Marks

1. For each of the following goods and services, briefly describe two manners in which a trademark could be associated with them (i.e. where the trademark could be displayed) in compliance with the “use” requirement under Section 4 of the Trademarks Act.

[8 Marks]

2 (a) Running shoes
2 (b) Restaurant services
2 (c) Bananas
2 (d) High speed internet services

2. Briefly discuss the registrability of the following trademarks. Point form answers are acceptable:

[4 Marks]

2 (a) DELIZIOSO for frozen desserts. “Delizioso” is the Italian word for “delicious”.
2 (b) UNCLE RAY’S HOLIDAYS for travel agent services. The applicant’s name is Raymond Ebrahimi.

6 3. Susie wants to register the trademark HILLARY CLINTON for women’s business clothing. Identify two registrability issues, and for each issue briefly explain how the issue might be overcome (without changing the trademark).

4. Calvin applied to register the trademark GATOR in association with scooters. The application was filed on June 1, 2015 based on use of the mark since January 1, 2015. The application is now (i.e., in April 2016) being examined by an Examiner in the Canadian Intellectual Property Office. Explain whether the Examiner will or will not raise objections to Calvin’s application based on the following facts and provide reasons for your conclusions. Treat each one separately, not cumulatively.
3 (a) There is a pending Canadian trademark application for the trademark GATOR for use in association with scooters, filed by Moe on August 1, 2015 claiming use of the mark in Canada since September 1, 2013.

3 (b) The Government of the State of Florida adopted and began using the mark GATORS on January 1, 1910 in association with sports promotion among youth. On December 1, 2014, the Florida Government filed a request with the Registrar of Trademarks for the Registrar to give public notice of the Florida Government’s adoption and use of GATORS as an official mark under s. 9(1)(n)(iii) of the Trademarks Act. The Florida Government’s s. 9(1)(n)(iii) request remains pending and the Registrar has not given any public notice of the adoption and use.

4 (c) Hobbes, a resident of England, has a pending Canadian trademark application for the mark GATOR for use in association with scooters. Hobbes’ Canadian application was filed on August 1, 2015 and is based on two grounds: (i) Hobbes’ proposed use of the mark in Canada; and (ii) Hobbes’ use and registration of the mark in England. Hobbes’ English registration for the mark issued on February 1, 2015 based on an application filed in England on October 1, 2014.

5 Bert owns a Canadian trademark registration for the mark SESAME AVENUE. In association with this trademark, Bert produced a successful and sophisticated TV cooking show featuring world renowned chefs. After several years, Bert burnt out, and decided to take a hiatus from TV production by living “off the grid” in the Amazon jungle for an indefinite time. To finance his Amazon adventure, Bert licensed the SESAME AVENUE mark to Ernie in return for a lump sum upfront royalty payment. Ernie, having much a different opinion on viewer demand, rebranded the show as SESAME WITH THE KARDASHENANIGANS featuring the cooking skills (or lack thereof) of celebrity socialites. It has now been five years since Ernie took over the show. Explain why Bert’s registration for SESAME AVENUE may be vulnerable to a third party’s challenge.

END OF PART I
(Use a new booklet for Part II)
Briefly comment with justifying reasons on whether the following subject matter is patentable in Canada, assuming it is new, non-obvious and useful:

(a) A method of editing genes. The method can be used to treat many forms of inherited disease in humans, help counter antibiotic-resistant microbes, disable parasites and improve global food security.

(b) A cannabis (marijuana) plant cultivar which has been bred to produce a medicinal compound for treatment of specific disease conditions such as chronic pain, emesis (nausea/vomiting) and epilepsy.

(c) A computer-implemented method of calculating the average daily value of a portfolio of exchange-traded funds (ETFs) and comparing that value to a benchmark index.

Nick invented a new hand-held device for converting a smart phone for use as a stethoscope (i.e. to hear and record a patient’s heartbeat) in November of 2014. He first disclosed the device to the public at a conference to showcase the innovations of young inventors held in Munich, Germany in February of 2015. The structure and operation of the device was described generally by Nick at the conference in a ten minute presentation to potential investors, but the electronic circuitry for amplifying and recording acoustic signals was not mentioned. After attracting the attention of some venture capital funds, Nick eventually filed a Canadian patent application for his device on March 15, 2016. Is Nick’s Canadian patent application valid? Do you need any further information in order to fully advise Nick?

Tara has developed a hair straightening formulation which comprises a combination of amino acids, pH-reducing agents, botanicals, surfactants, emollients, emulsifiers, skin-cleaning agents, preservatives, fragrances, conditioners, and thermal protectants. The formulation is effective when used at a much lower temperature than conventional hair straighteners and does not require the application of highly toxic formaldehyde chemicals. The formulation is therefore safer and causes less damage to hair than conventional straighteners. Tara filed a Canadian patent application for her formulation in December of 2013. The application describes the formulation in detail and includes a single claim directed to the combination of a specific class of amino acids and pH-reducing agents which Tara has determined are the active ingredients of her formulation for achieving the hair straightening effect. The application also mentions that “the formulation may also be effective in promoting hair re-growth in some individuals”, but no examples are provided. Tara’s application has now been filed...
examined and the Examiner has rejected claim 1 pursuant to sections 2 and 28.2(1)(b) of the Patent Act. The Examiner contends that the claim lacks utility since the application fails to demonstrate or soundly predict that the formulation will achieve hair re-growth and hence the “promise of the patent” has not been fulfilled. The Examiner has also cited one prior art reference which discloses a shampoo having a very different combination of ingredients but which does include the same class of amino acids and pH-reducing agents as claimed by Tara. Advise Tara on her prospects for overcoming the Examiner’s rejections.

4 4. The following is an excerpt from an editorial entitled “Time to fix patents” published in the August 8, 2015 edition of the The Economist magazine:

“Innovation fuels the abundance of modern life. From Google’s algorithms to a new treatment for cystic fibrosis, it underpins the knowledge in the “knowledge economy”. The cost of the innovation that never takes place because of the flawed patent system is incalculable”.

Briefly discuss whether you agree or disagree with this statement and provide examples.

3 5. What is the risk if an inventor intentionally obscures the true nature of her invention, for example by describing and claiming an invention in very broad terms in a patent application but withholding the preferred embodiment of the invention as a trade secret?

3 6. According to Canadian case law, when will an invention be considered “obvious to try”?

6 7. Ruby is the owner of a Canadian patent entitled “Animal Warming System”. The invention relates to a blanket designed to provide warm air heating for animals recovering from surgery in veterinary cages. The blanket consists of two layers forming a hollow space between them into which warm air is delivered from a forced warm air heating system. The blanket is preferably formed from a permeable polyester material so that the warm air is diffused over the surface of the material. Ruby's Canadian patent includes a single claim which recites “a blanket comprising a first layer and a second layer defining a space therebetween for receiving warm air from an air supply, wherein the layers are formed from an air-permeable material”.

Ruby has recently become aware of a US company, Pet Innovations Ltd., which is selling a competing animal warming product in Canada. The competing product also includes a blanket consisting of two polyester layers, but only the upper layer in contact with the animal is air-permeable.

Advise Ruby whether she has good grounds for suing Pet Innovations Ltd. for patent infringement in Canada. Consider whether your advice would be any
different if the description portion of Ruby’s patent includes the following statement:

“The blanket or a portion of the blanket may include one or more air holes or it may be of a porous/permeable material, to allow warmed air through the blanket to warm the patient.”

END OF PART II
(Use a new booklet for Part III)
Marks

1. Answer the following questions, citing statutory or case law authority and explaining your reasoning as appropriate. Point form answers are acceptable.

[13.5 Marks]

2 a) How does copyright law establish an interface between copyright and industrial design protection, with reference to statutory authority? Why is it important to be aware of this difference?

2 b) What is the “notice-and-notice” regime, and how is this different from the corresponding U.S. regime? What statutory sections establish this regime?

2 c) What does it mean to say that copyright arises automatically and what is the source of this concept? Why would someone ever register copyright?

2 d) What is the principle of technological neutrality? What Supreme Court of Canada case established this principle in Canadian law?

3 e) In 1956, Steve set up a camera in Antarctica and collected 200 hours of footage of penguins walking in front of the camera. Steve titled this footage “Lives of the Penguins” and published this footage through National Geographic in 1960. Steve passed away in 2014. When did copyright expire, or when will copyright expire, in “Lives of the Penguins”?

2.5 f) What is the reversionary right in copyright? What section of the Copyright Act provides this right? Briefly explain why this right is in the Copyright Act.
2. Do the following acts give rise to liability for infringement of copyright or moral rights in Canada if done without the consent of the copyright/moral rights owner? Explain briefly, citing case or statutory authority. Point form answers are acceptable.

Detailed analysis of potentially complicating issues is not expected -- deal with only the single most relevant potential issue and one authority in your response.

[5 marks]

1 a) Moving an original painting in which copyright subsists from the main display hall to the basement of an art gallery.

1 b) Posting a copy of your child lip synching a modern hit song on Facebook.

1 c) Copying a translation of your own book, where you did not translate the book and had no agreement with the translator regarding ownership of copyright.

1 d) Drawing a moustache on the Mona Lisa, in which copyright has expired.

1 e) Using a mathematical system of coloured rods to teach children math using a methodology described in a book in which copyright subsists.

3.5 3. Briefly explain the concept of “fixation” in copyright law, citing legal authority. List three reasons why fixation is a requirement for copyright to subsist in a work. Identify one example of where copyright can subsist without fixation, citing legal authority.

3.5 4. Explain briefly what is meant by the phrase “idea/expression dichotomy” in copyright law. Explain briefly how the law deals with this problem, using either B.C. Jockey Club v. Standen (BCCA 1985) or Cinar Corporation v. Robinson (2013 SCC 73) as an example. Include a description of the two-part test for assessing infringement in Canadian copyright law.

3 5. What are the two steps of the test for assessing whether an activity constitutes fair dealing in Canadian copyright law? Can Canadian courts add new exceptions for fair dealing? Briefly explain why or why not and, from a policy perspective, state whether you think the Canadian approach to fair dealing is better or worse than the American approach. Provide one rationale supporting your position.
You represent recording artist and DJ Cheryle Crooner. She has come to you because rap artist Kyle East has incorporated a remix of musical works prepared by Crooner into his latest hit song without her permission. Although there are some differences in the tempo of the works incorporated into East’s song, the musical works used and their order is identical to Crooner’s remix.

Crooner advised you that although the musical works that were incorporated into her remix were created by other people, she had spent considerable time and effort determining what works to be included, how to modify the works for the remix, and in what order the works should be used (not to mention time spent clearing all copyright in those works). Furthermore, she had mailed a CD with her remix on it to Kyle East’s recording company via registered mail for consideration, and she has provided you with a copy of the delivery confirmation.

Based on these facts, you wrote a nasty letter to Kyle East’s lawyer. She responded that her client had never received the CD because his recording company does not permit him to receive such materials. Furthermore, she stated that all of the musical works used in East’s song were written by people other than Cheryle Crooner, and therefore that East was free to incorporate them into his hit song.

Without going into available remedies, briefly advise Crooner on whether East is liable for copyright infringement.