

INTELLECTUAL PROPERTY IN CANADA

The various forms of intellectual property in Canada are governed under the following federal legislation: the *Patent Act*, the *Trade-marks Act*, the *Copyright Act*, the *Industrial Design Act*, and the *Integrated Circuit Topography Act*. The Canadian Intellectual Property Office (CIPO) is responsible for administering these acts. CIPO also maintains databases of registered patents, trade-marks, copyrights, industrial designs and circuit topographies. Intellectual property protection is also available for breeders of plants under the *Plant Breeders' Act*, which is administered by the Canadian Food Inspection Agency.

PATENTS

What is protected? A Canadian patent gives the inventor the right to exclude others from “making, using or selling” the patented. Patents may be issued for any new (*ie.* not already publicly disclosed), useful (*ie.* functional and operative), and inventive (*ie.* non-obvious to someone skilled in the art) product, process, apparatus or chemical composition. A patent will be granted only for the physical embodiment of an idea. You cannot patent a scientific principle, an abstract theorem, an idea, some methods of doing business, or a computer program *per se*.

Duration and scope of registration: Patent rights begin on the date the patent is granted and run for a maximum of 20 years after the filing date of the application, provided that the required maintenance fees are paid. The rights given by a Canadian patent extend throughout Canada, but not to other countries.

How to protect your rights: A patent will be given to the inventor who first files an application. If an inventor sells his or her rights, then the purchaser of those rights may file an application. If the inventor makes the invention as part of an employment contract, the employer may own the invention and have the right to the patent.

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A preliminary search of the Patent Office records is advisable as it may reveal that the invention or a similar one has already been patented.

You should not advertise, display or publish any information about your invention before you are ready to file for a patent. Public disclosure of your invention before filing a patent application may make it impossible to obtain a valid patent.

Foreign registrations: Canada is a signatory to the *Paris Convention for the Protection of Industrial Property* (the *Paris Convention*). This treaty allows someone who has previously filed a patent application in a convention member country to claim the benefit of the foreign filing date for an application for the same invention that is filed in Canada within the following 12-month period.

Canada is also a signatory to the *Patent Cooperation Treaty* (PCT), administered by the World Intellectual Property Organization (WIPO) in Geneva. Under the PCT, a person may file for a patent in over 130 other PCT member countries through a single application filed in Canada.

TRADE-MARKS

What is a trade-mark? A trade-mark is a word, symbol or design (or a combination of these) that distinguishes the wares or services of one person or organization from those of another. CIPO has also recently begun

accepting applications for registration of trade-marks consisting of sound.

Is a trade-mark registration required? It is not necessary to obtain a registration in order to acquire rights to a trade-mark being used in Canada. Trade-mark rights may be acquired at common law through use of the trade-mark over a period of time. However, a trade-mark registration provides certain advantages, namely (a) the owner of a registered trade-mark has *prima facie* exclusive rights to use the trade-mark throughout Canada; (b) a registration, under most circumstances, allows the owner to more easily assert priority over others attempting to register the same or similar mark; (c) a registration potentially makes it easier for the owner to stop infringement of the trade-mark.

Duration and scope of protection: Trade-mark registrations are valid for 15 years from the date of registration and may be renewed for successive 15-year periods. Canadian trade-mark registrations will protect the trade-mark only in Canada.

How to protect your rights: Canadian trade-mark applications may be based on prior use of the trade-mark in Canada or on proposed use in Canada. However, before the final registration of a proposed use trade-mark will be granted, the applicant must confirm that use in Canada has begun. Canadian applications may also be based on registration of the mark in the applicant's country of origin and use by the applicant in that country.

If a registered trade-mark has not been used over a specified period of time, the registration may be subject to cancellation.

Foreign registrations: Under the Paris Treaty, applicants for a Canadian trade-mark may claim a convention priority date for any trade-mark filed in a member country within the 6-month period im-

mediately preceding the date of the Canadian application.

Canada is not a party to the Madrid Protocol, which created a system for the international registration of marks, administered by the WIPO. Therefore, an owner who has registered their trade-mark under the Madrid system cannot extend that registration to Canada and must file a separate application in Canada.

COPYRIGHT

What is protected? Copyright applies to all original, dramatic, musical, artistic, and literary works (including computer programs). It also applies to performances, communication signals and sound recordings. Copyright gives the owner the sole right to produce, reproduce, perform, communicate or translate the work.

Duration of protection: Copyright protection in Canada currently lasts for the life of the author, plus 50 years.

Is a copyright registration required? Because copyright arises automatically on the creation of a work (provided the author meets certain citizenship requirements), there is no need to register the copyright. However, registration does have certain advantages. A registered copyright is *prima facie* evidence of the existence and ownership of copyright, a presumption that is useful if the copyright is litigated. Also, a copyright registration is deemed notice of copyright, enabling the owner to obtain both damages and injunctive relief in an infringement action. Copyright is registered by means of an application submitted to CIPO.

Foreign registrations: Canada is a member of the *International Copyright Convention* (the *Berne Convention*) and of the *Universal Copyright Con-*

vention. Under these treaties, copyright subsists in all original literary, artistic, dramatic and musical works, provided that the author is a citizen or resident of a treaty country, or the work, if published, was first published in a treaty country. Under the *Universal Copyright Convention*, each contracting nation agrees to protect works first published in other contracting nations, provided that the published copies of the work are marked with the symbol © followed by the date of first publication and the name of the copyright owner.

INDUSTRIAL DESIGNS

What is an industrial design? An industrial design is the visual features of any original shape, configuration, pattern or ornamentation (or any combination of these) applied to a finished article made by hand, tool or machine. Examples of industrial designs are: the shape of a bottle; the visual features of a shoe; a wallpaper pattern.

What is protected? The owner of an industrial design registered under the *Industrial Design Act* has the exclusive right to make, import, and sell any article to which the industrial design has been applied.

How to protect your rights: An application to register an industrial design must be filed by the “first proprietor” of the design within 12 months of the publication of the design in Canada or anywhere else in the world. The author of a design is the first proprietor of the design unless the design was executed for another person for consideration or payment, in which case that other person is the first proprietor.

Although marking is not a condition to protection of a design, in order to ensure a right to damages in an infringement action, the articles to which the industrial design has been applied (or the packaging containing such articles) must be marked with

the symbol consisting of a capital D in a circle, together with the name of the proprietor.

Duration: An industrial design registration will provide protection for a period of 10 years, provided that the applicable maintenance fee is paid before expiry of the first 5 year plus 6 months of the registration.

INTEGRATED CIRCUIT TOPOGRAPHIES

What is integrated circuit topography? An integrated circuit product is a device in which miniaturized electronic circuits are integrated, commonly referred to as microchips or semiconductor chips. Integrated circuit topographies refer to the three-dimensional configurations of electronic integrated circuit products or layout designs.

What is protected? A registration grants the owner exclusive rights (subject to some exceptions) to reproduce the topography, manufacture the integrated circuit incorporating the topography, and import or commercially exploit the topography or an integrated circuit product incorporating it.

How to protect your rights: An application to register topographies must be filed within 2 years of the date of first commercial exploitation of the topography anywhere in the world.

This publication is for general information only and does not constitute legal or other professional advice. For more information regarding the subject matter of this article please contact:

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