**s.3 Copyright rights and who they vest in**

* Sole right “reproduce the work, perform the work in public, translate the work, communicate the work to the public by telecommunication.” To publish the work or any substantial part if unpublished. Also spefic rights: translation, converting into novels, sound recordings, or films.
* Works = literary, dramatic (including movies), artistic, musical
* It’s the work or any substantial part of it = any recognizable part
* S.1.1: communication of a work by telecommunication includes making it available to the public by telecommunication in a way that allows a member of the public to have access to it from a place and at a time individually chosen by that member of the public (2012 amendment) so if you upload something to be accessed whenever and wherever, that is infringement
* Author is generally the first owner of copyright – last for life plus 50 years
* Does not protect against parallel creation, must be derived from it, copying
* If authored in course of employment, the first owner of copyright is the employer (s.13(3)), but if the work is a contribution to a newspaper or periodical, author can restrain publication.

**New “Creativity” Exception to Copyright**

* s.29.21: can use copyright material that has been published or made available to the public for creation of a new work (with some new creative element).
* Only applies to individuals, for a non-commercial purpose, must name the source, and the individual must have reasonable grounds to believe the source to be original and not itself infringing, and the new work cannot have a substantial adverse effect on the exploitation or potential exploitation of the original work

**Neighbouring Rights**

* S.15, 26: performer’s right in performance
* S.18: sound recording maker’s right
* S.21: broadcaster’s right in the communication signal
* These rights layer on top of one another: if I copy a recording of a song without authority/license, I infringe composer’s s.3 rights, performer’s right, and the maker’s right.

**Collective Works**

* The individual authors of the components have copyright in their parts, while whoever put the work together has copyright in the whole, the selection and arrangement
* S.13(3): staff writers don’t have copyright in the individual articles, employers’, but if it’s contribution to a newspaper, they can restrain publication other than as part of a newspaper, but the demand must be explicit (Robertson)

**Joint authorship**

* Work created by collaboration of two or more authors where the contribution of one is not distinct from the other (not a collective work with individual components)
* The copyright is jointly owned, each with a part interest, not necessarily 50/50
* Neudorf: there must be the mutual intent for you to be joint author.
* Neugebaurer: disagreed with Neudorf and said intent isn’t necessary – just a factual question as to whether there is enough of a contribution for someone to be called a joint author.

**Originality (s.5(1))**

* University of London Press: original does not mean creative or high quality, can be routine or mundane. Need not be novel, just not copied, just that it originates with the author.
* CCH: mere fact it took work and resources to compile or create this work doesn’t matter.
* CCH: the standard is “skill and judgment” and not creativity (as in Feist). For instance, in compiling these law reports, was there skill and judgment in the selection and arrangement of the compilation?
* This exercise of skill and judgment is usually an issue of compilations of data, where the contents themselves are not subject to copyright, so it comes down to whether any skill and judgment in its selection/arrangement
* Needs to be more than routine tweeks to raw substance, don’t need a lot of skill and judgment, just some. Need not be creative either, just original

**Literary Works**

* University of London Press: “literary” simply means “written” and does not imply quality
* Can’t claim copyright in a regular word people use. Also hard for a title to be copyright, like “Man who broke the bank at Monte Carlo” because it is probably commonplace.
* Exxon: the point of words is to communicate something, info or enjoyment, THAT’s a literary work. Exxon is meaningless and confers nothing. For this reason, hard for any one word to be.
* Holland Rake and Trustle: not a literary work where it’s merely a mechanical contrivance or tool, where you’re not really concerned about the words at all, as the words are just some means to a mechanical end, part of a tool, communicating no meaning in themselves.
* Buhlman: other side of Holland – directions on a form were copyright and protected the form by extension. The directions, “put this here”, communicated enough info while in Holland, the words meant nothing in themselves.

**Fixation**

* Canadian Admiral: telecasts weren’t copyright because they weren’t fixed in a material form. Live unscripted performances aren’t protected
* An idea must be recorded in material form to get copyright protection
* A telecommunication can be fixed even if it is being recorded/fixed simultaneously with its broadcast. And once it’s recorded, it’s fixed.

**Infringement: What is Copying**

* Don’t have to copy literally, can’t escape with immaterial variations, substantial part is enough.
* Nichols: no clear boundary between when you’re reproducing the original or just something that looks like it, it’s a matter of impression.
* For the play, the formula she thought of is not protected, just he actual expression, the play itself. There must be STRIKING similarities, like a character with the same name, attributes, and graphic resemblance (as in Robinson Sucroe)
* The expression is the characters and plot, so need striking similarities in these areas, not just same kind of general ideas.
* have to show that the plot/characters were clearly taken, not just broad similarities, otherwise it’s just using ideas.
* Space Pets: sometimes elements are so generic and non-distinctive or poorly realized that even if they are shared between works, they can’t be copied.

**Compilations**

* Teledirect: just putting stuff in alphabetical order does not meet originality standard, nor does just publishing anyone who wants to be published. Time and money is not the test.
* If you chose what to list and where, that would meet the standard
* Ladbroke: cannot separate the thinking behind the selection or arrangement from the actual selection and arrangement – can’t say it was just an “unoriginal putting down” once the thinking was done. If the organization, or putting down, is based on business decisions, can’t separate the two and say the former is unoriginal while the latter is.

**Losing Copyright in Transfers to Different Medium**

* Newspapers are both collective works and compilations with layeres of copyright.
* Robertson: copyright in the compilation is lost when transferred into a medium that separates the components. Newspaper, when plugged in digitally, made it so that you could retrieve individual articles without the newspaper associated with it. This is just a reproduction of the authors’ articles, which Globe had no copyright in, without the compilation.
* Transferring a word to a new medium may allow it to be used in a different way and different market, making it a different work, changing copyright

**Assignments and Licenses**

* S.13: owner of copyright can assign the right, wholly or partially, generally or with limitations for either the whole or part of the term of their copyright. Licenses give ability to use work for a while.
* S.13(7): assignments and grants of exclusive license are grants of interest and must be in writing. Other licenses do not.
* Equitalbe ASignees: as in University of London Press, where the author had previously agreed that they would assign, the other party, with a binding promise for assignment, gets a binding equitable right in the person to make them assign it. That said, if the equitable assignee takes any legal action on the basis of the assignment, the legal owners must be made a party.
* S.57(3): any assignment of copyright is void against an subsequent assignee or licensee for valuable consideration who didn’t have notice of the assignment. REGISTER!

**Computer Programs**

* S.2 explicitly includes them, piled in as literary works, which need not be in human language.
* Apple Computer: in determining whether literary, focus on what it does, not how it works.
* S.64.1: features dictated solely by utilitarian function of the article are not subject to protection
* Delrina: you can copy code either by copying the actual source code (this is difficult, as programmers can make variations to achieve the same thing. There can also be copying of the non-literal elements: the look and feel, the structure, user interface.

**Delrina Process for Non-Literal Elements in Programs**

* Abstraction: have to be able to describe what elements in the look and feel you’re claiming are original to you
* Filtration: filter out whatever is not original to the author (like came from public domain) or is dictated by functional considerations.
* Comparison: compare the infringing program with the original to see if the residue of the original elements has been duplicated.
* Non-literal elements are protected to the extent that they’re original and not dictated by functional requirements.
* If you can only do it one way, you can’t copyright it; if there’s room for writing it more elegantly, that’s subject to copyright.
* Non-literal: the actual code that’s written, non-literal: the way it’s arranged and structured.
* Unconscious copying: unconsciously copied earlier work. Can be shown where there is evidence of having been exposed to the original.

**Dramatic Works**

* Fixation is required
* For movies that are dramatic, the term is live of author plus 50 while for non-dramatic, s.11.1, 50 years after first publication

**Registration**

* S.53: copyright is evidence of the particulars entered in it, including who is the author
* Only way to make sure your assignment is effective against subsequent assignees
* S.34.1(2): the register is presumed evidence of its contents. Where no assignment has been registered, presumption is that if the author is named, that person is the author and the person named as the publisher is the owner.

**Sound Recordings and Musical Works**

* S.19: where sound recording is communicated to the public by telecommunication, both the composer and owner of the sound recording copyright have a right to equitable remuneration
* Sound records: exclusively sounds and excludes soundtrack from movie (Resound Collective). Onec in a movie, it’s no longer a sound recording and no longer subject to remuneration, regardless of whether it was pre-existing or not.
* Musical work need not be written down to be composed, but subject to fixation argument.

**Artistic Works**

* Cuisinaire: to qualify as artistic works, they must have been intended to be contemplated as art with an aesthetic main function.
* S.3(1)(g): right to present at a public exhibition for purpose of sale or hire
* S.3(1)©: right to convert into a dramatic work
* S.32.2(1)(a) exception: author who doesn’t own the copyright can use the molds, casts, sketches, plans, or models if that doesn’t repeat or imitate the main design of the work
* S.32.2(1)(b)(i) exception: you can take picture of buildings or sculptures in public places

**Incidental Inclusion**

* Copps: can’t get around copyright by taking a picture of a picture
* S.30(7): not infringement to incidentally and not deliberately include a work in another work. Must be unintentional.

**Territorial Scope of Copyright**

* SOCAN: Canadian IP applies in Canada and nowhere else. With physical copying, if it happens in Canada it’s caught, if happening elsewhere, no.
* For things like telecommunication: any communication that has a real and substantial connection to Canada. Need not involve Canadian server. Thus, either a Canadian place of origin or a Canadian place of reception can work.

**“Communication” by Telecommunication**

* Entertainment Software: communication is tied to performance. Mere delivery of a copy is not caught by this right. This is merely a reproduction thing. (Also, tech neutrality). The work is not communicated if all that is happening is that a copy is being sent, not played. Sending of a copy is not “communication,” which is tied to performance.

**Authorizing Infringement**

* SOCAN: ISPS protected by s.2, only providing means of telecommunication necessary. Don’t assume instrument is going to be used to infringe copyright just because it can be. It is different, though, where the provider gets notice by the copyright owner and does nothing.
* Authorizing a third person to infringe makes you liable for infringement, only copyright owner can authorize.
* CCH: simply providing the equipment that gets used isn’t enough – must prove they authorized it, there must be some form of active participation, must implicate yourself. Making it possible isn’t the same as authorizing it.

**Moral Rights**

* S.14.1: author has the right to be associated with the work by name, pseudonym, or anonymous
* S.28.2: if the work or performance is distorted, mutilated, modified, or used in association with a product, service, cause or institution to the prejudice of the author or performer’s honour or reputation.
* This also applies not just to modification of originals, but also distorted reproductions
* Term is life of the author plus 50 years. Moral rights are not transferrable from the author, cannot be assigned, though they can be waived.
* S.28.2(2): for paintings, sculptures, or engravings, prejudice is deemed t have occurred as a result of ANY distortion, modification, or mutilation. Don’t need to show prejducie.
* For s.28.2(2) to apply, it must be a modification to the original work. A distorted copy/reproduction requires a showing of prejudice (Dinosaur Painting)
* Snow: judge thought it was enough to show prejudice that the author THOUGHT there was prejudice to his reputation.
* Deberge: author can’t really complain with what a user does to a reproduction after legitimately purchasing it. You can do what you want with it after you buy it.

**Sound Recorder’s Rights**

* Once it’s recorded, has separate right to publish it for the first time, reproduce it in any material form, or to rent it out. The copyright owner/composer may have the right to authorize the work to be reproduced but once they’ve given permission to the recording company to put out the cording, both of them have a stake in further reproductions.
* Compose must agree also to your making a recording of it, but the performer must agree to any live broadcast and to any fixation at all, video or sound, but once it’s fixed, the sound recorder’s rights kick in.

**Performer’s Rights**

* If not fixed, sole right to communicate it to the public by telecommunication or to perform it in public, sole right to fix the performance in any material form.
* If there is a sound recording of the performance, you have the sole right to have it made available by telecommunication, make it available
* If it is fixed in a sound recording in form of a tangible object, you have sole right to sell or otherwise transfer ownership of it and decide how the hard copy of the performance is distributed.
* S.19: once sound recording is published, the performer and composer get equitable remuneration for its performance in public or telecommunication to the public. Once you’ve agreed to it being broadcast, they can play it any number of times, just paying you each time.

**Secondary Infringement**

* Roy: s.27(2) (only the owner can sell or rent out or offer to do so) applies if the person knows or should have known that the works infringe copyright or would infringe had they been made in Canada. Trafficking in copies you know or should have known infringed
* Mere possession does not constitute infringement where you I mported it from someone who has no right to it in Canada (but may, for instance, have right to it where they are), but it’s infringement to traffic these.

**Remedies and Exceptions**

* Roy: offering up of the infringing goods
* Kaffka: if you can’t get the profits made off the infringement, you can get the fee you would have charged had they paid to use your design or paid you to make it as well as punitive damages for being deprived of the recognition for use of your design.
* Euro-Excellence (Rothstein): exclusive licensee cannot claim infringement by the copyright owner
* Bastarache: sale of copyrighted material incidental to the sale of goods isn’t covered.

**Fair Dealing**

* Educational institutions, libraries, museums, and archives get a specific exemption under s.30.3 (institution enters into agreement with collective society authorizing owners to grant licenses). This is rarely needed becauase of fair dealing.
* S.29: fair dealing for purposes of research, private study, education, parody, or satire.
* S.29.1: fair dealing for purpose of criticism or review, but must mention the source and, if it’s in the source, the author/performer/maker/broadcaster.
* S.29.2: fair dealing for purpose of news reporting with same sourcing requirements of s.29.1
* CCH: two stage test: does it fit one of the statutory purposes? If yes, is the dealing fair?
* Bell Canada: research does not need to lead to new discoveries. Deciding whether you want to buy something is valid as “research.”
* Bell Canada: that the provider has a commercial purpose does not alter that the user has a research purpose. Purpose issue is taken from the user’s point of view.

**Determining Fairness (CCH)**

* Purpose of the dealing (if it’s research, what kind? Is the activity tailored to the purpose? (Bell)
* Character of the dealing (how the work is dealt with, how many copies, frequency, etc)
* Amount of the dealing (how much are you taking? Proportion: taking as little as needed for your purpose?). Bell Canada: it’s how much of each individual work is copied in each individual copy, not the aggregate volume of all the copying (that global factor is addressed in character)
* Alternatives to the dealing: is there some other way other than copying this stuff?
* Nature of the work: is what you’re doing harmful to the work or its value to the copyright owner due to its nature? For instance, making confidential work public through copying.
* Effect of the dealing on the work: are you undercutting its economic potential? (Access Copyright: slumped sales isn’t enough – must show it’s because of the dealing)

**Passing Off**

* Naming a product so as to mislead the public as to the source of the goods. Could be a name, looks of the thing, description, anything public associates with the product.
* Advocaat: can work for generic names where there’s goodwill invested in it. Not just classic passing off of misleading the public about where a product comes from, but also what it is (as long as you can prove that the market recognizes it as a distinct thing and that the plaintiff(s) have good will in the name of the product).
* Passing off protects not just the source but also the identity of the product, unlike trade-mark. (and for that, a group of people, everyone who markets the stuff, can sue)
* Law Society: need not be a business to sue, as long as they have a good will/reputation

**Passing Off Test (Advocaat)**

* There is good will attached to the goods or services
* There is a misrepresentation by the defendant likely to lead the public to believe that the defendant’s goods or services are those the plaintiff has the good will in
* Demonstrate damage (don’t have to prove you lost money, just that the public was being confused about your particular brand/label – losing exclusivity and control of your brand)

**Establishing Good Will in cases of Misrepresenting the Source**

* CIBA Geigy: must show that the public identifies the similarity with your product, and not with some other. Must prove that it (here, the size and shape of the pill) is distinctive of your product so the public sees it as identifying not just what it is, but who made it
* Walt Disney: a word can’t be said to be generic where the party created it.

**Establishing Misrepresentation and Confusion**

* Walt Disney: it’s enough if people are led to assume that there is some authorization or license given by the plaintiff to the defendant.
* Walt Disney: passing off is territorially limited. The party alleging passing off must have goodwill/recognition in the territory in which the defendant operates.
* Test: where this allegedly confusing mark was used, would the ordinary consumer assume that those goods or that service was being provided directly or indirectly by the same people that have that band?
* Law Society: Intention to confuse is NOT required for liability.
* The confusion must be actual, not just potential: you don ‘t need to bring forward examples, but you must be able to infer that people are being confused. This means that if the goodwill in your business is local, you can only succeed in a local case.

**Establishing Damage**

* Walt Disney: It’s presumed. Once you’ve shown that there is good will and it’s affected by misrep, you’ve proven damage. No need to prove dollar loss, the damage is the loss of control
* Law Society: does not have to amount to confusion that results in a loss of customers – a misrepresentation that diminishes the good will in the name is enough.

**Passing Off and Utility**

* The looks of a product can be the basis of a passing off action if your product has a distinctive look that you h ave goodwill in, but that doesn’t extend to looks that are purely functional. If the look is dictated by the function, you can’t use as basis as a passing off action, nor could you register that as distinguishing guise.

**s.7(b)**

* A passing off action under the TMA. Do this because it is the way to get national regulation for unregistered trademarks. The court can give a national order.
* It is, however, restricted to unregistered trademarks – you can’t sue for misrepresenting any selling point of wares or services or the item itself or generic descriptors (Advocaat.

**Prohibited Trademarks**

* S.12: primarily name of someone alive or dead within the last 20 years
* Standard Oil: to be prohibited, it must be PRIMARILY a name or surname, whether the average person would be likelier to recognize it as a surname. Here, Fior wasn’t very common.
* S.12: Anything clearly descriptive of the wares or services or misdescriptive
* Teachers’: prohibited for describing a highly prominent feature, trait, or characteristic belonging to the appellant’s services. The standard is that the reasonable person doesn’t require effort or imagination or reflection to get the connection.
* Maple Leaf (misdescription): basically, the Canadian public has to get the false connection – for instance, they have to know that Parma is a place where meat comes from to be misled by Maple Leaf’s “Parma” trade-mark.
* S.9: Royal arms/crests, govn’t symbols, and national flags of union countries, any badge or crest of Armed Forces, university, or any public authority in Canada provided they’ve notified the registrar and the registrar has provided public notice.
* Obscene or immoral

**Registration**

* Gives public notice and unchallengeable right to exclusive use, across the country
* Infringement is hypothetical: unlike passing off, pre-emptive national protection means you can shut people down to preserve your ability to expand.
* If you don’t take care to preserve it’s distinctiveness, you can lose it.
* To register it, you must actually use it. This means that it is marked on the wares themselves or on the packages such that it gives notice to the purchaser at time of purchase. For services, it must be used or displayed in the performance or advertiseing of the service.
* Can register a proposed trademark on the condition that file a declaration of use within 3 years
* You can amend what you register as the years go by
* Can register distinguishing guises and certification marks
* Must not be an unregistrable trade-mark as per s.12
* S.18: It must be distinctive – distinguishes your wares or services from other providers. This distinctiveness is measured at the point the trade-mark’s validity is challenged.
* Invalid if the trade-mark is abandoned, you stop using it.
* S.17: Invalid if applicant for registration was not the person entitled to it due to someone else’s prior use (already made known or in the market at the date of your first use), though they only have 5 years to come forward (and it has to be them, not a third party)

**Rights of Exclusivity**

* S.19: exclusive use in Canada of the mark that you registered in respect of those wares or services
* S.20: your right to exclusive use is deemed to be infringed by a person who sells wares or services in association with the confusing mark

**Trade-name Exceptions to Exclusivity**

* Exclusive use is subject to bona fide use of a person’s personal name as trade-name (business name)
* Subject to bona fide use, other than as a trade-mark, of the geographical name of his place of business or of an accurate description of the character or quality of his wares or services.

**Establishing Use**

* Clairol: s.4 makes it so that it’s not just about putting it on the package, they have to actually be saying that it is that product
* Tommy Hilfiger: intention doesn’t matter: not about whether you meant to infringe or not, or to use a trade-mark to imply it came from somewhere else, it’s about what the customer infers

**Depreciating Goodwill (s.22)**

* No person shall use the registered trade-mark of someone else in a manner likely to have the effect of depreciating the goodwill attached.
* Clairol: this catches situations where comparative statements are made to the disparagement of the competitor’s product, or in the case of Clairol, likely to cause them to lose customers (???)

**Descriptiveness**

* Shredded Wheat: can’t register something like “shredded wheat” that simply is the name of the product or a description of the product. Hard for this to be distinctive: people see shredded wheat as the name of a product, not YOUR product.
* Can’t register the name of the wares or services in ANY language (s.12(1)©
* If it’s descriptive or misdescriptive, you can’t register it in English or French (s.12(1)(b))
* S.12(2) if the descriptive term has acquired the necessary public association with the source of the product (distinctive), it can be registred, but only for the area of Canada within which it has gained this distinctiveness (OFF! Insect Repellant)

**Bona Fide Commercial Usage (s.10)** – common, recognized commercial expressions

* If by ordinary bona fide Commercial usage the mark becomes recognized in Canada as designating kind, quality, quantity, destination, value, place of origin, or date of production of the wares or services, no person shall adopt it or one resembling it as a trade-mark in association with such wares or services of the same general class in a way likely to mislead
* Glen Breton: complained not registrable due to s.10, Glen was recognized as designating Scottish products. But FCA said while Glen means Scottish, it hasn’t come to be recognized by the public as meaning “from Scotland,” and if it did and s.10 worked, it’s a complete ban on adopting the word because it’s a common, recognized expression for the origin of the product

**Public Authorities**

* Bypasses the opposition process and requirement of being person entitled to register. Public authority has to have adopted and used it as an official mark, but TMA doesn’t say for how long. They just write a letter to registrar and declare they’ve adopted it, then registrar provides public notice. No grounds of opposition.
* From the moment it gets public notice, s.9 prohibition kicks in: no one cas use the mark or one that resembles it (NOT a confusion test!)
* Anyone who was already using it is okay, no retrospective effect
* No ban on govn’t adopting an official mark that is confusing with prior mark.
* Ontario Architects Association: to be a public authority and get benefits of this process, you must be subject to government control (ongoing government supervision of the activities of the entity) and work for the public benefit. Being created by statute is not enough.
* Royal Roads: no person shall adopt it in connection with a BUSINESS. It’s each new business after the public authority takes it, not ongoing businesses.
* Maple Leaf: foreign public authorities don’t get this treatment

**Disclaimer**

* S.35: you can register a trade-mark as a whole and disclaim any right to the exclusive use of a piece of it, allowing for registration of a trade-mark with unregistrable components.
* Lake Ontario Cement: you can use disclaimers to get misdescription into the trade-mark, but something like “premier” is a lauditory epithet no one would put stock in.
* Lake Ontario Cement: it’s whether the mark as a whole is distinctive. Where you’ve disclaimed a word, you can’t stop people from using that with their wares, but you can complain about people using some piece of the design that may confuse consumers
* Canadian Jewish Review: the distinctiveness of the brand must be in the design, not the part you’re disclaiming. Words that are just in a different font don’t have enough design elements to be registered. If the design is dominated by the disclaimed word, it’s not registrable.

**Test for Confusion (Mattel)**

* Can only complain about a trade-mark if it’s confusing with yours, s.6(2) says confusion is where the use of both in the same area would lead to the inference that the wares or services are by the same person, regardless of whether the wares are of the same general class. Hypothetical.
* Doesn’t have to mean everyone is going to infer they’re from same source, just an appreciable number of people.
* Onus is on the applicant to show that their mark is not confusing.
* S.6(5) factors: inherent distinctiveness of the trade-marks or trade-names
* The extent to which they’ve become known
* The length of time the trade-marks/trade-names have been in use
* The nature of the wares or services (if totally different, less likely people see connection)
* The nature of the trade (like whether wares or services)
* The degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them (this takes not just the word, but the design into account)
* Again, whether the other party intended to confuse is irrelevant, it’s just whether they did.
* Standard of confusion: casual consumer somewhat in a hurry.
* Can’t register a mark that’s confusing with a prior trade-mark, judged from first use
* Phillip Morris: confusing trade-marks can only be confusing if they circulate in the same market

**More on Confusion**

* Masterpiece: standard of confusion is taken when the person first encounters the marks, you can’t get over confusion by saying people would’ve figured it out later.
* It’s not what the registrant is actually doing with the mark, how they’re using it, but what they’re entitled to do with it once they’re on the register. It’s not if they’re using it in a confusing way, but if they could.
* Substantial confusion, not total confusion, a de minimis test.

**Registration of Distinguishing Guises**

* S.13: registrable if it has been used in Canada so as to become *distinctive* at the date of application; shaping of wares or packaging done for the purpose of distinguishing.
* this means that it won’t be registrable in early days of use
* s.13(3): exclusive use by the applicant of this guise cannot unreasonably limit the development of any art or industry.
* S.13(2): can’t interfere with any utilitarian feature embodied in the distinguishing guise.
* Dominion Lock: even though that shape of the key was distinctive to them, giving them exclusive use of it through trade-mark would unreasonably limit the key replacement industry

**Challenged on Distinctiveness**

* Remember, the mark must remain distinctive; if it loses it through common use, can be expunged upon challenge
* Philip Morris: a trade-mark cannot lose distinctiveness thanks to spill-over marketing for a foreign product, particularly when the domestic product is the only one in its market

**Transfer of a trade-mark**

* S.48: transferrable either with or separate from the good will of the business
* Doesn’t have to be in writing, but if it’s a transfer or a registered trademark, the transfer must be in writing with the transferee registered (s.48(3))

**Licensing**

* Eli Lilly: s.50: if the owner has, under the license, direct or indirect control of the character or quality of the wares/services then the use, advertisement, or display of the trade-mark by that licensed entity is deemed to have the same effect of such use by the owner. In Eli Lilly, the court also said control over the use of the alleged marks.
* If this is the case, the owner does not lose distinctiveness in the marks – it’s still theirs.

**Test for Depreciation**

* Veuve Clicquot: has to be a use of the plaintiff’s mark, must be good will in the mark, use has to somehow have a connection with the good will in that the way that it’s used has to have an impact on it, and there has to be a likelihood of depreciation
* For first hurdle, there must be some psychological connection between the two brands, even if not confused by them.

**Patent – Inventions, Patent Rights**

* Art, process, machine, manufacture, or composition of matter. Can be a process or method
* Has to be in writing; invention must be translated into English or French
* Term is 20 years that kicks in when grant is given. Get money back from those while pending.
* Exclusive rights to making, constructing, using, or selling the invention.
* Infringements on making or vending don’t require intention, but use does (Monsanto)

**s.2: The Specification**

* Application must correctly and fully describe the invention, it’s operation or use as contemplated by the inventor, and what it is that it does (s.3(3)), and it must set out clearly the steps in a process or the method of contructing or using the thing in such terms that a person skilled in this art could make it or, if it’s a method, use it
* S.3(4): must end with a claim defining distinctly and explicitly the subject-matter of the invention for which an exclusive privilege or property is claimed
* Specification = disclosure + claims

**Requirements for Registration of a Patent and Priority**

* Novelty: no one has come up with it before, either in Canada or anywhere else. If it has been disclosed to the public, by anyone, you have one year to file an application. (s.28)
* Must not be obvious
* Must be useful: must do something and be known to do something when you apply. Need not be helpful or commercially viable.
* You can patent improvements to a patented invention.
* S.28.1: priority is based on the first treaty country applied to
* S.58: if any claims in the patent are invalid, the patent only consists of the valid ones

**Usefulness**

* Requirement that you know at the time of application that it works/have sufficient evidence to show that it works
* It can be useful as a matter of sound prediction, that don’t KNOW that it works as haven’t proven it, but have every reason to believe that it does; very close to proving. It’s whatever a person skilled in the art would regard as a sound prediction
* Apotex (requirements of sound prediction): there must be a factual basis for the prediction (must know enough about the thing to predict) and the inventor must have, at date of application, an articulable and sound line of reasoning from which the desired result can be inferred from the factual basis. There must also be proper disclosure (not necessary for providing why it works, just disclose what it does).

**Patenting an Idea**

* S.27(8): can’t patent a mere scientific principle or mathematical theorem; an idea is distinguished from an invention, which is the incarnation or applied version of the idea.
* Need a way of using that concept for something or having it somehow alter or do something in the physical world, the mere concept is patentable.
* Lawson: couldn’t patent a new way of sub-dividing land – this was just a new way of drawing a line, not enough of a physical operation, more of an intellectual one. Too much idea.
* Amazon: FCA says there is a physicality requirement, a discernible effect or change in the physical world, though broad and minimal, which is not satisfied by saying it’s done with a computer or that the idea can be applied to a practical purpose.

**Medical Treatment and Professional skills**

* Tennessee Eastman: while it turns on the old s.41 ban on patenting medicine, you cannot patent a method of treatment
* Lawson: generally cannot patent a particular way of performing a professional task, a professional skill

**Method Patents**

* Shell Oil: even if all the substances involved were not novel, they were able to patent the newly discovered use for these substances
* Calgon: the extreme: able to patent an unexpected benefit of an existing use.

**Laws of Nature**

* Mayo v. Prometheus: cannot patent a law of nature, even if it’s newly discovered by you. The ways of reading the reaction and administering the drug were not new, just the reaction.

**Problems with Patenting Info Technology**

* Just putting equations in, too close to being an intellectual operation with no change physically, the computer is the same (Schlumberger), can’t patent an equation or principle just by having it run through a computer. Nothing novel is being done physically.
* You can’t patent any mathematical operation, can’t do this by passing it through a computer
* Schlumberger: software is not patentable unless you can show that it’s somehow changed what it’s being plugged into. In Schlumberger, everything was well-known except the method of manipulating data, which is not patentable under s.27(8)

**Patenting Business Methods**

* No rule against patenting business methods. Patents do not have to be scientific or technological in nature.

**Living Things**

* Harvard Mouse: living things are not patentable because Act isn’t suited to it. That said, unicellular organisms are patentable because they are mass produced by chemical means and uniform.
* Monsanto: you CAN patent the human engineered gene or cell in the living thing and use of the living thing, or the larger whole, constitutes use of the cell/gene or the smaller, significant part. There must be intention to use the whole, however. Intention to use.

**Genus and Selection Patents**

* Perfectly valid to patent a large group of things, and then later patent one of that group where that one is found to have special advantages.
* This selection must be a new invention: it must be a newly discovered, unexpected extra advantage not foreseen in the original patent or by anyone else.
* Doesn’t have to be a totally different use for the selection patent. It can be the same use as it was patented for in the genus, just better.

**Obviousness**

* Apotex: no longer just that the invention is obvious to a person skilled in the art, but also that it’s “obvious to try,” that if you tweak this or that it’ll obviously work, for instance, or that it’s an obvious extension or variation of an earlier invention
* Obviousness has now gone from “that’s gotta work” to “I think it’ll probably work but I’ll have to do some testing to see that if it does,” that there’s an obvious motive to go in that direction
* If it’s a ton effort required, it’s not obvious – “try” means routine experimentation, not research and prolonged invention.