

Registering trademarks in three dimensions: ‘Good design is good business’

‘Distinguishing guise’ must be used in the Canadian market to be protected

BY LARA DANIEL, SPECIAL TO THE GAZETTE JULY 9, 2012



One example of three-dimensional marks that enjoy trademark protection are Ferrero Rocher’s golden paper-wrapped chocolates.

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MONTREAL – “Good design is good business,” as Thomas J. Watson, the former chief executive of International Business Machines Corp. – better known as IBM – said in the 1950s.

Without necessarily thinking that “design is everything,” a mantra of Paul Rand, the influential graphic designer known for logo designs that are still an integral part of the corporate identities of such companies as IBM, UPS and ABC, it is undeniable that product appearance plays an important role in the mind of the consumer when deciding on the choice of a purchase.

It is a fundamental tool used to attract consumers and build a positive reputation for the brand. Similarly, the overall design of a store or restaurant is influential in the consumer’s selection process.

Businesses can protect their product or service's design or appearance under Canadian trademark law, which covers much more than brand names or logos.

The shape of a given product or the look and layout of a restaurant or store can be trademarked. Such non-traditional trademarks are known as three-dimensional marks, look and feel, trade-dress or get-up.

Well-known examples of three-dimensional marks that enjoy trademark protection are Ferrero Rocher's golden paper-wrapped chocolates, Pepperidge Farm's goldfish-shaped crackers, Nesquik's rabbit-shaped bottles of chocolate-flavoured milk and Build-a-Bear's unique storefront design.

The terms three-dimensional mark, trade-dress, get-up or general appearance do not appear as such in the Canadian Trademarks Act, and the right to register these types of trademarks depends on the statutory definition of what is called "distinguishing guise."

A distinguishing guise is a shaping of a product or a method of wrapping or packaging a product that is not primarily functional and serves to distinguish the product or service of the applicant from other products or services.

A trademark application must be filed with the Canadian Intellectual Property Office, or CIPO, to obtain protection for a distinguishing guise.

To be protected, a distinguishing guise, unlike traditional trademarks, must be in use in the Canadian market. A mere intention to use the guise is not enough. It must be distinctive in the mind of consumers and CIPO requires evidence that, as of the date of filing the application in Canada, the applied-for guise has acquired such distinctiveness. This evidence is usually submitted by way of a sworn declaration.

If a mark does not qualify as a three-dimensional mark, but rather consists of a two-dimensional mark, such as a label affixed on a three-dimensional product, it cannot be protected as a distinguishing guise but may nonetheless be registrable as an ordinary trademark.

As an alternative strategy, you may consider seeking registration for the features of shape, configuration, pattern or ornament applied to a finished article as an industrial design. Registration as an industrial design is not dependent on acquired distinctiveness and it grants the owner the exclusive right to prevent another person from making or selling any product whose design has been registered by the owner.

To qualify for registration as an industrial design, a design must not be identical to, or so similar as to be confused with, a registered design, and it must be an original design. The application to register an industrial design must be filed within one year of its public disclosure anywhere in the world and the registration may not last longer than 10 years. This 10-year window offers some protection pending the filing of an application for a distinguishing guise.

Even if trade-dress or get-up is not registered for trademark protection, it can be protected against copying by a third party on the ground of "passing off," when someone other than the original product or service provider makes a false representation to the public, or to a third person, leading consumers to believe goods or services are their own. The traditional test for passing off requires the plaintiff to show the existence of goodwill in the trade-dress, deception of the public due to a misrepresentation, and actual or potential damage to the plaintiff.

However, registration of a three-dimensional mark carries several benefits. Once it is registered, protection is indefinite as long as it is being used by its owner. It also provides multiple possible causes of action, such as the right to prevent the sale, distribution or advertising of goods or services with a potentially confusing or similar trademark, and the right to prevent the use of the registered distinguishing guise in such a manner as to depreciate the value of the goodwill attached to the distinguishing guise.

Careful consideration should be given to the possibility of trademark protection. The unique combination of features associated with your products and services may give them that certain je ne sais quoi to set them apart from the ordinary, and provide you with a valuable tool for business growth and profitability.

To maximize your chances of success in today's ever-increasingly competitive business environment, the protection of your intellectual property assets is a must.

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