

Contents

ABOUT THE AUTHOR	xix
AUTHOR'S NOTE	xxi
CHAPTER 1: Introduction	1
1. Introduction	2
2. International Obligations	2
a) Conventions, Agreements, and Treaties	2
b) Implementation	4
3. Trademarks	4
a) <i>Trade-marks Act</i>	4
b) Common Law Rights	5
4. Domain Names	6
5. Copyright	6
6. Industrial Designs	6
CHAPTER 2: Protection of Trademarks in Canada	9
1. Trademark Legislation in Canada	10
a) Federal Legislation	10
b) Provincial Legislation	10
2. Basic Definitions	11
a) Trademark	11
b) Certification Mark	12
c) Distinctiveness	13
d) Distinguishing Guise	15
e) Prohibited Marks	17
f) Prohibited Designations	20
g) Protected Geographical Indications for Wines and Spirits	21
h) Official Marks	21
i) <i>Olympic and Paralympic Marks Act</i>	24
CHAPTER 3: Registrable Trademarks	25
1. Characteristics Which May Preclude Registration	26
2. Primarily Merely a Name or a Surname	27

3. Descriptive or Deceptively Misdescriptive Trademarks	28
a) The First Impression	29
b) Clearly	30
c) Deceptively Misdescriptive	30
d) English or French Language	30
e) Character or Quality	31
f) Conditions of or the Persons Employed in Production of Wares	31
g) Place of Origin	32
h) Suggestive Words	32
i) Coined Words	33
j) Disclaimer	33
4. Acquired Distinctiveness—Secondary Meaning	34
a) Applicability	34
b) Evidence Required	35
c) The Determination	35
5. Names of Wares or Services	36
6. Confusing With a Registered Trademark	36
a) The Statutory Framework	36
b) Associated Marks	37
7. Prohibited Marks and Designations	38
CHAPTER 4: Acquisition of Rights	39
1. Adoption	40
2. Making Known	41
3. Registration and Use in the Applicant's Country of Origin	42
a) Applications	42
b) Registrability of Marks Registered and Used in a Country of Origin	43
4. Use or Proposed Use in Canada	45
CHAPTER 5: Trademark Use	47
1. The Importance of Trademark "Use"	48
2. Wares	48
a) At the Time of the Transfer of Property or Possession	49
b) In the Normal Course of Trade	49
c) Notice of Association	49
3. Services	50
4. Wares Exported from Canada	51
5. Deviating Use	51
CHAPTER 6: Entitlement	53
1. Entitlement to Registration	54
2. Marks That Have Been Used or Made Known in Canada	55
3. Marks Registered and Used Abroad	56
4. Proposed Use Marks	57

CHAPTER 7: Applications	59
1. Content	60
2. Amendment	62
3. Examination	63
4. Disclaimer	64
5. Advertisement	64
CHAPTER 8: Registration	67
1. Allowance	68
2. Registration	69
3. Marking	69
4. Invalidity	70
5. Registration of Concurrent Rights	71
6. Term of Protection and Renewal	71
CHAPTER 9: Assignments and Licenses	73
1. Assignments	74
a) Scope	74
b) Effectiveness	75
c) Distinctiveness	76
2. License	77
a) Availability	77
b) Control	78
c) Proceedings for Infringement	78
CHAPTER 10: Expungement	79
1. Section 45 Proceedings	80
a) Summary Procedure	80
b) Evidence	81
c) Effect of Non-Use	83
d) The Hearing	83
e) Appeal	84
2. Expungement by the Federal Court	85
a) Jurisdiction	85
b) Procedure	86
c) Person Interested	87
d) Limitations	87
e) Grounds for Expungement	88
CHAPTER 11: Confusing Trademarks	93
1. Introduction	94
2. Confusing Trademarks	94
a) The Statutory Framework	94
b) Inherent Distinctiveness	97
c) Duration of Use	99

d) The Nature of the Wares, Service, or Business	99
e) Famous Trademarks	100
f) Nature of the Trade	101
g) Degree of Resemblance	102
h) Other Circumstances	103
CHAPTER 12: Opposition Proceedings	105
1. Introduction	106
2. Statement of Opposition	106
a) Time for Filing and Extensions	106
b) Grounds of Opposition	107
c) The Material Dates	108
d) Content	109
e) Counter Statement	110
f) Amendments	111
3. Evidence	111
a) The Framework	111
b) The Onus of Proof	112
c) The Nature of the Evidence	113
4. The Hearing	114
5. Appeal	115
CHAPTER 13: Infringement	117
1. Infringement	118
a) Statutory Framework	118
b) The Requirement to Show Use	120
c) Invalidity	120
d) Comparison with a Claim for Passing Off	121
e) Grey Market Goods	122
2. Defenses to an Action for Infringement	122
a) Invalidity of the Plaintiff's Registered Trademark	122
b) Ownership	123
c) Consent or License	123
d) Denial of Infringement	123
e) Plaintiffs Own Goods	123
3. Depreciating the Value of the Goodwill Attached to a Trademark	123
a) Statutory Definitions	123
b) The Elements Required to Be Shown	125
CHAPTER 14: Common Law Rights—Passing Off	127
1. Passing Off	128
a) The Nature of the Tort	128
b) Reputation or Goodwill	129
c) Trade Dress or Get Up	129
d) Misrepresentation	130

e) Damage	131
f) The Relevant Date	132
2. Subsection 7(b) and (c) of the <i>Trade-marks Act</i>	132
3. Defenses	133
a) The Absence of Reputation or Goodwill	133
b) Other Defenses	135
CHAPTER 15: Actions for Infringement and Passing Off	137
1. Jurisdiction	139
2. Interim Proceedings	140
a) Proceedings for Interim Custody	140
b) Proceedings for Detention by Minister	141
3. Parties	142
a) Plaintiff	142
b) Licensee	143
c) Defendants	143
d) Directors and Officers	143
4. Pleadings	144
a) Basic Requirements	144
b) Particulars	144
5. Interlocutory Injunctions	145
a) Purpose	145
b) The Test for Granting an Interlocutory Injunction	146
c) A Serious Question to Be Tried	146
d) Irreparable Harm	147
e) The Balance of Convenience	147
6. <i>Anton Piller</i> Orders	148
a) Purpose	148
b) Conditions for Granting an Order	149
c) Safeguards in the Order	150
7. Discovery	153
8. Delay and Acquiescence	153
9. Limitation Period	154
10. Evidence at Trial	154
a) Plaintiff's Ownership in an Action for Infringement	154
b) Infringement	155
c) Passing Off	155
11. Remedies	156
a) The <i>Trade-marks Act</i>	156
b) Permanent Injunction	156
c) Profits or Damages	157
d) Destruction, Exportation or Other Disposition of Offending Wares	159
e) Costs	160

CHAPTER 16: Domain Names	161
1. The Internet	162
2. Domain Names	163
a) First Come, First Served	163
b) gTLD Domain Names	163
c) .ca Domain Names	165
d) Trademark Protection	165
3. Jurisdictional Issues	166
4. The UDRP	167
a) History	167
b) Applicable Disputes	168
c) Confusingly Similar	169
d) No Rights or Legitimate Interest	169
e) Bad Faith	170
f) Procedure	172
5. The CDRP	173
a) History	173
b) Applicable Disputes	173
c) Confusingly Similar	174
d) No Legitimate Interest	175
e) Bad Faith	176
f) Procedure	177
g) CDRP WHOIS Privacy Policy	177
6. Actions in the Courts	178
CHAPTER 17: Copyright: Basic Concepts	179
1. Introduction	180
a) Acquisition	180
b) Originality	181
c) Fixation	182
d) Compilations	183
e) Derivative Works	183
CHAPTER 18: Literary, Dramatic, Musical, and Artistic Works	185
1. Introduction	186
2. Literary Works	186
a) What Is Protected	186
b) Computer Programs	186
c) The Rights Associated with a Literary Work	187
3. Dramatic Works	188
a) What Is Protected	188
b) Cinematographic Works	189
c) The Rights Associated with a Dramatic Work	190

4. Musical Works	191
a) What Is Protected	191
b) The Rights Associated with a Musical Work	191
5. Artistic Works	192
a) What Is Protected	192
b) The Rights Associated with an Artistic Work	193
c) Designs Applied to Useful Articles	194
CHAPTER 19: Neighboring Rights	199
1. Introduction	200
2. Performers' Rights	200
a) What Is Protected	200
b) Canada and Rome Convention Countries	201
c) Performers' Rights—WTO Countries	204
d) The Right to Equitable Remuneration	204
2. Sound Recordings	206
a) What Is Protected	206
b) The Rights Associated with a Sound Recording	207
c) The Right to Equitable Remuneration	209
4. Broadcaster's Communication Signal	209
a) What Is Protected	209
b) The Rights Associated with a Broadcaster's Communication Signal	209
CHAPTER 20: Moral Rights	213
1. What Is Protected	214
2. The Right to the Integrity of the Work	214
3. The Right to Be Associated with the Work or to Remain Anonymous	215
4. Waiver	215
5. Term of Protection and Succession	216
CHAPTER 21: Term of Protection	217
1. The General Term of Protection	218
2. Anonymous and Pseudonymous Works	218
3. Posthumous Works	219
4. Works of Joint Authorship	220
5. Photographs	220
6. Cinematographic Works	221
7. Crown Copyright	222
8. Performer's Performances, Sound Recordings and Communication Signals	222
9. Abandonment	223

CHAPTER 22: Ownership of Copyright	225
1. Authorship	227
a) The Author Is the Owner	227
b) The "Author"	227
2. Engravings, Photographs, or Portraits	228
a) Photographs	229
b) Engravings	231
c) Portraits	232
3. Other Commissioned Works	232
4. Contracts of Service	232
a) Employment Under a Contract of Service or Apprenticeship	232
b) In the Course of Employment	235
c) Absence of Agreement to the Contrary	235
d) Articles or Other Contributions to a Newspaper, Magazine, or Similar Periodical	235
5. Collective Works	236
6. Compilations	237
7. Works of Joint Authorship	238
a) Statutory Definition	238
b) Collaboration of Two or More Authors	238
c) The Nature of the Contribution	238
d) The Nature of Joint Authors' Interest	239
8. Cinematographic Works	240
9. Performer's Performances, Sound Recordings, and Communication Signals	240
10. Presumptions as to Ownership	241
CHAPTER 23: Crown Copyright	243
1. Crown Copyright	244
a) The Crown	244
b) Government Departments	244
c) The Rights Available to the Crown	245
d) Federal Policy Relating to Crown Copyright	246
e) Other Rights under the Act	246
2. Crown Prerogative	246
3. Crown Immunity	247
CHAPTER 24: Assignment	249
1. Assignments	250
a) The Extent of the Right	250
b) Partial Assignments	250
c) The Rights of the Assignor	251
d) Must Be In Writing	251
e) Construction	252

f) Transfer of Possession of Physical Things	253
g) Limitation where the Author Is the First Owner of Copyright	253
h) Registration of Assignments and Licenses	254
2. Devolution	254
3. Bankruptcy	255
a) The Property of the Bankrupt	255
b) Licenses	255
c) Proposals	256
d) Reversion of Copyright	257
CHAPTER 25: Licenses	259
1. Proprietary Licenses	260
2. Ordinary Licenses	261
3. Implied Licenses	261
4. Assignment	262
5. Withdrawal of Consent	262
6. Licenses by Operation of Law	262
CHAPTER 26: Registration and Marking	265
1. Registration Is Not Required	266
2. Applying for Registration	266
3. Rectification of the Register of Copyrights	268
4. Effect of Registration	268
a) Admissibility	268
b) Evidence	269
c) Notice of Assignment or License	269
d) Varying Presumptions	270
e) Statutory Notice	270
CHAPTER 27: Direct Infringement	271
1. The Sole Right	272
a) The Nature of the Right	272
b) Intention to Infringe	273
c) Consent or Licence	273
2. Authorizing Infringement	274
a) The Sole Right to Authorize	274
b) Authorization	275
c) Infringement by Agents and Employees	275
CHAPTER 28: Secondary Infringement	277
1. Secondary Infringement	278
a) The Nature of the Right	278
b) Knowledge of Infringement	279
c) Importation of Infringing Works	279
d) Sale or Rental of Infringing Works	281

e) Distribution to the Prejudice of the Copyright Owner	281
f) By Way of Trade Distribute, Expose, or Offer for Sale or Rental, or Exhibit in Public	282
g) Possession of Infringing Works	282
h) Possession of Plates Specifically Designed for the Purpose of Making Infringing Copies	282
2. Permitting Infringing Performances in Theatres	283
3. Parallel Importation of Books	283
a) Exclusive Distributor	284
b) The Nature of the Exclusive Distributor's Rights	284
CHAPTER 29: Exceptions	287
1. Application	289
2. Fair Dealing	289
a) The Excepted Activities	289
b) The Meaning of "Fair Dealing"	290
c) Fair Dealing for the Purpose of Research or Private Study	292
d) Fair Dealing for the Purpose of Criticism or Review	293
e) Fair Dealing for the Purpose of News Reporting	293
3. Educational Institutions	294
a) Definition of Educational Institution	294
b) The Excepted Activities	294
c) Literary Collections	296
4. Libraries, Archives, and Museums	296
a) Definitions	296
b) The Excepted Activities	297
5. Machines Installed in Educational Institutions, Libraries, Archives, and Museums	299
a) The Excepted Activities	299
6. Computer Programs	301
a) The Excepted Activities	301
7. The Incidental Inclusion of a Work in Another Work	302
a) The Excepted Activities	302
8. Ephemeral Recordings	302
a) The Excepted Activities	302
9. Pre-Recorded Recordings	304
a) The Excepted Activities	304
10. Retransmission	305
a) The Excepted Activities	305
11. Persons with Perceptual Disabilities	307
a) The Excepted Activities	307
12. Statutory Obligations	308
a) The Excepted Activities	308
13. Miscellaneous Exceptions	309
a) Artistic Works	309

b) Architectural Works, and Sculptures or Works of Artistic Craftsmanship Situated in Public Places	309
c) Newspaper Report of Public Lecture	309
d) Public Recitation of Extracts	310
e) Report of an Address of a Political Nature Given at a Public Meeting	310
f) Performance at any Agricultural or Agricultural-Industrial Exhibition or Fair	310
g) Performance by Religious, Educational, Charitable, or Fraternal Bodies	311
h) Equitable Remuneration	311
i) Library and Archives of Canada	311
CHAPTER 30: Actions for Infringement of Copyright	313
1. Jurisdiction	315
2. Seizure of Imported Copies	316
a) Section 44	316
b) Sections 44.1–44.3	316
c) Exceptions	319
3. Parties to Actions in the Courts	320
a) The Owner of Copyright	320
b) The Author	321
c) Persons Deriving Rights from the Owner	321
f) Defendants	322
4. Pleadings	323
a) Notice of Claim	323
b) Statement of Claim	324
c) Statement of Defense	324
d) Particulars	325
5. Interlocutory Injunctions	325
6. <i>Anton Piller</i> Orders	325
7. Summary Applications	325
8. Discovery	326
9. Limitation Period for Civil Remedies	327
10. Evidence at Trial	327
a) Presumptions	328
b) Certificate of Registration as Evidence	328
c) Circumstantial Evidence	328
d) Expert Evidence	328
11. Remedies	329
a) Permanent Injunction	329
b) Possession of Infringing Copies	330
c) Declaratory Relief	332
d) Damages	332
e) Account of Profits	334
f) Statutory Damages	334

g) Delivery Up	337
h) Costs	337
CHAPTER 31: Criminal Remedies	339
1. Criminal Proceedings	340
2. Section 42 Offences	341
a) Section 42(1)	341
b) Subsection 42(2)	342
c) Penalties	343
3. Section 43 Offences	343
a) Performance of a Dramatic or Operatic Work or Musical Work	343
b) Change or Suppression of Title or Author's Name	344
4. Criminal Code	344
CHAPTER 32: Copyright Board and Collective Administration of Rights	345
1. The Copyright Board	347
2. Jurisdiction	347
3. The Powers of the Copyright Board	348
4. Collective Administration of Performing Rights and Communication Rights	350
a) Background	350
b) Performing Rights and Communication Rights Societies	351
c) Equitable Remuneration for Performers and Makers of Sound Recordings	354
d) The Effect of Fixing Royalties	355
e) Radio Performances in Places Other Than Theatres	355
5. The General Regime-Collective Administration in Relation to Rights under Sections 3, 15, 18, and 21	356
a) Background	356
b) General Regime Collective Societies	356
c) Tariff or Agreement	357
d) Filing of Proposed Tariffs	358
6. Examination of Agreements	359
7. The Retransmission Regime	360
a) Background	360
b) Retransmission Collective Societies	360
c) Filing of Proposed Tariffs	362
d) Claims by Non-Members	362
8. Private Copying	363
9. Owners of Copyright Who Cannot Be Found	365
10. Compensation for Acts Done Before Recognition of Copyright	366
CHAPTER 33: Industrial Designs	367
1. Definition of a Design	369
a) Shape and Configuration	369

b) Pattern or Ornament	370
c) Finished Article	370
d) Appeal to and Judged Solely by the Eye	370
e) Sets	370
f) Kits	371
2. Industrial Designs and Other Intellectual Property Rights	371
a) Copyright	371
b) Patents	371
c) Trademarks	372
3. Originality	372
4. Publication	374
5. The Proprietor	374
a) Author	374
b) Designs Executed for Consideration	375
6. Application	375
a) The Requirements	375
b) Identifying the Features that Constitute the Design	377
c) Priority Based on an Application Filed in Another Country	377
7. Registration	378
8. Marking	379
9. Term	380
10. Assignment and License	380
11. Expungement and Alteration	381
12. Infringement	381
a) The Exclusive Right	381
b) License	382
c) The Activities	382
d) The Article in Respect of which the Design Is Registered	383
e) Whether a Design Not Differing Substantially from the Design Has Been Applied	383
13. Actions for Infringement	384
a) Jurisdiction	384
b) Limitation Period	384
14. Remedies	385
a) Injunction	385
b) Damages or Profits	385
c) Delivery Up	386
d) Defenses	386
 TABLE OF CASES	 387
 INDEX	 425