. 13-14)

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<sup>31</sup> (1769), 4 Burr. 2303, at p. 2335.