



## **COPYRIGHT REGISTRATION EXPUNGEMENT GRANTED IN LAST-INNING VICTORY**

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It is trite to say that in a baseball game, there is no winner before the last inning is over. One gets the same impression when reading the judgement of Madam Justice Reed in *DRG INC. v. DATAFILE LIMITED and THE REGISTRAR OF COPYRIGHTS* (Federal Court of Canada, Trial Division, dated 20 November, 1987, Court no. T-1334-86).

The applicant was seeking the expungement of certain copyright registrations pertaining to labels designed to be affixed to folders to enable easy location of a file and easy identification of any misfiling which may take place.

The applicant raised six grounds for expungement. The respondent was successful with respect to the first five grounds, and it was only on the sixth ground that the applicant came back in force in the last-minute victory which became apparent only in the last few lines of the 26<sup>th</sup> page of the judgement. The grounds for expungement were dealt with as follows.

(1) The design is not proper subject matter for copyright because it lacks the characteristics of an artistic work.

Madam Justice Reed found that requiring Courts to determine what is “artistic”, and what is not, is not a happy situation. She expressed the view that it is not necessary for the Court to ascertain the degree of “artistic”-ness in order to decide whether a work falls in the category of an “artistic work”. She found that the respondent’s work was a graphic design reduced by a printing process. As such, it was an artistic work for purposes of copyright, and no higher standard of originality was required than in the case of literary copyright.

(2) The design is not a proper subject matter for copyright because it is essentially a functional tool.

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Madam Justice Reed found that she could not hold that simply because function and design coalesce in the work, the design thereby cannot be protected by copyright. She noted that many items specifically listed in the Copyright Act may be designed primarily to serve functional purposes: maps; charts; photographs; architectural buildings; works of artistic craftsmanship. She decided that though the label design was created to serve a functional purpose, it was not thereby deprived of the character of an “artistic work”, nor of copyright protection.

(3) The work is not sufficiently original because it does not constitute a substantial modification of the pre-existing art.

Madam Justice Reed thought that this was not a test for originality which applied in the field of copyright. This kind of test applied with respect to patents. The test is whether or not the work was the author’s original production. The Court decided that the respondent’s work had met the relevant requirements of originality: it was the original work of the author; it was not copied from another.

(4) The alleged author was not the author of the work.

It was argued by the applicant that the “work” was nothing more than an order to the printers to create labels having certain background colors. The Court did not accept this argument and found that, because the respondent had a registered copyright, the burden of proof was on the applicant to show that Mr. Barber was not the author. In light of the evidence adduced, the Court found that the applicant had not met the burden of disproving authorship by Mr. Barber.

(5) The “work” was disclosed in prior patents, and as such, was dedicated to the public.

The Court did not see much merit in this argument. It did not see how the disclosure of an idea in a patent can prevent copyright attaching to a work which uses the same idea but which is independently proper subject matter for copyright. The idea is not copyrighted. It is the form of expression which is the subject of the copyright.

(6) The design was registrable under the Industrial Design Act and therefore is not protected by copyright as a result of the operation of section 46 of the Copyright Act.

This argument was considered to be the most serious hurdle for the respondent. Section 46 of the Copyright Act precludes copyright protection of designs capable of being registered under the Industrial Design Act. The Court found that the respondent’s design was one that is *prima facie* registrable under the Industrial Design Act. The respondent brought forward four arguments in support of its contention that the label design could not be registered under the Industrial Design

Act. Having analysed all four sets of arguments, the Court concluded that section 46 of the Copyright Act applied and that the registration must therefore be expunged.



