

INTELLECTUAL PROPERTY - LAW 347

Course Syllabus: Fall, 2011

Professor Howell

Course Description

Law 347 Intellectual Property

The course description is set out in the UVic Calendar. The course will present a study of the concept of intellectual property and the principles and policies of selected areas of intellectual property law, primarily:

- (i) copyright in its categories of literary, dramatic, musical and artistic works.
- (ii) registered trade marks and related common law provisions; and

In addition, the course includes an introduction to the law and policies of patents, industrial designs and confidential information and the interrelationship and boundary issues between the categories that together comprise the subject of intellectual property.

(iii) Today, intellectual property (IP) is frequently interwoven with technology. Attention will be given to this linkage in the broader context of the doctrinal and policy elements of copyright and trademark law. In many instances, leading developments do not involve issues of technology. Overall, technology can be divided into two categories with respect to its relationship with IP. First, the technology may simply be contextual background with no direct application to the legal analysis beyond being causative of the factual event. Second, the technology may be invasive of legal principle by bringing about dimensions that involve a re-consideration of legal principles within a framework set by the technology. It is this latter category that we will cover. Required readings for this purpose are extracts from R. Howell, *Canadian Telecommunications Law: Dimensions in a Digital Age*, Irwin Law, Inc., Toronto (February; 2011). The Priestly Law Library has acquired a licence enabling full electronic access for students to this and other Irwin publications. References will be given to this work in various places in the syllabus.

- (iv) Over recent years there have been three attempts to implement Copyright law reform:

- Bill C-60 (2005)
- Bill C-61 (2008)
- Bill C-32 (2010)

In each instance minority federal governments and frequent federal elections have frustrated enactment. With a now majority federal government, a further Bill is expected in Fall, 2011. If such a Bill is introduced either immediately before commencement of the course or during the course, features of the Bill relevant to our course coverage will be noted in class to an extent considered appropriate.

Assigned Readings

1. Readings marked * are assigned and are examinable, including those aspects of recent SCC decisions that are discussed in class. If time does not permit coverage in the classroom of a particular area then that area is not examinable.
2. Legislative provisions and all other matters covered in class are assigned and examinable.

A) Prescribed Books and Materials

1. Howell, Vincent & Manson, *Intellectual Property Law Cases and Materials*, Emond Montgomery Publications Limited, Toronto, Ont. 1999 (References in this syllabus to “C.B.” refer to this publication) (available in University Bookstore)
2. R. Howell, *Canadian Telecommunications Law: Dimensions in a Digital Age*, Irwin Law Inc. Toronto, February 2011. Extracts from this work are referred to in various places in this syllabus – available under license electronically, Priestly Law Library, Fraser Building.
3. *Canadian Legislation on Intellectual Property* 2010 (or 2011 if available) (ed. MacKaay and Gendreau) Carswell [Note editions from earlier years (say 2000 onwards) are also usable.]
4. A copy of Howell, *Reformulation of Copyright by the Supreme Court of Canada*, (2004) (unpublished) has been made available. This paper summarizes recent key, but lengthy, SCC and appellate cases including: (a) *Théberge v. Galerie d’Art du Petit Champlain inc* (2002), 17 C.P.R. (4th) 161 (S.C.C.); (b) *CCH Canada Ltd. v. Law Society of Upper Canada* (2004) 2004 SCC 13; *Society of Composers, Authors and Music Publishers of Canada v. Canadian Association of Internet Provider (Tariff 22)* 2004 SCC 45; and *Delrina Corp. (Carolian Systems) v. Triolet Systems* (2002), 17 C.P.R. (4th) 289 (Ont. C.A.) (Application for leave to appeal to S.C.C. denied, November 28, 2002). This paper provides a guide for you to check (as you want to) aspects in the case itself.
5. Further recent SCC decisions are:
 - a. Copyright
 - (i) *Robertson v. Thomson Corp* [2006] 2 SCR 399; 2006 SCC 43 (October 12, 2006)
 - (ii) *Euro-Excellence Inc. v. Kraft Foods Schweiz AG*, 2007 SCC 37 (July 26, 2007)

These cases are not as centrally relevant to our course as the earlier noted decisions. However, copies are on reserve in the library and passages will be referred to in various areas. *Reference to particular paragraph numbers will be provided where appropriate.*

b. Trademark

- (i) *Kirkbi AG and Lego Canada v. Ritvik Holdings Inc. (Mega Blocks Inc.)* [2005] 3 SCR 124; 2005 SCC 65 (November 17, 2005)
- (ii) *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 SCR 772; 2006 SCC 22 (June 2, 2006)
- (iii) *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltee*, [2006] 1 SCR 824; 2006 SCC 23 (June 2, 2006)
- (iv) *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27.

The *Kirkbi* case concerns the constitutional structure of trademark protection in Canada; the doctrine of “functionality”; and, within the constitutional framework, the position of section 7(b), *Trade-Mark Act*.

The *Mattel* and *Veuve Clicquot* cases were delivered on the same day by the SCC and concern “famous marks”.

The *Masterpiece Inc.* case involves the test for “confusion”.

When these lengthy cases are considered in class *reference will be made to particular paragraphs that need to be read.*

B) Recommended Overview Texts

D. Vaver, *Intellectual Property Law: Copyright, Patents, Trade-marks* (2nd ed), Irwin Law, Toronto, 2011

D. Vaver, *Copyright Law*, Irwin Law, Toronto, 1999

C) Constitutional and Statutory Provisions:

1) General Provisions

Constitution Act, 1867

: S. 92(13) Property & Civil Rights (Prov.)

: S. 91(2) Trade and Commerce (Fed.)

: S. 91(27) Criminal Law (Fed.)

: S. 132 Treaty Implementation (Fed.)

Sections 406-414 *Criminal Code*, R.S.C. 1985, c. C. 46

2) Common Law and Section 7, Trade Mark Act

*See C.B. pp. 440 and 447-448. See *Kirkbi AG and Lego Canada v. Ritvik Holdings Inc. (Mega Blocks Inc.)*, 2005 SCC 65 (On Reserve)

3) **Trade Marks:**

The above provisions of the *Constitution Act, 1867*.

**A.G. Ontario v. A.G. Canada (Canada Standard Trade Mark)*, [1937] A.C. 405 at p. 417 (P.C.).

Bell and Probert, *The Constitutionality of Canadian Trade Mark Law* (1985) 4 C.P.R. (3d) 305.

4) **Patents:**

Constitution Act, 1867, section 91(22) (Fed.).

Patent Act, R.S.C. 1985, c. P. 4 as amended (see Carswell Consolidation).

5) **Copyright:**

Constitution Act, 1867, section 91(23) (Fed.).

Copyright Act, R.S.C. 1985, c. C. 42 as amended (See Carswell Consolidation).

6) **Industrial Designs:**

Industrial Design Act, R.S.C. 1985, c. I. 9 as amended (See Carswell Consolidation).

[N.B. In *Pipeline Displays & Fixtures Inc. v. Produits Metalliques J.P. Ltd.* (1987), 17 C.P.R. (3d) 252 at 253 the constitutionality of the *Industrial Design Act* was challenged as ultra vires but the issue was not dealt with].

D) **Copyright**

1) **Introduction *C.B. pp. 3-20**

- Overview
- International Treaties – see s. 91
- History – see s. 89
- Underlying Theory – See **Théberge v. Galerie d'Art du Petit Champlain inc.* (2002) 17 CPR (4th) 161 (SCC); Howell, *Reformulation of Copyright* (Handout)
- Scope of Copyright

2) **Basic Elements *C.B. pp. 21-54**

- Qualifying for Copyright

Mascot International v. Harman Investments Limited (C.B. p. 23)

- Publication

Oscar Trade Mark (C.B. p. 25)
Infabrics Ltd. v. Jaytex Ltd. (C.B. p. 27)
Robert D. Sutherland Architects Ltd. v. Montykola Investments Inc. (C.B. p. 28)

- Corporeal and Incorporeal

In re Dickens (C.B. p. 30)

- Fixation

Canadian Admiral (C.B. p. 33)
Gould Estate (C.B. p. 33)

- Originality/Expression/Idea

University of London Press, Limited (C.B. p. 38)
Fletcher v. Polka Dot Fabrics Ltd. (C.B. p. 40)
Boutin v. Bilodeau (C.B. p. 43)
Baker v. Selden (C.B. p. 48)

*See discussion in *Delrina Corp. (Carolian Systems) v. Triolet Systems* (2002), 17 C.P.R. (4th) 289 at 302-307 (paras. 33-52) (Ont. C.A.) (leave to appeal to S.C.C. denied, November 28, 2002)

See para. E.7 re “compilations” and “creativity” where the topic of “originality” has received considerable attention. Introductory comment will be made in class with respect to the following cases (not assigned at this stage): *Hager v. E.C.W. Press Ltd.* (1998), 85 C.P.R. (3d) 289, 301-309 (F.C.T.D.). (On Reserve) and *CCH Canadian Ltd. v. Law Society of Upper Canada* (2004) 2004 SCC 45; *Neudorf v. Network Productions Ltd.* (1999), 3 C.P.R. (4th) 129, 138 (Para. 19) (On Reserve); and *Gahel v. Corporation Xprima.com* (2008), 68 C.P.R. (4th) 423 at paras. 34-47 (Que. CA) (re skill and judgment) (On Reserve).

Is a chemical formula idea or expression? See *Tri-Tex Co. v. Ghaly* (1999), 1 C.P.R. (4th) 160, 171-172 (Que. C.A.).

Compare the facts of: *2703203 Manitoba Inc. v. Parks* (2006), 47 CPR (4th) 276 (NSSC), *affd* (reduced damages) (2007) 57 CPR (4th) 391 (NSCA) and *B & A Construction Ltee v. Betaplex Inc.*, (2006), 55 CPR (4th) 257 (Que CA).

3) **Literary Works** *C.B. pp. 55-117

- General Meaning

University of London Press, Limited (C.B. p. 55)
Hollinrake v. Truswell (C.B. p. 56)
The Bulman Group Ltd. v. Alpha One-Write Systems B.C. Ltd. (C.B. p. 56)
Exxon Corporation v. Exxon Insurance Consultants International Ltd. (C.B. p. 58)
British Columbia v. Mihaljevic (C.B. p. 65)

Via Rail Canada Inc. v. Location Via-Route Inc. (C.B. p. 69)

- Titles

McIndoo v. Musson Book Co. (C.B. p. 71)

Francis, Day & Hunter, Ltd. v. Twentieth Century Fox Corp. Ltd. (C.B. p. 73)

Canadian Olympic Association v. Konica Canada Inc. (C.B. p. 75)

See also *Shewan v. Canada* (1999), 87 C.P.R. (3d) 475 at 492-500 (Ont.)

- Copyright/Trademark Overlap

British Columbia v. Mihaljevic (C.B. p. 65)

See generally *Euro-Excellence Inc. v. Kraft Foods Schweiz AG* (SCC) 2007 [Not assigned at this point. This is a difficult case involving “parallel importation” that will not be discussed until completion of the trademark component.]

- Translations

Unauthorized translations (C.B. p. 78)

Originality of translations (C.B. p. 80)

Apple Computer Inc. v. MacKintosh Computers Ltd. (C.B. p. 81)

Reproduction/Translation: *EROS-EQUIPE de Recherche Operationnelle Santé inc. v. Conseillers en Gaston et Informatique CSI Inc.* (2005) 35 CPR (4th) 105 (FC) (Not assigned)

- Computer Programs

- a) “Literal” Copying

Apple Computer Inc. v. MacKintosh Computers Ltd. (C.B. p. 84)

- b) “Non-Literal” Copying

- (i) Look and Feel Approach

Broderbund Software, Inc. v. Unison World, Inc. (C.B. p. 91)

- (ii) Abstraction-Filtration-Comparison Approach

Computer Assoc. Int’l Inc. v. Altari, Inc. (C.B. p. 95)

**Delrina Corp. (Carolian Systems) v. Triolet Systems Inc.* (C.B. p. 103) *affd* (2002), 17 C.P.R. (4th) 289 (Ont. C.A.). Leave to appeal to S.C.C. denied November 28, 2002 (On Reserve)

Prism Hospital Software Inc. v. Hospital Medical Records Institute (C.B. p. 111)

- (iii) Method or System of Operation Approach

See note re *Lotus Development Corp. v. Borland International Inc.*
(C.B. p. 94)

4) Dramatic Works *C.B. pp. 119-135

Hutton v. Canadian Broadcasting Corporation (C.B. p. 119)
Kantel v. Frank E. Grant, Nisbet & Auld Ltd. (C.B. p. 123)
Green v. Broadcasting Corporation of New Zealand (C.B. p. 126)
FWS Joint Sports Claimants v. Copyright Board (C.B. p. 128)
National Basketball Association v. Motorola Inc. (C.B. p. 129)
Canadian Admiral Corporation Ltd. v. Rediffusion, Inc. (C.B. p. 130)
Cinematographic Works (C.B. pp. 132-135)

5) Musical Works *C.B. pp. 137-170

Composers, Authors and Publishers Association of Canada Limited v. CTV Television Network Limited (C.B. p. 138). The difficulties reflected in this case and the subsequent legislative and case developments are explained in *R. Howell, *Canadian Telecommunications Law* at pp. 223-227.
ATV Music Publishing of Canada Ltd. v. Rogers Radio Broadcasting Ltd. (C.B. p. 142)
Wood v. Boosey (C.B. p. 145)
Grignon v. Roussel (C.B. p. 148)
Drynan v. Rostad (C.B. p. 159)
See generally *Neudorf v. Network Productions Ltd.*, (1999), 3 C.P.R. (4th) 129 (B.C.S.C.) noted under para. 10(i) of this syllabus.

6) Artistic Works *C.B. pp. 171-232

- Meaning of “Artistic”

George Hensher Limited v. Restawile Upholstery (Lancs) Limited (C.B. p. 172)
Kenrick & Co. v. Lawrence & Co. (C.B. p. 185)

- Is there a need for “Artistic”-ness?

Cuisenaire v. South West Imports Ltd. (C.B. p. 188)
DRG Inc. v. Datafile (C.B. p. 191)
Lifestyle Homes Ltd. v. Randall Homes Ltd. (C.B. p. 198)

- Artistic Craftsmanship

George Hensher Limited v. Restawile Upholstery (Lancs) Limited (C.B. p. 199)

- Architectural Works (C.B. pp. 205-209) – See also *Chancellor Management Inc. v. Oasis Homes Ltd.* (2002), 19 C.P.R. (4th) 480 (Alta. Q.B.) (On Reserve)
- Other Specified or Numerated Categories (C.B. pp. 209-214)

Netupsky v. Dominion Bridge Co. Ltd. (C.B. p. 210)

- Three dimensional copying of two dimensional works

LB (Plastics) Limited v. Swish Products Limited (C.B. p. 217)

Bayliner Marine Corporation v. Doral Boats Ltd. (C.B. p. 220)

Note on *British Leyland* (C.B. p. 222)

Spiro-Flex Industries Ltd. v. Progressive Sealing Inc. (C.B. p. 225)

Preston v. 20th Century Fox Canada Limited (C.B. p. 214) (a literary description copied in two or three dimensional artistic depictions). See also *Anne of Green Gables*

Licensing Authority Inc. v. Avonlea Traditions Inc. (2000), 4 C.P.R. (4th) 289, (Ont.) (On Reserve)

- Sections 64 and 64.1, *Copyright Act* (Including interface with Industrial Design protection)

Bayliner Marine Corporation v. Doral Boats Ltd. (C.B. p. 227)

Magasins Greenberg Ltée v. Import-Export René Derby (C.B. p. 231)

Import-Export René Derby (Canada) Inc. v. Greenberg Stores Ltd. (2005), 37 CPR (4th) 305 (Que. CA)

Pyrrha Design Inc. v. 623735 Saskatchewan Ltd. (2005), 36 C.P.R. (4th) 432 (FCA)

7) Compilations and Databases

- This topic is de-emphasized this year. The minimal reading requirements here will allow for more analysis of technology later in the course.
- *See Extract, Howell re databases and originality (unpublished) (On Reserve)
- *See Howell, *Reformulation of Copyright by the Supreme Court of Canada* (unpublished) (Handout) paragraphs 17-27 giving references to key paragraphs in *CCH Canadian Ltd. v. Law Society of Upper Canada* (2004) 2004 SCC 13.
- *Gahel v. Corporation Xprima.com* (2008), 68 C.P.R. (4th) 423 at paras. 34-47 (Que. CA) (Re skill and judgment) (On Reserve) (Not assigned).
- Compare *Robertson v. Thomson Corp* [2006] 2 SCR 399; 2006 SCC 43 (October 12, 2006) re “collective works” (Not assigned) [Comment will be made in class as to the relationship of “compilations” and “collective works”.]

Europe

- *The European Database Directive* (C.B. p. 264) (not assigned)

See Howell, *Database Protection and Canadian Laws* – Report for Industry Canada and Canadian Heritage (1998) (On Reserve) at pp. 72-79 (Not assigned).

8) Economic Rights, Infringement and Defences *C.B. pp. 269-379

Introduction and Scope of Economic Rights: “Works” and “Other subject-matter” or “neighbouring rights”

Reproduction

Nichols v. Universal Pictures Corporation (C.B. p. 274)

Preston v. 20th Century Fox Canada Limited (C.B. p. 279)

Hanfstaengl v. Europe Palace (C.B. p. 282)

Rogers v. Koons (C.B. p. 285)

**Théberge v. Galerie d’Art du Petit Champlain inc.* (2002), 17 C.P.R. (4th) 161 (S.C.C.) (On Reserve)

Candow v. Savory (2000), 8 C.P.R. (4th) 219 (Nfld. S.C.) (On Reserve) (Not Assigned)

Substantively

(i) Quantitative

Hawkes & Son (London) Ltd. v. Paramount Film Service, Ltd. (C.B. p. 289)

(ii) Qualitative

Breen v. Hancock House Publishers Ltd. (C.B. p. 292)

Hutton v. Canadian Broadcasting Corporation (C.B. p. 294)

Prism Hospital Software Inc. v. Hospital Medical Records Institute (C.B. p. 296)

Re Breakthrough Films & Television Inc. (Unlocatable Copyright Owners) (2006), 53 CPR (4th) 240 (Cop. Bd) (325 words of 342 page book; 5 minutes of 45 minute episode) (On Reserve)

(iii) Might a character in a dramatic work be seen as a substantial part of that work? See *Productions Avanti Ciné-Video Inc. v. Favreau* (1999), 1 C.P.R. (4th) 129 (Que. C.A.)

Performance in Public

(i) Substantiality – see above

(ii) Performance (C.B. p. 300)

Canadian Cable Television Association v. Copyright Board (Canada) (C.B. p. 301)

(iii) In Public

Jennings v. Stephens (C.B. p. 303)

Francis, Day & Hunter Ltd. v. Twentieth Century Fox Corp. Ltd. (C.B. p. 305)

Canadian Admiral Corporation Ltd. v. Rediffusion, Inc. (C.B. p. 306)

Canadian Cable Television Association v. Copyright Board (Canada) (C.B. p. 309)

- (iv) Distinguish “in public” (s. 3(1)) from “to the public” (s. 3(1)(f)). See generally *Canadian Wireless Telecommunications Association v. SOCAN* (2008), 64 CPR (4th) 343 (FCA) (-app. to SCC, March 2008) (Ringtone)

Authorization Right

*R. Howell, *Canadian Telecommunications Law* at pp. 250-252 focused on the latest SCC decisions in *CCH* and *Tariff 22* is assigned. Note the following cases by way of *background* – not assigned in themselves:

- *University of New South Wales v. Moorhouse* (C.B. p. 311)
- *CBS Songs Ltd. v. Amstrad Consumer Electronics Plc* (C.B. p. 317)\
- *Vigneux v. Canadian Performing Right Society* [1945] AC 108 (PC)
- *Muzak Corporation v. Consumers, Authors & Publishers Association of Canada Ltd.* (C.B. p. 325)
- *de Tervagne v. Beloeil* (C.B. p. 328)

*Howell, *Reformulation of Copyright by the Supreme Court of Canada* (2004) (Handout)

[Note the cross over between Conflict of Laws and the authorization right in a transborder context. Relevant issues include where the authorization is to be remedial (jurisdiction, choice of law) and subsequent enforcement. *These matters are not dealt with in this course*, but the linkage should be remembered for your later professional activities. See generally *Disney Enterprises Inc. v. Click Enterprises Inc.* (2006) 49 CPR (4th) 87 and *Sirius Canada Inc. v. CMRRA/SODRAC Inc.* (2010), 89 C.P.R. (4th) 206 (FCA).]

Specific or Enumerated Rights

See C.B. p. 342-348

[Note – We do not have time in this course to give attention to the content and scope of “other subject matter” or so called “neighbouring rights”, nor to “Ephemeral Recordings”. However, for your information and later professional purposes, see R. Howell, *Canadian Telecommunications Law* at pp. 231-234 and 234-238 – *Not assigned.*]

Infringement

See C.B. pp. 348-351 and note generally *Euro-Excellence Inc. v. Kraft Foods Schweiz AG* (SCC) and *Microsoft Corp. v. 9038-3746 Quebec Inc* (2007) 57 C.P.R. (4th) 204 (FC).

See *Gahel v. Corporation Xprima.com* (2008) 68 C.P.R. (4th) 423 at para. 31 (actual or deemed knowledge not relevant to primary infringement under s. 27(1)).

Exceptions, Defences and Fair Dealing

Sony Corp. v. Universal City Studios, Inc. (C.B. p. 352) (cf *Kelly v. Arriba Soft Corp.* (9th Cir. 2002) – On Reserve – Not Assigned)

Allen v. Toronto Star Newspaper Ltd. (C.B. p. 366)

Television New Zealand v. Newsmonitor Services (C.B. p. 369) contrast *SOCAN Statement of Royalties* (noted below).

MCA Canada Ltd. v. Gillberry & Hawke Advertising Agency Ltd. (C.B. p. 375)

See also *Productions Avanti Ciné-Video Inc. v. Faureau* (1999), 1 C.P.R. (4th) 129 (Que. C.A.) and *Hager v. E.C.W. Press Ltd.* (1998), 85 C.P.R. (3d) 289, 309-314 (F.C.T.D.) (On Reserve)

*Howell, *Reformulation of Copyright* (Handout) concerning *CCH Canadian Ltd. v. Law Society of Upper Canada* (2004) SCC 13

*Note *SOCAN Statement of Royalties, Internet-Online Music Services, 1996-2006 (Tariff 22A)*, (2010) 83 C.P.R. (4th) 409 (FCA) paras. 12-22 (re: the meaning of “Research”) and paras. 24-31 (“fair”) in a context of an opportunity to preview downloads of musical works.

*The Federal Court of Appeal in *Bell Canada v. SOCAN* (2010), 86 C.P.R. (4th) 239 found that an intent to offer a work to the public, together with a communication to at least one member of the public, together with a communication to at least one member of the public, constitutes “to the public”. (This case is *not* assigned, simply note this point.)

Chayer v. Sun Media Corp (2006) 47 C.P.R. (4th) 291 (Que Ct) (comment will be made in class) (not assigned)

9) Technology Issues

To complete the linkages between copyright and technology the following readings from R. Howell, *Canadian Telecommunications Law*, chapter 5, “Copyright” are assigned:

a)* *Internet issues (“Location”)*, pp. 238-245 [Note linkage with Conflict of Laws]

b)* *Liability of Intermediaries*, pp. 252-260

c)* *Implementation of 1996 WIPO Treaties*, pp. 260-268

d)* *Private Copying/Regulated Royalties*, pp. 268-272

10) Moral Rights *C.B. pp. 381-397

Snow v. The Eaton Centre Ltd. (C.B. p. 385)

Prise de parole Inc. v. Guérin éditeur Ltée (C.B. p. 386)

John Maryon International Ltd. v. New Brunswick Telephone Co. Ltd. (C.B. p. 391)

**Théberge v. Galerie d'Art du Petit Champlain inc.* (2002), 17 C.P.R. (4th) 161 (S.C.C.) (On Reserve)

**Ritchie v. Sawmill Creek Golf & Country Club Ltd.* (2004) 27 CPR (4th) 222 (Ont. SCJ) (paras 48-53) (On Reserve)

**Enrietti-Zoppo v. Colla* (2007), 63 CPR 4th 377 (Ont. Sup. Ct.) (On Reserve)

11) Miscellaneous C.B. pp. 399-425 [Not Assigned – this list is provided only for your future research purposes. Some aspects – e.g. authorship and ownership – will have been covered earlier in the course.]

(i) Authorship

Kantel v. Frank E. Grant, Nisbet & Auld Ltd. (C.B. p. 399)

Neudorf v. Network Productions Ltd., (1999) 3 C.P.R. (4th) 129 (B.C.S.C.). (Specific readings from this may be assigned – this case is available at [1999] B.C.J. No. 2831.

Editors' Association of Canada Certification Application (2001), 12 C.P.R. (4th) 62 (CAPPRT) (Not Assigned)

Neugebauer v. Labieniec (2009) 75 CPR (4th) 364 (FC) (Not Assigned) (re joint authorship)

Tommy Hilfiger Licensing Inc. v. International Clothiers Inc. (2004) 29 CPR (4th) 39 (FCTD) (re Certificate of Registration)

(ii) Ownership

Notes (C.B. pp. 405-406)

Chancellor Management Inc. v. Oasis Homes Ltd. (2002), 19 C.P.R. (4th) 480 (On Reserve) (re authorship/ownership/s. 34 presumption) (Not Assigned)

Robertson v. Thompson Corp. (2004), 34 CPR (4th) 161 (Ont. CA) (Not Assigned)

(iii) Assignment and Licence

Notes (C.B. pp. 406-408). Note generally *Euro-Excellence v. Kraft Foods Schweiz AG* (SCC 2007).

(iv) Term

Notes (C.B. p. 408)

(v) Remedies

Notes (C.B. pp. 408-409). See *Louis Vuitton Malletier SA v. Young* (2007), 62 CPR (4th) 362 (F.C.)

(vi) Crown Copyright

Notes (C.B. pp. 415-425)

E) TRADEMARK

1. Functionality: *Avoiding Patent Style Protection* – See **Kirkbi AG and Lego Canada Inc. v. Ritvik Holdings Inc.* (Mega Blocks Inc.) (2005) 2005 SCC 65 (On Reserve)

- see also section 13 (distinguishing guise) (discussed in *Kirkbi*). Examples will be referred to in class.

2. Unfair Competition * C.B. pp. 439-441

* Notes (C.B. pp. 439 to 441) especially re *International News Service v. Associated Press* [Full case On Reserve]

* Section 7, *Trade-mark Act* and *MacDonald v. Vapor Canada Ltd.* (C.B. pp. 440 and 447 to 448). See also **Kirkbi* (2005, SCC) noted above. [Mention will be made in class of the relationship between section 7(b) and common law. Section 7(b) requires both a “use” (s. 4) of a trademark and “confusion” (s. 6), see *Positive Attitude Safety System Inc. v. Albian Sands Energy Inc.* (2006), 43 CPR (4th) 418, 427-29 (FCA), but compare *Pharmacommunications Holdings Inc. v. Avencia International Inc.* (2009), 79 CPR (4th) 460 (FCA) – no significant differences between common law and section 7(b)]. [*Positive Attitude* and *Pharmacommunications* are not assigned.]

Breach of Confidence, see Howell, “Trade Secret Protection: A Conceptual Overview” Pacific North West Intellectual Property Forum, Victoria, B.C. (February, 1991) (On Reserve) (Not Assigned)

3. Passing Off

(a) Notes re history * C.B. pp. 443-447

(b) Elements

• The “elements” of passing off will be considered under the following headings:

(i) Goodwill and Reputation

(ii) Misrepresentation

(iii) Damage

(iv) Defences/Exceptions/Disclaimers

However, the overlap between these headings will be obvious from the beginning. The headings are, at best, a checklist and illustrate situations in which the particular head is the primary focus of the particular proceeding.

- In addition, consider the following features that delineate passing off, but are as yet imperfectly analyzed by the courts:
 - (i) The content of a misrepresentation or what factual circumstance must actually be misrepresented in order to constitute an actionable passing off;
 - (ii) The situation presented in (i) above may sometimes be seen as a difficulty of distinguishing between a loss of goodwill by a misrepresentation and as opposed to a loss of goodwill by a pure misappropriation, without any misrepresentation;
 - (iii) A misrepresentation must cause *confusion* in the public; yet it is not entirely clear *who* or *what sector* of the public must be confused to constitute an actionable passing off;
 - (iv) Confusion is ordinarily determined as a matter of evidence, yet the rules for conducting public opinion polling are often imprecise and difficult to apply in practice; and
 - (v) What must be established to constitute “damage”? Can damage be “implied”? What is the role of “nominal damage”?
- Reputation/Goodwill * C.B. pp. 448-541 – Note, the cases below are heavily focused on FACTS. Most do not involve any significant analysis of legal principle. For this reason we go through these cases quite quickly. Those cases that do introduce legal principle will receive emphasis in class where an overview of legal and policy framework is provided.

Erven Warnink (C.B. p. 448)

Andres Wines (C.B. p. 455)

See *Shell Canada and Havana Club* under “Registrability”

Polsinelli v. Marzilli (C.B. p. 474) (contrast *Devinder Shory Campaign v. Richard* (2008) 71 C.P.R. 4th 89 (Alta. Q.B.)).

See generally *Law Society of BC v. Canadian Domain Name Exchange Corp.* (2006) 34 CPR (4th) 437 (BCSC) *affd* 43 CPR (4th) 321 (BCCA).

Oxford Pendaflex (C.B. p. 478)

Ray Plastics Ltd. (C.B. p. 484)

Reddaway (Frank) & Co. Ltd. v. George Banham (C.B. p. 488)

Grand Hotel (C.B. p. 496)

Andres Wines (C.B. p. 535)

Reckitt & Colman (C.B. p. 502)

Eli Lilly & Co. v. Novopharm (C.B. p. 512) *affd* (2000), 10 C.P.R. (4th) 10 (F.C.A.)

Ad-Lib Club (C.B. p. 532)

Orkin Exterminating (C.B. p. 460)

- Misrepresentation *C.B. pp. 543-595 and 598-610

Erven Warnink (noted earlier)

Andres Wines (C.B. p. 543)

“Common Field of Activity” rule – see p. 557

Annabel’s (Berkeley Square) Ltd. v. Schock (trading as Annabels Escort Agency), [1972] R.P.C. 838, 844 (C.A.) *National Hockey League v. Pepsi-Cola Canada Ltd.* (1992), 42 C.P.R. (3d) 390 at 401 (B.C.S.C.) *affd* (1995), 59 C.P.R. (3d) 216 (B.C.C.A.) (On Reserve)

Ciba-Geigy (C.B. p. 559)

Consumer Distributing (C.B. p. 568)

See generally *Edward Chapman Ladies’ Shop Ltd. v. Edward Chapman* (2006) 45 CPR (4th) 321 (BCSC), *affd* (2007) 60 CPR (4th) 1 (BCCA).

Contrast the above cases with *International News Service v. Associated Press* (1918), 248 U.S. 215 (On Reserve) (Discussed above); *Cadbury Schweppes Pty Ltd. v. Pub Squash Co. Pty Ltd.*, [1981] 1 W.L.R. 193 (1980, P.C.) (On Reserve); *Paramount Pictures Corp. v. Howley* (C.B. p. 581); and *Bristol Conservatories* (C.B. p. 587).

Compare the above cases with *Harrods* (C.B. p. 598).

Extra-territorial “goodwill” or reputation

See (i) **Orkin Exterminating* (C.B. p. 460) above

(ii) *Howell, “Parallel Importation of Wares and Reputation Spillover: Examples of Transnationalization of Law” in *Asia-Pacific Legal Development* ed. D.M. Johnston and G. Ferguson, UBC Press, Vancouver, 1998 at pp. 106-111 (On Reserve) discussing *Orkin* as well as *Walt Disney Productions v. Triple Five Corp.* (1994), 53 CPR (3d) 129 (Alta. C.A.) (leave to appeal to S.C.C. denied (1994), S.C.C. Bulletin 1210). For later proceedings see *Walt Disney Productions v. Fantasyland Hotel Inc.* (1994), 56 C.P.R. (3d) 129 (Alta. Q.B.) *affd* (1996), 67 C.P.R. (3d) 444 (Alta. C.A.)

*Howell, “Disney and Fantasyland in Alberta: One Fantasy Too Many” (unpublished paper: 1995) (On Reserve)

(iii) C.f. Parallel Importation (to be discussed later). See Howell, *ibid.*

Damages – see generally C.B. pp. 596-597 and *Law Society of BC; Edward Chapman*; and *2703203 Manitoba Inc. v. Parks* [these cases were referred to earlier in other contexts]

Defences *C.B. pp. 611-618

Unclean Hands

Use of One’s Own Name

Concurrent prior use

Disclaimers – C.B. p. 618

- Recall *Consumer Distributing* (C.B. p. 598)

- *National Hockey League v. Pepsi-Cola Canada Ltd.* (1992), 42 C.P.R. (3d) 390 at 408-409 (B.C.S.C.) *affd* (1995), 59 C.P.R. (3d) 216 (B.C.C.A.) (On Reserve)

Internet perspectives – See *B.C. Automobile Association v. OPEIU Local 378* (2001), 10 C.P.R. (4th) 423 (B.C.S.C.) (Not Assigned) and *Vulcan Northwest Inc. v. Vulcan Ventures Corp.* (2001), 12 C.P.R. (4th) 95 (F.C.T.D.) (Not Assigned)

4. Prohibited Marks [Not Assigned]

- (a) Sections 9-11.2 *Trade-marks Act* – See *FileNET Corp. v. Canada* (2001), 13 C.P.R. (4th) 385 (F.C.T.D.) and *Canada Post Corp. v. Epost Innovations Inc.* (2001), 12 C.P.R. (4th) 41 (F.C.T.D.) (Not Assigned) (CB pp. 679-684).
- (b) C.f. constitutional issues presented under s. 7, *Trade-marks Act*.

5. Registered Trademarks

(a) **Introduction *C.B. pp. 639-648**

See also **Kirkbi* (2005, SCC) concerning the relationship between the *Trade-marks Act* and common law and *Civil Code* (Quebec).

(b) **Definition of “trademark”**

“Distinguishing Guise” s. 13 (cf “get up” at common law) *C.B. pp. 688-692 including *Dominion Lock Co. Ltd. v. Schlage Lock Co.*

Proposed trademark – “adapted to distinguish”

Certification mark, s. 23 (C.B. pp. 692-694)

(c) **Registrability *C.B. pp. 648-688: Section 12**

Standard Oil (C.B. p. 648)

Non-assigned recent examples:

1. *Claisse v. Claisse Scientific Corp.* (2009), 81 CPR (4th) 133 (TMOB)
2. *Jurak Holdings Ltd. v. Biotech Laboratories Ltd.* (2006), 50 CPR (4th) 337 (TMOB)
3. *Waterford Wedgwood PLC v. Forma Kutzcher GmbH* (2006) 50 CPR (4th) 358 (TMOB)

Drackett & Co. (C.B. p. 653)

Home Juice Co. (C.B. p. 655)

Cf. *Shell Canada Ltd. v. P.T. Sari Incofood Corp.* (2004) 32 CPR (4th) 180 (TMOB) (Re JAVACAFE) and *Havana Club Holdings SA v. Bacardi & Co.* (2005) 35 CPR (4th) 541 (TMOB) (“Old Havana” Rum)

Note re *Genericness* (C.B. p. 659)

United Artists Corp. (C.B. p. 661) (See also *Toyota Jidosha Kabushiki Kaisha v. Lexus Foods Inc.* (2000), 9 C.P.R. (4th) 297 (F.C.A.))

For a recent example see *North American Leisure Group Inc. v. ETC Inc.*, (2007) 62 CPR (4th) 313 (TMOB)

Note re disclaimers (C.B. pp. 686-688)

Note re “secondary meaning” or “acquired distinctiveness” (C.B. pp. 684-685)

Registered foreign marks – see C.B. pp. 685-686 (s. 14)

Convention priorities – see ss. 31-34

Disclaimer – see s. 35 (C.B. pp. 686-688)

(d) **Famous Marks**

* *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22 (June 2, 2006) (On Reserve)

* *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, 2006 SCC 23 (June 2, 2006) (On Reserve). Especially note comments re s. 22, *Trade-mark Act*.

The history of section 22 will be discussed in class – see generally *Remo Imports Ltd. v. Jaguar Cars Ltd* (2006), 47 CPR (4th) 1 (FC) re a lower standard of “connection” under s. 22 than for “confusion” in s. 6 (Not assigned).

* Howell “Depreciation of Goodwill: A ‘Green Light’ for Dilution from the Supreme Court of Canada in an Accommodating Infrastructure” (2008), 17 *Transnational Law & Contemp. Prob.* 689 (On Reserve) [Specific reference will be given in class to key pages.]

* Re “confusion” – see *Masterpiece Inc. v. Alavida Lifestyles Inc.* 2011 SCC 27 (On Reserve)

(e) **Registration/Objection Process**

* Sections 37 and 38 c.f. s. 18

* Sections 16 and 17

(f) **Entitlement to Register *C.B. pp. 694-702**

*Sections 16 and 17

**Citrus Growers Association Ltd. v. William D. Branson Ltd.* (C.B. p. 695)

*Sections 2 and 4 re “Use” and “Used”

*Section 5 re “made known”

**Robert C. Wian Enterprises Inc. v. Mady* (1965), 49 D.L.R. (2d) 65 (Ex. Ct.) noted in C.B. p. 701 (Full case On Reserve)

Compliance with section 30.

*Consider the significance of section 14 (instead of section 12) for marks registered in a foreign treaty country. However, note that while section 14 will avoid section 12, it does not alter the standard of distinctiveness to be met under section 18. See *Apotex Inc. v. Canada (Registrar of Trademarks)* (2010), 81 CPR (4th) 459 (FC).

(g) **Post Registration Validity - *C.B. pp. 702-709**

Sections 45 and 46

Porter v. Don The Beachcomber (C.B. p. 703)

(h) **Invalidity - *C.B. pp. 709-716**

(i) *Section 18

- 18(1)(a) – was not registrable at the date of registration (c.f. s. 38(2)(b)) (link with s. 12)

- 18(1)(b) – not “distinctive” at the time proceedings commenced (c.f. s. 38(2)(d))

- 18(1)(c) – has been abandoned

- 18(1) (final paragraph) (and s. 17) – the applicant is not the person entitled to secure the registration (c.f. s. 38(2)(c) – distinguish s. 37(1)(c))

(ii) Distinctiveness

* *Aladdin Industries Inc. v. Canadian Thermos Products Ltd.* (C.B. p. 716)

* *Reddaway (Frank) & Co. Ltd. v. George Banham & Co. Ltd.* (C.B. p. 488)

* *E&J Gallo Winery & Andres Wines Ltd.*, [1976] 2 F.C. 3 (F.C.T.D.) (On Reserve)

Contrast *Robert C. Wian Enterprizes Inc. v. Mady* (1965), 49 D.L.R. (2d) 65 (Ex. Ct.)

(iii) Abandonment

* *Promafil Canada Ltée v. Munsingwear Inc.* (C.B. p. 717)

(i) **Expungement *C.B. pp. 727-737**

Remington Rand Corp. v. Phillips Electronics NV (C.B. p. 728)

(j) **Infringement - *C.B. pp. 737-746**

*Sections 19 and 20

*Sections 2 and 4 re “use” and “used”

Mr. Submarine Ltd. v. Amandista Investments Ltd. (C.B. p. 738) and **Masterpiece Inc.* (SCC, 2011) (above).

Not assigned: *Atomic Energy of Canada Ltd. v. AREVA NP Canada Ltd.* (2009), 78 CPR (4th) 113 (F.C.) emphasized a comparison of the overall presentation of the competing marks, rather than a focus on a “somewhat hurried customer”.

6. Appropriation of Personality

(a) See generally C.B. chapter 15 and Howell, “The Common Law Appropriation of Personality Tort” (1986), 2 I.P.J. 149 (On Reserve).

(b) *Howell, “Publicity Rights in the Common Law Provinces of Canada” (1998), 18 *Loy. L.A. Ent. L.J.* 487 (Supplemental Materials Package)

(c) *Aubry v. Les Editions Vice-Versa Inc.*, [1998] 1 S.C.R. 591 noted in C.B. p. 396 re privacy. C.f. *Dowell v. Mengen Institute* (1983), 72 C.P.R. (2d) 238 (Ont. H.C.).

(d) Compare:

Exhibition right in copyright *(C.B. pp. 346-348)

Parody and fair dealing *(C.B. pp. 374-375)

Passing Off - *See *Anne of Green Gables Licensing Authority Inc. v. Avonlea Traditions Inc.* (2000), 4 C.P.R. (4th) 289, 332 (Para. 156), 335 (Para. 163) (Ont.) (On Reserve)

Parody and moral rights *(C.B. pp. 396-397)

(e) Statutory Privacy Acts – see *C.B. pp. 864-868 including *Joseph v. Daniels* (p. 866)

(f) *Trade-marks Act* s. 9 *(C.B. pp. 869-870). See *Villeneuve v. Mazsport Garment Manufacturing Inc.* (2006) 50 CPR (4th) 127 (TMOB).

7. Parallel Importation/Grey Marketing: Trademarks and Unfair Competition

(i) *Principal reading for this topic is Howell, “Parallel Importation of Wares and Reputation Spillover: Examples of Transnationalization of Law” in *Asia-Pacific Legal Development* ed. D.M. Johnston and G. Ferguson, UBC Press, Vancouver, 1998 at pp. 84-128 (Supplemental Materials Package)

(ii) Particular attention should be given to:

- With respect to registered trademarks, sections 48 (transfer or assignment of trademark) and 50 (licence of trademark) – contrast the terms of these provisions, especially concerning “deemed distinctiveness”. The difference is illustrated by contrasting the cases of *Wilkinson Sword (Canada) Ltd. v. Juda* (1966), 34 Fox’s Pat. Cas. 77 (Ex. Ct.) and *S.C. Johnson & Son Ltd. v. Marketing International Ltd.*, [1980] 1 S.C.R. 99. (Copies of these cases are On Reserve)
- With respect to registered trademarks involving an *assignment* of a trademark to an authorized distributor for a region, consider the distinction between *Remington*

Rand Ltd. v. Transworld Metal Co., [1960] Ex. C.R. 463 (T.D.) (On Reserve) where the authorized distributor succeeded and *Wilkinson Sword (Canada) Ltd. v. Juda* (1966), 34 Fox's Pat. Cas. 77 (Ex. Ct.) (On Reserve) and *Breck's Sporting Goods Co. v. Magder* (1975), 17 C.P.R. (2d) 201 (S.C.C.) (C.B. p. 710) where the authorized distributor failed. See Howell, *ibid.* at pp. 92-96 and *Coca-Cola Ltd. v. Pardhan* (below).

- With respect to registered trademarks involving *licensing* of a trademark to an authorized distributor for a region see *Smith & Nephew Inc. v. Glen Oak Inc.* (1996), 68 C.P.R. (3d) 153 (F.C.A.) (C.B. p. 771). See Howell, *ibid.*
- See *Coca-Cola Ltd. v. Pardham* (1999), 85 C.P.R. (3d) 489 (F.C.A.) and (1999), 85 C.P.R. (3d) 501 (F.C.A.) (On Reserve). For subsequent proceedings see (1999) 4 C.P.R. (4th) 203 (F.C.T.D.).
- With respect to copyright see handout on *Euro-Excellence Inc. v. Kraft Foods Schweiz AG* (2007: SCC).