

## Drafting Industrial Designs

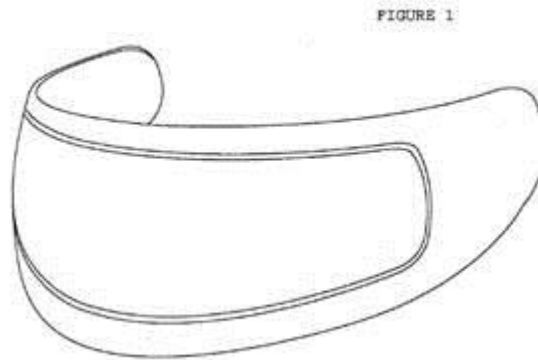
A recent [decision](#) of the Federal Court provides an overview of how the industrial design system works.

### The Facts

The plaintiff was the owner of a registered industrial design. The design registration states that:

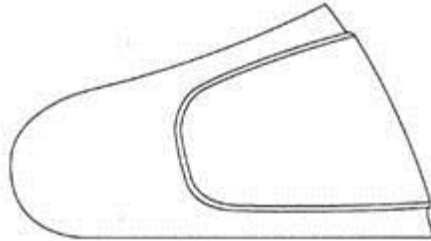
The design consists of the features, the shape, configuration, pattern or ornament of the entire helmet face shield as shown in the drawings. Three of the drawings are reproduced below:

#### Front left perspective



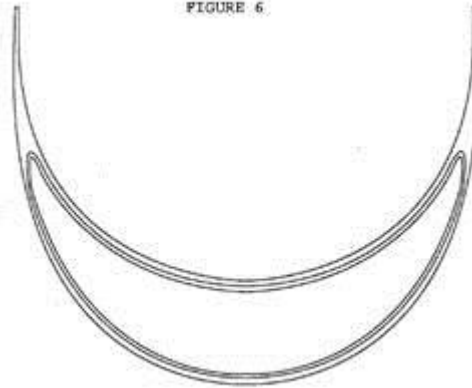
**Right side perspective**

FIGURE 5



**Perspective from above**

FIGURE 6



The plaintiff asserted that a face shield manufactured in Korea and sold by the defendants contained a raised lens viewing area and infringed the industrial design registration. A front left perspective view of the defendant's product is set out below:

### **Front left perspective**



The defendant denied infringement and attacked the validity of the claimant's registration.

### **The Test for Infringement**

The judge said there were four steps required to be considered relating to an alleged claim of infringement: (i) an examination of the prior art; (ii) an assessment of utilitarian function and any methods or principles of manufacture or construction; (iii) an analysis of the scope of protection outlined in the language and figures of the registered design itself; and (iv) after considering these factors, a comparative analysis of the registered design and the allegedly infringing product.

The *Industrial Design Act* provides that an owner of a registered industrial design has exclusive rights over the design and any design that does not differ substantially from it. In addition, the Act directs that the extent to which the registered design differs from any previously published design must be taken into account. In other words, prior art must be considered in assessing the scope of "substantial difference".

A registered industrial design cannot protect features applied to a useful article that are dictated solely by a utilitarian function of the article or by any method or principle of manufacture or construction. Functional features of designs may be protected but features whose form are dictated solely by function are not protected. The applicant can protect a small portion or feature of the product or the whole of the product. If the applicant is trying to protect a single feature, this must be delineated in the description and the drawings.

In order to determine whether infringement has occurred the perspective of an informed consumer is applied. An informed consumer is basically an individual who is familiar with the marketplace.

Finally, any designs that pre-existed the industrial design registration in issue can play an important role and determine the scope of protection that the industrial design affords its owner.

When the judge considered the prior art and the functional aspect of various pre-existing shield designs it was found that the following features were dictated solely by function:

- a shape that is contingent upon the helmet to which it must be affixed;
- a tab to raise the shield;
- hinge(s) to attach the shield to the helmet; and
- a viewing area that conforms to and facilitates human vision and sightlines.

The concept of implementing a double-walled feature in a shield design to avoid fogging was also functional. However, the way in which a double-walled feature is incorporated

into a shield, including the shape, contour and height of the projection and the style of its edges, may be protectable.

The plaintiff attempted to distinguish its design from others designs on the basis that its design protected the “outwardly molded projection and smooth contoured surface around the viewing area”.

Unfortunately for the plaintiff the trial judge did not agree. The judge observed that not all of the drawings submitted with the application showed these features and the application expressly referred to the entire design rather than this feature.

The judge referred to two principles that apply in the context of alleged infringement of an industrial design. First, if only small differences separate the registered design from prior art, equally small differences between the alleged infringing device and the registered design should be sufficient to avoid infringement. Second, when an industrial design incorporates fundamentally functional features small differences in ornamentation may be sufficient to take the second design out of the ambit of the earlier registration (referring to the writer’s text).

When the judge considered the plaintiffs registered design as a whole and the similarities and differences between the respective products, he concluded that an informed consumer would find that there were significant substantial differences between the respective designs and that no infringement occurred.

### **Comment**

Like the decision in the *Trunki* case, which we previously discussed [here](#), this case turned on the way in which the industrial design application had been drafted. If the raised protectable shield was what distinguished the plaintiff’s design from other

designs, then the application could have been limited to this feature. If this had been done the outcome in the case may have been different.

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*These comments are of a general nature and not intended to provide legal advice as individual situations will differ and should be discussed with a lawyer.*