

WHAT'S YOUR TYPE? INTELLECTUAL PROPERTY RIGHTS IN FONTS AND TYPEFACES

22 April 2020

Recently, a Toronto artist known as Dreeem has garnered attention for their COVID-inspired "We're all in this together" signs. Copies of Dreeem's sign now appear in many storefronts across downtown Toronto and were offered free for download through their Instagram account.

The notable feature of this sign is not simply the now ubiquitous expression, but the distinct style of the lettering made famous by the bygone Honest Ed's discount store that is familiar to many Torontonians. The original Honest Ed's signs were hand-written in bright, bold colours and exude nostalgia, harking back to days when no one had heard of the phrase "social distancing". Dreeem's signs mimic this style and harness that sense of nostalgia to further their message of collaboration and empathy.

Earlier this month, The Globe and Mail reported that Mr. Wayne Reuben, an artist who was employed by Honest Ed's as a sign-maker beginning in the 1960s, claimed to be the originator of this particular style of script. Mr. Reuben was seeking an apology for the creation of these unauthorized signs and was considering legal recourse.

This incident raises interesting questions about intellectual property in something that is ubiquitous in our lives, but is often overlooked. What rights do artists have in the typefaces they create?

Are typefaces and fonts protected by copyright?

Though the terms are often used interchangeably, a "typeface" refers to a specific design of characters, including numbers and letters, whereas a "font" refers to the different

weights and sizes of these characters within a typeface. In this case, Dreeem's signs use an imitation of the Honest Ed's typeface.

The Copyright Act protects original literary, dramatic, musical and artistic works.^[1] In order to attract copyright protection, a work must be the product of its author's skill and judgment, and must be more than the product of a mere mechanical exercise.^[2] The protection is limited to the distinctive fixed form of expression, and not the underlying ideas.^[3] In the context of typefaces, the idea of a serif, or similar feature, would not be protected, but the specific serif used in an original typeface, may attract copyright protection.

Typographers apply their skill and judgment to create unique typefaces.^[4] Copyright protection of a typeface is limited to those original aspects that are the product of the typographer's skill and judgment, and does not extend to the unoriginal underlying alphanumeric characters, which remain in the public domain, free for all to use. The Federal Court has held that in simple works, which arguably could include typefaces, the copying must be more exact in order to establish copyright infringement.^[5]

In the digital era, many signs are mass-produced using computerized typeface, or "digital font". Where a digital font is used, the code underlying the font design would likely also attract copyright protection. In the case of Honest Ed's iconic signs, a digital font was not used since the signs were hand-painted until the store's close in 2016.

Who owns copyright in the work?

A further wrinkle to the Honest Ed's typeface story, is that Mr. Reuben claims that he created the distinctive font as a part of his job as an employee of Honest Ed's. As a result, it may be that the discount store was the owner of the copyright in the distinctive font and not the originating artist. It is important for designers to remember that the Copyright Act states that where a work is made by an employee in the course of their employment, the employer is the first owner of the copyright in the work in the absence of any agreement to the contrary.^[6] This is specific to a work created as an **employee** and does not apply where a work is made by a designer operating as an independent contractor.

Moral rights

Even if the copyright in the Honest Ed's typeface does not belong to the originating artist,

the artist may retain moral rights in their work. These moral rights include the right to the integrity of the work and the right, where reasonable, to be associated with the work as its author. In Canada, an author cannot assign these rights, but they can be waived in whole or in part. ^[7]

When a work has been distorted, mutilated, modified, or used in association with a product, service, cause or institution, the moral rights of the author have been infringed. To seek legal redress, the work must be so infringed to the prejudice of the author's honour or reputation.^[8] To establish an infringement of moral rights, the author of the original work must provide objective evidence of prejudice to the author's honour or reputation.^[9]

Other IP Protection in typefaces

In addition to copyright, certain uses of typefaces may be protected through other forms of intellectual property.

For example, if the typeface is used for the textual portion of a design mark used to distinguish goods or services from those of others, it may attract trademark protection. However, in this case the protection would not cover the typeface independently, but would be limited. The scope of the protection would be based on the use of the typeface as found in the trademark and its use in association with the goods and services.

Typefaces can also be protected through industrial designs, if applied to an article. The Industrial Design Act defines an article as any thing that is made by hand, tool or machine. Industrial designs protect features of shape, configuration, pattern or ornament and any combination of those features that, in a finished article, appeal to and are judged solely by the eye - in this case, the typeface applied to the article.^[10] Unlike copyright, registration is required in order to benefit from industrial design intellectual property rights.

Conclusion

Typefaces can be protected through a variety of intellectual property rights. How these rights play into the creation and use of typefaces is important for both designers and consumers to understand. Whether you are a designer looking to license your new typeface or a business interested in hiring a type designer to help define your brand, seeking legal advice and knowing what rights need to be addressed can help you best protect your interests.

- [1] RSC 1985, c C-42, s 5.
- [2] CCH Canadian Ltd v Law Society of Upper Canada, 2004 SCC 13 at para 16 ["**CCH**"].
- [3] See e.g. CCH at para 8; Robinson v Films Cinar inc, 2013 SCC 73 at paras 43-45.
- [4] See e.g. Visa International Service Assn v Auto Visa Inc, (1991) 41 CPR (3d) 77.
- [5] Pyrrha Design Inc v Plum and Posey Inc, 2019 FC 129 at paras 112, 123 & 145.
- [6] Copyright Act, RSC 1985, c C-42, s 13(3).
- [7] Copyright Act, RSC 1985, c C-42, s 14.1.
- [8] Copyright Act, RSC 1985, c C-42, s 28.2(1).
- [9] Thomson v Afterlife Network Inc, 2019 FC 545 at para 47.
- [10] Industrial Design Act, RSC 1985, c I-9, s 2.

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