



IP PERSPECTIVES

INTELLECTUAL PROPERTY AND TECHNOLOGY LAW NEWSLETTER

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Supreme Court upholds selection patent

This landmark judgment has clarified and refined the doctrines of anticipation, obviousness and double patenting.

In its first decision squarely addressing the doctrine of selection patents, the Supreme Court of Canada has unanimously upheld the validity of a patent for a pharmaceutical drug marketed under the trade-mark PLAVIX. In *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61, Apotex argued that a patent claiming a single isomer was invalid on the bases of anticipation, obviousness and double patenting, in view of an earlier genus patent whose claims encompassed the isomer, its mirror-image enantiomer, and the mixture of the two (the racemate).

The patent at issue ('777) discloses and claims clopidogrel and its bisulfate salt. Clopidogrel (the dextro-rotary isomer) is disclosed by the '777 patent to be less toxic and better tolerated than the levo-rotary isomer and the racemate (the mixture of the two isomers). The earlier patent ('875) encompassed clopidogrel bisulfate within its claims and included an example describing the racemate.

In a proceeding under the *Patented Medicines (Notice of Compliance) Regulations*, Apotex

asserted that the '777 patent was invalid in view of the earlier '875 patent. The courts below had rejected Apotex's assertions and prohibited the Minister of Health from issuing a notice of compliance to Apotex for its generic product (*Apotex v. Sanofi-Synthelabo*, 2005 FC 390, aff'd 2006 FCA 421).

Writing for a unanimous Court, Justice Rothstein began by noting the distinction in the jurisprudence between originating patents and "patents based on a selection of compounds from those described in general terms and claimed in the originating patent." He also noted the conditions that must be satisfied for a selection patent to be valid:

1. There must be a substantial advantage to be secured or disadvantage to be avoided by the use of the selected members.
2. The whole of the selected members (subject to "a few exceptions here and there") possess the advantage in question.
3. The selection must be in respect of a quality of a special character peculiar to

the selected group. If further research revealed a small number of unselected compounds possessing the same advantage, that would not invalidate the selection patent. However, if research showed that a larger number of unselected compounds possessed the same advantage, the quality of the compound claimed in the selection patent would not be of a special character.

The Court then turned to a consideration of anticipation, obviousness and double patenting.

In considering **anticipation**, the Court refined the approach set forth in prior jurisprudence, laying down two requirements which had not previously been considered separately: prior disclosure and enablement.

As to prior disclosure, a genus patent does not anticipate the species patent if in reading the genus patent, the special advantages of the selection patent are not disclosed. In the case of clopidogrel, it was not made and its special advantages were not known; the invention was therefore not disclosed in the genus patent ('875).

As to enablement, the Court noted that if an inventive step is required to arrive at the invention from the prior disclosure, then the prior disclosure is not enabling. However, even if no inventive step is required, the prior disclosure must still enable the skilled person to perform or make the subsequently claimed invention without undue burden. The Court outlined a non-exhaustive list of factors to consider in assessing enablement. While the Court did not decide the issue, it noted that one might infer, on the basis of the work done by the patentee to separate the single isomer, that the Applications Judge would have found an undue burden in this case. The Court concluded that the '777 patent was not anticipated.

On **obviousness**, the Court considered U.K. and U.S. jurisprudence, noting that in both jurisdictions, "obvious to try" can be relevant to an obviousness inquiry. However, the Court expressly noted that the "obvious to try" test "will work only where it is very plain or ... more or less self-evident that what is being tested ought to work" and that it is only one factor to assist in the obviousness inquiry; "[i]t is not a panacea for alleged infringers". The Court noted: "[m]ere possibility that something might turn up is not enough."

The Court endorsed a four-step approach to obviousness (the restated *Windsurfing* questions):

1. (a) Identify the notional "person skilled in the art";
(b) Identify the relevant common general knowledge of that person;
2. Identify the inventive concept of the claim in question, or if that cannot readily be done, construe it;
3. Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
4. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps that would have been obvious to the person skilled in the art or do they require any degree of invention?

After noting that "obvious to try" may be appropriate as part of the fourth step of the obviousness inquiry in considering some pharmaceutical inventions, the Court provided a non-exhaustive list of factors as possible considerations. These include:

1. Is it more or less self-evident that what is being tried ought to work? Are there a finite number of identified predictable solutions known to persons skilled in the art?
2. What is the extent, nature and amount of effort required to achieve the invention? Are routine trials carried out or is the experimentation prolonged and arduous, such that the trials would not be considered routine?
3. Is there a motive provided in the prior art to find the solution the patent addresses?

The Court noted that another important factor is the actual course of conduct that culminated in the making of the invention. Evidence of the history of the invention may therefore be relevant.

On the facts of the case, the Court applied the four steps of the restated *Windsurfing* questions, including the obvious to try test, finding, "it was not self-evident from the '875 patent or common general knowledge what the properties of the dextro-rotatory isomer of this racemate would be or what the bisulfate salt's beneficial properties would be

and therefore that what was being tried ought to work". The Court concluded that the invention was not obvious.

Finally, the Court addressed the application of **double patenting** in the context of selection patents. Apotex challenged the validity of the doctrine of selection patents itself on this basis, submitting that a selection patent claims the same invention as the genus patent and, as a result, the selection patent cannot be valid. While the Court recognized that "evergreening" is a legitimate concern, it is not a basis for rejecting selection patents. First, the Court noted that selection patents are not limited to the owner or inventor of the original genus. Second, selection patents encourage improvements. On the facts, the Court rejected Apotex's arguments of same invention and obviousness double patenting.

Regarding the broader implications of this decision beyond the context of selection patents, the Court expressly commented that its discussions of anticipation and obviousness seem applicable to patents generally, "subject to limitations in the *Patent Act*". Although the Court did not elaborate on any specific limitations, one such statutory limitation arises in the case of obviousness. Due to the relevant dates of the '777 patent, this decision was rendered under the pre-1989 *Patent Act*, which did not contain any statutory provision governing obviousness; rather, the requirement for non-obviousness was considered to be implicit within the word "invention". In contrast,

under the *Patent Act* in force since October 1, 1989, obviousness is now codified in s. 28.3 of the *Patent Act*, which expressly states that it is the "subject-matter defined by a claim" that must not have been obvious. The *Windsurfing* approach appears, in steps 2 and 3, to compare the prior art to the "inventive concept" or, if that cannot be readily identified, "the claim as construed". However, s. 28.3 appears to permit only the latter comparison. (Indeed, in a recent decision, the House of Lords appears to have rejected the "inventive concept" approach to obviousness under *Windsurfing*, holding that "the patentee is entitled to have the question of obviousness determined by reference to his claim and not to some vague paraphrase ...": *Conor Medsystems Inc. v. Angiotech Pharmaceuticals Inc.*, [2008] UKHL 49.) More generally, Canadian Courts will have to exercise caution to ensure consistency between the *Patent Act* and the general principles set forth in this decision.

The decision in *Apotex v. Sanofi-Synthelabo* is a significant victory for innovators. The Supreme Court has expressly endorsed the concept of selection patents, recognizing the importance and nature of ongoing innovation. Moreover, the Court has significantly refined and clarified the tests for anticipation, obviousness and double patenting. However, the full impact of these refinements remains to be seen in future cases.

J. Sheldon Hamilton, Toronto

.TEL top level domain to provide new mechanism for electronically publishing business or individual contact information without using the World Wide Web

For registered trade-mark owners, "<trade-mark>.tel" domain names can be registered on a first-come, first-served basis commencing December 3, 2008.

.TEL is a new top level domain that is touted as a revolutionary mechanism for electronically publishing business or individual contact information, such as addresses, telephone numbers and email addresses. Unlike domain names having conventional top level domains (e.g., smart-biggar.ca) that are mapped to numeric IP addresses by the Domain Name System (DNS), .tel domain names (e.g., smart-biggar.tel) will be mapped to contact information that is stored directly in the DNS.



Because it is uniformly formatted and centrally stored, the contact information is more readily searchable and retrievable than contact information in web-based directories or business websites. Moreover, the contact information is intended to be retrievable by any internet-connected device, even one lacking a web browser. Proponents envision that .tel could eventually become a *de facto* global directory for a wireless society.

Registered trade-mark owners or licensees may register domain names in the form “<trade-

mark>.tel” commencing December 3, 2008 on a first-come, first-served basis. To be eligible, the trade-mark must be the subject of a national trade-mark application filed prior to May 30, 2008 that has issued to registration prior to the date of application for the .tel domain name.

It is difficult to predict whether .tel domain names will become ubiquitous. However, trade-mark owners may consider the relatively low cost of early registration to be cheap insurance for their important trade-marks.

Peter A. Elyjiw, Toronto

Settlement of conflict proceeding did not contravene *Competition Act*

A competition law violation requires something more than the mere existence or enforcement of statutory patent rights.

In Canada, the federal *Competition Act* establishes both criminal and civil liability for anti-competitive acts. In a recent judgment, *Les Laboratoires Servier v. Apotex Inc.*, 2008 FC 825, the Federal Court has revisited and clarified the interface between competition law and patent law in Canada.

In *Laboratoires Servier*, the plaintiffs alleged infringement of a patent for perindopril, a drug that is part of a class of angiotensin-converting enzyme (ACE) inhibitors used primarily for treatment of hypertension and cardiac insufficiency. While the patent application was pending, it had been placed in conflict with other patent applications for ACE inhibitors. Canadian conflict proceedings, which are similar to U.S. interference proceedings, are increasingly infrequent because they are applicable only to patent applications filed before October 1, 1989. However, the principles that the Federal Court articulated in *Laboratoires Servier* are likely to be of interest to patent holders generally.

The various parties to the conflict proceeding settled their dispute and the settlement led to the patent rights that the plaintiffs asserted in *Laboratoires Servier*. Apotex, the defendant generic drug manufacturer, alleged that the patentee conspired with the parties of the settlement agreement to unduly limit competition (contrary to the *Competition Act*) by ensuring that the parties to that agreement gained effective control over the manufacture and supply of a number of ACE inhibitors. More particularly, Apotex alleged that the

settlement agreement enabled its participants to control the commencement and duration of monopoly periods to control the relevant market and limit competition.

In considering Apotex’s submission, the Court reviewed the jurisprudence in this area. The Federal Court of Appeal had held in 1991 that the exercise of rights expressly provided by the *Patent Act* would not **unduly** impair competition contrary to the *Competition Act*. However, the Federal Court of Appeal later acknowledged in 2004 and 2005 that where an assignment of a patent increases the assignee’s market power **beyond** what is inherent in the assigned patent, then the assignment could be contrary to the *Competition Act*. For example, assignment of a patent may offend the *Competition Act* if the assigned patent unduly impairs competition when combined with other patents owned by the assignee. The Court concluded that a *Competition Act* violation requires “something more” than the mere existence or assertion of statutory patent rights.

Applying these principles to the present case, the Court found no basis for a *Competition Act* violation. The Court emphasized that the conflict settlement agreement had been entered into while the patent applications were still pending and held that until the patents issued, they could not confer market power or impair competition. The patentee’s actions in settling the conflict proceeding were nothing more than the exercise of the patentee’s statutory rights under the *Patent*

Act and the *Federal Court Rules*. Thus, Apotex had failed to establish “something more” than the mere existence or exercise of statutory patent rights.

The Court commented in passing that if the patentee had already held other patent rights for perindopril, or even for other ACE inhibitors, then such a settlement agreement would have arguably amounted to “something

more” than mere statutory patent rights because it would have effectively conferred more market power upon the patentee than that inherent in the patent itself.

The Federal Court’s decision in *Laboratoires Servier* is slated for review by the Federal Court of Appeal.

Jonas H. Gifford, Vancouver

Trade-marks Office considers changes to opposition practice

Among the most significant changes is the introduction of a cooling-off period to encourage settlement.

In a Notice published for comments on September 4, 2008, the Trade-marks Opposition Board announced that it is planning to amend its practice to simplify and clarify the Registrar’s benchmarks for granting extensions of time, including a cooling-off period. These amendments are intended to provide guidance regarding the granting of extensions of time in exceptional circumstances and to introduce a new practice for scheduling hearings.

If the proposed changes are implemented, practice before the Opposition Board could change dramatically.

One of the most significant changes relates to a cooling-off period to allow parties to an opposition to pursue settlement. The cooling-

off period will last for an initial maximum period of nine months, with an option for the applicant to extend the period for an additional nine months on consent.

The applicant may only request a cooling-off period prior to the deadline for filing a counterstatement. This is, of course, at a very early stage of an opposition proceeding. The proposed Practice Notice indicates that the Registrar will generally not grant extensions of time for parties to pursue settlement negotiations at any other stage of the opposition proceeding. It is uncertain why the Registrar would choose to restrict a cooling-off period to such an early stage of an opposition proceeding, when the parties may not yet have fully assessed the strengths and weaknesses of each other’s cases. If the parties fail to settle the opposition proceeding within this cooling-off period, the parties must carry on with the opposition proceeding and comply with all legislative and regulatory requirements, regardless of whether the parties are continuing their settlement negotiations.

The applicant can terminate the cooling-off period by filing and serving its counterstatement. The opponent may also terminate the cooling-off period by writing to the Registrar to request a resumption of the opposition.

The proposed Practice Notice also provides detailed benchmarks for extensions of time during the various stages of an opposition. Extensions of time beyond the benchmark deadlines will only be granted in exceptional circumstances “supported by a full and frank disclosure of all of the relevant facts”. Examples of such circumstances include:



- the existence of co-pending opposition proceedings in Canada between the same parties for related trade-marks,
- a very recent change in the party's instructing principal or trade-mark agent, and
- exceptional circumstances beyond the control of the person concerned, including illness, accident, death, bankruptcy or other serious and unforeseen circumstances.

In addition, either party may request one further extension of time beyond the benchmark if the parties require limited additional time to fully finalize and complete settlement negotiations. The facts must clearly demonstrate that the parties have already reached an agreement and merely require additional time to fully conclude and finalize the settlement, which will put an end to the

opposition proceeding. Only one extension of time during the course of an opposition proceeding will be available for the parties to fully complete settlement negotiations.

An additional proposed change will allow parties to request that an oral hearing be scheduled and held on short notice. This will allow the Registrar to use hearing time made available by the cancellation or postponement of other opposition hearings. Parties will only be given 24 hours to confirm their attendance at a hearing on short notice before the Registrar will go to the next pending opposition on the short notice list.

Feedback on the proposed changes was solicited from the public until October 24, 2008. It is expected that any amendments to the practice of the Opposition Board will not take effect until 2009.

Elliott S. Simcoe, **Ottawa**

Federal Court rejects inequitable conduct doctrine in Canada

Canada's brief flirtation with U.S. doctrine seems to be over but baggage remains.

The Federal Court has declined to introduce a general U.S.-style duty of candour into Canadian law. In *Janssen-Ortho Inc. v. Apotex Inc.*, 2008 FC 744, a *Patented Medicines (Notice of Compliance) Regulations* proceeding, the applicants sought an Order prohibiting the Minister of Health from issuing a notice of compliance for a generic version of levofloxacin to Apotex until after the expiry of Canadian Patent No. 1,304,080.

Due to the filing date of the patent, its validity and infringement are governed by the *Patent Act* that was in effect immediately prior to October 1, 1989 and its accompanying *Patent Rules*.

Apotex's response included three separate validity attacks relating to the applicant's conduct in prosecuting the application before the Canadian Intellectual Property Office (CIPO). These attacks related to an Office Action in which the Examiner had imposed two requirements, pursuant to sections 40(1)(a) and (c) of the *Patent Rules*, requiring the applicant to furnish: (1) prior art cited against the corresponding United States and European Patent Office applications and (2) particulars of any interference proceeding in which the

corresponding U.S. application may have been involved.

The applicant's response addressed seven of the eight requirements contained in the Office Action, including the prior art requirement, although the applicant furnished only citations rather than copies of the prior art references. The applicant's response may have also omitted a reference cited in the U.S. application, the Gerster 1987 article, which was not citable prior art in Canada.

More significantly, the applicant's patent agent inadvertently overlooked the interference proceeding requirement and the applicant's response was silent on this point. In fact, an interference proceeding involving the corresponding U.S. application had been declared. The patent agent subsequently discovered this omission and notified the Examiner of the interference by telephone, before the application was allowed.

Apotex alleged that the deficiencies in the applicant's response rendered the patent void under Rules 40(1)(a) and (c). Apotex also argued that the patent was void for breach of the applicant's duty of candour.

The Court rejected all three of these attacks. With respect to the prior art requirement under Rule 40(1)(a), the rules did not automatically require copies of the prior art references; citations were adequate. The Gerster 1987 reference was not citable prior art, and was therefore not within the scope of the requirement.

The interference requirement under Rule 40(1)(c) posed a greater risk. As previously reported in the [February 2008](#) issue of *IP Perspectives*, under the current *Patent Act*, a complete failure to respond to any single requisition contained in an Office Action will result in a deemed abandonment of the application, regardless of whether the omission was in good faith. However, the pre-1989 *Act* and *Rules* are different and merely require the applicant's response to constitute "a *bona fide* attempt to advance the application to allowance". The Court held that unlike the current *Act*, the pre-1989 *Act* did not require a reply to each and every requirement contained in the Office Action to prevent abandonment. Rather, all that was needed was a *bona fide* response to the Office Action as a whole. The Court held that the applicant's response was sufficiently *bona fide*, as demonstrated by the patent agent's subsequent telephone call to notify the Examiner of the interference upon discovering the deficiency in the response.

Of greater interest was Apotex's separate allegation that the same deficiencies rendered the patent void for breach of the applicant's duty of candour. The Court held that no such duty of candour exists in Canada, stating (at para. 201):

"It is clear that there is no express duty of candour contained in the *Patent Act* or the *Patent Rules* and that the word 'candour' does not even appear in this legislation. While a duty of candour and good faith exists during the prosecution of patent applications in the United States Patent Office, a similar duty does not exist in Canada. ... There is no basis in Canadian law for the separate allegation of breach of candour put forth by Apotex. As the Federal Court of Appeal stated in *Flexi-Coil Ltd. v. Bourgault Industries Ltd.*, the disclosure required 'can only be ... that which the statute, the rules and the jurisprudence already require. Furthermore, even if the duty of disclosure had been extended as suggested by counsel, the impact of the extension would be felt not at



the level of the validity of the patent but at the level of the remedies where equitable considerations might come into play: "

Historically, prior to 2007, Canadian courts had confined an applicant's duty of disclosure to the express requirements of the *Patent Act* and *Rules*. Thus, in *Bourgault Industries Ltd. v. Flexi-Coil Ltd.* (1999), 86 C.P.R. (3d) 221 (F.C.A.), the Federal Court of Appeal held that an applicant has no general duty to disclose prior art, unless and until the Examiner expressly requests the applicant to furnish prior art from corresponding foreign applications under Rule 40 (now Rule 29).

In 2007, however, these principles were cast into doubt by a lower court decision, *G.D. Searle & Co. v. Novopharm Limited*, 2007 FC 81 (as reported in the [February 2007](#) issue of *IP Perspectives*). In *Searle*, the patent applicant had responded to an obviousness objection contained in an Office Action by arguing that a prior art patent to Matsuo did not, on its face, state that any of the compounds it disclosed had a certain combination of properties. As it turned out, however, another researcher at Searle, who was not among the named inventors, had concluded that one of the compounds disclosed by Matsuo did in fact have those properties. This researcher had publicly disclosed her findings at a conference several months before the Canadian filing date but subsequent to the priority dates of the patent application. The Applications Judge, who had appeared as counsel for the defendant in the *Bourgault* case, referred to the U.S. doctrine of inequitable conduct with apparent approval and distinguished *Bourgault* on the ground that section 73 of the *Patent Act*, which requires a "reply in good faith" to

each requisition from an Examiner, did not exist at the time of the *Bourgault* decision. The Applications Judge broadly held that all “communications with the examiner must be made in good faith” and must provide “full, frank and fair disclosure”. The Applications Judge ultimately found that Searle’s response to the obviousness objection was not a reply in good faith, resulting in a deemed abandonment of the application.

The *Searle* decision was reversed on appeal (2007 FCA 173). Unfortunately, the reasons for judgment of the Federal Court of Appeal were unusually terse, as the Court had been urgently asked to render a decision within a week after the conclusion of a two-day hearing. The Court concluded that the public disclosure by the other Searle researcher regarding the Matsuo compounds was not citable prior art because it was a disclosure by the applicant within the one-year grace period preceding the Canadian filing date. As a result, the Court reasoned that Searle had no duty to discuss the other researcher’s findings with the Examiner and that Searle’s failure to do so did not result in a deemed abandonment for failure to reply in good faith to the requisition.

Owing to the unusually urgent and terse nature of the decision, the Court of Appeal in *Searle* did not comment upon any of the broader statements or views of the Applications Judge relating to inequitable conduct or duty of candour. It is implicitly clear, however, that the duty to “reply in good faith” to a requisition is narrower than any corresponding duty that

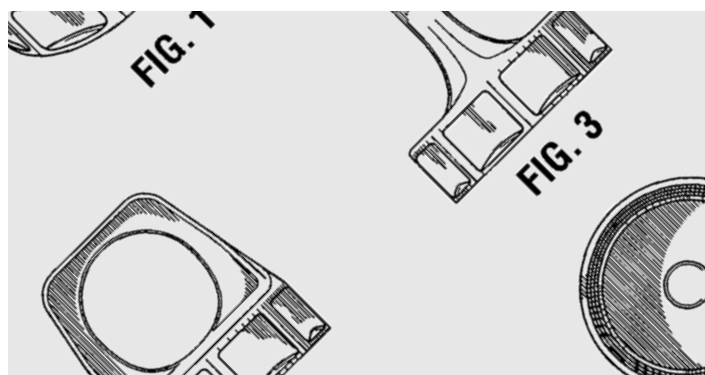
may exist in the United States. For example, 37 C.F.R. § 1.56(b)(2) obligates patent applicants to inform the U.S. patent office of any information that refutes or is inconsistent with a patentability argument advanced by the applicant during prosecution, regardless of whether the information itself is citable prior art. In contrast, it is clear from *Searle* that a Canadian patent applicant has no duty to disclose or discuss information that is not citable prior art.

As a result, a degree of uncertainty remains in Canadian patent law. On the one hand, from *Janssen-Ortho* and *Bourgault*, it is clear that the applicant has no duty of disclosure other than those that are expressly set forth in the *Patent Act*, the *Patent Rules* and the jurisprudence interpreting them. On the other hand, as *Searle* illustrates, under the current *Act*, an express statutory duty arises whenever an Office Action issues, requiring the applicant to “reply in good faith” to any requisition from an Examiner. Although the extent of this statutory duty is necessarily narrower than the duty of candour in U.S. law, its precise scope remains to be ascertained in future cases. It is hoped that this duty will be narrowly confined to cases involving either a complete absence of a reply or an intentionally fraudulent reply, to prevent the proliferation of baseless inequitable conduct allegations that have historically plagued U.S. litigation. Meanwhile, caution should be exercised in any Office Action response.

Stephen J. Ferance, Vancouver

Recent amendments to the *Industrial Design Regulations*

On October 5, 2008, amendments to the *Industrial Design Regulations* came into effect. The amendments update requirements on the



colour, size and quality of design applications, as well as the methods of illustrating the design and the environment of the article to which the design is applied. As a result of these amendments, colour drawings and photographs will now be accepted in industrial design applications in Canada. Most of the other amendments align the *Regulations* with processes and practices already in place. For example, the *Regulations* now include guidance on the use of stippled lines to show non-design portions of an article and permit the applicant to include one view showing the environment of the article to which the design is applied.

Kelly L. Miranda, Ottawa

Update on the PPH Pilot Program between CIPO and USPTO

As reported in the *February 2008* edition of *IP Perspectives*, the Patent Prosecution Highway (PPH) pilot program between the Canadian Intellectual Property Office (CIPO) and the United States Patent and Trademark Office (USPTO) began on January 28, 2008 and is scheduled to run until January 28, 2009. On July 22, 2008, CIPO issued an update to the Requirements and Procedure for participating in the program. It was previously established that to have prosecution of an application advanced under the PPH at CIPO, the claims in the Canadian application must substantially conform to claims allowed before the USPTO. This update clarifies that U.S. letters patent are acceptable documentation indicating allowable U.S. claims.

On their Frequently Asked Questions webpage for the PPH pilot program, CIPO also advises that by April 30, 2008, 60 requests to participate in the PPH pilot program had been

received. As of the last update to the webpage (July 25, 2008), 20 of those applications had been examined resulting in four allowances, 13 Examiner's reports and three rejections of the request to participate in the program. A majority of applications for which Examiner's reports were issued would have been allowed but for description informalities unique to Canada. CIPO recommends reviewing applications before filing requests to participate in the program to ensure that obvious informalities are corrected. Examples of corrections that should be made include deletion of incorporations by reference from the description and deletion or replacement of references to unpublished documents with their publication numbers or patent numbers.

CIPO has not yet determined whether it will extend this program. A decision should be made before the end of this year.

Kelly L. Miranda, Ottawa

Amendments to Copyright Act on hold

With the dissolution of Parliament resulting from the September 7, 2008 election call in Canada, Bill C-61, *An Act to Amend the Copyright Act*, died on the Government Order Paper. The proposed legislation included numerous provisions designed to balance the interests of rights holders who create content with those of Canadian consumers who use digital technology to view and reproduce content.

With the re-election of the Conservative Party, it is expected that the Bill will be reintroduced after Parliament resumes in late November

2008. However, the exact timing remains uncertain. This is because a Cabinet shuffle following the election resulted in the appointment of a new Minister of Industry, Tony Clement. The Minister's responsibility includes Canadian Intellectual Property Office legislation including copyright. It is possible that the new Minister will take the opportunity to consider making changes to the legislation before the law is reintroduced.

For background information on Bill C-61, please see the June 2008 edition of *IP Perspectives*.

Elliott S. Simcoe, Ottawa

Smart & Biggar/Fetherstonhaugh recognized in leading publications

This year, Smart & Biggar/Fetherstonhaugh received numerous recognitions in international legal surveys and directories. The most recent of those releases are listed below. We are proud of these recognitions and wish to congratulate all members of our firms who have been recognized.

The Best Lawyers in Canada. In the 2008 edition, the firms have been recognized as

having twelve pre-eminent lawyers in the areas of biotechnology law and intellectual property law – more than any other firm. Listed under intellectual property law: John Bochnovic, Mark K. Evans, Gunars A. Gaikis, Steven B. Garland, François Guay, Michael D. Manson, John R. Morrissey, A. David Morrow, Joy D. Morrow and J. Christopher Robinson. Listed under biotechnology law: Brian G. Kingwell,

Joy D. Morrow, J. Christopher Robinson and David E. Schwartz.

Legal Media Group's The Best of the Best 2008. In this guide, A. David Morrow is one of only three lawyers listed in the patent section in Canada.

Who's Who Legal. The firms have once again had professionals recognized in the 2008 International Who's Who of Trade-mark Lawyers: Michael D. Manson and A. David Morrow; and in the 2008 International Who's Who of Patent Lawyers: John Bochnovic, Michael D. Manson and A. David Morrow. The firms have also been acknowledged in the 2008 International Who's Who of Life Sciences Lawyers, with Gunars A. Gaikis, A. David Morrow, Joy D. Morrow and J. Christopher Robinson being listed.

Canadian Legal LEXPERT Directory. The firms have been listed as leading in the areas of

intellectual property and intellectual property litigation. Fourteen of our firms' professionals are listed in the 2008 edition. Listed under intellectual property: John Bochnovic, Mark K. Evans, Gunars A. Gaikis, Steven B. Garland, François Guay, Brian P. Isaac, Thomas R. Kelly, James D. Kokonis, Q.C., Michael D. Manson, John R. Morrissey, A. David Morrow and Joy D. Morrow. Listed under intellectual property litigation: Gunars A. Gaikis, Steven B. Garland, François Guay, John R. Morrissey and A. David Morrow. Listed under biotechnology: Brian G. Kingwell, Joy D. Morrow and J. Christopher Robinson.

Euromoney's Guide to the World's Leading Trade Mark Law Practitioners. Seven Smart & Biggar lawyers were selected as leading practitioners: John Bochnovic, Mark K. Evans, Brian P. Isaac, Philip Lapin, Michael D. Manson, A. David Morrow and Kohji Suzuki.

Notes

Announcements

Kazim Agha has joined our Ottawa office as an associate. Mr. Agha, who recently became a registered patent agent, holds a B.Sc. Hons. in Chemistry from Dalhousie University, a Ph.D. in Chemistry from McGill University, and a Grant MacEwan College Project Management Certificate.

Jeffrey E. Coles has returned after his articles to join our Ottawa office as an associate. Mr. Coles holds a B.Sc. Hons. in Biochemistry and Microbiology from Dalhousie University, and an M.Sc. in Medical Sciences – Oncology and an LL.B. from the University of Alberta.

Daniel S. Davies has returned after his articles to join our Ottawa office as an associate. Mr. Davies holds a B.A.Sc. in Electrical Engineering and an LL.B. from the University of Ottawa.

Roger T. Gallant has returned to the firms to join our Ottawa office as a technical consultant. Dr. Gallant holds a B.Sc. in Chemistry from the University of Prince Edward Island, an M.Sc. in Theoretical Chemistry from the University of Ottawa, an M.B.A. from Wilfrid Laurier University, and a Ph.D. in organic chemistry from the University of Western Ontario.

Joanne P. Gort has returned after her articles to join our Toronto office as an associate.

Ms. Gort holds a B.A.Sc. Hons. in Mechanical Engineering from the University of Toronto and an LL.B. from Osgoode Hall Law School.

Margaret (Ng Thow) Hing has returned after her articles to join our Toronto office as an associate. Ms. Hing holds a B.Sc. Hons. in Life Science from Queen's University, and an M.Sc. in Molecular and Medical Genetics and a J.D. from the University of Toronto.

Glen S. Kurokawa has returned after his articles to join our Ottawa office as an associate. Mr. Kurokawa holds a B.Sc. in Chemistry/Biochemistry from the University of British Columbia and a J.D. from the University of Toronto.

Patrick J. Laycock has returned after his articles to join our Ottawa office as an associate. Mr. Laycock holds a B.Sc. in Electrical Engineering from Brigham Young University, an M.Sc. in Optics from the University of Central Florida, and an LL.B. from the University of Alberta.

Tyler Lougheed has joined our Ottawa office as a technical consultant. Dr. Lougheed holds a B.Sc. Hons. in Biological Chemistry and a Ph.D. in Chemistry from the University of Toronto.

Lisa M. Thorne has joined our Vancouver office as an associate. Ms. Thorne holds a B.Sc. Hons. in Chemistry from Queen's University, and an M.Sc. in Chemistry and an LL.B. from the University of British Columbia.

Urszula Wojtyra has returned after her articles to join our Toronto office as an associate. Ms. Wojtyra holds a B.Sc. Hons. in Applied Biochemistry from the University of Guelph, and an M.Sc. in Biochemistry and a J.D. from the University of Toronto.

Smart & Biggar wishes to congratulate our professionals who passed the Canadian Patent Agents Examination in 2008. In Ottawa: **Kazim Agha** and **Sachiko Chijiwa**. In Montreal: **Andréanne Auger** and **George Elvira**.

Seminars and Presentations

Brian P. Isaac appeared on CTV's Canada AM morning show and was interviewed on the June 30, 2008 decision of the Commercial Court of Paris in *Louis Vuitton v. eBay*. The segment was filmed in Toronto and broadcast on July 2, 2008.

Sanro Zlobec moderated a discussion on "Recent Anti-Piracy Developments in Canada" at the joint Intellectual Property Institute of Canada and the New York State Bar Association summer meeting, held in Montreal on July 17, 2008. **François Guay** was a speaker at this same discussion.

Marc Gagnon conducted a workshop on "Patent Prosecution" and another on "Patent Advanced Claims Drafting" at the Intellectual Property Institute of Canada and McGill University's Understanding Patents – An Introductory Course, held in Montreal on July 29 and July 30, 2008 respectively.

Christian Bolduc spoke on the topic of "Preparing a Trade-mark Application, Use and Registrability Opinions" at the Intellectual Property Institute of Canada and McGill University Understanding Trade-marks course, held in Montreal in August 2008. Mr. Bolduc also led workshops on "Filing Strategies" and "Tips and Strategy in Opposition" at the same course.

Brian G. Kingwell was appointed Co-Chair of the IP Summit conference, held at the Four Seasons Hotel in Vancouver on September 8-9, 2008.

Keltie R. Sim led a panel discussion on the topic of "Who Handles Your Trade-marks?" at the MARQUES (Association of European Trade-Mark Owners) Annual Conference, held in Noordwijk, The Netherlands on September 17, 2008.

John R. Morrissey participated in a panel titled "A Justice of the Federal Court of Canada" at the Intellectual Property Institute of Canada's 82nd Annual Meeting, held in Toronto on October 15-17, 2008. **Mark K. Evans** spoke on

the topic of Canadian Opposition proceedings and conducted a mock cross-examination, **Sanro Zlobec** moderated a session on Copyright in the Digital Age, and **Brian P. Isaac** was on a panel that discussed Copyright Legislative Reform, at the same meeting.

Christian Bolduc spoke to Université Laval microbiology students about the patent agent profession, at an event held in Quebec City on October 17, 2008.

Sanjay D. Goorachurn was a co-conductor of a workshop on "Cross-border Intellectual Property" (providing a framework on the development and ratification of cross-border IP agreements and commercialization opportunities) at the 3rd Summit of the Canada-California Strategic Innovation Partnership, held in Montreal on October 27, 2008.

Karen F. MacDonald debated against the topic "Copyright Law has No Place in the Modern iWorld" at the inaugural Great Debate jointly hosted by Boughton Law Corporation and the British Columbia Law Institute, held in Vancouver on October 29, 2008.

Jeffrey D. Morton spoke on the topic of "Trade-mark Infringement on Online Auction Sites" at the University of British Columbia Law School Topics in Commercial Law (e-Commerce) course, held in Vancouver on November 3, 2008.

Brian P. Isaac will attend as a Canadian industry representative at the Security and Prosperity Partnership meeting between Canada, Mexico and the United States, to be held in Long Beach, California on November 19-20, 2008.

Sanjay D. Goorachurn will present on the topic of "*La gestion efficace d'un portefeuille de PI en contentieux d'entreprise - un outil de croissance et de compétitivité*" at the Canadian Institute conference *Protection de la propriété intellectuelle*, to be held in Montreal on November 24, 2008.

Christian Bolduc will co-preside and be a moderator on a panel discussion regarding "Business Method Patents" at the *Conférence avancée sur la protection de la propriété intellectuelle*, to be held in Montreal on November 25, 2008.

Christian Bolduc will speak on the topic of Community Trade-marks at the Intellectual Property Institute of Canada Roadshow, to be held in Montreal on November 28, 2008.

Brian P. Isaac will be the Course Leader for the Federated Press's Internet Law course, to be held in Toronto on December 4-5, 2008.



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