## General Principles

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|  | Copyright | Trademark | Patent |
| Protects | **Ideas** – expression of idea  Work – literary, dramatic, music, artistic | **Goodwill** | **Inventions**  Include – new way of ding things, embodiment of idea, implementation of idea  Exclude – ideas |
| Rights | Sole Right to exploit work  No monopoly - | Right to use the mark to sell goods and services | Monopoly – priority over other ppl |
| Function | Attaches automatically w/out registration |  | Registration |
| Timeframe | Life of author +50 years | Determine by usage | 20 years from date of filing application |

# Copyright

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| Definitions | |
| Copyright – 2 | Real rights   * A – in work – comprised of sole rights in 3   + Rights to produce/rep – work / any substantial part in any material form   + To perform the work in public   + If unpolished – rights to publish   + To auth any such acts   + Include sole right to     - A – produce/reproduce/publish any translation of the work     - B, – dramatic work – to convert to novel / other non-dramatic work     - C – novel/ non-dramatic – covert to dramatic work by performance in public     - D – make sound recording, film/ other means so work can be reproduced/performed     - E - right to make it into film     - F – right to communicate work to **public** by telecom       * Public – depends on the context, not #       * Commercialism – no determinative         + Free public exposure – still infringement       * Exclude- comm to private     - G-j – specific n narrow protection |
| Neighboring rights in   * B – performer’s performance * C- sound recording * D – comm signal |
| Subsistence of CR | |
| Subsists in - 5(1) | * Territorial aspect – requirement   + author of work is citizen / habitual resident of a country of union/treaty country     - treaty country – any country that’s part of Berne Convention (Art 2)   + If author from non-union country     - work was first published in union country |
| Authorship | **General rule**- 13   * 1 – author of work = 1st owner of copyright * 3 – employment cases   + Employer owns right if: unless stated otherwise     - In K of service     - Employee produce work during course of employment   + Article/ contribution to newspaper/ magazine – author     - Reserves right to restrain public of the work     - Unless stated otherwise * 4 – assignment of right   + Can slice it and dice it any way you want   + Requirement     - Has to be in writing       * Oral Is ok – if non-exclusive license Robertson   + Diff from licensing     - When assignee – have ownership     - Licensee – only rights to do certain things, no ownership * 7 – grant of interest = exclusive license   + Has to be in writing |
| **collective works** 2   * a- encyclopedia, dictionary, yr book * b- newspaper, review, magazine * c - anything in distinct part written by distinct author   general rule-   * each individual author will have right in own piece * person who put the piece collectively together 🡪 CR in collection * choice of work and arrangement 🡪 CRable |
| **work of joint authorship**   * 2 – work produced by collaboration of 2 / more authors   + Contribution of one author – not distinct * consider Neudorf   + 1. **Must** have contribute significant original expression   + 2. Contribution was merged with others contribution   + 3. Parties intended x to be joint author     - Controversial requirement – Neugebauer – refused to follow |
| Requirement of CR - 5(1) | 1. Originality  **5(1)** – work must be **original** to enjoy copyright   * **Requirement**    + Originate from author – not copied U of London Press     - Concern with – expression of idea, not the originality of the idea or creativity   + Work must be exercise in **Skill and judgment** CCH     - Criteria – some involved – ex decision to be made       * if pure mechanical – minimal n routine         + requires no skill/ judgement – not original   ex. trivial edits |
| **2. Fixation – not that important now**   * **Fixation requirement** Ca Admiralty   + Work – must have more than just temporary existence – fixed in material n permanent form * Prob- still the law but inconsistent with Berne convention   + BC – CR in whatever form/ mode of expression * Implication- not important now   + 3(1.1) – work that is comm in telecomm     - Considered fixed – includes live broadcast   + Neighboring rights     - Performer’s performance – s 2       * Includes – whether or not work was previous fixed |
| WORK | |
| Literary | 2 **– includes tables, computer prog, n compilation of literary works**  **Requirement of literary –**   * Does not need to be of “high literature” U of London Press   + As long as written form – * Has to be expressing something Exxon   + Cannot CR word – that does not express anything     - Even if its made up * Provide information/ pleasure/ instruction in form of literary   + **Tools** – if there’s literary words guiding you on how to use the thing Bulman     - That’s instruction – CR       * Even if purpose was to perform fcn – n not to be read         + If words – tell u how to use it – literary work   If words predominated the fcn   * + - Hollinrake – cardboard sleeve, measuring device – w/ minimal writing on it       * Device for making sleeves – not work that provides info / enjoyment       * Reason – the measuring fcn predominated over the word   + Even if arrangement is meaningless – as long as tell u information – OK     - Ie. Meaningless grid but tells u its winning Express   **Extent of CR**   * **Expression – not idea** Nichols   + Principle- only CR in **express not idea** Baigent   + rule – have right in specifics but not on the general level   + approach – abstract things at increasing abstract level     - CR - in the specifics and detail description     - NO CR – in general nature of work * computer program   + literary works – cuz contain intelligible instruction   + CR - the more abstract the copy is – less likely will have CR     - No CR in function |
| Compilation and Collective Works **Compilation –**  2   * A – result from selection/ arrangement of literary/dramatic/musical/artistic work * B – selection/ arrangement of data * CR subsists   + Contribution of author who compiles – CR in selection n arrangement Robertson     - If strip of compilation – loose CR     - If divide up – id of compilation is gone 🡪       * Use are not encountering the selection n arrangement – loose CR   **Collective work** – 2   * Encyclopedia, dictionary, yr book * Newspaper * Any work written in distinct parts by diff authors |
| Computer Programs 2- set of instruction/statements   * + Expressed/fixed/embodied / stored in any manner   + Used directly indirectly in computer to bring abt specific result   **Computer program = literary work**   * 1. Include in definition * 2. Fit requirement Apple Computer   + Expression -     - Can be expressed in computer, prog/ human language   + Provide instruction -     - instruction which computer will follow   + Form of presentation –irrelevant     - Whether write it out / embedded in computer chip   **Extent of CR** Delrina   * Have CR –in things that are original   + non-literal element – look n feel of prog, architecture     - General proposition – Yes if original       * Display and arrangement are still expression     - Nintendo – only case that’s arguing the actual screen display is infringed       * Unsettled – dismiss for other issues         + Claim Mario display infringed by copying * No Cr if   + 1. Previously used – if used in other program/ out there   + 2. Dictated by function – the only way u can write a program to do x   **Reproduction** Delrina   * Requirement – copy substantial part of the original part   + Original part-     - Not taken from elsewhere     - Had choice of writing the program       * Ie – not dictated by fcn       * Issue- difficult to show |
| Dramatic Work | 2 – includes cinematographic work - probably video game but not screen display of computer prog   * With dramatic quality – CR with author life+50 * no dramatic quality- CR to production date   **cinematographic works**   * Soundtrack – once given right of sound recording to be part of movie soundtrack Re Sound   + Future public performance/ telecomm – no infringement of 19     - Reason –       * Sound recording def’n – excludes soundtrack of cinematographic work |
| Musical Work | S 2 – any work of music/ musical composition   * With/without words * Includes any compilation |
| Artistic Work | Artistic work – works of artistic craftsmanship, arch works, charts, maps and etc 2   * Requirement Cuisnenaire   + Purpose – be enjoyed, give aesthetic pleasure     - If purpose was to use – not art |
| Approach to CR | **1. Is it original?**   * + Requires skill and judgment ? CCH   **2. Does it belong to a specified category?**   * + 2 - **every original literary, dramatic, musical and artistic work”**     - Includes original production in: literary, sc/ artistic domain       * Sc domain – does not expand CR, Cuisenaire         + Does not create a 5th category for scientific production     - Even if commercial aspect / product of decision – still CR Ladbroke   + Literary – has to express sth, provide info/pleasure/instruction Exxon   + Dramatic – includes movies   + Musical-   + Artistic - be enjoyed, give aesthetic pleasure Cuisenaire |
| Rights Comprising Copyright in Work | |
| Reproduction Rights | **Test for Infringement –** copied ”any substantial part thereof” s 3(1) Ladbroke   * Approach   + Look at the quality - than quantity     - If copy the very thing – that make it special – copied     - ex. compilation – look to the selection and arrangement   30.7 – not infringement if incidentally n not deliberate   * A – include a work * B – do any act in relation to a work |
| To Perform Work in Public | 3(1)- performance in public   * In public- any circumstance that’s Ca Admiral   + not domestic   + not restricted to private audience     - if factor full of employee – public   + irrelevant factors     - size of audience     - whether performer was paid / strangers/ member of domestic circle   + \*\*unclear line – anything that can’t be described as private(domestic) = public Admiral * Performance –   + Not restricted to live performance   + by playing on any digital device     - Includes – showing film, playing recording |
| To Communicate Work to Public by Telecommunication | 3(1)(f) – **right to comm any LDMA work to public by telecomm**  **Include**   * 2.4(1.1) – includes **making available** for public to have access   + From place n time – individually chosen by that member of public     - Issue –may argue that ESA is now altered by statute       * Cuz giving customer access – must include dling * **internet communication**  SOCAN   + Requirement – real and substantial connection with Ca     - Include – origin,, reception, service in ca / some combination       * Ie comm to, from and thru Ca     - ISP – if aware of CR infringement being communicated (**not in force yet)**41.25-41.26       * Requirement         + If given notice to someone in telecomm chain   Require to give notice to person who is uploading   * + - * + Must retain address of the person they give notice to – may be provided to CR holder   But up to holder to take legal step   * + - * If telecomm failed to do so – could be legally liable   **Excludes**-   * **network services** 31.1   + 1 – person providing service related to operation of internet/ other digital network / means for telecomm / reproduction     - Alone – doesn’t make infringement   + 2- do means to make it more efficient – not infringing     - Ex. caching   + 3 – conditions for protection     - Only protects you if u don’t       * a– modify – unless tech reason       * b- in manner consistent w/ industry practise       * c- must allow tracking   + 4 - online storage     - 5- doesn’t apply if know of court decision   + ISP is not comm work to public/ auth     - Not infringement cuz excluded by 2.4(1)(b)       * Reason - only providing means of telecomm   **Performance vs Reproduction**   * Downloading = reproduction, not comm to public ESA   + Reproduction includes - sending a whole file for permanent retention     - Not comm to public   + DL of musical works in video game     - Not communication –       * Delivery of copy – not performance of work over internet * Streaming = telecomm to public Rogers * Reason   + Performance vs reproduction right are separate in s 3   + Admin by separate collective societies   + Media neutrality     - If allow tariff – discrimination btw 2 modes of delivery   **Other provisions**   * 2.3 - telecomm isn’t performance in public * 2.4(1) – clarifies what’s “public”   + A – hotel / apartment   + B – proving only means to telecomm – not comm to public |
| Media Neutrality | Raised in Robertson case and 3 telecomm case   * **Issue** – difficulty to distinguish btw   + New way off doing old thing vs   + New tech that allows u to do diff thing * **Stances-** no clear answer   + Robertson majority – new tech for publishing newspaper= doing diff thing     - Minority – new way of publishing newspaper   + ESA majority – neutrality- demanding to keep dl out of telecomm right     - Dissent – parliament specifically contemplated medium as decsive factor       * Distinguish btw comm to public vs plain old performance |
| Moral Rights | |
| 14.1 | 14.1 – belongs to **author** of work / **performer**   * 1 – **right to**   + 1. integrity of work – 28.2   + 2. be associated w/ work by name/ pseudonym/ to remain anonymous * 2- may not be assigned but may be waived in part / whole * 3- assignment of Cr – doesn’t = waiver * 4 – if waived in favour of owner/ licensee of Cr   + May be invoked by any person auth by owner/ license to use work     - Unless – its indicated in waiver |
| Infringement | **Requirement** 28.2   * (1) – to the prejudice of its author/performer’s honour or reputation IF   + a – altered in some way – distorted, mutilated / modified OR   + b – commercialized – used in association w/ product/service/cause /institution * 2 – deemed to have occurred if   + Painting/sculpture/engraving – is distorted, mutilated/ modified     - \*only to original\* * 3 – if change location/physical structure/restore   + Not distortion   **Test –**   * Prejudice to honour/ reputation?   + author’s view – must be given weight Snow     - readily found – if artistic has some reasonable objection   + only has right to control use of work – if its prejudice to honour/ reputation Theberge     - if exact copy – no prejudice     - reason- bal btw buyer’s right vs author’s right * reasonable expectation   + but still need to consider the reasonableness |
| Neighboring Rights | |
| Broadcaster’s CR in broadcast signal | * Can complain if ppl make copy of broadcast w/out consent * 21 – to fix it, reproduce, auth another broadcaster to retransmit, perform it |
| Makers of sound recording | in the recording excluding soundtrack   * 18 –   + 1 –publish it for 1st time, reproduce, rent and auth   + 1.1 – WPPT     - Making it available, distribution |
| Performers | 15– CR in performer’s performance – sold right to and auth such act   * A – not fixed   + I- comm to public by telecomm   + Ii – perform in public   + Iii – fix it in any material form * B – fixed – right to reproduce unauthorized fixation * 15(2)- applies if Rome Convention country, Ca   **New addition**   * 15(1.1) – restricted to sound recording but rights extend   + B - If fixed in sound recording – to reproduce that fixation     - Auth/not   + C – rent out sound recording   + D – making it available   + E- distribution     - to sell/transfer ownership if fixed in tangible object   + 15(2.1) – applies if WPPT country , Ca |
| Rights give you | 19 - Equitable remuneration for public performance of performance/ sound recording   * **Only if made it available –** to public by telecomm |
| Other Issues | |
| Ownership | **General rule**- 13   * 1 – **author of work = 1st owner of copyright** * 3 – **employment cases**   + **rule**     - Employer owns right if: unless stated otherwise       * In K of service       * Employee produce work during course of employment     - Article/ contribution to newspaper/ magazine – author       * Reserves right to restrain public of the work       * Unless stated otherwise   + Issue-     - are you an employee? U of London Press       * Look at how the work is done       * Control by other person     - Work created in course of employment? |
| Assignment | 13(4) – **assignment of right**   * Can slice it and dice it any way you want * Requirement   + Has to be in writing U of London Press     - Oral Is ok – if non-exclusive license Robertson     - If binding K to assign Cr – operates as equitable assignment U of L Press       * When don’t have the CR to assign yet       * Binding obligation to assign - Rights as assignee will be recog       * Prob- equitable assignee cannot sue for breach of CR in own name * Diff from licensing   + When assignee – have ownership   + Licensee – only rights to do certain things, no ownership * 7 – grant of interest = exclusive license   + Has to be in writing   13(5) – **assignee and assignor –** treated as owner   * For the part of CR they own – so can sue for infringement   41.23   * 1 – assignee may sue in its own capacity to enforce/ protect rights it hold * 2 – if P is not owner, must be joined by owner as a party   + 4 – owner – has share in damages as appropriate |
| Terms | * 6 - work = life +50 years * 6.1- anonymous work / 6.2 – joint authorship unknown – earlier of   + A – publication +50 Or   + B – making of work +75 * 7 – posthumous work * 9 - joint authorship – life of author who dies last + 50 * 11.1 – cinematographic   + No dramatic ch – 50yr after 1st published * 23(1) – performance   + 50 yr after performance – unless     - Published the sound recording- get another 50       * Max – 99 yr |
| Infringement | |
| Definition | 27(1) – **infringement** – to do anything that’s only CR owner has right to do   * + w/out consent |
| 27(2) – **secondary infringement**   * + A – sell / rent out   + B – distribute – to affect prejudicially CR owner     - Includes free distribution   + C – by way of trade- distribute/expose/offer for sle / rental/exhibit in public   + D – possess for purpose of a- c   + E- import   + Requirement     - Know/ should have known – infringe/ would infringe CR       * If registered = known |
| Approach | * 1. Real rights – author’s right in the work 3(1)   + A - Produce/reproduce   + B, c - Convert   + D- make sound recording, film, means so work can be reproduced   + F - Comm to public by telecomm     - **Performer - Only if not fixed –** 15(a)(ii), 15(1.1)(a)(i) * 2. Neighboring rights   + Performers right? 15   + Sound recording? 18 * 3. Moral rights 17.1 – performer, 14.1 – author * 4. Canadian Copyright law subsists Roy Export |
| Test | **Literary works**   * Substantial part reproduced -   + If resemblance too general – no Preston   **Artistic work**   * Include taking a piece of work – n transorm into diff form Kaffka   + Ex. transform architect design into actual building |
| Remedies | **Types of remedies**   * 34(1)- infringement - entitle to all remedies – that may be conferred by law   + injunction, damages, acct, deliver up, * 34(2) – moral right infringement – conferred by law * 35 – can claim for infringer’s topic   + Policy reason – often difficult to prove loss but easier to prove what infringer made |
| **Court can award**   * Profit * damage * 38.1(1)- statutory damages – court’s discretion   + if elect not to recover damage n profit – can elect this   + A- commercial purpose - $500-$20k   + B – non-commercial - $100-$5k * Punitive damages Adobe   + Consider – how much is the infringement     - How long it last     - D’s act n cooperation     - Continue to do it?     - Conducting trial to increase P’s cost? * Injunction- owner may recover possession 38(1)   + Esp if D is not doing for profit – other damages may not give much Roy Export   Approach   * Can focus on infringer’s profit Roy Export * Focus on P’s loss – Kaffka   + Financial and reputational gain * Consider D’s action   + If blatant disregard of P’s right – may increase amt Kaffka |
| **Criminal remedies**   * 42(1)- knowingly (requires Mens rea)   + A –primary infringement – sale / rental   + F, g – hybrid offence   + Requirement     - Knowingly     - For sale / rental   **Presumptions**   * 34.1(1) – **presumption in proceedings** that   + A – CR subsist – unless contrary proven     - 34.1(2)a- presumed who’s named is the author       * B- no name – publisher is presumed to own it   + B- author/performer/ maker/broadcaster – presumed to be owner |
| Secondary Infringement | 27(2)- discussed above   * E – importing infringement copies –\*\*big deal –   + Issue – owner of Cr in another country may not be same as in Ca   + Right –to stop ppl from importing even if legal in original country   **Requirement**   * Knows/ should have known would infringe CR OR * Would infringe Cr If had been made in Ca by the person who made it   + Two possible arguments Euro Excellence     - 1. Not infringement if – only merely incidental incorporating the work       * Implicit distinction btw         + selling / importing a copy of work as such vs         + incidental to object / service actually being sold / imported     - 2. Inability of exclusive licensee to sue licensor/ owner of infringement       * If exclusive licensee only- cannot sue owner, but if assignee then can |
| 27.1 – importation of books   * 1 – can’t import them – even tho person who published it had right to do so in Ca   + B – if importer knows copy would infringe if importer had made it * 3 – exclusive importer – has deemed int in cr * Protects   + CR owner’s     - monopoly right – not infringed cuz its auth     - Exclusive distribution right       * Owner’s right to control – which auth copies goes to which market * 27.1(5)- to stop importation – give notice in writing w/in prescribed time |
| Auth Infringement | 3(1)- CR owner has sole right to auth such act   * Implication – can go after person who’s authorizing the infringement   **presumption** – even if provide facilities that can be used for infringement, presumed to be used for legal purpose CCH   * unless – know user were breaking law but fail to stop them   + or encourage them to do so |
| Exceptions to infringement | Fair Dealing  **Principle** – don’t want to stifle public debate and development of culture   * Idea should circulate – so for certain ppl – should have right to use copyright material   29 – for purpose of   * Research * Criticism * Education * Satire and parody   Requirement   * criticism/ review - Mention – source, performer, author, maker 29.1 ­ * news reporting – same as above 29.2   Limitation   * Non-commercial generated content   **Approach**   * 1. Is the dealing for one of the statutory **purpose specified**?   + Approach - Access Copyright     - Look to predominant purpose       * May be other factors involved – but predominant purpose is the one       * Access Copyright – even if purpose includes helping teacher teach         + If predom purpose – help student study ok     - Consider the activity of ppl they serve   + Research includes     - Professional research CCH     - Consumer investigation of products on offer Bell     - Studying in school Access Copyright * **2. Was the dealing fair?** CCH   + Idea – balance btw user right for legitimate use vs owner not having econ right undermined     - Benefit of dealing generals for dealer vs detriment to Cr owner   + If grossly out of line on one factor – unlikely to be fair Bell   + Factors     - 1. Purpose of dealing – motivation       * If for profit – may become factor in balancing exercise Access CR     - 2. Character of dealing       * What’s been done to the material –         + Many copies or few?       * How transformative –     - 3. Amt of dealing       * fair – if modest scale       * unfair – if industrial scale       * proportion of the whole work Bell         + not aggregate of the sample / usage     - 4. Alternatives     - 5. Nature of work       * Some work – should be more publicly accessible than others       * Ex. law reports, public information     - 5. Effect of dealing on work       * Undermining Cr owner’s econ rights? |
|  | Statutory Exceptions   * 30.2 – not infringement of CR for library/archive/museum/ person actuing under auth   + To do fair dealing * 29.21 – non-comm user generate content   + 1 – not infringement to use existing work that’s published if     - To create new work – ie mash up     - A – for non-comm purpose     - B – source mentioned in reasonable to do so     - C – reasonable ground to believe not infringing     - D- does not have substantial adverse /exploitation of existing work * 29.22 – reproduction for private use * 29.23- fixing signals n recording prog for alter listening/ viewing * 29.24 – if owns/ license to use – to back up the copy * 29.4-30.04 –educational institution * 30.1-30.21 -libraries, archives n museums * 30.3 – copiers in educational institution n libraries, etc * 31.1 – provider of network service * **Copying onto audio recording medium for private use**   + 79-80 –defines the copying   + 81 – right to remuneration   + 82 - blank audio recording media already levied when purchased |
| Other issues | |
| Digital Rights | 41.1 – right to claim remedies –from anyone who circumvents tech protection measure   * Or offers to provide services / supply device to this end * 41.19 can reduce damage if was unaware n had no reasonable gground to believe it was contravention   **Exceptions**   * law enforcement (s. 41.11); * for circumventing technological protection measures for the sole purposes of enabling the user to make a computer program interoperable (s. 41.12); * for conducting encryption research (s. 41.13); * for the sole purpose of finding out how to prevent personal information to be conveyed to a third party (s. 41.14); * to assess the security of a computer and correct any flaws (s. 41.15); * to make the work available to a person with a perceptual disability (s. 41.16); * for a broadcasting undertaking to make an ephemeral recording for the purpose of broadcast (s. 41.17); * fairly broad power given to make regulations providing additional exceptions from liability in the interests of competition or for other reasons of public policy (s. 41.21)   41.22(1) **–** knowingly altering rights management info is prohibited   * Entitle to all civil remedies * 31.22(3) – deemed infringement if knowingly deals with a copy whose digital rights management info has been tampered with |
| Criminal Liability | 42 – criminal prosecution possible if – commercially motivated   * Sale/ rental/ offer for sale * Distribute * Import * Cause them to be performed in public w/out consent * requirement   + Knowingly – mens rea requirement   + for money |
| Collective Admin of Rights | **types**  1. Operate a licensing scheme   * Applicable to – works, performance, sound recording, authorization of use in return for std royalties n terms n conditions applicable to each type of use * Filing tariffs   + All licensing collective societies – may file tariffs applicable to repertoires w/ copyright board for approval   + Board- hear objection to prosed tariff 🡪 decide whether approved     - Then legally defines the royalties to be paid     - Has power to fix royalties in individual cases where tariff doesn’t apply   2. Carries on business of collecting and distributing royalties / levies payable under act   * Negotiates license agreements w/ individual institutions / users of work   + Either on comprehensive basis / transactional basis |

# Passing Off

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| Elements of Passing Off | |
| **Common Law** | **1. Goodwill –** marketing power of a particular thing  Requirement   * Distinctiveness   + Ability of the name/etc to distinguish P’s gds / services form those of others   + Depends on public perception     - Which can change over time * Ppl need to react to that name by associating the product with you   + Consumer- ultimate user     - Even if in pharmaceutical setting where dr prescribe n pharmacist picked it – still has right to chose as patient CIBA-Geigy * in association w/ particular product/ industry   + if diff industry/ product – may not be able to extent     - Disneyland – only limited to theme parks not hotels * must have gdwill w/in the jurisdiction where passing-off is taking place   + business does not need to locate in the J – only goodwill Disneyland   include   * In brand name Disney, Law Society   + Includes non-commercial entity Law society * Specific product name Warnink * Distinctive product appearance CIBA-Geigy, Kirby   + Secondary meaning- appearance of the pills must comm source of pill CIBA-Geigy * To public- indicate that the gds come from P / of a particular quality / type Warnink   + Reasonable segment of mkt who buys the product   Exclude   * No gdwill in “functional aspect”   + Reason – everybody who makes the product is entitle to share the gdwill     - Giving monopoly in the product – supposed to be by patent law   + Even if there’s alternatives – probably still banned     - If alternative shapes doesn’t work as well as yours |
| **2. Misrepresentation**  - no intention required   * Brand name/product name/ appearance – may mislead the public   + Into thinking gds are P’s or of the type that P has gdwill in   + But they are not * Has to use the name/ appearance in misleading way   + Confuses the public   Requirement   * Confusion among an appreciable section of “the public” for your wares /services   + Survey can be evidence   Includes   * Interfering w/ the proper use of that name law Society   + Ie. Ppl searching will be diverted to other site   + Reason – loose control over their name   Reason   * Public should not be led to think it is a type of product when it isn’t Warnik |
| **3. Damage** –   * presumed when prove first 2 elements   + Substantial confusion is enough to give remedy Disneyland   include   * Loss of sale * Loss of control over reputation of product/ business   + This is the minimum damage presumed- Disneyland |
| **Approach** | CIBA-Geigy   * 1. Goodwill/ reputation * 2. Misrepresentation which cause deception of public   + Consider – likelihood of confusion   + Initial confusion that matters Masterpiece * 3. Actual / potential damage |
| **TMA-** S 7 | S 7 – no personal shall   * A – make false/ misleading statement tending to discredit ware/ services * B – direct public attn. to ware/ services   + In a way – as to cause / likely to cause confusion in Ca   + Stat codification of tort of passing off     - 1. Gdwill     - 2. Mis rep     - 3. Actual/ potential damage * C – pass off other wares / services   + narrow version of passing off |

# Trademark

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| Meaning of TM | |
| **Definition –** s 2 | * certification mark – mark used to distinguish wares/services that are of a defined std   + used to certify some quality of the product     - ex. CSA approved * distinguishing guise –   + a – shaping of ware/ containers or   + b – mode of wrapping/ packaging   + appearance used for purpose of distinguishing wares/ services * wares- include printed publications * proposed trademark –proposed to be used to distinguish ware/ services |
| **Elements of Trademark** | 1. Use 2  Definition   * A- a mark that is **used** for purpose of distinguishing   + **Used –**in association with wares / services/ proposed to use 4     - 1 -Wares – deemed used on the product / packaging when sold       * At time of property transfer – tm is marked on wares/ packages     - 2- Services – used in advertisement * B-d – certification mk, distinguishing guise, proposed tm   + Amendment- now is a sign   **Approach**  S 19 – owner has exclusive right to use thruout Ca -   * Infringed – used with purpose to distinguish/id ware/ services from others Clairol   + to imply the product/ associate product with that brand     - Rights no infringed – if not used for that particular purpose   + Even if within use of s 4- may still not infringe s 19     - Mere statement of mark – not used * Consider   + **Descriptions** of w/s – only become tm if acquire secondary meaning Shredded Wheat     - Public – looks at it as a brand name       * Not just description of product   + **Intent** – irrelevant Tommy     - Even if don’t mean to use tm to distinguish ware from others       * Enough- If public perceives brand as indication of source   + Exclude- if use made it clear that gds did NOT originate w/ that person     - Nintendo – if packaging saying it works with Nintendo       * Not infringing – cuz not implying its Nintendo product     - Musidor BV       * Record says unauth recording –so know its not from Rolling Stone |
|  | **2. Distinctiveness**   * + Can be acquired/ lost over time |
| Registration of TM | |
| **Registrability of TM** | **Canada**   1. **USED** 2. **Must be person entitled to register mark** 16    1. Invalid if       1. 18 – if not person entitled to registration – registration – invalid       2. 17-          1. 1 - only if the person who’s the prior user can claim to expunged the tm          2. 2- 5 yr limit to oppose             1. Unless – est that current tm owner – know of the previous use/ make known       3. If previously used – even if not in same area can expunged the TM masterpiece    2. Application – advertised in CA Gazette –can oppose w/in first 5 yr after registration       1. Burden – on applicant to show they are the person entitled    3. 3 source of conflicts       1. 1 – have used in CA / made known in Ca          1. Unless confusing with:             1. A – tm previously used             2. B – tm of application previously filed             3. C- trade name previously used       2. 2- applicant filing application already registered in country of origin       3. 3 – proposed tm          1. Look at – the date of application 3. **Registrable mark-**    1. Not Excluded by 12(1) 4. **Distinctive**  - specific to gd n services/ particular types    1. base on **what is on the market in ca** Imperial Tobacco       1. Spillover advertising – should not deprive Ca brand owner of their brand          1. Reason – its sth that Ca owner has no control    2. Don’t lose distinctiveness even if       1. Ca does not realize there’s Ca brand – doesn’t mean it loose its distinctiveness |
| **Registered in other country**   * 14(1) – * registered in country of origin – 2   + country of union – part of treat/ WTO member     - a- with real and effective industrial/comm est     - b – domicile     - c – citizen/ national   **test**   * + a- not confusing with registered tm   + b – not w/out distinctive character     - more relaxed then CA requirement – lowers bar for foreign registered marks   + c – not contrary to morality / public order   + d- not prohibited marks |
| conditions for registration | * invalid if 18(1)   + a – not registrable at date of registration   + b- not distinctive at time of proceeding     - ie . lost distinctiveness   + c – abandoned   + not the person entitled to secure registration * international aspect   + 34(1)- if apply to register in another treaty country     - A – within 6 mth filed in CA     - Deemed application date to be date of filing in the treaty country |
| contents of application - 30 | * a – connected to the /s which mark has been used/ proposed to be used * b – used – need to propose the date * c – if known but not used in ca * d – preferential treatment for tm that’s registered abroad   + less hurdle for registration * e – proposed – statement of intend to use * g – I – mechanics   + h – unless only registering word – need to provide drawing   + I – statement that u believe u can use them in ca |
| TM Not Registrable | |
| 12(1) – **not registrable** if | A – **primarily merely** the name/ surname of ppl – living / died w/in 30 yrs   * + **Test-** Primarily merely a name/ surname – of individual in Canada Std Oil     - If Ca public would perceive mark as primarily merely a name |
| B - **clearly description / deceptively misdescriptive** in Eng/ Fr   * + - Can be misdescriptive – if not deceptive     - **Description Test** - How the regular person is going to perceive it Teachers Pension Plan       * If view as description of the ware/ service – cannot register     - **Misdescriptive**        * Need to be recog by CA public as a description Parma |
| C – name of the ware/ service- no exception  d - **confusing with registered TM –** see below |
| e - **prohibited marks** in 9, 10  9 – Official marks- cannot adopt any mark that consists/ nearly resembles listed marks   * + Mechanism   + Public auth – can simply send a letter n request registrar to give public notice     - Outside the system – so even if confusion – ok   + Pre-empts adoption of mark/ similar mark   + Operates prospectively only – doesn’t invalid current occurring use   + Test- for public authority need both Ont Architects     - Govt control – need ongoing govt input       * Not enough if created by statute       * Has to be controlled by CA govt - Parma     - Public benefit   11.14. &.15 – geographical indication protection for wine and sprit   * + May not use unless actually come from indicated region   + Exception – 11.17 – doesn’t apply if used b4 1994 or 10 yr b4 that date |
| Confusing with Registered TM | 12(1)(d)- reason – would undermine monopoly   * Unless – own by same person 15 |
| **Confusion Requirement** – 6  **Requirement**   * Cause confusion if use of both in same area 🡪 inference its by same person 6(2)   + Consider – would public perceive its from same course? * Confusion – as to source   **Test -** Effect of mark- public confusion as to source 6(2)   * + Not about visual similarity * 6(5)- consider all surrounding circumstances   + Inherent distinctiveness of tm n extent become known   + Length of time used   + Nature of wares, services / business     - If two brands are in very diff segment – not met Barbie, McDonald   + Nature of trade     - How the business is conducted   + Degree of resemblance in appearance/ sound/ in ideas suggested by them     - Without resemblance – hard to see how public could be confused / misled about the source of the gd |
| Standard   * Whether Casual consumer somewhat in a hurry would be confused Mattel   + Focus-first impression of consumer masterpiece     - Cost might come into play – but its still consumer somewhat in a hurry       * Irrelevant if they could figure out afterwards   + Reason – will give confusing mark an unfair edge |
| Consideration   * Famous mark – no privileged treatment Mattel   + Possible to leap over diff bw wares     - But question of fact – whether they actually did   + Even powerful brand has limits McDonald     - Not everything that reminds you of powerful brand is confusing with it * Family of marks – McDonald   + could possible expand range of marks that might be confusing with it * Intention is irrelevant Mattel   + Even if intended to – if no confusion- can register * Location Irrelevant Masterpiece   + 6(2)- “if used in same area, would likely to lead to”     - Hypothetical – if both were use in same area, would ppl be confused? * Look at how the registered mark can be used Masterpiece   + Not at how its been used / actually used   + Look at the application mark – registrant can display the world in any way they want     - So even if for now its not confusion – but free to use it anyway they want |
| Registered vs unregistered   * if registered-   + can oppose registration of any TM that would be confusion with it under 12(1)(d) * unregistered 16(1)   + allows u to oppose registration of any confusing TM that applicant started using after you started using yours   + once registered – monopoly extends to any mark that’s confusing with yours 20 |
| 9 – prohibited mark – appearance test   * Can’t use this mark / anything that looks like it |
| **Exceptions** | **12(2)- exception acquired distinctiveness**   * May registered 12(1)a or b if had become distinctive –   + Requirement – evidence   35 – **disclaim the right to the exclusive use** of portion that’s not independently registrable   * Can register TM with parts unregistrable if disclaim exclusive use of the part * Consider- Whether the mark as a whole is still distinctive Lake Ont Cement   + take away the disclaimed part away –     - See whether its still distinctive?       * If disclaimed word dominate mark – not registrable         + Ie. Design elements/ other things are significant contributor to distinctiveness |
| Distinguishing Guise | 13 - **only registerable if**   * 1(A)- used to become distinctive at date of filing   + No proposed only – actual use   + Need evidence it become distinctive   Limitation   * 13(1)(B) – exclusive use – not likely unreasonably to limit development of any art/ industry   + 13(3) – may be expunged if become likely unreasonably to limit devel. * 13(2)(b) – no registration interferes w/ use of any utilitarian feature embodied in distinguishing guise * Consider –   + How the industry would be affected by the product     - Regular industry practise       * Ie. Always chose key blanks that look the same –if tm can’t Dominion Lock |
| Distinctiveness | * base on **what is on the market in ca** Imperial Tobacco   + Spillover advertising – should not deprive Ca brand owner of their brand     - Reason – its sth that Ca owner has no control * Don’t lose distinctiveness even if   + Ca does not realize there’s Ca brand – doesn’t mean it loose its distinctiveness |
| Licensing and Transfer | |
| Licensing | S50 – allows you to license TM   * Wont loose distinctiveness   + Even if 2 sources of your product * Don’t need to be registered * Requirement   + Licensor maintains control over the quality and character of w/s id by mark     - Look at the licensing agreement Eli Lily       * When dealing w/ related company – unlikely to find parent company has no control |
| Transfer | 48 - whether there’s transfer – question of K law   * Not required in writing * Unregistered tm – all abt evidence * Register – has to register transfer |
| Infringement | |
| S 19 | right to exclusive use of TM throughout CA   * Infringed if confused Phillip Morris * Look at general impression created by the brand – the “thought” that’s created   + Use of design mark – even w/out name – can be confusing with word mark     - Reason – design evokes a psychological association w/ word |
| 20(1) | 20(1)- deemed infringement   * if use with a confusing TM |
| usual approach | * TM owner – other party is infringing my mark cuz using a mark that’s confusing with it * Other party –   + Not confusion Or   + Mark is not valid 18 |
| Spillover effect | * CA TM owner – should not be affected by circumstances beyond their control   + Spillover of advertising by other countries * If not on Ca market –   + Product attempting to use spill over effect – CA owner has right to stop     - Marlboro – got on register b4 spillover took place so as long as maintain use – ok       * ie US Marlboro wasn’t popular when got on register * If both on CA market – look for confusion |
| Depreciating Value of Goodwill | S 22- no person shall use TM in manner w/ effect that is likely to depreciate the value of the gdwill   * Idea – use should be protected, anti-dilution provision   + Not be used to depreciate its value – even if legal use * **Requirement**- Veuve Cliquot   + 1. D has to be using P’s mark     - Used as in s 4   + 2. Is there goodwill ?   + 3. Use is likely to affect the goodwill – association btw the two   + 4. Is the effect depreciating? |
| Remedies | **Monetary**   * damages * Acct of profits – equitable so at discretion of the court * Punitive damages   **Non-monetary**   * Delivery up of infringing articles * Injunctions   + Need to show clear irreparable harm   **Federal vs prov court**   * Prov – interlocutory injunction * Federal - counterfeit and piracy   + Ex parte injunction – allow to seize gd w/out them knowing you r are coming     - Requirement     - Start an action w/in 2 weeks to justify seizure n detection |

# Patents

|  |  |
| --- | --- |
| Procedure for Obtaining Patent | |
| **Application for Patents**-27 | **1. File application in accordance w/ the act**   * + 2- file application in accordance with the act   + 3 – specification     - A -Must correctly n fully describe the invention – its operation / use       * disclosure – where u reveal ur invention to the world         + Requirement –   Enable reader skilled in the art to replicate the invention Teva   * + - B – If have process – must set out the process OR method of constructing     - C – machine – explain the principle     - D – process – explain process   + 4 - must end w/ claim defining in explicit terms the subject matter of the invention     - Disclosure in (3) – kind of a story / narrative     - Claim here– definition, set the boundary of what you claim that you have invented   + 28.1 – Can backdate application date if filed w/in 12 mth of foreign application   **2. Patent office Examines your application**   * compare w/ existent registry * test out the invention   **3. If satisfy – issue patent**   * 42 – monopoly, exclusive right of making, constructing and using |
| Term | 44 - Canadian – 20 yr from filing date   * S 2- filing date is the date on which application is filed in accordance with s 38 * 28.1 – claim date is not always the filing date * Actual term – usually less cuz its long examination process |
| Patent Bargain | |
| **Requirement for patent** | 27(3)- **Disclosure**   * Requirement Teva   + Enable reader skilled in art / sc to replicate the invention     - Should not require testing * Approach – look at the whole claim as a whole, not claim by claim Teva   + Since its all one invention – only diff aspect of one invention * Reason - Bargain theory Teva   + govt grant patent – in return for gaining knowledge     - specification has to let others know what the invention is |
| Patentability | |
| **Subject Matter** | **KEY –** can only patent invention NOT ideas   * **Idea –**    + 27(8) **–** cannot patent for any mere scientific principle or abstract theorem * Invention – need to be more than idea   + But difficult to ascertain what “more” means |
| **medical treatment**  can claim   * + if claiming substance x or substance x used for treatment y   Can’t claim   * according to Tenesse – not patentable, unknown if its gd law   + prob – at the time there’s the law related to not been able to patent drugs     - since allow med treatment to be patented – indirectly allow pt to drug * Mayo Collaborative – US case that help no pt can be granted for method of gauging correct dosage   + Reason – amt nth more than using law of nature to achieve certain tech     - Using well known tech * can consider it under professional skill – still not patentable   + reason – would inhibit medical access * Norvatis (2013)- ban on medical treatment still law in Ca   + Cannot go beyond to include method by which treatment is to be carried out     - If include how the way the med is admin –that’s med treatment       * Not patentable |
| **Information Tech**  Can’t patent   * Computer program – no matter how complex Schlumberger   + Fcn as usual but to perform a new task according to prog’s instruction   + Reason – 27(8) mere abstract principle/ sc theory     - Contains only set of instruction designed to get computer to take certain steps       * That is not invention   Can patent   * If instruction interact with computer / other equipment to produce sth that fcn in a new way IBM   + Physical improvement – efficiency in hard drive by the process – patentable IBM     - Ie sth that does sth novel w/ hardware, sth physical   Approach   * Is it pure computer or its computer program + sth else |
| **Living Matter**  Can patent   * Genetic modification process - Harvard * One cell organisms * Genetically modified cell Monsanto   + Invention extends to the cell – when incorporated in living matter   Can’t patent   * Animal/ plant Harvard   + 1. Construction of act – wording n stuff doesn’t allowed   + 2. Complex policy issues – should be dealt by parliament     - Ex. self-replication, natural growth * Can’t patent a naturally occurred sequence of cell Assc for Molecular   + Only discovery – no invention     - Irrelevant whether u have isolated in lab   + Policy reason – want knowledge to flow as freely as possible altho want ppl to conduct sc research on genetic materials |
| Test for Invention- s 2 | **1. Art / process that’s patentable under** s 2**?**   * New and useful art, process, machine, manufacture / composition of matter OR   + New and useful improvement in any art, process, machine manufacture / composition of matter     - art – means method     - process- can patent the method distinct from the product * include   + different use for previously known substance Shell   + computer program + to produce sth that fcns in new way IBM   + business method Amazon     - requirement       * sth with physical existence OR       * sth that manifests a discernible effect/ change       * Re Progressive Ins – system of monitoring car performance n sent to ins computer for process and analysis         + Feedback to website to insured         + Invention – more than just way o programming relevant computer   Monitoring hardware placed in vehicle🡪 novel combination   * + - not enough       * if its practical       * or mere use of computer   + Genetic modification process - Harvard   + One cell organisms Harvard   + Genetically modified cell Monsanto * exclude   + professional skills Lawson   + medical treatment Tenesse, Norvatis   + pure computer program Schlumberger   + Animal/ plant Harvard   + Naturally occurring sequence / genes Assc for Molecular |
| **2.. Useful –**   * Doesn’t have to be commercial success – but has to have some practicality * **Requirement –**    + Some practicality   + Sound prediction – given the way they work, could predict its useful OK     - Ok if there’s sound prediction – **at the time of claim date**        * **Even if prove useful later – irrelevant**         + But @time of claim date – need sound prediction     - Must disclose the facts on which the prediction is based       * And line of reasoning behind the prediction     - If turns out to be incorrect- patent is invalid for want of utility   + Does not need to justify the financial/ other value of use |
| **3. Novel –** was it already out there   * 28.2(1)(b) – cannot become available to public in CA / elsewhere be claim date   + Not valid – fi disclosed by 3rd part so subject matter is available to public anywhere     - Doesn’t need to be made – only need to be known   + Exception     - (a)- applicant disclosed the information       * Grace period – 1 yr to file for patent after disclosure   Consider   * **anticipation test –** Apotex * 1. Disclosure –   + Whether subject matter was previously disclosed-   + Disclosure – has to be total, whole intention disclosed * 2. enablement - Did the info out there **enable** you to make the patent –   + Has to allow person skilled in the art (no inventive quality) to make it without undue burden     - Can require a little bit of trial and error to confirm how to arrive at the variant       * If more than routine needed – new thing not anticipated   + Previous disclosure to public   + Combinations   Includes   * new use for a previously known substances – qualifies as an art/ process   + even if the composition / compound is already known Shell     - If discover new way of using it then – patentable Calgon * **Selection pt -** recog that a whole grp of things may be useful Apotex   + then find some part of grp to be even more useful 🡪 can pt   + requirement- must be in respect with     - quality or     - special adv particular to a selected group only * Combination – can have patents if put known things together Domtar   + Fcn is diff as a group then as a fcn on its own     - If when put together – fcn is no diff than fcn apart – not pt   + Old integers have to interact in some way so as to produce new result |
| **4.** **Non-obvious**   * + 28.3(b)- not be available to public b4 claim date   + **Principle**      - Cannot claim if – any person skilled in the art would have known this   **Test**  – **Consider from POV of person skilled in art w/ no inventive quality** Apotex   * More or less self-evident that trying would ought to work   + if thinks it ought to work/ self-evident when tried – obvious * extent of nature n amt of effort required to achieve invention   + look at how invention was arrived – if difficlut n lots effort🡪 invention * motive to find invention   + whether there’s a reason motivated by prior art to think should try this     - ie particular reason for picking one aspect of pt over the other * Obvious to try –   + Can require a little bit of effort – but not too much |
|  | **focus of test** Amazon   * On the subject matter of the claim – What is in the application   + Should not try to distinguish btw what’s actually invented vs what the application says * Approach- purposive approach of interpretation |
| **Exceptions** | 27(8) – no patent shall be granted for any mere sc principle/ abstract theorem   * Note – even if law not here, still same law cuz cannot patent idea, only invention   Idea vs expression   * Cannot patent math formulas, mental operation   + The more concrete the outcome is – heading into territory of art / process |
| Patent Construction | |
| **Approach to claim construction** Whirpool | **1. Purposive construction –** read for the purpose of understanding the invention   * Read it as the person skilled in the art would read it   + Need to keep in mind its explaining an invention * Construed in the context of the whole specification   + Translating it from English into the real thing * Time- at the time of the publication   + Reason – that’s when the information became available to the public     - As of that date – meaning has to be fixed * Approach – look at the **essential element**   + Whether later patent was valid - consider     - Was there an added new essential element?     - Whether was infringed       * Was the essential part used?   + Depends on person skilled in the art sees an essential |
| Infringement | |
| S 42 | S 42 – list out the rights of patent holder. Exclusive right-   * + making   + constructing   + **using** Monsanto     - includes merely possessing in context of business is enough -     - consider intention –       * infringed if         + might use it or intend to use it in future       * if doing in context of business         + presumption – doing it to service business purpose   even if never actually exploited   * + - approach – consider whether pt holder’s econ benefit is deprived   + vending it to others to be used |