Makerspaces and Canadian Intellectual Property Law

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Dr. Michael B. McNally
Assistant Professor
School of Library and Information Studies
University of Alberta

Dr. Samuel E. Trosow
Associate Professor
Faculty of Law and Faculty of Information
and Media Studies
University of Western Ontario
Outline

• Makerspaces, IP and Libraries

• Copyright Concerns

• Patent Issues

• Trademark Considerations

• Takeaways
Education and/or/versus Entertainment in Public Libraries

- Libraries do serve both purposes – education and entertainment

- From a copyright perspective though, education, research and private study are fair dealing categories, and in general entertainment is not

- Research will cover some personal interest uses, and according to the Supreme Court it:
  - “Can be piecemeal, informal, exploratory, or confirmatory. It can in fact be undertaken for no purpose except personal interest” (SOCAN v. Bell, para. 22)
Makerspace Technologies

• Some makerspace technologies (e.g. gaming consoles) present no IP concerns

• Most makerpace technologies (e.g. book printing machines, digital conversion tools) simply reproduce copyright issues of other library technologies

• 3D printers offer some unique considerations with regard to copyright, patents and trademarks

Source: B. Dring (2011)
Overview of Copyright, Patent and Trademark

- Copyright, patent and trademark are all forms of intellectual property (IP), but each has unique characteristics
  - **Copyright** covers literary, artistic, musical and dramatic works that are original and conveyed in a fixed medium
  - **Patents** cover inventions and must be novel, useful and non-obvious
  - **Trademarks** are used to distinguish goods and services in a marketplace

- Some key differences:
  - Copyrights and patents are conceptually linked to innovation, while trademarks are focused on reputational considerations
  - Patents have the most rigorous standards and application process
General Considerations

• When thinking about 3D printing and intellectual property law it is critical to keep in mind that you are often working with two separate elements: the object and the file [.stl is standard file format].

• The printed object and .stl file will attract different legal treatments under IP law

• Distinction between copyright and patent is important here.
  • Copyright protects original expressive/creative (nonfunctional) works --- attaches automatically the moment the work is created.
  • In contrast, patent protects functional objects. Protection is not automatic, and one needs to apply

• See https://www.pubricknowledge.org/news-blog/blogs/us-legal-lessons-from-canadas-first-stl-ip-infringement-case
Printed object and .stl file will attract different copyright treatments

- Functional object is generally not a work in which copyright subsists (important to distinguish functional object from a artistic object which may be treated as an artistic work/sculpture)
- But the .stl file is CODE, and code is treated as a literary work under copyright law
- Note that the files can be created several ways.... if it is scanned, then there is likely insufficient originality to warrant copyright (sweat of the brow inadequate per caselaw in US and Canada)
- But if file designed independently in CAD, it is more likely original (and then under copyright the creative elements exist independently from what is needed for utility)
- So even if the object is not protectable by copyright, the file may well be
- Several U.S. decisions on whether there are sufficient severable artistic elements to warrant copyright protection
Differences between U.S. and Canadian IP laws

• Major source of uncertainty (confusion) is that while much analysis is from U.S. perspectives but there are some key differences between U.S. and Canadian IP laws
• Canada has separate Industrial Design Act, focus in U.S. is between the creative/expressive and useful/functional aspects and whether they can be severed
• U.S. Copyright Act recognizes a broad derivative right as part of the bundle of owner's exclusive rights. Canadian Act does not
• “Notice and Takedown” (U.S.) v “Notice and Notice” (Canada) important difference
• In addition to fair dealing (with similarities and differences to U.S. fair use) Canada has very broad UGC exception
2-pronged analysis under Canadian Copyright Act

- Was there an infringement of one of the owners exclusive rights under section 3(1)?

- and if so...

- Is the use protected under fair-dealing, UGC exception or other exceptions/limitations?
Patent Issues

• Generally patents provide the strongest IP protection with the fewest exceptions for use

• However, in general the current limitations of 3D printing greatly limit the potential for patent infringement

• Patent Act also provides a number of limited exceptions including:
  • Experimental use related to the subject matter of the patent (Patent Act, s. 55.2(6))
  • Repair of patented product (Perry and Currier, 2012)

• Printing the components of a patented product with intent to sell the components as a kit constitutes infringement (Perry and Currier, 2012)

• Vaver suggests that a 19th Century English case (United Telephone Co. v. Sharples (1885)) may allow non-profit educational use, but this is untested
Trademark Concerns

• Two types of trademark infringement

  • Breach of the common law tort of passing off (*Trade-marks Act*, s. 7)

  • Infringement of a registered trademark based on:
    • Use of identical marks on identical wares or services (*Trade-marks Act*, s. 19)
    • Confusing marks (*Trade-marks Act*, s. 20)
    • Depreciation of a mark’s goodwill (*Trade-marks Act*, s. 22)
Trademark Concerns and Bill C-31

- Bill C-31 (Economic Action Plan 2014 Act, No. 1) includes important, changes to Canada’s *Trade-marks Act*

- Bill C-31 in part allows Canada to ratify three major Trademark agreements – the Madrid Protocol, the Singapore Treaty and the Nice Agreement

- Bill has received Royal Assent (June 19, 2014), but has not yet come into force

- Bill C-8 (Combating Counterfeit Products Act) also includes changes to Canada’s *Trade-marks Act*; however, this bill is still before Parliament
Trademark Concerns and Bill C-31

- Trademark is redefined as:
  - “a sign or combination of signs that is used or proposed to be used by a person for the purpose of distinguishing or so as to distinguish their goods or services from those of others” (Bill C-31, cl. 319(4))

- A “sign” is defined as:
  - “’sign’ includes a word, a personal name, a design, a letter, a numeral, a colour, a figurative element, a three-dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture and the positioning of a sign;” (Bill C-31, cl. 319(5))
Trademark Concerns and Bill C-31

• These changes considerably broadens what constitutes as a trademark
  • Importantly, with respect to makerspaces and 3D printers in particular, the three-dimensional shape of an object may constitute a trademark
  • However, a trademark is not registerable if its features are primarily dictated by a utilitarian function (Bill C-31, cl. 326(4))

• Trademarks will no longer have to be used to be registered
  • However the do have to be in use if the owner wishes to litigate
Takeaways

• Don’t default to assuming that there is an IP problem with makerspace technologies, but there are some concerns

• You need to be able to issue spot – most issues are not black and white
  • You have a lot of flexibility, but libraries offering makerspace services must develop a level of expertise on a range of IP issues

• Your library should already have a copyright policy in place
  • You will need to supplement this with guidelines around user-generated content (i.e. non-commercial use) and makerspace activity
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- School of Library and Information Studies, University of Alberta

- Michael B. McNally – mmcnally@ualberta.ca
- Samuel E. Trosow – strosow@uwo.ca
References