

NO LEGO, YES LOGO: The Federal Court of Appeal Protects Innovation in *Kirkbi AG and Lego Canada Inc. v. Ritvik Holdings Inc.*

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It has been well said that the most successful form of copying is to employ enough points of similarity to confuse the public with enough points of differences to confuse the courts.¹

Introduction

The name “Lego” is derived from two Danish words that are the equivalent of “play well”.² On July 14, 2003, the Appeal Division of the Federal Court of Canada handed down its decision on this very matter in *Kirkbi AG and Lego Canada Inc. v. Ritvik Holdings Inc.*³ The case explored the potential for proprietary protection of wares beyond the expiration of a patent through the commencement of passing-off actions under trade-mark law. Whereas a patent is a monopoly on technology for a limited period of time, a trade-mark is a potentially perpetual monopoly on a mark that serves to indicate the source of the product to the public.⁴ A mark may take the form of a name or a logo on the product or its wrapping, as opposed to the subject matter of a patent, which is the engineering or functional essence of a product. Additionally, where a mark takes the form of the shaping of the wares themselves or their wrapping, it is referred to as a “distinguishing guise”. The decisions address the elusiveness of trade-mark protection for unregistered and registered distinguishing guises that relate primarily to the functionality of the wares.

Kirkbi AG and Lego Canada Inc., the appellants (“Lego”), claimed that the configuration of the top of their blocks — i.e., the arrangement of cylindrical studs with the “LEGO” name inscribed on their tops (the “Lego indicia”) — constituted a distinguishing guise. Lego contended that *Ritvik Holdings Inc.* (“Ritvik”), the defendant, had infringed upon its distinguishing guise by the manufacture and sale of its Micro line of building blocks, a plastic toy system very similar to Lego blocks. Despite its functionality, Lego convinced the Court that the Lego indicia had acquired a distinctiveness as to source for the Canadian public, the hallmark of a trade-mark. However, in a 2-1 decision, the majority of the

Court held that Lego was not entitled to receive trade-mark protection irrespective of the Lego indicia being popularly distinctive of Lego as the source of the wares. Following its earlier decision in *Remington Rand*,⁵ the Court affirmed that the doctrine of functionality serves to delineate what is properly the subject of a trade-mark. In *Remington Rand*, it was held that where a distinguishing guise primarily or essentially relates to the wares themselves, that functionality will invalidate the trade-mark.⁶ In this case, the Lego indicia (except for the inscribed “LEGO” name), were considered functional in all respects and, therefore, could not be a distinguishing guise in either the statutory or common-law sense of the term.

The majority of the Court opined that Lego was attempting to extend its monopoly beyond the bargain struck with the public when it was granted a patent.⁷ Permitting protection for the utilitarian features of Lego blocks under the trade-marks regime would have set a precedent for Lego and others to acquire a renewable monopoly on their wares. Inevitably, this would act as a disincentive for innovation and render it difficult for competitors to enter the market. In disallowing the passing-off action, the Court decided in favour of competition and innovation by ensuring that formerly protected patent knowledge flows to the public realm.⁸ This article will discuss the case at the trial and appellate levels. It will specifically address the underlying policy debate between the majority and the dissenting decisions at the Federal Court of Appeal. The author will compare this debate to two similar international cases involving Lego’s infamous intellectual property litigation. With this recent finding in the 40-year-old saga of international case law surrounding Lego’s trade-mark enforcement strategy, the Appeal Division of the Federal Court of Canada joins the ranks of several other courts that have similarly excluded protection for Lego based on the doctrine of functionality.⁹ The comment concludes with some suggestions as to the implications of this decision in respect of its implicit endorsement of

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branding and marketing, especially in the context of functional modular products, such as Lego. In seeking to uphold competition by allowing others to use the utilitarian elements of expired patents, trade-mark law raises the potential for competitors to “piggy-back” on the goodwill of established competitors. This has created a situation where branding and marketing have become vital for incumbent manufacturers wishing to maintain proprietary protection. As a result of *Kirkbi*, the makers of functional modular products have limited prospects of maintaining their monopoly rights through trade-mark protection outside of adopting an aggressive branding and packaging strategy, which could include a distinctive ornamental dress on the ware itself or its packaging (i.e., a distinguishing guise). We will briefly question whether the innovation and competition imperative impelling intellectual property policy is served by a regime that endorses branding and its potential inefficiencies.

Decision at the Federal Court—Trial Division

Kirkbi AG et al. v. Ritvik Holdings Inc. involved Lego launching a passing-off action against Ritvik, a Canadian toy manufacturer. Lego did not try to defend its proprietary interest in the Lego indicia through patent law, since their patent expired in 1988. Instead, Lego contended that Ritvik had used the Lego indicia in association with the promotion and marketing of its Micro blocks. Lego alleged that the defendant had directed public attention to its wares in such a way as to cause confusion in the Canadian marketplace between its wares and those of Lego, contrary to paragraph 7(b) of the *Trade-marks Act*.¹⁰

Gibson J. first queried whether the Lego indicia was a valid trade-mark and, thus, capable of supporting an action for passing-off under paragraph 7(b) of the Act. The Court was presented with expert evidence on behalf of Ritvik as to the functionality of each element of the Lego indicia. Citing *Remington Rand*, Ritvik argued¹¹ that a distinguishing guise is invalid where “a mark goes beyond the distinguishing of the ware of its owner to the functional structure of the wares themselves”.¹² Lego countered by arguing that there is no mention of functionality in the definitions of either “trade-mark” or “distinguishing guise” in section 2 of the Act. It contended that functionality only plays a role in the scheme of the Act with respect to the registration and expungement of registered trade-marks and distinguishing guises.¹³ In his decision, Gibson J. noted that the requirements of a statutory passing-off action in paragraph 7(b) do not evoke either of the definitions of trade-mark or distinguishing guise as defined in the Act.¹⁴ Instead, he affirmed that the common-law definition of distinguishing guise applies to this section. He cited the decision of the Federal Court of Appeal in *Remington Rand*, which held that a distinguishing guise that is essentially functional does not fall

within the common-law definition of that term.¹⁵ Lego’s alleged distinguishing guise was found unable to support an action for passing-off. In conclusion, Ritvik was held not to have contravened paragraph 7(b) of the Act on the basis that to whatever degree it had adopted the Lego indicia, it had not infringed upon a mark that was indicative as to source.

In the alternative, Gibson J. questioned whether Ritvik had acted contrary to paragraph 7(b) by directing public attention to its Micro blocks by using the Lego indicia in such a way as to cause confusion in Canada. Gibson J. affirmed that paragraph 7(b) is the statutory equivalent of the common-law action of passing-off.¹⁶ He reviewed the evidence against the elements for the common-law test for passing-off: the existence of goodwill, deception of the public due to a misrepresentation, and actual or potential damage to the plaintiff. In terms of goodwill flowing from the use of the Lego indicia, Gibson J. held that Lego’s goodwill — “in the sense of benefit and advantage of the good name, reputation and connection of its business”¹⁷ — was derived to a certain degree from the Lego indicia.¹⁸ In respect of the deception of the public due to a misrepresentation, the Judge canvassed survey evidence and held that Lego had discharged its onus of showing the likelihood of confusion in the Canadian marketplace based upon its competitors’ uses of the Lego indicia.¹⁹ However, he further held that Lego had failed to show that the misrepresentation flowing from Ritvik’s adoption of the Lego Indicia was a deliberate strategy on the part of the defendant.²⁰ Instead, the Court opined that the confusion in the marketplace was a product of Lego’s promotion of a functional modular product in a way that did not clearly distinguish a mark indicative of source from a mark simply expressive of its engineering. This is to say that Lego made few efforts in either the ornamentation of the bricks or their wrapping towards the creation of a distinguishing guise or trade-mark as distinct from their preferred embodiment. This situation left little room for competitors, such as Ritvik, to distinguish their own toy blocks. Gibson J. concluded that confusion without the intent to misrepresent did not amount to passing-off.²¹ Thus, Lego’s action was dismissed.

The *Kirkbi* Decision, Federal Court of Appeal

Lego’s appeal from the decision of Gibson J. was heard by the Federal Court of Appeal at Toronto. The Court presented itself with two questions. First, it inquired into its ability to intervene in the findings of fact by the trial judge in respect of the functionality of the Lego indicia. The Court held that the standard to be applied when reviewing such decisions at the appellate level is that of “palpable and overriding error”.²² After a brief discussion of the utilitarian nature of Lego bricks, the Court decided not to interfere with the finding of

Gibson J. that the Lego indicia were functional. Second, the Court addressed the question of the validity of trade-marks that are primarily functional. It decided that this is a question of law and, therefore, the standard to be applied is one of “correctness”.²³ Citing its decision in *Pizza Pizza Ltd. v. Canada (Registrar of Trade-Marks)*²⁴ and *Remington Rand*, the majority of the Court held that where functionality is merely peripheral to the wares, then that is not sufficient to preclude trade-mark protection.²⁵ However, based on the doctrine of functionality, the majority decided that the Lego indicia did not satisfy the definition of “trade-mark” as found in the Act and at common law, due to their primarily functional nature.²⁶ Thus, since Lego could not hold a trade-mark on its toy blocks, Ritvik’s adoption and use of the Lego indicia had not contravened the provisions of the Act. In short, a trade-mark that is primarily functional cannot sustain an action for passing-off under paragraph 7(b) of the Act.

Lego’s action was founded upon two principal arguments. First, based on a plain language reading of the Act, Lego argued against importing the doctrine of functionality as an interpretive tool.²⁷ Under the *Unfair Competition Act, 1932*, the precursor to the *Trade-marks Act*, functionality was expressly mentioned as a consideration in the assessment of distinctiveness. Lego argued that since the *Trade-marks Act* does not mention functionality in the definitions of “trade-mark” or “distinguishing guise” in section 2, then functionality is not relevant to the existence of a distinguishing guise trade-mark; it is only relevant to the issue of registrability. The majority of the Court rejected these arguments, and held that the provision from the *Unfair Competition Act, 1932* on distinctiveness and functionality was never meant to be determinative of the separate question of validity. Instead, Sexton J.A., for the majority, held that the common-law doctrine of functionality “arose as a necessary part of trade-mark law as interpreted by the courts over the last 60 years. Its purpose was to prevent the obvious abuse of permitting a person to effectively obtain perpetual patent protection by means of a trade-mark.”²⁸ The doctrine of functionality was held to define the limits of trade-mark protection for registered trade-marks under both Acts as well as for unregistered trade-marks at common law.²⁹ Regardless of the omission by the drafters of the *Trade-marks Act* in a provision for distinctiveness, the Court held that the 60 years of judicial consideration of trade-mark validity through the optic of the doctrine of functionality remained in force.

Second, and in the alternative, Lego asserted that the unregistered status of its distinguishing guise meant that the doctrine of functionality did not apply.³⁰ The doctrine basically militates against the extension of patent protection beyond the 20-year maximum period through trade-mark protection. Lego argued that since, by definition, unregistered trade-marks do not enjoy the unqualified monopoly rights attaching to registered trade-marks, the doctrine of functionality need not be

applied to address its non-existent monopoly.³¹ Whereas a registered trade-mark grants the exclusive use of a mark to a trade-mark holder, Lego argued that an unregistered holder acquires only a qualified proprietary interest. It argued that this interest is limited, as competitors may market products based on the same utilitarian features so long as other incidental or ornamental material is added to the product so as to eliminate confusion in the mind of the public as to source. In other words, since the doctrine of functionality is intended to defend against monopolies, and the qualified proprietary interest of unregistered marks supports healthy oligopolies, the doctrine should not apply in the context of unregistered trade-marks.³² In the context of a registered trade-mark, it was argued that the exclusive right to use means that the addition of ornamental or other elements to a trade-mark by competitors is not enough to avoid a successful claim of injunctive relief by the registered owner (as opposed to the unregistered context, where such additions may be sufficient).³³ It follows, argued Lego, since registration inhibits competition, that the protection granted to a registered trade-mark should not include functional aspects, as this would inevitably curtail innovation. By contrast, since the qualified right of an unregistered trade-mark supports competition, functionality need not be a bar to the validity of a trade-mark. Lego further contended that the objective of avoiding confusion as to source for the public would be thwarted by a universal application of the doctrine of functionality. In conclusion, Lego argued that primarily functional unregistered trade-marks are capable of sustaining an action for passing-off under paragraph 7(b) of the *Trade-marks Act* and that it was entitled to injunctive relief.

The Court noted that if the doctrine of functionality did not apply to unregistered trade-marks, then they would become more lucrative than registered trade-marks because holders of expiring patents could prolong (or “evergreen”) the protection of their intellectual property over the functionality of their wares by remaining or becoming unregistered trade-mark holders.³⁴ In *Whirlpool Corp. v. Camco Inc.*³⁵, Mr. Justice Binnie described the prohibition on evergreening as it applies to patents:

A patentee who can “evergreen” a single invention through successive patents by the expedient of obvious or uninventive additions prolongs its monopoly beyond what the public has agreed to pay.³⁶

The appellant sought to evergreen its intellectual property protection not through the addition of uninventive features and the application for a patent, but by availing itself of trade-mark law and arguing that the doctrine of functionality did not act as a bar to unregistered trade-marks. The respondent successfully argued that Lego was attempting to evergreen its former patent on the wares themselves through trade-mark law.³⁷ Although holders of unregistered trade-marks would still face the difficulties of proving validity and the expense of defending their title from infringement, a fate avoided by the *prima facie* proof of validity granted by registration, the Court

implied that the benefits of a perpetual monopoly would more than compensate for these costs.³⁸ This form of monopoly would grant unregistered trade-mark holders a benefit that would exceed any available under registration. Such a result would usurp the reasoning behind the trade-mark registry and lead to the uncertainty of ownership it was created to readdress.

Thus, except for the imprinted “LEGO” script on the top of each stud, which itself is a trade-mark, the Lego indicia did not serve to distinguish the wares in the sense contemplated by the category of a distinguishing guise. The Court affirmed that the efficient design of the top of the blocks was dictated by the demands of the essence of the Lego blocks (e.g., “clutch power” and “playability”) and could not have been designed with the intention of distinguishing the source of the product.³⁹ This is analogous to the finding by the Court of Exchequer in *Imperial Tobacco Co. of Canada v. Canada (Registrar of Trade-marks)*,⁴⁰ where it was held that the cellophane wrapping and the red tear-strip of a cigarette package wrapper could only have ever been designed along the lines of utility, with a mind turned to repelling moisture rather than formulating a distinguishing guise.

The case law reveals that while a trade-mark or a distinguishing guise may have a functional component (such as a bottle of lemon juice shaped like a lemon⁴¹), where the shape of the wares or their containers, or the mode of packaging of the wares claimed for protection primarily relates to the wares and is lacking in ornamentation, protection is properly granted in the form of a patent or industrial design. Patent protection is usually discussed in terms of a contract between the public and the inventor; it is meant to provide a financial incentive to inventors in the form of a monopoly of limited duration as remuneration for their advancing of the state of the art. The expiration of the monopoly is vital for encouraging experimentation and competition in the market. Patent rights are, therefore, a means for the market to provide incentive for a self-sustaining cycle of invention, growth, and efficiency. If a patentee could evergreen a monopoly — for instance, by pursuing passing-off actions based on an essentially functional distinguishing guise — then society would witness a diminishing return from its intellectual property regime: there would be little incentive to advance the state of the art on the part of the patentee or others, and the price of wares would remain inflated in the absence of the pressures of competition.

In terms of Lego’s argument about piggy-backing on reputation and the confusion as to source which could flow from the universal application of the doctrine of functionality, the majority of the Court turned to the legal definitions of trade-mark and patent protection. Sexton J.A. stated that trade-mark protection is not the legal vehicle to obtain protection for what is properly the subject of a patent. As the majority disposed of the case based on the doctrine of functionality, it did not directly

address the issue of confusion, which figured so prominently in the dissenting reasons.⁴² The majority’s focus on functionality is a tacit endorsement of the proposition that the bargain struck between the inventor and the public with the granting of a patent must trump concerns for confusion as to source. In any event, market forces would punish those with weak trade-marks. In other words, competitive market forces and the impending expiration of a patent should animate Lego and other manufacturers to differentiate their wares from their essential form or preferred embodiment.

The majority decision is an affirmation of the liberal economic policy informing the bargain between the public and inventors along two poles: the duration of a patent and the benefits of trade-mark registration. The doctrine of functionality is clearly stated as the legal expression of this policy. In both common-law and statutory passing-off actions, the proprietary protection of functional elements is limited to the life of a patent so as to strike the balance between rewarding and encouraging technological innovation. Regardless of the acquired distinctiveness as to source flowing from a design — whether Lego blocks, the triple-head of a Philips electric shaver,⁴³ or an ergonomic foam shoulder rest for a violin⁴⁴ — when the patent on a design that is expressive only of its engineering essence expires, the doctrine of functionality places its guise beyond trade-mark protection. The effect of the affirmation of the doctrine of functionality also serves to buttress the trade-mark registration regime. Since the doctrine was held to apply equally to both registered and unregistered trade-marks (and distinguishing guises), registration, and the certainty of title it confers, was affirmed as the basis for an efficient trade-mark regime. Thus, registered trade-marks retain a critical advantage over unregistered marks. In the end, the self-sustaining cycle of incentive, growth, and efficiency of liberal intellectual property regulation is fostered in this decision by its delineation of the duration of a patent and affirmation of the benefits of trade-mark registration.

The Dissenting Opinion

Pelletier J.A., in dissent, argued that where numerous players share the same functional design, competition dynamics will naturally force competitors to differentiate their wares, thus reducing confusion. Pelletier J.A. proffered that the existence of a qualified proprietary right to exclusive use for unregistered owners, and the competition it engenders, was free from the risk of piggy-backing on the goodwill of the incumbent producer which would be produced by the majority’s decision.⁴⁵ The implication of Pelletier J.A.’s argument is that the majority reasoning, out of a blind adherence to promoting competition, abdicates its public service role of discouraging confusion as to source by allowing multiple

competitors to piggy-back. By contrast, the position of the majority is that the inventor has already been remunerated for the invention and, at the expiration of the patent, the invention enters the public domain. This is to say that to require emerging competitors to alter the dress of a ware that is rightly the property of society is to effectively grant incumbent inventors protection on the essence of the design which they are no longer owed. This would produce an uneven playing field in the market. Indeed, Pelletier J.A.'s position presents difficulties in cases where the augmentation of the ware, beyond its preferred embodiment in the interests of not confusing the public, would require a scale of alterations that would potentially render the competing ware less efficient, elegant, and marketable. Thus, Pelletier J.A.'s argument as to the existence of competition stemming from unregistered trade-marks would not be tenable in all cases, not the least of which would be functional modular systems, where even modest changes to a design could nullify compatibility and competitiveness. The result would be the uneven application and predictability of trade-mark law; for some products, a change in the colour would be enough so as to not confuse the public, whereas for others, the degree of change required would act as a bar to competition and a *de facto* monopoly would emerge, condoned by trade-mark law. Out of its overriding concern for clarity as to source, Pelletier J.A.'s decision posits that the continued exploitation of the public by the holder of an expired patent is a lesser evil than permitting piggy-backing on the good will of another.

Functionality in Germany and Italy

In place of the objective test of functionality presented by the majority, Pelletier J.A. presented a commercial ethical argument that sought to avoid the confusion as to source putatively promoted by the objective test. Instead of focusing on the monopoly that Lego holds on interlocking toy block systems, this argument addresses the unfair competition that results where competitors are permitted to imitate a product and piggy-back on both its development and goodwill. Decisions in some European courts have also tackled unfair competition within a commercial ethical framework, but from a different angle; with recourse to the distinction between functionality and necessity.⁴⁶

In the famous and controversial case, *Klemmbaustein*,⁴⁷ Lego successfully sought protection under the law of unfair competition against the copying of its bricks following the expiration of its patent. The German *Unfair Competition Act* is drafted in broad language which has allowed the German courts to decide unfair competition issues with a degree of latitude commensurate with the evolving requirements of the business community. The German Bundesgerichtshof ("BGH") held that the sale of identical copies of Lego bricks by a

competitor infringed Lego's rights and amounted to unfair competition. The BGH decided that although the Lego indicia was functional, it could indeed be configured otherwise and, thus, was not necessary. This is to say that since the configuration of the Lego indicia was held not to be essential, the doctrine of functionality did not apply. With this decision, competitors were free to make their own functionally similar toy blocks, but they were barred from making blocks identical to those of the Lego system. In reaching its decision, the BGH held that the Lego modular system was a *single distinct market*: if competitors could make parts for Lego systems, this would affect the sale of Lego. The BGH contrasted this to the case of spare parts for automobiles; the manufacturing of cars and spare parts are considered *two separate, but parallel, markets* because the manufacturing of spare parts does not impinge on the primary market of a car manufacturer. Competitors are permitted to manufacture parts for cars that they do not produce because to not allow them to do so would give car manufacturers a monopoly in both their primary and subsidiary markets. As Cuonzo and Pike note:

The BGH stated that the competitor was perfectly able to produce its own set of interlocking bricks and there was therefore no justification for encroaching on Lego's hard won market by making bricks identical to and compatible with Lego's. With this reasoning the BGH struck a balance between on the one hand allowing competitors to enter the market of toy building bricks and on the other allowing Lego to protect its own set of bricks.⁴⁸

The substitution of an objective test for functionality with a subjective test for unfair competition informs the smaller portion of the international case law involving Lego.⁴⁹

Despite the fact that *Klemmbaustein* was not mentioned, the Italian Supreme Court applied the same economic rationale⁵⁰ in the controversial case, *Lego Systems*.⁵¹ In contrast to the broad discretion available to the BGH, the Italian Supreme Court made its decision under the narrower unfair competition provisions found in Article 2598(1) of the *Italian Civil Code* and related case law. Lego appealed the decisions of Milan's District and Appeal Courts, which held that Tyco and other competitors were free to copy the functional aspects of Lego blocks so long as its patents had expired. In overturning the decisions of the lower courts, the Supreme Court held that although the Lego indicia were functional, they were not necessary; competitors were free to produce functionally similar blocks (i.e., those with "clutch power") provided that the form of the blocks, such as the arrangement of the cylindrical studs, was different. The Italian Supreme Court sought to strike a balance between protecting Lego's investment and research, and affording competitors the opportunity to market functionally similar blocks.

Although the reasoning of these courts supports the protection of functional modular systems, it becomes problematic in instances where there is already a domi-

nant manufacturer, because such protection actually would serve to support a monopoly. The result would be similar to one where a decision was motivated by concerns for piggy-backing and confusion, such as that proffered by Pelletier J.A. It may be argued that these commercial ethical arguments do not strike a balance between rewarding an inventor and stimulating innovation and economic growth, but instead produces a lessening of competition. In the context of a modular ware and a monopolistic market, such as in the case of Lego, it is dubious whether other players can realistically compete without recourse to a level of imitation synonymous with compatibility.⁵²

Conclusion

Kirkbi AG and Lego Canada Inc. v. Ritvik Holdings Inc. stands for the proposition that although a distinguishing guise may have a functional element, the extent to which it relates primarily to the wares themselves — where the form or wrapping of a product is really a result of its engineering and not its marketing — it ceases to be a distinguishing guise and becomes a matter more properly protected under patent law. This decision leads to the conclusion that where the form and, in this case, distinctiveness of a ware are purely drawn from its functionality, as opposed to an ornamentation intended to mark the source of the product, there are two possibilities open for those seeking monopolistic proprietary rights. First, these rights could be pursued by means of obtaining a patent. Second, where the first alternative is unavailable or its expiration date is approaching, (would-be) trade-mark holders could undertake a range of strategies in the hopes of engendering goodwill towards the ware before others are able to exploit the patent. These strategies may include adding non-functional material (or an “innocuous variation”), adopting distinctive packaging, and pursuing an aggressive branding scheme.

This case suggests that if one designs a product in an efficient way, based on principles of functionality, then one cannot expect to be able to extend a patent over the product with a trade-mark based on that efficient design. Furthermore, if one produces wares that are modular (such as a system of interlocking blocks, or any other wares designed in the preferred embodiment), then there is even less of an opportunity for an extended monopoly than if one produces wares that are less refined or non-modular, because the latter can be more readily the subject of a new patent for an innovation and/or distinguishing guise. From the one perspective, this decision seems to encourage inventors interested in long-term monopoly rights to advance the state of the art only so far as necessary to attract customers, but not so far as to exhaust the prospects for future patents based

on uninventive “improvements”. However, the policy behind the decision would undoubtedly maintain that the pressures of competition in the market would act as a corrective to ensure that any gross complacency towards invention would result in consequences to the bottom line.

This case deals with functional modular designs. Products that would fall into this category would include not only Lego toy blocks, but also an array of products whose “simple”, efficient engineering and unadorned aesthetic both flow from function, on the one hand, and are a source of distinctiveness, on the other. Inventors of such products are naturally disinclined to adopt guises that would interfere with their engineering, as they have already adopted the preferred embodiment. Nevertheless, this decision highlights that the interrelationship of patent and trade-mark law necessitates branding and marketing, as well as the adoption of an incidental element or ornament. An illustrative example of a company that has faced these intellectual property challenges is Interface, the world’s largest manufacturer of flooring.⁵³ This company chose fashionable colour combinations and patterns in its design of an extensive line of functional modular floor tiles. It also adopted a stylized logo based on the (functional) adhesive dots used to anchor the tiles to the floor. Part of its branding has also included its commitment to significantly reducing the company’s environmental footprint. Along with its compelling catalogue marketing, Interface has marshaled its putatively “ephemeral rights”⁵⁴ in 19.69 × 19.69 inch tiles into not only consistently successful sales but also a means of maintaining enforceable trade-mark protection.

Because of the opportunity for piggy-backing and the affirmation of the duration of patents in the majority decision, clever branding and marketing will only be encouraged. In addition to manufacturers competing for consumers based on reputation, quality, innovation, and price, one may argue that the intellectual property regime has ensured that branding and marketing forever play a critical role. In other words, instead of the public being free to reward producers for superior functional modular products — the beauty and identity of which flow from their function — the public is motivated to reward them for something arguably external to both the efficient advancement of the art or science and the sustainability of the economy: their spin.⁵⁵ In the case of Interface, we have seen this spin take an environmentally sustainable form. It remains to be seen whether the self-sustaining cycle of innovation that intellectual property law aims to uphold benefits in the many other instances where the efforts of advertisers and marketing professionals, as opposed to designers, engineers, and environmentalists, are the first to be rewarded.

Notes:

- ¹ *Baker et al. v. Master Printers Union of New Jersey*, 34 F. Supp. 808, 1940 U.S. Dist. LEXIS 2667 (D.C.N.J. 1940) [cited to LEXIS] at 7.
- ² *Kirkbi AG et al. v. Ritvik Holdings Inc.*, [2002] F.C.T. 585, 20 C.P.R. (4th) 224 [Kirkbi (FCTD) cited to C.P.R.] at 237.
- ³ *Kirkbi AG and Lego Canada Inc. v. Ritvik Holdings Inc., Gestions Ritvik Inc.*, 2003 FCA 297, 228 D.L.R. (4th) 297 [Kirkbi cited to D.L.R.].
- ⁴ *Ibid.* at 317-18.
- ⁵ *Remington Rand Corporation. v. Philips Electronics NV*, [1995] F.C.J. No. 1160; (1995), 64 C.P.R. (3d) 467 (F.C.A.); leave to appeal refused, [1996] S.C.C.A. No. 78 (S.C.C.) [Remington Rand cited to C.P.R.].
- ⁶ *Ibid.* at 478.
- ⁷ As the facts of this case reveal, two successive patents allowed Lego to garner patent protection in Canada for over 50 years: see *Kirkbi, supra* note 3 at 347.
- ⁸ The Court, in *Kirkbi*, sets out the policy followed in trade-mark cases as established in *Thomas and Betts Ltd. v. Panduit Corp. et al.* (2000), 4 C.P.R. (4th) (F.C.A.) at 343-44.
- ⁹ G. Cuonzo and E. Pike, “The Italian Supreme Court Adopts the ‘Klemmbaustein’ Approach to Protection of Lego Bricks” [2000] Eur. J.P. Rev. 22(3) at 136-140. See page 136: These courts include the French Cour de Cassation [SA *Lego v. SARL Tomy*, Cour de Cassation, March 29, 1994, [1995] G.R.U.R. 505]; Supreme Court of Norway–Høyesterett [December 20, 1994 [1995] G.R.U.R. Int. 508]; District Court of Milan [*Lego Systems A/S and Lego Spa v. Tyco Industries Inc. and Arco Falc Srl*, Trib Milano, October 28, 1991 [1991] Giur. Ann. Dir. Ind. 2712]; Court of Appeal of Milan [*Lego Systems A/S and Lego Spa v. Tyco Industries Inc. and Arco Falc Srl*, App. Milano, December 30, 1994 [1995] I Foro Padano 87]; Italian Supreme Court [*Lego Systems A/S and Lego Spa v. Tyco Industries Inc. and Arco Falc Srl*, March 9, 1998 [1998] I Foro Italiano 2475, [Lego Systems]]. From *Kirkbi, supra* note 3 at 345-46; the High Court of Justice, Chancery Division [*Interlego AG’s Trade Mark Applications*, [1998] R.P.C. 69, Lexis U.K. Patent Cases 44 (Transcript)]; District Court of New Jersey [*Tyco Indus. v. Lego Systems, Inc.*, 5 U.S.P.Q. 2d 1023 at 1039 (D.N.J. 1987), aff’d, 853 F.2d 921 (3d Cir.), cert. Denied, 488 U.S. 955 (1988)].
- ¹⁰ R.S.C. 1985, c. T-13 [the Act].
- ¹¹ *Kirkbi* (FCTD), *supra* note 2 at 249.
- ¹² *Remington Rand, supra* note 5 at 478.
- ¹³ *Kirkbi* (FCTD), *supra* note 2 at 250.
- ¹⁴ *Kirkbi* (FCTD), *supra* note 2 at 251-52. This separation of paragraph 7(b) from the definitions found in section 2 of the Act was found to be an error of law by the Federal Court of Appeal in *Kirkbi*. However, this error did not affect the result of the case: see *Kirkbi, supra* note 3 at 317.
- ¹⁵ See the comments of MacGuigan J. in *Remington Rand, supra* note 5 at 477-78; cited by Gibson J. in *Kirkbi* (FCTD), *supra* note 2 at 252.
- ¹⁶ *Kirkbi* (FCTD), *supra* note 2 at 259.
- ¹⁷ *Kirkbi* (FCTD), *supra* note 2 at 258-59.
- ¹⁸ *Kirkbi* (FCTD), *supra* note 2 at 270.
- ¹⁹ *Kirkbi* (FCTD), *supra* note 2 at 275-76.
- ²⁰ *Kirkbi* (FCTD), *supra* note 2 at 279. But see the dissenting opinion of Pelletier J.A. in *Kirkbi, supra* note 3 at 374-76, where he states that there is no authority for the requirement that intentionality be a component of misrepresentation.
- ²¹ *Kirkbi* (FCTD), *supra* note 2 at 279.
- ²² *Kirkbi, supra* note 3 at 312.
- ²³ *Kirkbi, supra* note 3 at 313.
- ²⁴ (1989), 26 C.P.R. (3d) 355 (F.C.A.).
- ²⁵ *Kirkbi, supra* note 3 at 326.
- ²⁶ *Kirkbi, supra* note 3 at 331.
- ²⁷ *Kirkbi, supra* note 3 at 328-31.
- ²⁸ *Kirkbi, supra* note 3 at 329.
- ²⁹ *Kirkbi, supra* note 3 at 339.
- ³⁰ *Kirkbi, supra* note 3 at 332.
- ³¹ *Kirkbi, supra* note 3 at 331-32.
- ³² As summarized in the dissenting opinion of Pelletier J.A.; see *Kirkbi, supra* note 3 at 356.
- ³³ *Kirkbi, supra* note 3 at 349-50.
- ³⁴ *Kirkbi, supra* note 3 at 339.
- ³⁵ 2 S.C.R. 1067, 2000 SCC 67 [cited to S.C.R.].
- ³⁶ *Ibid.*, at 1086-1087.
- ³⁷ *Kirkbi, supra* note 3 at 320.
- ³⁸ *Kirkbi, supra* note 3 at 339.
- ³⁹ *Kirkbi, supra* note 3 at 321.
- ⁴⁰ Ex. C.R. 141, 2 D.L.R. 65 (Ex. Ct.) [cited to D.L.R.] at 67.
- ⁴¹ *Reckitt & Colman Products Ltd. v. Borden Inc. & Ors*, [1990] R.P.C. 341, [1990] 1 All E.R. 873 (HL.).
- ⁴² *Kirkbi, supra* note 3 at 348.
- ⁴³ See *Remington Rand, supra* note 5.
- ⁴⁴ *Kun Shoulder Rest Inc. v. Joseph Kun Violin and Bow Maker Inc.* (1998), 83 C.P.R. (3d) 331; 157 F.T.R. 1 (F.C.T.D.).
- ⁴⁵ In contrast to Pelletier J.A.’s reading of *Singer Manufacturing Company v. Loog* (1880), 18 Ch. D. 395 (C.A.); aff’d (1882-1883), 8 App. Cas. 15 (H.L.), Sexton J.A. notes at paras. 68-71 that the right to exclusive use may be obtained with an unregistered trade-mark. He opines that proof of title is the major disadvantage to being unregistered, not want of right to exclusive use. Hence, it cannot be said that the unregistered interests are free from the dangers of monopolies.
- ⁴⁶ I am indebted to Cuonzo and Pike, *supra* note 9, for the illustrations of Klemmbaustein I, *infra*, and *Lego v. Tyco, infra*, which follow.
- ⁴⁷ *Klemmbaustein I* [1964] G.R.U.R. 621.
- ⁴⁸ Cuonzo and Pike, *supra* note 9 at 138.
- ⁴⁹ Cuonzo and Pike, *supra* note 9 at 138.
- ⁵⁰ Cuonzo and Pike, *supra* note 9 at 138.
- ⁵¹ *Supra* note 9.
- ⁵² From Cuonzo and Pike, *supra* note 9 at 139, this was argued by Tyco before the Hong Kong High Court: see *Interlego A*.
- ⁵³ Online: <http://www.interfaceflor.com/service/flor/index.html>.
- ⁵⁴ This term has been used to describe Lego’s rights in its bricks upon the expiration of their patents: see J. Phillips, “An Empire Built of Brick: A Brief Appraisal” [1987] 12 Eur. J.P. Rev. 363 at 366.
- ⁵⁵ Rather than implying that the Federal Court of Appeal is responsible for this state of affairs, I mean to simply point out the operation of the law in society.