

# INTELLECTUAL PROPERTY LAW IN CANADA

SECOND EDITION

MISTRALE GOUDREAU



Wolters Kluwer  
Law & Business

# **Intellectual Property Law in Canada**

**Second Edition**

**Mistrale Goudreau**

This book was originally published as a monograph in the International Encyclopaedia of Laws/Intellectual Property Law.

General Editors: Roger Blanpain, Frank Hendrickx

Volume Editor: Hendrik Vanhees



**Wolters Kluwer**  
Law & Business

*Published by:*

Kluwer Law International  
PO Box 316  
2400 AH Alphen aan den Rijn  
The Netherlands  
Website: [www.kluwerlaw.com](http://www.kluwerlaw.com)

*Sold and distributed in North, Central and South America by:*

Aspen Publishers, Inc.  
7201 McKinney Circle  
Frederick, MD 21704  
United States of America  
Email: [customer.service@aspenpublishers.com](mailto:customer.service@aspenpublishers.com)

*Sold and distributed in all other countries by:*

Turpin Distribution Services Ltd.  
Stratton Business Park  
Pegasus Drive, Biggleswade  
Bedfordshire SG18 8TQ  
United Kingdom  
Email: [kluwerlaw@turpin-distribution.com](mailto:kluwerlaw@turpin-distribution.com)

**DISCLAIMER:** The material in this volume is in the nature of general comment only. It is not offered as advice on any particular matter and should not be taken as such. The editor and the contributing authors expressly disclaim all liability to any person with regard to anything done or omitted to be done, and with respect to the consequences of anything done or omitted to be done wholly or partly in reliance upon the whole or any part of the contents of this volume. No reader should act or refrain from acting on the basis of any matter contained in this volume without first obtaining professional advice regarding the particular facts and circumstances at issue. Any and all opinions expressed herein are those of the particular author and are not necessarily those of the editor or publisher of this volume.

*Printed on acid-free paper*

ISBN 978-90-411-5889-5

This title is available on [www.kluwerlawonline.com](http://www.kluwerlawonline.com)

© 2015, Kluwer Law International BV, The Netherlands

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted in any form or by any means, electronic, mechanical, photocopying, recording, or otherwise, without written permission from the publisher.

Permission to use this content must be obtained from the copyright owner. Please apply to: Permissions Department, Wolters Kluwer Legal, 76 Ninth Avenue, 7th Floor, New York, NY 10011-5201, USA. Email: [permissions@kluwerlaw.com](mailto:permissions@kluwerlaw.com)

Printed and Bound by CPI Group (UK) Ltd, Croydon, CR0 4YY.

# **Intellectual Property Law in Canada**

# Table of Contents

The Author	3
List of Abbreviations	13
Preface	19
General Introduction	21
§1. GENERAL BACKGROUND	21
I. Geography	21
II. Cultural Compositions	22
III. Political System	22
IV. Population Statistics	23
§2. HISTORICAL BACKGROUND	23
Chapter 1. Copyright and Neighbouring Rights	25
§1. SOURCES: LEGISLATION	25
§2. SUBJECT MATTER OF PROTECTION	26
I. Different Categories of Protected Works	26
A. Literary Works	26
B. Artistic Works	27
C. Dramatic Works	27
D. Musical Works	28
II. Works Excluded of Protection	28
III. Special Categories of Works	29
A. Computer Software	29
B. Databases	29
C. Title of the Work	30
§3. CONDITIONS OF PROTECTION	30
I. Formal Requirements	30
II. Substantive Requirements	30
A. Originality	31

## Table of Contents

B. Fixation	32
C. Connecting Factors	32
§4. OWNERSHIP	33
I. The Author (Initial Authorship)	34
II. Joint Works/Works Created by Several Persons	34
A. Collective Work and Compilation	34
B. Work of Joint Authorship	35
III. Works Made for Hire	35
§5. TRANSFER	36
I. Assignment of Copyright	36
II. Licences	37
§6. SCOPE OF EXCLUSIVE RIGHTS	38
I. Moral Rights	38
A. Paternity Right	38
B. Integrity Right	39
II. Exploitation Rights	39
A. Reproduction Right	41
B. Performing Right	41
1. Public Performance Right	42
2. Transmission Right	42
C. Adaptation Right	43
D. Translation Right	44
E. Other Rights	44
1. Droit de Suite	44
2. Public Lending Right	44
3. Others	44
a. Right to Authorize an Exploitation Right	44
b. Secondary Infringement	45
c. Exhibition Right	46
d. Right to Rent Out Copies	46
e. First Public Distribution Right	47
f. Additional Rights	47
§7. LIMITATIONS OR EXEMPTIONS TO THE SCOPE OF COPYRIGHT PROTECTION	47
I. Fair Use	48
II. Educational Use	48
III. Use by Libraries, Archives or Museums	49
IV. Private Copying	49
V. Others Specific Exceptions in the Copyright Act	50
VI. Limitations Imposed by the Competition Act	51
§8. DURATION OF PROTECTION	52
§9. NEIGHBOURING RIGHTS	52

## Table of Contents

I. Performer's Rights	52
II. Sound Recording Maker's Rights	55
III. Broadcaster's Rights	55
§10. INFRINGEMENT AND REMEDIES	56
I. Civil Remedies	56
A. Presumptions	57
B. Injunctions	57
C. Damages	58
D. Account of Profits	58
E. Seizure of Imported Copies of Works	59
F. Recovery of Possession and Delivery Up	59
II. Criminal Remedies	59
III. Collective Management of Copyright	60
§11. OVERLAPPING AND RELATION TO OTHER INTELLECTUAL PROPERTY LAWS	62
Chapter 2. Patents	64
§1. SOURCES: LEGISLATION	64
§2. PATENTABLE SUBJECT MATTER	65
I. Computer Program	66
II. Professional Skill and Methods of Medical Treatment	67
III. Biological Inventions	68
§3. CONDITIONS OF PATENTABILITY	70
I. Novelty	70
II. Non-obviousness	72
III. Utility	74
§4. FORMALITIES (PROCEDURE FOR GRANT AND OBTAINING PATENT PROTECTION)	76
§5. OWNERSHIP AND TRANSFER (ASSIGNMENT: LICENSES)	81
I. The Right to Grant	81
II. Assignment	82
III. Licences	82
IV. The Right to Sue	82
V. Registration	83
§6. SCOPE OF EXCLUSIVE RIGHTS	83
I. The Taking of the Invention	83
II. Types of Exclusive Rights	86
A. Making or Constructing the Invention	87
B. Selling or Importing the Invention	87

## Table of Contents

C. Use of the Invention	88
D. Inducing Violation	89
III. Protection through the Regime Established by the Patented Medicines (Notice of Compliance) Regulations	89
§7. LIMITATIONS AND EXCEPTIONS TO THE SCOPE OF PATENT PROTECTION: COMPULSORY LICENSES	91
I. The Regulatory Review Exception	91
II. Acquired Rights of a Previous Purchaser or User	92
III. Control of Patented Medicines Prices	92
IV. Compulsory Licenses to the Benefit of Certain Developing and Least-Developed Countries	93
V. Limitations in Case of Abuse of Rights	93
VI. Experiment and Research	94
VII. Repairs	94
VIII. Limitations Imposed by the Competition Act	94
§8. DURATION OF PROTECTION: MAINTAINING AND TERMINATION OF PATENT PROTECTION	95
I. Duration	95
II. Failure to Pay Fees	96
III. Reissue, Re-examination, Disclaimer	96
IV. Dedication	97
§9. INFRINGEMENT AND REMEDIES	97
I. Damages	97
II. Account of Profits	98
III. Injunction	98
§10. OVERLAPPING AND RELATION TO OTHER INTELLECTUAL PROPERTY LAWS	98
Chapter 3. Utility Models	100
§1. SOURCES: LEGISLATION	100
§2. THE PROTECTION OF UTILITY MODELS	100
Chapter 4. Trademarks	101
§1. SOURCES: LEGISLATION	101
§2. SUBJECT MATTER OF PROTECTION	103
I. Signs Which May Serve as Trademarks According to the Trademarks Act	103
II. Different Categories of Marks	104



## Table of Contents

A. Certification Marks	104
B. Ordinary Trademarks	105
C. Special Signs (Including Distinguishing Guises)	106
D. Geographical Indications	106
E. Official Marks	109
§3. CONDITIONS OF PROTECTION	111
I. The Distinctiveness Standard	111
A. Prohibited Expressions	112
B. Expressions Registrable upon Proof of Acquired Distinctiveness	113
1. Names and Descriptive Words	113
2. Special Signs (Including Distinguishing Guises)	114
3. Marks Lacking Inherent Distinctiveness	115
C. Other Expressions	115
II. The Basis of the Application	116
A. Use in Canada	116
B. Making Known in Canada	117
C. Use and Registration of the Mark in Another Country	118
D. Proposed Use	118
§4. FORMALITIES (PROCEDURE FOR OBTAINING PROTECTION, ESTABLISHING AND MAINTAINING TRADEMARKS)	118
§5. OWNERSHIP AND TRANSFER (ASSIGNMENT: LICENCES)	120
I. Assignment	120
II. Licensing	120
§6. SCOPE OF EXCLUSIVE RIGHTS	121
I. Passing Off and Protection under Paragraph 7(B) of the Trademarks Act	122
II. Unfair Competition	122
III. Exclusive Right to Use in Canada	123
IV. Likely Confusion	124
V. Likelihood of Depreciation of the Value of Goodwill	125
§7. LIMITATIONS OF THE SCOPE OF TRADEMARK PROTECTION	127
§8. USE REQUIREMENTS	127
§9. DURATION OF PROTECTION: RENEWAL – TERMINATION	127
§10. INFRINGEMENT AND REMEDIES	129
§11. OVERLAPPING AND RELATION TO OTHER INTELLECTUAL PROPERTY LAWS	130

**Table of Contents**

Chapter 5. Trade Names	131
§1. SOURCES: LEGISLATION	131
§2. PROTECTION OF TRADE NAMES	135
Chapter 6. Industrial Designs	137
§1. SOURCES: LEGISLATION	137
§2. SUBJECT MATTER OF PROTECTION	137
§3. CONDITIONS OF PROTECTION	138
§4. FORMALITIES (PROCEDURE FOR GRANT AND OBTAINING PROTECTION)	139
§5. OWNERSHIP AND TRANSFER (ASSIGNMENT: LICENCES)	139
§6. SCOPE OF EXCLUSIVE RIGHTS	140
§7. LIMITATIONS OF THE SCOPE OF PROTECTION	140
§8. DURATION OF PROTECTION	140
§9. INFRINGEMENT AND REMEDIES	141
§10. OVERLAPPING AND RELATION TO OTHER INTELLECTUAL PROPERTY LAWS	141
I. Overlap with Copyright	141
II. Overlap with Patent	143
III. Overlap with Trademark	143
Chapter 7. Plant Variety Protection	144
§1. SOURCES: LEGISLATION	144
§2. SUBJECT MATTER OF PROTECTION	144
§3. CONDITIONS OF PROTECTION	144
§4. FORMALITIES (PROCEDURE FOR GRANT AND OBTAINING PROTECTION)	146
§5. OWNERSHIP AND TRANSFER (ASSIGNMENT: LICENSES)	148
I. The Right to Grant	148
II. Assignment	148
III. Licenses	148

§6. SCOPE OF EXCLUSIVE RIGHTS	149
§7. LIMITATIONS OF THE SCOPE OF PROTECTION: COMPULSORY LICENSES	150
§8. DURATION OF PROTECTION	151
§9. INFRINGEMENT AND REMEDIES	151
§10. OVERLAPPING AND RELATION TO OTHER INTELLECTUAL PROPERTY LAWS	152
Chapter 8. Chip Protection	153
§1. SOURCES: LEGISLATION	153
§2. SUBJECT MATTER OF PROTECTION	154
§3. CONDITIONS OF PROTECTION	154
I. Originality	154
II. Person Entitled to Register	155
§4. FORMALITIES (PROCEDURE FOR GRANT AND OBTAINING PROTECTION)	155
§5. OWNERSHIP AND TRANSFER (ASSIGNMENT; LICENSES)	156
I. Ownership	156
II. Assignment	156
III. Licenses	156
IV. The Right to Sue	156
§6. SCOPE OF EXCLUSIVE RIGHTS	157
§7. LIMITATIONS OF THE SCOPE OF PROTECTION	157
§8. DURATION OF PROTECTION	157
§9. INFRINGEMENT AND REMEDIES	158
§10. OVERLAPPING AND RELATION TO OTHER INTELLECTUAL PROPERTY LAWS	158
Chapter 9. Trade Secrets/Confidential Information	160
§1. SOURCES: LEGISLATION	160
§2. PROTECTION OF TRADE SECRETS/CONFIDENTIAL INFORMATION	161

## Table of Contents

I. Criminal Action	161
II. Civil Action	162
Chapter 10. Geographical Indications and Appellations of Origin	163
Selected Bibliography	165
Index	167

# **Intellectual Property Law in Canada**

**Second Edition**

**Mistrale Goudreau**

This book was originally published as a monograph in the International Encyclopaedia of Laws/Intellectual Property Law.

General Editors: Roger Blanpain, Frank Hendrickx

Volume Editor: Hendrik Vanhees



**Wolters Kluwer**  
Law & Business

*Published by:*

Kluwer Law International  
PO Box 316  
2400 AH Alphen aan den Rijn  
The Netherlands  
Website: [www.kluwerlaw.com](http://www.kluwerlaw.com)

*Sold and distributed in North, Central and South America by:*

Aspen Publishers, Inc.  
7201 McKinney Circle  
Frederick, MD 21704  
United States of America  
Email: [customer.service@aspenpublishers.com](mailto:customer.service@aspenpublishers.com)

*Sold and distributed in all other countries by:*

Turpin Distribution Services Ltd.  
Stratton Business Park  
Pegasus Drive, Biggleswade  
Bedfordshire SG18 8TQ  
United Kingdom  
Email: [kluwerlaw@turpin-distribution.com](mailto:kluwerlaw@turpin-distribution.com)

**DISCLAIMER:** The material in this volume is in the nature of general comment only. It is not offered as advice on any particular matter and should not be taken as such. The editor and the contributing authors expressly disclaim all liability to any person with regard to anything done or omitted to be done, and with respect to the consequences of anything done or omitted to be done wholly or partly in reliance upon the whole or any part of the contents of this volume. No reader should act or refrain from acting on the basis of any matter contained in this volume without first obtaining professional advice regarding the particular facts and circumstances at issue. Any and all opinions expressed herein are those of the particular author and are not necessarily those of the editor or publisher of this volume.

*Printed on acid-free paper*

ISBN 978-90-411-5889-5

This title is available on [www.kluwerlawonline.com](http://www.kluwerlawonline.com)

© 2015, Kluwer Law International BV, The Netherlands

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted in any form or by any means, electronic, mechanical, photocopying, recording, or otherwise, without written permission from the publisher.

Permission to use this content must be obtained from the copyright owner. Please apply to: Permissions Department, Wolters Kluwer Legal, 76 Ninth Avenue, 7th Floor, New York, NY 10011-5201, USA. Email: [permissions@kluwerlaw.com](mailto:permissions@kluwerlaw.com)

Printed and Bound by CPI Group (UK) Ltd, Croydon, CR0 4YY.

## The Author



Prof. Mistrale Goudreau holds an LL.L. from the University of Montréal (Faculté de Droit, Montréal, 1979) for which she received the Governor General's Academic Medal. She also holds an LL.M. in Commercial Law from the London School of Economics and Political Science, (Department of Law, London, England, 1981). She is a member of the Quebec Bar since 1981 and is full professor at the Civil Law Section of the University of Ottawa where she has been teaching since 1982. She has been also lecturer and visiting professor at the Faculty of law of the University of Montréal, at the Faculty of Law of the University of Nantes (France), and at the Canadian Foreign Service Institute (CFSI) in Ottawa, as well as research fellow at the Max-Planck-Institut für ausländisches und internationales Patent-, Urheber- und Wettbewerbsrecht (Munich, Germany) and consultant for the Government of Canada. In the past, Mistrale Goudreau has acted as executive director of the Council of Canadian Law Deans, assistant dean for clinical and applied teaching and vice-dean of the Civil Law Section of the University of Ottawa. She was the lead counsel for the Canadian Internet Policy and Public Interest Clinic (CIPPIC) of the Faculty of Law of the University of Ottawa, an intervener in the case of *Dell Computer Corp. v. Union des Consommateurs et Dumoulin* before the Supreme Court of Canada. She is a member of the executive committee of the editorial board of *Les cahiers de propriété intellectuelle*. She published numerous articles on copyright, unfair competition, legislative drafting and legal theory. She authored a book entitled *Guide juridique du droit d'auteur* (Ministère de la Culture et des Communications, Gouvernement du Québec, 1998) and she collaborated to the publication of *Le droit de la propriété intellectuelle* (Yvon Blais, 2006).





# Table of Contents

The Author	3
List of Abbreviations	13
Preface	19
General Introduction	21
§1. GENERAL BACKGROUND	21
I. Geography	21
II. Cultural Compositions	22
III. Political System	22
IV. Population Statistics	23
§2. HISTORICAL BACKGROUND	23
Chapter 1. Copyright and Neighbouring Rights	25
§1. SOURCES: LEGISLATION	25
§2. SUBJECT MATTER OF PROTECTION	26
I. Different Categories of Protected Works	26
A. Literary Works	26
B. Artistic Works	27
C. Dramatic Works	27
D. Musical Works	28
II. Works Excluded of Protection	28
III. Special Categories of Works	29
A. Computer Software	29
B. Databases	29
C. Title of the Work	30
§3. CONDITIONS OF PROTECTION	30
I. Formal Requirements	30
II. Substantive Requirements	30
A. Originality	31