Conference Examines IP in the new Millenium

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Recently, a US newspaper relocated its Canadian news bureau to Colorado. Taxes are too high, it seems, to permit reporters covering Canada to be physically located here.

In the same spirit, I'm reporting on the 73rd annual meeting of the Patent and Trade-mark Institute (PTIC) from Toronto - although the meeting was in Quebec City. The conference was from September 23 to September 25, 1999, and featured a special seminar called, somewhat unfortunately, "IP into The New Millenium" (a title which caused much hilarity around my office.)

I would have preferred to actually attend the conference in person, since it was at the Chateau Frontenac. But, being too busy, I sent my associate Roger Bauman to send dispatches back from the front lines.

The wine and fine dining at the Chateau Frontenac was, Roger reports, satisfactory. Roger also brought back some notes and a binder of thoughtful papers on the various topics that are big in the intellectual property world right now.

Some of these topics have been dealt with in previous columns, but it's still useful to recap here, because the various topics represent an overview of the current preoccupations of intellectual property lawyers.

Patents: there are essentially two big topics in patents these days, both to do with patentable subject matter i.e. what can be patented.

State Street case in US: The biggie that everyone is talking about is the possible impact in Canada of the State Street decision, a US appellate decision. In short, State Street held that software relating to methods of doing business can now be patented in the US. This is big news because it means, potentially, a huge expansion in the impact of patents generally. Banks, insurance companies, and many other service companies both in and outside the financial sector in the US may now be directly affected by patents. This means more work for patent people.

The patent in State Street claimed software, operating on an ordinary computer, designed to track the value of certain "pooled" mutual funds. The novelty was in the pooling i.e. the business structure itself, which created benefits such as economies of scale and more favourable tax treatment.

Alfred Macchione gave what my source tells me was a most interesting talk on the State Street case and the possible impact on Canada. There is little Canadian case law on point, but the patent examiner's manual says subject matter such as that dealt with in the State Street case would not be patentable in Canada. An equivalent application has been applied for in Canada, but has not so far issued. But there's a big change in the US, can the Great White North be far behind?

Patentability of life-forms: In a most interesting paper, Dr. John Rudolf of Bereskin & Parr summarized the current position in Canada. Both gene sequences and simple organisms can be patented. The big issue is the patentability of higher life forms. Here, the state of the law turns on the result in the so-called "Harvard Mouse" case, shortly to be heard by the Federal Court of Appeal. Harvard applied to patent an oncomouse, a mouse that had been genetically modified to be susceptible to tumours, used in cancer research. The Federal Court trial level ruled claims to higher life forms were improper, saying, among other things, that the issue was one for Parliament to decide. Either the Federal Court of Appeal or eventual legislation may reverse the effect of that ruling. If so, I plan to patent Roger as a "Mammal having conference-attending, information gathering capabilities."

Whither patent agents in the new millenium? A thought-provoking paper by John Orange, a well-known Toronto patent agent, urged Canadian patent agents to become more competitive and knowledgeable, particularly about laws outside Canada. Worldwide patent systems are become more integrated. Free trade is coming to patent agency services. Ninety percent of Canadian patent applications presently are filed by foreign firms using Canadian patent agents merely as local representatives, but it will in future become less necessary to use local firms. Other countries will have a similar lowering of their barriers, so these changes create opportunities for, as well as a potential threat to, the Canadian profession. The Canadian government, says Orange, should ensure future legislative changes ensure the survival of a vibrant patent agency profession in Canada.

Databases: A useful paper by Tom Onyshko looked at the protection of databases or compilations. The leading case here is the Tele-Direct case which held that mere "sweat of the brow" (hard work) was not enough to attract copyright in a compilation. There must be at least some small spark of originality in the arrangement of the compiled material before copyright protection will apply. The paper has a thoughtful discussion of the law in both in the US and Canada.

Other useful seminars dealt with trademarks and domain names, "three dimensional" trade-marks, and misleading advertising. Lack of space prevents me from extolling the

virtues of those presentations, but apparently they were good. And the golf tournament, I have it from a reliable source, was even better.