Intellectual Property Weekly Abstracts Bulletin — Week of May 9

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Industrial Design Decisions

An industrial design registration for a helmet face shield is found to be valid, but not infringed
AFX Licensing Corporation v. HJC America, Inc., 2016 FC 435

The Federal Court has found that while the Plaintiff AFX's industrial design is valid, the Defendants have not infringed it.

AFX's industrial design is for a "Helmet Face Shield", which purports to protect the visor, or face shield, portion of a snowmobile helmet. The Court sought to answer whether the industrial design was valid, infringed, and whether AFX has violated subsection 7(d) of the *Trademarks Act* in misrepresenting the design as valid.

Although AFX asked the Court to only consider the "outwardly moulded projection" of the face shield and not the whole, the Court held that the registration protects the entire design. This was because AFX did not restrict coverage of the registration to only a portion of the design. Upon review of the prior art, the Court found that the shield 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 is small.

It was also stated that face shield design is contingent on helmet design, and on its own, it has little to no use. This was found to diminish the designer's scope to introduce 'sparks of originality' into the product's design.

In sum, the Court held that an informed consumer would conclude that there are significant substantial differences between the two face shields, and thus no infringement was found.

When asked to assess the validity of the registration, the Court turned to the prior art and found that the registration met the degree of originality necessary to uphold its registration. The design was also held to not be purely utilitarian, contrary to

the *Industrial Design Act*. On finding the registration to be valid, the Court held that the allegation of holding out the industrial design to be valid contrary to subsection 7(d) of the Trade-marks Act, moot.

Supreme Court Leave Decisions

Leave to appeal dismissed for the expungement of the SPEED QUEEN mark
Whirlpool Canada LP v. Alliance Laundry Systems LLC (SCC #36782)

The Supreme Court has dismissed Whirlpool's leave to appeal from 2015 FCA 232, a 2-1 decision delivered from the bench of the Federal Court of Appeal.

As we previously summarized the week of November 2, 2015, Alliance had successfully appealed a decision of the Federal Court (2014 FC 1224 and summarized here) that upheld a decision of the Registrar of Trademarks (2013 TMOB 218) which confirmed the registration of Whirlpool's trademark SPEED QUEEN. The registration was expunged as a result of the appeal.

The Supreme Court provided the following summary of the leave to appeal:

Intellectual property – Trade-marks – Proof of use – Evidence – Evidence necessary to establish use of a trade-mark – Whether the Court of Appeal substantially compromised the jurisdiction of the Registrar of Trademarks and transformed a simple, summary and expeditious administrative procedure into an adversarial process.

At the request of the Alliance Laundry Systems LLC, the Registrar of Trade-Marks forwarded a notice under s. 45 of the Trade-marks Act, R.S.C. 1985, c. T-13, to Whirlpool Canada LP, the registered owner of registration no. UCA15837 for the trade-mark SPEED QUEEN, requesting proof of use of the mark between October 5, 2008 and October 5, 2011. At the outset, Whirlpool Canada conceded that the registration should be amended to delete all but two wares (washing machines and dryers), and all services. It submitted an affidavit from Whirlpool Corp.'s Director/General Manager indicating that SPEED QUEEN had been used by Whirlpool Canada and its licensees (including Whirlpool Corp.) in association with washers and dryers in Canada in the normal course of trade within the relevant period; total sales figures for SPEED QUEEN washers and dryers in Canada in 2001-2010, an unspecified portion of which were affirmed to have occurred in the relevant period; a licensee's invoices dated shortly after the relevant period, said to be representative of the invoices issued during the relevant period; that Whirlpool Canada had retained direct or indirect control of the character and quality of SPEED QUEEN washers and dryers marketed and sold by its licensees in Canada since it acquired the mark in 2004. He also provided undated photographs of what appeared to be commercial, coin-operated washers and dryers prominently displaying the mark.

The Hearing Officer was satisfied that the affidavit had showed use of the mark during the relevant period within the meaning of s. 4(1) of the Trade-marks Act. The Federal Court dismissed Alliance's appeal, but the Federal Court of Appeal allowed Alliance's further appeal. It ordered that the Registrar of Trade-marks expunge registration no. UCA15837 in association with Whirlpool Canada's washers and dryers.

Par

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