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# C’right: overview,

## Copyright Overview

* 1. **Definition**
     1. Set of exclusive rights in works of expression; performer’s performances, sound recordings, and communication signals.
     2. **Legislative Authority**
        1. Federal Government is responsible for copyright in Canada s.91(23)
        2. No common law copyright in Canada 🡪 Act
           1. *Theberge: Copyright in Canada is a creature of statute and the rights and remedies it provides are exhaustive*
        3. Modernization of Canadian copyright law = a work in progress
        4. Bill C-11- Copyright modernization act
        5. Recent right for extension for sound recordings
  2. 4 Justification theories
     1. Rewarding authors by market efficiency
     2. Personality of authors
     3. Human rights of author
     4. Protects authors dignity and autonomy interest
  3. Purpose of Copyright
     1. What basis can copyright be justified?
        1. It is justified because it establishes exclusive rights & provides an economic incentive resulting in benefits for that country/person. Creates market efficiency & rewarding authors for their work by profit
        2. Former approach: author centric
           1. Focused on rewarding and protecting the author

#### Theberge Case [articulates purpose current pupose]

* + - 1. Purpose is balance between promoting the public interest in the encouragement and dissemination of works of the arts and intellect and obtaining a just reward for the creator.
         1. Balance between the 2 goals is

Encourage people who create and;

Reward authors

#### Cinar Corporation v Robinson

* + - 1. Copyright act seeks to ensure that an author will reap the benefits of his efforts in order to incentivize the creation of new works.
  1. Origin of Copyright in Canada
     1. Stationers Company
        1. Was a system in place regarding the printing of newspapers? Once the company asserted the printing once, no other company was allowed to print it. They were allowed to regulate and censor work of the government
        2. *Purpose: to prevent non-members through sanctions*
     2. Statute of Anne [1709/10]
        1. Created to limit the power of booksellers by returning a right to the author after a certain period of time and by imposing a limit on copyright protection [14 years, and renewable for another 14 years]
        2. *Purpose: to advance the public interest in the creation of work that if we give authors rights it will lead them to create more work and benefit the public*
     3. *Purpose of these 2 french droits d’auter system was to protect and reward authors and morals rights expressed in the work*
     4. Canada
        1. ***Theberge***
           1. Canadian copyright law has been more concerned with economic than moral rights. The economic rights are based on conception of artistic and literary works essentially as articles of commerce
        2. ***Cinar Corp v Robinson***:
           1. “infringement of copyright in this case interfered with Robinson’s personal rights to inviolability and to dignity recognized by charter”. Clear to see that we have a French heritage about commerce and economics

# What is copyrightable

* (1) the work is covered by the CRA
  + must fit into one of 4 main categories
    - (artistic, dramatic, musical or literary)
* (2) fixation into a tangible form
* (4) expression vs. idea
* (5) originality

## Step1: Copyright Act

* 1. S.5(1)
     1. Subject to this Act, copyright shall subsist in Canada, in every **original literary, dramatic, musical and artistic work** if any one of the following conditions is met:
        1. In the case of any work, whether published or unpublished, including a cinematographic work, the author was, at the date of the making of the work, a citizen or subject of, or a person ordinarily resident in, a treaty country;

## Step 2: Requirements for Copyright

### Registration

* + 1. Not a condition for copyright
    2. ***Policy Question: Should Copyright be registrable****?*
       1. *if you ask people to register it will lead to fewer people registering and gaining benefits.*

### Fixation

* + 1. Work in order to be capable of copyright protection if it can be fixed in a tangible form [*rediffusion case].* It is a requirement for **certain** types of work but not a general requirement.
       1. Eg. Words on a page, paint on a canvas.
          1. Requirement by judicial interpretation
    2. *Policy Question: is fixation requirement beneficial***?**
       1. still an aspect that can’t require fixation such as movements/dances/general conversations/stand-up comedy. If we get rid of fixation it allows for more flexibility.

#### Case Example: Gould Estate et al v Stoddard Publishing [Fixation Requirement]

* + - 1. FACTS:
         1. g a famous pianist who was interviewed for an article. 40 years later, article published in a book called “Glenn Gould” which included photographs and conversations that Caroll recorded during the interview. Gouldes Estate stated they didn’t receive royalties and sues for copyright infringement due to authorization of publication
      2. ISSUES:
         1. Is there copyright in the spoken words by Goulde?
      3. REASONING:
         1. Court rejected the idea and stated that **not every utterance made by individuals is a valuable property right.** In order for they’re to be copyright in the work it needs to be fixed. A person’s oral statements are not literary creations and do not attract copyright protection.
         2. Court said if Gould requested questions beforehand and prepared his answers = copyright since there was fixation, however, speaking spontaneously gives the person who is writing the words down copyright in that work.
      4. *Policy Reasoning from case:*
         1. *Anytime a journalist published statements about celebrities who weren’t happy with that statement all they had to do was bring a copyright infringement case. It would restrict free speech.*

#### Case Example Theberge v Galaerie Art du Petit Champlain

* + - 1. FACTS:
         1. Appellant purchases right to produce the poster art. However, instead the A decides to transfer the ink from the poster backing onto the canvas backing to make it more esthetic. Theberge sues for copyright infringement
      2. ISSUE:
         1. Was there copyright infringement? Did it meet fixation requirement?
      3. RATIO
         1. Theberge gave up the economic right. In order for they’re to be an infringement there must be reproduction of a substantial part of the work. Here there was only a transfer, which did not constitute reproduction.
         2. Binnie j: said that since the number of copies was not increased, no “reproduction” occurred for the purposes of copyright and no infringement occurred. **Stated that fixation distinguishes works capable of being copyrighted from general ideas**
         3. **Gontheir J: Fixation is the fundamental element of the act of reproducing a work.**
      4. DISSENTING
         1. L’Heureux said that copyright concerns the fixation of an idea into material form. The ink transfer process created new fixation into material form and accordantly it should be considered reproduction for the purposes of copyright, even if the original happned to be destroyed; therefore transfer violated copyright

### Originality

* + 1. S.5 of the Act states that originality is the gatekeeper for copyright protection. If work is not original but satisfies all other requirements it **will not be copyrightable**
       1. If it comes from a person and is something more then a copy and the contribution of author is **unique and novel** = originality.
    2. Originality in Canada
       1. Pre-2004
          1. Sweat of the brow: work received copyright protection if it originates from an author and is more than a mere copy
          2. Creativity: a work must be the product of creativity in order to be original
    3. **Originality Test**
       1. Exercise of skill and judgment
          1. Skill = use of own knowledge, developed aptitude or practiced ability in producing the work
          2. Judgment = use of ones capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work.

*Eg: head notes of cases, case summaries, topical indexes, compilation of reported judicial decision.*

#### Case Example: CCH Canadian LTD v Law Society of Upper Canada

* + - 1. FACTS:
         1. Operated a reproduction service where they would photocopy requested passages from legal materials and send these reproductions to requesters. CCH accused the law society of violating their copyright by reproducing protected material.
      2. ISSUE:
         1. Did a photocopy of a single piece of work violate copyright law?
      3. REASONING
         1. The court stated that in order for a work to be original, you need an exercise of skill and judgment that is more than purely mechanical exercise. The plain meaning of original implies not just creativity, but something more such as intellectual. Cant be just a sweat of the brow approach, it needs to safeguard the author for additional skills
         2. **Adding a few things to decisions such as basic factual information, fixing grammatical errors and spelling mistakes cannot be characterized as a merely mechanical exercise.**
         3. McLachlin CJ [5 justifications to her decision:

Plain meaning of original implies that not just creativity, there needs to be some intellect.

History of copyright points back to BURN convention, the underlying purpose is to reward and protect authors and intellectual creations

Recent jurisprudence rejects the sweat of the brow approach

Purpose of copyright act is that if we are going to interpret as copyright then it cant be just the sweat of the brow approach, it is to safeguard the author for additional skill and judgment to allow the public domain to flourish

Workable, yet fair standard which higher then the sweat of the brow approach but so high that it deprives creativity of certain author of copyright

* + - * 1. TEST

Skill = use of owns knowledge, developed aptitude or practiced ability in producing the work

Judgment = use of ones capacity for discernment or ability to form an opinion or evaluation by comparing different possible options in producing the work.

* + - * 1. Work found original after CCH

Head notes of cases, case summaries, topical indexes, compilation of reported judicial decisions

Skill = picking out essential pieces and exercising critical thinking

Judgment= using own knowledge on how head notes are presented and creating work to the expectation to produce work

## Step 3: Work that is Copyrightable- artistic, dramatic, musical literary [s.2]

### Facts and Ideas

* + 1. Facts and ideas **are not entitled to copyright** protection
       1. Facts aren’t protected because only work that are authored or created get copyright protection, where as with facts = discoverable.
       2. No copyright in facts/ideas/procedures/methods of operation/mathematical concepts/ arrangemetns/ systems/schemes or methods for doing a particular thing or processs.

#### Case Example- Kenrick v Lawrence

* + - 1. FACTS:
         1. A company held the copyright in a drawing of a hand, holding a pencil, and drawing a check-mark into a box. A rival company produced a card with a similar but not identical drawing of a hand drawing a check-mark in a box.
      2. ISSUE:
         1. Was the use of the check-mark with a hand holding a pencil an idea protected by copyright?
      3. RATIO
         1. Court held that copyright has to be confined to things. Ideas expressed by a copyright work may not be protected because they are not original, or are so commonplace and that copyright has to be confined to things special to the individual drawing.
         2. In order for there to be an infringement in the idea every line measurement has to be exactly like the original.
         3. Ways to separate ideas from expressions is to consider whether an infringement took place – infringement = copy perfectly the specific drawing.

#### Case Example: Delrina Corp v Triolet- \*IMPORTANT CASE ON WHAT IS NOT COPYRIGHTABLE

* + - 1. FACTS:
         1. The P Delrina sued Triolet for infringing its copyright of the computer program by designing similar software called Assess. Delrina hired the D, and after the D left the P’s company he created similar software.
      2. ISSUE:
         1. Was there copyright infringement of the software program?
      3. RATIO
         1. The court said that the non-protection of ideas embraces the view that there is **no copyright in any arrangement, system, scheme or method for doing a particular thing or process**. Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts **as such\***
         2. Abstract Filtration Comparison

Abstraction

Identify the general idea behind the work

Filtration

Filter out all non-protectable elements to protectable = core of material that is protection

Comparison

* + - 1. *Policy Reasoning:* 
         1. ***Ideas, arrangements systems, or schemes or processes mathematical concepts are not protected under copyright*** *to preserve public use. Certain creations of the mind that we don’t want others to have property rights over. For Delrina, there was the* ***merger*** *doctrine that there was only a couple of ways that ideas develop and want to make sure people continue to do those things.*

### Literary Work

* + 1. S.2: literary work includes tables, computer programs, and compilations of literary work.
       1. **Literary work is** words expressed in print or writing, books, novels, work of literary merit, a work with story.
       2. Literary work must be of a specific length; no separate copyright in the title of a work unless original and distinctive

#### Case Example: University of London Press v University Tutorial Press – Exam = Literary

* + - 1. FACTS:
         1. Case dealt with examination papers, which were written for the University of London. University of London assigned copyrights and rights of publication to any specific exams for a period of 6 years. In the same month University Tutorial published exams from the previous year attained from students. London Press sued Tutorial press for copyright infringement over the published Exams.
      2. ISSUE?
         1. Are the exams protected by copyright?
      3. RATIO:
         1. **Copyright acts are not concerned with the originality of ideas, but with the expression of thought.** **Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work.** Literary work is not confined, literary work covers work that is expressed in print or writing irrespective of whether the quality is high. Literary is used in a sense of literature and refers to printed or written matter.
         2. Papers set my examiners = literary work.

#### Exxon Corp v Exxon Insurance Consultants – word = not literary work.

* + - 1. FACTS:
         1. Exxon sued Exxon insurance for copyright infringement for the use of the work Exxon which had been fully created by the company, being a word not existing prior to its creation in the English language.
         2. Evidence was put forth as to the careful creation and selection in this process through a large time, expenditure and labor investment in the word’s creation, potentially indicating it as an original work.
      2. ISSUE?
         1. Was the name EXXON an original literary work protected under copyright
      3. RATIO
         1. Court stated that some expression is not eligible for copyright protection because it is too minimal to satisfy the requirements of an original literary work under s.2. The court said that it is a word, which, though invented and therefore original, has no meaning and suggests nothing in itself.
         2. Court said a literary work is **intended to afford either information and instruction or pleasure in the form of literary enjoyment.**
         3. EXXON did not afford any information or instruction, nor did it provide pleasure through literary enjoyment by itself; therefore it was **not** a **literary work.** The fact that there was labour or invented, or research doesn’t entitle it to a literary work.

### Titles of Work

* + - 1. titles of work do not have a separate copyright.
      2. S.2 states **title of work is included if it is original and distinctive in some cases.** 
         1. *Eg. Long titles*

#### Case Example: Francis Day and Hunter v 20th Century Fox Corp

* + - * 1. FACTS:

Francis Day and Hunter released a song titled “the man who broke the bank at monte carlo” which was written by Fred and acquired copyright. 20th century fox released a film with the same title, which had no connection to the song.

* + - * 1. ISSUE?

Was there infringement of the literary copyright?

* + - * 1. RATIO:

The court stated that the definition of work included the **title thereof when such title is original and distinctive**. Further stated that there is no separate copyright in the title of works and is too small to have copyright protection.

Work includes title where the title is **original and distinctive** it is included as part of the work.

### Dramatic work

* + 1. S.2 states a dramatic work includes
       1. Any piece for recitation, choreographic work or mime, the scenic arrangement or acting form of which is fixed in writing or otherwise,
       2. Any cinematographic work, and
       3. Any compilation of dramatic works.
    2. **Story, thread of consecutively related events** either narrated or presented by dialogue or action or both

#### Case Example: Hutton v CBC

* + - 1. FACTS:
         1. P co produced with the D, CBC, a television series known as Star Chart. CBC cancelled the program. 3 years later CBC produced a series called Good Rockin Tonite. Hutton alleged CBC copied the concept and creative element and breached his copyright.
      2. ISSUE:
         1. Did CBC infring P’s copyright by producing a similar dramatic work
      3. RATIO:
         1. Court stated that a dramatic **work must have a story, a thread of consecutively based events either narrated or presented by dialogue or action or both.**
         2. Court held that there was no infringement

#### Case Example: FWS Joint Sports Claimants v Canada [Sports play = not copyrightable]

* + - 1. FACTS:
         1. FWS argued that there should be copyright in the football moves performed by their athletes as they were created by coach’s written playbook and game.
      2. ISSUE:
         1. Are sports move considered choreography amounting to copyright?
      3. RATIO
         1. Court said that a coach’s written playbooks and game plans were **copyrightable but the play itself would not qualify for protection under copyright** due to a play being unpredictable and not planned. 🡪 lacking certainty and creativity.
         2. The court stated a mere spectacle is not sufficient to attract copyright protection because it is inconsistent with the concept of choreography and what transpires on the field is not what is planned but something unpredictable.

*If you can bet on the outcome of a dramatic work = not copyrightable.*

#### Case Example: National Basketball Association v Motorola- Athletic feats = not copyrightable

* + - 1. FACTS:
         1. Motorola manufactured and marketed the SportsTrax paging device which uses game information supplied by sports team analysis and compiled its scores and statistics by employing people to listen or watch the game, and then entering the scores on the computer and transmits scores to online service. NBA argued that they won the exclusive rights to transmit scores and claimed Motorola infringed in NBA through misappropriation of the game arguing that the factual data about the game represents the overall value of the game.
      2. ISSUE?
         1. Was the broadcast of the NBA game protected by copyright?
      3. RATIO:
         1. The court said that the broadcasts of the NBA games, and not the game itself are entitled to copyright protection.
         2. There is no copyright in sports move since it would prevent people from watching. Copyright extended to broadcast but not to the game.
         3. HELD that A was not infringing copyright in the NBA games.

### Artistic Work

* + 1. s.2 defines artistic work as;
       1. Includes paintings, drawings, maps, charts, plans, photographs, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations of artistic works
          1. ***Artistic if it has an emotional impact on viewer***
    2. **Includes work expressed** in a visual medium, artistic merit, and artist’s intention to create art, aesthetic value of the work is not relevant to the question of whether the work is an artistic work. [DRG Case]
       1. *Policy question: should artistic merit, the artist’s intention to create art, and the aesthetic value of the work be relevant to whether something meets the classification of artistic works? DRG case*

#### Case Example: DRG Inc v Datfile Ltd.

* + - 1. FACTS:
         1. P argued that there was copyright as an artistic work in his filing system that incorporated colours, numbers, and letters. The P was claiming copyright in the design of the labels.
      2. ISSUE?
         1. Did the P have copyright in the artistic work regarding the colour-coded labels?
      3. RATIO:
         1. Court held that the filing system was improper subject matter for copyright because it served a functional purpose.
         2. The court held that the design of the bales was an artistic work because it was a general description of work that finds **expression in a visual medium.**
         3. **Court held that artistic merit, artist’s intention to create “art” and the actual aesthetic value of the work are not pertinent to the question of whether a work meets the classification of artistic work.**

### Musical Work

* + 1. s.2 defines musical work to mean;
       1. Any work of music or musical composition, with or without words and includes any compilation thereof;

## Other Copyrightable Work

### Compilations

* + 1. S.2 defines compilations
       1. As a work resulting from the selection or arrangement of literary, dramatic, musical or artistic works or of parts thereof, or
       2. A work resulting from the selection or arrangement of data.
    2. Requirement:
       1. Work must be **original** in order to attract copyright protection
       2. *Case example: CCH [ under original requirement] 🡪 originality requirement*
          1. The court stated that in order for a work to be original, you need an exercise of skill and judgment that is more than purely mechanical exercise. The plain meaning of original implies not just creativity, but something more such as intellectual.
          2. What is copyrightable

Para 33: reported judicial decision when properly understood as a compilation of headnotes and accompany edited judicial reasons, are **original** works. Copyright protects original form or expression. A compilation takes existing material and casts it in a different form. No copyright in the individual components. Arrangement may have copyright in the form represented by compilation.

*Reported judicial decisions meet the test for originality. The author arranged the case summary, catch lines, case title, case information and judicial reasons in a specific manner. Arrangement requires skill and judgment so* ***compilation is met!***

### Collective work

* + 1. S.2 of the copyright defines collective work as;
       1. An encyclopedia, dictionary, year book or similar work,
       2. A newspaper, review, magazine or similar periodical, and
       3. Any work written in distinct parts by different authors, or in which works or parts of work of different authors are incorporated.
    2. *Policy question: Why grant copyright in compilation and collective work?*
       1. *Strong incentive for creating copyright because then producers can create economic value resulting in more work created opposed to no economic incentive which may result in no work being created all together. It also provides reward for skill and judgment and a broad societal benefit—labour or personality.*

#### Case Example- Robinson v Thompson Corp

* + - 1. FACTS:
         1. Robertson a freelance writer wrote 2 articles that were published in print edition and Globe and mail. Later the newspaper place copies of her article in 3 databases. Robinson objected to the presence of her articles in the database and sued the Globe and Mail for unauthorized reproduction of her work.
      2. ISSUE:
         1. Was the reproduction of Robinson’s articles part of the Globe’s copyright in the newspaper or did it infringe copyright in her work?
      3. RATIO:
         1. Court held that although a newspaper held the copyright in the collection and the arrangement of freelance articles and in its newspaper, it could not public the articles within a database.
         2. Publication within the database would remove the articles from the context of the collective work and would make it globe and mails publication, which they were not.
         3. The author held copyright in her articles, and the newspaper held copyright in the compilation or collection of works that contained them.

# C’right: rights of c’right owners [Consider s. 13 if created during Employment]

## Legislation

* 1. COPYRIGHT OWNER’S RIGHTS
     1. Focus of section 3 is on the economic right of the user. Moral rights don’t exist in Canada, which include retracting/modifying work. Section 3 does articulate the rights used by other parties to achieve an economic benefit that allows it to go to the copyright owner.
  2. S.3
     1. For the purposes of this Act, “copyright”, in relation to a work, means the sole right to produce or reproduce the work, to perform the work in public or, if the work is unpublished, to publish the work and includes the sole right
        1. Produce (3(1))
        2. Reproduce (3(1))
        3. Perform in public (3(1))
        4. Produce … any translation (3(1)(a))
        5. Convert dramatic work into non-dramatic work (3(1)(b)
        6. Convert non-dramatic work into dramatic work (3(1)(c))
        7. To make a sound recording, etc of a literary, etc work (3(1)(d))
        8. Reproduce, etc a literary, etc work as a cinematographic work (3(1)(e))
        9. Communicate a work to the public by telecommunication (3(1)(f))
        10. Present an artistic work at a public exhibition …. (3(1)(g))
        11. Rent out a computer program, etc (3(1)(h))
        12. Rent out a sound recording of a musical work … (3(1)(i))
        13. Sell or transfer ownership of tangible object … (3(1)(j)
        14. Authorize any of above acts (3(1))
  3. *Keep in mind: Work that is produced during course of employment = ER is owner of copyright*

## How long should rights last?

* 1. Canada
     1. Life + 50 is the terms of the copyright act
  2. *Staute of Annes*
     1. *Lasted 14 years renewable once for a total of 28 years.*
  3. *UK 1842 Act*
     1. *Balance between benefit during lifetime and their estate. Enough for descendants to live off it.*
  4. *BURN Convention*
     1. *Life of author + 50 years*
  5. *US Approach*
     1. *Life + 70*

## Canada Copyright ACT

### Ss 6-12 of Copyright Act

* + 1. S.6
       1. Life of author + 50 years from the end of the calendar year in which the author dies
    2. S.9
       1. Joint ownership 🡪50 years runs from the end of the calendar year in which the last of the author dies
    3. S.6.1 [Anonymous or pseudonymous works]
       1. 50 years from end of the year in which the work was published;
       2. 75 years from the end of the year in which it was made
          1. Whichever ends earlier
          2. *If identity becomes known of author then shifts to life + 50.*
    4. S.12 [Copyright owned by government]
       1. 50 years from end of the calendar year in which the work is first published

## Rights of the Copyright Owner- which can be infringed

### Reproduction

* + 1. Can have literal reproduction, which includes taking portion of text from work.
       1. *Ie. Taking publication from 2/3 chapters of a book*
    2. Non-Literal reproduction is taking aspect of the work but not copying it directly.
       1. *Ex. Japanese version of lion king*
    3. In order to succeed in a copyright of reproduction, the P has to show that the copyright work **is the source of the P’s** from which the infringed work is derived, doesn’t have to be direct source.

#### Case Example- Apple Computer Inc. v Mackintosh Computers

* + - 1. FACTS
         1. Apple had registered copyright in Autostart ROM and applesoft. The D including Mackintosh, made copies of the silicon chips by burning the physical binary patterns. Apple sued for copyright infringement. Mackintosh argued that the electronic programs were not eligible for copyright protection.
      2. ISSUE?
         1. Was their copyright protection in electronic
      3. RATIO:
         1. Judge found in favour of Apple.
         2. Stated that the copyright act **covered the work in any material form and covers the program as embodied in the ROM chip**. Stated that copy does not need to be in human readable form in order to be covered by copyright, only needs readability. Further the way s.3 is worded draws on new technologies that haven’t been thought of when act was amended.
         3. A copy of a copy is still a copy. Idea that copy of a reproduction where reproduction exists in a different material form is stills an infringement of the copyright of the original.
         4. All you have to have is the idea of readability, if you are claiming copyright in the work you have to have some way of visually comparing the 2 works between the 2 work that infringe or other documentary evidence.
         5. S.2 of literary work includes computer program.

#### Case example- Theberge v Galerie Art- REPRODUCTION

* + - 1. FACTS:
         1. A decides to transfer the ink from the poster backing onto the canvas backing to make it more esthetic. The work is very similar to the original work. Theberge sues for copyright infringement
      2. ISSUE?
         1. Was there reproduction?
      3. RATIO:
         1. Court said that in order to have **reproduction there needs to be an increase** in the number of copies. Regardless of how temporary it is, there needs to be a point where it goes from 1 copy to 2 copies. Re-fixing work on a different sub strain didn’t constitute reproduction.
         2. If you trace or photocopy a document for a certain period of time you have 2 copies.
      4. DISSENT:
         1. Stated that you don’t need to have additional copies to have reproduction to have copyright. The core of reproduction is fixation, and all you need to have is something re-fixed and anytime the work is refixed = reproduction.

#### Case Example- Bayliner Marine Corporation v Doral Boats LTD- Leading case in 3D/intermediary work

* + - 1. FACTS:
         1. P manufactured boats and claimed copyright infringement against the D for manufacture boats by stripping down the P’s boat, to make a 3D rending and then making a mold for its own boats. This saved the D from engineering designs of its boats and made them for way cheaper.
      2. ISSUE:
         1. Is there reproduction in a 3D object
      3. RATIO:
         1. Court stated that in order to succeed in a claim of copyright infringement, the P has to show that the copyright work is the source from which the infringing work is derived. It doesn’t have to be the direct source.
         2. Can copy intermediary work. Court said that when you look at the boat you could tell that they are from the drawings of the P, which is original work.
         3. Limitation to Copyright

S.64

Act doesn’t apply to designs capable of being registered under the Industrial Design Act except designs that though capable oF being registered, are not used or intended to be used as models or patterns to be multiplied by any industrial process.

S.64(2)

Where copyright exists for a design, which is derived. The article is reproduced in quantities of more than 50; it shall not be an infringement of copyright or moral rights. [*Protects manufacture of furniture, + mass production]*.

* + - * 1. Creation of a 3D work from a drawing = reproduction
      1. APPEAL
         1. Appeal was only granted due to s..46 of the industrial design act which states it doesn’t apply to designs.
    1. *Policy question: what are consequences of these sections for fashion and furnishing industries?*

### Right to perform a work in public

* + 1. What does public mean?
       1. Public= what a reasonable persons expectation of public would mean
       2. Private = where there is restriction to the place where only certain people can attend through invite, tickets, etc.
          1. *Performance in public = compensation for owner of copyright*
          2. *Performance in private = no compensation for copyright owner*
       3. A musical work = performed when it is caused to be heard, a visual work = performed when caused to be seen
       4. A radio or television broadcast does amount to a performance of work in public [Canadian Cable Television]

#### Case example: Canadian Admiral Corp v Rediffusion – Defnt of public

* + - 1. FACTS:
         1. A football game was broadcast live from the stadium by a set of 3 cameras directed by a producer outside the venue. Canadian Admiral had purchased the right to the live feed from the game. Rediffusion a cable company, captured the transmission of the broadcast and sold it to private homes and public show rooms.
      2. ISSUE?
         1. Was there copyright infringement for reproducing the work on behalf of Rediffusion?
         2. Did Canadian own the copyright in the work?
      3. RATIO:
         1. Court held that there was **no copyright in the rebroadcast of a live game**. Nothing suggests that performance in a private home to an immediate household is a performance in public.
         2. A radio or television broad cast does not amount to a performance of work in public.
         3. **Definition of public was**;

if the audience considered in relation to the owner of the copyright, can properly be described as the owner’s ‘public’ or part of their public, then anyone who performs the work before **that** audience without consent of the copyright author would be infringing the copyright authors copyright.

* + - * 1. Anyone who performs work before the audience without consent of the author will be infringing copyright

Public = body of persons who want to hear *lecture/concert* who have no paid.

Openly, without concealment, and to the knowledge of all

Not public = performance given by children, performance for members of country house party.

* + - * 1. Court held that a performance in a private home to an immediate household is a performance in private = television watching at home is private
        2. However, performance of the television broadcast on the showroom where anyone can walk in without restriction = public

### Right to communicate work to the public by telecommunication [s.3(1)(f)]- TV/Radio/Online/Fax

* + 1. Legislation
       1. S.2.3
          1. A person who communicates a work or other subject matter to the public by telecommunication **does not by the act alone perform it in public,** nor by that act alone is deemed to **authorize its performance in public.**
       2. S. 2.4(1.1)
          1. For the purposes of this Act, communication of a work or other subject matter to the public by telecommunication includes **making it available to the public by telecommunication [internet] in a way that allows a member of the public to have access to it from a place and at a time individually chosen by that member of the public.**
       3. S.3(1)(f)
          1. Right to communicate a work to the public by telecommunication gives right to

TV/radio/online/Fax Machine

* + 1. Overview
       1. If you make work available online without authorization of copyright owner and do so in a way that allows people to access it = **infringing a right set out in s.3(1)(f).**

#### Case Example CCH Canadian v LSUC-FAX

* + - 1. FACTS:
         1. Operated a reproduction service where they would photocopy requested passages from legal materials and send these reproductions to requesters. CCH accused the law society of violating their copyright by reproducing protected material
      2. ISSUE:
         1. Was a fax transmission to a single individual a communication to the public infringing copyright?
      3. RATIO
         1. Court found that **a fax transmission** of a single copy of work to a single individual **is not a communication to the public**. Faxing 1 copy to 1 person is not a communication to the public because it goes from one point and received at a single point that it was intended.
         2. However, a series of repeated work to different receipts could constitute communication to the public.

#### Case Example: SOCAN v CAIP\* [need this case]- INTERNET

* + - 1. FACTS:
         1. SOCAN applied to the copyright board to receive royalties for copyrighted materials transferred over the Internet. CAIP claimed that they served only as intermediaries and could not be held liable.
      2. ISSUE:
         1. Was there communication via telecommunication?
      3. RATIO
         1. Court found that there needs to be a real and substantial connection between Canada and the transmission source. **Act applies to communications received in or originating from Canada.**
         2. Court said communication to public through telecommunication occurs online when the content is transmitted from host server to the end user. Push technology includes cable television, radio broad cast, pushed to the user

Pull = accessible through a link

* + - * 1. Telecommunication occurs when content become available and accessed
        2. Court stated that the **party that uploads the wok** is infringing the right and downloading infringes the right to reproduce.

#### Case Example: CWTA v SOCAN- RINGTONES

* + - 1. FACTS:
         1. Downloading a ringtone from a mobile communication is a communication to the public via telecommunication infringing copyright.
      2. ISSUE:
         1. Does it amount to a communication to the public via telecommunication
      3. RATIO
         1. **Court stated that the download of ringtones is a communication** because it is a passing of information from one person to another. Due to the ability to access the ringtone from multiple users at different times. Musical ring tones are information in form of digital audio file and capable of being communicated.
         2. Ringtones are made available to individuals for download and can happen multiple times, by a wide range of individuals at any time= **right to communicate in public**. Also when the phone rings and ringtone plays in public = **performance in public**.
         3. Court found that it was a communication to the public

Ex. 15 people want one ringtone, and push it out to all 15 people at one time = performance in public.

#### Case Example ESA v SOCAN- VIDEOGAMES

* + - 1. FACTS:
         1. ESA a video game publisher enables customers to download copies of video games over the internet. SOCAN applied to the copyright board for a tariff covering downloads of musical work over the internet.
      2. ISSUE?
         1. Is the download of a video game containing a musical work communication to the public via telecommunication?
      3. RATIO?
         1. Court found that the download of a permanent copy of a video game **containing musical work using the Internet did not** amount to a communication.
         2. Court held that there needed to be a balance between the creator and the public interest. Court said they are entitled to one royalty. Lastly requires technological neutrality that the copyright act apply equally between traditional and more technological advanced forms of the same media.
         3. Reasoning by majority; principles of technological neutrality, need for consistency with purpose of copyright, preserve traditional balance in digital environment. Alternative proposals were inefficient, legislative history and debates, case law, historic distinction between right or perf, and reproduction.

#### Case Example: Rogers Communication v SOCAN- STREAMING from INTERNET

* + - 1. FACTS:
         1. Rogers provides online music services that allow on demand downloads and streams of files holding musical work. The Copyright board held that the streaming of copyrighted music falls within the copyright owners right to communicate to the public.
      2. ISSUE?
         1. On demand download over the internet constitute a communication to the public via telecommunication?
      3. RATIO?
         1. Court held that on demand transmissions of music streams made available by online music services constitute communication to the public.
         2. Court found that point-to-point communication is to the pubic. IF the content is intentionally made **available to anyone who wants to access it**, it is treated as communicated to the public even if the users access the work at different times and places.
         3. However, when point to point from website or online is to INDIVIDUAL customer = private.

# C’right: users’ rights DEFENCES

## Legislation

* 1. S.27(1)
     1. It is an infringement of copyright for any person to do, without the consent of the owner of the copyright, anything that by this Act only the owner of the copyright has the right to do.

#### Steps in a Copyright Lawsuit

* + 1. 1: Unauthorized act occurs. Has there been an infringement?
       1. S.27(1)
    2. 2: Burden shifts to D to establish a defense to copyright infringement

## Defences- User Rights

* 1. **STEPS**
     1. Always make argument for fair dealing defense first.

### Defense of Public Interest

#### Case Example: R v Lorimer & Co. LTD

* + - 1. FACTS:
         1. L wanted to publish a condensed version of a government report.. L told government that he would provide royalties of 8%. Crown later sued for copyright infringement
      2. ISSUE?
         1. Can L establish a defence of public interest?
      3. RATIO:
         1. L argued that it was in the public interest that this information be disseminated as broadly as possible. However, court rejected that idea and found L could not establish defense. The information was not being suppressed and needed to get out.
  1. Defence of fair dealing-  **[ALWAYS MAKE FD DEFENCE FIRST]**

***\*did you treat it in best possible light?***

* + 1. What is fair dealing?
       1. Under fail dealing, individuals have the right to use substantial part of another’s copyright protected expression without that person’s permission, providing that the individual act
          1. In furtherance of certain purposes,
          2. That the individual acts in a fair manner and that—
          3. in some cases—certain attribution requirements are satisfied.
       2. Categories of fair dealing
          1. Research, private study, education, parody, satire, news reporting, criticism, review.
       3. Judicial Interpretation
          1. Since there is no definition of fair in the copyright act, fair is determined through judicial interpretation.
    2. Legislation
       1. S.29
          1. Fair dealing for the purpose of research, private study, education, parody, or satire does not infringe copyright
       2. **S.29.1[ extra factors to consider]**
          1. Fair dealing for the **purpose of criticism or review** does not infringe copyright if the following are mentioned

The source; and

If given in the source, the name of the

Author, in the case of a work.

* + - 1. **S.29.2[extra factors to consider]**
         1. Fair dealing for the purpose of **news reporting** does not infringe copyright if the following are mentioned

The source; and

If given in the source, the name of

The author, in the case of a work.

#### Case Example: Michelin v CAW Canada- LOGO on BROCHURE-s. 29.1/ CRITCISM

* + - 1. FACTS:
         1. In a union drive the CAW produced leaflets, posters with unauthorized reproduction of the Michelin name and logo.
      2. ISSUE?
         1. Can CAW use a fair dealing defence under parody?
      3. RATIO:
         1. Court stated that the dealing was not fair and wasn’t treated in a fair manner and even if it CAW argued parody it requires that the **authors name and source** **be cited in order to qualify.** Further CAW didn’t treat in a good faith manner or portray work as the original author intended but held it up to ridicule.
         2. Court stated **that criticism requires** analysis and judgment that sheds light on the original whereas **parody** is a musical literary or other composition that mimics styles of other composers in a humorous or satirical way.

#### Case Example: Productiosn Avanti Cine inc c Favreau- PARODY

* + - 1. Tried to argue that a reproduction of a porno was a parody. However, court held that the D tried to take advantage of a commercial opportunity and that it did not constitute a defence of fair dealing under parody.

#### Case Example: CCH Canadian et al v LSCU- Reproduction

* + - 1. FACTS:
         1. operated a reproduction service where they would photocopy requested passages from legal materials. CCH accused the law society of violating their copyright by reproducing protected material.
      2. ISSUE:
         1. Was this reproduction through a telecommunication leading to copyright?
      3. RATIO:
         1. **Fair dealing** is an integral part of the copyright act and must be interpreted restrictively. Court said that law society could rely on general practice of fair dealing. Court held that categories need to be given a **LARGE AND LIBERAL INTERPRETATION**
         2. Court held that law society can rely on fair dealing.
         3. **Steps for a fair dealing analysis**

D has to prove that it was for one of the list purposes

That the dealing was fair.

* + - * 1. **TEST**

**Purpose of the dealing**

8 categories; Research, private study, education, parody, satire, news reporting, criticism, review

*purpose was for research and review and private study. It was part of the research process and necessary condition of the research.—*

Was the dealing fair[ CCH factors]

**Purpose of dealing**

**Character of the dealing**

Were multiple copies distributed?

How is work dealt with?

What is the custom or practice in the industry?

*dealing was found to be fair because there was reasonable safeguard to ensure that material being used was for research and private study*

**Amount of the dealing**

How much of the work was copied

*Photographs = can get away with copying the whole work because you don’t want to lose impact*

Are you taking a significant amount and incorporating into new work?

*Single copies were being provided and no evidence of multiple copies to multiple parties—amount copied was limited.*

**Alternatives to the dealing**

Was it reasonably necessary to achieve the ultimate purpose?

Any other way to achieve a similar result other than using the work?

Would the criticisms have been equally effective if you didn’t reproduce the work?

*Alternative would result in people going to the courthouse to look at the documents at the great library—however court found that there was no alternatives to the dealing and patrons cant be reasonably expected to research on site. Also if people were allowed to take out material it would restrict access and also viability of license.*

**Nature of the work**

Was work unpublished? [might be more fair] compared to confidential [unfair]?

*In public interest that access to judicial decision an dother decisions are justifiably restrained. This type of work needs to be available.*

**Effect of the dealing on the work?**

Is reproduced work likely to compete with market of work?

Do sales of the completed book decline?

*Found that there was no evidence offered that the market for publishers would decrease as a result of copies made under custom photocopying services.*

#### Case example: SOCAN v Bell- LEADING CASE

* + - 1. FACTS:
         1. Bell operates online music services that sell download of digital files of musical work. The service provider allows consumers to listen to 30-90 second previews for musical work before making a purchase.
      2. ISSUE?
         1. Can BELL Canada use the defense of fair dealing?
      3. RATIO:
         1. Court began with the **Theberge** analysis stating that there is a move away from an author centric approach that was focused on exclusive rights towards a need to balance protection and to promote public interest. Shift towards user rights. Fairness analysis determines if work is done correctly or not to protect author but balance interest is to look at Copyright Act
         2. Fairness analysis

If consumers are given the ability to sample music before buy it fits under research to purchase.

Purpose of dealing

A commercial purpose to make money through sales. Goal is to help research and identify musical work through reasonable safeguards to ensure that the dealing is restricted to research purposes.

Character of the dealing

There was shorter clips and lower quality = technological safeguard to prevent streaming

Amount of dealing

Assessed on indidivdual use and the amount htat was preview compared to the whole song was a small preview.

Alternatives to the dealing

There are no real alternatives to inform consumers of what work actually sounds like. The court finds them expensive and market inhibiting and technologically prohibited.

Nature of work

Court thinks that the purpose of category is a public interest defence and states that work should be available and preview will assist in work being widely disseminated.

Effect of dealing

Could result in an increase purchasing music, the previews don’t compete because they allow people to know what the work sounds like.

#### Case Example: Alberta v Canadian Copyright Licensing Agency

* + - 1. FACTS:
         1. Teachers in elementary and secondary schools across Canada frequently made photocopies of excerpts from textbooks and other published work from Access’s copyright collection.
      2. ISSUE?
         1. Did teachers photocopies amount to fair dealing?
      3. RATIO:
         1. Court found that although the teachers were making copies for research or private study the **use of the fair dealing defense was not available**
         2. Fair dealing analysis

Purpose?

Private study

Factors to consider

Purpose of the dealing

Court stated that copying work hides behind the shield of the users allowable purpose that engages in a separate purpose, which makes deal unfair. Commercial copiers that create course back for students are one situation where court points to where it wouldn’t protect users allowable purpose.

Amount of dealing

Focus on proportion of the exported copy and it was the entire work.

Alternatives to the dealing

Buy text for students was unrealistic, and suggests realistic and unrealistic alternatives

Effect of the dealing

Evidence was brought that there was a decline in sale, but it was that linkage the court required that led to the fact to be neutral.

**Seems that the requirement by P is that a negative economic impact was the result of the dealing.**

P is to present evidence that there is decline linked to that specific use. *Absence of that will result in an easier defence of fairdealing for D.*

## DEFENCES- LAM/EI –s.2.4(1)(b)—Private Copying

## User rights for Certain Institutions—LAM/EI

* + 1. Steps:
       1. Fair Dealing defense
       2. Exceptions
       3. LAM/EI
          1. S.49

### Legislation

* + 1. **S.30.7- Incidental Inclusion**
       1. Not an infringement of copyright to incidentally and not deliberately
          1. Include a work in another work or other subject-matter; or
          2. Do any act in relation to a work that is **incidentally and not deliberately** included in another work or other subject matter.
    2. **S.32(1)(2)(3)- Other exception with specific group of individual**
       1. Not an infringement of copyright for a person with a **perceptual disability**, for a person acting at the request of such a person or for non-profit organizations acting for the benefit of such a person to
          1. Make a copy or sound recording of a literary, musical, artistic or dramatic work, other than a cinematographic work, in a format specifically designed for person with disability
          2. Translate, adapt or reproduce in sign language
          3. Perform in a public
       2. 32(2)
          1. does not authorize making of a large print book
       3. 32(3)
          1. Does not apply where the work or sound recording is commercially available in a format designed to meet the need of a disabled person
    3. **S. 32.1 Statutory Obligations**
       1. Not an infringement of copyfor any person
          1. To disclose to Access to Information Act a recording
          2. Privacy Act
          3. Cultural Property Export and Import
          4. Broadcasting Act
       2. Only the owner of the copyright in the record, person information or like information as the case may be, has a right to do
       3. Unless the Broadcasting Act otherwise provides, a person who makes a fixation or copy under 1(d) shall destroy it immediately on the expiration of the period for which it must be kept.
    4. **Specific Institutions**
       1. LAM/EI
          1. [49] [A] library can always attempt to prove that its dealings with a copyrighted work **are fair under section 29 of the *Copyright Act****.* It is only if a library were unable to make out the fair dealing exception under section 29 that it would need to turn to the *Copyright Act* to prove that it qualified for the library exception. *(CCH Canadian et al)*

*Consider s. 2 “lam + EI”*

### Exceptions to Libraries, archives, and museams [LAM]

* + 1. **Only non-profits are covered**. If a library or museum is affiliated with a profit making institution it is not covered
       1. Law libraries don’t fall within this
       2. Students and patrons can take part of LAM because they are not legally a part but connected through tuition.
    2. EXCEPTIONS
       1. 30.1-30.21
          1. s.30.1

not an infringement of LAM or a person acting under the authority of a LAM to make for the maintenance or management of its permanent collection or the permanent collection of another LAM, a copy of a work or other subject matter, whether published or unpolished in its permanent collection

* + - * 1. 30.4
        2. 30.5

### Exceptions to Educational Institutions [EI]

* + - 1. EXCEPTIONS
         1. S.29.4- 30.04
         2. 30.4
         3. 30.5

### Exception to both LAM + EI

* + 1. 30.4- work available through internet.
    2. (3) doesn’t apply to access control technological matters
    3. (4) doesn’t allow anyone to do any act in that subsection if that work restricts the doing of the act
    4. 4(b): cant do it if there is a visible notice posted on the site or other subject matter to prevent use in a EI.

##### Policy Discussion

* + 1. Is it necessary to have specific exceptions for EIs/LAM
       1. Provides certainty when educational institutions are doing specific activities to avoid litigation. One of the main criticisms of fair dealing is that you don’t know if Fair Dealing applies until you are in court.
    2. Why Fair dealing first then look at exceptions?
       1. CCH: SCC thought that this was an opportunity to talk about fair dealing and articulate what fair dealing is and how it applies. CCH felt that fair dealing was a users right.

### Common Carrier Exceptions – Internet Usage [s.2.4(1)(b)]

* + 1. Defence application
       1. Applies in the context of communication to the **public by telecommunication [internet]**
          1. *Created this defence as a public policy decision to encouraging makers of telecommunication to expand and without threat of infringement, to permit infringement could chill that expansion and development.*
       2. Defence does not apply to a person **whose only act of communication is to provide the necessary communication** does not = public

#### Case Example SOCAN v CAIP-

* + - 1. FACTS:
         1. SOCAN applied to the copyright board to receive royalties for copyrighted materials transferred over the Internet. CAIP claimed that they seved only as intermediaries and could not be held liable.
      2. ISSUE:
         1. Was there communication via telecommunication?
      3. RATIO:
         1. Court found innocent dissemination to **newsstand, bookstands**, like the Internet doesn’t have liability.

**Intermediaries are deemed not to communicate the work to the public at all**

* + - * 1. An important element of copyright’s balance is needed

*Theberge judgment—need a balance between public policy and user.*

* + - * 1. Necessary

**If means are reasonably useful and proper to achieve benefits of enhanced economy and efficiency.**

Ie. Routers; software connection equipment; connectivity services; hosting and other facilities; services **without which communications would not occur;** caching when undertaken for technical reasons.

When done for technical reasons shouldn’t attract liability.

* + - * 1. Key: content neutrality

As long as intermediary only provide a connection to the information and doesn’t engage in relating to the content then it falls within the exception.

Providing technical services = protection for specific exception.

* + - * 1. Liability attaches when intermediary ceases to be content neutral.

Creating embedded links that trigger telecommunication.

* + 1. Public Policy Question:
       1. What is relationship between s.2.4(1) and s.31.1 of Copyright Act?
          1. *S.****31.1****(1) A person who, in providing services related to the operation of the Internet or another digital network, provides any means for the telecommunication or the reproduction of a work or other subject-matter through the Internet or that other network does not, solely by reason of providing those means, infringe copyright in that work or other subject-matter.*
          2. Plays a complimentary role to section 2.4 that the provision only applies to **communicate work to public.** The right of s. 31.1 applies more broadly and is a reflection in order to ensure communication on internet proceeds. S.4 isn’t necessary sufficient and needs to be adapted to the evolving technological environment.

## PRIVATE copying regime—making private copies CD’s MUSIC

### Overview

* + 1. 3 set of provision that would allow the making or private copy non-infringing
       1. Fair dealing
       2. S.29.4- backup copy of certain work
       3. Ss.79-88

### Legislation

* + 1. S.79-80
       1. S.79
          1. Defines audio recording medium- kind ordinarily used by individual consumers for purpose of reproducing music.
          2. **Ordinarily used:**

**DVD** aren’t ordinarily used for copying music = infringement of copyright

**Usage by individual consumers that must be ordinary, not use of product generally**

Has it become ordinary practice for consumers to copy music onto X

* + - 1. S.80
         1. Allows for use under certain conditions, permits all of the substantial part of musical work onto an audio recording medium specifically for **private use for the person** who is making the copy—subject to various limitations.
         2. If you sell or rent out this work it doesn’t encompass it through the provision
         3. If you distribute or communication through telecommunication or perform in public = isn’t set to under the exception
    1. Objectives:
       1. Legalize private copying of sound recordings embodying musical works onto audio recording media
       2. To provide fair and equitable compensation for rights holders for those copies through a levy on blank audio recording media
    2. What does oridnairly use mean?
       1. Dynamic provisoin; applies to technologies as they become ordinarily used for the purpose of copying music

### Audio Recording Medium

* + 1. Certified: audio-cassetts greater than 40 mins, CD-R; CD-RW; Audio CD-R, Audio CD-RW, Mini Discs
    2. MP3 Players, cell phones, and computers audio recording

#### Case Example- Canadian Private Copying Collective v Canadian Storage Media Alliance

* + 1. FACTS:
       1. Wanted to impose a levy on blank audio recording media including ipods and MP3 players.
    2. ISSUE?
       1. Could they impose tariff?
    3. RATIO:
       1. Court sated that a permanently embedded or non-removable memory, incorporated into a digital audio recorder does not retain its identity as an audio recording medium. Board could not establish levy.

#### Case example- Apple Canada inc v Canadian Private Copying Collective

* + 1. Court stated that the copyright board has no legal authority to certify a tariff on digital audio recorders or on the memory permanently embedded in digital audio recorders.

# C’right: enforcement of rights, remedies

## Enforcement of copyright infringement

### Courts

* + 1. Federal Court Act s/20
       1. Federal courts Act to resolve a conflicting application for registration
       2. Concurrent for **remedies sought for copyright**
          1. Has more of an impact if brought to federal court
          2. Specialized judges hear the case
          3. More cases funneled towards federal court = more judges developing specific expertise.
    2. Provincial Court
       1. Looking for disputes on common law principles or criminal remedies = provincial court
    3. Primary Enforcement S.27 of Copyright Act
       1. It is an infringement of copyright for any person to do without the consent of the owner of the copyright, anything that by this act only the owner of the copyright has the right t odo.

#### Case Example- Boudreau v Lin – S.13 OWNERSHIP RIGHTS

* + - 1. FACTS:
         1. Student in a class handed in a paper that was distributed by the professor in a course back without recognition of the student. Instead it recognized the professor and college from a different university
      2. ISSUE?
         1. Who is the ownership of Copyright
      3. RATIO:
         1. S. 13(1)/13(3)

13(1)

the author of a work shall be the first owner of the copyright therein

13(3)

where the author of a work was in the employment under a contract of service or apprenticeship and the work was made in the course of his employment the person by whom the authoe was employed shall, in the absence of any agreement to the contrary be the first owner of the copyright, but where the work is an article or other contribution to a newspaper, magazine or similar periodical, there shall, in the absence of any agreement, be deemed to be reserved to the author a right to restrain the publication of the work, otherwise than as part of a newspaper, magazine or similar periodical

13(4)

Can assign your copyright but it must be in writing and signed.

Can be done wholly partially.

S.13(7)

Can grant license to do something that would constitute copyright infringement, and can grant non-exclusive where multiple parties are given permission in respect to work which you own copyright or exclusive rights to.

Granting interest via copyright.

* + - * 1. Court said that there was infringement on part of professor and university

#### Case Example- Hager v ECW Press LTD

* + - 1. FACTS:
         1. Action claiming damages for copyright infringement in which 16 major passages from a chapter of her work were incorporated by the D in their work titled Shania Twain.
      2. ISSUE?
         1. Right of reproduction was engaged, Did she reproduce the work and infringe copyright?
      3. RATIO:
         1. In order for there to be reproduction by reproducing the whole work or by taking substantial part of work
         2. What constitutes substantial taking

Quantitative/qualitative perspective

Court said we need to look at how much work and importance of the amount of work taken as a whole

* + - * 1. Factors in the case

Quality/quantity of material taken

Court said it was a short chapter and that it was taking so much and had directly copied the quotes and rearranged the words

Extent to which D’s use adversely affects P’s activities, diminishing value of copyright

No doubt that authorizing the copying of a large portion of an individuals work would decrease authors incentive to create.

Court found adverse impact on Hager

Material taken the proper subject of copyright

Intentional appropriation to save time/effort

Found hagger work was copied for purpose of saving expense and labor and taking was intentional

Material taken used in same/similar manner as P’s use

* + - * 1. Court found copyright infringement.

#### Cinar Corporation v Robinson

* + - 1. FACTS:
         1. Pitched an idea about television show, and later was let go and the show was picked up by Cinar Corp similar to the idea that Robinson pitched which was rejected.
      2. ISSUE?
         1. Who is owner of idea and was there substantial taking?
      3. RATIO:
         1. Court stated that substantial taking applies to all rights not just reproduction, by reproducing, preforming in public, communicating to public.
         2. **Substantial taking requirement**

Matter of fact and degree; flexibile notion; not limited to words on page or brushstrokes on the canvas; determined in relation to originality of the work that warrants protection; balance between protecting authors and leaving ideas;elements free for all to draw upon forms thebackground

Focus on quality and quantitity that is copyrightable

Ides that aren’t protected

Substantial part of work = work that represents substantial portions of authors skill and judgment.

* + - * 1. Court said have to look at purpose of copyright and the balance of the rights of the author and just reward to ensure ideas and certain elements can be drawn upon.

### Contracts

* + 1. In some cases, what you agree to under a contract [i.e. licensing agreement] is more strict than what you are restricted from doing under copyright act
       1. Contract is one way to guard against infringement of copyright and becoming popular because of prevalence of digital delivery. Digital delivery comes with licensing agreement, which comes with contracts.
       2. Copyright act set out what you can do—licensing agreement might set out a different list, so can see an overlap but necessarily consistent.
    2. Can bargain away user rights

### TPMs –Any effective technology, device or component

* + 1. Another mechanism used by copyright owners to protect against copyright infringement
       1. S.41
          1. Restricts any act or access of work through an access control
       2. Circumvent means
          1. In respect of a technological protection measure within the meaning of paragraph 1 of the definition “technological protection measure, to descramble a scramble work or decrypt an encrypted work or to otherwise avoid, bypass, remove, deactive or impair the technological protection mesure, unless it is done with the authority of the copyright owner
    2. CANT ARGUE FAIR DEALING
       1. Remedies limited when access control circumvented for private purpose
       2. Can recover statutory damages from person
       3. Law enforcement, encryption research, etc
    3. 2 types:
       1. access control measures, which restrict access to work, and
       2. copy control measuers, which restrict what can be done with work
    4. EXAMPLES of Access Control
       1. Passwords
       2. Pay walls or subscriptions,
       3. Registration keys
       4. Time limits -48 hour movie rentals
       5. Limits on number of simultaneous users
       6. Encryption/scambling [regional encoding on DVDs, IP blocking based on location] and
       7. Selective incompatibility [eg. CD that will read in a CD player but not a computer CD drive]
    5. EXAMPLES of COPY control
       1. Read only work
       2. Download blocking [streaming content]
       3. Copy blocking [digital music and movies]
       4. Print blocking
       5. Labeling
       6. watermarking

### Other technological measures

* + 1. Youtube Content ID System
       1. Uploading video to youtube—content ID gives choices of how stuff is showed on youtube.
       2. Can identify audio, video, each time it finds a match—notifies the copyright owner who can state how they want others to do with that video—to block it, or make money off of it.

### Notification letters

* + 1. Notice and notice systems; ss.41.25-41.27
       1. Copyright owner sends infringement notice to internet provide and require to forward to subscriber which includes
          1. Detail about sender
          2. About copyright work
          3. And alleged infringement.
       2. If internet provide doesn’t forward have to explain why and can face damages of 10,000 and copyright owner can retain 6-12 months of subscriber information
          1. System doesn’t disclose personal information to copyright owner.

## Legislation- Primary remedy provision

* 1. S.34(1) where copyright has been infringed, the owner of the copyright is entitled to all remedies by way of injunction, damages, accounts, delivery up and otherwise that are or may be conferred by law for the infringement of a right.
  2. S.35(1)
     1. Where a person has infringed copyright are liable to pay damages suffered due to infringement and also any profit from infringement that weren’t calculated by damages suffered.
     2. Copyright owner have a choice of getting statutory damages instead of damages and profit.

### Statutory Damages

* + 1. s.38.1
       1. note distinction between stat damages for infringements for commercial purposes and statutory damages for infringement for non commercial purposes
          1. commercial: 500-20,000 per work infringed
          2. non commercial: 100-5000 for all works infringed.
       2. All work infringed until time of lawsuit.
       3. If copyright owner has made election for non-commercial purpose than every other copyright owner is bared from receiving statutory under that section.

### Punitive Damages

* + 1. Can give punitive damages if there is unlawful interference.
       1. S. 49 of the Quebec Charter – “punitive damages may be awarded if there is an unlawful and intentional interference with any of the rights and freedoms that the Charter recognizes”.
          1. Here: rights to property, inviolability, dignity

### Limitation period

* + 1. 43(1)
       1. 3 years from time the act occurred or
       2. 3 years from after the time when the P knew or could have reasonably been expected to know of the act.

# T’marks: passing off

## Passing off

* 1. Definition
     1. No one may pass of their goods as those of another
     2. Protection for passing off is available as long as mark has acquired sufficient **goodwill or reputation** for it to be distinctive of a particular trade source
     3. Registration is not essential—however advantages for registration
  2. When can Passing off occur
     1. 2 contexts:
        1. Company A represents products a product as being those of company B to take advantage of company B’s **goodwill and reputation**
        2. Goods from company A are supplied to a party who has ordered from Company B. Purchasing party believed that they received goods from Company B
  3. How to establish Passing off?
     1. Need to establish that people looking at the product/appearance of product regard it as coming from the same trade/company source.
        1. Primary and Secondary meaning
           1. Primary Meaning= camel hair was descriptive of the product
           2. Secondary = a product made by reddaway

## Elements for Passing Off

* 1. Existence of **goodwill**
     1. Nature of goodwill
     2. Shared goodwill
     3. Foreign goodwill
     4. Descriptive name
     5. Product appearance
     6. And how to lose goodwill
  2. Deception of the public due to a **misrepresentation** which lead to confusion
  3. Actual or potential damage to the P
  4. *5 requirements to consider of passing off*
     1. *Must be a misrepresentation*
     2. *By a trader in the course of trade*
     3. *To prospective customers of his or ultimate consumers of goods or service supplied by him*
     4. *Which is calculated to injure the business or goodwill of another trader and;*
     5. *Which cause actual damage to the business or goodwill of the trader bringing the action.*

## TradeMark Act S.7(b) and (c)

* 1. TM Act s.7(b) and (c)
  2. No person shall
     1. B) direct public attention to his wares, services or business in such a way to cause confusion in Canada at the time he commenced to direct attention to them, between his wares, services or business, and the wares, services or business of another
     2. C) Pass off other wares or services as and for those ordered or requested.

# #1: Goodwill/ Reputation

## Goodwill

* 1. Goodwill is the benefit and advantage of the **good name, reputation and connection of a business.**
     1. *Consumer protection aspect*
     2. *Seen as commercial competitor*
     3. *Includes first person, all intermediary purchasers and everyone else.*
  2. Where the TM or get-up is associated in the mind of the purchasing public with the P’s goods as one trade source. = goodwill
     + 1. *E.g. B’s product that is being purchased is thought to be A’s*
     1. *Get up= external appearance of the good*
        1. *The way the package looks*
        2. *The way the good looks itself*

## Test for Goodwill

* 1. P needs to establish that it has goodwill or reputation associated with a particular mark
     1. ***Mark*** *may be a word or combination of words, a design, the getup of a product [the whole visible look of a product] or some other distinguishing feature.*
  2. To establish goodwill
     1. P must introduce evidence to demonstrate the strength of the association between its **mark** and its company as trade source.
     2. The length of time the goods or service have been in the market
     3. The degree of **distinctiveness** of the mark
     4. And the volume of publicity and sales are among the many different factors that may be considered in demonstrating the strength of association.
  3. *NB: Protection against passing off is available only where there is goodwill or reputation*
     1. *Can only have goodwill with the mark in question*
     2. *Cant have protection in another country.*
     3. *Depends on where you have acquired reputation*
     4. *Confusion is the essence of passing off, hard to argue confusion if consumer doesn’t know of its existence.*
     5. *If you can establish reputation…better chance for passing off in specific area.*

#### Case Example: Institut National [Generic and shared goodwill]

* + 1. FACTS:
       1. Champagne was produced in Canada and labeled Champagne. They argued that Champagne was a prestige name from French and had to develop goodwill and reputation in order to use the label.
    2. ISSUE:
       1. Was there an action of passing off?
    3. RATIO:
       1. Court stated that a P is entitled to bring an action in passing off when the alleged misrepresentation relates, not to the goods or services of a particular trader, but to a kind or **quality of goods** produced by a group of traders
       2. Court stated that a geographic location plays an important role because the goodwill has been built up between geographic indication which can have shared will in Canada.
       3. Goodwill can exist outside the area where it carries on business.
       4. Shared good will is accepted in Canada,

### Foreign Goodwill

* 1. Protection against passing off is available only where there is goodwill or reputation.
  2. A P’s goodwill can exist outside the area where it carries on business, as long as it has built reputation.
  3. Confusion or misrepresentation is the essence of the tort; where the **P’s product or service is unknown in a particular region, it will be difficult for the P to argue that customers were misled into thinking they were purchasing its products** when they were purchasing those of the D.
     1. *Can have goodwill in a country you don’t do business through online and travel.*
     2. *Question is of confusion*

#### Orkin Case Example

* + 1. FACTS:
       1. Company that doesn’t do business in Canada but making a claim of passing off for a Canadian company that has used its ideas.
    2. ISSUE?
       1. Is there a tort of passing off?
    3. RATIO:
       1. Court stated that a company whose good and services were well known in US and not in **Canada will not be protected from passing off due to confusion and misrepresentation.**
       2. It is difficult to establish confusion when people don’t know the company existed
       3. If you don’t do business in Canada you can still have good will in Canada through travel and online. Court found that ORKIN did have reputation in Canada.
  1. Online is an example of how you have goodwill one country without have physical presence in country.

### Secondary/descriptive Meaning

* 1. A product that is particularly distinctive in its appearance may come to be associated by consumers with a particular trade, When this happens a competitor who copies the product appearance may be liable for passing off.
  2. A descriptive product name may acquire, through trade, a secondary signification different from its primary one.
  3. CANNOT rely on TM if the product appearance is an inherent feature of the product.
     1. *Do people when looking at the product associate it with a particular brand?*

#### Case Example: Reddaway v Banham

* + 1. FACTS:
       1. Reddaway made machine belting, which he sold under the name CAMEL HAIR BELTING for many years. Banham a former employee of reddaway left to start his own business manufacturing machine belting also called Camel Hair belting. Reddaway sued for passing off on the basis of confusion
    2. ISSUE?
       1. Was there passing off by B regarding the descriptive name?
    3. RATIO:
       1. Court stated that the word acquired secondary meaning and that the public associated Camel Hair belting as a product that existed by Reddaway
          1. Primary Meaning= camel hair was descriptive of the product
          2. Secondary = a product made by reddaway

### Goodwill & Product appearance

* 1. A product that is particularly distinctive in appearance may come to be associated by consumers with a particular trade source.
     1. *If product appearance is an inherent feature of the product [that feature has to be there for that product]—cant rely on TM*
  2. If someone copies appearance than there is a tort of passing off, but you have to show that the appearance has acquired a secondary meaning.
  3. The most distinctive your product the easier it is to establish secondary meaning or reputation.

#### Case Example: Ray Plastics

* + 1. FACTS:
       1. Raywares manufactured and sold a new combination of snowbrush, ice scraper and squeegee called the Snow Tropper. It was black and yellow in appearance and was extremely successful. The D produced a similar product and took over the contract from Raywares from Canadian Tire.
    2. ISSUE?
       1. Was there passing off regarding the snow brush?
    3. RATIO
       1. Court stated that in order for there to be a **secondary meaning the product needs to establish that people looking at the appearance of the product associated it with a particular trade source or coming from the same trade.**
       2. Court stated that if the product is **novel, striking or unusual** it is easier to conclude that there is association with a single trade source.
       3. Goodwill and secondary meaning were found to exist in this case.
          1. If you don’t have secondary meaning or reputation or goodwill = no reputation.
       4. Evidence of intention, direct copying, court found that it establishes prima facie case of secondary meaning, and if someone copies something else it is for a reason and likely due to the goodwill that exist.

## Losing good will

* 1. When someone stops carrying on a business, they keep, for a period of time, the **goodwill attached to that business.**
  2. As long as the goodwill remains, the person should be able to enforce his rights in respect to any name attached to that goodwill.

#### Ad-Lib Club Limited

* + 1. FACTS:
       1. Ad Lib was a club in London that closed down 5 years ago. After a few years the D opened up the club and called it the grand re-opening of the famous club. P asked for an injunction stating that people are going to associate D’s club with P’s.
    2. ISSUE?
       1. DID P lose his goodwill and reputation in the club?
    3. RATIO
       1. Court stated that the club had goodwill because the D chose the name based on the reputation established by P.
       2. There was no other evidence to show why D chose the name. Court stated that members of the public would see this club as a continuation in part of the phrase used that it was a reopening and that there was still goodwill attached to the name because of the name selection.

### Generic Product Names

* 1. Can prevent product names from becoming generic by modifying your own name and brand, ad campaigning, lobbing for laws to prevent names from being generic.
  2. **To show generic term**
     1. Show evidence of survey
     2. How other people use the word
     3. Is it only associated with a specific product?

#### Case Example: Institute National- Champagne Case- Showed it wasn’t generic

* + 1. FACTS:
       1. Case involving Canadian champagne company that used the word “champagne” to market product. People apart of the France Champagne stated that the word had goodwill and reputation and not anyone could use it.
    2. ISSUE?
       1. Has champagne become a generic product or does it still attract goodwill and reputation?
    3. RATIO:
       1. D showed consumer studies to state that the word champagne has become a generic term and is no longer associated with france. Champagne has been described as excellence and not just the bubbly drink.
       2. P brought evidence [surveys] to show that some people associated champagne with the bubbly drink.
       3. Court stated that champagne had acquired a generic term and has lost distinctiveness over time.

# #2: Misrepresentation

## Misrepresentation

* 1. Definition
     1. Once goodwill has been established, need to show misrepresentation in order for there to be passing off
     2. In order for there to be misrepresentation there needs to be **actual or potential** **confusion**
        1. Misrepresentation can be **negligent, willful, careless**, but has to be there.
  2. TEST:
     1. The P must be able to establish that the D misrepresented his or her wares or services as those of the P in a manner that was likely to cause **consumer confusion**
        1. Actual confusion does not need to be established.
        2. Can get injunction to prevent anticipated confusion if a product was allowed to enter the market.
        3. Misrepresentation may be willful, negligent, or careless
     2. How to show **confusion**
        1. If product is inexpensive and likely to take quickly from shelf= than similarities in product appearance are more likely to lead to confusion
        2. Luxury product = consumer might take a great deal or more care in inspection the item, product, literature, the label and brand.
        3. **TEST PERSON for confusion**
           1. Average or ordinary consumer for the wares or services at issue, who may be found at any point in the chain of consumption

If inexpensive = take quickly from shelf

Luxury = consumer take a great deal in inspecting item

* + - * 1. *Can vary depending on the nature of goods or services at issue. It is important because it fyou attribute knowledge then they are less likely to be confused if they are in a hurry and not a lot of knowledge than more likely to be confused.*

#### Case Example: Institute National:

* + - 1. FACTS:
         1. Champagne and generic term for excellence. Using word is passing off.
      2. ANALYSIS
         1. Court stated that there needs to be misrepresentation leading to **actual or potential** [anticipated] confusion and cannot be enough for the P to establish that the D were benefiting from using the term Champagne.
         2. Court stated that there was no confusion due to the knowledgeable consumer and the increase in public exposure.

Bright consumer= less confusion

Naïve consumer/consumer in a hurry = more likely to be confused.

## Reverse Passing OFF

* 1. Reverse passing off = the D represents P’s wares or services as his or her own
     1. Regular passing off= D misrepresents his or her wares as those of P

#### Case Example: Bristol Conservatories

* + 1. FACTS:
       1. Salesmen for the D’s company allegedly showed prospective customers pictures of the P’s conservatories as if they were samples of the D’s product and workmanship.
    2. ISSUE?
       1. Was there reverse passing off?
    3. RATIO:
       1. Court stated that there was no confusion because the customer’s had no idea that the product existed as P’s [Bristols] product.
       2. **There is misrepresentation but there is no confusion**

#### Case example: BCAA v Union Local 378

* + 1. FACTS:
       1. During a labour dispute the union created various versions of the website similar to BCAA’s website in appearance and used the BCAA’s trademarking in its domain name and meta tag. BCAA argued that there was misrepresentation leading to confusion.
    2. ISSUE?
       1. Was there misrepresentation leading to confusion?
    3. RATIO:
       1. Court stated that the **test person was a reasonably prudent web user**. There was passing off in the 1st site, but that there was no misrepresentation in the labour context.
       2. Important principles
          1. Reasonable balance between legitimate protection of IP right and citizen or union freedom of expression- don’t see it discussed in IP Law, except this case, and this is in part because of the way it is easier to use charter when dealing with common law compared to statutory frame work
          2. Disclaim: see that the prominence given to the disclaimer must be dependent on a false expression, if there is high potential for confusion than disclaimer must be prominent if it is low than it can be fairly small.
       3. Court said there might be situations where no disclaimer is adequate and there is likelihood of confusion.

# #3: DAMAGES or Remedies

## Damages

* 1. In order for there to be damages **P must establish damages or likelihood of damages in passing off action**
     1. If P can establish a likelihood of confusion, then a likelihood of damages will be presume
  2. Injunction
     1. In case of injunction, P need only show a likelihood of damage

## Types of Damages

* 1. Loss of goodwill and reputation
     1. Where competitor passes off inferior product as P’s causing P’s product to possibly not be purchased again.
  2. Loss of trade
     1. Rayplasitc—loss of trade where competitors product is identical or confusion which cut into P’s sale.

## Defences by D

* 1. P failed to make out element of tort of passing off
  2. Use of ones own name in business
     1. Has to be surname
     2. Cant be given name or nickname
     3. Has to be used honestly without intent to trade on the goodwill or reputation of another business
     4. Cant be confusing with an already existing business using the name
  3. D holds a TM registration for the mark it is using
     1. COMPLETE DEFENCE TO PASSING OFF
        1. *Molson Canada v Oland breweries*
  4. P has accepted in the use of the mark

## Remedies

* 1. Damages
     1. For actual harm suffered
     2. For harm to reputation or goodwill
  2. Permanent injunction
  3. Order for disgorgement of profits
  4. Delivery up or destruction of wares or materials with the offending mark
  5. Punitive damages.

# T’marks: introduction, what is a trademark

## TradeMark?

* 1. A mark used by a person for the purpose of distinguishing that person’s goods or services from those of others in the marketplace.
     1. *Words, symbols, designs*
     2. **A purely functional design may not be the basis of TM registered or unregistered**
        1. *Lego*

### Types of TM

* + 1. Ordinary Marks [Words & Designs]
       1. Circumstances in which TMs are registrable
          1. S.12(1)(a)(b)(c)
    2. Certification
    3. Collective
    4. Official marks regime
    5. Distinguishing guises.

### *N*on Traditional marks

* + 1. Smell, taste, sounds, moving images, holograms, colour marks, gesture marks.
    2. T’marks: the concept of use,

## Ordinary Mark

* 1. Distinguish the product or services of a specific firm or individual
     1. *Eg: Coca-cola, lego, McDonalds, pepsi, Microsoft—****word marks or design marks***
  2. Mark
     1. Limited to visually perceptible marks
        1. Words, grouping of words, initials, numbers and designs, sound marks
  3. S.2
     1. Outlines that it has to be a **mark, it has to be used, and has to be distinguished.**
        1. **(a)** a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired, or performed by him from those manufactured, sold, leased, hired, or performed by others,
        2. (b) a certification mark,
        3. (c) a distinguishing guise or
        4. (d) a proposed trade mark

## Certification Mark

* 1. Identify Wares or services which meet defined standards
     1. Common categories =**safety and performance**
        1. *Eg: Woolmark design—quality assurance symbol that is made from 100% wool and complies with strict performance specification*
  2. Can be used by anyone who complies with the standards defined by the owner of the certification mark
     1. Usually owned by 1 person who licenses for use by others
  3. S,2
     1. Means a mark that is used for the purpose of distinguishing or so as to distinguish goods or services that are a defined standard with respect to
        1. (a) the character or quality of the goods or services,
        2. (b) the working conditions under which the goods have been produced or the services performed,
        3. (c) the class of persons by whom the goods have been produced or the services performed, or
        4. (d) the area within which the goods have been produced or the services performed, from goods or services that are not of that defined standard

## Collective Mark

* 1. Signs that distinguish the geographical origin, material, mode of manufacture or other common characteristics of goods or services or enterprises using the collective mark
     1. *Eg. NHL—owned by an entity but can be used by any member of the organization*
  2. Function is to inform the public about certain features of the product, owned by an entity, can be used by members of this entity.
  3. Differences
     1. Certification mark = used by anyone who complies with specific standards, verses, collective which is owned by an entity and all members of that entity can use it
  4. S.2 definition of collective mark is broad enough to include collective marks

## Legislation [Ordinary Marks]

### TM ACT:

* + 1. Section 2 of TM
       1. A mark that is used by a person for the purpose of distinguishing or so as to distinguish wares, or services manufactured, sold leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others

### TM is not registrable if its not

### Section 12(1): --subject to s.13 distinguishing guise.

* + - 1. Subject to section 13, a TM is registrable if it is not
      2. (a) Primarily merely the name or the surname of an individual who is living or died within 30 years
      3. (b) whether depicted, written or sounded, either Clearly descriptive or deceptively misdescriptive in English or French of the character/quality of wares/services or of the conditions of production/persons employed in their production/ place of origin
      4. (c) Name in any language of any of the wares or services in connection with which it is used
      5. (d) Confusing with a registered TM- as defined in s.6 and factors in s.6(5)--

#### S.6. (1)

For the purposes of this Act, a trade-mark or trade-name is confusing… if the use of the first mentioned trade-mark …would cause confusion with the last mentioned trade-mark …in the manner and circumstances described in this section.

#### 6(5)

 In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

the length of time the trade-marks or trade-names have been in use;

the nature of the goods, services or business;

the nature of the trade; and(e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

* + - 1. (e) Mark prohibited by s.9 or 10
      2. (f) a denomination the adoption of which is prohibited by section 10.1
      3. (g) in whole or in part a protected geographical indication where the TM is to be in association with a wine not originating in a territory indicated by the geographical indication;
      4. (h) in whole or in part a protected geographical indication, where the TM is to be registered in association with a spirit not originating in a territory indicated by the geographical indication; and
      5. (f) subject to subsection 3(3) and paragraph 3(4)(a) of the Olympic and Paralympic Marks Act, a mark the adoption of which is prohibited by subsection 3(2) of that act
    1. Section 13: DISTINGUISHING GUISE
       1. (1) a distinguishing guise is registrable only if
       2. (a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration; and
       3. (b) the exclusive use by the applicant of the distinguishing guise in association with the goods or services with which it has been used is not likely unreasonably to limit the development of any art or industry
       4. (2) no registration of a distinguishing guise if it interferes with the use of any utilitarian feature embodied in the distinguishing guise
       5. (3) the registration may be expunged on application of any interested person if court decides it has become likely unreasonably to limit the development of any art or industry.

### Section 12(2):

* + - 1. If not registrable due to (1)(a) or (b);
      2. is registrable if it has…**become distinctive** at the date of filing an application for registration
      3. Registration requirement:32. (1)
         1. An applicant who claims that his trade-mark is registrable under subsection 12(2) or section 13 shall furnish the Registrar with **evidence** by way of affidavit or statutory declaration establishing the time the trade-mark has been used in Canada and with any other evidence that the Registrar may require in support of the claim
         2. 2) The Registrar …having regard to the **evidence**…, restrict the registration to the goods or services in association with which the trade-mark … shown to have been ..used as to **have become distinctive** and to the defined territorial area in Canada in which the trade-mark is shown to have become distinctive.

*Section 32 is stating that you have to bring evidence of distinctiveness, and prove that, and also registration can be restricted to an area in Canada where it requires distinctiveness*

#### Section 12 Case Example [Ordinary Marks]

#### Surname: Case Example: Canada Registar of TM v Coles Book Store [SECTION 12(1)(a)]

* + - 1. 12(a) Primarily merely the name or the surname of an individual who is living or died within 30 years
    1. FACTS:
       1. Coles book store wanted to register the word Cole with the association of publication but was refused by the register due to s. 12(1)(a)
    2. ISSUE:
       1. Is a mark a word?
    3. RATIO:
       1. *Standard Oil Co v Canada*—stated that there are 3 classes of words. If it doesn’t fall within the 3 categories then it is not a word
          1. *Dictionary*
          2. *Names*
          3. *Invented words*
       2. Case further states that if it **primarily a name or surname of an individual** who is living or who has died within the previous 30 years?
          1. TEST:

Would a person of ordinary intelligence and ordinary education in English or French be just as likely, if not more likely to respond to a word the word by thinking of it as a brand or mark to a business rather then a name or surname.

If so then it is not merely a name or surname and could be registered

* + - 1. Court applied in cole
         1. Court found that it was merely a name or surname and no one in Canada would have known it was cabbage or respond to this name as a surname or know that it had a dictionary definition.
         2. Refused TM registration

#### Surname: Case Example: Jack Black LLC v Canada [SECTION 12(1)(A)]-

* + 1. FACTS:
       1. Rejected TM of Jack Black in relation to skin care products based on s.12(1)(a)
    2. ISSUE:
       1. 12(1)(a); cant register mark of a name or surname.
    3. RATIO:
       1. Registrar objection was withdrawn because there was no issues with the specific mark according to s.9(1)(k):
          1. any matter that may falsely suggest a connection with any living individual;
       2. Also the fact that no one named jack black complained

#### Descriptive: Case Example: Unilever Canada Inc v Superior Quality Foods INC-[12(1)(B)

* + - 1. S.12(b) whether depicted, written or sounded, either **Clearly descriptive or deceptively misdescriptive** in English or French of the character/quality of wares/services or of the
    1. FACTS:
       1. SQF tried to register a TM in association with a soup
    2. ISSUE?
       1. Can you TM a soup 12(1)(b) is the mark descriptive?
    3. RATIO
       1. Court stated that a **clearly descriptive TM =**
          1. Does the mark tell potential dealers/purchasers of the goods/services what the goods/services are? Or describe them or describe a property, which is commonly associated with them?
       2. Court considered **Deceptively misdescriptive**
          1. Would dealers/purchasers of the goods be deceived by the mis-description into purchasing goods or ordering services, which different in character or quality from those expected?

*Does the mark tell potential dealers of the goods or services of what they are or describe them with what is commonly associated with them>*

* + - 1. *Both factors were considered*
         1. *Clearly= easy to understand, self-evidence, plain*
         2. *Character = feature, trait, characteristic of wares*
         3. *Quality= degree of excellence, laudatory description [expressing praise]*
      2. S.12(1)(b)
         1. Average purchaser of the wares
         2. Consider the mark in its entirety as a matter of immediate impression.
      3. When looking at s. 12(1)(b) court said we have to look at it from point of view of an **average purchaser of the wares**.
      4. Court found it is descriptive of goods and services.
         1. The mark does describe as first impression that soup and soup bases are better than bouillon which is contrary to s.12 (1)(b), and is justified in policy that anyone should be able to say that other people in the industry should be able to use it and free of competition.

#### Descriptive: Worldwide Diamond Trademark LTD v Canadian Jewelers Association [SECTION 12(1)(B)]

* + 1. FACTS:
       1. an attempt was made in association with diamond report certification and appraisal
    2. ANALYSIS
       1. Rejected under s. 12(1)(b) because the first impression of the mark the reader is notified of the inherent quality and ware and in this case Canadian diamonds, was clearly descriptive of the wares and services

#### Name in any language: General Foods LTD v Carnation Co [12(1)(C)

* + - 1. 12(c) Name in any language of any of the wares or services in connection with which it is used
    1. FACTS
       1. Can GFL register the TM ‘instant breakfast’ for use in association with wares described as fortified powder food for mixing with milk
    2. ANALYSIS:
       1. Rejected it and said that the statement of what the wares are in ordinary terms **is an instant breakfast** so we see a company applying to register a TM that applies to the names of the wares so it wouldn’t be registrable in 12(1)(c)
  1. Policy Question: What is significance in the distinction between 12(1) and 12(1)(c)?
     1. A mark is not registrable if it is in french or name in any service. C doesn’t get registrable because it cant be distinctive, and for b you can register if distinctive. Scope is wider in what you can do in other languages apart from English languages. Businesses are free to use a number of terms but there are certain categories that they cannot use.

## DISTINGUISHING GUISE [SECTION 13]

* 1. Definition:
     1. The **shape or design** of the product or packaging that effectively distinguishes the product from others.
     2. S.2: distinguishing guise means
        1. (a) a shaping of goods or their containers, or
        2. (b) a mode of wrapping or packaging goods
        3. The appearance of which is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired, or performed by him from those manufactured, sold, leased, hired, or performed by others.
     3. In order for a distinguishing guise to be registered it must be proven **that it has become distinctive through usage**
        1. S. 13 of TMA
           1. *Eg: shape of Coke bottle*

### Legislation

* + 1. Secion 13 of TMA
       1. 13. (1) A distinguishing guise is registrable only if
          1. it has been so **used in Canada** to have become distinctive at the date of filing an application for its registration; and
          2. the exclusive use by the applicant of the distinguishing guise in association with the goods or services with which it has been used is **not likely unreasonably to limit the development of any art or industry**.
       2. 2) No registration of a distinguishing guise interferes with the use of any utilitarian feature embodied in the distinguishing guise.
    2. Can register if you have acquired distinctiveness through use and doesn’t interfere with **s.9 or 10**

### PROHIBITED MARKS- S.9

* + 1. **Prohibited sections 9/10**
       1. Section 9 of TM; 2 categories of prohibited marks
          1. Idea that no person shall adopt in connection with business as TM any mark consisting of or resembling or likely to mistaken
          2. **Prohibited Mark**

Royal arm crest or standard

Royalty- royal family

The standard, arms or crest of his excellency the governor general

Any word or symbols likely to lead to the belief that the good or services is used or received, produced, sold, performed under royal, vice regal, or governmental patronage, approval or authority

Arms, crests, or Flags used by Canada or any province

Symbols with red cross

The emblem of the red crescent on a white ground adopted for the same purpose as specified in (f) [above]

National flags

Governor general

Cant use scandalous or obscene moral words or marks

* + - * 1. **Official marks 9(1)(n)(iii)**

Allows entities, which are **“public authorities**” to request, the Registrar of Trade-marks to give public notice of their **adoption and use** of particular names or symbols. These marks are referred to as “official marks”.

Once notice is given, these official marks are also removed from the general realm of trade and commerce.

Statutory requirement

Mark must have been adopted and used

Adoption and use has to be by a public authority in Canada

Adoption and use must be as official mark for wares and services.

* + - * 1. ***S. 9(1)(n)(iii) is controversial***

*S. 9(1) prohibits anyone else from adopting an official mark. This prohibition is absolute.*

*None of the usual formalities for the adoption of official marks*

*Have to request that the registar give public notice of the use of the mark,.*

*Limited ability to refuse mark*

*No opposition proceeding; no scrutiny by Registrar*

*Mark can be descriptive; not required to be distinctive of wares, services*

*No need to renew; no provisions to remove unused marks*

* + - 1. **Section 10.**
         1. Where any mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, no person shall adopt it as a trade-mark in association with such goods or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.
    1. **Stat Requirement**
       1. Mark must be adopted and used
       2. Adoption and use has to be by a public authority
       3. Adoption and use must be as an official mark for wares and services
    2. *Important here is that it has to be public authority*

#### S.9 Case Example: Ontario Assn of Architects v Ontario Assn of Architectural technologist –PUBLIC AUTHORITY TEST

* + 1. FACTS:
       1. Wanted to register architectural work as public mark
    2. RATIO
       1. The Court decided that **significant government control must be exercised** such as an ongoing influence in an entity’s governance and decision-making structure.
       2. **TEST: Degree of governmental control**
          1. Consider bodies objects, duties and power, including distribution of its assets
          2. Needs an ongoing government supervision of the activities of the body claiming to be a public authority;

Sufficient to allow the government to exercise a degree of ongoing influence in the bodies governance and decision making

* + - * 1. **Bodies activities benefit the public**

Broadly interpreted by the courts as a benefit for the public—need to see some public benefit.

* + 1. **PRINCIPLE:** important to remember that once a mark is given public authority than people who haven’t adopted it cant adopt or use any mark related to the specific mark. If you used it before public notice, you can continue to use it but your use gets frozen at that point in time. If you used it and didn’t register—you cant register, if you did register—cant modify or change your logo over time.
  1. Examples
     1. Anne of Green gables

# Registration process

## Step1: Use

* 1. To register a TM, first **use** entitles registration.
     1. Failure to use= basis for expungement of TM
     2. Unauthorized use = possible infringement action
  2. Use is one of the core concepts of TM law, which requires first use of the mark as a requirement for registering a TM
  3. Legislation

### Trademark Act s.4

* + - 1. Refer to **section 2** of the “trade-mark” than go to s.4(1)/4(2)
         1. a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

a certification mark,

a distinguishing guise, or

a proposed trade-mark;

* + - 1. S.2 “Use”
         1. In relation to a TM, means any use that by section 4 is deemed to be a use in association with goods or services.

### s.4

* + 1. (1) A trade-mark is deemed to be used in **association with goods** if, at the time of the transfer or in possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property is transferred. = goods
       1. **Ex:**
          1. **Written material inserted in packages**
          2. **Invoice at time of checkout with competitors mark**
          3. **Purchase that comes with a gift with competiors mark**
    2. (2) A trade-mark is deemed to be used in association **with services if it is used or displayed in the performance** or advertising of those services.= performances
       1. **add ex of services**

### Use s.4(1)

#### Use 4(1): Case Example: Syntex v Apotex INC- DRUG SALE

* + - 1. FACTS:
         1. Syntax is registered owner of TM of naproxen and sold naproxen under the name of nyproxen since 74. Apotex got a license to be able to sell this specific drug and took aponaporxed and registered it as TM in Canada, which was advertised on a flyer an distributed in pharmacies
      2. ISSUE?
         1. Did apotex use naproxen infringe s.22 of TM act

S.22(1)

No person shall use a TM registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attracting thereto.

* + - 1. RATIO:
         1. Court stated that use was not made out . Need to look at s.2 and s. 4(1) because in relation to wares and services. In this case Apotex didn’t use mark on product or packaging.
         2. Court stated that it needed to be looked at time property was transferred.

TEST:

because the mark was **not on the product or packaging**. There was no notice given during any time associating the property to the D and the goods of purchaser.

* + - * 1. Court stated that in s.4(1) the appearance of the TM in written material inserted in packages even though not on product itself could constitute use in s.4(1) but it was not made out because it was not on product or packaging and no notice given during any associating at time of transfer of property to D’s good of purchaser.

#### Use 4(1): Clairol International Corp

* + - 1. FACTS:
         1. use in association between Clairol and Revelon regarding comparison charts on product and brochures
      2. ISSUE:
         1. Did placement of the TM on packages constitute Use?
         2. Did the use of the marks on the brochures constitute use?
      3. RATIO:
         1. S.19-22 of TM states that “ was P’s mark used by D in association with D’s own good meaning of s.4(1)?
         2. Mark was used on package = use under s.4(1), however, TM was **not “used” in respect to brochure** because it was not part of packaging and it wasn’t done during time of transfer of property
      4. **POLICY REASONS**
         1. Consumers rights; to make a good decision by allowing access to important information
         2. A connected policy reason is important of free competition in any industry and not to interpret provision of TM act that would stifle the competition
         3. Can have comparative advertising on both goods and services.

#### Use 4(1): CBM Kabushiki Kaisha v Lin Trading Co-

* + - 1. FACTS:
         1. CBM created Q and Q design in 76, than CBM decided it wanted to enter Canadian market, established contract with microsonic as possible distributor, shipped watch to microsonic but it fell through, CBM made contract with LTC who indicated interest as Canadian distributor. LTC tried to register Q and Q as TM
      2. ISSUE:
         1. was LTC entitled to register the mark Q & Q design as Tms?
      3. ANALYSIS:
         1. The normal course of trade begins with the manufacturer, has wholesaler and retailers as intermediaries, and ends with the consumer. **If any part of the chain takes place in Canada, this is use under s.4**
         2. S. 16. (1)

S.16 establishes what party is entitled to registered mark if you file an application in correct form and pay requisite fees unless the mark is on the date you made it known is confusing with a TM that was previously used in Canada or known in Canada by another person

* + - * 1. Need to look at s.4(1) and s.16(1)(a)
      1. REASONING
         1. Court stated that the normal course of trade begins with manufacturer, goes to consumer, and ends with retailer = use in s.4
         2. CBM did use it when they sold the watch to microsonic in 80s, which was using a mark in Canada so LTC is not entitled to register mark

#### Use s.4(1): Distrimedic Inc v Dispill

* + - 1. FACTS:
         1. Goods are given away for free to get product out there
      2. ISSUE:
         1. Goods given away as samples? Does this constitute Use?
      3. ANALYSIS:
         1. “The expression "in the normal course of trade" … requires some payment or exchange, which excludes the use of a trade-mark in situations where the wares are given away for free or donated.”
         2. Court stated that if you start selling product that product later it constitute use than court may look back and mark that original use as the original distribution of the use.

### Use 4(2)

#### Use4(2): Gesco Industries Inc v Sim [GET FACTS]

* + - 1. ISSUE:
         1. Was the stainshield TM used in association with the services disclosed in the registration of TM?
      2. ANALYSIS:
         1. Term should be liberally construed; can include **services, incidental or ancillary to the sale of goods**
         2. S 4(2) states that TM is used in association with services if used in performance or advertising in use of service
         3. Service needs to interpret broadly.

There is no definition of services given because the human mind is capable of perceiving and interpreting liberally and each case needs to be decided on its own facts considering prior precedent. Nothing in definition to suggest that there is internal limitation to what srvices is, the argument has been made that services should be limited to those that are not incidental or ancillary to sale of goods, if you are providing product and providing sale of product that is not a service, that was rejected and can include incidental or ancillary to the goods itself.

* + - * 1. Stainsheild was displayed in advertising in treatment of carpet and rugs = as a result it was used in the specific case.

## How to apply for registration

* 1. Process
     1. Research
     2. Confirm there is a legal basis for your registration
        1. S. 16,30,12
           1. Can register mark as long as it is done in accordance with **s.30**[ which sets out what is needed—mark for which registration is sought, outline specific ware and services associated with mar,start day of use]
           2. Also look at s.12 to determine if it is descriptive, or name of any service
     3. Apply
        1. S.30
        2. *250 if done online, 300 in other cases*
     4. Initial review by registrar
        1. S.37
           1. TM officer conducts search to see if there are any other marks.
           2. S.37 sets out why an application can be refused

Can refuse if it does meet s.12 or offends s.9/10/13

Can refuse if you are not entitled to registration mark on basis that it is confusing

* + 1. Opposition
       1. S.38
          1. Within 2 months of mark being advertised in journal, can file statement of opposition; various reasons for opposition

Doesn’t conform to s.30

Can argue confusion

* + - * 1. Not automatic that you get hearing, only heard if registrar is satisfied that it raises substantial issue for decision. Claimant [the person who wants mark registered] has to prove on BOP that it should be registered
        2. *Can oppose mark if it violates s.12, is confusing s.6 with previous mark, not distinctive-s.13*

#### Passing off in TM under s.7 (b)/(c) + Opposition + prior use s.3

\*Can bring passing off under tort or s.7

#### Case Example: Timothys Coffee of the World v Starbucks Corp

Facts:

Timothy opposed Starbucks Christmas blend coffee

Issue:

Was Timothys able to establish use?

ANALYSIS:

T argued ground for opposition was that it was not distinctive because it doesn’t distinguish between goods of Starbucks and Timothy’s.. Timothy argued first use through advertising in their publication.

Court held that merely advertising in publication in Canada doesn’t constitute use of the mark in Canada—T didn’t meet burden of establishing prior use

T didn’t bring enough evidence that its mark had a reputation in association with coffee that wouldn’t have been enough to take away from distinctiveness of Starbucks, evidence wasn’t enough

Relied on magazine advertisement of a special publication

**Opposition was unsuccessful.**

* + 1. Registration
       1. S.40
    2. Renewal
       1. Can be renewed every 15 years [s.46]
  1. **Why register**
     1. Don’t have to prove good will or reputation to register mark compared to passing off—all you have to show is use or proposed use
     2. National protection for TM, doesn’t matter if it has goodwill in certain party of country of if it is not known at all—registered TM get protection across whole country
     3. Once registered presumed to be valid for all goods and services for which it is registered.
        1. **7.** No person shall
           1. (*b*) direct public attention to his wares, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his wares, services or business and the wares, services or business of another;
           2. (*c*) pass off other wares or services as and for those ordered or requested;
        2. *can bring passing off claim at COMMON LAW or S.7 of TM*

# Ownership, Transfer and Licensing of TMs

## How to remove existing TMs from register

* 1. 2 ways to remove
     1. s.45: expungement or amendment on the basis of non use
        1. can apply to registrar to have TM expunged on basis for non use --- a use it or lose it provision
     2. s.57; striking or amending a TM
        1. bringing an application to federal court to strike or amend a TM on the basis that it does not accurately express or define existing right of the registered owner of the mark.

## Legislation- s.45 [NON USE]

* 1. 45. (1) The Registrar may at any time and, at **the written request** made **after three years from the date of the registration** of a trade-mark by **any person who pays the prescribed fee shall**, unless the Registrar sees good reason to the contrary, **give notice to the registered owner** of the trade-mark requiring the registered owner to furnish **within three months an affidavit** or a statutory declaration **showing**, with respect to each of the goods or services specified in the registration, whether the **trade-mark was in use in Canada at any time during the three year period** immediately preceding the date of the notice and, if not, the **date when it was last so in use** and the **reason for the absence of such use since that date**.
     1. Need to make request to registar; in writing; after 3 years from date or registration; for fee of 400; has to be for a good reason. Not automatic—threshold for exercise.
     2. Responded has to provide evidence within 3 months immediately proceeding date of notice, and an affidavit or statutory declaration.
     3. If TM not in use, owne has to provide evidence proceeding date of notice when it was last in use, the reason for its absence.
  2. 45. (3) Where, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence, **it appears to the Registrar** that a trade-mark, either with respect to all of the goods or services specified in the registration or with respect to any of those goods or services, **was not used in Canada at any time during the three year period immediately preceding the date of the notice** and that the absence of use has **not been due to special circumstances** that excuse the absence of use, the **registration of the trade-mark is liable to be expunged or amended accordingly.**
     1. If no appeal, registrar is to expunge TM, if appeal than has to wait until final judgement
     2. If registar concludes it wasn’t used in 3 years and no special circumstances registar can emend or expunge the TM.

#### Case Example- Gowling Lafleur v Ameri Court- S.45(3)

* + 1. Facts:
       1. case involving….
    2. Issue:
    3. Ratio
       1. **Free gifts and donations** do not amount to use in the normal course of trade
       2. **Barter and consignment might amount to use in the normal course of trade**
    4. REASONING
       1. Application of non use test:
       2. Court stated that the length of non-use was 4 years and 11 months and no evidence that it was used in Canada. Factors applied from above
       3. Reason for non use🡪 argued that special circumstances regarding threat of litigation, but not evidence was found.
          1. There were no special circumstances of non-use. Court stated that **threat of litigation** = special circumstances. However, no evidence of that in this case.
       4. Intention to resume use—there was no indication that use would take place soon or at some point at a later time.
       5. Registration = expunged.

### TEST to show non USE for TM s.45

* + - 1. Onus on registered owner to establish special circumstances excusing non use of the TM s.45(3)
      2. 3 additional factors to consider
         1. length of time of non-use
         2. were reasons for non-use due to circumstances beyond the registered owners control
         3. was non use deliberate and voluntary
         4. is there a serious intention to shortly resume use?
      3. Other principles to consider
         1. Circumstances of non use must be special

Special circumstances are an exception to the general rule that a TM which is not used should be expunged

#### Case example- Scott Paper Limited

* + 1. Facts:
       1. Scott paper didn’t use TM for 13 years brought action for expungement.
    2. ISSUE:
    3. ANALYSIS;
       1. The special circumstances which excuse the absence of use of the mark must be the circumstances to which the absence of use is due
       2. The fact that the registered owner may have plans to resume use of mark is not sufficient to excuse non-use
    4. REASONING
       1. Court stated that if an individual intended to use the mark in the near future, even after 13 years, could be enough to excuse specific non-use. However, 13 year non use was due to deliberate decision to not use mark and plans for future use don’t explain the period of non use and cant amount to special circumstances.
       2. **TEST FOR SPECIAL CIRCUMSTANCES**
          1. Special circumstances must be circumstances to which absence of the use is due
  1. Policy Question
     1. Should TM be a use it or lose provision? Would you make any changes to the expungement of non-use. S.45

## Section 57 [Look at 57 🡪takes you to s.18]- STRIKING /AMENDING

* 1. Can **strike or amend TM on basis it does not accurately express** or define the existing rights of the registered of the mark [read with s.18]
     1. 4 ways to deal under s.18
        1. If TM **was not registrable at the date of registration** [18(1)(a)]
           1. See s.9,10,12,13 of TMA

Section 12 (1)= context of registrability

* + - 1. *If the TM* ***is not distinctive*** *at the time proceedings bringing the validity of the registration into question are commenced [18(1)(b)] [DON’T NEED TO KNOW]* 
         1. *See s. 48-50 for TMA becoming generic*

*Focuses on distinctiveness; is TM still distinguish the companies good or services from those offered by others or is there confusion*

* + - 1. If the **TM has been abandoned** [18(1)(c)]
         1. See +s.45 of TMA

Penguin Case Decision

If mark is abandoned and period is less than 3 years than you can use

57 +18 [less than 3]

More than 3 = section 45 OR 18(1)(c)+57 to have mark expunged

* + - 1. If the applicant for registration **was not the person entitled to secure the registration** [18(1)]
         1. See s.16,17 of the TMA

S.16 = applicant is not person entitled to register mark if on date mark used was made to be confusing

S.17 – says only way application will be refused or registration expunged on ground that previous use of confusing TM is by the person who has right to the **previous mark brings the case**- LIMITATION OF S.17

Eg. 2nd person says 3rd persons TM is confusing, 3rd person cant say yours is confusing with 1st persons TM, 1st person has to bring TM.

S.17(2) sets 5 year limitation period for date of registration being challenged unless it has been established that person did so with knowledge of the previous mark.

#### S.18(1)(c)Case: Promafil Canada

* + 1. Facts:
       1. Canadian company based in NS and obtained license from MS to use penguin mark, it was used but never registered in Canada. MS was concerned with French design in 97 which tried to register TM in respect to shirt and shorts but not with wool, opposed registration and accepted by registrar that mark was confusing with wool. P brought action to propose registration of new design and to expunge new design. New design was confusing
    2. ISSUE
    3. Analysis:
       1. To show abandonment 18(1)(c) (#3)
          1. Must show registered TM no longer in use in Canada
          2. Need to show intention to abandon mark
       2. Amendment:
          1. Can amend mark provided that the amendment doesn’t’t materially alter the character of the mark. Can have variations on the same mark [both can be used]. All the law requires is that there’s maintenance of recognizability – to avoid confusion of unaware purchasers. (Promafil)
       3. **Test = substantial variation**
          1. Mark cant be substantially different from the registered design. As long as it is not substantially different it will constitute use.
    4. Reasoning
       1. Court stated that the 2 design is not the same visual impact and is different. An **unaware purchaser** would be confused as to whether it was 2 different companies. Court held that at some point a variation in a mark might be significant enough to constitute a new mark. One question to ask is has the mark varied so much to confuse the consumer as to the source of the wares?
       2. Question to ask if whether the change alters impression of mark and does character of mark materially altered?
       3. If you maintain dominant feature of design, an unaware purchaser won’t be mislead.
          1. Reason for altering is due to technology.

# the concept of confusion s.6(1) + 6(5)

## Confusion

* 1. A TM is not registrable if it is confusing
     1. Ss. 12/16 = state when TM is not registrable
     2. S.18(1)

### Confusion legislation

* + 1. S.6(1)
       1. Trade mark or trade name is confusing with another TM or TN if the use of the first mentioned TM or TN would cause confusion the last mentioned TM/TN in the manner and circumstances described in this section
    2. S.6(2)
       1. The use of a TM causes confusion with another TM if the use of both TM in the same area would likely lead to the interference that the goods or services associated with those TMs are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.
    3. S.6(5)
       1. FACTORS: In determine whether TM are confusing
          1. The inherent distinctiveness of the TM and the extent to which they have become known

*Eg. Words or symbols invented to express TM—EXXON—no other meaning of TM*

*If word is made up = high degree of distinctness*

*Ordinary words = low degree of distinctness*

*TM doesn’t describe or suggest any characteristic of goods they identify*

*Mark is to have a high degree of inherent distinctiveness if only thing they do is identify or signify a sense of a product…word made up.*

* + - * 1. The length of tiem the TM have been in use
        2. The nature of the goods, services or business;
        3. The nature of the trade and
        4. The degree of resemblance between the TM in appearance or sound or in the ideas suggested by them.

#### Case Example: S & S production v Possum Lodge

* + 1. FACTS:
       1. D wanted to create a getaway lodge based on a name of a TV show that had possum lodge. M files TM registration of possum based on proposed use in association with a number of different uses such as cabins, sales, lodges, campsites, cottages, time shares, recreational real estate and restaurant.
       2. S&S opposed this application on the basis s. 38(2)(b) TM is not registrable specifically on the basis that it is confusing with an opponents TM possum lodge.
    2. ISSUE:
       1. How was application opposed?
    3. RATIO:
       1. Court stated that s.6(2) had to be used and 6(5)
          1. 6(2)

Court stated that inherent distinctiveness of TM are unique marks that identify specific source of product. A mark is set to have **a high degree of inherent distinctiveness** if only thing they do is identify or signify a sense of a product

*Eg. Words or symbols invented to express TM—EXXON—no other meaning of TM*

*If word is made up = high degree of distinctness*

*Ordinary words = low degree of distinctness*

Court stated that for the applicant the word was purely descriptive whereas the show had acquired a secondary meaning. The applicant had a less distinct meaning to the word because it was describing exactly what it was doing.

* + - * 1. S.6(5)

The inherent distinctiveness of the TM and the extent to which they have become known

For A second part was purely descriptive whereas for people who opposed had acquired secondary meaning beyond the launce of possums. Both marks would be distinct to goods or services don’t serve a descriptive function, but the A’s mark was found to be less distinctive because it is describing what it is doing

Opponents mark is well known

No evidence of use or promotion of applicants mark, there is extensive use of opponets mark

The length of tiem the TM have been in use

Opponents mark has been used since 91

The nature of the goods, services or business;

Court found slight overlap, a connection. A’s is business, O is about outdoors, there was connection but no overlap.

The nature of the trade and

The degree of resemblance between the TM in appearance or sound or in the ideas suggested by them.

When applying for a mark has to show that there is no reasonable likelihood for confusion between your mark and other mark. Onus on applicant to establish no reasonable likelihood of confusion

* + - * 1. Court found that it couldn’t be done the applicant had not satisfied that there was no connection between the 2 marks.
        2. TEST:

If it creates an impression then there is going to be a connection between the mark which is enough to stop the mark from being registered.

#### Case Example: Mattel v 3894207

* + 1. FACTS:
       1. Barbie opposed registration of the numbered company who was opening up a restaurant in Montreal. Mattel said that there would be confusion with the restaurant and the barbbie figure
    2. ISSUE?
       1. Was there confusion between the 2 marks?
    3. RATIO:
       1. Binnie J: Some TMs are so well-known that use in connection with any wares or services would generate confusion. You don’t need to establish a connection between the goods and/or services in order for a finding of confusion to be made out.
          1. Responsibility of the restaurant to establish there is no reasonable likelihood of confusion with the 2 marks
       2. Court stated that there does not need to be a connection between the goods and/or services in order for a finding of confusion to be made.
       3. Restaurant needs to establish that there is no reasonable likelihood of confusion. The opposition board found that there was no real connection between the 2 marks. The federal court said that you cant automatically assume that there is confusion due to the fame of the mark
       4. TEST PERSON:
          1. SCC stated that the test person for the confusion analysis is aN ordinary hurried purchaser with average intellect acting with ordinary caution and the chances of being deceived.
       5. Court applied the factors from s 6(5) and stated that even though there was an inherent fame attached to Barbie, an ordinary consumer wouldn’t be confused between Barbie dolls and a restaurant chain since they are operating in 2 different fields. Further the fact that there is a product line difference is a significant factor.
          1. Nature of trade is different and don’t intermingle.
          2. Resembalance; both use same name but numbered company is wrapped in a design,

#### Case example: Masterpiece INC v Alavida Lifestyles- 18(1)- Applicant not entitled to register!

* + 1. FACTS:
       1. MI and AL both used master piece living. One was in association with a retirement home and the other was a company that used Master piece living. Masterpiece INC went to apply for TM and tried to register master piece living and both were denied on Alavida’s TM
       2. INC tried to get Alavida’s TM expunged
    2. ISSUE?
       1. Whether TM in mater piece living registered by A was confusing with unregistered mark of MINC?
    3. RATIO
       1. Court stated factors to look at
          1. **Is geography relevant when performing confusion analysis?**

The location where a mark is used is not relevant when considering the likelihood of confusion between a mark that is registered (or for which an application for registration has been made) and a prior unregistered mark.

* + - * 1. **How to assess the resemblance between a proposed use TM and an existing unregistered TM**

Separate analyses wrt each of TMs, TNs (paras. 42-48)

*If question is whether TM is confusing with another TM or trade Name, then you have to take separate confusion analysis to each TM/TN. If applying for TM consider factors 1-4, for each one.*

**Factor w. greatest impact on conf. analysis – degree of resemblance (paras. 49-50)**

*Degree of resembalance is likely to have greatest effect and other factors are only significant once marks are found to be identical or similar.*

*Start analysis with degree of resemblance, if there is none than you can stop there.*

**Focus on full scope of possible uses of registered TM, not actual use (paras. 51-59)**

*When considering when TM has applied is confusing consider entire scope of exclusive rights that would be granted to it under its registration. Need to consider not the use that has been made of mark BUT range of use that has been possible.*

*If unregistered mark consider how mark has been used because all that is attached is good will with registeretration you get mark and all variation of it.*

***Is aspect of mark striking or unique.***

* + - * 1. **Impact of the nature and cost of wares and services on the confusion analysis**

The test is one of first impression (even if consumers shopping for expensive wares or services might be more alert, aware of TMs)

Expensive goods 🡪 not relevant because not likely to make choice based on first impression

Careful research, which may later remedy confusion, does not mean that no confusion ever existed or that it will not continue to exist in the minds of consumers who did not carry out that research. (para. 72)

*SCC assume that more care might include research or inquire after person encounters TM. Court wanted to correct this issue because more discerning the fictional test consumer to do research after the fact the more difficult it is to establish confusion.*

*Careful research might rememdy confusion. The test of first impression can differ if looking at expensive good or mild price thing.*

*Doesn’t matter what consumer does after mark it is also not relevant with expensive good not likely to make choice based on first impression.*

* + - * 1. **Relevance of expert evidence**

TJ’s should question necessity and relevance of expert evidence before admitting it (para. 99)

Judges should use their own common sense to determine whether the casual consumer would likely be confused in cases of wares or services being marketed to the general public (para. 92)

Surveys can be valuable (para. 93)

*Found that expert evidence is unhelpful. Wanted to impose test of necessity relevance but surveys they could continue to be valid.*

*Expert evidence not useful.*

*Use of survey in proposed use and actual use.*

* + 1. **Party wasn’t entitled to secure registration under 18(1) because it wasn’t party entitled to register mark. Master succeeded and as a result the registar was ordered to expunge registration**

# T’marks: infringement and remedies

## Infringement

* 1. 4 main provisions that address infringement
     1. s.7 = provides protection against passing off; applies to both registered and unregistered marks
     2. s.19; governs use of precise TM registered for same wares and services
     3. s.20: deals with confusing uses of TMs
     4. s.22: governs uses that depreciate value of goodwill

### S.19

* 1. Definition
     1. Governs use of precise TM registered for **same wares and services**
        1. Owner of TM has exclusive right to use in Canada but only applies in limited circumstances
           1. Has to be exactly same mark in which **original mark is registered.** *If someone uses coca-cola for couches ≠ s.19 protection*

Eg: Coca-cola…creating another coke product with same name.

* 1. S.19 is subject so ss.21,32,67
     1. S.21 = compromise provision
        1. Honest, concurrent use of the mark
           1. *Ex. Company X creates TM registered mark praire for luggae, Company Y has been using same mark for same thing at an earlier date but didn’t register. Company Y sues for TM infringement for registration of mark.*

See. If s.18 + s.17(2) = have 5 years to object registration of mark on basis of prior use

Apply s.21 🡪 allows use unless it is **confusing.** [consider s. 6(2) + 6(5)]

* + - 1. S.21 allows court to carve out space for a party’s continuing use of a mark BUT has to be distinguishing to ensure no **confusion** with public

### S.20 = confusing use of TM

* 1. Definition
     1. Covers 2 types of situations
        1. Where a similar but not identical TM is used
           1. *Eg. Coca cola vs coca colla*
        2. Where the identical TM is used, but with respect to wares and services for which the original TM is not registered
           1. *Eg. Coca cola used for chair*
        3. Consider 6(2) + 6(5)

### S. 22= goodwill

* 1. Definition
     1. Governs use that depreciate value of goodwill 🡪 don’t need confusion
     2. Governs use of mark that has effect of depreciating value of goodwill of that mark

#### S.19+s.22: Case Example: Clairol

* + 1. Argued infringement of s.19 +22
       1. S.19 Analysis
          1. In order to infringe apply s.19 [s.2 + s.4]

S.2 = what does “use” mean in s.19 🡪 leads to s.4(1) association with wares or 4(2) association with services

* + - 1. S. 22
         1. Define use in s. 2 + 4(1) or 4(2)
         2. TEST

If there is use, then the test becomes whether the use is likely to depreciate the value of the goodwill attaching to the mark [by reducing the esteem in which the mark is held; or enticing customers away]

* + 1. Analysis
       1. S.19
          1. Court found that s.19 infringement was not made out since it was clear that D was not pretending to be the P or creating an impression that it is P’s product at a discounted price. It was just showing that if you buy D’s product and relevant to P’s product.
          2. To infringe s.19

S.2 +4

Applies only where someone uses the mark as registered; in association with goods or services for which it is registered

* + - 1. S.22
         1. To infringe s.22

D must have used the mark s. 2 + 4

If there is use….test becomes whether the use is likely to depreciate the value of the goodwill attaching to the mark by reducing esteem in which the mark is held or enticing customers away

* + - 1. TEST:
         1. S.22 if there is use then the test becomes **whether the use is likely to depreciate the value of the goodwill attaching to the mark by reducing esteem in which the mark is held; or enticing customers away**
         2. What goodwill attached to TM

Court defines goodwill consist of advantage that has been built up from honest, work, trade, money to promote the product. It can depreciate by reducing the esteem for which mark is held and by enticing customers away.

* + - * 1. Court states it is legitimate for business to attract customers but must do so in honest means

Information of wares by stating your wares are in preference of other TM, but cant put competitor TM to entice customers away.

* + - 1. RATIO
         1. Court found that under s. 22, the D used P’s name in package was an infringement but not on the brochure
         2. Court stated that their needs to be honest means to attract customers but cant put competitors TM to entice customers away which is what happened in this case.

The competitors TM was used in package = violation of s.22 because they were trying to get customers to switch at no cost to the customer.

* + - * 1. By using comparing products in Ads, Brochures = no use under s.4 BUT on the actual product = USE
        2. Can have comparison with respect to product but now with services.
      1. Use on brochure didn’t violate s. 22 because putting mark on brochure isn’t using it in association with ares.

#### S.22 Case Example: Future Shop v A&B Sound

* + 1. FACTS:
       1. AB sound put up price comparison with Future Shop, who wasn’t happy because there prices were more expensive and sued for TM infringement in violation of s.22.
    2. ISSUE?
       1. Was there infringement of s.22
    3. RATIO
       1. Court stated that public has interest in comparative advertising and helps consumers make a better choice.
       2. If you are using s.22 that stresses similarities by enticing customers away from P then violation of s.22
       3. If you are stressing difference between the 2 marks and distancing yourself from the TM of the competitor = s.22 would not be offend.
       4. Showing similarities = violation of s.22/ showing difference = no violation of s.22

#### S.22Veuve Clicquot v Boutiques Cliquot – S.22 TEST TODAY

* 1. Facts:
     1. French champagne wanted to TM Veuvue which was similar to a female clothing boutique. P claimed that there was confusion between the two marks
     2. Confusion s. 6(2) analysis + s.22
  2. Issue
     1. Was there confusion and depreciation of goodwill?
  3. ANALYSIS
     1. Court found little confusion to source and did not violate s.22.
     2. Court stated that mere mental association of the 2 marks doesn’t give rise to likelihood of depreciation.
     3. S.22 = super weapon
        1. Which in interest of fair competition needs to be kept in check and could apply to a wide range of circumstances. Court main purpose of TM law is to protect mark as a representative of a source.
        2. Need to prove dilution by evidence
     4. TEST
        1. **4 elements**
           1. **was the Ps registered TM used in connection with the D’s wares or services in a way that gives notice of the association?**

S.4 – define use

Would a casual observer recognize the mark used by the D as the mark of the P

*Judge held that person wouldn’t make association between the 2 marks and no use with respect to s.4*

* + - * 1. **Is P’s registered TM sufficiently well-known to have significant goodwill attached to it?**

Goodwill = positive association that attracts customers towards its owner’s wares or services

How to determine how much goodwill exists in a mark recognition of the mark within the relevant universe of consumers, the volume of sales and the depth of market penetration of products associated with the claimant’s mark, the extent and duration of advertising and publicity accorded the claimant’s mark, the geographic reach of the claimant’s mark, its degree of inherent or acquired distinctiveness, whether products associated with the claimant’s mark are confined to a narrow or specialized channel of trade, or move in multiple channels, and the extent to which the mark is identified with a particular quality.[PARA 54]

*Court found there is substantial goodwill attached to mark and extends beyond*

* + - * 1. **Is the P’s mark used in a manner likely to have an effect on that goodwill?**

P has to prove a connection or linkage made by consumers between the P’s goodwill and the defendants use

*Trial judge found that the hurried customer wouldn’t associate the 2 marks and if there is no association = no impact on goodwill*

* + - * 1. **Is the likely effect to depreciate the value of the goodwill?**

Depreicate = lower the value of; to disparage, belittle underrate

Lower value

Loss of distinctiveness

Used by other people

Dilution [blurring of brand image]

Harm in association between consumers mark and different good or servi e

Disparage

Tarnish; creation of negative association

2 primary ways of how depreciation occurs but not limited to only those 2 areas. Have to show that it is **likely to occur**

*in this case the casual consumer wouldn’t associate the 2 so s.22 element weren’t established.*

## Remedies

* 1. S. 53.2 + s.2 “interested person”
     1. Injunction
     2. Damages
        1. Compensating for lost sales, damage to goodwill, loss of control of reputation
     3. Account of profits [alternative to damages]
     4. Destruction of offending materials
     5. Removal of mark from wares
     6. Concealment of mark on wares
     7. Punitive damages.

# Patents: introduction, Patents: what is patentable subject matter

## Patents Introduction

* 1. S.91 (22)- Federal Government
     1. Has exclusive authority, enacted through **Patent Act**
  2. Definition
     1. A limited term monopoly for an **invention**; the right, given to an inventor by the government to exclude others from making, using or selling ones invention from the day the patent is granted.
        1. *Right to exclude*
        2. *Person entitled to benefit = patentee and can only get patent for inventions, has to be novel, useful, and non obvious.*
  3. Can only patent inventions
  4. Term of protection : 20 years [ss.44,46]
  5. Has to be novel, useful, and non obvious
  6. Have to take active steps to get specific patent for invention
  7. Balance of Patent law
     1. At its core, a bargain between the inventor and the public;
        1. One party discloses an invention in exchange for 17/20 year monopoly period in which to make, use, and sell the invention.
     2. Case Example TEVA
        1. Invalidated Pfizer a top drug because it failed to disclose sufficient information of invention. Invalidation is significant and underscores the idea of bargain and talks about consequences of not upholding the information to publicly disclose.
        2. Public gets to look at disclosure documents 18 months after patent filing date.
        3. Patent System is quid pro quo
           1. Not intended as an accolade or civic award for ingenuity. It is a method by which inventive solutions to practical problems are coaxed into the public domain by the promise of a limited monopoly for a limited time.

In order for society to benefit need to make information public

Patent bargain = certain benefits conferred on society

Encourages innovation

* + - 1. Patent specification- heart of the disclosure requirement
      2. Incentive not to disclose
         1. If you give enough information to ensure it is granted but not enough to make patent—benefit of both worlds to preserve secrecy.

### Patent Act [Insert Examples]

* + 1. **S.2 Patent Act**
       1. Can only patent an “invention”
          1. **“Invention”** means any **new and useful art, process, machine, manufacture or composition of matter,** or any new and useful **improvement** in any art, process, machine, manufacture or composition of matter;

*Amazon Canada Case: states that a patent application must be refused if claim construed describes something outside of the numerated categories in the definition of invention*

*Similar to copyright*

* + - * 1. **Composition of matter:**

Refers to combination of ingredients, whether combined as a chemical union or a physical mixture and includes chemical compounds, compositions and substances.

Eg: a phase of cubic silicon; and a phase comprising a first element other then silicon, arranged in eutectic aggregation with phase of cubic silicon.

#### Case Example: Harvard College

Facts:

Mouse genetically modified for cancer patentable?

Ratio

Principle applied: A collective term that completes an enumeration is often restricted to the same genus as those words, even though the collective term may ordinary have a much broader meaning. A higher form of life is not a composition of matter.

Argued that definition need to be more narrow for composition of matter. A higher life form is not a composition of matter which is inline with the dictionary definition.

Dissent:

composition of matter is an open-ended expression. Defintion of invention is not expressly confided to inanimate matter. And is a composition of matter. “We should not encourage the Commissioner to try to circle each of the five definitional words with tight language that creates arbitrary gaps between, for example, “manufacture” and “composition of matter” through which useful inventions can fall out of the realm of patentability

* + - * 1. **Manufacture:**

Process of making [by hand, machine, industrially, by mass production] technical articles or material [in modern use on a large scale] by the application of physical labour or mechanical power; or the article or material made by such a process [case example: Harvard College]

Eg:an article manufacture, comprising; polymer, and digitally encoded image made with ink

#### Case Example: Harvard College

Majority: Manufacture = non-living mechanistic product or process

Mouse cane be manufactured, because manufactured is something made with hands of man

Dissent: We should not encourage the commissioner to try to circle each of the 5 definitional words with tight language that creates arbitrary gaps between for example, manufacture and composition of matter, through which useful inventions can fall out of the realm of patentability

* + - * 1. **Machine**

The mechanical embodiment of any function or mode of operation designed to accomplish a particular effect [Amazon case- one click buying option]

Eg: smart phones may embody many different machines of functions or mode of operation design to accomplish a particular effect = patent thickets

Eg: a food article slicing machine comprising; a slicing station a knife blade…

Eg. Chair

Laptop/TV/

#### Case Example: Amazon

One click ordering system

Can include machine which may embody many different machines of function or mode of operation designed to accomplish a particular effect.

* + - * 1. **Art**

The application of knowledge to effect a desired result; must be defined in a way that gives practical effect to the knowledge. [medication]

Eg: Requesting prior art from the public in exchange for a reward

*Method*

Eg: use of non-fired refractory products as a lining of large-volume industrial furnaces and industrial furnaces lined with the non-fired refractory prodcuts

*Use*

A method or use

**Use:** application of certain **means** to achieve a specific result

Eg: a known drug applied to treat a known disease.

*Must be practical application of knowledge*

**Practical/Method**: an act or series of acts performed by some…object and producing in that object some change of either character or condition

Eg: Defined in manual

*TEST for art as method*

Must not be a disembodied idea but have a method of practical application

Must be a new and inventive method of applying skill and knowledge

Must have a commercially useful result.

Can get patent for method **or** use.

Eg: requesting prior art from the public in exchange for a reward

Use of non-fired refractory products as lining of large volume industrial furnaces and industrial furances lined with non-fired refractory products = use

* + - * 1. **Process**

A process can be considered to be a mode or method of operation by which a result of effect is produced by physical or chemical action, by the operation or application of some element or power of nature or one substance to another.

Eg: process of removing calcium and obtaining sulfate salts from an aqueous sugar solution’

Way to characterize a specific process

### Legislation

* + 1. s.28.3
       1. Invention cannot be **obvious** on the date claimed to a person skilled in the art or science to which it pertains, having regard to
          1. (a/b): Information disclosed more than 1 year before filing by the applicant to anyone either by the applicant or someone else, and became available to the public or Canada or elsewhere
    2. s.44/46
       1. 44: patent terms = 20 year from filing
       2. 46: patentee has to pay fees for such periods. (2) if not paid the term of the patent expires end of that time.
  1. Policy Question: right balance struck between protections?
     1. *No requirement for protection except X has to take active steps to get patent for invention. At its core, it is a bargain between the inventor and the public. One party discloses an invention in exchange for a 17/20 year monopoly period in which to make, use, and sell invention*.

#### Case Example: Teva Canada v Pfizer Canada- Patent Definition

* + 1. Facts:
       1. T had patent for Viagra, argued that P was not valid due to insufficient information.
    2. Issue:
       1. Did P have a patent for failure to disclose all relevant information
    3. Ratio:
       1. Court said purpose of s.27(3) outlines; what the invention is and how it works
       2. Court said patent system is a quid pro quo which grants inventer exclusive rights for new useful invention for limited period in exchange for disclosure of the invention so society can benefit from novel. It is a method by which inventive solutions to practical problems are coaxed into the public domain by the promise of a limited monopoly for a limited time.
       3. Patent specification is at the heart of the disclosure requirement.

#### Case Example: Diamond – Patent Definition

* + 1. Facts:
       1. Deals with patentability of generic bacteria to break down crude oil spills
    2. RATIO
       1. Courts stated that anything made by men under the sun is not the right approach regarding patents.
       2. Stated that an invention should be defined broadly but not unlimited and that some subject matter can be outside the scope of protection. The purpose of it being broad is to promote inventions for unforeseen innovative technology. It was intention of parliament that some subject matter would not be in scope of patent protection.

### Improvements [s.32]- SELECTION PATENTS

* 1. **Improvement**
     1. Any person who has invented any improvement on any patent may obtain a patent for the improvement, but does not obtain the right of using the original invention, nor does the patent for the original invention have right using the improved patent [S.32]
     2. Eg: Multiple call handling in a call center
        1. In a call center having an automatic call distributor for routing directed calls and a plurality of call-receiving devices, the improvement comprising; creating a first route point in the call center devoid of a queue statement that would direct calls routed to the firt rout point away from the first route point, so that the ACD loses control over distributing of the calls that are routed to the first route point for at least a first period of time;
  2. **Pharmaceutical industry**
     1. Set of ingredients can be improved by selecting a subset of ingredients that are more efficacious or safe then the entire class of ingredients. [selection patents granted for this type of improvement]
     2. **Selection Patents**

#### Case Example: Apotex v Sanafi

* + - * 1. **Condition for selection patents: Requirement**

Must be a **substantial advantage** to be secured or disadvantage to be avoided by the use of the selected members

The whole of the selected members possess the advantage in question

Where are you drawing a circle around the subset of ingredients you select

The selection must be in respect of a quality of a special character peculiar to the selected group

Allowed to have improvement if you can show that compound has further advantage then larger compounds.

* + - * 1. *Evergreen a patent: a term raised by individuals action of certain pharmacy companies that try to get patent for small improvements and extend it in a way that is less legitimate then otherwise would be possible.*
        2. *Case reveals:*

Case confirms that selection patents are not invalid in principle they are a thing and are valid and sets out conditions for which have to be satisfied for selection patent to be valid

This test gets at where we draw the line; make sure you are drawing the line that is not over broad.

# Non patentable subject matter

## Mere scientific principle or abstract theorem – Purposive [Canada] Literal [no]

* 1. S.27(8)
     1. No patent for principle or abstract theory
        1. Natural phenomena and laws of nature
           1. Laws of gravity/physicals = specifically excluded
        2. Abstract theorem
           1. Math expressed in formula = excluded
  2. Computer programs?
     1. Historically computer programs are not patentable because they are mathematical algorithms based on s.27(8)

#### Case: Example Schlumberger v Canada

* + - 1. Facts:
         1. Wanted to patent a user friendly computer program regarding oil and class.
      2. Ratio
         1. Court stated that the process of carrying out calculations was not patentable because they are mathematical formula

#### Case example: Motorola Inc. – How to patent computer programs

* + - 1. Ratio
         1. Case allowed to patent a mathematical algorithm by claiming it was part of a machine [the computer] that performs calculation.
         2. **If a novel algorithm is embodied in firmware or hardware it will not be characterized as abstract and will be patentable**.

#### Case example: amazon Canada patent of business method- Purposive approach vs Literal

* + - 1. Facts:
         1. Amazon applied for patent for one click purchase and applied for patent.
      2. Reasoning
         1. Court stated that in order to determine actual invention of a patentable subject **have to use a purposive** construction of the patent claim **not literal**

*Interpret in broad manner according to the actual goal of the invention itself.*

*ADD LITERAL APPROACH*

* + - * 1. To avoid patenting a mere idea or discovery, the claimed invention must have some **physical existence that manifests a discernible effect or change**. This is not met by virtue of the fact that the claimed invention have a practical application

**In order to patent idea needs some sort of physical existence that manifests a discernable effect or change.**

*Abstract idea becomes patentable because it has practical embodiment—but test is ineffective because any business method is practical*

* + - * 1. Claim will fail if it is only mathematical component, instead if it is one piece of a practical component, can still get patent.
        2. Patent achieved
    1. Mathematical formula in computer system = patentable, but if it is just an algorism = no patent.
  1. Requirement
     1. Where a computer is found to be an essential element of a construed claim, the claimed subject matter will generally be statutory. A good indicator that a claim is directed to statutory subject matter is that it **provides a technical solution to a technical problem.**

## Professional arts/skills

* 1. Overview
     1. Professional skills are not patentable, and not included in art or process because they reflect the personal knowledge and capacities that one would expect from anyone skilled in their field.

#### Case Example: Lawson v Canada

* + 1. Fact:
       1. Can you patent a skill of subdividing land that increases density
    2. Ratio
       1. The professional skill of surgeon or barrister are not proper subject matter for patent, so the skill of subdividing = a professional skill which is not patentable
       2. Don’t want to create a monopoly in skills that we would prefer many individuals to use.
          1. *Art = practical application of knowledge—defined in some ways as a manner to exclude skills of individuals in a professional business aspect as opposed to hobby.*

## Higher life forms

* 1. Overview
     1. Lower life forms are patentable subject matters
        1. Micro organisms, yeasts, moulds, fungi, bacteria, unicellular algaie, cell lines, viruses, or protozoa = composite of matter
     2. Higher life forms are not patentable subject matter
        1. Seeds, plants, animal

#### Case Example: Harvard College

* + 1. Facts:
       1. Case involving mouse
    2. Ratio
       1. Majority:
          1. Common sense difference between lower and higher life forms. Higher life form is more connected to humans and only parliament can extent patent protection to plants and animals.

**Exception: fertilized mouse egg is patentable**

* + - * 1. Legislation doesn’t include life form that can get up and walk away and if it doesn’t deal with higher life form than it shouldn’t be patentable. There is a common sense difference between the two.
        2. Can patent lower life forms—produced as chemical compounds and prepared and formed in such large numbers that any measurable form and characteristics should come in stat subject matter

Yeast, mould, viruses, etc.

* + - * 1. ACCEPTS that fertilized egg = patentable BUT NOT MOUSE
      1. Dissent
         1. Focus; innovation, public policy, keeping up with other nations in the innovation economy. Nothing in patent act to support conclusion that non-human life forms were intended to be excluded from the definition of invention and the legislators should draw this line.
         2. Wanted to refused to interpret legislation expansively, but there are social benefits. There is nothing in patent act that non-human life was intended to be excluded from invention.

## Methods of medical or surgical treatment

* 1. Overview
     1. New surgical methods are not patentable and flows from public policy ethical position

#### Case example: Tennesse Eastman V Canada

* + 1. Ratio
       1. Not in public interest to grant a monopoly on the use of the material and thus hamper the medical profession
  1. Ways to get around it
     1. Methods of medical or surgical treatment
        1. The use of Drug X for treating cancer in humans = acceptable
     2. Swiss use claim
        1. The use of a {known product} X for the manufacture of medicine for the {new] therapeutic treatment of Y = acceptable
  2. Definition
     1. If the essential aspect of your patent claim instructs a medical professional **how to treat a patent, then it is a method of medical treatment and not patentable**.
     2. If the essential aspect of your patent claim instructs a medical professional **on what to use to treat a patient, then it is patentable subject matter.**
        1. *drug is good at treating depression and good at treating OCD and is a method of treating in humans* ***due to specific does schedule*** *= rejection*
        2. ***use of drug*** *Z treating depressions in humans = acceptable*
           1. Use of Z for manufacture of medicine for new therapeutic treatment of depression

# Patents: the requirements of patentability

## Utility

* 1. Overview
     1. Utility = requirement for patentability
        1. It prevents stock piling of inventions of patents
        2. Utility requirement means the invention works and does what it claims it does
        3. Not patentable until you discover a use or utility for patent
           1. If you draft too broadly then it may be struck down!
     2. Need to consider the filing date or claim date in order to determine relevant date for consideration of utility

### Requirement

* + 1. Does the invention do what the patent says it will do [Teva]
    2. Relevant date for consideration of utility = PRIORITY DATE OF THE CANADIAN PATENT APPLICATION
       1. Need to have utility on priority date, IF NOT
       2. Then there needs to be a sound prediction
  1. S.43(2)
     1. Patents issued = valid. Have to satisfy court that patent is invalid on balance of probabilities
        1. Show that the patent doesn’t do what it says it will do

#### Case example: Apotex v Wellcom- SOUND PREDICTION

* + 1. Facts:
       1. 2 generic drug manufacturing companies are appealing a decision from federal court regarding validity of patent of AZD. The argument was based on **lack of utility** and that it couldn’t established that the invention actually worked or did what it claimed it to do because clinical testing of the drug hadn’t been complete before the priority date of application. Apotex stated Welcome shouldn’t have obtained patent protection as a shot in the dark due to inadequate testing that it could be used for HIV.
    2. Issue:
       1. Should Wellcome have been able to obtain patent protection based on its shot in the dark?
    3. Ratio
       1. SCC: where the new use is the essence of the invention, utility, as of the priority date must either be demonstrated or be a sound prediction based on information and expertise then available.
       2. Evidence cited at trial showed that once priority application was filed there was sound prediction that it was useful.

##### Test: Sound Prediction

* + - 1. **There must be a factual basis for the prediction**
      2. The inventor must have, **at the date of the patent application**, an articulated and **sound** line **of reasoning** from which the desired result can be inferred from the factual basis
      3. There must be a full, clear, and exact description of the nature of the invention and the manner in which it can be practiced, but it is generally not necessary to provide a theory of why the invention works
    1. Court stated that soundness of each predication is question of fact and discipline involved. Not all sound predictions are going to be correct. If D prediction showed to be wrong and lack of utility, the patent would be invalid. Court found D met the burden for showing sound predicition

## Novelty/Anticipation

* 1. Overview
     1. Has the invention been disclosed in some way prior to the date of the patent claim
     2. If patent is not novel then patent will not be issued.
     3. Did someone invent it before you?
  2. S.28.2
     1. Only get patent for an invention that is new
     2. **Prior art [invention existed before]**
        1. Material which may disclose invention which you’re claiming was invented or existed before the patent claim
        2. If established 🡪 renders patent invalid

### #1: Filing date v Claim Date

* + 1. Filing date:
       1. s.28(1)
          1. Date on which the commission receives certain documents, information and fees
    2. Claim date:
       1. Each claim has a claim date;
       2. Establishes the date for determining the patentability of the invention defined by the claim
  1. S.28.1
     1. **Claim date normally the filing date EXCEPT**
        1. Where person who has filed the application has previously filed an application for a patent, which disclosed the subject matter of **that** same claim.
  2. **S.28.1(1)(a)(i)- could be previously filled date**
     1. Claim date could be the date of a previously filed application in canada where the filing date of the most recent application is **within 12 months** from the date of the filing date of **previously filed application**
        1. Claim date can = first filing date within 12 month period only
     2. S.28.4(1) PRIORITY REQUEST
        1. In order to get previously filed date to be the claim date have to make a **priority request** on the basis of a previously filed application
           1. *Might not want later date due to novelty*
  3. **S.28.1(1)(a)(ii) foreign filings section+ Priority Request**
     1. If person has filed an application for the **same** invention in **another treaty country** under s.28.1(1)(b) and (c),
     2. If the 2nd filing is within 12 months of the first filing **and if** the applicant has made a **request** for priority on the basis of the **previously regularly filed** application, then the first date can be the claim date
        1. *Ex: filing in USA on Jan 1, then filing in Canada on Aug 1. As long as Canadian filing is within 12 months, then first date becomes Canadian claim date*
        2. Only get patent protection in country you have filed in.
     3. Policy Issue: Patent vs Copyright
        1. Copyright—once you satisfy all requirement of copyright protection get protection world wide, where as with patent protection doesn’t go from country to country
  4. 28.1(1)(b)
  5. 28.1(1)(c)

### #2: Prior art disclosure

* + 1. 28.2(1)(b)
       1. the subject matter defined by a claim in an application for a patent in Canada [the pending application] must not have been **disclosed**
          1. (a): either the applicant or person who obtains information for the applicant [*person unaffiliated with patent*
          2. (b) **before the claim** date by a person not mentioned in paragraph (a)in such a manner that the subject matter became available to the public in Canada or elsewhere
    2. 28.2(1)(d):🡪 prior art amount to disclosure
       1. Where **someone else has filed an application** for a patent in Canada with a **filing date after your claim date**,
       2. Where that other party has another date prior to the claim date of your application that they can rely upon under s.28.1
       3. Where this date is within 12 months of the Canadian filing date
       4. And where the other party has request priority based on their earlier filing date
          1. Is invention new?

*Ex: A file for patent in US on Mar 2. A files for Canada in June, wants to use priority for claim date = Mar 2 in Canada*

*Ex: B files for patent in Feb in Germany. B files for patent in Canada in August. Claims German filing date as claim date. B = priority for invention because before A’s.*

*A’s patent void for novelty*.

### #2(a): When has anticipation/novelty occurred?

* + 1. Lack of novelty is only found when invention has been **disclosed** in a single publication/use
    2. This publication must disclose the invention without mosaicking references
    3. Commonly occurs through publication
    4. Other ways
       1. Display of invention in a public place
       2. Sale of the invention
       3. Use of the invention
       4. Conference presentation
       5. Disclosure online
       6. Filing of earlier patent application in Canada or else where s.28.2

#### Case example: Apotex v Sanofi- TEST FOR NOVELTY/ANTICIPATION

* + 1. Facts:
       1. Claimed one of S’s patent was invalid due to a lack of novelty
    2. Test for novelty/anticipation
       1. **Prior disclosure**
          1. Prior patent must disclose subject matter, which if performed, would necessarily result in infringement of that patent

At this stage, the skilled person is simply reading the prior patent for the purposes of understanding it

There is no room for trial and error or experimentation by the skilled person.

***Did prior patent disclose subject matter result?***

Yes = enablement

No= stop here

* + - 1. **Enablement**
         1. Would the person skilled in the art have been able to perform the invention?

Look at enablement in respect to patent as a whole

Specification and entire claim/patent

**Skilled person who is fictional person, can use common general knowledge to supplement information contained in prior patent**

Prior patent must provide enough information to allow subsequently claimed invention to be performed without **undue buden**

If invention takes place in technological, where there are experiments = higher burden

If less effort is normal = lower threshold.

* + 1. Analysis
       1. Court found that it didn’t disclose and as a result the patent was not anticipated.

#### Case Example: Availble to public Baker Petrolie v Canwell-Enviro

* + - 1. Case gives 8 different situations where novelty becomes available to the public
      2. TEST:
         1. Sales to the public or use by the public alone is insufficient to prove novelty. Disclosure is required.

Use constitutes disclosure only so far as it makes information available about the invention

Prior disclosure

* + - * 1. For a prior sale or use to anticipate an invention, it must amount to enabling disclosure

Enablement – Step 2

* + - 1. Examples
         1. The prior sale or use of a chemical product will constitute enabling disclosure to the public if its composition can be discovered through analysis of the product

If you can take a look at product and if you find out its composition that will constitute enabling disclosure and anticipation

* + - * 1. The analysis must be able to be performed by a person skilled in the art in accordance with known analytical techniques available at the relevant time [and without the exercise of inventive skill]

A prior sale will enable disclosure if you can discover it

How to determine if you can discover it:

Using a skilled person of art acting in accordance with known technique is the person to use and cant use inventive skills

* + - * 1. Where reverse engineering is necessary and capable of discovering the invention, an invention becomes available to the public if a product containing the invention is sold to any member of the public who is free to use it as she or he pleases [s.28.2(1)(a))

If there is confidential agreement or restriction to access then this wouldn’t be seen as available to public

When reverse engineering involved it becomes public when it is free to use as they please

* + - * 1. It is not necessary to demonstrate that a member of the public actually analyze the product that was sold

As long as it is possible to analyze..disclose anticipated

* + - * 1. The amount of time and work involved in conducting the analysis is not determinative of whether a skilled person could discover the invention. The relevant consideration in this respect is only where inventive skill was required.

Amount of time is not determinative of skilled person to discover invention

Q: is whether inventive skill is required –what extent is this party able to use and make invention itself

* + - * 1. It is not necessary that the product that is the subject of the analysis be capable of exact reproduction. It is the subject matter of the patent claim [the invention] that must be disclosed through the analysis. Novelty of the claimed invention is destroyed if there is disclosure of an embodiment which falls within the claim.

Has there been disclosure of the key inventive concept or substance of the claim itself.

If there has and if there is enablement then there will be anticipation and patent wont be valid

Is subject matter of patent claim disclosed through analysis.

1. DIFFERENCES
   1. Between Novelty and Obviousness
      1. Novelty: cant mosaic🡪 have to find it within one paper
      2. Obviousness: could the unimaginative skilled person have taken all of the pieces, and using reasonable deduction, have arrived at this invention?

## Obviousness

* 1. Overview:
     1. If patent is obvious = not patentable
     2. Purpose of patent law is to reward for inventions for full disclosre of invention. If invention is obvious there is no need to get a 20 year monopoly.
     3. TEST PERSON:
        1. **POSITA- Person ordinarily skilled in the art**
           1. Would the person skilled in the relevant art and science, based on their skill and knowledge but without a scintilla of imagination have been led to this invention?
  2. #1: S.28.3 = What qualifies as prior art [previous invention]
     1. **Test person**: would the person skilled in the relevant art and science to which patent pertains, based on their skill and knowledge but without a scintilla of imagination have been led to this invention?
        1. *If inventor discloses information before 1 year of filing application = prior art and is obvious*
        2. *Or if any person who discloses information before the claim date before information becomes public*
           1. *Research assistant.*

#### Case example: Apotex v Sanofi

* + 1. TEST:
       1. **Requirement for obviousness**
          1. Was the invention obvious to try [POISTA]

There must be evidence to convince a judge on a balance of probabilities that it was more or less self evidence to try and obtain the invention

Mere possibility that something might turn up is not enough

* + - * 1. **POSITA def’n + Need to identify person + common knowledge of that person**
      1. **Obviousness inquiry TEST**
         1. POSITA: would the person skilled in the relevant art and science based on their skill and knowledge but without a scintilla of imagination have been led to this invention?

Identify the notional person skilled in the art

Identify the relevant common general knowledge of that person

* + - * 1. Identify the inventive concept of the claim in question or construe it

What is the claim they are making?

* + - * 1. Identify what, if any differences between the matter cited as forming part of the state of the art and the inventive concept of the claim as construed

Difference between the 2 claims and state of art?

* + - * 1. Viewed without knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention

Once you know difference would they be obvious to the POSITA? Look at additional factors below

Is it more or less self-evidence that what is being tried ought to work?

Is it obvious?

What is the extent, nature and amount of effort required to carry out the invention

Obvious to try?

Is there a motive provided in the prior art to find the solution the patent addresses

Has there been a need to deal with this issue that non one has managed to deal with it?

Look at the history of the invention.

Did invention or routine invention easily or quickly or with time money and effort looking for result?

How skilled was team

How did they arrive at result?

* + 1. Decision
       1. After apply 4 part test, held that when all factors are considered the invention was not self evident and common general knowledge to satisfy test.

# Patents: misc patent topics

## Application Process

* 1. Complete application—if maintenance fee not paid, patent application = dead
     1. Petition
        1. Formal request for patent
        2. List application & invention
        3. Identify patent agent if you have one
     2. Abstract
        1. Short technical summary of the invention
        2. Include statement of the use of the invention
     3. Specification
        1. Description
           1. Bulk of application process; includes background information relevant to invention + describes invention in levels of detail
           2. *Goal: to allow POSITA to reproduce the invention just from reading the description and looking at the drawings*
        2. Claims
           1. IMPORTANT—legal basis for protection
           2. Several claims for each patent
           3. S.27(3): Requirement for specification of invention

Application has to be truthful

* + - * 1. S.53(1)

Patent is void if any material allegation in the ptetition is untrue or if specification in drawing contain more or less than is necessary and the omission or the addition is willfully made for the purpose of misleading

* + 1. Drawings
       1. Must be included so that it’s easier to understand the patent itself if your invention can be illustrated visually
    2. Final step
       1. File for patent and pay required fees
       2. $400 standard fee—reduced for small entities’

##### Policy Question: How can patent encourage innovation

* + 1. Decrease application fee; increase the term of protection; perhaps modify the patent system isn’t the answer. Tax incentives

### After filing for patent

* + 1. 10 months after relevant date, application is open for public inspection
       1. s.10(2)
    2. Continue to pay maintenance fee
    3. Request examination if you choose
       1. S.35(1)
    4. Objections
       1. Patent office & applicant to exchange “OFFICE ACTIONS AND RESPONSES” until it is allowed or rejected or you abandon
          1. If you reject: gets forward to patent review board for review

Commissioner is required to refuse application if your not entitled to be granted a patent [don’t satisfy requirement of Patent Act[

* + - * 1. If approved; patent granted
      1. You can appeal refusal to federal court
      2. S.53
         1. Valid claims survive in the face of invalid claims

You request examination, its reviewed, the object to certain claims but that doesn’t mean that your entire application is invalid.

## Disclosure Requirements

#### Case Example: Teva Canada

* + 1. Disclosure requirements [s.27(3)]
       1. Define the nature of the invention
          1. Must consider specification as a whole, look at the patent as a whole to determine nature of the invention
          2. Patent is granted for only one invention only
       2. Does the specification correctly and fully describe the invention
          1. Act requires the courts consider the specification as a whole to determine whether the disclosure of the invention is sufficient
          2. Question to ask; does the specification [claims & disclosure] define the precise and exact extent of the privilege being claims so as to ensure that the public can, having only the specification, make the same use of the invention as the inventor
          3. What would a skilled person consider to be sufficient?
    2. Decision
       1. Court found that P failed to meet disclosure requirement because further testing would have been required to determine which compound was effective. Specification did not indicate S is the effective compound. All other compounds claimed were found to be not effective.
       2. P had information needed to disclose useful compound and chose not to release it, as a matter of policy and sound statutory interpretation, patentees cannot benefit this way.

## Patent Terms

* 1. Legislation
     1. S.44
        1. 20 years from filing date of patent --s.46 as long as maintenance fees are continued to be pay
     2. s.49
        1. assigned of the right to obtain a patent
     3. s.50
        1. assignment must be in writing and signed

### Rights of patent owner

* + 1. S.42
       1. Right to make the invention
       2. Right to construct the invention
       3. Right to use the invention

#### Case Example: Monsanto Canada v Schmeiser

* + - 1. Facts:
         1. S was caught using seeds without authorization; argued seeds were just blown onto his land by wind and that he hadn’t used it to produce canola.
      2. Issue:
         1. Whether S made or used the gene and cell?
         2. Did the D’s activity deprive the inventor in whole or in party, directly or indirectly of the full enjoyment of the patent monopoly?

*Patent holder is entitled to protection even in the absence of commercial exploitation*

* + - 1. Ratio
         1. S infringed s.42 by using the patented gene so court didn’t consider whether S made it
         2. Use applies both to patented products and processes, and also to their output if the PATENT plays an important part in production
         3. Q: Did D’s activity deprive the inventor in whole or in party, directly or in of the full enjoyment of the patent monopoly

Patent holder is entitled to protection even in the absence of commercial exploitation

D infringes patent when the D manufactures, seeks to use, or uses a patented part contained within something that is not patented, provided the patented part is significant or important

* + - 1. Application
         1. Use means utilization with view to production or advantage
         2. Saving seeds and harvesting and selling appears to constitute utilization on a common sense view
         3. M was deprived of full monopoly but cultivating crop without license S deprived M of granted monopoly [lost out on license fee]
         4. S had seeds in business context which lead to presumption of use or intended use.
         5. S didn’t provide enough evidence to rebut use.
      2. Dissent
         1. Rejected by majority that you only use genes when you use them in isolation. Stated that where D’s commercial business activity involes something on which patented part is a significant component, infringement will be found in regards to use.
         2. If its limited to lab use, then purpose of patent protection is defeated.

### Standby Utility

* + 1. Compare object of patent with what the D did and ask whether D’s action involved that object
       1. In order for object to be involved in D’s activity it doesn’t have to be done exacty
    2. Mere possession can amount to use if possession is standby
       1. Must look at whether D intended to exploit the invention if the need arose.
       2. Mere possession isn’t use but a business that possesses a patented product for trade may be presumed to either have used it or to intend to use it
          1. *Presumption can be rebutted*

## Patentabiliy of life

* 1. Higher life forms are not patentable
  2. But inventions embeeded in higher life forms may be patentable
     1. Claims related to process were found to be patentable and fertized eggs were patentable…therefore Genes in M case was patentable even it grows into plan
     2. Those patents are infringed when higher life form is “used”

## Loss of Patent rights

* 1. S.60(1)- Loss
     1. Patent rights can be lost once granted
        1. Interested person
           1. Actual or potential infringers
           2. Anyone dealing with the same/similar kind of thing as the DA and is in competition with it
           3. Where a person is using or wants to use an invention in respect of which another person claims to have a patent
  2. S.48.1(1)- Invalidated patents –new prior art
     1. Can be invalidated when prior art that came to light after the patent had been approved
        1. Can request examination of patent itself but can be declared invalid by court or AG
  3. S.48- Modified
     1. Allows patentee to disclaim part of patent to narrow an overbroad claim.
     2. S.48(1)(a): claim is overbroad when it is more than what was invented
     3. S.48(1)(b): claim is overbroad if it claims subject matter to which patentee had no lawful right
  4. Patent rights can be dedicated to public

#### Case Example: Parke- Davis Division v Canada

* + - 1. Although there is no act it is not impossible. Can do it through dedication notice at the Canadian patent office
      2. Cant be revoked.

## Claims Construction

* 1. Overview
     1. Claims describe what is not to be made or used by anyone else during the term of the patent
     2. Anything disclosed in the specification but not claimed is not protected by the patent
     3. Each claim must have all the elements of patentability in order to be valid
        1. Describes scope of protection for invention
        2. Novelty/obviousness/utility
     4. If claim is over something previously publically known claim might be unavailable due to novelty.

### Process

* + 1. Important for assessing exactly what is claimed by the inventor
    2. Important in patent infringement cases
       1. Does D’s activity fall within P’s patent
    3. Important in cases in which of the issues is whether the claimed invention is patentable subject matter.
       1. Determination of subject matter needs to be based on **purposive** construction of patent claim

#### Case Example: Whirlpool Corp- PURPOSIVE APPROACH

* + 1. The language of the claim defines the legal boundary of the invention. Construe claim in a purposive construction
       1. **What is the essential element of an invention**?
          1. Problems with purely literal

Allows people to make too many superficial changes to plan. Allows competitors to make minor changes and get around patent itself, which is bad because it defeats purpose of patent providing the balance is between monopoly and exchange of useful information. If we accept patents are valuble then we want to make sure we adopt a claim construction that wouldn’t undermine it.

* + - * 1. **Purposive approach is better because**

Key is for court to identify certain words and phrases in claim that describe essential element of invention. Key concept to remember is the need to identify essential element of invention. Significant of finding the invention is no infringement if essential element is admitted or omitted. If someone changes an essential element there might be no infringement but there might be an infringement for non-essential elements for omitted.

* + - 1. **How to detetermine essential vs non essential [below]**
         1. Skill reader; hypothetical person possessing the ordinary skill and knowledge of the particular art to which the invention relates and a mind willing to understand a specification that is addressed to him.

Equated with reasonable person who is trying to achieve success and not looking for difficulties or seeking failure.

* + - 1. **Consider question in light of the knowledge of the art at the date of publication of the patent specification [18 months after fling]**
         1. Non essential

Based on purposive construction, not intended to be essential or

At date of publication skilled worker would have understood that this element could be substituted without impacting how the invention works.

#### Free world case TEST:

* + 1. **Is claim construction essential**
       1. **Does D’s variant have a material effect on the way the invention works?**
          1. Yes no infringement because variant is outside of the claim
          2. No:

Was it obvious at the date of publication that the variant would not have a material effect on the way the invention works

No: no infringement

If it wasn’t obvious on material effect of how invention works and inventor didn’t expand patent fence then inventor shouldn’t be able to claim this

Yes: was exact complicance an essential part of invention 🡪 was it obvious

Yes: no infringement

No: infringement

* + 1. **Need to interpret claim according to the intent of the inventor expressed or inferred from the claim**
       1. Be sympathetic, ,but not so generous to give a meaning that wasn’t intended
       2. Extrinsic evidence should not be relied on
    2. Application in Free world Trust
       1. Only real similarity between the two machines is that they are electromagnetic machines to use energy to diagnose and treat disease. Core of P’s invention was circuit means.
       2. Know how broad or narrow the claim is before someone has infringed the patent

## Patent infringement

* 1. Overview
     1. S.42
        1. Infringement= doing anything that the patentee has exclusive right to do
        2. Making, constructing, using the invention, selling it to others to be used
        3. Actions must take place in Canada to be infringing
     2. S.55.01
        1. Limitation period = 6 years from the act of infringement [s.55.01]

### Defences to patent infringement

* + 1. Your invention doesn’t fall within the patent claims
       1. Claim construction and as a result is infringing
    2. The patent is not valid [s.59, s.43(2)
       1. S.59: states that D in any action of infringement of patent may plead as defence any fact which renders patent void
          1. Not novel
          2. Insufficient disclosure
          3. Obviousness
       2. S.43(2):
          1. Patent benefits of validity
          2. What finding of invalidity is that reversal of patent office determination that patent should be granted
          3. In raising this defence have to bring new evidence that patent examiner didn’t consider or failed to apply correct test
    3. License
    4. Limitation period –s.55.01
       1. 6 years expired
    5. Exception relating to regulatory approval—s.55.2(1)
       1. States it is not infringement for any person to make construct, use or make for uses reasonably related to development of
          1. Pharmaceutical industry
          2. Stockpiling
    6. Experimental use exception –s.55.2(6)
       1. doesn’t effect to property or privilege granted to patent for non commercial purposes
    7. Terms of the patent had expired
    8. Existing uses defence—s.56
       1. deals with situation where person has acquired subject matter defined in claim before claim date.
       2. Where person has acquired subject matter before the claim date and makes or uses invention that B later patents.
       3. If A’s invention becomes available then B’s patent would be become invalid for patentability
       4. If A does not make it public and keeps it out of public eye then can A continue to use privately despite B’s patent
          1. Yes—good faith requires independent inventor are personally respected for acts done before claim date of patent
          2. A can keep using it but A cant expand use by making or constructing fresh example of patent itself
    9. Repair of the patented article
       1. Right based on fact that patent hold is presumed to prevent this type of activity
       2. If you make extensive repairs = infringement
    10. Patent exhaustion
        1. Patentee is taking to apply renounce using and selling patent right once it has been sold.
        2. Patentee sells article and imply exclusive right to use article and selling article
        3. Once sold it can be used to purchase and sold to another party without being infringing act
    11. Abuse of rights/compulsory license—s.65
        1. Patent act gives commission to grant license to other person of patent right where there has been an abuse
        2. S.65(1)
           1. Any interest person can apply any time after 3 year grant of patent to commission alleging abuse of patentee exclusive rights
        3. 65(2)
           1. criteria for patent abuse
           2. includes demands for article is not being met to an adequate extent or reasonable terms.
           3. If trade or industry in Canada is prejudice a license should be granted or shown that existence of patent has been used to prejudice use or sale of material
           4. Number of criteria asked to look at that could be employed to request a license.

## Infringement action

* 1. Can be brought in federal court or provincial court—s.54
  2. Federal court has exclusive jurisdiction to impeach a patent, annul a patent, and have an entry in the patent registry varied—s.20/s.60

## Remedies

* 1. Damages-s.55(1)
     1. Includes reasonable compensation for damage sustained as a result of acts committed by parties prior to the grant of the patent but after the patent had been open to public inspection that would have been infringement had they occurred post grant of the patent (s.55(2)
  2. Account of profits (s.57(1)(b)
  3. Punitive damages
     1. Awarded where a parties conduct has been malicious, oppressive and high-handed, or offends the courts sense of decency o represents a marked departure from ordinary standard of decent behaviour
  4. Injunction s.57(1)(a)
  5. Delivery up or destruction of the infringing products

#### Case Example

* + 1. Monsanto
       1. Damages are a representative of the investors loss.
       2. Accounting of profits = measured by profits made by the infringer
          1. The inventor is only entitled to that portion of the infringer’s profit which is causally attributable to the invention
          2. SCC: None of the profit earned by Schmeiser could be attributed to the modified gene; Monsanto is entitled to nothing on their claim of accounting of profitse
    2. Teva
       1. Logical consequence of a failure to properly disclose an invention and how it works would be to deem the patent in question invalid (para. 84)