

Write Your Exam Code Here: _____

Return this exam question paper to your invigilator at the end of the exam before you leave the classroom.

**The University of British Columbia
Faculty of Law**

**LAW 422.002
INTELLECTUAL PROPERTY
EXAMINATION - DECEMBER 2018**

Professors Marles/Melnychuk/Bailey

**This Examination Consists of 8 Pages (Including Cover Page)
TOTAL MARKS: 100**

**TIME ALLOWED: 3 HOURS
and 20 minutes reading time**

OPEN BOOK:

**Students are permitted to also write during the 20 minutes reading time.
Use a separate answer booklet for each part.**

**PART I - 34 MARKS
PART II - 33 MARKS
PART III - 33 MARKS**

THIS EXAMINATION PAPER MUST BE RETURNED WITH THE ANSWER BOOKLETS

(Total: 34 marks)

Marks

- 5 1. It has been said that copyright does not protect ideas, only the expression of those ideas. Provide one example of an idea that cannot be protected by copyright, and one example of a form of expression that can be protected by copyright. Briefly explain why it is difficult for the courts to draw a clear line between the concepts of “idea” and “expression”. Identify one case we studied that shows this difficulty to support your explanation.
- 5 2. What is the standard for establishing that a work meets the originality requirement, and why is this standard important? List the case that established this standard in Canadian law. What other options have the courts considered for this standard? Cite case law examples that support these other options.
- 5 3. Answer the following:
- What section of the *Copyright Act* permits fair dealing for the purpose of parody?
 - What year was this exception added to the *Act*?
 - What are the requirements for establishing that a dealing is for the purpose of parody?
Do not include an explanation of the multifactorial test used to determine whether a dealing is fair in your answer.
 - What Canadian case considered fair dealing for the purpose of parody?
 - Do you think the inclusion of parody as a fair dealing purpose in Canadian law is a good thing? Briefly explain why or why not.
- 19 4. You have been retained by Vancouverite Cliff Hanger, who is the author of several climbing guidebooks featuring local climbing routes. Cliff alleges that Diana Daredevil has copied a guidebook relating to a new climbing crag, Edge of Haven, that Cliff published three years ago. Cliff set all of the routes in Edge of Haven over the course of a number of years, and created his guidebook with photographs and illustrations of all of the routes, as well as a description of the difficulty and special features of each route. Unbeknownst to anyone, Cliff included a fake route, Wayward Canine, in his guidebook.
- Diana’s guidebook, just released last week, includes all of the same routes as Cliff’s guidebook, including Wayward Canine, in the same order, but uses different photographs. The illustrations used in Diana’s book are highly similar to the illustrations used in Cliff’s book, and the route descriptions and difficulty ratings are the same. However, the descriptions of the special features of all of the routes is different from the descriptions provided in Cliff’s guidebook, with the exception of Wayward Canine, for which the description of the special features of the route is identical to Cliff’s book.

Advise Cliff on the following points:

- (a) Is Cliff likely to succeed if he sues Diana for copyright infringement? Consider issues such as ownership of copyright, originality, and the test for infringement, citing case law or statutory authority as appropriate to support your answer. **[10 Marks]**
- (b) Should Cliff register copyright in his guidebook now? **[2 Marks]**
- (c) Does Cliff need to hurry to initiate his action if he wishes to sue Diana? **[1 Mark]**
- (d) Advise Cliff of four remedies that may be available to him if he is successful in his action against Diana, citing authority for each remedy. **[4 Marks]**
- (e) What defences might Diana have to defend against a copyright infringement action brought by Cliff? **[2 Marks]**

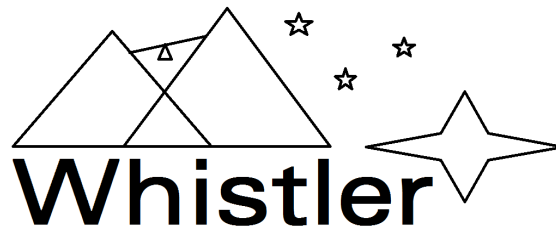
END OF PART I
(Use a new booklet for Part II)

(Total: 33 marks)

Marks

- 6 1. (a) Briefly explain the geographic scope of trademark rights. [2 Marks]
- (b) Briefly explain the difference between a trade name and a corporate name. [2 Marks]
- (c) Briefly explain what the abandonment of a trademark registration under s. 18(1)(c) of the *Trade-marks Act* requires. For full marks, cite relevant case law. [2 Marks]

- 12 2. Briefly discuss the likelihood of registering the following trademarks (point form answers are acceptable). For full marks, cite relevant case law and/or relevant provisions of the *Trade-marks Act*.
- (a) WHISTLER & Design for backcountry tour guide services. [3 Marks]



- (b) POSTAL for alcoholic beverages. An official mark application for CANADA POST has been advertised. [3 Marks]
- (c) GREG'S ROAST for coffee and coffee shop services. Greg has significant use and advertisement of the trademark across Canada since 2012. [3 Marks]
- (d) JUNIPER for massage services. JUNIPER for organic grocery store services is previously used and registered by a third party. [3 Marks]
- 3 3. Discuss ways through which an owner of a foreign trademark registration may acquire enforceable trademark rights in Canada. Assume that the owner is not using the trademark in Canada and has no intention to use the trademark in Canada. For full marks, cite relevant case law.
- 8 4. Alpine Enterprises Ltd. ("Alpine") operates brick and mortar pet shops in the U.S., but not in Canada, in connection with the trademark ALPINE'S. Since October 2018, Alpine has provided certain pet shop services through its website, including a "Pet Finder" service and a "What Food Is Right For My Dog?" service, which provide information on a vast array of animals and products available for purchase at Alpine's

shops. Although no online sales to Canada have occurred, Alpine's website receives tens of thousands of visits annually from Canadians. Alpine does not own any trademark applications or registrations in any jurisdiction.

- (a) On what ground(s) should Alpine base an application to register ALPINE'S in Canada in association with pet shop services? Explain. For full marks, cite relevant case law. **[4 Marks]**
 - (b) Firm Inc. ("Firm") has sold dog food in Canada in association with the trademark ALPO since January 2017. Can Firm prevent Alpine from obtaining a trademark registration? If so, how and on what ground(s)? For full marks, cite relevant provisions of the *Trade-marks Act*. **[4 Marks]**
- 4 5.
- (a) What is the effective date of entitlement of the trademark particularized in the registration details below? **[1 Mark]**
 - (b) A third party applied to register the trademark KAHUNA in Canada based on proposed use in association with skateboards on February 1, 2014. Assuming the third party application was pending when Canada Application No. 1740942 (below) was examined, how would the Canadian Intellectual Property Office have treated Canada Application No. 1740942? **[1 Marks]**
 - (c) The owner of Registration No. TMA958241 is interested in assigning this registration to a third party. Discuss any relevant issues. **[2 marks]**

Canadian Trademarks Details

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1740942 - KAHUNA PADDLEBOARDS & Design



Application/Registration numbers

Application number	1740942
Registration number	TMA958241

Status

CIPO status	REGISTERED
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Key Dates

Filed	2015-08-07
Registered	2016-12-16

Goods

(1) paddleboards; paddles; paddleboard accessories, namely, paddleboard fins, leashes

(2) paddleboard accessories, namely, deck pads, tie-down straps, rack pads, soft racks, tail gate pads; paddleboard bags

Claims

Used in CANADA since at least as early as April 15, 2010 on goods (1).
Used in CANADA since at least as early as July 2010 on goods (2).

Associated marks

TMA958,256	TMA958,257
TMA958,258	

END OF PART II

(Use a new booklet for Part III)

(Total: 33 marks)

Marks

- 8 1. Briefly comment with justifying reasons on whether the following subject matter is patentable in Canada and the United States, assuming it is new, non-obvious and useful:
- (a) An isolated human gene used in a diagnostic test to detect early-onset Alzheimer’s Disease. **[4 Marks]**
- (c) A computer-implemented method to verify the identity of an individual. The method comprises capturing a digital image of the individual’s hand and comparing the image to biometric recognition data stored in a cloud-based database. **[4 Marks]**
- 4 2. Discuss whether the Supreme Court’s judgment in *Monsanto Canada Inc. v Schmeiser*, 2004 SCC 34 (“*Monsanto*”) is consistent with its judgment two years earlier in *President and Fellows of Harvard College v Commissioner of Patents*, 2002 SCC 76 (“*Harvard Mouse*”). Can *Monsanto* be characterized as a vindication of the dissenting opinion in *Harvard Mouse*?
- 4 3. Michael invented a chemical process for removing impurities from natural gas in May of 2017. He discussed detailed particulars of the process and its commercial applications with investors in a conference call on July 15, 2017. All but one of the investors had previously signed a non-disclosure agreement with Michael. The investors were able to eventually raise sufficient venture capital to fund a pilot study to test the process. The pilot study commenced on June 1, 2018 in Calgary, Alberta. A Canadian patent application claiming the process was filed on August 31, 2018 including data derived from the pilot study. Is Michael’s Canadian patent application valid?
- 4 4. Frances has developed a cannabis-infused beverage which is attracting the attention of several large Canadian cannabis suppliers. The beverage includes numerous ingredients including ginger, lemon juice, honey and a mixture of cannabis extracts derived from five different plant varieties. Frances successfully obtained a Canadian patent in 2017 with claims directed to her particular mixture of five extracts. Several years prior to filing her patent application, while working as a surfing instructor, Frances sold granola bars at a coffee shop in Tofino, British Columbia which contained the same mixture of cannabis extracts together with oats, dried fruits, chocolate chips and many other ingredients. Although Frances did not disclose her granola bar recipe, a skilled chemist could have reverse engineered the granola bars at the time they were sold and identified the source and constituents of four of the five extracts using known analytical techniques. Frances has asked you to comment on the enforceability of her patent. Advise Frances.

- 3 5. Briefly explain the test for determining whether an alleged invention would be considered “obvious to try”.
- 4 6. In an article published in *Science* in 1998, referred to in the *Harvard Mouse* case, Michael Heller and Rebecca Eisenberg questioned whether more intellectual property rights may lead paradoxically to fewer useful products for improving human health:
- “Patents and other forms of intellectual property protection ... may fortify incentives to undertake risky research projects and could result in a more equitable distribution of profits across all stages of R&D. But privatization can go astray when too many owners hold rights in previous discoveries that constitute obstacles to future research”.
- Discuss whether patents encourage or hinder research and development and provide an example.
- 2 7. Explain the meaning of the term “selection patent” and provide an example.
- 4 8. How do the courts in Canada determine what features recited in a patent claim are essential and what features are non-essential? Can extrinsic evidence be referred to when construing a patent claim?

END OF EXAM