

Cassels on IP: August 23

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August 10, 2023

In this edition: CIPO fee increases, compelling discovery from Canadian witnesses, enforcing foreign judgments in Canada, a look at comparative advertising, and the latest from our team...

IP Updates

CIPO Fee Increases Coming in 2024 >

Fees at the Canadian Intellectual Property Office (CIPO) will increase significantly on January 1, 2024, as a result of amendments to the Patent, Trademark, and Industrial Design regulations.

CIPO has proposed an increase of 25% to most fees relating to patent, trademark, copyright, and industrial design matters.

As a result of the upcoming increases, to save costs, we recommend that IP owners review their Canadian portfolios and identify any steps that can be taken in 2023 while the current lower fees still apply.

CIPO Announces Revisions to AI-Generated Pre-Assessment Letters

On August 7, 2023, the Canadian Intellectual Property Office (CIPO) announced a significant update to its AI-generated “pre-assessment” letters, indicating that, effective immediately, the letters will identify the particular goods and/or services that may require amendment in order to comply with current Trademarks Office practice standards.

Since early 2022, the Examination Branch at CIPO has been issuing “pre-assessment” letters prior to an application being assigned to an examiner. These letters were intended to provide applicants with a sense of whether their applications are in formal compliance with the provisions of the *Trademarks Act* and *Trademarks Regulations*, particularly in respect of the specificity requirements – however, until now, the letters provided no details and simply alerted applicants to the existence of possible problems without explaining what particular goods and/or services might require amendment.

This is a welcome development from CIPO and will hopefully assist applicants and their agents to amend

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their applications and revise their lists of goods and services to help simplify the process once the applications enter “live” examination.

Hot Off the Press

Compelling Discovery from Canadian Witnesses >

Foreign subpoenas or orders for discovery are not automatically enforceable in Canada. Accordingly, if a person in Canada does not voluntarily give evidence in a foreign proceeding, it may be necessary to use judicial procedures to compel that evidence.

Federal Court Notes Limits on Copyright and Moral Rights in the Design of a Functional Object >

Authors and owners of copyright may be unable to enforce copyright and moral rights in designs that are applied to mass-produced functional objects. A recent decision by the Federal Court serves as an important reminder of the benefit of obtaining timely industrial design registrations for such designs, to ensure they may benefit from protection under intellectual property legislation.

US Supreme Court Finds that Andy Warhol Foundation’s Licensing of “Orange Prince” is Not a Fair Use of the Underlying Photograph >

The US Supreme Court recently released its ruling in *Andy Warhol Foundation for the Visual Arts, Inc. v Goldsmith et al.*, one of the most important fair use decisions in recent decades.

Cassels Wins

Mark Davis Named to IAM’s Patent1000 2023 >

Mark Davis has been ranked by IAM on its Patent1000 list for 2023.

Cassels Contributes to WTR’s Americas Trademark Prosecution Review >

Cassels has contributed to the 2023 edition of WTR’s Americas Trademark Prosecution Review. The first edition of the WTR Americas Trademark Prosecution Review takes a wide-ranging view of the best

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strategies to follow across the Americas to secure trademarks, with a focus on the prosecution landscape in specific key markets.

Casey Chisick and Len Glickman Named WIPR Leaders 2023 >

Casey Chisick and Len Glickman have been named WIPR Leaders by the World Intellectual Property Review for 2023. WIPR Leaders is a one-stop guide to the leading IP practitioners in the world.

Sazia Aftab Achieves Certified Canadian Trademark Administrator Designation >

Sazia Aftab, a Toronto-based law clerk in our national Intellectual Property Group, has recently been certified by the Intellectual Property Institute of Canada (IPIC) as a Certified Canadian Trademark Administrator (CCTA).

Cassels Supports The Forum's Spring E-Series Event >

In support of The Forum's Spring E-Series event, Cassels lawyers will provide virtual sessions, participate in a live Q&A, and offer a set of pro bono hours through an "Ask an Expert" type service for participating entrepreneurs on a range of topics including intellectual property law.

Stephen Selznick Reappointed to CLP Examination Development and Maintenance Committee

Stephen Selznick has been reappointed to the Certified Licensing Professionals' (CLP) Examination Development and Maintenance Committee. This committee was developed for those seeking the CLP professional designation recognizing demonstrative experience, proficiency, knowledge, and exposure to licensing and commercialization of intellectual property.

In Case You Missed It

Enforcing Foreign Judgements in Canada >

Canadian courts take a generous and liberal approach to the recognition and enforcement of foreign judgments. While different considerations apply to foreign monetary and non-monetary judgments, the principle of comity underlies the Canadian approach.

"Electrifying" Insights: Federal Court Considers Comparative Advertising >

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A recent decision considers whether a comparative advertising campaign that made both direct and indirect references to a competitor's brand violated the *Trademarks Act* or *Competition Act*. This decision is the latest word in a limited line of case law on the intersection between comparative advertising, trademark law, and competition law, and provides valuable insights for consumer-facing businesses when considering a comparative advertising campaign.

Federal Court of Appeal Confirms Arbitration Clauses Should be Honoured in All but the Clearest Cases >

A recent decision from the Federal Court of Appeal reinforces that courts are generally unwilling to depart from the terms of commercial agreements and will favour arbitration where parties have agreed to arbitrate their disputes.

Revisions to Google Ads' Trademark Policy >

Trademark owners may have a heavier burden of policing the unauthorized use of their trademarks in Google Ads following Google's revised trademark policy, which will remove industry-wide complaints. The revised policy came into force on July 24, 2023.

FCA Confirms the Importance of Counsel's Role in Maintaining the Independence of Experts >

The Federal Court of Appeal recently considered allegations that an expert report was inadmissible or should be given no weight because it did not reflect the expert's independent opinion. In assessing those allegations, the Court confirmed that counsel can work closely with experts to prepare their reports, provided that the reports present the substantive and objective opinion of the experts.

A Bite-Sized Update on the New Restrictions on Advertising Food to Children >

Canadian advertisers are facing new restrictions on advertising food to children on two fronts: regulatory and self-regulatory.

On the Horizon

- Stephanie Roberts will be co-hosting the Intellectual Property Institute of Canada's Trademark Agent Exam Tutorials from July 7 – August 25, 2023.
- Kassandra Shortt and Jessica Zagar will be participating in the Intellectual Property and Exhaustion: What IP Practitioners Should Know webinar on September 7, 2023.

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- Jessica Zagar will be part of the faculty for Osgoode's Intellectual Property Law & Technology Intensive Program. Jessica will be presenting on IP Rights in Fashion on September 8, 2023.
 - Casey Chisick will be attending Copyright + Technology, an annual conference presented by the Copyright Society and Giant Steps Media Technology Strategy, on September 14, 2023, at Fordham University in New York.
 - Eric Mayzel will be part of a panel discussing The Emergence of AI at Canadian Franchise Association's Franchise Law Day held September 21, 2023.
 - Karen MacDonald and Jennifer McKenzie will be attending the International AIDV Conference 2023, taking place September 29 – October 1, 2023. Jennifer will also be presenting at this conference.
 - Karen MacDonald will be speaking part of the panel providing "Regional Case Law Updates" at the INTA Trademark Administrators & Practitioner's Meeting being held October 1-3, 2023.
 - Casey Chisick will be attending and speaking at the first-ever Copyright Society International Conference, focusing on collective licensing in North America and the European Union, from October 14-16, 2023, in Berlin.
 - Steven Selznick will be attending the American Intellectual Property Law Associations' Annual Meeting in Washington, DC, from October 19-21, 2023.
 - Casey Chisick, Mark Davis, Steven Kennedy, Karen MacDonald, Jennifer McKenzie, and Stephen Selznick, will be going to the INTA Leadership Meeting being held November 14-17, 2023, in Houston, Texas.
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This publication is a general summary of the law. It does not replace legal advice tailored to your specific circumstances.