June 3, 2015

Want an Enforceable Industrial Design? Make it Smart AND Sexy

In industrial design, it pays to have it all. In a recent decision, the Federal Court of Appeal held that while a purely functional design does not attract protection (as per section 5.1(a) of the Industrial Design Act), an industrial design that has a functional aspect can still be enforced if the design is also visually appealing.

In industrial design, it pays to have it all.

In a recent decision, the Federal Court of Appeal held that while a purely functional design does not attract protection (as per section 5.1(a) of the Industrial Design Act), an industrial design that has a functional aspect can still be enforced if the design is also visually appealing.

The Plaintiffs brought an action for, among other things, infringement of an industrial design (the "Design")[1] related to a line pipe tray. For the uninitiated, the purpose of a line pipe tray is to support oil drilling pipes during disconnection, and to capture any residual fluids from the pipes.

At trial, the Defendant admitted that its designer used the Design as a model for its own product. The Federal Court noted that "an attempt to imitate is not an infringement of an industrial design unless the imitator is trading on the aesthetic features of a competitor's design" and held that the Design was functional in nature. The Plaintiffs appealed.

The Federal Court of Appeal took issue with the interpretation of section 5.1(a) as it was applied at trial, focusing on the fact that the prohibition only covers the features of a design that are dictated solely by a utilitarian function. The FCA held that design features can be both useful and aesthetic, and therefore functional features are not automatically excluded from protection.

The FCA also confirmed that when only infringement is in issue, not validity, there is no onus on a plaintiff to provide evidence as to the validity of the design in question.

Ultimately, the appeal was allowed in part and the question of infringement of the Design was sent back for redetermination.

Given the relative ease of obtaining industrial design registrations compared with patent protection, the FCA's

decision may result in an increase in popularity for the former, particularly since many of the same remedies available for patent infringement are available with respect to industrial design infringement, including injunctions.

Case: *Zero Spill Systems Inc et al v. Heide et al*, 2015 FCA 115

[1] . There are also several patents in issue and addressed in this case which are not discussed in this blog post.