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Cassels on IP: February 2023

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In this edition: CIPO treatment of marks filed in colour through the Madrid Protocol, a look at industrial design, and the latest from our team...

Cassels Wins

Five Cassels Partners Recognized by WTR1000 2023>

Mark Davis, Alison Hayman, Steven Kennedy, Jennifer McKenzie, and Stephen Selznick have been recognized by the *World Trademark Review* (WTR) in its latest ranking of leading Canadian Trademark Professionals.

Steven Kennedy Named a 2022 Lexpert Rising Star>

The Lexpert “Rising Stars: Leading Lawyers Under 40” awards pay tribute to the rising stars and future leaders of the Canadian legal community.

Casey Chisick and Mark Davis Named to the Lexpert/American Lawyer Guide to the Leading 500 Lawyers in Canada>

Casey and Mark are among the 11 Cassels lawyers included in the guide, which recognizes an exclusive group of lawyers ranked highest in the annual Lexpert survey in practice areas of importance to an American audience.

Hot Off the Press

CIPO Treatment of Marks Filed in Colour Through the Madrid Protocol>

Many brand owners are now seeking to register their trademarks in Canada using the Madrid Protocol system for international applications administered by the World Intellectual Property Organization (WIPO).

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While there are some benefits for foreign applicants, such as somewhat accelerated processing, it is important for foreign applicants and their counsel to bear in mind an important limitation related to colour marks.

In Case You Missed It

Key Canadian Patent Law Decisions From 2022 and Some Predictions for 2023>

2022 was another busy year in Canadian patent litigation. Canadian courts delivered a record-setting monetary award and clarified several important legal principles including the proper test for patentable subject matter. We have summarized some of the most important developments in Canadian patent law in 2022 and offer some predictions on how they will affect pending and future cases.

Springing Into Action: Supreme Court of Canada Clarifies Accounting of Profits Remedy in Patent Infringement Cases>

On November 18, 2022, the Supreme Court of Canada released its decision in *Nova Chemicals Corp. v. Dow Chemical Co.* In a near-unanimous decision, the Court upheld the largest monetary award ever in a Canadian patent case and, in doing so, clarified the test for an accounting of profits. The Court also confirmed that springboard profits — profits that a patent infringer made from an infringing product after the patent expired but which are attributable to infringement that took place during the term of the patent — may be included in an accounting. This is an important decision because it sets out the analytical framework that litigants will have to consider, and courts will have to apply, to determine patent remedies.

Industrial Design Suit Gets the Plaintiff a Croc of Gold>

In a rare decision reached under the *Industrial Design Act*, the Federal Court of Canada awarded the plaintiffs almost \$650,000 in profits amounting to the full extent of the defendant's gross revenues for infringing the plaintiffs' registered industrial design.

Changes to List of Comparator Countries Used to Assess Pricing of Patented Medicines Affirmed on Appeal>

The Federal Court of Appeal's recent decision in *Innovative Medicines Canada v Canada (AG)* confirmed the scope of the Governor in Council's power to regulate the excessive pricing of patented medicines. Specifically, the Court affirmed the validity of amendments to the list of comparator countries to be considered by the Patented Medicine Prices Review Board (PMPRB) in assessing whether prices are

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excessive — even though the amendments extended beyond the mandate of the PMPRB to the ancillary purpose of cost savings.

Trademarks in Québec: No News is Not Good News>

It has been six months since Bill 96 received Royal Assent, ushering in amendments to the Charter of the French Language (Charter). Some of those amendments had immediate force, while others will come into force on June 1, 2025.

Culinary Knockout: Federal Court Strikes US Restaurant Owner’s Claims Against an Alleged Canadian “Copyright” with Leave to Amend>

A recent Federal Court of Canada decision provides an important reminder for franchise systems entering Canada that intellectual property protection is “territorial.” The fact that a franchisor owns intellectual property rights under the laws of its home jurisdiction will not necessarily ensure ownership and protection in Canada. Franchisors are encouraged to take stock of their IP assets and ensure that there are no gaps in protection under Canadian law.

A Cautionary Tale of Two Restaurants: The Risk of Brand Development Before Launch>

A recent decision of the Ontario Superior Court of Justice (Divisional Court) weighs in on issues regarding trademark infringement in the case of an unlaunched franchise brand.

Did You Know?

An industrial design relates to a product’s appearance, meaning features of shape, configuration, pattern, or ornamentation, rather than a product’s function. A registered industrial design confers an exclusive right over these unique aesthetic features in Canada for either 10 years from the publication date or 15 years from the filing date, whichever is later.

Registration can be completed by filing an application to the Canadian Intellectual Property Office. Timing of the application is important, as industrial design registration works on a first-to-file system, meaning the first person to file an application will prevent others from filing an application for the same or a substantially similar design. Registration must be done within 12 months of a design’s disclosure to the public, in Canada or elsewhere.

Registering industrial designs is an important element of protecting your rights over your unique designs.

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Contact a member of our [Intellectual Property](#) team to learn more about the process for registering an industrial design.

A Few More Things...

- Jessica Zagar, Casey Chisick, Eric Mayzel, and Lindsay Dykstra attended the 2023 Copyright Society's Midwinter Meeting in Palm Springs from February 9 to 11.
- Eric Mayzel spoke to the Intellectual Property Society of Osgoode (IPSO) at Osgoode Hall Law School about career paths in intellectual property law on February 15.
- Casey Chisick moderated a panel on Bankruptcy & Insolvency in the Entertainment Industries on February 15 as part of the Osgoode Certificate in Entertainment Law program. The panel included Cassels partner Jane Dietrich and Jeffrey Rosenberg of FTI Consulting.
- Cassels is once again a sponsor of the Harold G. Fox Moot, taking place on February 24 and 25. Stephen Selznick and Jennifer McKenzie will be sitting on judging panels for the competition, which is the preeminent Canadian national IP moot competition, and Chandimal Nicholas and Cassandra Shortt will be coaching the Osgoode Hall Law School team.
- Stephen Selznick and Olivia Ells are part of the coaching team for Osgoode Hall Law School at the 20th Annual Oxford International Intellectual Property Moot Competition. Based upon the team's factum submissions in the fall of 2022, the Osgoode Hall Law School team has been invited to argue orally against selected moot teams from around the world in Oxford, United Kingdom from March 16 to 18.
- Cassandra Shortt will be presenting awards at Health Innovation Hub's FemSTEM 2023 Pitch Competition on March 23. The Pitch Competition gives up-and-coming healthcare innovators the opportunity to present their idea to the public and the chance to win funding and in-kind services from Cassels to scale their project.

This publication is a general summary of the law. It does not replace legal advice tailored to your specific circumstances.