Federal Court  Cour fédérale

Date: 20160422

Dockets: T-1110-12
T-491-14

Citation: 2016 FC 435

Ottawa, Ontario, April 22, 2016

PRESENT: The Honourable Mr. Justice Diner

Docket: T-1110-12

BETWEEN:

AFX LICENSING CORPORATION

Plaintiff

and

HJC AMERICA, INC
AND HJC CO, LTD (KR)

Defendants

Docket: T-491-14

AND BETWEEN:

AFX LICENSING CORPORATION

Plaintiff

and

ROYAL DISTRIBUTING INC

Defendant

JUDGMENT AND REASONS

I. Overview

[1] In this action, the Plaintiff claims that the Defendants infringed its registered industrial design – "Helmet Face Shield", Can ID No 133964 (10 February 2010) [ID 964] – which purports to protect the visor, or face shield, portion of a snowmobile helmet. It seeks an injunction and damages for infringement under the *Industrial Design Act*, RSC 1985, c I-9 [the Act].

[2] The Defendants deny these allegations. They allege by counterclaim the invalidity of the design and request that this Court expunge it from the Register of Industrial Designs. The Defendants also allege that in holding out the design as valid, the Plaintiff has infringed subsection 7(d) of the *Trade-Marks Act*, RSC 1985, c T-13.

[3] For the reasons outlined below, I find that while the ID 964 is valid, the Defendants have not infringed it. As a result of the design's validity, the Defendants' subsection 7(d) arguments are moot.

II. Factual Background

A. *The Parties*

[4] The Plaintiff, AFX Licensing Corporation [AFX], is an Ontario corporation. It holds all rights to ID 964, which was registered on September 3, 2010. AFX therefore asserts that it has

the exclusive right, under the Act, to "make, import for the purpose of trade or business, sell, rent, offer, or expose for sale or rent" any product to which ID 964 has been applied until September 3, 2020 – the end of the 10 year period outlined in subsection 10(1) of the Act.

[5] HJC America, Inc. [HJC America], a California corporation, serves as the marketing arm of HJC Co, Ltd (KR) [HJC Korea], a South Korean corporation that manufactures and distributes the HJ-17L helmet face shield, the product that the Plaintiff claims infringes ID 964.

[6] Royal Distributing Inc. [RDI], a retailer in Guelph, obtains supplies from Parts Canada – HJC Korea's distributor in this country – and has admitted to selling 20 HJ-17L helmet face shields. The plaintiff originally sued RDI in a separate proceeding (Court Docket T-491-14), though the two actions were eventually consolidated as the evidence, witnesses, counsel, issues, and products involved were identical. This decision thus addresses both actions.

B. ***The Industrial Design and the Allegedly Infringing Face Shield***

[7] Snowmobile helmets have been available to consumers in North America since at least the 1960s. Helmets and their face shields are designed primarily to protect the human head from injuries sustained on snowmobile trails most commonly caused by collisions, falls, and tree branches. Face shields, such as that represented by ID 964, protect an individual's eyes and face from wind and cold, while permitting them to see where they are going. To prevent fogging or condensation on the inside of the visor, some face shields (like the Plaintiff's) contain a layer of air between an inner and outer lens. Others employ electric heating elements.

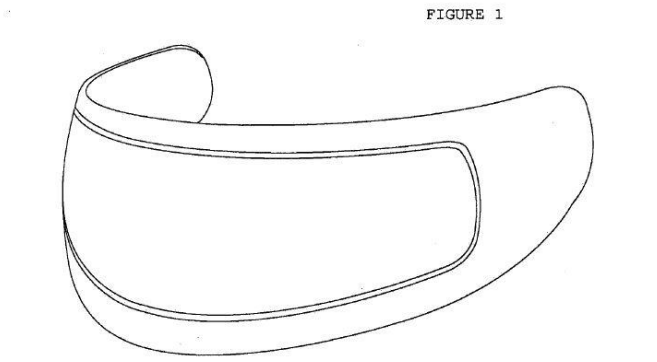
(1) The Industrial Design, ID 964

[8] ID 964 was originally registered to AFX North America Inc. [AFX-NA] on September 3, 2010, and then assigned to the Plaintiff on November 9, 2011. It contains the following brief description:

> The design consists of the features of shape, configuration, pattern and ornament of the entire helmet face shield as shown in the drawings.

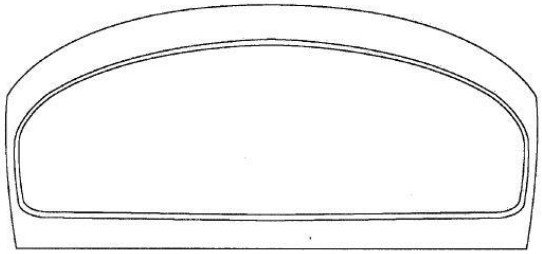
[9] The drawings referred to in this description are reproduced in their entirety below, with additional clarification to describe the perspective of each image:

ID 964 Figure 1 – Front left perspective



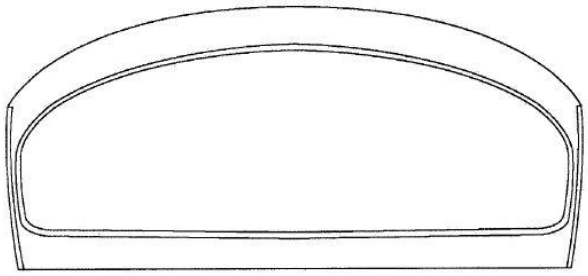
ID 964 Figure 2 – Perspective from exterior

FIGURE 2



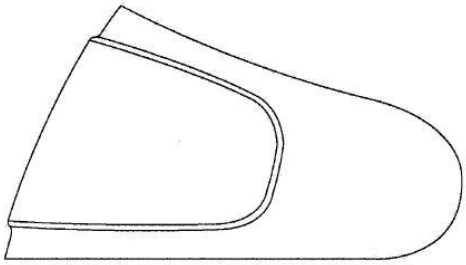
ID 964 Figure 3 – Perspective from interior

FIGURE 3



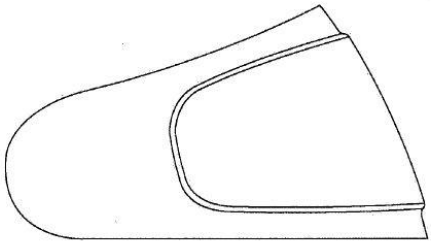
ID 964 Figure 4 – Left side perspective

FIGURE 4



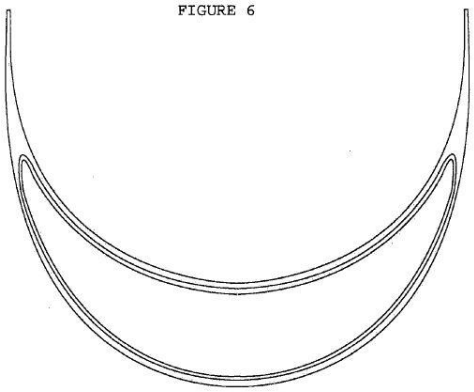
ID 964 Figure 5 – Right side perspective

FIGURE 5



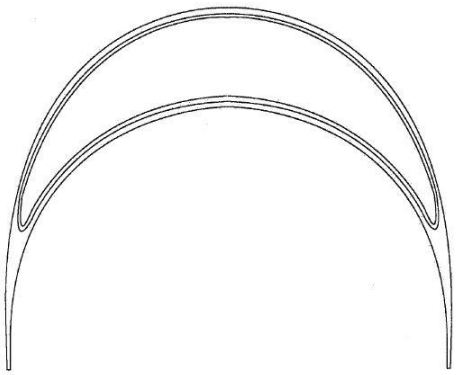
ID 964 Figure 6 – Perspective from above

FIGURE 6



ID 964 Figure 7 - Perspective from below

FIGURE 7



[10] These drawings show the face shield from various angles and perspectives. In them, one can clearly see the shape of the viewing area, which I would describe as rectangular with rounded corners and rounding at the top with tapered ends. The height of the viewing area retreats along the arms.

[11] During the trial, the Plaintiff emphasized what it termed "the outwardly moulded projection and the smooth contoured surface around the viewing area" [the "outwardly moulded projection"], most clearly visible in Figures 4 and 5 of ID 964 above.

(2) The HJ-17L Face Shield

[12] The HJ-17L, manufactured by HJC Korea, is a dual lens helmet face shield which, like ID 964, contains a raised lens viewing area and which the Plaintiff asserts infringes ID 964. Photographs of the HJ-17L corresponding to figures #1-7 of ID 964 follow:

HJ-17L Figure 1 – Front left perspective

HJ-17L Figure 2 – Perspective from exterior

HJ-17L Figure 3 – Perspective from interior

HJ-17L Figure 4 – Left side perspective

HJ-17L Figure 5 – Right side perspective

HJ-17L Figure 6– Perspective from above

HJ-17L Figure 7 – Perspective from below

III. Issues

[13] The three issues to be decided are:

A. Whether the HJ-17L infringes ID 964;

B. Whether ID 964 is valid; and

C. Whether the Plaintiff has violated subsection 7(d) of the *Trade-Marks Act* in misrepresenting ID 964 as valid.

IV. Fact Witnesses

A. *George Douglas Hill*

[14] Mr. Hill is the co-founder of AFX-NA and of the Plaintiff. AFX-NA is a powersports helmet manufacturer. Mr. Hill started AFX-NA in 1996 with his wife and their business partner after having worked in the powersports industry since 1978. Mr. Hill defined the powersports industry as that which "[c]omprises motorcycle, snowmobile, ATV, scooter, dirt bike, [and] all areas of two-wheeled, three-wheeled and four-wheeled recreation [vehicles]" (Condensed Trial Transcript at 9 [CTT])). Mr. Hill testified that AFX-NA has recently shipped its two millionth helmet.

[15] In terms of the product at issue, Mr. Hill clarified that the term "visor" has a number of interchangeable meanings in the powersports industry, including, for instance, the peak of a dirt bike helmet. Therefore, he stated that one should properly refer to ID 964 and HJ-17L as "shields" or "face shields".

[16] Mr. Hill testified that he started developing his face shield design in 2009 and that at the time there were only two ways to make a helmet face shield that was cold-weather appropriate. The first "black plastic frame" approach required the insertion of two clear plastic pieces (the viewing area) into a black plastic frame. The second approach required a clear stick-on application affixed to the inside of a warm-weather face shield.

[17] Mr. Hill stated that his sales team "pressured" him to create a new design, given considerable success with their FX-90 motorcycle helmet, which lacked a cold-weather version. Mr. Hill then described his "wow" moment in envisioning how the design would work with this "landmark" helmet, describing it as follows:

> What I designed was an outwardly moulded viewing area around the full perimeter of the opening of the face shield of the helmet, the smooth contour around the entire of the perimeter so that if, when we look at the helmet, the outside is away from the person's face, so this is outwardly moulded this direction, away from the rider's face, with a smooth contoured curve around the entire visible viewing area, this was my design.
>
> (CTT at 19)

[18] Mr. Hill testified that he introduced his face shield design to the market in early 2010 and that, to his knowledge, there was nothing like it. He later admitted under cross-examination that he had not done a patent search, although according to Mr. Hill "it is impossible to know everything that is in the marketplace" (CTT at 32). He stated that he acquired his awareness of existing designs through his exposure to them in his business and from regular attendance at industry events.

[19] Mr. Hill then sought both industrial design and patent protection for his design. The patent application sought to protect "a face shield or a visor for a helmet with a second spaced apart lens to thereby improve the anti-fogging property of the face shield" (CTT at 35). However, a protest was filed under section 10 of the *Patent Rules*, SOR/96-423, claiming that a similar face shield had been on the market since 2008. The patent application was subsequently abandoned.

[20] The industrial design application, however, was filed on February 10, 2010 and was registered as ID 964 about seven months later.

[21] On November 7, 2011, Mr. Hill incorporated the Plaintiff. Two days later, he transferred to it the ownership of ID 964 from AFX-NA. Mr. Hill's intention was for the Plaintiff to license ID 964 to any interested parties, charging $1 per item sold. Then, almost two years after introducing AFX's face shield into the market, he saw the HJ-17L being advertised on http://www.hjchelmets.com, a website maintained by HJC America. He subsequently ordered one through HJC Korea's retail dealer.

B. *George Hong*

[22] Mr. Hong is the President of the Defendant HJC America. He testified that HJC America is a small company that is responsible for marketing HJC brand helmets and that it does not manufacture, distribute or sell helmets. In short, http://www.hjchelmets.com, the website maintained by HJC America, serves as a product information source for consumers. The website

details are displayed directly on the HJ-17L helmet shield packaging when sold. The website is also listed in a manual that comes in the box with the face shield.

[23] In terms of its activities in Canada, Mr. Hong testified that HJC America occasionally assists customers with warranty and product replacement issues. However, one can only purchase an HJC product from a dealer and not through the company website, which contains a dealer locator. For these marketing and customer service activities, HJC America is compensated entirely by HJC Korea.

[24] Finally, Mr. Hong testified that on November 16, 2011, he received a notice of infringement and the ID 964 registration from the Plaintiff. Mr. Hong also admitted that the HJ-17L shield was introduced into the market after the application for ID 964 was filed.

C. *Gregory Forrest*

[25] Mr. Forrest is a patent agent employed by the Defendants' law firm, McMillan LLP. Mr. Forrest accessed http://www.archive.org, the Internet Archive's "Wayback Machine", to date a catalogue posted on the website of Al's Snowmobile Parts Warehouse [Al's], an American company. The Internet Archive is a non-profit organization that automatically gathers data from individual websites at irregular intervals and stores that data for retrieval later (Affidavit of Gregory Forrest at 1). When that data is stored, the date that it was gathered is stored along with it, as described by Justice McVeigh in *Davydiuk v Internet Archive Canada*, 2014 FC 944 at para 6:

> The "Wayback Machine" is a collection of websites accessible through the websites "archive.org" and "web.archive.org". The

> collection is created by software programs known as crawlers, which surf the internet and store copies of websites, preserving them as they existed at the time they were visited. According to Internet Archive, users of the Wayback Machine can view more than 240 billion pages stored in its archive that are hosted on servers located in the United States. The Wayback Machine has six staff to keep it running and is operated from San Francisco, California at Internet Archive's office. None of the computers used by Internet Archive are located in Canada.

[26] Mr. Forrest testified that he searched for http://www.alssnowmobile.com, a website run by Al's. He then went to the October 10, 2007 version of that website and downloaded a post-script data file [PDF] of the 2007-2008 product catalogue available on Al's website [Al's Catalogue] at the time. He testified that the metadata associated with the PDF of Al's Catalogue indicated that it was most recently modified on September 18, 2007. That catalogue was attached as Exhibit A to Mr. Forrest's affidavit. On cross-examination, however, Mr. Forrest admitted that the Wayback Machine is not definitive proof that the catalogue was available on A1's website and/or that the computer used to access it necessarily reflected the correct date.

V. The Defendants' Expert Witness: Professor Harry Mahler

[27] Professor Mahler holds an Associate degree (Ontario College of Art) and a Master's degree (University of Birmingham) in industrial design. He has taught design since 1989 (full-time since 2004) and previously worked in the private sector where he designed hockey helmets and visors for Cooper Canada, Ltd (now Bauer Hockey).

[28] As will be explained below, while I appreciated his submissions on the functional limitations of face shield design, Professor Mahler ultimately admitted that he was not familiar

with the concept of design as defined by the Act. Therefore, I have not placed significant weight on his conclusions regarding both infringement and validity. Nonetheless, it is instructive to review his testimony, which was as follows.

[29] Professor Mahler first outlined the similarities between hockey helmet visor design and snowmobile face shield design:

> The visor's geometry must be modelled to ensure clear visibility of the user, from one side to the other. The visor for both helmets must protect the wearer's eyes and face from any unexpected impacts. Both visors are designed to withstand impacts by using structural elements, such as surface modelling, to strengthen the visor and improve its impact resistance. If a plastic visor is used in a cold environment, fogging can be an issue in both cases. Both visors require adjustable attachment points, release mechanisms for removal and cleaning. The shape of the visor has to reflect the form of the helmet for attachment purposes. The visor has to be designed to match… the helmet to prevent vibration. It is quite important that the visor and helmet are very well-matched.
>
> (CTT at 94-95)

[30] Professor Mahler was asked, as an expert in the field of industrial design, to address two questions. First, on the question of validity, Professor Mahler examined whether the Plaintiff's ID 964 is identical or so similar to the designs described in the Statement of Defence and Counterclaim (discussed in my analysis below) as to be confounded therewith. Second, regarding the question of infringement, Professor Mahler addressed whether the Plaintiff's ID 964 has been applied to the HJ-17L face shield (Expert's Affidavit of Professor Harry Mahler at para 8 [Mahler Affidavit]).

[31] Professor Mahler was given the following, all of which were admitted into evidence for the trial of this action: a copy of ID 964; a copy of "anti-Condensation Visor", US Patent No 5765235 (20 November 1995) [the Arnold Patent]; a copy of "Helmet Having Shield", US Patent No 5161261 (16 August 1991) [the Kamata Patent]; a copy of "Helmet Face Shield", US Patent No 11/148450 (application filed on 9 June 2005) [the Douglas Patent Application]; a copy of Mr. Hill's abandoned patent application ("Helmet Face Shield", Can Patent No 2731186 (application filed on 8 February, 2011)); pages from Al's Catalogue; and two HJ-17L face shields (Mahler Affidavit at para 9).

[32] Professor Mahler also attached to his affidavit Exhibit A, a "Visual Comparison of Snowmobile Visors", which placed a number of images of the side view of helmet shields attached to snowmobile helmets. He testified that he found these images through an internet search in 2014. The Plaintiff argued, however, that those images cannot be considered in any prior art analysis since there is no proof before this Court that the shields depicted predated the ID 964 registration of September 3, 2010. I agree and accordingly will not consider any of Professor Mahler's submissions regarding these assorted snowmobile helmets.

[33] Professor Mahler first testified that designs that are based primarily on function are hard to differentiate and thus would not be perceived as unique (Mahler Affidavit at para 17). He then stated that there were several functional restrictions on helmet shield design, including the following:

A. The form of the shield must mirror the form of the helmet so that (a) the shield may pass over the helmet when hinged up and (b) the shield closely fits the helmet when covering the viewing area;

B. Both the width and the length of the face shield are determined by the location of the hinge points on the helmet and the size of the helmet; and

C. The size and shape of the shield's viewing area are contingent on both the user's field of vision and the overall size and form of the helmet, particularly its opening for the viewing area.

[34] As a result, the form and function of the helmet ultimately dictate the overall appearance of the shield. Prof. Mahler concluded:

> Since all visors fulfil much the same requirement such as overall size, shape, so to fit over and fasten to a standard helmet, meet the user's physical and visual requirements and the location of the helmet's fastening points, the visor appearance [tends] to be standardized. They are very similar.
>
> (CTT at 106)

[35] Turning to ID 964, Professor Mahler testified that the images in ID 964 had been "simplified to their most basic" and were "generic with no design details, just very basic functional drawings" (CTT at 105). He took particular issue with Figure 1, which he felt did not display an external protrusion around the outline of the viewing area. On this point, Professor Mahler testified that Figure 1 was a "badly done" drawing because "[w]hen you do a drawing of this type, you actually have to draw in perspective and in perspective, there is a difference between the surfaces that you lay out. This drawing is not in perspective, and it's not laid out properly" (CTT at 151).

[36] Professor Mahler acknowledged under cross-examination, however, that while Figure 1 of ID 964 did not demonstrate a "change in height" in the viewing area (i.e. an "outwardly moulded projection"), Figure 4 did indeed show such a change. The Professor further acknowledged that all of the figures must be interpreted together for a proper understanding of ID 964.

[37] Professor Mahler also commented specifically on the viewing area's edge, denoted by a dual line in the figures, which he assumed to be a tape or adhesive "white line" connecting the inner and outer lens in order to create an insulated, anti-fogging air gap. On cross-examination, he admitted that he reached this conclusion by assuming that ID 964 described a winterized face shield and not because there was anything in ID 964 to inform his conclusion.

[38] Professor Mahler then considered the various designs provided to him, describing them all as being "very similar" other than the size of the helmet's viewing area and the connection point to the helmet in each. He thus concluded that "[ID 964] does not meet the criteria… of being original because this does not differentiate itself… substantially from the prior art" (Mahler Affidavit at para 21).

[39] In comparing ID 964 with the HJ-17L face shields during oral testimony, Professor Mahler physically pointed to various differences between the face shields as follows:

> [I]f we compare [ID 964] to [the HJ-17L shield], we have got the tab, which [ID 964] doesn't have. We have got a textured surface, which [ID 964] doesn't have. We have a longer section that goes back further on the [HJ-17L]. We have details here that actually are quite interesting, they are also textured. We have the detail for

> the actual opening [of the HJ-17L]. None of that is on [the ID 964] drawing.
>
> So it's really difficult to suggest that they are the same because [ID 964] has no information on it.
>
> (CTT at 111)

[40] Professor Mahler concluded that the HJ-17L shields infringe the Plaintiff's ID 964 but "so does the pre-existing prior art" (CTT at 117). In other words, and as he responded in cross-examination, Professor Mahler opined that "[e]verything that's on the market that's a visor infringes on that design registration because that design registration is so vague that it basically covers all the ground" (CTT at 134). Professor Mahler returned to this assessment repeatedly, stating, for instance, that the figures in ID 964 "were badly done" and if a student of his had submitted them, they "would have failed" (CTT at 148-52).

[41] While Professor Mahler concluded that ID 964 "does not meet the criteria of being original because it does not differentiate itself substantially from the prior art" (Mahler Affidavit at para 21), it became clear that he lacked an understanding of certain key elements of the term "design" as defined by the Act. Professor Mahler admitted that he did not know about the law or the examination procedure around industrial design protection. He also stated under cross-examination that he did not agree with the definition of "design" as used in the Act and applied a different definition when conducting his analysis:

> Q: Would it be fair to say, Professor Mahler, that therefore your words or use of the word "design" in your affidavit does not reflect the definition of the word "design" in the Act?
>
> A: No, the Act is narrower and more focussed. And when I talk about design, I talk about [the] broader sense of design.

(CTT at 144)

[42] This "broader sense of design" on which he relied included, for example, functionality:

> Q: So a good design, a good design inherently incorporates an element of functionality?
>
> A: Yes. But it's not the entire – design is much bigger than the function of the product.
>
> […]
>
> Q: Is there a bright line, Professor, between design and function? Or is there a point at which they blend?
>
> A: They are all part of the same thing. But it's bigger than function. Function is only one aspect, that is all I'm saying.
>
> (CTT at 124)

[43] As will be discussed in detail below, the Act's protection cannot cover any solely functional or utilitarian elements of the design at issue. The Federal Court of Appeal has stated in *Zero Spill Systems (Int'l) Inc v Heide*, 2015 FCA 115 at para 24 [*Zero Spill*] that "[f]eatures may be simultaneously useful and visually appealing" but a clear understanding of the legal distinction between utility/function and design is nonetheless an essential precondition to speaking meaningfully on infringement and originality. Suffice it to say that Professor Mahler's criticisms of ID 964 for vagueness and insufficient visual detail were rooted in his expertise as an industrial designer and professor in that field of study, and not his expertise in Canadian industrial design protection or what constitutes infringement of a registered design in this country.

[44] Additionally, on cross-examination, Professor Mahler admitted that he was not given a physical sample of any of the prior art he was asked to examine. He asserted that this in no way affected his ability, as an expert in design, to assess the degree of similarity between the ID 964 and the prior art. Yet it is clear from the confusion around the "white adhesive edge" he assumed was present in ID 964 that there are limits to what can be determined from visual depictions alone, including the images in Al's Catalogue.

[45] In light of the above, I find Professor Mahler's evidence concerning the functional limitations on helmet face shield design to be helpful. However, I do not give significant weight to his conclusions on whether the ID 964 design is original, is valid, or has been infringed by the HJ-17L face shield.

VI. Relevant Statutory Provisions

[46] According to section 2 of the Act:

[D]esign or industrial design means features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye;	[D]*essin* Caractéristiques ou combinaison de caractéristiques visuelles d'un objet fini, en ce qui touche la configuration, le motif ou les éléments décoratifs.

[47] There are some essential restrictions on industrial design protection, outlined in section 5.1 of the Act:

5.1 No protection afforded by this Act shall extend to (a) features applied to a useful article that are dictated solely	5.1 Les caractéristiques résultant uniquement de la fonction utilitaire d'un objet utilitaire ni les méthodes ou

by a utilitarian function of the article; or	principes de réalisation d'un objet ne peuvent bénéficier de la protection prévue par la présente loi.
(b) any method or principle of manufacture or construction.	

[48] There are also conditions of registrability of a design outlined in section 6 of the Act:

6. (1) The Minister shall register the design if the Minister finds that it is not identical with or does not so closely resemble any other design already registered as to be confounded therewith, and shall return to the proprietor thereof the drawing or photograph and description with the certificate required by this Part.	6 (1) Si le ministre trouve que le dessin n'est pas identique à un autre dessin déjà enregistré ou qu'il n'y ressemble pas au point qu'il puisse y avoir confusion, il l'enregistre et remet au propriétaire une esquisse ou une photographie ainsi qu'une description en même temps que le certificat prescrit par la présente partie.
[…]	[…]
(3) The Minister shall refuse to register the design if the application for registration is filed in Canada	(3) Le ministre refuse d'enregistrer le dessin si la demande d'enregistrement a été déposée au Canada :
(a) more than one year after the publication of the design in Canada or elsewhere, in the case of an application filed in Canada on or after the day on which this subsection comes into force; or	a) plus d'un an après sa publication au Canada ou ailleurs dans le monde, dans le cas d'une demande déposée au Canada à compter de l'entrée en vigueur du présent paragraphe;
(b) more than one year after the publication of the design in Canada, in the case of an application filed in Canada before the day on which this subsection comes into force.	b) plus d'un an après sa publication au Canada, dans les autres cas.

[49] Subsection 7(3) of the Act states that a certificate of registration, which the Plaintiff possesses for ID 964, creates a presumption of validity:

7. (3) The certificate, in the absence of proof to the contrary, is sufficient evidence of the design, of the originality of the design, of the name of the proprietor, of the person named as proprietor being proprietor, of the commencement and term of registration, and of compliance with this Act.	7 (3) En l'absence de preuve contraire, le certificat est une attestation suffisante du dessin, de son originalité, du nom du propriétaire, du fait que la personne dite propriétaire est propriétaire, de la date et de l'expiration de l'enregistrement, et de l'observation de la présente loi.

[50] Finally, section 11 of the Act describes the exclusive right provided to the owner of a registered design:

11. (1) During the existence of an exclusive right, no person shall, without the licence of the proprietor of the design,	11 (1) Pendant l'existence du droit exclusif, il est interdit, sans l'autorisation du propriétaire du dessin :
(a) make, import for the purpose of trade or business, or sell, rent, or offer or expose for sale or rent, any article in respect of which the design is registered and to which the design or a design not differing substantially therefrom has been applied; or	a) de fabriquer, d'importer à des fins commerciales, ou de vendre, de louer ou d'offrir ou d'exposer en vue de la vente ou la location un objet pour lequel un dessin a été enregistré et auquel est appliqué le dessin ou un dessin ne différant pas de façon importante de celui-ci;
(b) do, in relation to a kit, anything specified in paragraph (a) that would constitute an infringement if done in relation to an article assembled from the kit.	b) d'effectuer l'une quelconque des opérations visées à l'alinéa a) dans la mesure où elle constituerait une violation si elle portait sur l'objet résultant de l'assemblage d'un prêt-à-monter.

(2) For the purposes of subsection (1), in considering whether differences are substantial, the extent to which the registered design differs from any previously published design may be taken into account.	(2) Pour l'application du paragraphe (1), il peut être tenu compte, pour déterminer si les différences sont importantes, de la mesure dans laquelle le dessin enregistré est différent de dessins publiés auparavant.

VII. Analysis

A. *Infringement*

(1) The Status of HJC America

[51] A preliminary issue to be discussed when considering infringement is whether HJC America was actually engaged in any activities that could fall under paragraph 11(1)(a) of the Act.

[52] HJC America argues that, since it is a marketing arm, it does not make, import, sell, rent, or offer or expose for sale or rent the HJ-17L face shield.

[53] The Plaintiff, by contrast, takes the position that HJC America is, at the very least, exposing the HJ-17L face shields for sale by displaying them on its website and directing interested customers to dealers where they can, if they desire, then purchase those shields. The Plaintiff further argues that even if HJC America does not make or sell the HJ-17L, as Mr. Hong's testimony made clear, HJC America plays an important role in the process by which HJC

Korea sells its products in Canada. HJC America, for example, operates at a loss and exists solely to market products that HJC Korea develops.

[54] While this is an interesting issue and the case law on "exposing for sale" is scant, as will be explained below, I do not find that the HJ-17L face shields infringe ID 964. There is thus no need to address the issue of whether the HJC America was engaged in any of the activities listed in paragraph 11(1)(a) of the Act.

(2) The Test for Infringement

[55] There are four steps required to determine 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) in light of all of the above, a comparative analysis of the registered design and the allegedly infringing product.

(a) *Prior art*

[56] The analysis of infringement starts with prior art (*Bodum USA, Inc v Trudeau Corporation (1889) Inc*, 2012 FC 1128 at para 52 [*Bodum*]). This is because, pursuant to paragraph 11(1)(a) of the Act, the owner of a registered industrial design retains exclusive rights over the design *and* any design that does not differ substantially from it. Subsection 11(2) of the Act stipulates that "the extent to which the registered design differs from any previously

published design may be taken into account". In other words, prior art must be considered in assessing the scope of "substantial difference".

(b) *Utilitarian function and methods and principles of manufacture and construction*

[57] A second consideration in establishing the parameters of the infringement analysis is that, as described in subsection 5.1 of the Act, a registered industrial design cannot protect the (a) "features applied to a useful article that are dictated solely by a utilitarian function of the article" or (b) "any method or principle of manufacture or construction". As such, "the similarities arising from the utilitarian function are not taken into account by the Court in its infringement analysis" (*Bodum* at para 46), though, as the Federal Court of Appeal clarified in *Zero Spill* at paras 23-27, "functional features of designs may be protected under the Act …[o]nly those features whose form are dictated *solely* by function are not protected ". Similarly, design features that stem solely from methods and principles of manufacture and construction are excluded from design protection.

(c) *Scope of protection*

[58] Third, one must consider whether the registered design covers only a portion or small feature, rather than the whole of the protected object. If a registrant is trying to protect a single feature, the registration must clearly limit its scope to that particular feature, either through its written description and/or a clear indication in any associated illustrations.

[59] At trial, the Plaintiff directed the Court's attention repeatedly to one feature – the "outwardly moulded projection" – stressing in its submissions that this is the key feature that ID 964 protects. The answer to whether this is actually the case, however, lies in an assessment of the contents of ID 964 itself – both the text and the images that comprise the registered design.

(d) *Comparative (infringement) analysis*

[60] After assessing the prior art to determine the scope of substantial difference, identifying the purely utilitarian features and excluding them, and assessing the scope of protection offered by the design itself, a comparative analysis must be done between the design and the impugned article: if the latter does not differ substantially, then infringement results. In this comparative analysis, an "informed consumer" perspective must be used (*Bodum* at para 80). An informed consumer has been described as one "who is familiar with the … market field" (*Rothbury International Inc v Canada (Minister of Industry)*, 2004 FC 578 at para 38 [*Rothbury*].

(3) What is the state of the prior art?

[61] When an industrial design is registered, the designs that pre-existed it play an important role in determining the scope of protection that the industrial design affords its owner. The Defendants adduced several examples of what they alleged to be prior art, also making them available to Professor Mahler. As explained above, Professor Mahler's "Visual Comparison of Snowmobile Visors" will not be considered in this analysis since the designs it contains cannot be accurately dated to before ID 964 was registered. The rest of the prior art is considered below.

(a) ***Al's Catalogue***

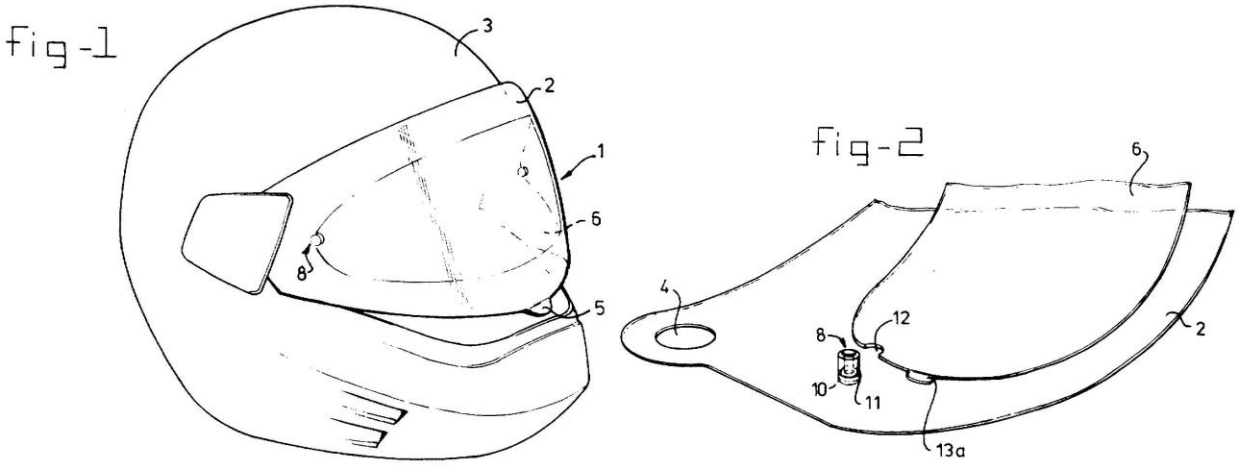
[62] The Defendants drew the Court's attention to page 81 of Al's Catalogue, the document attached to Mr. Forrest's affidavit that he found on http://www.alssnowmobile.com as dated to October 10, 2007. That page of the catalogue contains photographs from various angles (but primarily side views) of two snowmobile helmets with face shields. The Defendants emphasized the face shield portion of one helmet in particular, suggesting that "you can clearly see the transition from the lower surface to a higher lens surface that's necessary to accommodate the double-lens construction" (CTT at 267).

[63] I agree with the Defendants that there is little reason to mistrust the date of publication or provenance of Al's Catalogue in spite of the possibilities the Plaintiff raised regarding the accuracy of the Wayback Machine and the computer used to access it. However, the image of the helmet to which the Defendants directed the Court's attention is pixelated, small, and cannot assist in the more detailed elements of prior art analysis. Contrary to the Defendants' submissions, I cannot clearly see the transition to which they refer. However, the entirety of the helmets and face shields on the page are of some assistance: they provide a general sense of the design constraints on a face shield – that they must correspond to a helmet and are contingent on the space provided for the viewing area, a space which can vary slightly depending on the helmet design.

(b) ***The Arnold Patent - US Patent No 5765235***

[64] The following images come from US Patent No 5765235, issued June 16, 1998 to Derek Leslie Arnold for an "Anti-condensation visor". The Arnold Patent's abstract describes the invention as follows:

> An anti-condensation visor comprises an outer visor which, relative to the user, is situated on the outermost peripheral surface of a helmet or hood to which the visor belongs. The outer visor is provided with openings for fitting on the helmet and with at least one lip for the user to fold the outer visor away. An inner visor is detachably fitted against the inside wall of the outer visor and is held against via at least one mechanical retaining element, while the inner visor rests over essentially its entire surface against the inside wall of the outer visor, and the inner visor is made of hydrophilic material.



[65] The design in the Arnold Patent features a smooth outer visor with no external projection. Instead, the anti-fogging effect is achieved by pressing an inner shield fully up against the inside of the outer visor, which appears to be similar to the "stick-on application" approach that Mr. Hill described in his testimony. The Arnold Patent also clearly describes a hinge point to connect the face shield to the helmet and a tab so that the wearer may raise it above the helmet's viewing

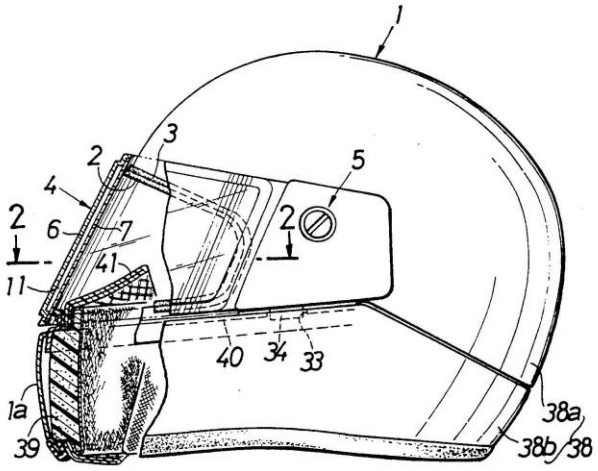
area. The Arnold Patent is rounded and contoured to the helmet and a line, created by the shape of the inner visor and corresponding to the viewing area of the face shield, is visible from the outside. The arm of the face shield ends and its edge veers abruptly up to the hinge point, which protrudes out slightly from the rest of the arm.

(c) *The Kamata Patent - US Patent No 5161261*

[66] The following image comes from US Patent No 5161261, issued November 10, 1992 to Eitaro Kamata for a "Helmet having shield", the abstract of which reads in part:

> A recess is provided in the inner surface of a primary shield plate which is connected to a cap body of a helmet through a pivotal mounting means, and a step depressed from the inner surface of the primary shield plate is formed at the entire peripheral edge of an opening of the recess. An inner shield is fitted to the step and bonded thereto with a soft adhesive, so that a heat insulating space tightly closed in the recess is defined by the primary shield plate and the inner shield plate. The inner surfaces of the primary shield plate and the inner shield plate are formed into a continuous surface which comes into close contact with a sealing member provided at a peripheral edge of a window opening in the cap body. This ensures that clouding of the inner surface of the shield can be prevented regardless of conditions of use such as the presence and absence of travel wind and the temperature of the open air.
>
> (Emphasis added)

FIG.1



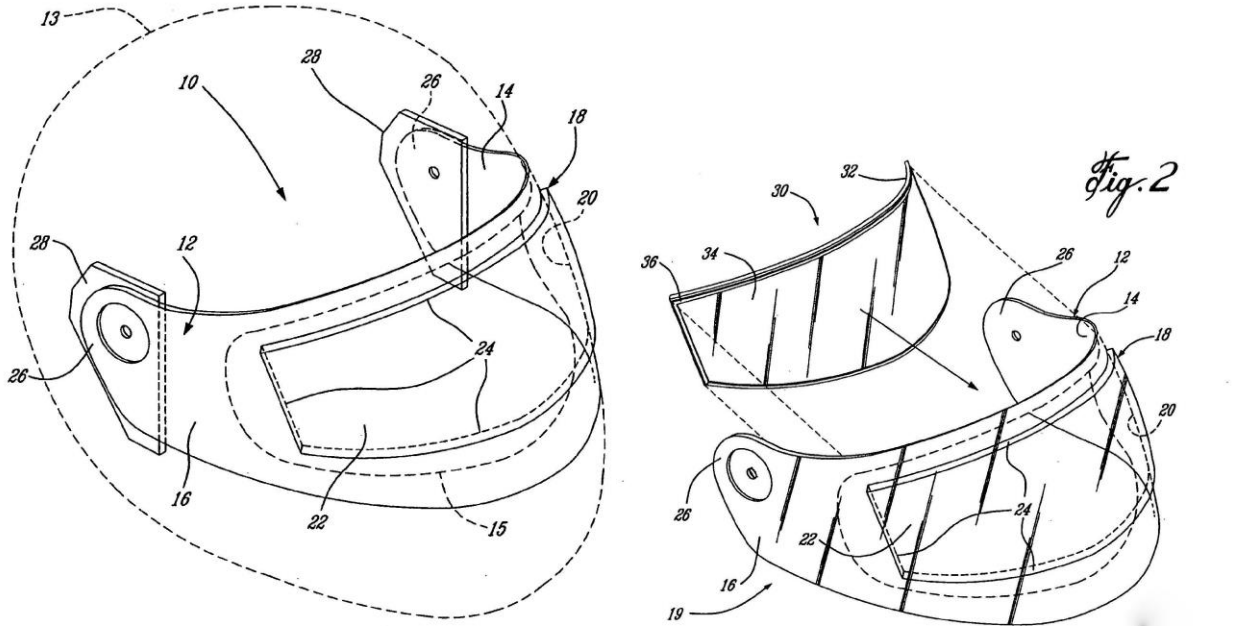
[67] One clearly sees various defining features, including the rectangular shape of the viewing area, which extends above the edge of the viewing area of the underlying helmet. The arms have almost square, flat ends with rounded corners. Unlike the Arnold Patent, a recess in the Kamata Patent's outer lens creates an outward projection. An inner lens is placed over this recess, forming an insulating space. The angle of the face shield and its contour mirror those of the helmet itself. The contour of the outward projection is edged, not smooth. The contour of the inner lens does not match the contour of the underlying helmet viewing area.

(d) *The Douglas Patent Application – US Patent No 11/148,450*

[68] US Patent No 11/148450 for a "Helmet face shield" was published on January 19, 2006, containing the following abstract and images:

> A face shield for headgear comprises a generally transparent main lens, adapted for engagement to the headgear. The main lens comprises a curved inner and outer main lens surfaces and has a central recessed portion with a curved recessed inner lens surface and a curved recessed outer lens surface. The recessed inner lens

> surface and the recessed outer lens surface are respectively offset from the curved inner and outer main lens surfaces. The recessed portion is adapted to receive a secondary lens such that a sealed air gap is formed between the secondary lens and the main lens, thereby forming a sealed double pans lens having condensation reduction properties.
>
> (Emphasis added)



[69] The Douglas Patent Application, in simple terms, features an outwardly moulded projection with an inner lens which creates an insulating air gap. The corners and edges of that projection, however, are square, rather than the smoothly curved "outwardly moulded projection" of ID 964. The area of the outward projection, as in the Kamata Patent, does not match up to the viewing area of the helmet. The arms of the face shield have a rounded end, with the lower edge of the arm bending up, passing behind the hinge point, and curving around that point to meet the upper edge. The upper edge of the shield has a slight upward rounded slope as it moves from the arm to the middle of the helmet. The lower edge is straight.

(e) *The Black-Rimmed Face Shield*

[70] At trial, the Plaintiff adduced a physical sample of a black-rimmed face shield which Mr. Hill asserted was the dominant winterized helmet face shield design before he registered ID 964. Unfortunately, the Plaintiff did not provide the Court with information on the manufacturer or model name.

Black-rimmed face shield – Front left perspective

Black-rimmed face shield – Perspective from interior

Black-rimmed face shield – Left side perspective

[71] This black-rimmed face shield has a somewhat rectangular viewing area with curved edges, although the viewing area grows in height towards the middle of the shield. Most of the frame is made of black, non-transparent plastic, except for the viewing area and a space around the connection point, which is transparent. As is clear from a side view, the plastic of the recessed viewing area sits at a different angle from the top of the frame itself, instead of a smooth continuous transition. There are also two holes at the top of the face shield in a recessed space with a small projection above them. The entire viewing area is surrounded by smooth, curved, raised outline of black plastic.

(4) What are purely functional elements of a face shield?

[72] There are a number of functional constraints on the design of a winterized helmet face shield. These constraints play an important role is assessing the scope of protection afforded by ID 964 since the Act excludes purely utilitarian or functional features from protection.

[73] There are various ways in which a face shield is contingent on the shape of the helmet to which it is attached, which in turn is contingent on the shape of the human head on which it sits. This includes the overall length and width of the face shield. These contingencies mean that shield design is constrained by utilitarian, non-aesthetic considerations. A shield must closely fit on its associated helmet to prevent cold air from entering and affecting the wearer's eyes and face. Otherwise, the design is of little use to the consumer.

[74] Further constraints were discussed at trial: the face shield, for example, must have some connection point attaching it to the helmet so that it can be raised above the helmet's viewing area, and face shields often feature a small tab, at their bottom edge, which the wearer can hold to raise or lower the shield over the viewing area. Neither connection points nor a tab are present in ID 964, though they are present on all the physical exhibits that this Court examined, including the HJ-17L.

[75] In considering whether the HJ-17L differs substantially from ID 964, I must acknowledge that these contingencies and constraints significantly limit the overall variability available in helmet face shield design and thus impact directly on the infringement analysis.

[76] Having considered the prior art and functional aspects of various shield designs, I find that the following features are dictated solely by function:

- a shape that is contingent upon the helmet to which it must be affixed;
- a tab to raise the shield (as in the Arnold Patent);
- hinge(s) to attach the shield to the helmet; and

- a viewing area that conforms to and facilitates human vision and sightlines.

[77] There is, of course, also the question of the double-walled viewing area. This feature prevents fogging, which, as mentioned above, is a purely utilitarian consideration. The Plaintiff argued at trial that this double-walled component – a functional feature for which it had failed to obtain patent protection – was a protectable element of design. The Plaintiff's position was that since there are varying methods and approaches to achieving anti-fogging in a face shield (the inner application or the black-plastic frame style, as described by Mr. Hill) the choice to create a double-walled space necessarily involves aesthetic considerations.

[78] This position, however, casts too broad a net. Protecting the double-walled anti-fog component would blur the Act's fundamental distinction between function and design. Just because a designer has a range of purely functional options to choose from in achieving a particular utilitarian outcome in their design does not make those options aesthetic.

[79] What can be protected, however, is the way in which the double-walled feature is incorporated into the shield, including the shape, contour, and height of the projection and the style of its edges. In other words, whereas ID 964 cannot protect any purely utilitarian design elements of a double-walled anti-fogging face shield, it can protect the way those elements are expressed, so long as that expression involves an original "shape, configuration, pattern or ornament", per section 2 of the Act. In other words, the "outwardly moulded projection and the

smooth contoured surface around the viewing area" is not a purely functional feature but a protectable aesthetic design element of the double-walled design.

(5) What is the scope of protection described in ID 964?

[80] The third step in the infringement analysis is to examine the scope of ID 964 itself. The Plaintiff took the position throughout that ID 964 *only* protected the "outwardly moulded projection and a smooth contoured surface around the viewing area" – in other words, the raised area, most visible in Figures 4 and 5 of ID 964, that defines the viewing area of the helmet shield and more specifically the curved, rather than sharp or square-edged, nature of the contour of that raised area.

[81] I do not agree with this interpretation for three reasons. First, nothing in ID 964 suggests that this is the *only* element of the design subject to protection. The totality of the written description accompanying the seven figures that comprise ID 964 state that the design "consists of the features of shape, configuration, pattern and ornament of the entire helmet fact shield as shown in the drawings" (emphasis added). Had the Plaintiff wished to uniquely highlight that element of the shield for protection, that could have been done in a variety of ways, including through additional explanatory text, diagrammatic detailing (such as dotted lines, shading or highlighting), or a combination of both.

[82] The singular focus on the outward projection seems even stranger when one observes that Figure 1 of the ID 964 does not demonstrate an outward projection at all: if this were the sole innovative design feature contained within the design and the explicit focus of the protection,

one would assume the drafter would be more cautious to ensure it was amply exhibited, where possible, in each figure.

[83] The second reason that I find that ID 964 protects the entire design rather than simply the "outwardly moulded projection" is that the Plaintiff stated, in oral submissions, that certain elements such as the "hinged connection of the visor to the helmet" and the "attachment means" were left out of the design because they were purely utilitarian and thus "not susceptible to design protection" (CTT at 197).

[84] The logical extension of this position, then, is that if some elements were excluded from the design, it is reasonable to assume that whatever was included in the design was something that the Plaintiff sought to have and believed would be protected, including whatever appears in the entirety of the seven figures. As depicted in those figures, the entirety of the design includes the shape of the arms and of the viewing area. In other words, ID 964 goes well beyond the "outward projection", which is only clearly visible in two of the seven figures (4 and 5). Since the ID 964 describes, in its own words, "the entire design" of the face shield, this Court's infringement analysis cannot be restricted to one feature alone.

[85] Finally, I note that the Canadian Intellectual Property Office itself suggests that applicants indicate whether protection of all, or only some, of a design is being sought:

> The description must indicate whether the design relates to the appearance of the entire article or to the appearance of a portion of the article. Further, if the design relates only to a portion, that portion must be clearly identified.

> (Canadian Intellectual Property Office, *Industrial Design Office Practices* (Ottawa: Innovation, Science and Economic Development Canada, 2013) at para 6.4.5).

[86] While this is only a guideline and not binding law, I find that this extract is nonetheless helpful in the assessment of the scope of the design. Here, the Plaintiff did not restrict the coverage of the registration to only a portion of the design. As a result, the entire shield is included in the industrial design protection.

(6) Comparison: does the HJ-17L infringe the Industrial Design?

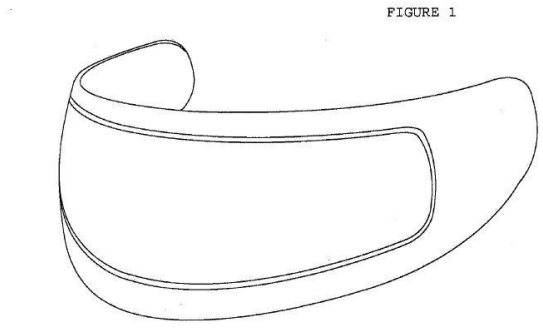
The design and the allegedly infringing face shield	
ID 964	**HJ-17L**
Figure 1 – Front left perspective 	**Figure 1 – Front left perspective** 

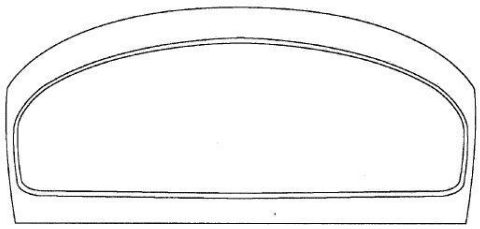
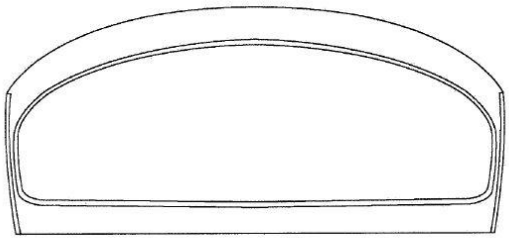
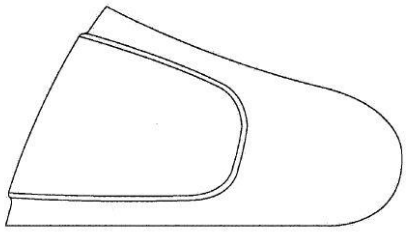
Figure 2 –Perspective from exterior	**Figure 2 – Perspective from exterior**
FIGURE 2 	
Figure 3 – Perspective from interior	**Figure 3 – Perspective from interior**
FIGURE 3 	
Figure 4 – Left side perspective	**Figure 4 – Left side perspective**
FIGURE 4 	

Figure 5 – Right side perspective	**Figure 5 – Right side perspective**

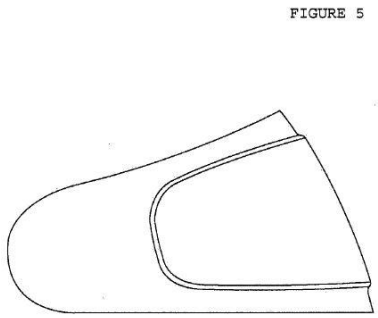



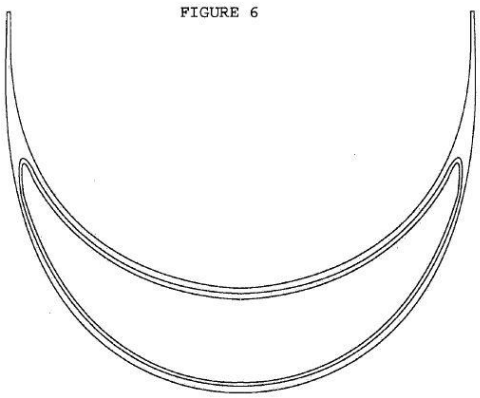
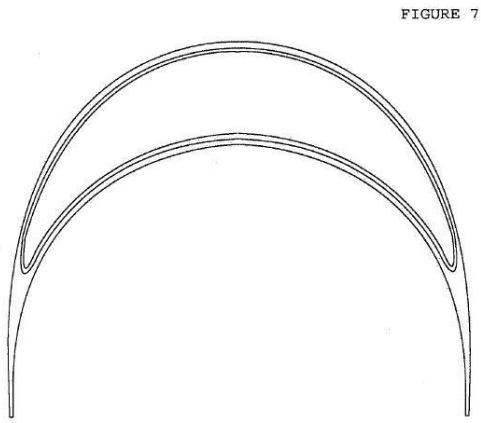
Figure 6 – Perspective from above	**Figure 6 – Perspective from above**
	

Figure 7 – Perspective from below	**Figure 7 – Perspective from below**
	

[87] To summarize the above sections of analysis, a review of the prior art presented by the Defendants suggests that the Plaintiff's ID 964 entered a crowded field in which the notion of an outwardly moulded viewing area was already present in some forms and where the general contouring and shape of a helmet face shield was also well-defined. Thus, the degree of difference necessary for a newer design to evade the protection afforded ID 964 is small:

> If only small differences separate the registered design from what has gone before then equally small differences between the alleged infringement and the registered design will be held to be sufficient to avoid infringement.
>
> (*Sommer Allibert (UK) Limited v Flair Plastics Ltd*, [1987] RPC 599 at 623 (UKCA))

[88] Turning to the question of functionality, as was demonstrated by Professor Mahler, helmet face shield design operates under a great number of utilitarian constraints. Furthermore, the double-walled anti-fogging feature is not, as explained above, a protectable design feature,

even if certain aspects of the way that feature is manifested are protectable. As a result, most helmet face shields will share a degree of similarity in overall shape and size, which is again why the amount of variation necessary to render a design substantially different from its competitors is relatively small:

> When an industrial design incorporates fundamentally functional features even small differences in ornamentation may be sufficient to take the second design out of the ambit of an earlier design registration.
>
> (John S McKeown, *Fox on Canadian Law of Copyright and Industrial Designs* (Toronto, Ont: Carswell, 2012) (loose-leaf updated 2015, release 4), ch 31 at 38; see also *Carr-Harris Products Ltd v Reliance Products Ltd* (1969), 58 CPR 62 at 84 (Ex Ct)).

[89] Finally, despite the Plaintiff's submissions on this point, I am unable to accept that ID 964 was ever intended to *solely* protect the "outwardly moulded projection". Instead, I find that it protects the entire design, and "where emphasis is on the entirety of the design, in order to establish infringement, the article in question will have to be quasi identical" (*Bodum* at para 50).

[90] Given that the entire design forms the basis for the comparative analysis that will establish whether infringement has occurred, the key features to be examined, after having examined the prior art, are: the shape of shield's viewing area; the shape of the arms; any distinctive features on the item that are not purely functional; and the shape of any outward projection.

[91] With these design considerations in mind, I turn my attention to the question of the alleged infringement and the question of substantial difference, by comparing ID 964 with HJ-17L.

[92] Simply put, the HJ-17L face shield is different enough that it does not infringe ID 964. Ignoring the various unprotectable elements – the colour of the adhesive lining that connects the two lenses and frames the viewing area, the presence of the tab, the presence of the hinge points – there are substantial differences that the eye is drawn to upon comparison.

[93] The first is the shape of the viewing area. ID 964 has an almost rectangular viewing area – tallest in the middle, but with only slightly shorter ends on each arm. The HJ-17L, by contrast, has considerably shorter arm ends and narrows more steeply from the middle point at the centre of the viewing area. The viewing area also extends further back onto the arms of the face shield on the HJ-17L than in ID 964.

[94] The second is the shape of the arms. The arms of the face shield depicted in ID 964 end in a circular curve after a gradual and continuous slope down from the front of the shield. The arms of the HJ-17L terminate in much smaller ends, raised upward from the lower edge of the shield, so that they round off the rectangular feature. If one cut off the two arms of ID 964 at each end of the rectangular portion and placed them together, they would form a circle, due to the circular curve. This is not the case with the HJ-17L, where the same process would form more of a heart.

[95] Third, there is a speckled patterning on the plastic around the viewing area of the HJ-17L that is entirely absent from the ID 964. This patterning terminates where the viewing area does and it renders the plastic outside the viewing area opaque rather than transparent. There is no suggestion in the ID 964 of any patterning whatsoever.

[96] As for similarities, there are few that can be distinguished from the restrictions of prior art and functionality. Both must abide by the general shape of a helmet shield, including a large viewing area, and both are contingent upon the dimensions and requirements of helmet design. Both do have "outwardly moulded projections", protectable design features that, unlike those in the prior art, are smoothly contoured around their viewing areas. Yet there are differences between the outward projections of the HJ-17L and ID 964. In the former, for example, the projection's height clearly and distinctly expands the further one goes from the centre of the shield frame toward the arms; put another way, the projection is thinnest in the middle of the shield. In ID 964, however, the height remains constant, at least per the figures that illustrate the outward projection (Figures 4 and 5). As a result, even the presence of this one similarity is insufficient to ground a finding of infringement. HJ-17L is, overall, substantially different in appearance from ID 964.

[97] Before concluding on the issue of infringement, there are two broad observations vis-à-vis design that merit mention. First, the protection offered by the industrial design regime is different from that of the patent regime, which may be commensurate with the amount of effort required to qualify under each. It is interesting to take this very case as an example: while the Plaintiff obtained a design registration (ID 964), the corresponding patent application, which

contained a more detailed written description than ID 964, was not granted. The reason for the unsuccessful patent application was not canvassed in full; as mentioned above, the Court only heard that an objection was filed under Section 10 of the Patent Rules. Suffice it to say that patent protection would have provided a more appropriate platform for the Plaintiff to protect the double-walled anti-fogging feature. It must be remembered that, stated broadly, the patent regime protects functionality and the design regime protects the aesthetic features of any given product. As this Court articulated in *Bodum* at para 46:

> [t]he protection offered by industrial designs should also not be confused with the protection obtained for a product or a process through a patent. As admitted by the plaintiffs, industrial designs do not confer on them monopoly over double wall glasses in Canada.

[98] Similarly, ID 964 should not confer on AFX a monopoly over double-walled anti-fogging face shields in Canada. Rather, it provides a measure of protection for any shield that is substantially similar to that depicted in the ID 964 illustrations, and it cannot be said that the HJ-17L meets that threshold.

[99] The second observation is that face shield design is contingent on helmet design. A face shield is not a stand-alone product: on its own, it has little to no use. This diminishes the designer's scope to introduce 'sparks of originality' into the product's design. The relationship between originality and contingency is generally an inverse one: the more contingent a design is on another product, the less room for aesthetic differentiation is available. This consideration played a role in my conclusion that the differences outlined above were sufficient to avoid infringement.

[100] In summary, an informed consumer would conclude that there are significant substantial differences between the HJ-17L and the design described in the ID964. The HJ17-L does not infringe the Plaintiff's design.

B. ***Validity***

[101] Under subsection 7(3) of the Act, a certificate of industrial design is, absent proof to the contrary, sufficient evidence to establish the validity of the design itself. As noted in *Zero Spill* at para 18, "[s]ubsection 7(3) creates a blanket presumption of compliance with the entire Act". The onus is thus on the Defendants, AFX and RDI, to bring sufficient evidence to demonstrate that, on a balance of probabilities, ID 964 is invalid.

[102] There was some debate at trial as to what grounds for invalidity in relation to prior art were set out in the Act. The Plaintiff focused on the grounds outlined in subsection 6(1) and paragraph 6(3)(a). Subsection 6(1) of the Act states that "[t]he Minister shall register the design if the Minister finds that it is not identical with or does not so closely resemble any other design already registered as to be confounded therewith" (emphasis added). Subsection 6(3)(a), by contrast, states that "[t]he 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" (emphasis added).

[103] Plaintiff's counsel argued that these provisions suggest that there are two separate standards to consider. First, the design must not be identical with or so closely resemble as to be confounded with a design that has already been registered. Second, the design – that is to say, the

exact design and no variation thereto – cannot have been published more than a year before the application for registration. In this light, the Act extends a broader range of protection to registered prior art than it does to unregistered prior art.

[104] Defendants' counsel, by contrast, argued that the wording in subsection 6(1) and paragraph 6(3)(a) must be interpreted in the context of paragraph 11(1)(a), which states that an article infringes a valid, registered design if it does not differ "substantially therefrom". Defendants' counsel submitted that there must be parity in the validity and infringement analyses: a design should only be registered if it differs substantially from what came before, and an article is not infringing if it differs substantially from any registered design. The differences in language between subsection 6(1) and paragraph 6(3)(a), according to this interpretation, are meaningless.

[105] I agree with the Plaintiff that the words of subsection 6(1) and paragraph 6(3)(a) must be read to have distinct meanings. This is consistent with the basic principle of statutory interpretation that "when different terms are used in a single piece of legislation, they must be understood to have different meanings … If Parliament has chosen to use different terms, it must have done so intentionally in order to indicate different meanings" (*Agraira v Canada (Public Safety and Emergency Preparedness)*, 2013 SCC 36 at para 81; see also Ruth Sullivan, *Sullivan on the Construction of Statutes*, 6th ed (Markham: LexisNexis, 2014) at 218). Having said that, there is a third ground upon a design may be invalidated that is relevant to this assessment: subsection 7(3) states that the industrial design must be "original".

[106] Unlike the grounds in subsection 6(1) and paragraph 6(3)(a), which the Act clearly describes, originality is a criterion of validity that is mentioned, but not defined, in the Act. Instead, its definition is found in the case law. In *Clatworthy & Son Ltd v Dale Display Fixtures Ltd*, [1929] SCR 429 at 433[*Clatworthy*] , the Supreme Court described it as follows:

> …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.

[107] Originality in industrial design is a higher threshold than originality in copyright: "[i]t seems to involve at least a spark of inspiration on the part of the designer either in creating an entirely new design or in hitting upon a new use for an old one" (*Bata Industries Ltd v Warrington Inc*, [1985] FCJ No 239, 5 CPR (3rd) 339, at 347 (FCTD)); see also *Bodum* at para 97).

[108] There are similarities between the infringement analysis and the originality analysis for the purposes of determining validity. As with infringement, the role of functionality in a design plays a role ("when an article is primarily functional, minimal differences may suffice for a conclusion of originality" (*Rothbury* at para 38)), as does prior art ("to constitute an original design there must be some substantial difference between the new design and what had theretofore existed" (*Clatworthy* at 433)). Furthermore, as with infringement, the review of the features of the design relative to the prior art must be from the perspective of the informed consumer (*Rothbury* at para 31).

[109] Originality, per subsection 7(3), is thus a broader criterion than either subsection 6(1) or paragraph 6(3)(a), since it requires that the applied-for design be "substantially different" from the prior art (see *Bodum* at para 96) and applies even if the prior art in existence is not registered. It is distinct from the condition under subsection 6(1), which gives an additional level of protection to already registered designs, and it is distinct from paragraph 6(3)(a), which speaks specifically to the publication of the exact design and which I interpret as a mechanism to encourage applicants to seek registration of their new designs in a timely fashion.

[110] To sum up, a registrable design (i) must differ substantially from the prior art (be "original"), (ii) cannot closely resemble any registered designs (as per subsection 6(1)), and (iii) cannot have been published more than a year before application for registration (as per paragraph 6(3)(a).

[111] By way of *obiter*, I note that one might ask how a design could differ substantially from the prior art (i.e. be "original" and thus survive on subsection 7(3) grounds), but then so closely resemble a previously registered design as to be confounded with it (i.e. fail on subsection 6(1) grounds). A separate and distinct ground of originality, in other words, appears to render subsection 6(1) superfluous. I note only that expected amendments to the Act appear to make no distinction between registered and unregistered prior art in the assessment of the registrability of an applied-for design.

[112] Turning back to the facts evinced at trial, the Defendants adduced no evidence of previously registered industrial designs, nor does the evidence suggest that the exact design itself was published a year before its registration.

[113] There is consequently nothing in the evidence presented to this Court on prior art to suggest that either paragraph 6(3)(a) or section 6(1) of the Act apply. As such, I will confine my infringement analysis to two lines of the Defendant's counterclaim:

1. That ID 964 lacks originality;
2. That, per subsection 5.1(a) of the Act, the design is invalid because it seeks to protect functional, rather than aesthetic, features.

(1) Originality

[114] The Defendants rely on the prior art they submitted – the helmets in Al's Catalogue, the Arnold Patent, the Kamata Patent, and the Douglas Patent Application. As discussed above in the infringement analysis, a review of this prior art suggests that winterized helmet face shield design is a crowded field under a number of functional constraints. Nonetheless, to determine whether the shield in dispute was sufficiently original necessitates a short review of the prior art.

[115] ID 964 substantially differs in design from the prior art in the Arnold and Kamata Patents and the Douglas Patent Application (see figures and/or abstracts from these patents reproduced in the infringement analysis above). The Arnold Patent design has a different viewing area than ID 964, created by an inner panel which presses up against the exterior pane, as well as differently shaped arms and a small protrusion at the hinge point; in addition, there is no outward projection. The Douglas Patent Application design has sharp edges and corners and a rectangular

viewing area. The design in the Kamata Patent is notably straighter and squarer in shape, including in the arms.

[116] With respect to the one physical sample of prior art that was in evidence before the Court, the black-rimmed plastic frame shield, there were clear differences between it and ID 964, including the viewing area, which was depressed into the frame rather than protruding outwards, and the two holes in the raised surface above the viewing area. There was no evidence before the Court to suggest whether those holes were functional or not, but certainly the form they take and the shape of the face shield around them goes beyond the purely utilitarian.

[117] Finally, the page from Al's Catalogue, as discussed above, is of the same limited value to this validity analysis as it was to the infringement analysis above: its images are small, pixelated, and do not offer the multiple perspectives necessary to assess any degree of substantial difference or similarity. What is clear from the page from Al's Catalogue is that the shields generally share a common overall form which must correspond in large part to the shape of the helmet.

[118] Ultimately, I could not find anything in the prior art made available to me that clearly contained an outwardly moulded projection and a smooth contoured surface around the viewing area or otherwise did not differ substantially from ID 964. Therefore, I find that ID 964 meets the degree of originality necessary to uphold its registration.

(2) Subsection 5.1(a) of the Act

[119] The Defendants also took the position that the "outwardly moulded projection" is a purely utilitarian feature due to it being a necessary part of the double-walled anti-fogging feature.

[120] It is true, as noted above, that both the double-walled anti-fogging feature and certain other features of face shield design are purely functional and accordingly cannot receive industrial design protection.

[121] However, there are equally several shield design features that can be protected, including the shape of the arms, the shape of the viewing area, and the expression of the double-walled anti-fogging feature as an "outwardly moulded projection" with a "smooth contoured surface around the viewing area". Furthermore, as was clear from a review of the Douglas Patent Application, for instance, there is no reason why this outward projection needed to have smooth contouring and the decision to do so reflects an effort to appeal to the eye.

[122] For these reasons, I find that the ID 964 is not invalid on the ground of utility.

[123] As a final note, the Defendants argued at trial that the raised projection was a "method of manufacture" which would make it invalid per subsection 5.1(b) of the Act. However, there was neither much time spent on this ground, nor evidence adduced to support this allegation. I

therefore find no basis to invalidate the design registration on this ground either. At its core, ID 964 does not in any way describe or point to any method of manufacture.

C. *Subsection 7(d) of the Trade-Marks Act – Unfair Advantage*

[124] Lastly, Defendants' counsel raised a novel cause of action at trial, alleging that the Plaintiff, in holding out their industrial design as valid, breached subsection 7(d) of the *Trade-Marks Act*, which states that:

7. No person shall…	7 Nul ne peut :
(d) make use, in association with goods or services, of any description that is false in a material respect and likely to mislead the public as to	d) employer, en liaison avec des produits ou services, une désignation qui est fausse sous un rapport essentiel et de nature à tromper le public en ce qui regarde :
(i) the character, quality, quantity or composition,	(i) soit leurs caractéristiques, leur qualité, quantité ou composition,
(ii) the geographical origin, or	(ii) soit leur origine géographique,
(iii) the mode of the manufacture, production or performance	(iii) soit leur mode de fabrication, de production ou d'exécution.
of the goods or services.	

[125] While their submissions on this issue were interesting, without a finding of invalidity, they are moot.

VIII. Conclusion

[126] The Plaintiff, at trial, stated that it was seeking $20 in damages – or one dollar per infringing face shield sold by RDI – along with an injunction. The Defendants were seeking expungement of the Plaintiff's ID 964 and damages for misrepresentation. I find that, on the evidence before me, none of these remedies are merited. The Plaintiff's industrial design is valid and the Defendants have not infringed it.

[127] The Court wishes to thank the parties' counsel for their able representation and courtesy shown, including providing the images used in these reasons.

IX. Costs

[128] Costs are awarded to the Defendants.

JUDGMENT

THIS COURT'S JUDGMENT is that:

1. The Plaintiffs' action against the Defendants is dismissed: no infringement of ID 964 has occurred;

2. The counterclaim by the Defendants is also dismissed: ID 964 remains valid; and

3. Costs are awarded to the Defendants.

"Alan S. Diner"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKETS:	T-1110-12 AND T-491-14
STYLE OF CAUSE:	T-1110-12, AFX LICENSING CORPORATION v HJC AMERICA, INC, AND HJC CO, LTD (KR) AND T-491-14, AFX LICENSING CORPORATION v ROYAL DISTRIBUTING INC.
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