

Intellectual Property: What You Need To Know

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What is Intellectual Property?

Intellectual Property = IP

- IP is categorized as an intangible property
- Right to exclude others from doing something
 - Usually over something you created / invented / developed
 - Results in a monopoly over the “something” in question
- IP Law
 - Provides incentives to creators and inventors by rewarding innovation/creation while balancing the interests of the public to enjoy the innovations/creations

Types of IP

- **Patents** - new and useful inventions
- **Trademarks** - 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** - literary, artistic, dramatic or musical works
- **Industrial designs** - visual features of shape, configuration, pattern or ornament, or any combination of these features applied to a finished article
- **Integrated circuit topographies** - 3D configurations of electronic circuits embodied in integrated circuit products or layout designs
- **Trade secrets** – secret information

Multiple types of IP

- A creation/innovation can involve more than one type of IP

Patents

| | | |
|---|---|---|
|  Office de la Propriété Intellectuelle du Canada Un organisme d'Industrie Canada | Canadian Intellectual Property Office An agency of Industry Canada | CA 2658413 C 2011/11/01 (11/21) 2 658 413 BREVET CANADIEN CANADIAN PATENT (13) C |
| (86) Date de dépôt PCT/PCT Filing Date: 2007/09/05 (87) Date publication PCT/PCT Publication Date: 2008/03/13 (40) Date de délivrance/Issued Date: 2011/11/01 (88) Entrée phase nationale/National Entry: 2009/01/16 (89) N° demande PCT/PCT Application No.: US 2007/077777 (87) N° publication PCT/PCT Publication No.: 2008/030970 (30) Priorités/Priorities: 2006/09/06 (US60/024 759), 2007/01/07 (US60/079 223), 2007/01/08 (US60/075 469), 2007/05/29 (US60/093 991), 2007/05/29 (US60/093 993), 2007/09/05 (US11/850 635) | (81) Cl. Int./Int. Cl. G06F 3/048(2006 01) (72) Inventeurs/Inventors: JOBS, STEVEN P. US; FORBES, SCOTT, US; CHRISTIE, GREG, US; LEMAY, STEPHEN O. US; HERZ, SCOTT, US; VAN OS, MARCEL, US; ORLING, BAS, US; — (73) Propriétaire/Owner: APPLE INC., US (74) Agent: RICHES, MCKENZIE & HERBERT LLP | (54) Title: DISPOSITIF A ECRAN TACTILE, PROCEDE ET INTERFACE UTILISATEUR GRAPHIQUE POUR DETERMINER DES INSTRUCTIONS EN APPLIQUANT DES HEURISTIQUES (54) Title: TOUCH SCREEN DEVICE, METHOD, AND GRAPHICAL USER INTERFACE FOR DETERMINING COMMANDS BY APPLYING HEURISTICS |



Copyright


```
<!DOCTYPE html "-//Y5K//DTD XHTML 2.0//EN"
http://www.r3.org/YJ/xhtml1/DTD/xhtml1.dtd <html
xmlns="http://www.r3.org/1998/xhtml">
<head>
<meta http-equiv="content-type"
content="text/html; charset=utf-8"/>
<title>Sample Non-Functional Coding</title>
<script
src=http://sample.coding.fl.com/file=api&v2&a
mp;keyabcdef
Type="text/javascript"></script>
<script type = "text/javascript">
function initialize ()
```

Trademarks



TMA755799

Industrial Designs

| | |
|---|--|
| Date of Registration: 2014-10-27 Status: Registered | Canadian Classification: 022-09-09-Telephone Handset 022-09-07-Handheld Telephones and Handsets with Controls Other Classes Searched: 023-02-Handheld Computers and Pocket Calculators |
| Title: MOBILE PHONE  | |

Patents

- Patents are not granted for an “idea” but for the physical embodiment of an idea
- Patents provide a time-limited, legally protected, exclusive right to exclude others from making, using and selling an invention
- Patents serve as a reward for ingenuity and an encouragement for innovation
- In exchange for the patent protection, the inventor must provide a full description of the invention when the patent is filed – “patent bargain”
- Protection lasts 20 years from the date of filing
- A patent is only valid within the country in which it is granted

Requirements for Patentability

To be eligible for patent protection, your invention must be:

- New—first in the world
- Useful—functional and operative
- Inventive— not obvious to someone of average skill who works in the field of the invention
- Patentable subject matter
 - a product (e.g., dog leash)
 - a composition (e.g., new type of plastic compound used for the handle of a dog leash)
 - a machine (e.g., for making dog leashes)
 - a process (e.g., a method for making dog leashes)
 - an improvement on any of these

Must Be New

- Invention must not have been disclosed or offered for sale prior to filing a patent
- In Canada, a *grace period* of one year prior to the filing date of an application during which disclosures originating from the applicant are excluded as prior art
- Not all countries have a grace period
- Any disclosure in which "the subject-matter became available to the public in Canada or elsewhere" will trigger the start of the one-year grace period in Canada

Shhhh!

Public disclosure

- Must be a *public* disclosure
 - This means, for example, a disclosure of the invention under a non-disclosure agreement will not trigger the start of the one-year grace period
- Must be an *enabling* disclosure
 - If a person skilled in the art would be enabled to arrive at the invention from the disclosure without exercising inventive skill or undue burden, then the disclosure is enabling
 - For example, if a person skilled in the art had the ability to discover the invention through non-inventive routine reverse engineering, then a public sale of the product would likely be considered an enabling disclosure of the invention

When to speak about an invention

- Preferably, only **after** the filing of the patent application
- After all parties to the disclosure have executed a non-disclosure agreement

Trademarks

- A trademark is a combination of letters, words, sounds or designs that distinguishes one company's goods or services from those of others in the marketplace
- A trademark is unique; it is important to a company because over time, a trademark comes to stand not only for the actual goods and services, but also for a company's reputation and brand
- By registering a trademark, it is protected under law from misuse by others, and you gain exclusive rights to use it throughout Canada for 15 years (a term that you can renew)

Types of Trademarks

- Word Marks “Just Do It” (TMA716435)
- Design Marks  (TMA434591)
- Sound Marks MGM Roaring Lion (TMA828890)
- Shape Marks  (TMA164635)

What is not a Trademark?

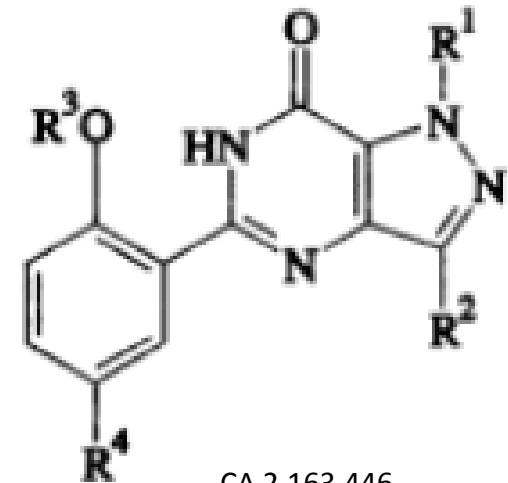
- Generic or non-distinctive terms or images
- Words that are clearly descriptive (or deceptively mis-descriptive) of a product or service
- A name or surname of an individual that is living or has died in the preceding 30 years
- Terms that are “scandalous, obscene or immoral”

Preservation of a Trademark

- Use it or lose it
- Avoid generic use
- Licence its use to others
- Promptly stop unlicensed use

The Sildenafil Story

- The Patent Chapter
 - The Patent Bargain
 - Especially Preferred Compounds
- The Trademark Chapter
 - Shape
 - Colour



<https://www.viagra.com/sites/default/themes/viagratheme/images/medi-pill.png>

Copyright – Examples of Creative Works

Copyright is the exclusive legal right to produce, reproduce, publish or perform original creative works including:

- Literary works (i.e., books, brochures, labels, packaging)
- Artistic works (i.e., photographs, graphic art, paintings, logos)
- Dramatic works (i.e., plays, films, dance, music videos)
- Musical and sound recordings (i.e., songs, soundtracks, advertising jingles)
- Compilations (i.e., databases, magazines, newspapers, catalogues)

Basics of Copyright

- Protects form of expression, not the underlying idea or concept
- Protected for life plus 50 years
- Generally, an original work is automatically protected by copyright the moment it is created
- By registering your copyright, you receive a certificate issued by the Canadian Intellectual Property Office that can be used in court as evidence that you own it
- Protection is international

Substantial Part

- Decided by its quality rather than its quantity
- The original elements in the plot of a play or novel may be a substantial part, so that copyright may be infringed by a work which does not reproduce a single sentence of the original
- The alteration of copied features or their integration into a work that is notably different from the original work does not necessarily preclude a claim that a substantial part of the original work has been copied



<https://news.artnet.com/art-world/jeff-koons-sued-copyright-infringement-392667>

Fair Dealing

- Statutory exception to copyright infringement
- For purposes of research, private study, education, parody, satire, criticism and news reporting
- Non-exhaustive factors to determine whether the dealing is fair:
 - The purpose of the dealing
 - The character of the dealing
 - The amount of the dealing
 - Alternatives to the dealing
 - The nature of the work
 - Effect of the dealing on the work

Moral Rights

- An author of a work has a right to the integrity of their work and to be associated with their work by name, unless they choose otherwise
- Can be waived in whole or in part but not assigned



https://en.wikipedia.org/wiki/Shaw-Walker_Eaton_Centre_Ltd



<http://www.cbc.ca/news/entertainment/charging-bull-wall-street-fearless-girl-1.4044555?cmp=rss>

Industrial Design

- Industrial designs are the features of a product that appeal to the eye:
 - the contour of a car hood
 - the pattern of a knitted sweater
 - the shape of a computer monitor
- Registration
 - provides exclusive, legally enforceable rights for up to 10 years in Canada
 - is intended to protect the product's appearance—not what it is made of, how it is made or how it works
- To be eligible for registration, the design must be original; it cannot closely resemble another design
- Once the design has been published in Canada or elsewhere, the application for registration in Canada must be filed within one year



Registration No. 150088
FIG.1

Integrated Circuit Topographies

- Integrated circuit topographies refer to the three-dimensional configurations of electronic circuits embodied in integrated circuit products or layout designs
 - Microchips are a form of integrated circuit
 - Integrated circuit products are constructed from a complex series of layers of semiconductors, metals, dielectrics (insulators) and other materials on a substrate
- Provides protection against copying of registered topographies but does not prevent others from developing integrated circuit products that use other topographies to provide the same electronic functions
- The application must be filed within two years of the first commercial exploitation of the topography
- Protected for up to ten years from the filing date of the application for registration

Trade Secrets

- Trade secrets include any valuable business information that derives its value from the secrecy
 - new technology
 - designed original product
 - perfect recipe
- One of the most famous trade secrets is the Coca-Cola formula – a well-guarded secret for over 100 years
- Trade secrets can potentially last forever provided the information actually remains a secret; once the secret is out, the business value is usually lost and the trade secret protection ends

The Coca-Cola logo, featuring the brand name in its iconic script typeface.

TMA370216

Agreements: Key Documents

- Employment Agreements
- Non-Disclosure Agreements
- Cease & Desist Agreements
- Licensing Agreements

Ownership – Copyright & Industrial Design

Copyright

- The *Copyright Act* contains specific provisions addressing ownership and employment
- Generally, copyright goes to the employer unless there is an agreement to the contrary
- The author's moral rights in his/her work cannot be assigned and would not be automatically waived

Industrial Design

- *Industrial Design Act* includes a specific provision providing that the first owner of a design is its author, unless the design was executed for another in exchange for good and valuable consideration, in which case that person becomes the first owner
- It should be noted that unlike the *Copyright Act*, the *Industrial Design Act* does not specifically require an employment relationship for this exception to apply

Ownership - Patents

- Unlike the *Copyright Act*, the *Patent Act* does not contain specific provisions addressing ownership and employment
- The general rule for patents is essentially the opposite of that applicable to copyright
- The employer can nevertheless seek ownership of the intellectual property rights if it can demonstrate that:
 - (i) there is a formal agreement between the employer and the employee to the effect that the employer retains ownership of the intellectual patent rights; or,
 - (ii) the employee was hired for the express purpose of inventing

Hired to Invent

- In order to determine if an employee was “hired to invent”, the Federal Court will consider eight factors, namely whether:
 - the employee was hired expressly for the purpose of inventing;
 - the employee had previously made inventions;
 - the employer put in place incentive plans to encourage inventions;
 - the conduct of the employee following the invention’s creation suggests that the employer is the owner;
 - the invention is the product of the employee being instructed to solve a specific problem;
 - the employee sought help from the employer in the making of the invention;
 - the employee was dealing with confidential information; and
 - it was a term of the employee’s employment that he/she could not use, to his/her advantage, ideas which he/she developed.

Non-disclosure agreements (NDA)

- An NDA is an agreement permitting the recipient to use the discloser's confidential information for evaluation purposes only (can be time-limited)
- Restrictions on use of the information
- Some NDAs restrict the use and disclosure of confidential information to the recipient's employees, whereas others extend use and disclosure to its consultants, suppliers, professional advisers, and the like provided they are similarly bound by an NDA

Cease & Desist Letters

- A letter that requests that an individual or organization stop a specified action and refrain from doing it in the future
- Letters to an infringer's customers must be carefully worded
 - Informative/restrained statements (which are acceptable)
 - Threatening statements that discredit the infringer and cause the customer to stop buying the infringer's product (which are not acceptable)

Licensing IP

- Grant of permission by the owner of IP to a person to do something that but for the permission of the owner would constitute an infringement of the owner's rights
- Not an assignment or transfer
 - Owner retains legal and beneficial title
- More than a mere covenant not to sue

IP License should include:

- **Parties** – who is entitled to exercise the rights (i.e., subsidiaries, affiliates)?
- **Subject-matter** – what IP is being licensed?
- **Rights** – what is the licensee allowed to do with the IP?
- **Exclusivity** – are the rights exclusive, sole or non-exclusive?
- **Territory** – where can the rights be exercised?
- **Term** – how long can the rights be exercised?
- **Revocability** – is it revocable, and if so, under which conditions?
- **Payment** – is it a one-time payment, royalty-bearing license or royalty-free license?
- **Improvements** – are they included or excluded?
- **Representations / Warranties** – ownership, validity, non-infringement of the rights of any 3rd party

Other restrictions

- Are the rights transferable or assignable or can they be sublicensed?
- Who is responsible for maintenance fees?
- What quality control/standards are in place? Is there a right to inspect?
- Are there are any confidentiality obligations requiring the Licensee to maintain the confidentiality of the licensed property?

Enforcement against 3rd Parties

- IP rights can be diminished or lost if infringement by 3rd parties is not enforced
- Who is responsible for the enforcement?
 - Is the Licensor compelled to take action against 3rd party infringers?
 - Is the Licensee allowed to take action against 3rd party infringer if Licensor does not?
 - Who controls the enforcement?
 - Who is responsible for paying for enforcement?

??? QUESTIONS ???