## General Principles

|  |  |  |  |
| --- | --- | --- | --- |
|  | Copyright | Trademark | Patent |
| Protects | **Ideas** – expression of ideaWork – literary, dramatic, music, artistic | **Goodwill**  | **Inventions**Include – new way of ding things, embodiment of idea, implementation of ideaExclude – ideas |
| Rights | Sole Right to exploit workNo 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

|  |
| --- |
| 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 Programs2- 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

|  |
| --- |
| Elements of Passing Off  |
| **Common Law** | **1. Goodwill –** marketing power of a particular thingRequirement* 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

|  |
| --- |
| 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 exceptiond - **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
 |