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Intellectual Property

Changes and updates to intellectual property law a 'field day' for lawyers: expert

By Ian Burns

(November 20, 2018, 9:29 AM EST) -- Big changes may be in store for intellectual property in Canada as the federal government has moved to make significant amendments to patent and trademark rules.

The federal government's recently-announced omnibus budget legislation, Bill C-86, includes a number of proposed changes to intellectual property (IP) and copyright law. Under the bill, the *Patent Act* will contain minimum requirements for patent demand letters to ensure that allegations of patent infringement comply with regulations under the Act, and will require subsequent owners or holders of standard essential patents to act in accordance with licensing commitments made by prior owners. The legislation also introduces a prosecution history estoppel provision, which would allow for prior statements made by a patentee or patent applicant to the Canadian Intellectual Property Office to be admitted as evidence during prosecutions.

Amir Eftekharpour of Blake Cassels & Graydon LLP said it has been a longstanding principle of Canadian patent law that patent prosecution history can't be used to construe a patent claim.

"Rather patents must be construed by determining the objective intent of the inventor as evidenced by the patent claims, without reference to extrinsic evidence," he said. "This statutory change could have a substantial impact on the way that patent agents prosecute patent applications, and on the way that parties litigate patent infringement and validity cases."

The legislation also acts on trademark issues, establishing a "bad faith registration" ground of opposition to the registration of a trademark and requires the owner of a trademark to show use of it after three years. In terms of copyright, it would prohibit settlement offers or payment demands being sent to Internet subscribers whose accounts may have been linked to activities that infringe copyright.

"The introduction of a 'bad faith' ground of opposition could help individuals opposing an application [for a trademark] argue that the applicant is abusing the system by seeking to register a particular mark," said Eftekharpour. "This change would help prevent trademark trolls from registering a mark solely for the purpose of seeking settlement from the legitimate owner or user of that mark."



Jenna Wilson, Wilson Lue LLP

But Jenna Wilson of Wilson Lue LLP noted the bill remains before parliamentarians and could lead to changes in committee or by the government later. She also added the cumulative effect of the changes is also unknown because a lot of the actual operation of the bill is to be defined in future regulations.

"We know it's going to have a significant effect, but we don't actually know what that effect will be because we haven't seen the regulations," she said. "But the government reserves the power to write regulations that define what a standard essential patent is and what characterizes a licensing commitment."

At the same time, the Competition Bureau of Canada is inviting public comment on a draft version of its revised intellectual property enforcement guidelines (IPEGs). The bureau released new IPEGs in 2016 but has now revised them to account for changes in regulations governing early generic pharmaceutical entry and recent jurisprudence, in particular the Federal Court of Appeal's decision that the Toronto Real Estate Board (TREB) could not keep information in its database of home listings private. The IPEGs clarify the bureau's approach to conducting investigations of alleged anti-competitive activities that involve intellectual property.

Pina D'Agostino, founder and director of the Intellectual Property Law and Technology Program at Osgoode Hall Law School (IP Osgoode), said the consultation process on the guidelines means the competition bureau is allowing for greater transparency in their decision-making, which should lead to more respect and buy-in from industry and the public.



Pina D'Agostino, IP Osgoode

"The competition bureau is really there to be the watchdog over the markets for the benefit of the public," she said. "It's still very early to see what the effects will be but what I think it does put different companies that are thinking of merging or playing together to be mindful of what the rules of the game are and that the bureau is watching."

Wilson said, although the changes proposed by the bureau are not earth-shattering, it's always good to refresh and get input from the public to make sure the guidelines are addressing relevant concerns in the marketplace.

"And that's what happened in 2016, they added fuller discussion about IP rights where they intersect with interoperability standards," she said. "They also included more discussion about patent enforcement and patent trolls, because those elements were missing from their previous guidelines."

D'Agostino said there has been so much going on with regards to changes and updates to IP law it has become a "field day" for enthusiasts and lawyers.

"I think all of this is addressing IP in its different ways and I'm really happy about it," she said. "The omnibus bill addresses really the issues we have in the IP system which have been long overdue, because we tend to always focus on changing the laws and not so much on the system that is in place. And that is really the first brush the public actually has with the system."

The competition bureau's public consultation is open until Dec. 31 and can be done by filling out an online form.