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ARTICLES

Better Late Than Never – Issued Patent’s List Of Inventors Corrected

By: David Turgeon

The Federal Court has recently confirmed the principle that an inventor can be added to an issued patent’s list of inventors. In *Plasti-Fab Ltd. v. Canada (Attorney General)*,¹ four individuals were listed as inventors on a patent application in the United States. After obtaining their American patent, the inventors filed a patent application in Canada for the same invention. This patent application listed only three of the investors identified in the U.S. patent. To justify leaving the fourth inventor, Mr. Doren, off the list, affidavits were filed attesting that he did not qualify as an inventor.

A few years later, after becoming better acquainted with the criteria for qualifying as an inventor, the four individuals reconsidered their initial position and realized that Mr. Doren did indeed qualify as an inventor and, as such, should be added to the two Canadian patents. In support of their claims, Mr. Doren and another inventor claimed that the omission was a mistake and not for the purpose of a delay; rather, they were unaware of the correct legal test for inventorship when they filed their Canadian patent application.

The Federal Court found that the Commissioner’s authority is limited when it comes to adding an inventor to an issued patent. It ruled that a patent holder cannot avail himself of Section 8 of the *Patent Act*, which provides for the correction of clerical errors, to add an inventor, thus upholding *Micromass UK Ltd. v. Canada (Commissioner of Patents)*.² On other hand, paragraph 31(4) of the same act grants the Commissioner the discretion to add an applicant, but only if the patent is pending.

Once a patent is issued, the Federal Court alone has the jurisdiction to amend the list of inventors. The Court confirmed that the word “entry” in section 52 of the Act is broader than the acquisition of rights by assignments: it also covers matters relating to the root of the titles, namely the listing of inventors. The Federal Court’s jurisdiction therefore extends to correcting clerical errors relating to the naming of inventors on an issued patent, including errors of a clerical nature relating to the transcribing of inventor names. In other words, the powers conferred by section 52 are very broad and allow the Court to accomplish what the Commissioner would have been able to do before the patent was issued.

The Court therefore applied the test set out in section 31(4) of the Act to determine if Mr. Doren should be added to the list of inventors. Since the evidence showed that Mr. Doren had met with another inventor before the patent application was filed in the United States, that they had discussed concepts, that Mr. Doren did in fact qualify as an inventor and that the affidavits filed at the same time as the Canadian patent were not for the purpose of a delay, the Court ordered the records amended to include the name of Mr. Doren as an inventor.

This case may have ended well, but it nonetheless remains that the proceedings instituted before the Federal Court to amend the records were far more onerous than the procedure that could have been taken while the patent applications were still pending. This case teaches the importance of fully grasping the notion of “inventor” before a patent application is filed and taking whatever corrective measures may be necessary as soon as possible.

¹ 2010 FC 172

² 2006 FC 117, 46 C.P.R. (4th) 476

Registrar Not to Embark on a Validity Analysis in Section 45 Proceedings

By: Chloé Latulippe

In an appeal from the Trade-Marks Opposition Board, the Federal Court set aside a decision reached pursuant to Section 45 of the *Trade-Marks Act* and maintaining in part Malcom Parry's registration for the trade-mark VANCOUVER LIFE in association with "editorial/advertising inserts into publications and periodicals".

The Federal Court addressed mainly two issues. The first issue was whether the Registrar was wrong in concluding that in Section 45 proceedings she was not required to decide if use of the mark constituted trade-mark use within the meaning of the Act. The second issue was whether such use was one in association with wares contemplated by the registration.

With regard to the first issue, the Court found that the Registrar had not erred in refusing to embark on a review of the distinctiveness or validity of the mark VANCOUVER LIFE. As established by the Federal Court of Appeal in *United Grain Growers Limited v. Lang Mitchener*, no words in Section 45 direct the Registrar to re-examine whether the registered trade-mark is used for the purpose of distinguishing or so as to distinguish wares or services. Rather, the Registrar's duty under Section 45 is only to determine, with respect to wares specified in the registration, whether the trade-mark, as it appears in the register, has been used in the three year period preceding the notice issued by the Registrar. The Federal Court therefore upheld the decision of the Registrar in this respect.

With regard to the second issue, however, the Court came to the conclusion that it was not reasonable for the Registrar to conclude that columns of editorial content published in a magazine constituted "editorial/advertising inserts into publications and periodicals". In the Court's opinion, the expression "editorial/advertising inserts into publications and periodicals" found in the statement of wares could not reasonably be understood as extending to "editorials inserted into publications and periodicals". The trade-mark was expunged.

This decision highlights the importance of a carefully drafted description of wares and services in the context of Section 45 proceedings.

Horst Dusseldorf v. Horst Waterproof. Did the Québec Court of Appeal Bet on the Wrong Horst?

By: Silviu Bursanescu

In a recent case, *Octeau v. Kempter Marketing Inc.* (2010 QCCA 171), the Court of Appeal of Quebec rendered an important judgement on the issue of confusion between trade-marks composed primarily of a foreign first name that is uncommon in Canada. In a unanimous decision, Justice Hilton confirmed the ruling of the Superior Court judge who had previously ruled that no significant confusion was caused by the use in parallel of the registered trade-mark *Horst Dusseldorf* owned by appellant Octeau and the common law trade-mark *Horst Waterproof* used by respondent Kempter. The central issue was one of distinctiveness and whether the use of a foreign first name in a trade-mark has an impact on the degree of distinctiveness of the trade-mark. The Court of Appeal effectively established that a lower degree of distinctiveness is to be afforded to such a trade-mark.

Appellant Octeau, an importer of men clothing and accessories, had been using the trade-mark *Horst Dusseldorf* since 1992. However, the use of the trade-mark had grown significantly since 1999 while important advertisement campaigns were staged between 2002 and 2007. In comparison, respondent Kempter had only started using its trade-mark *Horst Waterproof* in 2004 in association with cycling accessories, including bags. Moreover, while Kempter attempted to register its trade-mark with CIPO, it failed to respond to examiner's objection based on possible confusion with Octeau's registered trade-marks and therefore Kempter's demand was considered abandoned. However, the Court of Appeal did not consider Kempter's failure to answer examiner's objection as material and stated that one cannot presume of the ultimate decision of the examiner had Kempter provided the required reply.

On the issue of confusion (sec. 6(5) Trade-Marks Act), the Court of Appeal made a number of rulings that depart from previous jurisprudence. It considered that the trade-mark *Horst Dusseldorf* is not very distinctive because it is composed of a foreign first name and the name of a foreign location. This ruling changes the applicable test from one where the Court must consider the perception of the average Canadian consumer with respect to the trade-marks at issue to determine whether confusion is likely to occur with one where the perception of the Court is to be considered. Had the test of the average Canadian consumer been applied, it is at least possible that the Court would have ruled in favour of Octeau as the average Canadian consumer probably ignores that "Horst" is a common first name in Germany. Moreover, the same reasoning can be applied to *Dusseldorf* which is probably not a location that is well known to the Canadian public. Thus, it appears from our reading of the case that the Court in rendering judgement either set aside the test of the average Canadian consumer or, at the very least, chose a somewhat knowledgeable Canadian consumer as its reference point.

The ruling of the Court also raises a number of questions as to the weight to be given to the other criteria that the Court must consider as par of the confusion test. For instance, the Court gave little weight to the duration of use of the trade-mark *Horst Dusseldorf*, which had been effectively in use since 1992, while Kempter's trade-mark was only introduced in 2002, some 10 years later. Even if one considers, as did the Court, that it's only since 1999 that the mark *Horst Dusseldorf* had been more widely used, this is still 5 years prior to the first use of the mark *Horst Waterproof*.

Moreover, it is also apparent that at least some overlap exists as to the nature of the wares involved. The cycling bags carrying on the trade-mark *Horst Waterproof* could easily have been commercialized by Oceau whose trade-mark description included “bags”, even though none were commercialized under that mark at the time. However, if one looks at this criteria the other way, one can see that Kempter was in fact commercializing wares which overlapped with the general category of wares (clothing and accessories) commercialized by Oceau. In any event, the decision of the Court closes the door to Oceau who can no longer commercialize bags under the trade-mark *Horst Dusseldorf* in the future.

In conclusion, the Court of Appeal’s decision somewhat dilutes the protection afforded to the owner of the registered trade-mark, mainly by modifying the test of the average Canadian consumer. It thus becomes necessary to consider, when registering a trade-mark, that simply using a first name of foreign origin or a location located outside Canada may not be enough to create sufficient distinctiveness for one’s brand and that additional elements, including wording and graphics, would need to be added to ensure that the trade-mark is sufficiently distinctive so as to afford adequate commercial protection to the registered owner.

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