

COURT OF APPEAL BLOCKS LEGO

BRAD CRAN

LEGO blocks are among the most readily identifiable childhood toys. Intuitively then, many consumers might find it difficult to believe that courts would allow another manufacturer to produce and sell an outright copy.

Nevertheless, the Federal Court of Appeal in *Kirkbi and Lego Canada v. Ritvik Holdings* produced exactly that result. The decision brings Canada in line with decisions by courts in other countries, including the United States and England, which have considered the blocks.

Kirkbi and Lego Canada are both members of the Lego Group of Companies. Lego markets construction blocks characterized by cylindrical studs on their upper surfaces which enable the blocks to attach to each other. Ritvik sells substantially identical blocks in association with the trade-mark MEGA BLOKS that can be used interchangeably with the LEGO product. Kirkbi and Lego commenced an action against Ritvik under paragraph 7(b) of the *Trade-marks Act* ("Act") alleging that Ritvik was passing-off its blocks for those of Lego. Lego claimed that it had acquired trade-mark rights in the look of the upper surface of its toy block. The trial judge agreed that the appearance of Lego's blocks had become distinctive of Lego, but concluded that function dictated form. Following previous jurisprudence, which held that a trade-mark on a product shape cannot be a primarily functional feature of that product (termed by some the "doctrine of functionality"), the judge dismissed Lego's action. Lego appealed.

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On appeal, Lego did not dispute that its mark was primarily functional. Instead, it argued, as it had at trial, against the rejection of protection for primarily functional, unregistered marks. It sought to limit the "doctrine of functionality" to trade-marks registered under the Act. Because Lego had not registered its alleged mark, Lego claimed that the doctrine of functionality did not apply.

MAJORITY

By a 2:1 majority, the court reiterated that a primarily functional element of a product cannot act as a trade-mark. The upper surface of the LEGO block cannot be a trade-mark because it serves an obvious function for the block. The majority's lengthy review of the jurisprudence in this area provides some further guidance:

- Any combination of elements that forms a part of a product and that is primarily designed to perform a function (other than simply acting as a trade-mark) is not a trade-mark in which rights are enforceable. The opposite result would prevent others from exploiting the functional elements of that product.
- "Peripheral" or "secondary" functionality is allowed. The court used the example of a valid trade-mark consisting of a working phone number used by a pizza restaurant. The phone number is functional, but it is not functional in the sense of being a part of the pizza itself.
- The existence of a prior patent that covers the feature claimed to be a trade-mark is evidence that the feature is primarily functional.
- Functionality is a pure question of fact.

According to the court, the policy consideration behind the prohibition on functionality is "to ensure that no one directly or indirectly achieves the status of patent holder through the guise of a trade-mark." Lego had managed to maintain a monopoly on its toy blocks for a period of approximately 50 years through a succession of patents, with the last Canadian patent having expired in 1988. The court felt that Lego should not be able to obtain perpetual or "evergreen" protection by

way of trade-mark rights of features which had been claimed in the patents.

DISSENT

The dissenting judge accepted Lego's argument that the doctrine of functionality should apply only to registered, and not unregistered, trade-marks. He would have allowed Lego's action for passing off, finding that the LEGO trade-mark is enforceable.

The dissenting judge said that a registered trade-mark has greater substantive rights than an unregistered mark. In his opinion, only a registered trade-mark gives a trade-mark holder the right to exclusive use of that mark. In contrast, he said, a competitor is entitled to use another's unregistered mark provided that the competitor uses additional material to sufficiently distinguish its product from that of the trade-mark owner. In the latter case, there would be no harm in allowing an unregistered mark to be primarily functional because a competitor could still use those functional elements by ensuring that its product is sufficiently distinguishable in other ways. The majority disagreed with this approach, noting that it would lead to the illogical result of parties electing not to register trade-marks where their marks have functional elements.

It is now clear that a primarily functional element of a product cannot be an enforceable trade-mark in Canada. Businesses should be wary of developing a brand based on a mark having functional elements. Even if others can design around the shape of the product to achieve the same function (for example, square studs instead of round), there is still a risk of having the mark found unenforceable.



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VOLUNTARY DIVISIONAL APPLICATIONS MAY SPELL DOUBLE TROUBLE

MICHAEL VAILLANCOURT

A recent decision of the Federal Court, *GlaxoSmithKline v. Apotex*, confirms that, even under the post-1989 provisions of the *Patent Act* (the "Act"), patents that issue from voluntary divisional applications are susceptible to attacks of invalidity on the ground of double patenting.

The prohibition against double patenting is one of the numerous grounds for invalidating Canadian patents. In *Whirlpool v. Camco*, the Supreme Court of Canada held that the prohibition against double patenting involves two branches, namely "same invention" double patenting and "obviousness" double patenting. Under the "same invention" branch, a second patent is invalid if its claims are "identical or coterminous" with those of a patent that issued earlier. Under the "obviousness" branch, a second patent is invalid if its claims are not "patentably distinct" (i.e., novel and inventive) from those of an earlier patent. The courts (including the Supreme Court) have used language in some cases that suggests that a finding that a second patent displays either novelty *or* inventive ingenuity over the first patent is sufficient to rebut an attack of double patenting. It is more likely, however, that both novelty *and* inventive ingenuity are required to support a second patent.

The courts have used two rationales to justify the prohibition against double patenting, namely that 1) one invention may be the subject of only one patent, and 2) permitting multiple patents for one invention results in an improper extension of the patent monopoly. In *Whirlpool*, the rationale for the prohibition was stated to be that the Act provides that an "inventor is only entitled to "a" patent for each invention. If a subsequent patent issues with identical claims, there is an improper extension of the monopoly."

Pursuant to section 36 of the Act, where an application describes more than one invention, the applicant *may* voluntarily limit the application to one invention and file one or more divisional application(s) that claim any other invention(s) disclosed. However, on the direction of the Commissioner of Patents, the applicant *shall* file such divisional application(s).

It is settled law that the prohibition against double patenting does not apply to patents resulting from divisional applications directed by the Commissioner. However, the prohibition has been applied against patents that issued from voluntary divisional applications under the pre-1989 provisions of the Act. Until recently, there was some uncertainty as to whether the prohibition was applicable to patents that issue from divisional applications under the post-1989 provisions of the Act.

Under the pre-1989 provisions of the Act, the term of a patent grant is 17 years from the date of grant. Thus, where a second patent issues for the same invention as, or for an invention that is not patentably distinct from, that claimed in an earlier patent, there would be an improper extension of the monopoly to that invention.

Under the post-1989 provisions, the term of a patent grant is 20 years from the date of filing. Since a divisional application shares the same filing date as the original application, the patent that issues from a divisional application does not extend the monopoly granted to the patent that issued from the original application.

In *GlaxoSmithKline*, GlaxoSmithKline argued that, under the post-1989 provisions, a patent that issued from a divisional application cannot be found invalid on the ground of double patenting. Counsel submitted that "the sin of double patenting" had been removed by the 1989 amendments, since patents that issue from divisional applications under the post-1989 provisions do not extend the patent term accorded to the invention. The Federal Court disagreed and stated that GlaxoSmithKline had overlooked the particular impact that multiple patents can have under the *Patented Medicines (Notice of Compliance) Regulations*, which enable a patentee of a medicine to obtain an injunction to prevent regulatory approval of a generic equivalent. Further, and more importantly from the perspective of general patent law, the court held that a patentee should not be able to receive additional patents for the same invention. Even though there is no extension of the monopoly to the invention, inventive ingenuity is still required to support the second patent.

The message to be taken from this decision is that the filing and prosecution of divisional applications in Canada, including the cancellation of claims in a parent or other divisional application, requires a careful strategic analysis. Risks may be less in the case of division required by the Patent Office than where division is voluntary. However, in all cases, careful attention should be given to consideration of the merits and disadvantage of filing a divisional application and the timing of such applications.



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PRIVACY COMMISSIONER REFUSES TO SUBSCRIBE TO PUBLISHER'S CONSENT PRACTICES

VEERA RASTOGI

Beyond stating general principles, the *Personal Information Protection and Electronic Documents Act* ("PIPEDA") does not provide much guidance on how (or how not) to obtain the "knowledge and consent" of an individual which is necessary for a valid consent.

However, in comments sprinkled through more than 170 decision summaries published late last year, the former Privacy Commissioner ("Commissioner") elaborated to some extent on his interpretation of the consent principles of PIPEDA. In those decisions, the Commissioner established broad guidelines recommending that organizations inform individuals in a prominent, comprehensible and relatively specific manner as to: 1) what personal information is to be collected and from whom; 2) how and why this information is to be used; and 3) to whom this information is to be disclosed and why. The Commissioner also stated that an immediate, convenient and inexpensive means of opting out of non-essential uses and disclosures of information must be offered.

The Commissioner's latest and most specific pronouncement on consent requirements is found in a summary of a decision on an individual's complaint that a magazine had been selling or renting his name and address to third parties without his consent. While the masthead of each magazine issue contained notification of the practice in question and of the procedure by which a subscriber could opt out of having his/her name included on this list, the original subscription card made no mention of this disclosure and opt-out option. The notification on the masthead appeared in small print and was "buried in a dense paragraph of miscellany" on the page. The names or types of companies to which subscriber information was forwarded were not identified.

In its defence, the magazine pointed out that it had been following the practice of most magazines and the guidelines established by the Canadian Marketing Association. As such, the magazine expressed concern that it would be put at a competitive disadvantage if it undertook a higher level of

disclosure than the rest of the industry.

The Commissioner determined that the magazine's purpose notification was inaccessible and that the opt-out option was not presented at the time of subscription. Thus, the magazine had failed to obtain the complainant's knowledge and consent. The Commissioner recommended that in the future the magazine inform its subscribers of its non-essential uses and disclosures of their information by: 1) including a purpose statement and a checkoff box on the subscription form; 2) displaying the statement prominently and in regular size type and including in it a description of the items to be disclosed (for example, name and address) and the organizations to which the disclosures are to be made; and 3) providing and prominently advertising a mechanism, including a toll-free telephone number, where subscribers can conveniently, inexpensively and promptly withdraw their consent at any time. The Commissioner held that the magazine could continue to use the opt-out form of consent, *provided that* the organizations to which disclosure is to be made are identified at least by type *and* that the items of information to be disclosed remain limited to name and address.

The Commissioner was dismissive of the magazine's "industry standard" defence. The Commissioner's unequivocal view was that his conclusions were never meant to be subject to industry approval and that, rather, PIPEDA (and presumably his interpretation of it) *is* the new industry standard for the management of personal information. The Commissioner made it abundantly clear that his "recommendations" are meant not for negotiation, but for adoption.

It remains to be seen whether the new Commissioner will adopt an equally inflexible stance.



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PRIVACY COMPLIANCE FROM COAST TO COAST— NOBODY SAID IT WOULD BE EASY

IAN HAY

With the coming application of the federal *Personal Information Protection and Electronic Documents Act* (“PIPEDA”) in January 2004, and the development of similar private-sector privacy legislation in the provinces, organizations should be prepared to comply with a patchwork of privacy obligations.

PIPEDA empowers the federal government to exempt organizations (as well as particular activities) from application of the statute in respect of the collection, use or disclosure of personal information that occurs solely within a province, if that province has enacted legislation determined to be “substantially similar” to PIPEDA. Some provinces have enacted or proposed their own privacy legislation. However, substantial similarity of local provincial legislation will rarely be the end of the privacy story. Importantly, PIPEDA will still apply to the interprovincial and international collection, use and disclosure of personal information, as will any local privacy legislation of the provinces involved. It is very common for provincial organizations to do business or have customers or clients outside their own province. These organizations may find themselves subject to a patchwork of varying privacy legislation, regardless of whether their own legislation is substantially similar.

Currently, Québec is the only province with private sector privacy legislation in force. The Alberta and British Columbia (“B.C.”) legislatures have tabled bills, each expected to be passed before the end of the year. Ontario released a consultation draft of its proposed private-sector privacy legislation in February 2002, though whether a bill is forthcoming in Ontario remains uncertain. If so, it is expected to contain substantial revisions from the earlier draft.

While the final determination rests with the Governor in Council, PIPEDA requires the Privacy Commissioner to report to Parliament on whether provinces have enacted “substantially similar” legislation and its application. The former Commissioner had found the Québec private sector privacy legislation to be substantially similar to PIPEDA. The B.C. and Alberta bills, however, according to statements made shortly after their publication, are not substantially similar in the view of the former Commissioner, who found these proposed statutes to be deficient in a number of respects.

Organizations in provinces with legislation that is not deemed to be substantially similar to PIPEDA will have to comply with both the federal and the provincial legislation. Even where the privacy legislation of a province is deemed to be substantially similar, however, the landscape of privacy legislation within which organizations will have to operate and comply may not be any less complex. Collection, use and disclosure of personal information that takes place wholly within a province with substantially similar legislation will likely need only to comply with the applicable provincial statute. However, when one takes into account business and transactional realities, particularly the fact that many, if not most,

businesses have some extra-provincial aspect to their commercial activities or transactions, these businesses will likely find that they have to comply with multiple privacy regimes irrespective of the “substantial similarity” of local provincial legislation.

An Alberta business, for instance, may collect, use and disclose information about its B.C. clients or customers. A Québec company may seek financing from an Ontario-based organization that requires examination of customer account records as part of due diligence prior to financing, or regular records-reporting in the course of a commercial relationship. A B.C. organization may trade customer information with a Québec company as part of a joint marketing initiative.

Assuming, hypothetically, that each of Québec, Ontario, Alberta and B.C. has enacted privacy legislation, *regardless* of whether any of these are found to be substantially similar to PIPEDA, each of the above transactions and activities will likely require compliance with at least three privacy statutes concurrently. The provincial statutes that govern each of the sending and receiving organizations, or those of the organization and its customers, respectively, will have to be followed. In addition, because of the cross-provincial aspect to each of the above scenarios, these transactions or activities will have to comply with the federal PIPEDA.

Concurrent compliance with multiple privacy regimes is made more complex by the fact that many of the above hypothetical situations may be treated differently under one statute as compared with another. A provincial statute, for instance, may provide an exemption in respect of certain uses or disclosures of personal information that may not be available under PIPEDA. While PIPEDA’s allowance for “substantially similar” provincial legislation is intended to create uniformity of personal information protection among Canadian jurisdictions, emerging provincial privacy statutes may have been crafted to address or clarify uncertainties found in the federal legislation or that of a neighbouring province, resulting in some differences in the details.

The resulting privacy landscape will be complex for organizations seeking to comply with each regime. Organizations doing business in Canada should not lose sight of the fact that extra-provincial collection, use and disclosure of personal information may, in any event, have to comply with PIPEDA and the legislation of other provinces in which they deal, and familiarity only with the requirements of an organization’s local provincial legislation will often not be sufficient.



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WHEN IS A .CA DOMAIN NAME “CONFUSINGLY SIMILAR”?

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Notwithstanding the relatively small number of decisions rendered to date under the Canadian Internet Registration Authority (“CIRA”) Domain Name Dispute Resolution Policy (“CDRP”), two divergent approaches have already emerged in applying a suitable test in determining whether a disputed .ca domain name is “confusingly similar” to a complainant’s mark.

For a complainant to succeed in a proceeding under the CDRP, one of the three elements it must satisfy is that the disputed .ca domain name is confusingly similar to a mark in which the complainant has rights. A complainant must also prove that the registrant registered the domain name in bad faith and must provide some evidence that the registrant has no legitimate interest therein.

“CONFUSINGLY SIMILAR” DEFINED

Unlike the equivalent concept under the Uniform Domain Name Dispute Resolution Policy (“UDRP”) adopted by The Internet Corporation for Assigned Names and Numbers (“ICANN”), the CDRP expressly defines “confusingly similar”. The CDRP states that a “... domain name is ‘Confusingly Similar’ to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.”

The definition is based on elements of subsection 9(1) of the Canadian *Trade-marks Act* (the “Act”). Subsection 9(1) enumerates certain types of marks which persons are prohibited from adopting in connection with a business, the test being that a mark may not consist of, or so nearly resemble as to be likely to be mistaken for, one of the enumerated types of marks. By way of comparison, paragraph 6(5)(e) of the Act sets out five non-exhaustive “surrounding circumstances” required to be assessed in the determination of whether trade-marks or trade-names are “confusing” for the purposes of the Act. This paragraph provides that, in assessing confusion, the court or the Registrar of Trade-marks, as the case may be, is to have regard, among other factors, to “... the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them”.

CIRA expressly incorporated certain elements of Canadian trade-mark law, but not the full test of confusion as set forth in subsection 6(5) of the Act. Given the *de novo* nature of the CDRP, the inference is that in defining “confusingly similar”, CIRA intended to steer away from a traditional trade-mark confusion analysis under Canadian trade-mark law, and instead adopt a more limited test based on “resemblance” to assess whether a .ca domain name is confusingly similar to a

complainant’s mark. A limited test could be seen as consistent with the stated purpose of the CDRP which is to deal with domain name disputes relatively inexpensively and quickly.

THE DIVERGING DECISIONS

In the decisions rendered under the CDRP to date, some panels have concluded that the test in assessing whether a domain name is confusingly similar with a complainant’s mark is not one of confusion, as normally found in Canadian trade-mark jurisprudence, but of resemblance.

However, other panels have interpreted the definition of confusingly similar as requiring an assessment of whether the domain name is confusing with the complainant’s mark in the traditional trade-mark sense. Notably, in <<browneco.ca>> the panel adopted an approach based on confusion, taking note of the corresponding provision in the UDRP which requires that a domain name be “identical or confusingly similar” to a mark in which a complainant has rights. Finding significance in the fact that the words “identical or” were not incorporated into the CDRP, the panel reasoned that the intention of the CDRP was to put a clear focus on the meaning of the term “confusingly”. The panel concluded that the intention behind the definition of the term confusingly similar was not to adopt a simple test of similarity of the domain name; if it were, there would be no reason to include the word “confusingly” before the word “similar”, nor would there be any logic in deleting the words “identical or” in adapting the Canadian test from the analogous provision under the UDRP. In its assessment of the issue of confusion, the panel considered factors included in a traditional trade-mark infringement analysis, including the inherent distinctiveness and secondary meaning of the complainant’s trade name as well as the similarity of that trade name with the domain name browneco.ca. The panel concluded that the domain name was confusingly similar to the complainant’s trade name.

Interestingly, in <<airproducts.ca>>, the panel not only applied a confusion test but, in noting the relative infancy of the CDRP and acknowledging other possible interpretations of the term confusingly similar, *also* applied a resemblance test. Under the confusion test, the panel found that the domain

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name was not confusingly similar to either the complainant's registered mark or to its trade name, Air Products Canada Ltd. However, in applying a resemblance test, the panel held that the domain name was confusingly similar to both the complainant's registered trade-mark and its trade name. In the end, the panel adopted the result arising from applying a test of confusion and dismissed the complaint.

A RESOLUTION? GOVERNMENT OF CANADA V. BEDFORD

In the CDRP dispute between the Government of Canada and David Bedford, the Government of Canada was successful in obtaining the transfer of 9 of 10 disputed .ca domain names.

Acknowledging that divergent approaches had been applied in previous disputes, the panel rejected the confusion test, and adopted the resemblance test. In doing so, the panel took note of a number of considerations: 1) the similarity of the definition of confusingly similar to subsection 9(1) of the Act; 2) the test under subsection 9(1) of the Act does not include consideration of marketplace factors which form part of a source confusion analysis; 3) the significance of the omission of the elements of subsection 6(5) of the Act other than paragraph 6(5)(e); 4) an official mark advertised under paragraph 9(1)(n) of the Act may be relied upon to prevent the use of similar marks even without the likelihood of confusion; 5) a comparison of domain names and trade-marks without considering marketplace factors is consistent with the way in which domain names are used on the Internet; and 6) the procedure under the CDRP is not suited to the kind of factual determinations involved in a conventional confusion analysis.

The panel thus concluded that, in order to succeed, the complainant must prove that a person, on a first impression, knowing of the complainant's mark only, and having an imperfect recollection of it, would likely mistake the disputed domain name for the complainant's mark based upon the appearance, sound or ideas suggested by the mark, consistent with the cases decided under subsection 9(1) of the Act.

In its reasoning, the panel expressly disagreed with the conclusion in <<airproducts.ca>> adopting confusion as the proper test and with the suggestion that a complainant's mark must be distinctive in order to sustain a finding that a domain name is confusingly similar with a mark. The panel was of the

view that, although distinctiveness of a complainant's mark may be relevant in the determination of whether a complainant has rights in a mark, it is not an appropriate consideration in determining whether a disputed domain name is confusingly similar to a complainant's mark.

FUTURE DISPUTES

Disputes under the CDRP are, in effect, arbitrations rather than formal court proceedings. Thus, previously rendered decisions are not binding on subsequent disputes. Having said that, they no doubt have instructive value and should be of guidance to panels in future proceedings. It will be interesting to observe how future panels address the confusingly similar criterion and whether the test set forth in *Bedford* will establish itself as the preferred approach in determining whether a domain name is confusingly similar to a complainant's mark.

Blakes is counsel to CIRA. Our retainer by CIRA expressly permits Blakes to represent parties in domain name disputes under the Policy.

NEW FACES AND HONOURS

Peter Hogg has returned to our Toronto office to be the Firm's Scholar-in-Residence after completing a five-year term as Dean of Osgoode Hall Law School.

As well, Peter has recently been named a Companion of the Order of Canada. He was first named an Officer of the Order of Canada in 1991. His promotion to Companion, the highest of the three honours, was announced by the Governor General of Canada, Adrienne Clarkson.

The Order of Canada recognizes people who have made a difference to our country – Canada's highest honour for lifetime achievement.

We are pleased to announce that the following people have joined the Blakes Intellectual Property Group.

Pauline Wong has joined the Intellectual Property Group in Toronto after her call to the bar. Pauline obtained both her LL.B. and her B.C.L. at McGill University. Prior to law school, she obtained a degree in systems design engineering from the University of Waterloo and worked for major technology companies. She has also clerked with the Quebec Superior Court. Pauline will focus on intellectual property and technology related litigation and computer, mechanical and electrical technology matters.

Cindy Yan has joined the Intellectual Property Group in Toronto after her call to the bar. Cindy obtained her law degree at the University of British Columbia. Prior to law school, she obtained her science degree with a speciality in pharmacology from the University of Alberta. Cindy, who is fluent in Chinese, also studied in the Masters of International Business Law program at Chulalongkorn University in Thailand. Cindy's practice will focus on the life sciences.

Elizabeth McNaughton (Regulatory), **Brian Gray** (Biotechnology) and **Sheldon Burshtein** (Pharmaceutical) have all been listed in the Global Counsel Life Sciences Handbook.

George Fisk and **Brian Gray** have been recognized in Euromoney's Guide to the World's Leading Patent Law Experts.

Brian Gray and **Sheldon Burshtein** have again been selected to the International Who's Who of Patent Lawyers, 2004.

Brian Gray and **Sheldon Burshtein** have again been listed in the International Who's Who of Business Lawyers, 2004.

Sheldon Burshtein was one of four Canadians among 26 worldwide selected for Trade-marks in The Best of the Best 2003 by Euromoney. Three other Blakes' lawyers were also selected in other practice areas.

Sheldon Burshtein has been recognized in Euromoney's Guide to the World's Leading Trade Mark Law Experts.

PROFESSIONAL NOTES

ADVERTISING AND FOOD AND DRUG

Rob Kwinter, co-chair, *Advertising & Marketing Law*, The Canadian Institute. Rob moderated the panel on *From Drawing Board to Market: A Survey of 'Best Practices' for Bridging the Gap Between Legal and Marketing*. Rob also spoke on *Beyond Misleading Advertising: What Advertisers Need to Know About the Other Provisions of the Competition Act*.

Elizabeth McNaughton, moderator, *Privacy and Customer Information: How to Get Critical Marketing Information While Staying Compliant*, Advertising & Marketing Law, The Canadian Institute.

Rob Kwinter, speaker, *Navigating the Jungle of Ambush Marketing - the Defendant's Perspective*, Annual Advertising and Marketing Law, Insight. **Mark Rushton** co-authored the paper.

Elizabeth McNaughton, speaker, *Current Federal and Provincial Enforcement Efforts in Advertising and Consumer Protection*, Annual Advertising and Marketing Law Conference, Insight.

Alice Tseng, speaker, *Regulatory Issues for the Pharma Industry*, Drug Patents, Insight.

Elizabeth McNaughton, speaker, *Selected Recent Federal and Provincial Advertising and Consumer Protection Developments*, Annual Advertising and Marketing Law Conference, Insight.

Elizabeth McNaughton, Richard Corley and Parna Sabet, co-authors, *Competition Bureau Clamps Down on Internet Advertising*, E-Commerce - Canada, International Law Office.

Elizabeth McNaughton, member, Editorial Advisory Board, Food and Drug Law Journal.

Elizabeth McNaughton, speaker, *Advertising in the International Arena: Advertising and Promotional Contests - The Canadian Perspective*, National Advanced Forum for Advertising Law, America Conference Institute.

Elizabeth McNaughton, **Richard Corley** and **Parna Sabet**, authors, *Internet Advertising in Canada*, World Internet Law Report.

Elizabeth McNaughton and **Crystal Witterick**, of our Competition Group, authors, *Price Claims Cost \$1,000,000*, FTC Watch.

COPYRIGHT & DESIGNS

George Fisk, speaker, *Copyright and Industrial Designs*, Intellectual Property: Year in Review 2002, Law Society of Upper Canada - Ottawa. The paper was also co-authored by **Sheldon Burshtein** and **Marcy McKee**.

Sheldon Burshtein, speaker, *Copyright and Industrial Designs*, Intellectual Property: Year in Review 2002, Law Society of Upper Canada - Toronto. The paper was co-authored by **George Fisk** and **Marcy McKee**.

Sheldon Burshtein, speaker, *Update on Copyright Law*, Annual Meeting, (International Association for the Protection of Intellectual Property (AIPPI) - Canadian Group.

Sunny Handa, speaker, *Focus on Computer Programs*, Understanding the Business of Copyright, McGill University and Intellectual Property Institute of Canada.

Sheldon Burshtein, speaker, *Posters, Satellite TV, Software, Headnotes, the Internet and Other Stuff: Canadian Copyright Law in 2002*, (Association Literaire et Artistique Internationale - Canada). The paper was co-authored by **Sheldon**, **George Fisk** and **Marcy McKee**.

Brian Gray, speaker, *Exempt Activities*, Understanding the Business of Copyright, McGill University and Intellectual Property Institute of Canada.

COMPETITION

Jack Quinn and **Neil Finkelstein**, of our Competition Law Group, co-chairs, *Canada's Changing Competition Regime*, Insight. Jack also moderated two panels, one on *Proposed New Approaches to Conspiracy Issues* and another on *Proof of Competitive Injury*. Neil participated in the panel on *Proof of Competitive Injury*.

Cal Goldman and **Michael Piaskoski**, of our Competition Law Group and **Richard Corley**, speakers, *Competition Law in High Tech Industries: Market Definition and Other Economic Considerations*, Asia Foundation.

Cal Goldman, panelist, *Exchange of Confidential Information Between Enforcement Authorities and the Role of Privilege*, Canada's Changing Competition Regime, Insight.

INTELLECTUAL PROPERTY

Dawn Mains, speaker, *The Nuts and Bolts of Intellectual Asset Management*, Blake, Cassels & Graydon LLP Seminar on Protecting Intellectual Property in the Petroleum Industry, Calgary.

Ken Mills and **Darel Samuelson**, speakers, *Strategies for Protecting Trade Secrets*, Blake, Cassels & Graydon LLP Seminar on Protecting Intellectual Property in the Petroleum Industry, Calgary.

LICENSING & TECHNOLOGY TRANSFER

George Fisk, co-chair, *Negotiating and Drafting Intellectual Property License Agreements*, The Canadian Institute. George also presented a paper on *Representations and Warranties in License Agreements*, authored by **Sheldon Burshtein**.

Sheldon Burshtein, co-chair, *The Legal and Business Forum on Advanced IP Licensing - Joint Venture, Co-Development and Co-Promotion Agreements*, The Canadian Institute. Sheldon also moderated a panel on *Negotiation of Difficult Clauses in a Partnering Deal*.

Richard Corley, panelist, *Negotiation of Difficult Clauses in a Partnering Deal*, The Legal and Business Forum on Advanced IP Licensing - Joint Venture, Co-Development and Co-Promotion Agreements, The Canadian Institute.

Sheldon Burshtein, author, *2003 Update, Canada*, The Law of Merchandise and Character Licensing, Battersby & Grimes (Aspen Law & Business).

Sheldon Burshtein and **John Sawicki**, student-at-law, co-authors, *Developments in Canadian Licensing*, 2003 Licensing Update, Battersby & Grimes editors (Aspen Publishing).

Sheldon Burshtein, speaker, *Negotiating and Drafting License Agreements*, Intellectual Property Summit 2003, Infonex.

Sheldon Burshtein, author, *Licensing Fundamentals: Governing Law and Jurisdiction and Government Intervention*, World Licensing Law Report.

Sheldon Burshtein, author, *Licensing Fundamentals: International Agreements*, World Intellectual Property Report.

Sheldon Burshtein, author, *Licensing Fundamentals: Boiler Plate*, World Licensing Law Report.

Sheldon Burshtein, author, *Licensing Fundamentals: Execution and Formalities*, World Licensing Law Report.

Sheldon Burshtein, author, *Licensing Fundamentals: Export and Import Restrictions*, World Licensing Law Report.

Sheldon Burshtein, author, *Licensing Fundamentals: Recordal and Notification*, World Licensing Law Report.

Sheldon Burshtein, author, *Licensing Fundamentals: Limitations of Liability*, World Licensing Law Report.

Christine Ing, panelist, *Trademark Licensing: A Strategic Brand - Building Tool*, Licensing Executives Society USA/Canada.

Sheldon Burshtein, author, *Licensing Fundamentals: Limitation of Liability Clauses*, World Licensing Law Report.

Sheldon Burshtein, member, US/Canada Licensing Field Guide Committee, American Bar Association.

LITIGATION AND ARBITRATION

Alan Aucoin, speaker, *Intellectual Property Disputes: When and How to Fight*, IT Spring Training II, Canadian IT Law Association and The Law Society of Upper Canada.

Mark Penner, judge, Niagara Moot, University of Toronto.

Neil Finkelstein, of our Litigation Group, co-chair, *The Art & Science of Trial Advocacy*, American College of Trial Lawyers and The Advocates' Society. Neil also spoke on *Effective Openings and Closings*.

Sheldon Burshtein, judge, Osgoode Hall Law School Laskin Moot Team.

Gord McKee, of our Litigation Group, chair, *National Forum on Drug and Medical Device Liability*, The Canadian Institute. Gord also spoke on *Drug and Medical Device Liability in Canada: A Bird's Eye View of the Current Legal Landscape*.

Joel Richler, of our Litigation Group, speaker, *Scientific Evidence and Admissibility in the Context of a Drug or Device Injury Claim: How Do You Prove or Rebut Causation?*, National Forum on Drug and Medical Device Liability, The Canadian Institute.

PROFESSIONAL NOTES

PATENTS

Brian Gray, co-chair, *Drug Patents - Latest Developments and Strategies*, Insight.

John Koch, moderator, *A View of the NOC Regulations from Counsel Representing Research-Based Pharmaceutical and Generic Drug Companies*, Drug Patents, Insight.

Sheldon Burshtein, author, *Patents: Who is Entitled to a Patent and What Should be Done Before Applying?*, Pharmaceutical Canada.

Brian Gray and **Monica Rooney**, authors, *Supreme Court Rejects Patentability of Harvard University's 'Oncomouse'*, World Intellectual Property Report.

Mark Penner, author, *Supreme Court Upholds Validity of Wellcome's Patent for AZT Use*, World Intellectual Property Report.

Sheldon Burshtein, author, *Patents: What Must a Patent Application Include?*, Pharmaceutical Canada.

Bob Nakano, tutorial leader, *Understanding Patents: An Introductory Course*, McGill University and Intellectual Property Institute of Canada.

Brian Gray and **Sean Zhang**, authors, *Applicant's 'Small Entity' Designation Does Not Change During Term of Patent*, World Intellectual Property Report.

PRIVACY

Elizabeth McNaughton, speaker, *Document Keeping, Consent and Disclosure - What, When, Where, How Long and To Whom?*, Privacy Laws & Effective Workplace Investigations, Insight.

Elizabeth McNaughton, moderator, *Privacy and Customer Information: How to Get Critical Marketing Information While Staying Compliant*, Annual Conference on Advertising and Marketing Law, The Canadian Institute.

TECHNOLOGY

Sunny Handa, appointed to the IT-Can Board of Directors, effective October 23, 2003.

TRADE-MARKS AND DOMAIN NAMES

Chris Hale, co-author, *Canada*, International Annual Review, The Trademark Reporter.

Sheldon Burshtein, author, chapter on *Canada*, Trademark Practice & Forms, Oceana Publications.

Chris Hale, co-author, *Canada*, Trademark Law Handbook.

Sheldon Burshtein, author, *Metatags in Canada*, World Internet Law Report.

Ian Hay, author, *First Decision Under the CIRA Dispute Resolution Policy Released*, World Internet Law Report.

Sheldon Burshtein and **Ian Hay**, authors, *Domain Name Dispute Resolution Policies Compared*, World Trademark Law Report.

Tony Prenol, author, *Courts Continue to Define Grounds for Attacking 'Official Marks'*, World Licensing Law Report.

Sheldon Burshtein, author, *'Confusingly Similar' Does Not Mean 'Confusing' in the Canadian Domain Name Dispute Resolution Policy: Are you Confused?*, Intellectual Property.

Sheldon Burshtein and **Ian Hay**, co-authors, *Domestic Domain Name Dispute Resolution Policy*, E-Commerce - Canada, International Law Office.

Sheldon Burshtein, speaker, *Domain Name Dispute Resolution*, Internet Law, Insight.

Sheldon Burshtein, instructor, *An Introduction to Trade-mark Law in Canada; The Basics of Trade-mark Use in Canada: The Who, What, Where, When and Why; Understanding Trade-marks: An Introductory Course*, McGill University and Intellectual Property Institute of Canada.

Sheldon Burshtein, speaker, *International and Canadian Domain Name Dispute Policies: Substantive Rules and Procedures*, Avoiding Bloodsports: The New Rules of Engagement, Canadian Bar Association.

TRANSACTIONS

Sheldon Burshtein, moderator, *Intellectual Property Management, Business Issues in the Innovation Economy*, University of Toronto Center for Innovation Law & Policy. Sheldon also presented a talk on *Intellectual Property Audits and Due Diligence*.

Sheldon Burshtein, speaker, *Intellectual Property, Technology and E-Commerce Due Diligence in Business Transactions: Focus on Trade-marks and Copyright*, FORPIQ 2003 IPIC/AIPPI/FICPI.

Anne Stewart, of our Corporate Group, co-chair, *Negotiating and Drafting Major Commercial Agreements and Transactions*, Atlas Information Canada.

INTELLECTUAL PROPERTY GROUP

Blakes Intellectual Property Group is one of the largest intellectual property practices in Canada and has repeatedly been recognized as one of the top practices in the country. Ours is a full service IP practice with lawyers and patent and trade-mark agents who advise on the acquisition, transfer and enforcement of patent, trade-mark, copyright and numerous other IP rights. We also have extensive experience in the litigation and mediation of IP infringements, and licensing and regulatory disputes.

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