

# Star Athletica Type Rights Outside the United States

An Overview

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Worldwide Availability Of *Star Athletica*  
Type Rights In Design Features  
Incorporated Into Products.



**Once your client creates this sort of useful article  
in the U.S., what rights does it have elsewhere?**

## Berne Copyright Convention - Article 5 National Treatment & No Formalities

“(1) Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.

(2) The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work.”

## Berne Convention - Article 5 National Treatment & No Formalities

- The Treaty requirement of an absence of formalities applies to the *acquisition* of rights.
  - No need of a copyright registration, or marking (e.g. ©)
- The Treaty requirement of an absence of formalities does not apply to the *enforcement* of rights.
  - Registration *can be* a pre-requisite to enforcement.
- The Treaty requirement of national treatment means that an author’s copyright extends to all Berne Convention countries, but its scope varies according to national law.

## What do *Star Athletica* Type Cases Look Like in Canada?

- Useful Articles, as defined in §64 of the Copyright Act, are **excluded** from protection.
  - **useful article** means an article that has a utilitarian function and includes a model of any such article;
  - **utilitarian function**, in respect of an article, means a function *other than merely serving as a substrate or carrier for artistic or literary matter*.
- There are statutory **exceptions to the exclusion** of Useful Articles from copyright protection.

## What do *Star Athletica* Type Cases Look Like in Canada?

These cufflinks  
are useful articles.



This pin is not a useful article.



*As per the rule in Pyrrha Design v. 623735 Saskatchewan, 36 C.P.R.(4<sup>th</sup>) 432 (FCA)*

## What do *Star Athletica* Type Cases Look Like in Canada?

These are not useful articles.

	Pyrrha's Design Title	Pyrrha's Design Picture	Defendant's Design Title in 2013	Defendant's Design Picture in 2013	Defendant's Design Title in 2018	Defendant's Design Picture in 2018
7.	Bond of Friendship		Friendship – Clasped Hands		Friendship – Clasped Hands	
8.	Boars Head		Warrior – Boars Head		Boars Head Warrior Necklace	
9.	Full of Spirit		Rooster - While I live I'll show Courage, Confidence and Bravery Rooster		Rooster – While I live I'll crow	

*Pyrrha Design Inc. v. Plum and Posey Inc.*, [2019 FC 129]

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***useful article*** means an article that has a utilitarian function and includes a model of any such article;

***utilitarian function***, in respect of an article, means a function *other than merely serving as a substrate or carrier for artistic or literary matter*.

WEST ELM® Table Lamp  
(a useful article)



## What do *Star Athletica* Type Cases Look Like in Canada?

“Useful articles” are *excluded* from copyright protection, *except* to the extent that one or more of certain *exceptions to the exclusion* apply.

- (a) a graphic or photographic representation that is applied to the face of an article;
- (b) a trade-mark or a representation thereof or a label;
- (c) material that has a woven or knitted pattern or that is suitable for piece goods or surface coverings or for making wearing apparel;
- (d) an architectural work that is a building or a model of a building;
- (e) a representation of a real or fictitious being, event or place that is applied to an article as a feature of shape, configuration, pattern or ornament;
- (f) articles that are sold as a set, unless more than fifty sets are made

*Copyright Act at §64(3)*

## What do *Star Athletica* Type Cases Look Like in Canada?

### Exceptions?

- (a) a graphic or photographic representation that is applied to the face of an article;
- (c) material that has a woven or knitted pattern or that is suitable for piece goods or surface coverings or for making wearing apparel;



## What do *Star Athletica* Type Cases Look Like in Canada?

### Exceptions?

- (a) a graphic or photographic representation that is applied to the face of an article;
- (e) a representation of a real or fictitious being, event or place that is applied to an article as a feature of shape, configuration, pattern or ornament;



## What do *Star Athletica* Type Cases Look Like in Canada?

### Exception?

- (d) an architectural work that is a building or a model of a building;



**Backyard playsets are not buildings or models of buildings.**  
*Corocord Raumnetz GmbH v. Dynamo Industries Inc.*, 2016 FC 1369.

## What do *Star Athletica* Type Cases Look Like in Canada?

### Exceptions?

(a) a graphic or photographic representation that is applied to the face of an article?

(b) a trade-mark or a representation thereof or a label?



## What do *Star Athletica* Type Cases Look Like in Canada?

### Exceptions?

(a) a graphic or photographic representation that is applied to the face of an article;



## What do *Star Athletica* Type Cases Look Like in Canada?

***Exceptions?***

WEST ELM<sup>®</sup> Table Lamp  
(a useful article)



## What do *Star Athletica* Type Cases Look Like in Canada? **Enforcement.**

1. Section 5 of the Copyright Act implements national treatment for foreign works in accordance with the Berne Convention.
2. There is no requirement that the foreign author has observed formalities in the home country.
3. Section 34(1) of the Copyright Act creates a cause of action for copyright infringement.
4. Section 54 of the Copyright Act provides for registration of copyright in works, but *not* as a prerequisite to enforcement.



## What do *Star Athletica* Type Cases Look Like in Europe?

1. Design protection is typically included in copyright laws of EU countries. (e.g. U.K. *Copyright, Designs and Patents Act 1988*)
2. Under the EU Design Directive (*Directive 98/71/EC*) a *design* is defined as :  
"the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation."
3. A design is protectable to the extent that it is new and has "*individual character*."
4. Both *registered* and *unregistered* designs are protected.
5. Limited term. (e.g. In U.K., 15 years for unregistered designs, with some compulsory licensing.)

## What do *Star Athletica* Type Cases Look Like in Europe?

The most interesting cases arise in the context of EU trademarks.

## What do *Star Athletica* Type Cases Look Like in Europe?

### General Rule:

“An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

*Ch. II, Sec.1, Art. 4*

## What do *Star Athletica* Type Cases Look Like in Europe?

### Exceptions for functional features:

1. The following shall **not** be registered:

(e) signs which consist exclusively of:

- (i) The shape, or another characteristic, which results from *the nature of the goods* themselves;
- (ii) The shape, or another characteristic, which is necessary to obtain a *technical result*;
- (iii) The shape, or another characteristic, which *adds substantial value* to the goods;

*Ch. II, Sec.1, Art. 7*

## What do *Star Athletica* Type Cases Look Like in Europe?

The following shall **not** be registered [as a trademark]:

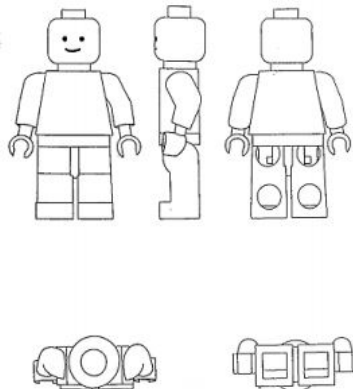
(e) signs which consist exclusively of:

- (i) The shape, or another characteristic, which results from the nature of the goods themselves;
- (ii) The shape, or another characteristic, which is necessary to obtain a technical result;



LEGO Blocks

## What do *Star Athletica* Type Cases Look Like in Europe?



LEGO figurines

## What do *Star Athletica* Type Cases Look Like in Europe?

**Q:** Do any of these exceptions to registrability apply to LEGO's figurines?

The following shall **not** be registered:

(e) signs which consist exclusively of:

- (i) The shape, or another characteristic, which results from the nature of the goods themselves;
- (ii) The shape, or another characteristic, which is necessary to obtain a technical result;
- (iii) The shape, or another characteristic, which adds substantial value to the goods;

**A:** There was no evidence that the shape of the LEGO figure was dictated by the goods. The features of the TM have no relationship to the "interlocking function." There was no evidence that the shape "added substantial value."

*Best-Lock Europe (Ltd) v OHIM — Lego Juris*, EU Gen. Ct., Cases T-395/14 and T-396/14

## What do *Star Athletica* Type Cases Look Like in Europe?



A combination of shape and/or location **and** color.  
This is not simply the color red as a TM for shoes!

## What do *Star Athletica* Type Cases Look Like in Europe?



## What do *Star Athletica* Type Cases Look Like in Europe?

**Q:** Do any of these exceptions to registrability apply to Louboutin's red soles?

The following shall **not** be registered:

(e) signs which consist exclusively of:

- (i) The shape, or another characteristic, which results from the nature of the goods themselves;
- (ii) The shape, or another characteristic, which is necessary to obtain a technical result;
- (iii) The shape, or another characteristic, which adds substantial value to the goods;

**A:** (i) The *shape* may result from the nature of the product being a shoe, but the *color* does not. (ii) The red color is not necessary to make the shoes function, but the shape might be.

“Furthermore, while it is true that the shape of the product plays a role in creating an outline for the colour, it cannot, however, be held that a sign consists of that shape in a case where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product”

*Louboutin v. Van Haren Schoen*, CJEU Case No. C-163/16

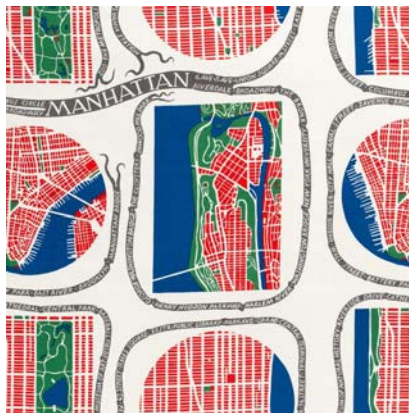
## What do *Star Athletica* Type Cases Look Like in Europe?

- *Svenskt Tenn v. Textillis*, ECJ Case No. C-21/18
- This pattern, **printed on textiles**, such as bed covers, table cloths, and wall hangings can serve as a TM for those goods.
- It is irrelevant that the pattern is copyrightable, and that copyright was owned by someone other than the TM owner.



## What do *Star Athletica* Type Cases Look Like in Europe?

- Under **Canadian** copyright law, would this design, imprinted on a table cloth, be a protectable work even though the table cloth is a Useful Article?
  - **(a)** a graphic or photographic representation that is applied to the face of an article





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