The Copyright- Design Conundrum: An Inquiry into the Efficacy of *Sui Generis* Design Laws

by

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Abstract

There exists a legal gulf separating copyright from industrial design in that these laws appear to be protecting different kinds of subject matter. While copyright law protects pure artistic works such as paintings and sculptures, design law purports to protect artistic works that are industrially applied to mass-produced goods. Copyright law refuses to protect designs that are applied to mass-produced goods and this is the line separating copyright from design. The normative assumption remains that a *sui generis* design law effectively protects all designs. This thesis aims to establish that in many cases copyright and design protect similar subject matter and, more importantly, challenges the notion that a piece of art must lose the status of a *work*, and the designer the status of an *author* merely because the artistic work has been industrially applied.
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1 Introduction

The development of intellectual property laws has largely been historically and contextually specific.\(^1\) Several persuasive historical accounts suggest that a variety of prevailing policy considerations guided the enactment of distinct laws governing different intellectual endeavours.\(^2\) Each form of intellectual property is meant to fulfil a distinct purpose, and the scope of intellectual property rights is determined on this basis. The same justifications do not underlie the various forms of intellectual property.\(^3\) Although boundaries have been drawn to preserve coherence within the intellectual property framework, overlaps arise in a system that otherwise creates distinct realms of protection. It is possible for certain kinds of subject matter to tear through legislative boundaries and form protectable subject matter under more than one intellectual property doctrine.\(^4\)

Intellectual property laws allow certain overlaps to exist but disallow certain others. For instance, the Disney character Mickey Mouse has been protected both as an artistic work and a

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trade-dress. Although the protections offered by copyright law and trademark law apply differently to the same character, these rights are allowed to co-exist. On the other hand, there are other instances where the law does not permit the simultaneous enforcement of multiple intellectual property rights pertaining to the same subject matter. For instance, national legislations normally refuse to extend copyright protection to artistic works that are applied as designs to useful articles. The designer might still have recourse to design law, but the copyright in the design becomes unenforceable.

My purpose here is to specifically understand the legal gulf separating copyright from design. Intellectual property legislations do not always systematically exclude all kinds of overlaps. But the exclusion of design from the purview of copyright is particularly informative because I find that the separation of copyright from design is not one that pertains to subject matter. Design and copyright pertain to similar subject matter. Designs are defined as aspects of shape, configuration, pattern or ornament applied to a useful article that are solely judged by the eye. In other words, it is the features of aesthetic form that design laws protect, and not features of utility. I will elaborate with an example. If Coco Chanel made a drawing of a tweed suit on a piece of paper, this would indisputably be a copyrightable artistic work. If the same drawing was used to manufacture more than fifty suits, the copyright in the work would no longer be enforceable because the Chanel design has now been applied to a useful article (the suit). This is because copyright law employs a copyright exclusion that prevents the enforcement of the

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6 Copyright law protects the character for its expressive function while trademark law grasps its purpose as a source identifier. Nevertheless, these protections are allowed to coexist.
7 See Copyright Act, RSC 1985, c C-42, s 64.
8 Industrial Design Act, RSC 1985, c I-19, s 2.
copyright when a design (that is also copyrightable as an artistic work) is applied to a useful article that is manufactured in numbers greater than fifty. The application of the design through an industrial process denies a designer the status of the author. The author of the drawing might still be able to prevent others from reproducing the drawing, but the copyright does not prevent the making of the suit itself or the reproduction of the suit in any other material form. This severely limits the enforcement of the copyright in the underlying work. This strict separation was made on the assumption that a sui generis design regime would capture all forms of applied art and protecting them as designs.

The evaluation of a design is tied entirely to its aesthetic appeal, and separations within design law of form from function and of art from applied art have historically been problematic. Modern designs serve as a good example of overlaps. Designs can be artistic works, utilitarian inventions or source identifiers. While the law clearly excludes functional designs from the purview of the legislation, the restriction of designs to aspects of appearance has led to design law’s conceptual incoherence in several ways. Firstly, the historical evolution

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9 *Supra* note 7.

10 *Ibid* (it shall not be infringement of the copyright, “to reproduce the design of the article or a design not differing substantially from the design of the article by (i) making the article, or (ii) making a drawing or other reproduction in any material form of the article.”).

11 For a historical contextualization of design law’s inconsistencies, see Mark McKenna and Katherine Strandburg, “Progress and Competition in Design” (2013) 17 Stan L Rev 1.

12 G Dinwoodie, *supra* note 2 at 620.

of design law has been closely tied to the development of decorative arts. While the law still retains this understanding of artistic design, the current industry definition of design is much broader and refers to a conscious process of tinkering or problem-solving that may not even include aspects of ornamentation or surface decoration. Secondly, aesthetics, consumer appeal, functionality and indications of source are all potential components of a design. But the legal circumscription of a ‘design’ to its aesthetic qualities increases the severity of its overlap with copyright law.

When a design in which copyright subsists is applied to a useful article that is reproduced more than fifty times, mass-produced designs of this nature lose copyright protection. I will henceforth refer to this as the more-than-fifty rule. In essence, the industrial applicability of an artistic work warrants a different remedial scheme through a *sui generis* design legislation that requires designs to be registered and confers a monopoly of ten years thereafter. Common to the various national legislations that protect designs, is the notion that the mass production and consumption of useful articles to which designs are applied fundamentally distinguishes the designs from copyrightable artistic works. The Canadian Copyright Act also employs a form of terminable copyright through the more-than-fifty rule. I will establish that barring this aspect of industrial application, the current legal conception of industrial design pertains to what would otherwise be copyrightable works. I argue that the lack

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15 Wilkinson and Muhlstein, *supra* note 13 at 1-3

16 Commentators have observed that the number fifty is an arbitrary figure. The rule is intended to exclude mass produced designs from the purview of copyright. See William Hayhurst, “Intellectual Property Protection in Canada for Designs of Useful Articles” 4 IPJ 381 at 388.

17 *Industrial Design Act*, RSC 1985, c I-9, s3, s10.

18 *Copyright Act*, RSC 1985, c C-42, s 64 (2).
of a first principles justification for the legal separation of copyrightable artistic works and industrial design is the root cause of the design system’s problems.

The underlying normative assumption remains that the standalone designs regime effectively protects the designer’s rights and, at the same time, prevents her from double-dipping by enforcing rights under both copyright law and design law. As will be shown below, the legislative scheme protecting works of applied art is both inadequate and theoretically unsound. In this context, the scope of this thesis can be summarized as an attempt to theoretically examine the widely held view that mass-produced designs are legally separable from artistic works. A detailed analysis of the key provisions in copyright and design laws exposes some fundamental inconsistencies that are not only the reasons for, but also the results of, this legal separation of “pure” art from “applied” art.\(^{19}\)

The copyright-design overlap forces us to rethink some of the fundamental issues of intellectual property in artistic works. First, the current state of the law allows us to ask some foundational questions about *sui generis* design protection. There is an overarching theoretical problem in attempting to separate pure artistic works from applied artistic works: should the fact that an artwork is applied to a utilitarian object, deprive the maker of the status of author?\(^{20}\)

The intersection between copyright and design can arise in two ways: first, a work of pure art such as a painting can be industrially applied to a wall paper or a piece of fabric.

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\(^{19}\) This problem within the Canadian intellectual property framework has been identified by several commentators. *See example* David Vaver, *Intellectual Property Law: Copyright, Patents, Trade-marks* (Toronto, ON: Irwin Law, 2011), at 33-36; Wilkinson and Muhlstein, *supra* note 13 at 10; Tawfik, *supra* note 13.

Second, functional items such as door handles or hangers can incorporate artistic features. In both these cases, in its applied form, the piece of artwork loses protection under copyright law the moment fifty copies are made.\(^\text{21}\) In the first instance, the copyright in the pure artistic work remains enforceable but the copyright in its applied form becomes unenforceable.\(^\text{22}\) Both instances represent different ways in which art and industrial goods interact. However, in both instances, the question remains the same: why does the application of art to useful articles fundamentally change the legal status of the work and the legal status of the author?

Second, other kinds of practical concerns arise as a result of the separation between copyright and design. When the copyright in a design becomes unenforceable, the designer is left with one choice- to register the design under the Industrial Design Act whereby registration is compulsory to gain design protection.\(^\text{23}\) In the case where fifty copies are made in the absence of a registered design, the author risks losing both copyright and design protection. Since the threshold of originality (a prerequisite for the registration of a design) is higher than copyright level originality,\(^\text{24}\) artistic works that do not meet the higher threshold under design law may not be capable of being registered as industrial designs and simultaneously also lose copyright protection owing to the more-than-fifty rule. The additional administrative and financial burdens imposed by the design registration system become applicable only to those artistic works applied to useful articles industrially. The more-than-fifty rule has been widely accepted to be a rather arbitrary line.\(^\text{25}\) For instance, as David Vaver suggests, “a policy which seeks to draw a

\(^{21}\) *Copyright Act*, RSC 1985, c C-42, s 64 (2).

\(^{22}\) *Ibid.*

\(^{23}\) *Supra* note 17.

\(^{24}\) See *Clatworthy & Son Ltd v Dale Display Fixtures Ltd*, [1929] SCR 429 at 433 (Holding that, for a design to be original, there needs to be a substantial difference between the claimed design and prior designs.).

\(^{25}\) Hayhurst, *supra* note 16.
bright line between works appropriate only for copyright protection and those appropriate for design protection, and which seeks to ensure that cumulative protection is not available, necessarily requires complicated provisions and often arbitrary cut-off points.” The arbitrary legal divisions between copyright and design are a result of the theoretical problem outlined above. The lack of a clear foundational justification for the protection of designs in their present form amplifies the difficulties in separating design from other forms of intellectual property including copyright.

The industrial design system has by itself remained largely unexplored. The lack of a comprehensive historical account explaining why and how the need to enact sui generis design laws arose only sharpens this issue. Moreover, several national design laws have been left undisturbed for a long period, and even though the need for modernizing the legislation has arisen, focused legislative effort has never been made. Designs are uncomfortably seated in the cusp of trademark, copyright and patent law. In legal literature, pertaining to the copyright-design overlap, two distinct claims have been made thus far. First, there is a class of scholarly literature that suggests that sui generis laws better suit industrially applied art. They take into account the inadequacies of existing design laws and suggest that a systematic review of the industrial design regime could potentially help navigate the interface between copyright and

27 See DuMont and Janis, supra note 2.
28 Ibid.
29 McKenna and Strandburg, supra note 13 at 44.
30 See Daniel H Brean, “Enough is Enough: Time to Eliminate Design Patents and Rely on More Appropriate Copyright and Trademark Protection for Product Designs” (2008) 16 Texas IP LJ 325, at 379-381 (arguing that the design patent system should either be abolished or should be phased out and replaced with a system more akin to community design protection).
design.\textsuperscript{31} Second, a class of literature identifies the shortcomings of the sui generis design system, and favours the integration of applied art with the copyright model or the unfair-competition model.\textsuperscript{32}

I examine the copyright design overlap on three distinct levels with a view to identify the differentiation, if any, between a copyrightable artistic work and an industrial design. The distinction that I hope to find is not one that we can glean from the formal differences between copyright and design. On a deeper more fundamental level, I hope to find a rational explanation for why mass-produced designs lose the status of a work and the designer the status of an author.

First, I will examine the historical evolution of the legal conception of design, and the development of sui generis design laws. This exploration reveals the disjointed evolution of design law enacted primarily to address concerns pertaining to preservation of competition given that design laws were enacted as an immediate response to design piracy. I argue that the evolution of design law as an exception to the traditional forms of intellectual property has contributed to the lack of a first-principles justification for the protection of designs and to the fact that it is limited to artistic design as opposed to the modern industry conception of design.

Second, in the interest of truly understanding the normative goal that design laws purport to achieve, I will identify the differentiation, if any, between a copyrightable artistic work and an industrial design. Both on a conceptual and a doctrinal level, this section will establish that

\textsuperscript{31} Wilkinson and Muhlstein, supra note 13 at 10; Tawfik, supra note 13.

\textsuperscript{32} See Roy V Jackson, “A New Approach to Protection for the Designs of New Products” (1956) 38 J Pat Off Soc’y 449 at 449 (arguing that design patent protection should be converted to a system of “engineering copyright” or “copyright-design”), Henry D Williams, “Copyright Registration of Industrial Designs” (1924) 7 J Pat Off Soc’y 540 at 540 (arguing that the design patent laws are a “misfit” and have been “altogether insufficient”).
artistic designs are copyrightable works of authorship that would, in the absence of the more-than-fifty rule, be eligible for full copyright protection.

Third, I will analyse two important normative presuppositions that underlie the present *sui generis* design system. First, design laws operate on the assumption that all designs raise common competitive concerns. But, the realities of the marketplace suggest that the competitive concerns raised by the availability of automobile spare-parts are not the same as those that arise in relation to a Chanel tweed suit. Second, *sui generis* design law was enacted on the presumption that the anti-competitive concerns caused by extending full copyright protection to designs necessitated the creation of a pure intellectual property distinction between copyright and design. Because the *sui generis* design law was enacted to preserve competition, it does not create a distinct form of intellectual property subject matter on a more conceptual level in the same way that patent law does for inventions or copyright law does for works of authorship. It is important to address these assumptions in order to truly appreciate the copyright-design overlap on a deeper conceptual level.

Through this three-stage exploration of *sui generis* design laws I hope to establish two things: first, the current legal distinction between design and copyright is a formal one and not a conceptual one. Second, because the copyright-design distinction does not strictly pertain to subject matter, we need to reorient our current understanding of design. On the one hand, if preservation of competition is the main purpose here, we must ask ourselves if a *sui generis* law is the most effective solution to address anti-competitive concerns. On the other hand,

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33 I am aware that an element of competition policy always plays a role in the enactment of intellectual property law. But issues relating to the subject matter that each form of intellectual property governs are not necessarily dictated by competition policy. The inherent dignity of each form of intellectual property does not solely hinge on
considering that the current design law does not actually pertain to the modern conception of industrial design, we might benefit from re-evaluating the purpose of design law within the larger intellectual property framework and accordingly conceptualizing designs differently (so as to not limit them to artistic design).

its interaction with competition policy. For instance, the copyrightability of literary works is not determined by competition policy but is based on whether literary works are works that copyright law purports to protect. Questions regarding copyrightability arise prior to the involvement of competition policy.
2 A Principled Approach to Intellectual Property Overlaps

The elaborate legislations that create separate realms of protection do not provide for all conceivable forms of overlap. There is equilibrium in a system that recognizes the rights of creators in conjunction with a continually flourishing public domain.\textsuperscript{34} Intellectual property overlaps encourage creators to ‘stretch’ their monopolies by seeking to protect their works in ways the parliament may not have intended.\textsuperscript{35} Kirkbi’s attempt to extend its monopoly over its LEGO construction sets by asserting trademark protection after the expiration of its patent is an example of how overlaps facilitate this behaviour.\textsuperscript{36} It has often been suggested that this practice is likely to result in over-protection and thereby constrict the flow of knowledge into the public domain.\textsuperscript{37}

Any descriptive account of the current state of intellectual property law will unequivocally suggest that every form of intellectual property protects specific intellectual endeavours. However, the evolution of intellectual property laws has been disjointed at best.\textsuperscript{38} All forms of intellectual property are backed by different policy considerations, and have historically been traced back to specific developments that occurred at different points of time. For instance, while the origins of copyright law can be traced back to the invention of the


\textsuperscript{35} Vaver, supra note 3 at 144.


\textsuperscript{38} See Sherman and Bently, supra note 1.
printing press and the economics of the early publishing industry,\textsuperscript{39} the genesis of design law, arguably, lies in the intention to foster creativity in the market place. Although these laws have developed as if ‘hermetically sealed’,\textsuperscript{40} intellectual property laws often suffer from murky boundaries and deficiencies that arise as a result. The nature and purpose of the various forms of intellectual property, even to this day, are normally gleaned from their formal differences. In their preoccupation with the formal boundaries between these various forms, as Tawfik suggests, “contemporary law makers have avoided having to address the more profound metaphysical questions surrounding the immutable ‘essence’ of each body of law and whether there is or ought to be a coherent or comprehensive policy to bind them one to the other.”\textsuperscript{41}

It is my view that this very absence of a theoretical foundation for design law characterizes the problematic divide between copyright and design. The conceptual incoherence of design law, which is the main point of inquiry in this thesis, necessitates a deeper and more principled engagement with the purpose of design law as distinguished from other forms of intellectual property.

In my view, the principled approach of the Canadian Supreme Court in relation to intellectual property overlaps in recent times reveals an ideal manner of delineation between the various forms of intellectual property. The court’s decisions in \textit{Kirkbi}\textsuperscript{42} and \textit{Kraft}\textsuperscript{43} offer a

\textsuperscript{39} John Feather, “Copyright and the Creation of Literary Property” in \textit{A Companion to the History of the Book} 520 at 522 (Simon Eliot & Jonathan Rose, ed, 2008) (“Copyright, as we now understand it, is essentially a product of the age of printing. The early printers soon discovered a basic fact of economic life: that printed books would only be profitable if enough copies were sold, that they would only sell if the price was acceptable.”); \textit{See} Tawfik, \textit{supra} note 5.

\textsuperscript{40} I borrow this phrase from David Vaver. \textit{See} Vaver, \textit{supra} note 3.

\textsuperscript{41} Tawfik, \textit{supra} note 13 at 269.


profound jurisprudential viewpoint by which one form of intellectual property cannot be used to protect tangential interests that are legitimately governed by another form. I specifically refer to Justice Lebel’s opinion in *Kirkbi* and Justice Bastarache’s opinion in *Kraft* to identify instances in which the Canadian Supreme Court adopts a principled approach to overlaps. Although these approaches may not reflect the general view regarding intellectual property overlaps they strongly indicate the court’s intention to strictly adhere to the conceptual distinctions and justifications that underlie various forms of intellectual property. My purpose in using these examples is to establish that there are two prevailing ways to problematize intellectual property overlaps.

The first and the more prevalent approach is to rely on the anti-competitive concerns that overlaps cause, namely, the economic argument in relation to extended monopolies and reduced competition. But secondly and more importantly, in the court’s initial recognition of competitive concerns lies a more principled approach to overlaps. In *Kirkbi*, the court viewed the functionality principle and the passing-off claim through the lens of market competition. The overlapping trademark and patent rights unduly restrain free competition and must therefore be disallowed. In addition to this, Justice LeBel alluded to the “basic and necessary distinctions between different forms of intellectual property and their legal and economic functions.” In *Kraft*, Justice Bastarache builds on this proposition by touching upon the issue of legitimate economic interests. “The protection offered by copyright,” says Justice Bastarache, “cannot be leveraged to include protection of economic interests that are only tangentially related to the

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44 *Kirkbi*, at para 52 (“At the root of the functionality principle in European law, as in Canadian intellectual property law, lies a concern to avoid overextending monopoly rights on the products themselves and impeding competition, in respect of wares sharing the same technical characteristics.”).

45 *Ibid* at 37.
copyrighted work.”46 By refusing to protect tangential interests, the court offered a more principled view of overlaps generally. On this view, copyright law cannot be used to protect economic interests that would be within the exclusive domain of trademark law.

There is an underlying principled distinction between the various forms of intellectual property and the doctrines within them help maintain the inherent integrity of each form. A comprehensive examination of overlaps in intellectual property not only necessitates the understanding of boundaries but also requires a deeper engagement with the interconnectedness between the various forms of intellectual property.

Within this broad context of intellectual property overlaps design laws tend to be the most notorious because they seem to lack a clear foundational purpose. The extension of copyright protection to designs in early Victorian Britain or the later developed sui generis design laws were immediate responses to design piracy.47 This thesis is an attempt to analyse the design- copyright divide from the authorial locus of a designer. In our preoccupation with “copies” and their impact on industry we seem to have failed to evaluate the role of a designer as a creator and an artist.48 It is not enough to view design laws as a solution to design piracy. In a more principled manner, it is pertinent to answer the prior question of why the copying is wrongful in the first place. The Canadian Supreme Court’s nuanced view of the conceptual

46 Kraft, supra note 43 at para 83.
48 This, in essence, is also a rejection of the proposition ‘what is worth copying is worth protecting’. It is not a question relating to design piracy but on a more conceptual level I refer to the understanding of why and how designs must be protected in the first place. Designs cannot be protected just because they are “worth” something. See University London Press v University Tutorial Press, [1916] 2 Ch 601. For a detailed discussion on the relationship between copyrightability and value- generation, see Abraham Drassinower, What’s Wrong with Copying? (Harvard University Press, 2015).
underpinnings of the various forms of intellectual property provides a foundation on which to critically engage with the copyright-design separation.
3 The Mixed Heritage of Design Law: Artful Utility or Useful Art?

*Sui generis* intellectual property rights are created as a result of the inability of copyright, patent or trademarks regimes to singularly capture certain creations.\(^49\) Copyright law has historically protected two- and three-dimensional artistic works. On the other end of this spectrum is patent law that protects functional and useful articles. Colston and Middleton suggest that if copyright and patent occupy the opposite ends of a spectrum, design law seems to uncomfortably occupy the median state.\(^50\)

In Canada, the Industrial Designs Act protects the shape, configuration, pattern or ornament applied to useful articles judged solely by the eye.\(^51\) In other words, design law protects the appearance of useful articles and not the features dictated by utility.\(^52\) The application of design law, in its present form, rests on two presuppositions. First, design law does not protect functional aspects of designs. The policy underlying this principle is that it is not in the public interest to allow a designer to exercise monopoly over technical functions (which must be capable of being freely used by all).\(^53\) Second, design protection only extends to ornamental


\(^{51}\) *Industrial Design Act* RSC 1985, I-9, s 2 (“…shape, configuration, pattern or ornament applied to useful articles judged solely by the eye.”).

\(^{52}\) Ibid.

\(^{53}\) Orit Fischman Afori, “The Role of Non-Functionality Requirement in Design Law” (2010) 20:3 Fordham Int Prop, Media and Ent LJ 847, at 848 (“A key requirement for eligibility is that functional features of the design cannot receive protection. This requirement pursues an important public interest objective, “namely that a shape whose essential characteristics perform a technical function and [are] chosen to fulfill that function may be freely used by all.”)

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features of a design.\textsuperscript{54} Design law protects the shape of a penguin-shaped teapot but not the teapot itself. The current law presupposes that the ornamental design features are separable from the utilitarian features, and that the application of the ornamental design features clearly distinguishes artistic works from useful articles.

This confinement of design to matters of appearance creates other overlaps. The focus on the ‘appealing’ aspects of a design creates a possibility for designs to be protected as artistic works under copyright law or as distinguishing guises under trademark law. The Parliament’s attitude towards the copyright-design overlap specifically has been to keep the two regimes mutually exclusive. The 1988 amendment to the current S. 64 of the Copyright Act was enacted with a view to absolutely deny copyright protection to designs. Strong arguments were made in the Parliament in favour of this strict separation because certain applied artworks deserved a shorter term of protect owning to economic and competitive reasons-

"Full copyright protection is… life of the creator, plus fifty years. This is a very strong form of protection. It would be quite inappropriate and certainly not good for the economy to extend this type of protection for examples of work that would only receive the lesser protection under industrial design."\textsuperscript{55}

The 1988 amendment brought three important changes to this section of the Copyright Act. First, when copyright subsists in a design that is applied to a useful article, when fifty or more copies of it are made under the authority of the owner, to reproduce the design either by making the article or by any other material form is not infringement of the copyright in the

\textsuperscript{54} \textit{Ibid} ("The function of the article or device is covered by patent law, which establishes extensive thresholds in order to balance, on the one hand, creating incentives for the development of new inventions against, on the other hand, securing maximum benefits for the public. The aim of industrial design law, however, is not to encourage the development of new technologies, but rather to encourage the development of their external appearance.").

\textsuperscript{55} \textit{House of Commons Debates} (26 June 1987) at 7692 (Lynn McDonald).
Even though one might argue that the underlying drawing retains its copyright this is of limited practical significance because the law still permits the making of the article which the copyright in the underlying drawing cannot prevent. Second, there are some exceptions to the more-than-fifty rule that include a graphic or photographic representation applied to the face of a product, a trade mark or a label, or a distinguishing guise, material that has a woven or knitted pattern or that is suitable for piece goods or surface covering or a representation of a real or fictitious being, event or place applied to the product as its shape, configuration, pattern or ornament. In these cases design and copyright protection are available concurrently. Third, utilitarian or functional features were completely removed from the ambit of copyright law.

These rules are meant to indicate the bright line dividing copyright from design. The historical evolution of the pre-1988 legislation and case law in this regard reveals the policy considerations that motivated the divorce between copyright and design. It exposes not only the purely economic reasons for separating the two, but is also reflective of the arbitrariness of the copyright-design divide.

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56 Copyright Act, RSC 1985, c C-42, s 64 (2).
57 Copyright Act, RSC 1985, c C-42, s 64(3)(a) (a graphic or photographic representation that is applied to the face of an article, e.g., the graphic representation of a penguin on a t-shirt).
58 Copyright Act, RSC 1985, c C-42, s 64(3)(b) (a trade-mark or a representation thereof or a label, e.g., the shape of a CocaCola bottle).
59 Copyright Act, RSC 1985, c C-42, s 64(3)(c) (material that has a woven or knitted pattern or that is suitable for piece goods or surface coverings or for making wearing apparel, e.g., repeat pattern used on a wallpaper or flooring tiles, or a repeat pattern knitted as a sweater).
60 Copyright Act, RSC 1985, c C-42, s 64(3)(e) (a representation of a real or fictitious being, event or place that is applied to an article as a feature of shape, configuration, pattern or ornament, e.g., character merchandizing such as Mickey Mouse shaped salt-shakers or Popeye key chains).
61 Copyright Act, RSC 1985, c C-42, s 64.1.
3.1 The Evolution of Design Laws in Canada

A good starting point to grasp the difficulties associated with legislating on design is to understand the huge disparity between the modern industry conception of design and the limited artistic design that intellectual property law recognizes. The law does not protect industrial design per se but is limited to the aesthetic aspects of designs as applied to useful articles. This in itself is a highly limited conception of design and is a consequence of the disjointed evolution of design law. As will be shown below, the sui generis design law evolved as an exception for artistic designs and for many policy reasons these applied artistic works were not accorded full copyright protection.

The first formal scheme of protection was extended to designs in the Province of Canada in 1861 through an amendment respecting trademarks to provide for the registration of designs. Modelled primarily on the British design law at the time, this legislation extended “copyright” protection to designs. The general idea was that copyrighting, protecting and registering of new and original designs, necessitated a unique remedial scheme as they principally had only industrial uses. Although this legislation pertained to the registration and use of trademarks, the scheme of protection offered to what we now call ‘design’ was described as a copyright. A range of three to seven years of protection was granted under this legislation depending on the class to which the industrial application belonged.

62 Wilkinson and Muhlstein, supra note 13 at 1-7.
63 Ibid. See also, Suthersanen, supra note 49.
64 (1861) 24 Vict c 21.
65 Wilkinson and Muhlstein, supra note 13 at 6.
66 (1861) 24 Vict c 21, s 11.
67 Wilkinson and Muhlstein, supra note 13 at 5.
was considered appropriate for artistic works applied to mass produced products to be protected separately from artistic works that enjoyed full copyright protection.\textsuperscript{68}

The \textit{Trade Mark and Design Act} of 1868, the first legislation of the Dominion of Canada, replaced the Act of 1861.\textsuperscript{69} Under this legislation a uniform term of protection was applicable to all designs.\textsuperscript{70} This new design monopoly applied primarily to “ornamenting of any article of manufacture.”\textsuperscript{71} Thus, a legislative separation arose between the utilitarian aspects of an industrial product and its aesthetic appearance. Some commentators believe that the artistic trends in Britain at the time coupled with the influential Arts and Crafts Movement emphasized on the importance of ornamentation and decorative arts.\textsuperscript{72} Therefore, even though a clear distinction seemed to exist between the artistic form and the utilitarian function of a useful article,\textsuperscript{73} the continual focus on the artistic nature of designs did not do much to explain the true distinction between an artistic work and its applied form. The formal structures of the law dictated that applied artistic works must be protected separately, but the legal circumscription of a ‘design’ to its aesthetic qualities increased the severity of its overlap with copyright law. Even

\textsuperscript{68} \textit{Ibid} at 5-6.
\textsuperscript{69} 31 Vict c 55.
\textsuperscript{70} Wilkinson and Muhlstein, \textit{supra} note 13 at 5 (suggests that the uniform period seems to have been chosen purely for pragmatic reasons.).
\textsuperscript{71} \textit{Trade Mark and Design Act of 1868}, 31 Vict c 55, s 12.
\textsuperscript{72} Wilkinson and Muhlstein, \textit{supra} note 13 (explaining the impact of the Arts and Crafts Movement on early design laws and suggesting that the confinement of design to ornamental features can be attributed to this influence). The Arts and Crafts Movement of the late nineteenth century was influenced by William Morris, John Ruskin and others. For further discussion see \textit{George Hensher Ltd v Restawile Upholstery (Lancs) Ltd} [1976] AC 64, 90-92; Nikolaus Pevsner, Pioneers of Modern Design (London: Penguin Books, 1991) 12, quoting John Ruskin, The Seven Lamps of Architecture (New York, 1849) at 7.
\textsuperscript{73} This is not to say that the art-function debate had been resolved. But the genesis of design law as an exception to the pure arts seems to suggest that the boundary between copyright and design seems to be murkier than other overlaps because of their intertwined heritage. \textit{See} Suthersanen, \textit{supra} note 49.
to this day, design law has largely retained its pre-confederation iteration.74 While copyright developed for the protection of artistic and literary works, design law only evolved as an exception for artistic works applied to mass-produced goods.

As a separate law for the protection of designs emerged in the latter half of the 20th century, the legal gulf between the formal structures of copyright and design law widened. The 1921 Copyright Act in Canada removed the requirement for registration of copyright, and gradually the duration of protection given to copyrightable works increased.75 What initially began as a fixed term of protection starting from seven years, now had become lifetime of the author plus fifty years.76 The design legislations retained some of these formalities and thereby provided a stronger monopoly for a shorter period.77 The threshold requirements such as originality were higher for industrial designs as opposed to copyright where the bar for originality was much lower and the artistic or literary merits of the works did not play a role in ascertaining whether a work was copyrightable.78

The nature of the monopoly under both legislations is vastly different. Copyright law protects works for a long period but allows the use of copyrighted works in many ways and is

74 Tawfik, supra note 13 at 271.
75 The copyright harmonization that came with the 1908 revision of the Berne Convention required the life-plus model of copyright duration to be adopted. The reason for this, in part, is to be found in the strong influence which continental European legal doctrine has had on the development of the convention. This has always emphasized the property rights of authors in their creations, with the consequence that little objection has been made to lengthy terms of protection. See Sam Ricketson, “The Berne Convention for the Protection of Literary and Artistic Works: 1886 1986” (London, Eastern Press: 1987) at 320. Canada eventually adopted the life-plus model.
76 Ibid.
78 Ibid.
therefore not a strict monopoly like a patent monopoly.\textsuperscript{79} In contrast, design laws create a stronger monopoly in that they create an exclusive right to manufacture and sell an article to which a design in applied and to do any of these things without the authority of the owner amounts to infringement.\textsuperscript{80} The stronger nature of this monopoly necessitated a higher threshold for acquiring a design right. In its ‘applied’ form the artistic work needs to be original,\textsuperscript{81} result from some “spark of inspiration”,\textsuperscript{82} and differ substantially from earlier designs.\textsuperscript{83}

However, some judicial decisions in the 1980s interpreted the pre-1988 copyright exclusion narrowly. The erstwhile exclusion under S. 46 of the Copyright Act provided that a design \textit{capable of being registered} under the Industrial Design Act cannot avail copyright protection except where they were \textit{not intended to be multiplied by any industrial process}.\textsuperscript{84} Further, R. 11 of the \textit{Industrial Design Rules} provided that to be excepted under S. 46, the design has to be \textit{reproduced or intended to be reproduced} in numbers greater than fifty and the design must be applied to a class of articles mentioned under the rule.\textsuperscript{85}

\textsuperscript{79} \textit{Ibid.}
\textsuperscript{80} \textit{Industrial Design Act RSC 1985, c I-9, s 11(1).}
\textsuperscript{81} \textit{Industrial Design Act RSC 1985, c I-9, s 7(3), s 8.2.}
\textsuperscript{82} See Clatworthy & Son Ltd. v Dale Display Fixtures Ltd, [1929] SCR 429 at 433 (“It must be remembered, however, that to constitute an original design there must be some substantial difference between the new design and what had theretofore existed. A slight change of outline or configuration, or an unsubstantial variation is not sufficient to enable the author to obtain registration. If it were, the benefits which the Act was intended to secure would be to a great extent lost and industry would be hampered, if not paralyzed.”).
\textsuperscript{83} \textit{Bata Industries Ltd v Warrington Inc, (1985)5 CIPR 223 at 231- 232 (FCTD).}
\textsuperscript{84} \textit{Copyright Act, RSC 1970, c. C-30 s 46.}
\textsuperscript{85} “Rule 11 A design shall be deemed to be used as a model or pattern to be multiplied by any industrial process within the meaning of section 46 of the Copyright Act,
(a) where the design is reproduced or is intended to be reproduced in more than 50 single articles. . . and
(b) where the design is to be applied to: i) printed paper hangings; ii) carpets, floor cloths, or oil cloths manufactured or sold in lengths or pieces; iii) textile piece goods, or textile goods manufactured or sold in lengths or pieces; iv) lace, not made by hand.”
In Royal Doulton v. Cassidy\textsuperscript{86} and Interlego AG v. Irwin Toy Ltd\textsuperscript{87} R. 11 of the Industrial Design Rules\textsuperscript{88} was interpreted narrowly. The Federal Court was clear that the use of the word ‘and’ at the end of paragraph (a) meant that both paragraphs (a) and (b) of Rule 11 must be read conjunctively. This meant that a design had to be produced in numbers greater than fifty and be applied to one of the enumerated industrial articles in order to be excluded from copyright protection. Therefore, in Royal Doulton, considering that there was no mention of porcelain or china in these provisions, the court held that the floral pattern applied to chinaware was not intended to be a design even though it was produced in numbers greater than fifty. This narrow interpretation of the Rule caused some confusion.\textsuperscript{89} Consequentially, most designs remained copyrightable because they were not specifically enumerated under R. 11.

The more controversial case that exposed the flaws of the erstwhile copyright exclusion was Bayliner Marine Corp. v. Doral Boats Ltd.\textsuperscript{90} The plaintiff, Bayliner, had produced highly successful boats of two designs.\textsuperscript{91} The plaintiff claimed copyright both in the underlying drawings of the boats and the boats that were constructed using the drawings. The defendant purchased one boat of each type, made moulds based on each of the boats and produced more with the help of the moulds and thereby allegedly infringed the plaintiff’s copyright. In relation to the nature of works in question two arguments were made before the Federal Court (Trial Division). First, the plaintiff claimed that each boat was an “architectural work of art” which was

\textsuperscript{86} (1984), 1 CPR (3d) 214, 5 CIPR at 10.
\textsuperscript{87} (1985), 4 CIPR. 1, 3 CPR (3d) 476 at 486.
\textsuperscript{88} Ibid.
\textsuperscript{89} The Federal Court of Appeal in Bayliner Marine Corp. v. Doral Boats Ltd., ruled against this and held that paragraphs (a) and (b) do not have to be read conjunctively.
\textsuperscript{90} (1985), 5 CPR (3d) 289 (FCTD).
\textsuperscript{91} Bayliner, \textit{ibid} at para 1-3
then defined in the Act as “building or structure having an artistic character of design”.\textsuperscript{92} This meant that each boat, in and of itself, was a copyrightable work. Second, copyright was claimed in the underlying drawings of the structures of the boats.\textsuperscript{93}

Justice Walsh refused to accept the first argument by stating that neither is the boat a ‘structure’ nor is the boat a ‘work of art’ for the purposes of the definition of architectural works.\textsuperscript{94} However, problems arose while the second argument was considered. In respect of the drawing, Justice Walsh followed the same line of reasoning as the court in \textit{Royal Doultan} and \textit{Interlego}. The copyright claim was not impaired by S. 46 because the boat designs were not enumerated in paragraph (b) of Rule 11.\textsuperscript{95} Let us temporarily put the interpretation of the copyright exclusion under Rule 11 aside.\textsuperscript{96}

Justice Walsh pursued a more controversial line of thinking to support the copyright claim. Relying on the idea that the right of reproduction under copyright law can be in “any material form”, the three-dimensional imitation of a two dimensional drawing was deemed copyright infringement.\textsuperscript{97} Justice Walsh did not speak of the copyrightability of the boat drawings themselves. But in holding that “the weight of jurisprudence seems to support the proposition that copying an object made from a drawing, even if the drawing itself was not used,

\textsuperscript{92} \textit{Copyright Act}, RSC 1970, c C-30, s 2.
\textsuperscript{93} \textit{Bayliner} supra note 90, at para 24-25.
\textsuperscript{94} \textit{Ibid}.
\textsuperscript{95} \textit{Ibid} at paras 14-18.
\textsuperscript{96} This approach was rejected by the appellate court in \textit{Doral Boats Ltd v Bayliner Marine Corp}, (1986) 10 CPR (3d) 289.
\textsuperscript{97} \textit{Ibid} at paras 25-30.
constitutes an infringement,” he seems to have extended copyright to the boat drawings.\textsuperscript{98} Even though Justice Walsh agreed with the defendant that the drawings did not show how the finished boat would look he held, “when one looks at the plaintiff’s two boats in question it can be seen that they are derived from the drawings”.\textsuperscript{99} He finally held that the defendant did not copy the drawings but an intermediate object that came from these drawings.\textsuperscript{100} This analysis was entirely based on British case law that relied on the erstwhile British law governing this aspect of copyright.\textsuperscript{101}

This case was appealed to the Federal Court of Appeal.\textsuperscript{102} For the copyright exclusion to apply there is a primary requirement that the work be capable of registration under the Industrial Design Act.\textsuperscript{103} More importantly, absent the intention to be used as models or patterns to be multiplied by any industrial process, even if the work can be registered as such, the copyright exclusion will not apply.\textsuperscript{104} The appellate court found that the ornamental (non-functional) features that the boats possessed qualified them for design protection and thereby did not attract copyright protection. However, the court of appeal went further and excluded the boat drawings from copyright protection. The “plans” themselves are not a subject of copyright because they disclose designs capable of being registered under the Industrial Designs Act within the meaning of s. 46 of the Copyright Act.\textsuperscript{105} This conclusion, contrary to Justice Walsh’s view, renders the

\textsuperscript{99} Bayliner supra note 87, at para 31.
\textsuperscript{100} Ibid.
\textsuperscript{101} See British Leyland Motor Corp v Armstrong Patents Co. [1986] 1 All ER 850 (HL).
\textsuperscript{102} Doral Boats Ltd v Bayliner Marine Corp, (1986) 10 CPR (3d) 289.
\textsuperscript{103} Copyright Act, RSC 1970, c C-30, s 46.
\textsuperscript{104} Ibid. These requirements no longer apply under s. 64 of the current Copyright Act.
\textsuperscript{105} Doral Boats Ltd v Bayliner Marine Corp, (1986) 10 CPR (3d) 289 at para 23.
design drawing not copyrightable because its only function is the disclosure of an independent design. ¹⁰⁶

While making this line of argument, Mahoney J had the opportunity to consider a similar House of Lords’ decision in British Leyland Motor Corp Ltd v Armstrong Patent Co Ltd.¹⁰⁷ In British Leyland, a design drawing for an exhaust system was deemed to have been infringed by the defendant’s manufacture of an identical exhaust system through reverse engineering. Even though the exhaust system had no aesthetic qualities, the fact that it was derived from a design drawing meant that it deserved full copyright protection.¹⁰⁸ Consequently, no person could manufacture an exhaust system of a similar kind until the term of the copyright ended.¹⁰⁹ This is similar to Walsh J’s judgement at the trial court. Mahoney J, while disagreeing with this view, made a problematic observation in relation to the Leyland decision—

“That case dealt with the copyright in plans for automobile mufflers found to have been copied in much the same way as the boat plans in this case... However, in the nature of the mufflers, as they are not ordinarily exposed to public view, ornamentation was not a factor and the parallel exclusion from copyright protection was not in play.” ¹¹⁰

¹⁰⁷ [1986] 2 WLR 400.
¹⁰⁸ Ibid.
¹⁰⁹ This problem was recognized by the House of Lords, but found a different way to resolve it. Drawing upon previous authority which had held that the purchaser of a patented product does not infringe the patent by effecting repairs to it by virtue of an implied license for repair, held that the purchaser of a copyright product has the right to repair it and that such a right necessarily entailed the further right to acquire replacement parts in an unrestricted market. See Lord Griffith’s dissent in British Leyland. See also, Solar Thomson Engineering co Ltd v Barton [1977] RPC 537.
This meant that a design that lacked ornamental features could not be excluded from copyright protection because it was not capable of being registered as a design. To clarify this point further, purely functional designs could now avail full copyright protection because they lack aesthetic appeal and therefore do not qualify as designs (which would normally be excluded from copyright protection). The appellate court in *Bayliner* should have restricted itself to asking whether the boat design should be copyrightable.\(^{111}\) The distinction they drew between the purely functional design of the exhaust system and the aesthetic boat designs magnified the problem caused by the *Leyland* court. This is because it seems as if the court said that the only distinction between the boat drawings and the sketches of the exhaust system is that the boat drawings disclosed ornamental features but the exhaust system drawings did not. So if the same sketches of the exhaust system came before this court Mahoney J might have agreed with the House of Lords. This had the effect of allowing full copyright protection for purely functional objects, but a minimal design protection for a piece of applied art that actually qualifies for copyright barring its subsequent application to a useful article.

The *Bayliner* cases in fact revealed profound theoretical problems in effectively separating copyright from design. If Walsh J was right, it would be impossible to meaningfully separate the design of the boat from the drawing of the boat. If the underlying drawing could be used to prevent a third party from buying a boat and copying its features from that boat, a meaningful *sui generis* design right can never exist. Because most designs are almost always

\(^{111}\) Hayhurst, *supra* note 106 at 190–191 (“A draftsman may, by choice and arrangements of views, thickness of lines and other selected features, be entitled to copyright in this drawing, even though such features of his drawing are not reproduced when one makes a three dimensional object having the design that the drawing illustrates. This reasoning would at least preserve for the draftsman the right to prevent others from reproducing that which in his drawing, as distinguished from his design, qualifies as an artistic work.”).
based on an underlying two-dimensional sketch, a full copyright would always be enforceable in those designs. On the other hand, even though Mahoney J’s conclusions avoided some of these problems, as explained above, it did not do much to clarify the issue of drawings that disclosed purely functional objects. His conclusions limited the design right and excluded the copyright, but in suggesting that the illustrated object in the drawing determined its copyrightability, he avoided making a principled distinction between an artistic work and a piece of applied art. Neither interpretation of the copyright exclusion helps conceptually delineate artistic works from works of applied art.

Recalling the Coco Chanel example, on a conceptual level this problem persists. Even though the law makes the copyright in the design unenforceable, the delineation between the artistic work and the design remains unclear even under the current regime and raises the same questions that bothered the Bayliner courts.

### 3.2 The Parliament’s Response to the Bayliner Problem

In this context the 1988 amendment was purported to resolve some of these issues. First, by removing the requirement of intention the 1988 amendment drew a different boundary between copyright and design. Instead of requiring that the artistic work be capable of design registration the new law uses the phrase “where copyright subsists in a design”. This means that a suit for copyright infringement will not prevail as soon as more than fifty reproductions have been made of the design under the authority of the owner. Second, a separate exclusion was

112 See Suthersanen and Ricketson, supra note 20.

113 This problem was recognized by commentators immediately after the Bayliner case was decided. See Hayhurst, supra note 106 at 189- 193; David Vaver, “The Canadian Copyright Amendments of 1988” (1989) 4 IPJ 121; William L Hayhurst, “Intellectual Property Protection in Canada for Designs of Useful Articles”(1989) 4 IPJ 381.

114 Copyright Act, RSC 1985, c.C-42) s 64 (2).
made against features solely dictated by a utilitarian function. They can neither be registered as
designs\textsuperscript{115} nor as copyright;\textsuperscript{116} function is the sole domain of patent law.

While these amendments, along with the exemptions to the more-than-fifty rule,\textsuperscript{117} clarified the boundary between copyright and design, the bright line that this amendment drew did nothing to explain the conceptual nature of the copyright-design divide. The changes brought applied to the formal structures of copyright and design laws. Insofar as the amendment was a response to the Bayliner problem, it did not find, as Myra Tawfik suggests, the “immutable essence” of industrial design and its domain and purpose within the larger intellectual property framework.\textsuperscript{118} The more-than-fifty rule and the requirement that a design be applied to a useful article are distinctions that were carried over from the previous iterations of the legislation.\textsuperscript{119} In addition to this, the list of applied art exempted from the more-than-fifty rule are allowed to retain copyright and some opine that these extensive exemptions undermine the bright line between fine art and industrial design.\textsuperscript{120} Finally, a fundamental question remains unanswered: even as we accept that “copyright subsists in these designs”, what is the foundational justification to deny a designer the status of an author?

\textsuperscript{115} Industrial Design Act, RSC 1985, c I-9), s 5.1.
\textsuperscript{116} Copyright Act, RSC 1985, c C-42), s 64.1.
\textsuperscript{117} Copyright Act, RSC 1985, c C-42), s 64 (3).
\textsuperscript{118} House of Commons Debates (26 June 1987) at 7689 (Sheila Finestone) (observing that even though Bill C- 60 aimed to find an objective way to distinguish between copyright and design the bill returned the law to the ambiguity caused by the pre-Bayliner iteration of the law).
\textsuperscript{119} Tawfik, supra note 13 at 271. See also, Wilkinson and Muhlstein, supra note 13 at 5- 10.
3.3 Design Law as a Response to Design Piracy

The evolution of design laws suggests that the limited short-term protection granted to designers is to preserve competition in the market. It is believed that the competing interests of designers and consumers can be balanced better by allowing a shorter monopoly for industrialized products.\textsuperscript{121} Lara Kreigal’s persuasive historical account of design copyright in early Victorian Britain suggests that the British Parliament extended copyright protection to designs in 1842 after extensive lobbying from within various manufacturing industries, predominantly the calico manufacturers.\textsuperscript{122} She suggests that cultural practices and economic activity in nineteenth century Britain made copying of all varieties possible.\textsuperscript{123} The copyright debate, therefore, focused primarily on the prevention of copying in the market place.\textsuperscript{124}

The genesis of design laws in this manner was substantially intertwined with market competition.\textsuperscript{125} If designers claimed copyright extension to prevent design piracy, it also meant that their monopolies could not impede competition. Be that as it may, the modern trappings of copyright law, especially in Canada, are considerably different from the nineteenth century conceptions of authors and users. In fact, even the nineteenth century conception of art, design and utility has itself changed significantly.\textsuperscript{126} In no way do I intend to suggest that competition plays no role in intellectual property policy. But recalling the Canadian Supreme Court’s principled view in \textit{Kraft} that “each form of protection relies on some core normative notion”

\textsuperscript{121} Tawfik, \textit{supra} note 13 at 270.
\textsuperscript{122} Kreigel, \textit{supra} note 47 at 264.
\textsuperscript{123} \textit{Ibid} at 235.
\textsuperscript{124} \textit{Ibid}.
\textsuperscript{125} Wilkinson and Muhlstein, \textit{supra} note 13 at 5-10. \textit{See also}, Suthersanen, \textit{supra} note 49.
\textsuperscript{126} Suthersanen, \textit{ibid}.
must remind us that the locus of every intellectual property right is determined by a foundational purpose.\textsuperscript{127}

Statutory changes by themselves do not explain the legal conception of design. As in the case of any other law, statutory amendment is reflective of a pre-existing normative goal. Even though the Government clearly stated that the purpose of the 1988 amendment was to find a way to “to provide an objective means of determining whether an article can be protected by copyright, industrial design, both or neither”,\textsuperscript{128} the amendment only restated the more-than-fifty rule in the new section. This legal separation of copyright and design did not reflect the theoretical conception of design. It was seen as a convenient way to create a separate domain for design without having to answer the deeper foundational questions about the intellectual and creative process that led to the creation of a design and the status of the designer in this space. In *Samsonite Corp v Holiday Luggage Inc*\textsuperscript{129} the Federal Court remarked that “the essence of a good design is that there be a unity of form (appearance) and function.”\textsuperscript{130} The current design law in Canada still retains its pre-confederation iteration for the most part and it continues to be limited to artistic design.\textsuperscript{131} The legal leap we might need to take to embrace the modern conception of design necessitates deeper engagement with the concepts of ‘artistic work’ and ‘authorship’ under copyright law. The following section will attempt this.

\textsuperscript{127} *Kraft, supra* note 43 at para 82.
\textsuperscript{128} This was one of the stated objectives of the 1988 amendment. *See House of Commons Debates* (26 June 1987) at 7689 (Sheila Finestone).
\textsuperscript{129} 21 CIPR 286, (1988) 20 CPR (3d) 291 at 308.
\textsuperscript{130} *Ibid* at 308.
\textsuperscript{131} Commentators have identified the need for a revision of industrial design law and find that the current law is outdated. *See Tawfik, supra* note 13, Wilkinson and Muhlstein, *supra* note 13.
Ingenious Authors or Artistic Designers: Tracing the Contours of Intellectual Property in Design

Irrespective of where one chooses to draw the line, the principle distinction between copyrightable artistic works and designs lies in the application of the latter to a useful article. Notwithstanding the competitive concerns, it has proven considerably difficult to understand the distinction between artistic works and industrial design. Within the current law it is undeniably possible to juxtapose an artistic work and a piece of applied art, and suggest that the former is copyrightable but the latter might not be. The formal structures of copyright and design laws support this conclusion. However, in the interest of truly understanding the normative goal that design laws purport to achieve, we need to go further than this and ask the following questions: first, what is a work of applied art? Second, does design law necessitate the preponderance of artistic content? Finally, does applied art have the same communicative value as other copyrightable works of authorship?

4.1 Works of Applied Art: Where Design and Copyright Meet

Copyright subsists in every original literary, dramatic, musical and artistic work. In Canada, artistic works have been defined to include paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works. In *DRG v. Datafile*, a case that involved both artistic copyright and industrial design, the Federal Court was asked to decide whether ‘a series of colour coded labels’ was an ‘artistic work’. The labels in this case were designed to be affixed to file folders.

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132 *Copyright Act*, RSC 1985, c C-42, s 5.
133 *Copyright Act*, RSC 1970, c C-30, s 2.
to enable easy location of a file and also easy identification of any misfiling.\footnote{Ibid at paras 4-6.} It was claimed by the applicant that the registered copyright in these labels must be expunged because they do not qualify as ‘artistic work’ and are essentially ‘functional tools’ that copyright law does not protect.\footnote{Ibid at paras 7.} Reed J held that the labels were artistic works because-

“…the phrase “artistic work” is used merely as a generic description of the type of works which follow. It is used as a general description of works which find expression in a visual medium as opposed to works of literary, musical or dramatic expression.”\footnote{Ibid at para 15.}

In previous English and Canadian decisions such as \textit{Hensher,\textsuperscript{138}} \textit{Merlet}\textsuperscript{139} and \textit{Hay,\textsuperscript{140}} courts suggested different ways to ascertain whether a creation was in fact an ‘artistic work’. These approaches included identifying the intention of the creator, the perception of the public, and identifying the “artistic”-ness of the work. Reed J in \textit{DRG} rejected all these arguments because the use of the word “artistic” was not intended to be a test of copyrightability, but was a general description of works that are copyrightable.\footnote{\textit{DRG, supra} note 134 at para 15.} It was also found that the functional purpose of the label design did not deprive it of copyright protection.\footnote{Ibid at para 17.} Further, the same artistic labels were also found to be capable of being registered as a design.\footnote{Ibid at paras 31-39.} This clearly highlights the region of the overlap. While dealing with the conflict between function and appearance, Reed J

\textsuperscript{135} Ibid at paras 4-6.
\textsuperscript{136} Ibid at paras 7.
\textsuperscript{137} Ibid at para 15.
\textsuperscript{138} [1975] RPC 31 (HL).
\textsuperscript{139} [1986] RPC 115.
\textsuperscript{140} 27 CPR 132, 12 DLR (2d) 397 (Ont HC).
\textsuperscript{141} DRG, supra note 134 at para 15.
\textsuperscript{142} Ibid at para 17.
\textsuperscript{143} Ibid at paras 31-39.
had no doubt in declaring that the labels were functional.¹⁴⁴ But the labels were not solely
ddictated by function and were therefore not precluded from design registration. The appearance
aspect in design law, as Reed J held, was not about making the article more attractive, and did
not require courts to judge the artistic merit of a design.¹⁴⁵ The design must therefore be a visual
embodiment readily discernable to the eye of the beholder.¹⁴⁶

In principle, the juristic and legislative approach to the design-copyright overlap suggests
that artistic works that are “applied” in a manner so as to be useful do not lose their “artistic”-
ness. It is pertinent to note that the phrase “works of applied art” does not feature in the Canadian
Copyright Act. But the conclusions in DRG suggest that design and copyright law speak of
“artistic works” but the former refers to these works only in their “applied” form. In fact, all the
Berne member states are required to protect “works of applied art” which has been included in
the definition of “artistic works”.¹⁴⁷ How, then, did we establish a frontier between Van Gogh’s
Starry Night and Coco Chanel’s tweed suit?

Stephen Ladas characterizes this as a historical accident.¹⁴⁸ While the Paris Convention
on industrial property extended protection to industrial designs and models, a substantial number
of countries never protected designs.¹⁴⁹ A design never clearly became industrial property of the

¹⁴⁴ Ibid at paras 37- 38.
¹⁴⁵ Ibid.
¹⁴⁶ I borrow this phrasing from the Patent Commissioner’s decision in Re Application for Industrial Design
¹⁴⁷ Art. 2(7) Berne Convention for the Protection of Literary and Artistic Works (as amended on September 28,
¹⁴⁸ Stephen P Ladas, II Patents, Trademarks and Related Rights: National and International Protection (Harvard
¹⁴⁹ Ibid.
same nature because of its preoccupation with external appearance.\textsuperscript{150} The 1908 Berlin revision to the Berne Convention ensured that the term “artist work” also included works of applied art.\textsuperscript{151} But because the Berne Convention left it to individual member states to determine the manner in which these designs would be protected, most countries retained their \textit{sui generis} design laws that were first brought to force in the late 1700s and the early 1800s.\textsuperscript{152} By suggesting that designs can be industrial property or artistic works, the ambivalence in international instruments such as the Berne Convention, the Paris Convention or the TRIPS agreement does not do much to ameliorate the situation.\textsuperscript{153} But conceptually what this suggests is that the artistic nature of a work does not change in any manner so as to require a separate remedial scheme within the intellectual property framework. The beauty of copyright lies in the fact that it does not make a qualitative assessment of what constitutes art.

But it is extremely difficult to justify the creation of legal pigeon-holes without a clear normative goal. One might suggest that the undue restraint on competition due to long lasting monopolies sufficiently justifies the enactment of a \textit{sui generis} law. But this raises further questions about the nature of the \textit{sui generis} protection itself. For one, should the \textit{sui generis} protection mirror copyright or patent legislation? Second, what are the reasons to strictly separate design from copyright protection so as to completely disallow cumulative protection? Even before we find answers to these questions, the more-than-fifty rule and the application requirement appear arbitrary because the conceptual delineation between pure and applied art is unclear. While it is now clear that designs cannot be considered lesser forms of art, we must

\begin{flushright}
\textsuperscript{150} Ibid at 829.
\textsuperscript{151} Ibid.
\textsuperscript{152} Ibid.
\textsuperscript{153} Suthersanen supra note 49 at 5.
\end{flushright}
locate within the concept of ‘authorship’ a reason to preclude designs from copyrightability. The
shared aspect between copyright and design - the artistic work - either obscures a real difference
between the two or is evidence of the fact that there exists no difference between the two.

4.2 Works of Authorship: Separating the Starving Artist from the Fashion Designer

“Copyright continues to benefit from the image of the starving author in the
garret, whereas the designer sitting in front of a computer monitor in an air-
conditioned high-rise office tower rarely excites much parliamentary
sympathy.” 154

Thus far, almost every attempt to analyse overlaps generally and the copyright-design
overlap in particular, has focused on the commonality of the subject matter protected by the
two. 155 But the appreciation of the overlap both at a doctrinal and a conceptual level must also
account for the distinctive nature of copyright protection and find within the distinct domain of
copyright true compatibility with the designer’s creative output. The assertion that copyright
protects all literary, artistic and musical works is an empty one, at best. They are no doubt the
kinds of works copyright law associates itself with. But copyright law’s refusal to protect

154 Vaver, supra note 120 at 36.
155 See example Myra J. Tawfik, “The Law of Copyright and Industrial Designs in Canada” (1991) 7 Canadian
Contours and Mapping the Fault Lines ‘Case by Case’ and ‘Law by Law’” in Ysolde Gendreau, (ed), A New
Intellectual Property Paradigm: The Canadian Experience (London: Edward Elgar, 2008); G Dinwoodie,
46 J Pat Off Soc’y 615. Sam Ricketson & Uma Suthersanen, “The Design/Copyright Overlap: Is There a
Resolution?” in Neil Wilkof & Shamnad Basheer, eds, Overlapping Intellectual Property Rights (United
ideas\textsuperscript{156} or its requirement of skill and judgment for originality\textsuperscript{157} are all ways to establish a special kind of relationship between the author and the work.\textsuperscript{158} In other words, the idea-expression dichotomy and originality help to identify what is distinctly protectable by copyright. Therefore, even though the foregoing sections show that copyright and design have a shared aspect - the artistic work, this fact by itself does not prove that the design of Bayliner's boat or Coco Chanel's tweed suit are artistic works within the domain of copyright. In other words, the fact that both copyright and designs capture artistic endeavours does not sufficiently justify extending copyright protection to designs. The specificity of copyright lies in its application to acts of original authorship\textsuperscript{159}.

A work is subject to copyright only if it is original.\textsuperscript{160} In \textit{CCH}\textsuperscript{161} the Supreme Court of Canada conclusively moved away from the 'sweat of the brow'\textsuperscript{162} standard and held that for a work to be original, the author must have exercised 'skill and judgement'.\textsuperscript{163} But what is most crucial for this conception of originality is the specificity of the skill and judgement that copyright law requires. I will demonstrate this with the help of two cases: \textit{Feist Publications Inc.} \textit{v. Rural Telephone Service Co. Inc.}, and \textit{CCH Canadian Ltd. v. Law Society of Upper Canada}.\textsuperscript{164}

\textsuperscript{156} See example, \textit{Baker v Selden}, 101 US 99 (1879).
\textsuperscript{159} \textit{Ibid.}
\textsuperscript{160} \textit{Copyright Act}, RSC 1985, c C-42, s 5.
\textsuperscript{162} \textit{Ibid} at paras 24-25.
\textsuperscript{163} \textit{Ibid}
In *Feist* the US Supreme Court said that an alphabetically arranged phone directory is not a copyrightable work. This was because a compilation of facts could not possibly originate from the author, and a compilation of names, towns and telephone numbers did not possess even a *de minimis* quantum of creativity.\textsuperscript{165} The court clarified its position by declaring that this position should not be construed as demeaning Rural's efforts in compiling its directory, but rather as making clear that copyright rewards originality, not effort.\textsuperscript{166}

In *CCH* the Canadian Supreme Court held that an original work must emanate from the author, not be copied and must be a result of an exercise of ‘skill and judgement’.\textsuperscript{167} The Court held that the case summaries, headnotes, and topical indices included in case reports all required a level of skill and judgment that copyright law recognizes and protects.\textsuperscript{168} Even though the court seemed to think that the ‘skill and judgement’ standard was lower in some sense than the US ‘creativity’ standard, both these decisions, in their move away from the ‘sweat of the brow’ standard, teach an important lesson about authorship in copyright.

In *Feist*, while discussing the creativity standard, it was said that the mere selection, coordination and arrangement of white pages do not fulfil the minimum standards of creativity for such a work to be copyrightable.\textsuperscript{169} Even though selection, co-ordination and arrangement may generate copyright, on the facts of this case the mere selection, co-ordination and arrangement of white pages was not sufficient to meet the threshold of originality. In the same way, McLachlin CJ in *CCH* said that making minor grammatical changes and other additions to

\textsuperscript{165} *Feist*, *ibid* at 1287.
\textsuperscript{166} *Ibid* at 1296.
\textsuperscript{167} *CCH*, *supra* note 161 at para 25.
\textsuperscript{168} *Ibid* at 29- 32.
\textsuperscript{169} *Feist*, *supra* note at 1291- 1295.
judicial reasons is only a trivial exercise of skill and judgment that is not covered by copyright. Therefore, if someone reproduces the directory from *Feist* or the judicial decisions by themselves from *CCH*, there is nothing within copyright doctrine that would prevent such copying. This is because the *Feist* directory is not a copyrightable work of authorship, and the copyright in the judicial decisions in *CCH* is not the plaintiff’s to enforce (even though the plaintiff made an effort to make grammatical changes in the text of the judicial decisions). It is my view that in arriving at these conclusions the courts did not say that the compilation of the telephone directories or the correction of grammar in judicial reasons is not a valuable exercise of skill and judgment. This is not to say that these tasks are not valuable but more importantly is an assertion that copyright law does not protect a work just because it has value. The purpose of copyright law is not to reward effort but to protect specific acts of authorship which without a doubt require effort, but effort by itself does not determine copyrightability. This in turn creates a special relationship between the author and her work and that is not one based on value generation. Therefore, in order to truly synthesize designs with copyright law, we must first locate in the relationship between Coco Chanel and the tweed suit the same symbiotic relationship that exists between Van Gogh and the Starry Night.

### 4.3 Designs as Works of Authorship

I must make it clear that my purpose here is not to show that all designs are works of authorship. My attempt, which is more modest, is to show that the creative process of a designer

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170 *CCH, supra* note 161 at para 35.
171 See Drassinower, *supra* note 48 (arguing that the concept of value-balancing does not create or explain copyright).
173 I say symbiotic because copyright law recognizes the work and its author contemporaneously. One cannot exist without the other.
and the design produced as a result are not necessarily antithetic to the act of authorship and the creation of a copyrightable work. Just as copyright law protects drawing, maps, charts and other useful works; I argue that there is nothing within copyright law that prevents the protection of mass-produced designs as artistic works. The implication of making this argument is that the underlying normative purposes of copyright law do not preclude the protection of works just because they are commercially successful or embody features of utility (because designs are applied to useful articles). Both on a conceptual and doctrinal level, designs that possess artistic features constitute works of authorship that would be eligible for full copyright protection in the absence of the copyright exclusion. Not all designs may be works of authorship; but I argue that there is nothing within the specific domain of copyright law that precludes the protection of designs that are works of authorship.

In a recent decision in *Lucasfilm Inc v. Ainsworth*, the UK Supreme Court was required to decide whether the Imperial Stormtrooper helmet used in the recent Star Wars film was an artistic work for the purposes of copyright law.\(^{174}\) The court felt that movable three-dimensional works, to qualify for protection, had to either be sculptures or works of artistic craftsmanship.\(^{175}\) The court asked itself a very interesting question: even though these helmets were functional “within the confines of the film”, can they also qualify as copyrightable artistic works?\(^{176}\) The court came to the puzzling conclusion that the helmets were purely utilitarian and did not qualify as sculptures for the purposes of copyright law.


\(^{175}\) Section 4(1)(a), (c), CDPA 1988. There is a further possibility of convincing courts that some movable three-dimensional works qualify as “works of architecture” which are defined widely enough to possibly include individual sculptural elements of building such a stained glass window or an intricately designed balcony.

\(^{176}\) *Lucasfilm* at para 42.
I say that this conclusion was puzzling for two reasons: first, even within the confines of the film, how are these helmets functional? Second, the court said that relative to the helmets’ “utilitarian” objectives, its purpose as an artistic work was very limited: “But it was the Star Wars film that was the work of art that Mr. Lucas and his companies created. The helmet was utilitarian in the sense that it was an element in the process of production of the film.” These two conclusions are important because they seem to represent a shared conceptual frontier between copyright and everything else. I want to argue, in that sense, it is this conception of art and its relationship with function that largely obscures our view of designs and leads us to deem them as “lesser” forms of art or “functional” art. I am going to consider both these conclusions in turn.

Firstly, the idea that the helmets are functional is puzzling. A functional helmet would normally be used to protect the head of the wearer. In other words, the protective function of the helmet is what makes it utilitarian. However, the Stormtrooper helmet used in the film was nothing less than any other copyrightable work in the film. Just like the dialogues and the music, the helmet and other visual props were present in the film to make a visual impact on the viewer. In the same way these props are not popular in the marketplace for their utilitarian value. They sell at relatively high prices because they are collectors’ items; for a collector who values the helmets as artistic works in the same way an antiques collector would a painting from the 19th century. My point here is not that the helmets must be considered copyrightable

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178 While utilitarian and functional elements fall within the exclusive domain of patent law, the problem raised here is not concerning the protection of utilitarian features. The question I am asking is prior to this consideration in that it challenges the determination that the Stormtrooper helmet was utilitarian just as any other protective headgear.
179 Suthersanen expresses a similar idea. See supra note 49.
180 Ibid.
because they are collected. The helmet was not merely a utilitarian article that happened to be used in the film. The helmet is an important aspect of the characterization of the Imperial Stormtrooper (a fictional soldier), and performs an expressive function that is integral to the film just like the dialogues or music.

Secondly, the court, based on a historical analysis of the evolution of design law, held that the Parliament clearly intended to create three separate tiers of protection: copyright, the registered design right and the unregistered design right (the three layers of protection extended to works of art within the UK copyright and design system). While copyright is intended to protect “pure” artistic works, the design rights protect the so-called “lesser” forms of art that are visually appealing and sometimes even utilitarian. The court, trusting that Parliament had good policy reasons to enact laws in this manner, refused to treat the helmet as a work of art. Moreover, it is my view that the Court’s preoccupation with the three-tier structure of UK design law led them to look at the helmet as an object and not a work. This is because the formal structures of copyright and design law dictate that the distinct shape of an object can only be a ‘design’ worthy of short term protection. While it is the Court’s duty to apply the law, this problem is one that needs to be raised and answered on a conceptual level.

The foregoing sections have clearly discussed the problems with the disjointed evolution of design law. But in the courts’ continual adherence to the formal legislative distinctions between copyright and design we have failed to evaluate the real communicative value that some designs might have and the Stormtrooper helmet is the best example. Designs

181 Lucasfilm, supra note 177 at paras 73-79.
182 For a detailed discussion on the history of copyright in two-dimensional design drawings see Richard Butler on Copyright, Designs and Patents: The New Law, Robert Merkin (ed.) (London UK: Longman, 1989) at 283-304; See also Russell Clarke And Howe On Industrial Designs (Martin Howe, 8th ed., 2010).
such as the helmet are as expressive as poetry or a work of literary fiction. By viewing the helmet merely as an object- a protective head gear- we ignore its artistic merit. The most troubling concern is that even though copyright law shuns the qualitative assessment of artistic merit, the contrived separation of pure from applied art induces this qualitative assessment nevertheless. Despite the lengthy discussion on what constituted an artistic work, the Supreme Court’s final stance on this was attributable largely to their view that there were “good policy reasons for the differences in the periods of protection, and the Court should not, in our view, encourage the boundaries of full copyright protection to creep outwards.”\(^{183}\) Therefore, in denying copyright protection, the formal structures of copyright and design law seem to have played a major role. The existence of two separate regimes by itself was sufficient for the court to deny copyright protection without having to justify that the helmet was in fact not copyrightable. The court did not rely on the concept of originality to determine whether the helmet was an original artistic work. While the formal structures intend to separate function from art, the court’s reluctance in engaging with the more difficult threshold questions means that irrespective of the spectators’ view, the formal legislative structures determine what is copyrightable and what is not.\(^{184}\)

It is possible to suggest that under this view, a designer is merely denied the status of the author because she subjected her work to an industrial process.\(^ {185}\) But even worse is the fact

\(^{183}\) Lucasfilm, supra note 177 at para 73- 79.

\(^ {184}\) Suthersanen, supra note 49 at 17 (“These are made from unauthentic moulds; if a Stormtrooper helmet is cast from the “original Ainsworth” mould, it would cost £500. If one wished to step across from the “mass-produced industrial design” to “art”, the Ainsworth-made unfinished Stormtrooper helmet sold at a Christies auction in 2002 for £4465.81 Under the Marcel Duchamp approach suggested above, these are art works. The spectator has made his views known, has lifted it to a profitable merchandising status…”)

that the denial of authorship status depreciates the value of the spectator or the user within this system of rights. The author is not alone within the copyright system. As Marcel Duchamp suggests, the spectator plays an important role in determining whether a thing is a piece of art. In his opinion, the artist lacks full consciousness of what is being produced and is a mere medium of the work itself. This in a sense confirms the communicative nature of works. When we fail to consider the expressive function of the helmet and its impact on the spectator, the helmet will obviously appear to be utilitarian. In that sense, every copyrightable aspect of the film including the script and the music play a utilitarian role within the larger creative project (the film). If the helmet is viewed as a mere object- a protective head gear- it is quite natural to confine it to limited functional design protection.

When we look at the act of authorship itself as a communicative act, the author is only a part of the larger copyright system in which her works “insert themselves into the cultural space between persons, offering the public an invitation to dialogue about ideas.” When copyright is viewed in this manner, based on its dignitary and communicative aspects, works are not mere intangibles but are the author’s personal actions whose misappropriation

IP LJ 325, at 379-381 (arguing that the design patent system should either be abolished or should be phased out and replaced with a system more akin to community design protection).

186 See Drassinower, supra note 48.
188 Ibid (“All in all, the creative act is not performed by the artist alone; the spectator brings the work in contact with the external world by deciphering and interpreting its inner qualification and thus adds his contribution to the creative act. This becomes even more obvious when posterity gives a final verdict and sometimes rehabilitates forgotten artists.”).
190 Drassinower, What’s Wrong with Copying?, ibid at 84.
It is my view that the Stormtrooper helmets performed this exact communicative function in the film. It is hard to deny that the helmet performed a communicative function in the film in just the same way as the script or the background music score, both of which are undeniably copyrightable. The legal conception of a design as a work of art applied to an object leads us to believe that all objects (including the Stormtrooper helmet, an automobile spare part, the Chanel tweed suit or a penguin shaped teapot) are useful things and not works of art. But the truth is that all these designs are not the same. A unitary conception of design as art applied to an object and the common competitive concerns that the designs regime is meant to address create a contrived unity of design where the helmet, the spare part, the tweed suit and the teapot are all the same.

191 See Simon Stern, “From Author’s Right to Property Right” (2012) 62 UTLJ 29. (The property justification is not rich enough to understand the deeper problems that subject matter exceptions present.).
5 Competitive Concerns, Arbitrary Boundaries and the Contrived Unity of Design

Muhlstein and Wilkinson noted the tension between the treatment of industrial works and that of works of the creative arts: “It was considered appropriate to treat artistic works applied to products produced in certain industries separately from other works which enjoyed full copyright protection.” In *Philips v. Remington*, Jacob J held that “The reason that parallel rights can exist is simple: each form of right is created by statute. Unless there is a specific provision preventing rights from coexisting, they just do.” The specific exclusions within copyright law clearly prohibit the coexistence of copyright and design rights. The competitive concerns in allowing full copyright protection for works of applied art caught Parliament’s attention when the 1988 amendments were being debated. As explained earlier, Parliament was faced with a situation where they had to resolve the problems caused by the narrow judicial interpretation of the copyright exclusion. Instead of allowing the case-by-case interpretation of the separation between copyright and design, without taking away the copyright in the artistic work, S. 64 only makes this copyright unenforceable in cases where the design is reproduced more than fifty times.

In *Magasins-Greenberg Ltée v. Import-Export René Derhy (Canada) Inc.*, Richard J refused to expunge the registered copyright in a jacket design even though more than fifty jackets had been manufactured. He explained the copyright exclusion as follows:

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194 Because the erstwhile copyright exclusion under S. 46 of the old Act required determination regarding the capability of registration under the Designs Act and the intent of the designer, virtually every decision relied on the court’s understanding of whether a work could qualify for design protection. See Hayhurst, *supra* note 106.
“s. 64 does not have the effect of precluding or removing copyright from designs .... Instead s. 64 merely establishes limits to the protection conferred by copyright in certain designs thereby providing a defence that may be raised in a copyright infringement action. Artistic works in the nature of designs for useful articles can still be registered under the Copyright Act, notwithstanding these limits.”

At first glance this would appear to resolve the authorship issues discussed in the foregoing sections. Since the author does not technically lose the copyright in a design, this separation of copyright and design seems non-contentious. To elaborate further, if the Lucasfilm dispute came before a Canadian court, owing to this interpretation, it might have been held that the Stormtrooper helmet is a copyrightable artistic work, but S. 64 would merely deny the enforcement of such copyright owing to the more-than-fifty rule.

This approach, however, raises other questions: firstly, this interpretation suggests that the aspects of an industrial design which would otherwise qualify for copyright are virtually the same as those which would qualify for design protection. If this is true, then the only normative purpose of separating copyright from design is to allow a shorter term of protection for designs. Second, because this rule captures only those designs applied to useful articles more than fifty times, the more-than-fifty rule constitutes the sole legal separation between copyright and design. This section will explore the genesis of these rules, and the problems with creating sui generis laws to address competitive concerns. This section will also analyse the exceptions

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196 *Ibid* at 236.
197 The designs excluded by the Copyright Act virtually cover all the designs that are capable of registration under the Industrial Designs Act because both legislations define the term ‘design’ identically.
to the more-than-fifty rule and to locate within these exceptions a rationale for allowing concurrent copyright and design protection.

### 5.1 Applied Art and the Number Fifty

Without having to rely on the intent of the creator, the reproduction of a design in numbers greater than fifty triggers the shift from copyright to the realm of industrial design. Some commentators believe that the number fifty is an arbitrary figure. It was carried over from the erstwhile Industrial Design Rule 11. The pre-1988 cases dealing with the copyright exclusion demonstrated the difficulty in conceptually separating the underlying artistic work from its applied form. The more-than-fifty on the other hand has the virtue of simplicity. It only requires the court to investigate whether the copyright owner or anyone claiming under her actually authorized such reproduction. If the industrial reproduction was authorized by the copyright owner or anyone claiming under her, by the operation of the more-than-fifty rule, the copyright in the design becomes unenforceable.

However, it must be noted that this rule is applied only in the case of copyrightable works applied to useful articles and an important issue comes to light in relation to the definition of ‘useful article’. A design must be applied to a useful article in order to be protectable subject matter under design law. The Federal Court, in *Pyrrah Design v 623735*

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199 Supra notes 86-106 with accompanying text (See discussion on S. 46 and Rule 11 in the history section).
200 Ibid (See Bayliner and British Leyland).
201 Hayhurst, supra note 198.
202 *Industrial Design Act*, RSC 1985, c I-9, s2 (useful article means an article that has a utilitarian function and includes a model of any such article; utilitarian function, in respect of an article, means a function other than merely serving as a substrate or carrier for artistic or literary matter).
Saskatchewan, was required to determine whether a piece of jewellery is a useful article. The defendant used the more-than-fifty rule to claim that since a piece of jewellery was a useful article, the plaintiff relinquished his right to enforce the copyright. This determination is pertinent because, if an article is deemed not useful then the copyright would continue to be enforceable. This also exemplifies the fact that neither copyright law nor design law determines whether a creation is artistic or not. Once the low barrier of ‘originality’ under both laws is crossed, the overlap between the two continues to exist. The case now rests on the following determinations: 1) has the work in question been applied to a useful article? If yes, the work is a design and the copyright is terminable. If the answer is no, then the work is not covered by design law at all. 2) If the work is a design, has it been manufactured more than fifty times? If yes, the design loses copyright protection. If the design has not been registered, it loses design protection as well. 3) Does the design qualify as an exception to the more-than-fifty rule? If the answer is yes, the design enjoys concurrent protection under both copyright and design law—where both the design and the copyright remain simultaneously enforceable.

In Pyrrah, the Federal Court of Appeal concluded that it was unclear whether jewellery was a useful article and as such subject to the more-than-fifty rule, or whether it was merely a carrier for artistic matter and thus not subject to that rule. Therefore, in Canadian
jurisprudence, the definition of ‘useful article’ remains ambiguous. This means that out of the three determinations outlined above, judges are not equipped to unambiguously ascertain whether an article is useful or not. Even though the determination of whether an article is useful or not is evidence-based and subjective, it is a highly important question to raise and answer. It is the application of a piece of art to a useful article that makes it a design.

This kind of terminable copyright arises as a result of the legislative separation. Once the copyright in the design becomes unenforceable, the only recourse available to the designer is to register the design under the Industrial Design Act within one year from first publication. However, there are several practical concerns that one might encounter. For one, a design needs to be registered within one year from publication, and this does not give the designer sufficient opportunity to test the commercial viability of the design. The design registration system imposes administrative and financial burdens for something that would otherwise be copyrightable (which does not require registration). Second, even though the registration of a design is relatively inexpensive and expeditious, it must also differ substantially from earlier designs. In Bodum the Federal Court found that Bodum’s useful types of jewellery holding clothing together, while other objects such as a brooch or an earring may be purely ornamental and not useful at all, valuable only for their own intrinsic merit as works of art. Further, a sculpture may be created merely to be observed and admired or it may be made to be used as a paper weight. This issue is a genuine one deserving of a full trial on viva voce evidence.”)

208 Industrial Design Act RSC 1985, c I-9, s 6(3).
209 Industrial Design Act RSC 1985, c I-9, s6 (3)(a) (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, in the case of an application filed in Canada).
210 In comparison to patent filing and examination, obtaining design registration is relatively expeditious and inexpensive. But it still comes with administrative costs that are an excess burden especially when applicable to works that would otherwise be copyrightable (which does not require registration).
212 Bodum USA Inc and PI Design AG v Trudeau Corporation (1889) Inc, 2012 FC 1128.
industrial design registrations, in light of the prior art, were not substantially different and expunged the registrations.\footnote{Ibid at paras 96-99 (the court held that since the designs in question were applied to articles of daily use, the difference between the design and the prior art must be marked and substantial.) (“the Court is of the opinion that the industrial designs in question do not meet the criteria defined by the jurisprudence entitling them to registration. As a result, the industrial designs in question do not satisfy the requirement of substantial originality and, consequently, they are not entitled to the protection set out in the Act and must be expunged from the register.”).} Not only does this requirement place an extra burden on designer, it also interacts with the concept of “originality” in notorious ways.

5.2 Originality in Design- Expanding the Gulf between Copyright and Design

In order to gain protection under design law, a design must be registered.\footnote{Industrial Design Act RSC 1985, c I-9, s 3.} Only original designs can be registered under the Industrial Designs Act.\footnote{Industrial Design Act RSC 1985, c I-9, s 6(1).} The design must substantially meet the legal standard of originality which has been held to be higher than copyright level originality.\footnote{Clatworthy, supra note 211.} Since there is a blanket copyright exclusion for all applied designs, if a design does not meet this standard of originality some commentators worry that a class of designs will remain protection-less.\footnote{Commentators have discussed this problem. See example Vaver, supra note 120, Wilkinson and Muhlstein, supra note 13.} It may well be the case that Parliament intended only for certain designs that meet the threshold requirement to qualify for design protection.

Conversely, considering the fact that design law was created as an exception for artistic designs, should not all applied art work qualify for protection under design law? In other words, since copyright law excludes all designs that are applied to useful articles, should not all designs excluded specifically by copyright law be registrable as designs? Somewhere in the transition
from copyright to design, the threshold for originality increases. It is possible that this might be
the case because design law provides for a stronger monopoly. With doctrines such as fair
dealing and independent creation within copyright law, the author’s rights are long-lasting but
do not create strong monopolies in her favour. But this also means that an original work of art
that would normally qualify for copyright protection, when applied to a useful article and
reproduced more than fifty times now remains in the grey area between copyright and design
where copyright is lost and design is too far-flung.218

Some of these issues came to light in Bodum.219 By taking the prior art into
consideration the court found that the interior and exterior lines claimed by Bodum in their
design already existed in the prior designs.220 Minor variants in Bodum’s design were not
sufficient to establish a case of infringement, and the court instead allowed the defendant’s
counterclaim of invalidity and expunged all of Bodum’s design registrations.221 In Paramount
Pictures Corp. Industrial Design Application,222 the design of a starship toy was found to be too
similar to the design of a similar merchandise toy of the Star Trek Enterprise.223 In both these
case, the designs failed to meet the higher threshold of originality under design law. While
independent creation can generate two independent copyrights,224 a similar justification does not
apply to designs because they have to be “substantially different” from prior designs. Patent like

218 Suthersanen, supra note 49 at 2 (“At one point of the design circle lies the value- and emotion- laden sentiments
of beauty, aesthetics and pleasure; at another point in this circle, design leads and is led by market conditions,
including consumer perception, product identity and competitive edge. In between art and market, lies a nebulous
and grey area in which most design products live.”)
219 Bodum supra note 212.
220 Ibid at para 81
221 Ibid at paras 82-101
222 (1981), 73 CPR (2d) 273 (Can Pat App Bd & Pat Commr).
223 Ibid.
224 The defence of independent creation can be used to establish originality. Two independent copyrights can exist
even when the works are identical.
standards of novelty seem to be applicable to designs that are primarily artistic. It seems that in the interest of curbing design piracy and preventing the easy replication of designs, the originality standard for new designs was increased thereby also preventing subsequent designs from being similar to earlier registered designs or designs already in public domain.

Two problems come to light in this context: first, what is the normative justification for the higher threshold of originality? Why should a piece of applied art be novel in a patent-like sense while the copyright exclusion applies to all applied artistic works (irrespective of their capability of being registered as designs)? An interesting survey by the National Industrial Design Council of Canada reported by the Canadian Royal Commission on Designs, asked companies in Canada if they would like to see a design regime which would prevent others from copying any new and original features of a design (not limited to matters of appearance) but would, unlike the patent system, not prevent another designer from independently creating a similar article. A majority of the companies that participated in this survey were willing to relinquish patent-like design monopolies granted by the current system for a simpler design right that arose upon the creation of a design and provided copyright-like protection that would not be a strict patent-like monopoly.

Second, following from the first problem, the current design system has patent-like procedural trappings (including higher originality and stronger monopoly) for subject matter that is primarily copyrightable because designs are so closely tied to aesthetic appeal. Although

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226 Ibid.

227 Ibid.
both copyright and design laws refer to originality, they apply the concept in very different ways. In other words, the ‘originality’ required under design law is essentially a patent-like novelty issue and is intended to be higher than originality as applied under copyright law.\footnote{A similar observation was made by the court in Clatworthy. See supra note 211.}

This is clear from the fact that the independent creation of a design does not mature into a finding of originality in design law. We must ask ourselves if it is practically possible to apply a higher threshold of originality for creations that cannot be compared in the same way that scientific inventions can be compared for determinations of novelty and non-obviousness. In other words, it might be incorrect to suggest that two competing teapot shapes are comparable in the same way scientific technologies are. There are coherent guiding principles that require originality to be the standard of copyrightability and novelty and non-obviousness to be the standard of patentability. The median level of originality required by design law is far less clear in its application to purely aesthetic aspects of products.

5.3 Exceptions to the Copyright Exclusion: Finding the Conceptual Basis for Concurrent Protection

There are some exceptions to the more-than-fifty rule that include a graphic or photographic representation applied to the face of a product,\footnote{Copyright Act, RSC 1985, c C-42, s 64(3)(a) (a graphic or photographic representation that is applied to the face of an article, eg., the graphic representation of a penguin on a t-shirt).} a trade mark or a label, or a distinguishing guise,\footnote{Copyright Act, RSC 1985, c C-42, s 64(3)(b) (a trade-mark or a representation thereof or a label, eg., the shape of a CocaCola bottle).} material that has a woven or knitted pattern or that is suitable for piece goods or surface covering\footnote{Copyright Act, RSC 1985, c C-42, s 64(3)(c) (material that has a woven or knitted pattern or that is suitable for piece goods or surface coverings or for making wearing apparel, eg., repeat pattern used on a wallpaper or flooring tiles, or a repeat pattern knitted as a sweater).} or a representation of a real or fictitious being, event or place.
applied to the product as its shape, configuration, pattern or ornament.\textsuperscript{232} In these cases design and copyright protection are available concurrently- both the copyright and the design can be enforced simultaneously. Furthermore, this provision also empowers the executive to add to this list of exceptions any design that would then qualify for concurrent protection.\textsuperscript{233}

Wilkinson and Muhlstein, in their highly persuasive account of design overlaps in Canada, demonstrate that Parliament has been almost completely uninterested in industrial design from the beginning.\textsuperscript{234} They speculate that designs that are within this exception could not impede competition even if a granted full term copyright.\textsuperscript{235} This might have been the policy reason underlying these exceptions. Since they do not raise grave anti-competitive concerns, it is possible to suggest that Parliament might have specifically permitted the simultaneous enforcement of copyright and design in these specific instances. However, some suggest that these exceptions in fact undermine the strict separation between copyright and design. David Vaver points out that not only does this list undermine the strict separation but also causes severe anomalies.\textsuperscript{236} Considering that surface decorative patterns are allowed to retain full copyright, he rightly points out that mass-produced cloth can retain copyright protection but mass-produced clothing will not qualify. To further elaborate, if one applies the graphic representation of a dolphin to mass-produced textile, the design will retain full copyright. Mass produced textiles retain a full copyright along with design protection where both rights remain

\textsuperscript{232} \textit{Copyright Act}, RSC 1985, c C-42, s 64(3)(e) (a representation of a real or fictitious being, event or place that is applied to an article as a feature of shape, configuration, pattern or ornament, eg., character merchandizing such as Mickey Mouse shaped salt-shakers or Popeye key chains).

\textsuperscript{233} \textit{Copyright Act}, RSC 1985, c C-42, s 64(3)(g)

\textsuperscript{234} For a detailed discussion on the evolution of design law in Canada see Wilkinson, \textit{supra} note 13, Tawfik, \textit{supra} note 13.

\textsuperscript{235} Wilkinson, \textit{ibid} at 10- 14.

\textsuperscript{236} Vaver, \textit{supra} note 120, at 33- 36.
enforceable. But Coco Chanel’s designer tweed suit will not qualify for the same protection because it is not a regular surface decorative pattern.

Myra Tawfik identifies additional concerns in allowing trademarks and distinguishing guises to retain full copyright. She points out that competition policy, that seems to be the main motivation behind separating copyright from design, does not trigger the same concerns in relation to trademarks that effectively have concurrent copyright, design and trademark protection. Even if we consider that all forms of intellectual property do not protect the common subject matter in the same way, it has been impossible to find an overarching foundational claim supporting concurrent protection for the designs that all covered by the s. 64(3) exception. Even when we consider that these exceptions exist because they do not raise grave anti-competitive concerns, this clarifies two things: first, it now becomes clear that the main aim of design law is the preservation of competition and it does not create distinct intellectual property subject matter. Further, not all designs produce the same competitive concerns because the law allows some of them to retain full copyright. Second, the fact that the list of exceptions is not a closed list makes it abundantly clear that the competition policy in relation to the copyright-design overlap can change based on the market conditions under which designs are created and disseminated.

Until we find the immutable essence of design law it might be hard to justify any legislative or judicial boundaries drawn to avoid overlaps. In the absence of an overarching foundational justification for the protection of designs, it is simply difficult to justify the

237 Tawfik supra note 13 at 291.
238 Ibid.
concurrent protection offered to the dolphin textile pattern but not the Chanel suit. The higher threshold of originality, the arbitrary number fifty and the concurrent enforcement of copyright and design in limited cases cannot be justified until we find the immutable essence that clarifies the true meaning of design and establishes a clear conceptual domain for design within the larger intellectual property framework.

5.4 Competition Policy and the Contrived Unity of Designs

Uma Suthersanen, in her compelling historical account of the growth of designs in the pre- and post-industrial revolution periods, posits that “the concept of “design” from its origins of “art” and “craft” has reached a full circle today.”\(^\text{239}\) The difference between the seventeenth century craftsman and the modern industrial designer is not so much about their creative processes but is more about the market conditions under which they operate.\(^\text{240}\) The differential treatment of designs in comparison to fine artwork has been on-going at least since the nineteenth century.\(^\text{241}\) The legal separation of pure art from industrial art may also be justifiable for several reasons. For one, the situation of design at the “junction of art and industry” ties it closely with product production and consumption.\(^\text{242}\) As a result, the competitive market-place necessitates a balance between the designer’s rights and a competitor’s ability to compete within the same market.\(^\text{243}\) Second, within the commercial sphere some suggest that industrial

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\(^{240}\) *Ibid* at 296-305 (history shows that designers were always led by market and consumer considerations.) *See also* DuMont and Janis, *supra* note 2.

\(^{241}\) Vaver, *supra* note 120, at 36.

\(^{242}\) Suthersanen, *supra* note 239 at 296-305

\(^{243}\) J. Reichmann, “Legal Hybrids Between Patent and Copyright Paradigms”, 94 Col LR 2432, at 2461 (arguing that designs compete in a special market for artistic works and the general product market resulting in the two-market
design changes rapidly and firms are usually able to monetize and reap profits within the short period of protection that design law offers.  

Therefore, it is sufficiently clear that from the competition policy perspective *sui generis* design laws have the virtue of preventing “market failure”\(^\text{245}\) and allow competitive substitutes to sell in the marketplace.

One question remains: does the promotion of market competition sufficiently explain short-term design rights and the higher originality threshold? There are two reasons to challenge this point of view.

Firstly, raising common competitive concerns in the context of designs generally is to assume that all designs are the same. This is far from true. For instance, let us consider the following designs: a) the design of an automobile spare part; and b) the *Lucasfilm* Stormtrooper helmet. If the design of an automobile part was subject to copyright protection,\(^\text{246}\) it would be impossible to manufacture spare parts in the after-market, and this is clearly antithetic to free market competition.\(^\text{247}\) But in the case of the Stormtrooper helmet it is problematic to assume that the same competitive concerns arise. While it is true that the helmet’s replicas and other helmets produced with the original mould have been an immense commercial success, the

\(^{244}\) Vaver, *supra* note 120, at 36.

\(^{245}\) The concept of “market failure” has often been used to describe the problem in the industrial design context. *See example,* Suthersanen, *supra* note 239 at 295, J Reichman, “Design Protection in Domestic and Foreign Copyright Law: From Berne Revision of 1948 to the Copyright Act of 1976” (1983) 6 Duke LJ 1143 (“As copyright protection for designs of useful articles expands, the economic effects of this expansion on the general products market will induce countervailing pressures to reduce the scope of protection acquired in the name if art.”)

\(^{246}\) This was the problem that arose as a result of the *British Leyland* decision in the United Kingdom. Parliament had to create a separate exception, known as the repairs exception to avoid the market failure problem. For more details, *see Richard Butler on Copyright, Designs and Patents: The New Law,* Robert Merkin (ed.) (London UK: Longman, 1989).

\(^{247}\) *Ibid.*
competitive availability of the helmets in the market does not sufficiently explain the refusal to extend the copyright label to it because the consumers buying the Stormtrooper helmet replica do not buy the helmet as a substitute for a regular motorcycle helmet. They buy it in order to imitate the physical appearance of the fictional Imperial Stormtrooper. The copyright in this particular helmet design will not impede competition in the market for helmets generally. This assumption is also debunked by the merchandizing exception under S. 64(3). This section allows the concurrent protection under copyright and design of character merchandizing items.

To elaborate further, when we consider the Stormtrooper helmet to be a work of art, a full copyright in the helmet will only prevent the manufacture of helmets that are substantially similar to the Stormtrooper helmet. When the British Leyland court extended copyright protection to the automobile exhaust system, the market failure argument could be raised because in the after-sales market, the copyright could directly impede competition by preventing spare-parts manufactures from making and selling a similar exhaust system. The copyright extended protection to all exhaust pipe systems that perform a similar function thereby giving the copyright owner monopoly over the function of a thing and not merely its appearance. A copyright in the Stormtrooper helmet would not, in the same way, impede competition by preventing the manufacture of helmets more generally. The significance of the

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248 The House of Lords in the Popeye case, *King Features Syndicate Inc v. O&M Kleeman Ltd*, [1941]AC 417, held that toy models of Popeye infringed the copyright in the original drawings. This has now been recognized as the merchandizing exception under copyright law.

249 *Copyright Act* RSC 1985, c C-42), s 64(3)(e) (a representation of a real or fictitious being, event or place that is applied to an article as a feature of shape, configuration, pattern or ornament, eg., character merchandizing such as Mickey Mouse shaped salt-shakers or Popeye key chains).

Stormtrooper helmet is limited to its expressive character and does not extend to its utilitarian function as a helmet.

To state the same point boldly, the Stormtrooper helmet, by its very nature, is closer to a work of literary fiction than it is to an automobile spare-part. While arguing for the availability of textbooks at reasonable prices in the market, one cannot assert that textbooks must not be copyrightable. These economic arguments do not play a role in deciding whether a work is copyrightable. In the domain of copyright the balance between authors’ rights and users’ rights does not inform assessments regarding copyrightability. In the same way, why must the copyrightability of the Stormtrooper helmet hinge on its competitive availability in the marketplace? When the competitive availability of literary works does not determine their copyrightability, the competitive availability of the Stormtrooper helmet must not determine its copyrightability because the competitive concerns that are raised in relation to books and works of art are vastly different from the anti-competitive effects of copyrighting spare-parts. Believing that the same competitive concerns arise in relation to the helmet and the spare-part means that we establish a contrived unity of all designs. Common competitive concerns do not account for the hybrid nature of a design, as icons of art, as museum exhibits, as collectors’ items, as practical everyday objects, and as industrial functional products. To assume that

251 Abraham Drassinower makes this observation. See Drassinower, supra note 48 at 46 (“The skill and judgement of creativity specific to authorship is irreducible “principled fulcrum” or “most fundamental axiom” that defines and orients the copyright balance. Any effort to derive this fulcrum or axiom from a higher order category is ultimately counter-productive. The reason that the standard or originality cannot be generated out of the concept of the copyright balance is that the concept of the copyright balance presupposes the standard of originality. Originality is, rather, the fundamental principle that makes the copyright balance- as distinct from, for example, the patent balance- possible in the first place.”) The Supreme Court, however, drew originality from the copyright balance. See CCH Canadian v Law Society of Upper Canada, (2004) SCC 13. However, the point I am trying to make is that copyrightability does not hinge on market considerations but is determined based on the legal rule that all original works are copyrightable.
common competitive concerns arise is to unify all these varied designs in a contrived manner and consequently create blanket exclusions such as the copyright exclusion.

Secondly, the *Lucasfilm* case is also reflective of a deeper difficulty that we have thus far refused to acknowledge. Once we are clear that copyright law protects specific acts of authorship, the blanket exclusion of all designs becomes more problematic. The blanket exclusion stems from the idea that all designs are born out of a pre-existing two-dimensional expression of the design. It was on this basis, that earlier court decisions in *Bayliner* and *British Leyland* protected the underlying design drawings as copyrightable works. However, this view runs the risk of assuming that any graphic representation on a piece of paper is an artistic work and hence must be copyrightable. And when viewed this way it is possible to sympathize with those that support the blanket exclusion of all design from the purview of copyright. But the specificity of copyright law in protecting only works of authorship also means that it does not endure the unprincipled “backdoor” extension of rights. In the context of patent drawings, Abraham Drassinower succinctly explains this problem:

“Thus, while reproduction of the diagrams as posters (or perhaps even as three-dimensional models) would be actionable, reproduction of the diagrams as working inventions would fall outside the legitimate domain of the copyright, not because the patentee has abandoned or licensed the latter reproduction, but because it was not within the purview of her right to begin with.”

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254 Drassinower, *ibid* at 150.
This principled view of the domain of copyright eliminates the need for external competition policy to warrant the limitation of copyright protection in designs. Without relying on the principles of a competitive market, copyright law, based on the sanctity of authorship would refuse to prevent the reproduction of automobile spare parts but protect the dignity of the Stormtrooper helmet as an act of authorship.
6 Concluding Remarks

The *sui generis* design law along with the copyright exclusion serves two purposes. First, it limits the copyright in a design by making the copyright in mass-produced designs unenforceable. Second, by removing designs from the purview of copyright and subjecting them to shorter terms of protection, the law ensures that competition is preserved in the marketplace. However, this approach also gives rise to two problems. First, as evidenced by *Lucasfilm*, the law creates a situation where it is almost impossible to differentiate between the Stormtrooper helmet and an automobile spare-part. Further, as discussed in the foregoing sections, although a common conception of design (as defined by the legislation) has the virtue of simplicity; it diminishes the value of the Stormtrooper helmet which would otherwise be a copyrightable work of art. We still do not have a clear normative goal that justifies the equal treatment of the Stormtrooper helmet and a spare-part. Second, while the preservation of competition is an important goal, the lack of a clear first-principles justification for the protection of designs makes design a mere exception to the traditional forms of intellectual property without a clear conceptual domain of its own. The blanket exclusion of designs from the purview of copyright has led to the creation of arbitrary boundaries (such as the more-than-fifty rule) that are both theoretically unsound and practically difficult to apply.

Designs are inherently complex. The hybrid nature of a design means that it can be a work of art, a collectors’ item, an icon of fashion, a practical everyday object or an industrial product. A design can also be a copyrightable work of art, a patentable utilitarian invention or a source-identifier that can be trademarked. And of course, enacting a law protecting designs that takes into consideration all these varied uses and functions can be an incredibly difficult task. Still, this is a much needed change that design law requires because in its present form it is only limited to artistic design and interacts with copyrightable artistic works in notorious ways.
There are some actions that can be taken to steer through the copyright-design overlap in a more responsible manner.

First, at the highest level, the design system has long been due for an overhaul that would modernize the definition of design to meet the present industry standard. It is one thing that the current design regime severely overlaps with copyright because of its limitation to artistic design. But the larger problem is that modern design is no longer restricted to the decorative arts. McKenna and Strandburg, in their exploration of the United States design patent system, suggest that modern designs are a unique integration of form and function. The design system has patent-like features to protect creations that are meant to be purely aesthetic. The problem stems from the fact that modern designs are neither purely aesthetic nor fully functional and a design system that strictly separates the two may not be the most ideal way to protect designs.

The current preoccupation of the designs regime with the aesthetic appearance of useful articles has led to several issues. The current design right requires the strict separation of functional elements of a design from aesthetic aspects. The application of the functionality doctrine (that precludes the protection of functional design features) has not aided this distinction in any meaningful way. While patent law captures utilitarian features, trademark law and copyright law capture aesthetic elements. Designs are therefore eligible for such

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255 See Wilikinson and Muhlstein, supra note 13.
256 McKenna and Strandburg, supra note 13 at 44.
257 This problem has also been identified by other commentators. See example, McKenna and Strandburg, supra note 13.
258 This problem has also been identified by other commentators. See example, Wilkinson and Muhlstein, supra note 13, McKenna and Strandburg, supra note 13, Uma Suthersanen, supra note at 49. See also Magasins-Greenberg Ltée v. Import-Export René Derhy (Canada) Inc, (1995) 61 CPR (3d) 133.
fragmented protection. The current designs regime is not broad enough to protect all aesthetic designs\(^\text{260}\) or narrow enough to ignore all functional designs.\(^\text{261}\) Potentially, an all-encompassing design right that blends form and function might lead to the formation of a more sensible and complete regime for the legal protection of designs.

In every possible way modern designs defy all distinctions that intellectual property law has maintained. For instance, a coffee cup can be designed in order to fit any car cup holder. The design of the cup serves the functional purpose of fitting into any cup holder. Simultaneously, the design possesses aesthetic value because visually different designs could achieve the same functional purpose.\(^\text{262}\) The new design right would conceptually blend form and function and protect the design of the cup as a whole. Theoretically, this would pave way for a comprehensive design right and eliminate the need to fall back on fragmented intellectual property protection. However, as McKenna and Strandburg rightly point out, a design right that blends form and function has never been implemented and therefore requires the establishment of new legal standards to assess the non-obviousness/originality of the design. If we fail to identify a workable means to assess a form/function blend, it might be impossible to establish a

\(^{260}\) Statistical research shows that most litigated designs are struck down because courts tend to apply a high functionality threshold in many cases. In the United States even when a design right is granted at least two-thirds of issued design patents are struck down as invalid in litigation. See Lindgren, “The Sanctity of the Design Patent: Illusion or Reality? Twenty Years of Design Patent Litigation Since Compco v. Day-Brite Lighting Inc., and Sears, Roebuck & Co. v. Stiffel Co.” (1985) 10 Okla City U. L. Rev. 195 at 208. Therefore, even if a design possesses ornamental features, partially functional designs are struck down under the functionality doctrine.

\(^{261}\) McKenna and Strandburg, supra note 13 at 48 ("dictated by function" test appears to recognize that product designs often link aesthetic and utilitarian aspects inextricably, but its solution to that difficulty is to raise the functionality threshold so high that it permits design patents for product designs that are primarily utilitarian in nature.).

\(^{262}\) See Berry Sterling Corp v Pescor Plastics, Inc, 122 F 3d 1452 (Fed Cir 1997) (Case involving a cup-to-go design where the cup’s lower portion allows it to fit into most car cup holders).
sensible design patent system.\textsuperscript{263}

Second, my purpose here has been to show that in the interest of preserving competition, certain works of authorship (such as the Stormtrooper helmet) tend to lose copyright protection. In its present form the law restricts designs to aesthetic features, and I believe that artistic designs would benefit from copyright-like protection. In the early stages of creation, application and dissemination, the European Union \textit{Green Paper on the Legal Protection of Industrial Designs} \textsuperscript{264} proposed the creation of an informal copyright-like design right that would protect designs for a short period of time without requiring formal registration.\textsuperscript{265} This might be beneficial for two reasons. First, designers who do not register their designs within one year of publication or reproduce the useful article more than fifty times currently lose both copyright and design protection. This can be avoided when the design is given informal copyright-like protection for a short period. Second, this right would also protect designs that do not meet the higher threshold of originality under design law and these designs would not have to be struck down like the \textit{Bodum} designs for not substantially differing from earlier designs. It is important to remember that these changes do not in any way deal with the conceptual problems caused by the copyright-design distinction. But these solutions might go a long way in dealing with some of the practical difficulties currently caused by the blanket copyright exclusion.

It is also worth noting that, internationally, there has been a slow transition towards a

\textsuperscript{263} Suthersanen, \textit{supra} note 49 at 22 (“The change in the law will come when, perhaps, our lawmakers can also embrace the modern notion of design, and let go of the nineteenth century notion of art divorced from function. That design is art, even if it is bad, functional, and ugly, and not necessarily appealing to the eye.”).

\textsuperscript{264} EC Commission published a \textit{Green Paper on the Legal Protection of Industrial Designs} in 1991, which proposed a directive for the harmonization of the Community's design laws.

\textsuperscript{265} Similar unregistered design rights exist in the United Kingdom and the European Union.
system that allows concurrent copyright and design protection. The WIPO Model Law on industrial design clearly states that \textit{sui generis} design laws cannot facilitate the blanket exclusion of all designs from copyright protection.\textsuperscript{266} The ‘unity of art’ doctrine applied in French copyright law protects all designs as artistic works without drawing a distinction between pure artistic works and applied artistic works.\textsuperscript{267} Other countries such as Australia allow two-dimensional artistic designs and three-dimensional designs that qualify as works of artistic craftsmanship to be protected under copyright law for a period of life of the author plus seventy years.\textsuperscript{268} While this system also requires a distinction between jewellery (that is clearly the work of an artistic craftsman) and a designer nutcracker (that is artistic but industrially mass-produced),\textsuperscript{269} it allows most artistic works to retain full copyright. Some commentators suggest that a common term of twenty-five years must be applicable to all works of applied art (including all two- and three-dimensional works) without subjecting them to a formal \textit{sui generis} form of design protection.\textsuperscript{270} This approach would not require any bright line divisions between copyright and design and the line between art and industry would be far less contentious. Again, it is pertinent to note that these approaches are practical solutions to the copyright-design overlap and in no way answer the deeper conceptual questions.

One final question remains: where a design has artistic, utilitarian, functional and source identifying aspects, can a \textit{sui generis} design law be enacted to protect a unique blend of


\textsuperscript{267} This has always been the case in France. There has never been a distinction except for the establishment of a deposit system for applied artistic works. See G. Finnis, “The Theory of ‘Unity of Art’ and the Protection of Designs and Models in French Law” (1964) 46 J of Pat Off Soc’y 615.

\textsuperscript{268} Copyright Act, 1968, s 33 and s 77.

\textsuperscript{269} This problem arises because while certain works clearly qualify as works of artistic craftsmanship certain others (even though artistic) fail to qualify for copyright protection because they have been industrially applied.

\textsuperscript{270} Ricketson and Suthersanen, \textit{supra} note 20 at 184- 185. This is also the period stipulated under the Berne Convention.
some or all these design aspects? At best, enacting such a law will be a daunting task and at worst, creating an all-encompassing design right will be impossible. Whether it is the art/function dichotomy or the pure art/applied art dichotomy, within the realm of design, bright line divisions create more problems than they resolve. As far as design law’s overlap with copyright is concerned, a non-contentious bright line separating copyright from artistic design may be impossible to establish. The conclusion is far more pessimistic than one would hope. A possible resolution is the recognition of an unregistered design right which may ease some of the practical burdens imposed by the blanket copyright exclusion. This would essentially be a copyright in a design that would last for a shorter period. This is different from the current *sui generis* design law because unlike under the current system, this new right would allow the designer to retain a copyright (albeit for a shorter period of twenty-five years) without having to register it even when the design is applied to mass-produced goods. However, it is pertinent to note that this would not in any way resolve the conceptual incoherence of the design system because this would still require a clear separation between artistic copyrightable features and purely utilitarian features that are exclusively within the domain of patent law. In the alternative, we could recognize a new design right that blends form and function, which would require an overhaul of the current system because the current system perceives design as a purely artistic endeavour. Although this solution may be theoretically appealing, the blend of form and function may not be workable, in which case a *sui generis* design law would not make sense at all.