Laws on Intellectual Property Rights Protection

(i) General Definition and Classification

- Intellectual property (IP) refers to creations of the mind, such as inventions; literary and artistic works; designs; and symbols, names and images used in commerce.

- IP is protected in law by, for example, patents, trademark, copyright, which enable people to earn recognition or financial benefit from what they invent or create. By striking the right balance between the interests of innovators and the wider public interest, the IP system aims to foster an environment in which creativity and innovation can flourish.

- Some types of IP include:
  - **Patents** cover new and useful inventions (product, composition, machine, process) or any new and useful improvement to an existing invention.
  - **Trademarks** may be one or a combination of words, sounds or designs used to distinguish the goods or services of one person or organization from those of others.
  - **Copyright** provides protection for literary, artistic, dramatic or musical works (including computer programs) and other subject-matter known as performer’s performances, sound recordings and communication signals.

(ii) Trade secrets

If another person independently invents or discovers the subject matter of your trade secret. There is nothing to prevent that person from using it, applying for a patent or publishing the information. The benefit of keeping a trade secret is that you do not have to make your innovation public as you do when you are granted a patent.

What makes this so attractive is that so long as the trade secret is kept secret, the company can enjoy protection of their IP forever. Once the secret is out however, that product/object loses its business value.

Trade Secrets:

1) Ensure an invention or design is not disclosed to the public before applying for a patent or an industrial design.

2) Protect an invention through means other than patent protection.

3) Protect valuable business information that is not formally protected through other intellectual property rights.

Ex) Coca cola has a secret formula that is kept hidden from the public. If someone were to leak the receipt to Coca Cola there is no legal action that can be taken place.
(iii) Patent Law

Range of Protection

There are three basic criteria for patentability—novelty, utility and inventiveness:

- **Novelty**—To be granted a patent, the invention (door lock) must be the first of its kind in the world.
- **Utility**—A valid patent cannot be obtained for something that does not work or that has no useful function. The door lock must work.
- **Inventiveness**—To be patentable, your invention must be a new development or an improvement of an existing technology that would not have been obvious to someone working in your area of specialty. The door lock must add an improvement to the field of door locks.

To be granted a patent, your invention can be:

- A product (a door lock)
- A composition (a chemical composition used in lubricants for door locks)
- A machine (a machine for making door locks)
- A process (a method for making door locks)
- An improvement on any of these

Although one may obtain a patent for an improvement to an existing invention, keep in mind that the original patent may still be in force. If this is the case, manufacturing or marketing the product with the improvement may be an infringement of the original patent. This situation is often resolved by agreement between the patentees (the people who own the patents) to grant licences to each other.

A patent is granted only for the physical embodiment of an idea (for example, the description of a possible door lock) or for a process that produces something tangible or that can be sold. Scientific principles, an abstract theorem, an idea, some methods of doing business or a computer program cannot be patented.

Obtaining a Canadian patent does not protect your invention in another country. If one wants this protection, they will have to apply for a foreign patent.

Application and Administration

The prescribed application fee must be paid and the application must be filed in accordance with the regulations by the inventor or the inventor’s legal representative and the application must contain a petition and a specification of the invention.

The specification of an invention must

- Correctly and fully describe the invention and its operation or use as contemplated by the inventor;
- Set out clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear,
concise and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most closely connected, to make, construct, compound or use it;

- In the case of a machine, explain the principle of the machine and the best mode in which the inventor has contemplated the application of that principle; and

- In the case of a process, explain the necessary sequence, if any, of the various steps, so as to distinguish the invention from other inventions.

Any public disclosure of an invention before filing may make it impossible to obtain a patent. There is an exception in Canada and the United States if the public disclosure was made by the inventor or by someone who learned of the invention from the inventor less than one year before filing the patent application.

However, filing while you are still developing your invention may mean missing important features from the patent application. You may then have to reapply, adding to your expenses and risking possible patent disputes.

The subject-matter defined by a claim in an application for a patent in Canada (the “pending application”) must not have been disclosed

- more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere;

- 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;

- in an application for a patent that is filed in Canada by a person other than the applicant, and has a filing date that is before the claim date;

Duration, Termination and Invalidation

Through a patent, the government gives you, the inventor, the right to stop others from making, using or selling your invention from the day the patent is granted to a maximum of 20 years after the day on which you filed your patent application.

Many reasons may be invoked in an attempt to invalidate a patent, either based on prior art or on technical reasons linked to intrinsic defects in the patent. Generally, an interested person will attempt to prove that the claims lack novelty, inventiveness or utility, that they are ambiguous, that they are not supported by the description

Impeachment of Patents-

Where any person has reasonable cause to believe that any process used might be alleged by any patentee to constitute an infringement of an exclusive property, they may bring an action in the Federal Court against the patentee for a declaration that the process or article does not or would not constitute an infringement of the exclusive property or privilege.
Measures of protection

Protection against infringement

Patent infringement happens if someone makes, uses or sells your patented item without your permission in a country that has granted you a patent.

If you believe your patent is infringed, you may sue for damages in an appropriate court. The defendant may argue that infringement did not occur or may attack the validity of your patent. The court will decide who is right based largely on the wording of the claims. If what the defendant is doing is not within the wording of any of the claims of your patent, or if the patent is declared to be invalid for any reason, there is no infringement.

Protection before grant

When you have a Canadian patent, you will be able to sue infringers for all damages that occurred after your patent was granted. Also after the grant, you may sue for "reasonable compensation" for infringements that occurred in Canada between the date your application was made available for public inspection (18 months after filing or priority) and the date your patent was granted.

(iv) Trademark Law

Trademarks can be one or many words, sounds or designs used to distinguish the goods or services of one person or organization from those of others.

There are three types of trademarks:

- **An ordinary mark** is made up of words, sounds, designs or a combination of these used to distinguish the goods or services of one person or organization from those of others. For example, suppose you started a courier business that you chose to call Giddy-up. You could register these words as a trademark (if you met all the legal requirements) for the service that you offer.

- **A certification mark** can be licensed to many people or companies for the purpose of showing that certain goods or services meet a defined standard. For example, the Woolmark design, owned by Woolmark Americas Ltd., is used on clothing and other goods.

- **A distinguishing guise** is about the shape of goods or their containers, or a way of wrapping or packaging goods that shows they have been made by a specific individual or firm. For example, if you manufactured butterfly-shaped candy you could register the butterfly shape as a distinguishing guise.

Range of Protection

Registering your trademark with the Registrar protects your rights in Canada only. If you are applying for registration of a trademark in Canada but are living in a country other than
Canada, you must appoint someone (called representative for service) in Canada to whom the Registrar can send correspondence.

**Application and Administration**

An applicant for the registration of a trade-mark shall file with the Registrar an application containing

- (a) a statement in ordinary commercial terms of the specific goods or services in association with which the mark has been or is proposed to be used;

- (b) in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of goods or services described in the application;

- (c) in the case of a trade-mark that has not been used in Canada but is made known in Canada, the name of a country of the Union in which it has been used by the applicant or his named predecessors in title, if any, and the date from and the manner in which the applicant or named predecessors in title have made it known in Canada in association with each of the general classes of goods or services described in the application;

- (d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant’s named predecessor in title on which the applicant bases the applicant’s right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant or the applicant’s named predecessor in title, if any, in association with each of the general classes of goods or services described in the application;

- (e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;

- (f) in the case of a certification mark, particulars of the defined standard that the use of the mark is intended to indicate and a statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used;

- (g) the address of the applicant’s principal office or place of business in Canada, if any, and if the applicant has no office or place of business in Canada, the address of his principal office or place of business abroad and the name and address in Canada of a person or firm to whom any notice in respect of the application or registration may be sent, and on whom service of any proceedings in respect of the application or registration may be given or served with the same effect as if they had been given to or served on the applicant or registrant himself;
• (h) unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed; and

• (i) a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the goods or services described in the application.

Duration, Termination and Invalidation
A registration lasts for 15 years from the date of registration. You may renew it every 15 years after that for a fee.

However, they can lose that right (expungement, or removal, from the Register of Trademarks) unless they carry out specific responsibilities. A trademark can be expunged for reasons related to owning a trademark, the distinctiveness of a trademark, abandoning a registered trademark, and not using a trademark.

No person shall:

• make a false or misleading statement tending to discredit the business, goods or services of a competitor;

• direct public attention to his goods, 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 goods, services or business and the goods, services or business of another;

• pass off other goods or services as and for those ordered or requested; or

• make use, in association with goods or services, of any description that is false in a material respect and likely to mislead the public as to

  o (i) the character, quality, quantity or composition,

  o (ii) the geographical origin, or

  o (iii) the mode of the manufacture, production or performance

National symbols such as the Royal crest is also prohibited from copyright

Measures of protection
It is up to you to make sure nobody is using your trademark without your permission and to take legal action if someone does. You also need to take action if you come across a trademark or a trade name that could be confused with your mark. You do not want anyone imitating your trademark.
Copyright Law

Copyright Owners
- Copyright is the exclusive legal right to produce, reproduce, publish or perform an original literary, artistic, dramatic or musical work. The creator is usually the copyright owner. However, an employer—for example, a film studio—may have copyright in works created by employees unless there is an agreement in place stating otherwise.

Application and Administration
- One must fill out an application via online or by mail at the regional Innovation, Science and Economic Development Canada office
- Information required for the work are the:
  - Title
  - Category of the work (Literary, Musical, Artistic, Dramatic)
  - Publication
  - Owner information (Usually the creator)
  - Author’s Declaration
  - Fees
- Generally, copyright lasts for the life of the author, the remainder of the calendar year in which the author dies, and for 50 years following the end of that calendar year. Therefore, protection will expire on December 31 of the 50th year after the author dies.

Publication, Performance, Sound Recording, Video Recording and Broadcasting

Performers' performances
- Copyright applies to a performer's performance if it takes place in Canada or a Rome Convention country, or if it is embodied in a sound recording whose maker is a citizen or permanent resident of Canada or a Rome Convention country. If the maker of the sound recording is a corporation, it must have its headquarters in Canada or a Rome Convention country.
  - Copyright also applies if the performance is embodied in a sound recording whose first publication occurred in Canada or a Rome Convention country, or if the performer's performance is transmitted by a communication signal broadcast from Canada or a Rome Convention country by a broadcaster that has its headquarters in the country of broadcast.

Sound recordings
- Copyright lasts until 50 years after the end of the calendar year in which the work was first recorded. If the sound recording is published before the copyright expires, the copyright continues for 50 years after the end of the calendar year in which the first publication occurs.

Communication signals
- Copyright lasts until 50 years after the end of the calendar year in which the signal was broadcast.

Measures of protection
(vi) Infringement of Business Secrets

Copyright Infringement

- According to section 34(4) of the copyright act, specific penalties will be decided by the court. Section 35(1) states that an infringer is liable for the financial gain made through infringement, and "such damages to the owner of the copyright as the owner has suffered due to the infringement". A copyright holder can instead elect to protect his/her copyright under section 38.1, which allows for "a sum of not less than $100 or more than $5,000 as the court considers just." for all non-commercial infringement, and $500 up to $20,000 for each commercial infringement.

- In addition to the civil penalties described above, Section 42(1) of the copyright act sets out a number of criminal offences. These primarily deal with infringement that involves sale or rental of copyrighted materials, and can result in fines of up to $1,000,000 or prison sentences of up to 2 years for indictment. For a summary conviction, the maximum fine is $25,000 and prison term is limited to 6 months.

- According to Section 44 of the copyright act, copyright owners may apply to have copies of their work that, were they made in Canada would be infringing, and are about to be, or have been, imported into Canada dealt with by border services. In these cases, such copies can be detained, and eventually destroyed or handed over to the copyright holder, at the discretion of the court.

Trademark Infringement

Under the Trade-marks Act, the remedies for passing off are the same as those for having a confusingly similar mark. A party who engages in these torts faces a number of liabilities, including:

- An interim/interlocutory injunction
- A permanent injunction
- Damages or an accounting of profits
- Legal costs
- Pre- and post-judgment interest
- Reasonable compensation for pre-grant sales
- Delivery of and destruction of infringing advertising materials

Patent Infringement

- **55 (1)** A person who infringes a patent is liable to the patentee and to all persons claiming under the patentee for all damage sustained by the patentee or by any such person, after the grant of the patent, by reason of the infringement.

- **(2)** A person is liable to pay reasonable compensation to a patentee and to all persons claiming under the patentee for any damage sustained by the patentee or by any of those persons by reason of any act on the part of that person, after the application for the patent became open to public inspection under section 10 and before the grant of
the patent, that would have constituted an infringement of the patent if the patent had been granted on the day the application became open to public inspection under that section.

Sources:
http://laws-lois.justice.gc.ca/eng/acts/C-42/index.html (Copyright Act)
https://www.marsdd.com/