

Top 10 High-Tech IP Issues in Canada

Gowlings' top-ranked IP team will help you address these important issues.

Patents

1) What to File. Evidence for a Declaration of Entitlement is required before a filing date in Canada and may include:

- Assignment (executed before the Canadian filing date). This should also be filed at the Canadian Patent Office. Any assignment executed after the PCT filing date cannot be used as a basis for Entitlement.
- Employment agreement
- Oral or another agreement (recommend filing a confirming assignment of an oral agreement)

2) Where to File. Voluntary Divisional Applications should be filed following receipt of a unity of invention objection issued by the Examiner, but should not be filed with the Canadian Patent Office. In order to ensure a unity of invention objection is raised, additional claims directed to any desired subject matter should be filed as early as possible during prosecution. There are no excess claim fees in Canada. However, maintenance fees on the divisional application are due from the date of filing of the parent application.

3) What is Patentable. Computer programs per se expressed as lines of code or listings are the subject of copyright protection, but software that has been integrated with a traditionally patentable subject matter may be patentable if the traditional criteria for patentability are satisfied. Certain criteria exist in Canada defining how a method is considered patentable art. The criteria do not also automatically exclude business method-related inventions either. Subject matter that lays claim solely to the skills of a professional or uses a computer to automate a professional task is not considered patentable in Canada.

4) How Claims Differ. Computer-implemented inventions may be claimed using different claim types. The types typically include: (i) art or process claims (e.g. a method); (ii) machine claims (e.g. an apparatus or system); and (iii) manufacture claims (to a computer program product or computer media embodying code or data structures). Signal claims such as computer programs embodied in a propagated carrier wave are not considered patentable subject matter.

IP Litigation

5) Claims Construction. A Markman-styled hearing is not available in Canada. The trial judge will construe the claims after hearing the evidence and submissions of the parties at trial. Summary judgment motions are uncommon in Canadian patent litigation as a requirement by the Judge to resolve any conflicting expert testimony on claim construction requires a trial. In Canada, claims are given a "purposive construction," which cannot have regard to evidence outside the specification.

6) Discovery. Relevance is framed by the pleadings. Formal interrogatories are permitted only on consent and are rarely used. However, a request to admit facts and documents can be served at any time. There is only an oral examination of a

single corporate representative. Answers must be given based on the best information, knowledge and belief of the witness. Irrelevant questions may be refused and there is no obligation to answer under objection. Undertakings to provide further answers or to produce documents are routinely given during examinations.

7) Remedies. Remedies in Canada are similar to those in the U.S. Differences include the inability to claim treble damages for intentional infringement, and also the practice that the defeated party pays at least a portion of the winning party's court costs.

Trade marks

8) Protecting Official Marks. Official marks are broader and more easily enforced than regular trade marks since others are prohibited from adopting a mark which is likely to be mistaken for an official mark. This test only considers the resemblance between the marks at issue and does not account for whether there is overlap in the channels of trade or goods and services at issue. It's also important to prohibit the promoting or directing of public attention to a business in a manner that misleads or is likely to mislead the public into believing that its business, wares or services are approved, authorized or endorsed by the owner of the mark.

9) Misstatements and Validity of Registrations. Canada's Federal Court confirmed a trade mark registration could be invalidated by two types of misstatements made during the application process: (i) fraudulent intentional misstatements and (ii) innocent misstatements that are material in the sense that without them the section 12 barriers to registration would have been insurmountable. Therefore, Canadian law can be distinguished from the American law where a material misstatement renders a registration void.

10) Cooling-Off Periods. Canada's Trade Mark Office will introduce new practices for opposition proceedings on March 31, granting extensions of time amounting to a cooling-off period. The Office will grant each party one extension of time (on consent) up to a maximum of nine months. This nine-month extension of time can be requested by the opponent either before the filing of the Statement of Opposition or opponent's evidence, and by the applicant either before the filing of the Counterstatement or applicant's evidence. The practice notice also explains the Office will not generally grant extensions of time beyond these two nine-month periods to negotiate settlement.

More Than IP

Gowlings can also assist you with your business law (including M&A and tax), employment, and regulatory (including biosimilars and filing in Canada) issues.

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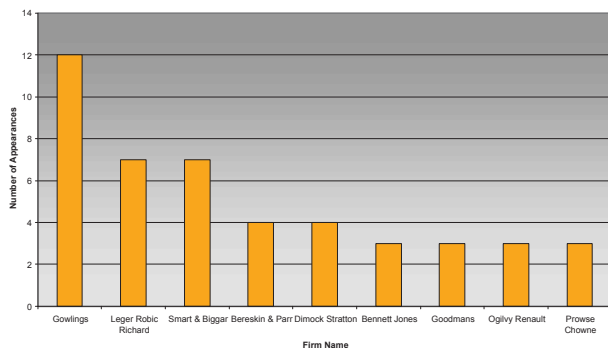
Six Gowlings patent experts named as world leaders in their practice
Legal Media Group, Guide to the World's Leading Patent Law Practitioners

A “leading” IP firm in Canada, including 10 professionals ranked as leaders in IP in Canada
Practical Law Company, PLC Which Lawyer? Yearbook

#1 ranking as an IP Firm in Canada with nine professionals ranked as IP leaders
Chambers and Partners, Chambers Global Guide

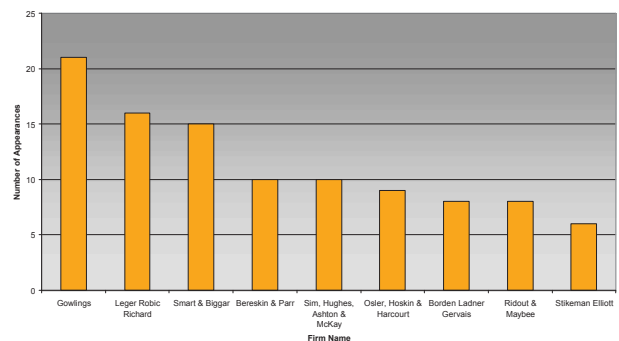
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Total Firm Appearances in Patent Infringement Actions*, 2004-2009



*Data represents judgments rendered from 2004 to February 2009 for reported patent infringement actions. For the purposes of this data, patent infringement actions are defined as trial and appeal decisions of the Federal Court and Federal Court of Appeal, and appeal decisions of the Supreme Court of Canada. Motions, judicial review applications and PM(NOC) proceedings were not included. Firms with fewer than 3 appearances were omitted. Appearances include representations of plaintiff, defendant or intervenor.

Total Firm Appearances in Trademark Proceedings*, 2004-2009



*Data represents judgments rendered from 2004 to February 2009 for reported trademark proceedings. For the purposes of this data, proceedings include actions and TMOB appeals at the Federal Court, Federal Court of Appeal, and Supreme Court of Canada. Motions (except granted summary judgments), and judicial review applications were omitted. Firms with fewer than 6 appearances were omitted. Appearances include representations of plaintiff (in an action) or applicant (in a TMOB appeal), defendant (to an action) or respondent (to a TMOB appeal), or intervenor (in either an action or TMOB appeal).

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