INTELLECTUAL PROPERTY GUIDE

FOR CANADIAN ENTREPRENEURS AND VENTURES

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for River City Venture Clinic with the
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This guide has been prepared by Dr. Faith O. Majekolagbe and Sereena Dosanjh (University of Alberta) for River City Venture Clinic with the financial support of ISED Canada Intellectual Property (IP) Clinics Program Grant, with editorial contributions from Michael Sharp.

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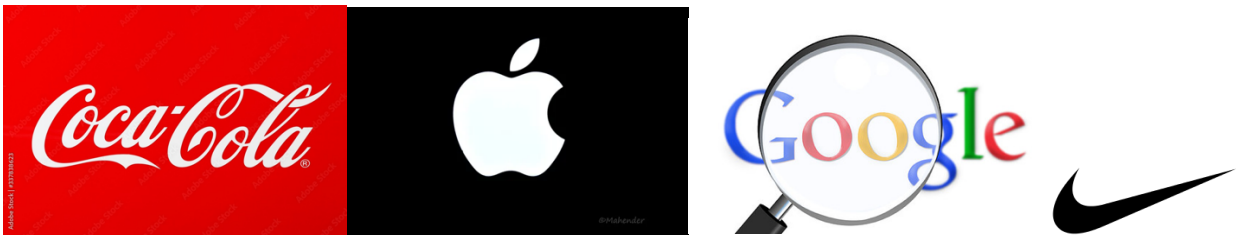
Trademarks Guide for Entrepreneurs and Ventures

What is a Trademark?

A trademark is a sign, or a combination of signs, that is used to distinguish a business's goods or services from that of another. Some of the most famous examples of trademarks include Coca-Cola®, Apple®, Google®, and Nike®.



Tradenames

Before we get started, it's important to distinguish trademarks from *tradenames*. A tradename identifies the company or business entity carrying on a business while a trademark identifies the products or services of the entity and distinguishes it from those of others. A company may choose to have the same or similar tradename and trademark.

For example, Tim Hortons Canadian IP Holdings (trading under the_corporate name) owns the trademark TIM HORTONS.

Tim Hortons

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But a company may also choose to register a trademark that is not related to the tradename at all. For example, Meta (tradename) owns the trademarks FACEBOOK, INSTAGRAM, THREADS, and WHATSAPP.

Credit: "File:Mark Zuckerberg on stage at Facebook's F8 Developers Conference 2015 (16908770206).jpg" by Maurizio Pesce from Milan, Italia is licensed under CC BY 2.0.

Eligibility

A trademark can be in the form of words, slogans, phrases, designs, letters, numbers, colours, figurative elements, 3D shapes, holograms, moving images, a mode of packaging goods, sounds, scents, tastes, textures, and the positioning of a sign. Any of these can be registered as a trademark, so long as they are considered distinctive.

Distinctiveness

When selecting your trademark, it is important that you ensure that the mark is *distinctive.* This means that the mark should be capable of distinguishing the product or service of the business from the product or service of other businesses. Marks that are inherently distinctive are preferred, as they are considered legally strong marks. An inherently distinctive mark is one that would immediately (i.e., prior to actual use) be indicative of a single source in the mind of the ordinary consumer of that good or service. Fanciful or made-up (coined) words typically have a high level of inherent distinctiveness because they have no associated meaning or suggestion with the good or service. Some examples of these include KODAK and SPOTIFY.

It is possible for a trademark to gain or lose distinctiveness over time. For example, the word "escalator" used to be a distinctive trademark, but now is used as a generic word for describing any brand of electrically moving stairs.

Examples

Let's look at some examples of the most common forms of trademarks.

Words

When most people think of trademarks, they think of the classic examples of "Coca-Cola" or "Facebook". Words, or a combination of words, can be a trademark.

Beyond classic brand names, you can also use a slogan or tagline as a trademark! Some recognizable ones include "Just Do It," and "Got Milk?"

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Colours

Colours can also be trademarked! However, they tend to be a bit trickier to protect as trademarks. To be protected as a trademark, the colour must have *acquired distinctiveness* by reason of prior long use by the business such that consumers automatically associate the colour with a single source of goods or service, which can be quite difficult in relation to colours. For example, Tiffany & Co. has been using the iconic robin egg blue packaging since before 1906, however Tiffany Blue was not granted trademark registration in the US until 1998 and 2020 in Canada!

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Non-traditional Trademarks

There are also several non-traditional forms of trademarks, including figurative elements, 3D shapes, holograms, moving images, modes of packaging goods, sounds, scents, tastes and the positioning of a sign.

It's important to note that if you are considering registering a non-traditional trademark, it won't be eligible if the mark has a utilitarian function in relation to the associated product or service. In other words, a colour cannot be registered for a colour-product, such as a paint. Similarly, the scent of vanilla cannot be registered as a trademark in relation to a perfume, but a vanilla scent could be registered in relation to a paint!

Some real-life examples include NOKIA's opening sound noise, the Microsoft Windows logo motion, the pyramid 3D shape of Toblerone, and the scent of Play-Doh!

What Can't be Registered as a Trademark?

A trademark application will be refused if the mark is identical or similar to another registered trademark or a pending trademark in association with similar goods and services. A trademark that is considered confusing with another trademark or tradename, such that an ordinary casual consumer will likely make a mistaken inference that the goods or services using both marks are from the same source, will not be registerable as a trademark.

There are also a few other categories that are not eligible for trademark registration.

Prohibited Marks

There are some prohibited marks under the Canadian *Trademarks Act*, which include any mark consisting of, or being similar to:

- Any scandalous, obscene or immoral word or design
- Official marks
    - Any mark adopted or used by any university or public authority
    - Royal arms, crest or standard

- The emblem of the Red Cross
- Any territorial or civic flag

Names and Surnames

A trademark cannot be registered if it is comprised of only a name or a surname. However, if you can prove that your product or service has become well-known under that name, such that there is an *acquired distinctiveness* associated with the name, it can be registered. Some examples include Ralph Lauren, Sony, and Johnson & Johnson.

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Clearly Descriptive or Deceptively Misdescriptive Marks

A descriptive mark describes the character or quality of the associated goods/service. For example, you could not register HYDRATING as a trademark in connection with moisturizers because that would unfairly prevent any other business from using the word hydrating to promote their moisturizer.

However, if you can establish that your descriptive trademark has become so well-known that consumers immediately think of your product, the trademark may be registrable. An example of this would be BEST BUY®.

Similarly, you cannot register a deceptively misdescriptive trademark. For example, you cannot register NATURALLY SWEETENED for a product that is sweetened with artificial sugars.

Place of Origin

A trademark that describes a geographical location where the product or service comes from is also not registrable under the *Trademarks Act*. For example, you could not register OKANAGAN for wine products because that would unfairly prevent other wineries and producers from using that geographical name in relation to their wine.

Descriptive Words in Foreign Languages

If a word translates into the English word of the associated goods or service, then it is not registrable as a trademark for that good or service. For example, the French translation of fresh juice is JUS FRAIS; this could not be trademarked for a company that produces fresh juice.

Importance of Trademarks

The primary importance of trademarks is that they can be used to distinguish your goods or service from a competitor's goods or service. Contrary to popular belief, trademarks are just as important and valuable for small businesses as they are for global corporations!

Common Law Trademarks

Before we look into *why* you should consider applying to register a trademark, it is important to note that it is not a requirement. Under common law, you will have certain rights after using a mark for a period of time. You can also identify your common law trademark by using the ™ symbol. However, the "passing-off" claims made for common law rights are limited to the specific region where you have built up goodwill, and the legal battle can be far longer, more expensive, and more confusing than a claim using a registered trademark.

Goodwill

One of the reasons a good trademark is important for your business is because it can help build your brand's reputation, which in turn creates a relationship of trust with consumers. Consumers are more likely to use a product or service that is associated with an easily recognizable and trusted company. Trademarks help confirm the source of the product or service, which ensures a consistent level of quality. Thus, trademarks are essential for establishing and building your company's *goodwill.*

Commercialization

Trademarks are also property assets; they can be bought, sold, licensed or used as collateral for loans. Trademarks add value to the company, but the trademark value itself can also appreciate over time; as the brand's reputation grows, more and more commercialization opportunities will present themselves.

Step-by-Step Guide

Below is a step-by-step guide on how to register your own trademark,

1. After deciding you want to register your trademark, the first thing to do is to check if it is registrable. See above for eligibility and what cannot be trademarked.

2. If the chosen mark is eligible for registration, the next step is to check if there is a confusingly similar mark, in association with similar goods and services, on the Register of Trademarks (via the Trademarks Database) as well as the internet, business or trade names databases and domain name registers. The Canadian Intellectual Property Office has created a tutorial to help navigate the trademarks database and make the most out of your search.

3. If the mark is eligible and distinctive, then you can begin an application using the e-filing system on the Innovation, Science and Economic Development Canada (ISED) website. A separate application must be filed for each trademark a business wishes to register, but one application can be used for registering the same trademark used or proposed to be used for multiple goods and services of the business.

An application includes:

a. The name and mailing address of the applicant
b. A statement regarding the goods or services in association with which the trademark is used or proposed to be used
c. A representation or description, or both, of the trademark to be registered (e.g., for a logo mark, an image of the logo would be an ideal representation)
d. The application fees

Once submitted, the Registrar would register the mark and issue a certificate of registration if the application for registration is successful. Again, the registration would give the owner of the trademark the exclusive right to use the trademark anywhere in Canada in respect of those goods or services for which the mark was registered for an initial period of 10 years. The trademark registration process in Canada typically can take up to 4 years to fully process.

Maintenance

Once your trademark has been registered by the Registrar, you must take steps to protect the trademark to maintain the registration and ensure it truly remains a valuable intangible asset. To maintain the trademark registration beyond the initial period of 10 years, the trademark owner must renew the registration every 10 years by paying the prescribed renewal fees as and when due. The protection is provided indefinitely as long as the renewal fees are paid, and the mark is in use.

It is important to note that failure to pay the prescribed renewal fee within the prescribed period will lead to the expungement of the trademark from the Register and a loss of the exclusive rights.

Protection

In order to protect your trademark registration, the most important step is to ensure that it is in use in connection with all the classes of goods and services for which it has been registered. Non-use of a mark is a ground for invalidating the mark and removing it from the register.

Another way to protect your trademark is to ensure that it continues to maintain its distinctiveness. If a mark that was distinctive at the time of registration loses its distinctiveness later, then it can be expunged or removed from the register. One of the ways that a mark can lose its distinctiveness is by improper advertisements, which are advertisements that make no distinction between the name of the product and the trademark. A common example of this is the adhesive bandage product being referred to as a BAND-AID, making the trademark less distinctive.

Some other examples include CHAPSTICK (lip balm), GOOGLE (internet search engine), and POST-IT (sticky notes).

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A business can also protect its trademark by using its trademark in its domain names and social media usernames, handles, and account names.

Lastly, you should protect your marks by monitoring for trademark infringement, commencing an action if necessary, and opposing the registration of marks by third parties that are likely to confuse consumers that those marks are from your business. If another business uses or applies to register your mark and you do not file an opposition or the trademarks registrar does not cite it against the application, then it can cost you the distinctiveness, and thus the registrability, of your trademark.

Frequently Asked Trademark Questions

1. Does my Canadian trademark registration protect my mark outside of Canada?

No. Trademark registrations in Canada only protect the use of the mark in Canada so a business that wishes to expand outside of Canada should consider filing in each country in which protection is desired. However, there is a simplified process of protecting marks in multiple countries via the World Intellectual Property Organization (WIPO) - the Madrid System.

2. Does incorporating a corporation under the same name as my trademark give me the benefits of trademark registration in Canada?

No – trademark registration and incorporation are different frameworks. You still would need to file for trademark registration to gain the exclusive right to use the mark throughout Canada and this can be done before or after incorporation.

3. What do I do if someone is about to register a trademark that I have been using in association with similar goods and services?

It is possible to oppose trademark registration. See Opposition Proceedings on the ISED website to learn more.

4. What do I do if someone is using my registered trademark or a mark similar to mine in association with similar goods and services?

You can write to them to notify them of your mark and to stop them from continuing to use the mark. If they fail to stop, you can consult with a lawyer to discuss suing for trademark infringement.

5. Can the River City Venture Clinic™ help me register a trademark?

Yes. However, the trademark registration process can be long and complex, and the volunteer students may not be able to assist with every aspect of the process. It might be worth looking into a trademark attorney for assistance.

Industrial Design Guide for Entrepreneurs and Ventures

What is Industrial Design?

An industrial design is any feature of shape, configuration, pattern or ornament and any combination of those features that, in a finished product appeal to and are judged solely by the eye. In simpler terms, an industrial design protects how something looks for up to 15 years. An industrial design provides the owner with an exclusive right to prevent others from making, selling, and importing for commercial purposes a product that has the same or substantially similar design as the registered design.

Eligibility

The registration of an industrial design confers an exclusive right for the 3D features of a shape and configuration, or the 2D features, including pattern, ornament, and colour (note that colour in itself is not protected, it is protected in combination with another feature). A design is registrable if (a) an application for registration is filed in accordance with the *Industrial Design Act*, (b) the design is novel (see meaning below), (c) the design was created by the applicant or the applicant's predecessor in title, (d) the design does not consist only of features that are dictated solely by a utilitarian function (see below), and (e) the design is not contrary to public morality or order.

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Some examples of industrial designs can be the specific shape of a bottle, such as the unique contours of the Coca-Cola® bottle. Apple® also holds a registered industrial design for their iPhones®, including the shape of the smartphone and the layout of the icons on the screen.

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Novelty

A design must be novel to be registered and protected. A design is considered novel if the same design, or a design not differing substantially from it has not been disclosed in such a manner that it became available to the public in Canada or elsewhere. Where the design has been previously disclosed but by the intending applicant for industrial design, the applicant will have a grace period of 12 months between the date of first disclosure to the public and the date the application for industrial design protection is filed.

If your design is substantially similar to pre-existing designs used on the same class of products, it will fail the novelty test.

Utilitarian Function

The design to be registered must not consist only of features that are dictated solely by a utilitarian function of the finished product. It must also have physical features that appeal to, and can be judged solely by, the eye. If your design has both features that are dictated solely by its utilitarian function and features that are visually appealing, then your design can be protected. Although, you will not have the exclusive right over features of the product that are dictated solely by utilitarian function.

An example of a design that is dictated solely by its utilitarian function is the interlocking system of LEGO® blocks.

It's important to note that where the utilitarian function of a product cannot be separated from the design, industrial design protection will not be available.

Ineligibility

An idea, method of construction, materials used in the construction of a product, and the purely functional features of a product are not protectable as industrial designs. Non-visual features of a product, such as sound, smell or taste are also not eligible for industrial design registration.

Importance of Design Registration

Industrial designs can be a useful tool for businesses because they can provide a competitive advantage to a product in the market. Consumers are frequently attracted to visually striking products, which is why manufacturers and corporations invest time and money to perfect their industrial designs. The influence on consumer behavior is the reason an innovative design and its registration are valuable business assets. Thus, design protection can attract investors and business partners.

Application

You can secure your industrial design rights by registering an eligible design (see above for eligibility rules) with the Canadian Intellectual Property Office (CIPO).

The application for an industrial design must contain:

- the name of the finished product in respect of which the design is to be registered;
- A representation of the design that complies with any prescribed requirements;
- Any other information or statements; and
- The prescribed fee. (Fee information is found here).

It is important to remember that if the design has been previously published or publicly disclosed by the applicant, the application for design protection must be filed within 12 months of publication.

Once an application has been submitted, CIPO will ensure that the application complies with the requirements for registration. They will compare the design with all pending, registered and published designs in Canada and abroad to assess novelty. After examination, the application will either be approved for registration, rejected or returned to the applicant for amendments. If approved, your design will be registered and then CIPO will issue a Notice of Industrial Design Registration!

Rights of an Industrial Design Owner

The registration of a design gives the proprietor an exclusive right in the design. This means that during the term (duration) of the exclusive right, no one must (without the permission of the owner of the design right): make, import for trade or business, sell, or rent any product in respect of which the design is registered and that has the registered design or a design not substantially similar to the registered design.

Term

The term of an exclusive right in a registered design begins on the later of the date of registration of the design and the date on which the application is made available to the public. The term ends on the later of the end of 10 years after the date of registration of the design and the end of 15 years after the filing date of the application.

In order to maintain the exclusive right to the design, you must pay such maintenance fees as prescribed every five years after the date of the registration.

Infringement

The right of the owner of a registered design is infringed upon when a person without the permission of the owner makes, imports for trade or business, sells, or rents any product in respect of which the design is registered and that has the registered design or a design not substantially similar to the registered design. If a person infringes the right of the registered design owner, the design owner can ask the infringer to obtain a license from the owner to use the design or ask the infringer to cease and desist from using the design on their product. The design owner may also choose to initiate an infringement action in court.

Note that there is a limitation period of 3 years for the commencement of an infringement action. This means that the court will not entertain an infringement action if the infringement was committed more than 3 years before *you begin the action for infringement.*

To further protect your registered design from infringement and to get the best legal remedy possible if your design is infringed upon, the capital letter “D” in a circle Ⓓ and your name or the usual abbreviation of your name as the proprietor (owner) of the design should be marked on the products. This helps inform people that the design of your product is registered.

Frequently Asked Industrial Design Questions

1. Does my Canadian registration protect me internationally?

No, but there is a system that can be used as a tool for the international registration of industrial designs called the *Hague System*. This is done through a single application submitted through the WIPO Secretariat (International Bureau).

2. Are there examples of registered industrial designs?

Yes! See the Canadian Industrial Designs Database.

3. If copyright protection is automatically awarded for a design, why should I consider registering an industrial design?

Industrial design protection may also overlap with other IP rights, such as copyright protection. However, when over 50 copies of a product with a design are produced, copyright protection does not generally apply, and thus only industrial design may be available.

4. Can the River City Venture Clinic™ help me register an industrial design?

The industrial design registration process can be long and complex, and the volunteer students may not be able to assist with every aspect of the process but can provide general knowledge.

Patent Guide for Entrepreneurs and Ventures

What is a Patent?

A patent is a form of intellectual property that may be granted for an invention. An invention is defined as any new, non-obvious and useful *art, process, machine, method of manufacturing, or composition of matter*. It may also include improvements to an existing invention if there is enough of an inventive step.

In the context of a patent, art means a way of doing things, as in "the state of the art," as opposed to the common definition of artistic expression. While methods and use are forms of art, a patentable invention must also be something with physical existence; it must have both a practical application AND a physical existence.

A process refers to the application of a method to a material or materials. For example, an industrial process may be the subject matter of a patent. However, business methods and methods of medical treatment are generally not patentable subject matters.
A machine is defined as the mechanical and/or physical embodiment of any function or mode of operation designed to accomplish a particular effect. An example of this may be something like a lawn mower.
Manufacturing means to make something. Again, the manufacturing of living things is not patentable.
A composition of matter is a composition of two or more substances; this includes non-living compositions such as pharmaceutical preparations. However, composition of matter does not include any higher life forms, such as an animal.

Eligibility

Not all new technology or inventions are patentable subject matter. Section 2 of the Canadian *Patent Act* defines invention as any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

Once an invention falls within the meaning under section 2, it must also satisfy the requirements for patentability: it must be novel, it must be non-obvious, and it must be useful.

Novelty

For an invention to be patentable, it must be new. It must not have been previously disclosed by the applicant or someone else in a way that makes the invention available or known to the public. This means that an invention that is the same as the subject matter of an already granted patent or a patent that has its application pending cannot be new. Thus, it is particularly important for an inventor to be careful when disclosing the subject matter of the patent to others. A disclosure by way of publication or by way of sale may affect the novelty if the disclosure is capable of allowing a person skilled in the art of the invention to work or perform the invention.

However, if the inventor, or a person who obtained knowledge of the invention from them, files the application for patent within 12 months of disclosing the invention to the public, it would still be considered as new and patentable.

Non-Obvious/Inventive

An invention must also be non-obvious to a person skilled in the art or science of the invention. This ensures that no patent is granted with respect to trivial advancements by considering the differences between the claimed invention and the prior inventions and existing knowledge as a whole. If a person skilled in the art would have come up with the claimed invention on the basis of prior inventions and existing knowledge including common general knowledge, then it would be considered to be obvious.

Useful

An invention must also be useful in order for it to be patented. Thus, a patent application must disclose an invention with sufficient utility. It's important to note that a single use related to the subject matter of your invention is sufficient to satisfy the requirement.
However, a patent can't be granted where the use of the invention is merely speculative as of the filing date.

Ineligible Subject Matter

Mere scientific principles, abstract theorems, ideas, plans, abstract principles or mathematical formulae are non-patentable subject matter. For example, you cannot protect your business methods because that would constitute an abstract idea. Further, a computer program is likely in the form of a scheme, plan, or set of rules for operating a computer, which would be abstract and not patentable.

Some other things that are not patentable in Canada include methods of medical treatments and diagnostic methods, other professional art (e.g. the professional art of being a lawyer), higher life forms, forms of energy, printed matter, and features of solely intellectual or aesthetic significance.

It's important to note that while higher life forms resulting from a genetic engineering process is not suitable subject matter for a patent application, the process or art of genetically altering the genome of a higher life form, such as a plant, animal, or seed, can be patentable. Pure discoveries of natural phenomena are also not patentable; for example, if you discover a new species of plant, it will not be eligible for patent protection in Canada.

Registration

Patents must be registered in order to obtain protection and it is not automatic upon satisfying the eligibility requirements. In Canada, there is a one-year grace period to apply for a patent for your invention once it is disclosed to the public.

The patent system is complex to navigate and may be time-consuming and expensive. It might be beneficial for your business to utilize a patent agent. However, it's also possible to submit a self-represented application!

Before you begin an application, it's important for you to do preliminary research to find out if your invention, or a similar one, has been published or patented already. You can search existing and pending patents using: Canadian Patents Database, PATENTSCOPE, United States Patent and Trademark Office patent database, Google Patents, patent databases at your local library, or internet searches, using "patent" as a keyword, to find more information and databases.

To obtain a patent for an invention, the inventor or their legal representative must file an application for a patent. This application must contain a petition, which is a formal request for a patent, and a specification of the invention. The specification is a disclosure of the invention in a manner that would allow a person skilled in that art to recreate the invention based on the information specified without undue burden.

The specification must also include patent claims or what the inventor is claiming monopoly over. It is important for you to make a full and complete disclosure of your invention and how to operate it; if the disclosure is found to be insufficient, this may lead to refusal of the patent or an attack on the validity of the patent.

A complete patent application will include:

- A formal petition for grant of a patent
- Detailed specification of the invention
- Claim or claims to the invention
- Any drawings mentioned in the description
- A biological sequence listing, if applicable, in electronic format
- Appointment of a patent agent, when required
- The application fees (found here)
- A signed small entity declaration, if applicable
- A statement of entitlement
- Names and addresses of the inventors

It is important to note that in order to maintain the exclusive rights conferred by the patent (see above for scope of patent protection, including duration), the patentee must pay the prescribed annual maintenance fees starting from the second anniversary of the patent filing date. If this requirement is not satisfied, the term of the patent may be deemed to have expired, and you will no longer have the exclusive rights.

Importance of Registration

Patents remain integral to a capitalist economy; they were originally created to encourage innovation and invention. By disclosing useful inventions, other innovators are able to build upon

that which is required for economic growth. The patent system essentially provides an incentive for innovation in the form of a time-limited monopoly.

Additionally, obtaining patent protection can be a key competitive advantage for your business! It will allow you to prevent competitors from making, selling, or using the product that would infringe the patent.

Scope of Patent Protection

Once a patent is granted, the patentee is conferred with the exclusive right, privilege, and liberty of making, constructing, and using the invention and selling it to others to be used for a term of 20 years from the filing date. Given the exclusive scope, this is an incredibly useful commercialization tool for business owners!

Limitations on the Rights of a Patentee

There are also limitations that may fall on the rights of a patent holder. First, it's important to note that if your patent is in respect to an improvement on a patented invention, your patent does not give you the right to make, construct, use or sell the original invention. Likewise, if another person obtains a patent for an improvement on your original invention, you do not confer the right to make, construct, use or sell the patent improvement.

Additionally, a patentee's right does not include the right to exclude the doing of an act in relation to the invention that is done for the purpose of experimentation and acts done for the purpose of regulatory review.

When a person does an act in good faith in relation to the invention *before* the patentee filed their patent application, that person may continue to do the same act after the filing date and the grant of the patent. However, the person would be liable for infringement if the patentee can prove that they were only able to perform the act because they obtained knowledge of the invention somehow and knew that the applicant was the source of that knowledge.

Ownership of a Patent

The inventor of the invention is typically the applicant unless the inventor transfers their interest in the invention to another before or at the time of applying for the patent, either in whole or in part. For the transfer to be recognized, it must be recorded by the Patent Commissioner at the request of the transferee. Thus, it is in the best interests of all businesses to ensure that they acquire the rights to the patent from the inventor and to confirm the Patent Commissioner records the transfer immediately.

You can also commercialize the subject matter of a patent by granting other licenses to use, make or sell products that embody the invention covered by the patent. There is no similar requirement to record a license.

Frequently Asked Patent Questions

1. Would a Canadian patent protect my invention internationally?

No. You must apply for foreign patents to obtain such protections. You can do so either within Canada at the Canadian Patent Office under the Patent Cooperation Treaty, or directly to the patent office of the foreign country. It's important to note that you must comply with the patent laws of each jurisdiction to ensure you don't lose such rights.

2. Do I have to patent my invention?

No. You may also classify your invention as a Trade Secret, where you can protect your creation by keeping the information secret.

3. Can the River City Venture Clinic™ help with my patent application?

Yes. However, a patent application is an incredibly technical process, and the volunteer students will likely not be able to assist with technical specifications. It might be worth looking into a patent agent for assistance.

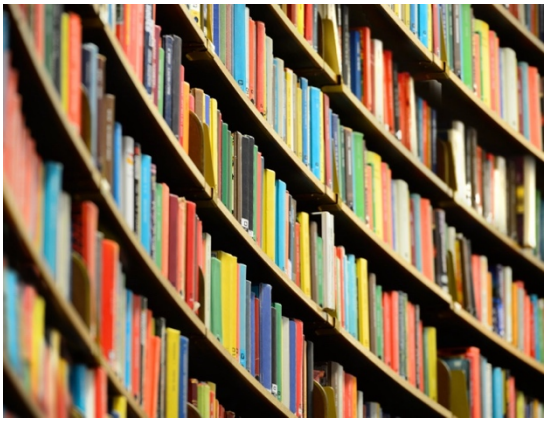
4. How do I find a patent agent?

The College of Patent Agents and Trademarks Agent provides a public register with a list of potential patent agents here.

Copyright Guide for Entrepreneurs and Ventures

What is Copyright?

Copyright refers to a bundle of rights that applies to artistic, dramatic, literary and musical works. It includes the exclusive legal right to publish, produce, reproduce or perform a work or any substantial part of it, the right to communicate a work to the public by telecommunication, and in the case of computer programs, the right to rent. In addition to these rights which can generate economic returns, creators of works eligible for copyright have other rights called moral rights. The moral rights of creators include the right to be named as the author of their works and the right to maintain the integrity of their work.



The Canadian *Copyright Act* (copyright law) generally prevents others from copying and disseminating your work without your permission. In some cases, the copyright law allows others to copy and use your work and for you to copy and use other people's work without obtaining their permission to foster an open exchange of ideas and promote innovation and creativity in Canada.

It's important to note that registration is not necessary for copyright protection, and for the most part, the copyright owner is entitled to copyright protection as soon as the work is created and for 70 years after the creator's death.

Eligibility for Copyright Protection

Generally, all original literary, dramatic, musical, and artistic works are eligible for copyright protection if they have been fixed.

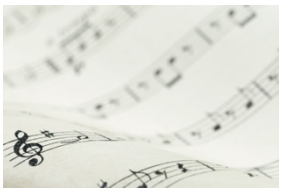
Literary Works

Literary works include novels, books, pamphlets, articles, emails, letters, poetry, lecture notes, software code, original databases, compilations of literary works and any other works consisting of text. Literary works encompass any written work, whether in digital or physical form, and it is regardless of literary quality.

Dramatic Works

Dramatic works include any piece for recitation, choreographic work or mime, scenic arrangement, any cinematographic work, and any compilation of dramatic works. This includes motion picture films, plays, screenplays and scripts.

Musical Works



Musical works are any work of music or musical composition, with or without words, and this also includes any compilation of musical works.

Artistic Works

Artistic works include paintings, drawings, maps, photographs, sculptures, charts, plans, engravings, works of artistic craftsmanship, engravings, illustrations, sketches, website designs, architectural works, and compilations of artistic work.

Are there other creations that can be copyrighted?

Yes. You can copyright other subject matters that are not necessarily literary works, dramatic works, musical works, or artistic works. The copyright law in Canada also allows you to enjoy some exclusive rights over sound recordings, performances, and communication signals (radio waves transmitted through space for reception by the public).

Copyright law does not, however, give moral rights for sound recording and communication signals. A performer of a performance has the same moral rights as creators of literary, dramatic, musical, and artistic works.

Originality

The *Copyright Act* requires a literary, dramatic, musical, or artistic work to be *original* in order to gain copyright protection. The copyright requirement of originality does not mean your work needs to be creative, novel, or unique. For a work to be considered original, it must be more than a mere copy of another work and it must be the result of an exercise of the creator's skill and judgment that is beyond a purely mechanical exercise.

Skill refers to the creator's use of knowledge, developed aptitude or practiced ability in producing the work and judgement refers to the creator's capacity for discernment or ability to form an opinion.

Fixation

An idea, on its own, is not eligible for copyright protection. The work must also be *fixed* in order to obtain copyright protection. This means that the work must be expressed in some tangible or material form from which it can be perceived. This applies to all eligible works with the exceptions of a performer's performance and communication signals; these do not have to be fixed in a tangible or material form to be granted copyright protection.

What Cannot be Copyrighted?

There are certain "creations" that cannot be protected by copyright. These include ideas, facts, schemes, methods, data, short and one-word titles, and works that are not fixed in a tangible work. Although they are not protectable themselves, an *original expression* of such information can be protected.

Who is the Copyright Owner?

Typically, the author or the creator of the copyrightable work would also be the copyright owner. This is the case even if a person commissions another to create a work for them. For example, if you pay a painter to make a painting for you, you will be the owner of the painting, but the painter will remain the copyright owner over the painting. However, the creator of a work can enter into an agreement to transfer copyright ownership to another person or entity. For example, you can enter into an agreement with the painter under which they will transfer copyright ownership to you.

Where a work is created by an employee of a business for the business, the employer is generally the owner of the copyright in the work created. It is important to know if the worker is truly working as an employee of the business. This is because a non-employee (for instance, a contractor) of the business is the owner of copyright in any work they create for the business unless they have agreed to transfer their copyright to the business.

In any case where the creator of the work is not the owner of the copyright in the work (for instance, because they transferred their copyright to another person, or they created the work as an employee), the creator would still have what we earlier referred to as moral rights. This means that the creator of the copyrighted work must be named as the creator whenever possible, unless they choose to be anonymous. It also means that the work cannot be used in a way that would negatively affect the honor or reputation of the creator. Moral rights are not transferable, but they can be waived by agreement.

Licenses and Transfers (Assignments)

A copyright owner can transfer their rights, either in whole (i.e., the entire bundle of rights) or in part (i.e., only one or some of the rights in the copyright bundle) through a transfer agreement. The transfer can be for the whole term of the copyright or for a certain part of it, and it may be as limited or as broad as desired. The copyright owner would usually be paid for the transfer of their work to another, either through compensation for employment or direct compensation for the transfer. It is important to remember that the moral rights of the author/creator of a work cannot be transferred. They can only be waived.

A license, on the other hand, grants others permission to use the work for certain purposes and under certain conditions. The copyright owner can grant a license for a fee or for free. Note that licenses can be implied, whereas assignments must be in writing.

Copyright Registration

Copyright is granted to a creator of a work immediately upon the creation of the work. There is no requirement of registration to obtain copyright under Canadian law. Registering your work with the Canadian Intellectual Property Office is, therefore, entirely optional, but there are several benefits.

The main reason you should consider registering your work is because a certificate of registration serves as evidence that the copyright exists, and that the owner of the certificate is also the copyright owner. Thus, if you or your business have registered a work for copyright protection, it is much easier to enforce your copyright against an alleged infringer.

Step-by-Step Guide

Below is a step-by-step guide on how to register your own copyright. After creating a work, the first thing to do in order to register your copyright is to check if it is eligible under the *Copyright Act*. See above for eligibility and what cannot be copyrighted.

If the work is eligible, then you should obtain an application form online.

An application must include:

a. The title of the work

The title must identify the single work. In the case of a series of books or an encyclopedia, a single application will be sufficient for the whole work.

b. The publication

If a work is published, the application will need the date and place of first publication.

c. Owner

The application must also specify the name and complete mailing address of the copyright owner.

d. Author

The name of the author or the individual who created the work must also be included. If the author is deceased, the date of death should also be included.

e. Declaration

The application must also contain a declaration that the applicant is the creator or author of the work, the owner of the copyright in the work, or an assignee of the copyright (i.e., a person to whom copyright was transferred by the initial copyright owner).

Fees

Once the application is complete, you must submit it along with the prescribed fees.

Duration of Copyright Protection

In general, copyright protection will last for the life of the author plus 70 years following their death. However, there are some exceptions to this rule depending on several factors.
If the work was created by more than one person, the copyright protection would exist for 70 years following the death of the last surviving individual. If the author is unknown, the copyright will exist for 70 years after the first publication of the work or 75 years after the making of the work, whichever is earlier.

In the case of government works, documents created by the federal and provincial governments are under *Crown Copyright*, where copyright generally lasts for 50 years after the date of publication.

After the copyright ends, the work becomes part of the *public domain*, which means it can be freely used, copied, and distributed by anyone without the need to acquire permission.

Copyright Infringement

Monitoring your copyrighted work and policing copyright infringement is also important to protect your personal or business intellectual property. Copyright infringement occurs when a person or entity copies or uses your work or a substantial part of your work without your permission. You can enforce your right by asking the infringer to obtain a paid license from you or to cease and desist from the infringement. You can also initiate a copyright infringement action in court.

It is not only important for business owners and entrepreneurs to protect their own works against infringement, but also to avoid infringing on the copyright of others. Copyright infringement can cause serious issues for your business, including costly fines and injunctions.

In the case of using another person's or entity's material, be sure to obtain appropriate permissions. Ensure you use materials within the public domain or that are openly licensed for commercial use, if you do not want to license others' works. Also, consider creating original works where possible or hire others to do so for you.

Limitations and Exceptions

Canadian copyright law places some limitations on the rights of copyright owners by allowing others to use the work for certain purposes and under limited conditions without obtaining permission from the copyright owner. Both commercial and non-commercial ventures can rely on some of these limitations to use copyrighted works without permission. If you are relying on an exception or limitation to copyright protection to use a work without permission, be sure that what you want to do is covered under the law.

For more information on the scope of limitations and exceptions to copyrights, you can contact River City Venture Clinic™.

Frequently Asked Copyright Questions

1. How can I find out who owns the copyright to a work?

The first step would be to consult the work and try to locate a copyright notice, but it is important to note that the absence of a copyright notice does not mean the work is in the public domain.

You can also search the online copyrights database for all Canadian copyrights that have been registered after October 1991. You are able to search by author name, category, country of publication, owner/assignee name, registration number, title and year of the publication.
If the work has been registered before 1991, you can visit the CIPO Client Service Centre to locate these records.

2. If the work is created outside of Canada, would it still be protected within Canada?

According to the Canadian *Copyright Act*, where a work or other subject matter has been created by a person residing outside of Canada, it would only be protected in Canada if the person or entity has some connection to a country that Canada has an intellectual property treaty relationship with.

3. How do I convey to others that I am the copyright owner of a work?

One way in which you can convey to the public that the work is copyrighted is by using a copyright notice, including the symbol ©, the name of the copyright owner and the year of the first publication. It is important to note that marking a work with the copyright symbol is not required and may be used even if the work is not registered. Marking the work may serve as a useful reminder to the public that the work is not in the public domain and can result in increased remedies for you in the case of infringement.