Write Your Exam Code Here: ________________

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THE UNIVERSITY OF BRITISH COLUMBIA
PETER A. ALLARD SCHOOL OF LAW

FINAL EXAMINATION - DECEMBER 2019

LAW 422/570C
INTELLECTUAL PROPERTY

Professors Takagawa/Bailey/Marles

TOTAL MARKS: 100

TIME ALLOWED: 3 HOURS
and 20 minutes reading time

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1. This is an OPEN BOOK examination.

2. Students are permitted to also write during the 20 minutes reading time.

3. 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

LAW 422 **PART I - TRADEMARKS – DECEMBER 2019**

(Total: 34 marks)

Marks

8 1. Briefly discuss the registrability of the following trademarks, citing the statutory provisions potentially at issue. Assume you are the trademark applicant.

(a) A logo consisting solely of the face of Prime Minister Justin Trudeau for "playing cards". **[2 Marks]**

(b) 4EVER WARM for "disposable heat pads". The heat pads contain chemicals that, upon activation, release heat for up to one hour. **[3 Marks]**

(c) SUPERSKI for "heli-ski tours". Heli-skiing is downhill skiing on remote mountain terrain accessed by helicopter. **[3 Marks]**

8 2. Do the following qualify as trademark "use"? Briefly explain why or why not. (Do not consider other issues such as distinctiveness and registrability.)

(a) A smiley face logo for "apples". The apples are sold with a small sticker with a smiley face on them. **[2 Marks]**

(b) RYDE for "ride share services". The services are provided through an app that displays the RYDE trademark. The app is available for download to users in Canada. RYDE ride share services are widely available in the United States but so far in Canada the service is only available in Vancouver, where the city has agreed with the RYDE company to test the service for a one month trial period. **[3 Marks]**

(c) Images of cartoon vegetables for "T-shirts". A series of T-shirts, each prominently featuring on the front, in a similar distinctive cartoon style, a large image of different vegetables against a plain background. For example, one T-shirt in the series displays an image of a carrot, while another displays an image of lettuce. **[3 Marks]**

3 3. Identify three ways in which a university mark under section 9(1)(n)(ii) differs from regular trademarks.

15 4. Mariam has been selling bagels in association with her HOLE IN ONE trademark since 2000. She began with a small bagel shop in Kitsilano. Due to her great success over the past several years she has expanded her business to ten locations across Vancouver, Burnaby and Richmond.

(a) On January 1, 2019 Mariam filed a Canadian trademark application for HOLE IN ONE for "bagels". The trademarks examiner has raised the objection that HOLE IN ONE is clearly descriptive of bagels, relying on a dictionary definition of "bagel" as "a dense bread roll with a hole in it". Briefly advise Mariam on her options for overcoming the examiner's objection. **[4 Marks]**

(b) The trademarks examiner also raised the objection that the HOLE IN ONE trademark is confusing with an existing trademark registration, for HOLEY ONE for "donuts". The HOLEY ONE trademark was registered in 2010. Miriam has learned that the owner of the HOLEY ONE trademark registration runs a popular chocolate donut shop in Toronto. She further learned that this shop underwent a rebranding in 2015 toward a Mexican theme, and has since been selling chocolate donuts only under the trademark HOLEY MOLEY IT'S THE ONE. Briefly advise Mariam on her options for overcoming the examiner's objection. **[5 Marks]**

(c) Would it make a difference in question (b) if a search of the Canadian trademark register also revealed the following trademark registrations: WHOLE ONE for "bread"; HOLY ONE for "muffins"; and "HOLY 1" for "hamburger buns", all owned by different parties? Explain why or why not. **[3 Marks]**

(d) On December 1, 2019 Mariam obtains a trademark registration for HOLE IN ONE. Unbeknownst to Mariam, a Montreal bagel shop has been using the HOLE IN ONE trademark with bagels since 1995. Briefly advise Mariam of any vulnerability of her trademark registration with respect to the Montreal bagel shop if she discovered this fact (i) today and (ii) seven years from today. **[3 Marks]**

END OF PART I

LAW 422 **PART II - PATENTS – DECEMBER 2019**

(Total: 33 marks)

Marks

9 1. Briefly comment with justifying reasons on whether the following subject matter is patentable in Canada assuming it is new, non-obvious and useful:

(a) A method of dispersing fog by causing water droplets to coalesce and precipitate as rain. **[3 Marks]**

(b) The use of an anti-cancer drug for prevention and treatment of ebola virus disease. **[3 Marks]**

(c) A heart-monitoring apparatus and method which employs a set of computer algorithms designed to identify irregular heartbeats. **[3 Marks]**

4 2. In *President and Fellows of Harvard College v Commissioner of Patents*, 2002 SCC 76, Bastarache J. stated: "Patenting higher life forms would involve a radical departure from the traditional patent regime". Discuss whether or not you agree with this statement and provide reasons.

3 3. Amelia is an avid cyclist and entrepreneur. On a trip to Amsterdam in the summer of 2018 she rented a bicycle having a wheel lock mounted on the bicycle frame that could be engaged by extending a metal rod between the spokes of the rear wheel. Amelia later determined that the wheel lock was not patented or commercially available in Canada. Seeing a business opportunity, she filed her own Canadian patent application for the wheel lock on April 16, 2019 after offering the product for sale at the BC Bike Show held in Vancouver in February 2019. Is Amelia's Canadian patent application valid?

5 4. In 2017 Jeremy invented a synthetic, resin-based mortar intended for use in the construction of outdoor patios and driveways. The mortar, which is installed between paving stones or tiles, comprises a mixture of a filler and a binder. When the mortar sets it is very strong and prevents the intrusion of weeds or insects between the stones or tiles. The mortar is also water-permeable so it allows for rapid drainage of rain water from the surface of the patio or driveway to the underlying substrate. After experimenting with various different formulations of the mortar on a confidential basis, Jeremy filed a Canadian patent application on January 15, 2018. The application has now been examined and the Examiner has rejected all of the claims pursuant to Sections 28.2 and 28.3 of the *Patent Act.* The Examiner has cited two prior art references. The first reference is a German patent application published in 1997 which describes a settable mortar for indoor ceramic floor tiles which includes the same binder as Jeremy's product but which is not water-permeable. The second reference is a US patent granted in 2008 for a silica sand formulation which is water-permeable. The formulation is very similar to Jeremy's filler but is not recommended for driveway mortar applications

requiring a high level of durability. The Examiner contends that "the claimed invention lacks novelty and would be obvious to a person of ordinary skill in the art having regard to the teachings of the cited references". Advise Jeremy on the prospects for overcoming the Examiner's rejections.

3 5. Linda has invented a synthetic dye which is a derivative of methylene blue. When the dye is exposed to a particular wavelength of light it produces a biocidal agent which kills bacteria and viruses but has very low toxicity to humans. Linda has filed a Canadian patent application claiming the use of the dye to decontaminate various materials including blood plasma. The Canadian Red Cross is interested in licensing the invention and has reviewed Linda's patent application as part of its due diligence assessment. The Red Cross reviewer has noted that the wavelength and intensity of light which triggers production of the biocidal agent is not specifically mentioned in the patent application. Linda has asked you to advise whether that is a potential problem.

3 6. Explain the difference between independent and dependent claims. Why might an applicant wish to include more than one independent claim in a patent application?

3 7. Explain when the words used in a patent application may result in a "self-inflicted wound" and provide an example.

3 8. Is the intention of a defendant relevant to a finding of patent infringement in Canada? Cite case authority and advise whether there are any judicially recognized exceptions.

END OF PART II

LAW 422 **PART III - COPYRIGHT – DECEMBER 2019**

(Total: 33 marks)

Marks

7 1. (a) List the four requirements for copyright to subsist in a work and the section of the *Copyright Act* that governs these requirements.

(b) State if the following statement is true or false and briefly explain why: all of the requirements for the subsistence of copyright are statutory.

4 2. Briefly explain what neighbouring rights are and list two ways they are different from copyright in works. List one neighbouring right and the section of the *Copyright Act* that confers it.

5 3. What is the principle of technological neutrality? List the Supreme Court of Canada case that introduced the concept into Canadian jurisprudence. List one case that considered the principle of technological neutrality in valuing royalties payable, and briefly explain how technological neutrality affected the valuation of those royalties considering that the new technology required the creation of more copies than the old technology.

4 4. What requirements must a work meet to be considered a parody at the first step of the fair dealing analysis? Cite statutory and case law authority for your answer. Must the source of the work being parodied be provided to benefit from the exception? Briefly explain why or why not.

13 5. Susan is an employee of Whistler-based Quick Skis Inc. Using her skill and experience as a ski designer and after hundreds of hours of hard work for Quick Skis, Susan came up with a design for a new ski that is ultra light, strong, and fast, called the "SuperSki". The ski is beautiful to look at in terms of its design, and is extremely exclusive with a limited production run--Quick Skis made and sold only 25 pairs of the skis and vows never to make any more to maintain the exclusivity of the skis. The SuperSki was just released to the public three weeks ago at the Whistler Ski Show.

Just yesterday, Quick Skis' competitor Fast Boards Inc. released their "UltraSki", and it appears to be a direct knock-off of the SuperSki, being virtually identical in shape and configuration. A representative of Fast Boards was in attendance at the Whistler Ski Show and asked Susan to show him the SuperSki up close and personal, which Susan did. She now regrets having done that since she suspects the Fast Board's representative copied the ski based on that interaction.

Quick Skis is fuming that their ultra exclusive SuperSki has been flagrantly copied and seeks your advice. Advise Quick Skis on the following points:

(a) Is Quick Skis likely to succeed if it sues Fast Boards for copyright infringement? Your answer should address ownership of copyright, originality, and the test for infringement, citing case law or statutory authority as appropriate to support your answer. **[9 marks]**

(b) Would your advice change if Quick Skis had mass-marketed the SuperSki and made and sold one million pairs? **[4 marks]**

END OF PART III
(END OF EXAM)