

Protection of IP Canada

I. TRADE-MARKS

I.1 INTRODUCTION

The Unfair Competition Act, which deals with trade-marks in Canada, came into force on 1 September 1932. Difficulties and dissatisfaction with this Act prompted the Trade-marks Act, which received Royal Assent on 14 May 1953.

I.2 REGISTERED TRADE-MARKS

It is not necessary to register a trade-mark in Canada as use of a mark can establish ownership through Common Law. It is however highly recommended to register a trade-mark, since it provides the owner with exclusive use across Canada for 15 years. Registrations can be renewed thereafter for periods of 15 years.

A trade-mark must be used by a person for the purpose of distinguishing, or so as to distinguish his wares or services, from those of another person. In order to be registrable, a trade-mark must not be descriptive or deceptively misdescriptive of its related wares or services and must be distinctive.

Distinguishing guises are registrable as trade-marks only in specific cases, as per the conditions of Section 13 of the Law and under Practice Notices issued by CIPO.

The registered owner of a Canadian trade-mark registration does not have to prove its ownership in a dispute since it has exclusive use of a mark across Canada pursuant to Section 19 of the Trade-Marks Act. It can also invoke Section 7 (passing-off), Section 20 (infringement), as well as Section 22 (depreciation of goodwill). Moreover, the owner of a Canadian trade-mark registration can request a judicial order before the Federal Court pursuant to Section 55 of the Act. A registered trade-mark may be subject to expungement if it is not used for three years from the date of registration.

I.3 UNREGISTERED TRADE-MARKS

If a trade-mark is not registered on the Canadian database, it may be inadvertently used by a third party or without the owner's consent. If a trade-mark is registered on the database it will at least help to prevent infringement before it happens and may also be useful to resolve litigation with third parties.

When a trade-mark is not registered in Canada, its user could be involved in a long and expensive legal dispute in order to prove who has the right to use the trade-mark. The owner of a non-registered trade-mark will only be able to sue under Section 7 of the Act and will have to prove, unlike an owner of a registered trade-mark, that its business has acquired a reputation or goodwill in the trade-mark throughout Canada, otherwise, the scope of protection could be limited to only a certain territory within Canada.

Following a recent Supreme Court's decision, the rule of first to file, first to proceed with the registration process at CIPO, now applies. The owners of a unregistered trade-mark, having prior use, now has to formally file an opposition to prevent registration of the confusing trade-mark, provided obviously that he has even been made aware of the filing of such a confusing trade-mark, to be able to oppose within the statutory period.

2. PATENTS

2.1 INTRODUCTION

In Canada, patents are ruled by the *Patent Act 1985*. A patent protects inventions, which are new, useful, inventive and not obvious to someone skilled in the art.

A patent provides its inventor with the right to prevent third parties from copying, using or making the invention. The protection is granted for a period of 20 years starting from the date of application.

A patent cannot be obtained in Canada if the invention was published more than one year before its application with the Canadian Patent Office.

In Canada, the first to file system applies. Even if the inventor can prove that he was the first to produce the invention, he will not have priority on an inventor who filed before him.

Specific federal legislation also applies in the case when of an invention is made by a public servant during the scope of his duties or employment or with facilities, equipment or financial aid. The *Public Servants Inventions Act* grants the inventions and rights with respect thereto to Her Majesty in such a case.

2.2 INDUSTRIAL DESIGNS

Under the Canadian *Industrial Design Act 1985*, an industrial design is defined as “features of shape, configuration, pattern or ornament and any combination of these features that, in a finished article, appeal to and are judged solely by the eye”.

If a creator’s industrial design has been published, an application to obtain a registration must be filed within 12 months following the publication.

A registered industrial design gives exclusive rights to its creator for a period of 10 years. It will then become part of the public domain. The protection conferred by an industrial design in Canada is different to that conferred by copyright and trade-marks because, if an industrial design is not registered, it is not possible to claim ownership or legal protection.

2.3 COPYRIGHT

In Canada, copyright is protected by the *Copyright Act 1985* and gives rights to authors of literary, artistic, dramatic and musical works and of computer programs. The protection subsists during the life of the author and lasts for 50 years following his death.

Under Section 27 of the *Copyright Act*, it is an infringement of the copyright for any person, without the consent of the owner, to :

- (a) sell or rent out;
- (b) distribute to such an extent as to affect prejudicially the owner of the copyright;
- (c) by way of trade distribute, expose or offer for sale or rental, or exhibit in public;
- (d) possess for the purpose of doing anything referred to in paragraphs (a) to (c); or
- (e) import into Canada for the purpose of doing anything referred to in paragraphs (a) to (c);
a copy of a work, sound recording or fixation of a performer’s performance or of a communication signal that the person knows or should have known infringes copyright or would infringe if it had been made in Canada by the person who made it ”.

Specific legislations also apply with regard to the status of the artist, the professional status and conditions of the engagement of performing, recording and filming artists, and the professional status of artists in the visual arts, arts and crafts and literature and their contracts with promoters.

2.4 INTEGRATED CIRCUIT TOPOGRAPHIES

The *Integrated Circuit Topography Act* refers to computer chips constituting integrated circuit products and grants to the owner the right to reproduce, manufacture and exploit its topography.

To obtain protection under the Act, the topography must not reproduce another topography.

The Act gives the owner the exclusive right to (Section 3(2) of the *Integrated Circuit Topography*):

- (a) reproduce the topography or any substantial part thereof;
- (b) manufacture an integrated circuit product incorporating the topography or any substantial part thereof; and
- (c) import or commercially exploit the topography or any substantial part thereof or an integrated circuit product that incorporates the topography or any substantial part thereof”.

2.5 PLANT BREEDERS' RIGHTS ACT

New varieties of plant species can be protected under the Plant Breeders' Rights Act. Thus, a person cannot adopt or use a mark resembling a denomination protected under that Act. Agriculture and Agri-Food Canada grant rights for these denominations, which provides owners with control over their reproductive material.

2.6 OTHER FEDERAL STATUTES

The use of a registered trade-mark or a coined trade or brand name may violate other Canadian federal laws, such as:

- (a) The *Textile Labelling Act* which prohibits false representations of a textile fibre product;
- (b) The *Consumer Packaging and Labelling Act* which prohibits false representations on products' labels;
- (c) The *Competition Act* which prohibits false representations related to the promotion of a business interest;
- (d) The *Food and Drugs Act* which prohibits advertising, labelling or selling of food which causes mistaken impression;
- (e) The *Precious Metals Marking Act* which prohibits the use of marks falsely or incorrectly identifying precious metal articles;
- (f) The *Bank Act* which prohibits the use of the words “bank”, “banker” or “banking” in the description of a trade-mark without authorisation under the Bank Act;
- (g) The *Canada Agricultural Products Act* and the *Meat Inspection Act* which prohibit the use of grade names and agricultural product legends without authorization under these Acts;
- (h) The *Food and Drugs Act*, with *Look-alike, Sound-alike (LA/SA)* regulation for health products, with specific homologation procedures for trade-marks intended for use with such products, to reduce the risk of medical error;
- (i) The *Olympic and Paralympic Marks Act*, for the specific registration of official trade-marks and provisions regarding specific infringement.

3. PROTECTION OF IP RIGHTS

3.1 REGISTRARS

3.1.1 PATENTS

Patent applications can be filed by the inventor, but preferably with the help of a patent agent, who will draft a patent application comprising generally an abstract, a description of the invention including prior art and designs as well as claims of the invention, which define the boundaries of the patent protection.

The patent application will be published 18 months after the date of filing. It will be examined only if it is requested by the applicant, who will then have 5 years starting from the date of filing to submit such a request. An examiner will determine if the invention meets all the requirements concerning novelty, utility and inventiveness. The patent will then be granted for a period of 20 years starting from the filing date, subject to the payment of annual maintenance fees.

3.1.2 Trade-marks

Trade-mark applications can be filed by the owner itself, but preferably with the help of a trade-mark agent. Canada does not adhere to the Nice Convention and thus trade-mark applications do not refer to the International Classification and can be filed in association with unlimited goods or services for the same governmental fees.

The applications are verified by examiners who will check if the trade-mark meets all the requirements of the Trade-marks Act so as to be registrable. Objections are outlined in an examiner's report, to which the applicant must respond.

Once the examiner has approved the application, it will be published in the Trade-marks Journal, following which third parties will have two months to oppose the trade-mark. If no oppositions are filed, or if an opposition is settled, the application will proceed to registration.

3.1.3 Industrial Designs

A description providing the features of the design as well as drawings or pictures must be provided to the Office, which will examine the applications on a first-come first-served basis. Registrations can be obtained within approximately 7 to 8 months if the application is properly prepared. Protection is granted for a period of 10 years beginning on the registration date, following which it will fall in the public domain. A maintenance fee will have to be paid after five years of registration.

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