

acclaim

quarterly news issue 20 december 2006



CAWEE
CANADIAN ASSOCIATION
OF WOMEN EXECUTIVES
& ENTREPRENEURS

broaden your perspective

WHAT'S INSIDE

How Well Are
You Protected?
President's Message
How to Protect
Yourself Financially
Here We Grow Again!
CAWEE Meets
Your Voice:
Intellectual Property -
Know Your Rights
Legal Lessons:
Contracts and Employment
Final Word

LEGAL LESSONS

INTELLECTUAL PROPERTY - HOW TO PROTECT YOURSELF

by: Michelle L. Wassenaar and Andrea Long



Copyright Conundrums

Publishing papers and making presentations are routine for entrepreneurs and executives. Here are a few situations in which you may find yourself wondering about the extent of your rights.

Handout Materials

At a presentation for a potential client, you distribute a handout that you prepared. You are subsequently retained by the client who now believes that they may use the handout you provided without your permission. In this case, the handout is considered to be a literary work, in which you as the author, and therefore first owner, have copyright. This means that you have the sole right to produce and reproduce the handout in any material form, either in whole or in substantial part. You may assign your copyright interest in writing to another party, in which case the new owner has the rights that originally vested with you as the author, to produce and reproduce the pamphlet. Therefore, so long as you did not transfer your copyright interest to the client, you still retain full rights to your handout and the client should not be copying it in whole or in substantial part without your permission.

However; if the handout was created while you were employed by a company under a contract of service or apprenticeship and the handout was made in the course of your employment by that company, the company will, in the absence of any agreement to the contrary, be the first owner of the copyright.

Presentations

You are presenting at a conference and at the last minute, the conference organizers decide to tape the conference. The organizers then sell the tapes to attendees; without your permission. In this situation, the recitation or reading of a literary work (the paper) or an improvisation of the paper gives you as the presenter, "performers' rights" in your presentation. As the performance is now fixed (i.e. on videotape) without your authorization, any reproduction of the fixed copy of your performance may only occur legally with your permission.

Publications

You were commissioned by a print-based magazine to write an article that was published in the print magazine. The magazine has now posted your article on its on-line website in a new arrangement without your permission. In this case, the consent of the author and/or compensation to the author is required before the magazine can legally electronically republish articles in this manner. The magazine only has the rights to publish the article in the magazine and rights in the magazine as a compilation of articles, advertisements, etc.

The above situations fall into the realm of copyright; a branch of intellectual property that grants the author of a work the sole right to produce or reproduce certain types of works, either in their entirety or in substantial part. Copyright exists in the expression of an idea, not in an idea itself. A complete list of the types or works copyright vests in is found in the copyright act, and includes such things as literary works, artistic works, dramatic works and musical works. As demonstrated by the second scenario, rights outside of the traditional realm of copyright are provided for in what is referred to as "neighboring rights." "Neighboring rights" exist in such things as performer's performances, sound recordings and communication signals. The rights granted to these works are similar to, but more limited in scope than, traditional copyright.

Other forms of intellectual property are trade-marks, patents and industrial designs.

Trade-marks

Essentially, a trade-mark is a word or design or any combination of the two that is used to distinguish one trader's wares and/or services from those of a competitor. Examples of some well-known trade-marks include NIKE, BLACKBERRY, STARBUCKS and LEXUS. You may already be using a trade-mark in association with your business to differentiate your business from competitors, and are building a reputation the public will associate with your trade-mark, and therefore your business.

Trade-marks may be registered with the Canadian Intellectual Property Office to provide the owner with the exclusive right to use the trade-mark in association with the wares or services it is registered in association with throughout Canada for a period of 15 years. This term can be renewed for further 15 year terms upon payment of a renewal fee. While a trade-mark registration is not required for rights to accrue, it is highly recommended for the purposes of enforcing your trade-mark against any potential infringers. A valuable trade-mark registration is an asset for your business. The biggest asset of COCA-COLA is arguably the trade-mark not the secret formula.

Patents

Patents are statutory instruments that give the owner the exclusive right to make, use and sell an invention. Being granted a patent is akin to being granted a monopoly to the patented invention, which the patent owner may use, sell or license to their benefit. Unlike trade-marks and copyright, in which intellectual property rights arise by virtue of their existence, a patent is a statutory instrument that can only be granted in accordance with the Canadian Patent Act. Therefore, a patent will only exist if applied for, and granted, by the Canadian Intellectual Property Office and is geographically limited to the country that issued it (i.e. Canada). If granted, a patent has a finite term of 20 years from the filing date, with no right to renew.

To be eligible for patent protection, an invention must be new (not previously known to the public anywhere in the world), useful (the invention must be able to function in the manner stated in the patent) and inventive (it may not be obvious to a person skilled in the subject-matter of the invention).

Industrial Designs

An industrial design is a shape, configuration, pattern or ornamentation or any combination of these features that appeal to and are judged solely by the eye. Examples of designs may include a unique shape for a necklace pendant or the wing of an airplane. Whatever the design in question may be, it must be registered with the Canadian Intellectual Property Office for the industrial design right to exist and for the owner of that right to have protection against infringement. For a design to be eligible for registration, it must be original, which is to say that it must not be identical to or closely resemble any other design already registered. Nor can the owner of the design have made the design public more than one year before filing the Canadian design application. An industrial design registration is valid for 10 years from the date of registration, with no right to renew.

Intellectual Property Rights and Your Business

Understanding each of these areas of intellectual property law is important in determining what rights you already have, and what rights you would like to obtain to fully realize the valuable assets that copyright, trade-marks, patents and industrial designs may be for your business. On the flip side, being knowledgeable about intellectual property rights and determining whether a course of action will infringe upon the intellectual property rights of others is also very important.

Michelle L. Wassenaar is a partner with Johnston Wassenaar LLP, an intellectual property boutique law firm in Toronto. Michelle is a lawyer, registered Canadian Patent and Trade-mark Agent and advises clients on copyright, trade-mark, patent and design matters. Michelle can be reached at (416) 867-1661, ext. 241 or mwassenaar@jawioplaw.com. Andrea Long, an associate at Johnston Wassenaar LLP, can be reached at (416) 867 1661, etc. 236 or along@jawioplaw.com.

This article is intended only as an overview and readers should consult their own lawyer for advice on any specific questions.