

Sand, Sun and Patents: IP Bermuda

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This is the first column I've ever written on a beach. It seemed the most appropriate place to write about this year's Annual Meeting of the Patent and Trade-mark Institute of Canada (PTIC), held at the Sonesta Beach Resort in Bermuda, September 25 to 27.

Discussion of matters of substance has been kept to a tasteful minimum, so as not to interfere with food, cocktails, and limbo-dancing. So far, we've had not one, but two, evenings devoted to limbo contests. (I myself declined to limbo, feeling this would not be in keeping with the proper dignity of a Lawyers Weekly columnist).

The meeting was held jointly with the equivalent body in the UK, but, as it turned out, hardly anyone from the UK came. The poor turn-out from mother England may have been due to (a) the cost of airfare from the British Isles, and (b) a sterner view of the proper role of professional get-togethers among Britons. I spoke to one of the few UK practitioners who did come (he had to; he was a speaker) who commented that although he and his British colleagues do occasionally get together for serious seminars, they don't go in for "weekend retreats to holiday resorts".

We frivolous colonials did, however, manage to fit in at least a few weighty seminars, including the following:

Pharmaceutical Practice

A panel of three discussed "pharmaceutical practice". Two representatives of innovator drug companies spoke on the recent parliamentary hearings on Bill C-91 (Canada's laws governing drug patents), and made the pitch for patent term extensions. IP litigator Carol Hitchman discussed the Patented Medicine (Notice of Compliance) Regulations. These controversial regulations came into force in 1993 and have caused a huge flood of drug patent litigation, and were also a key issue in the Bill C-91 parliamentary hearings earlier this year.

The limited time available unfortunately did not allow time for discussion from the floor. This was too bad, because a number of lawyers were present who have been involved in many of the cases under the Regulations, on both the generic and brand name side. It would have been interesting to hear an exchange of views as to why there has been such a deluge of litigation (well over a hundred cases), and what should be done to improve the situation, which everyone seems to agree is unsatisfactory.

Third Party Procedures

Broadly speaking, there are two kinds of intellectual property people: patent people and trade-mark people. The next part of the program allowed trade-mark types to hear about third party procedures involving trade marks, while patent people went to another room to hear about, you guessed it, third party procedures involving patents.

What's a third party procedure? Basically, it's when party A tries to prevent a trade mark registration, or patent, from issuing to party B, through a statutory "opposition" procedure of some kind (as opposed to arguing invalidity in court).

A formal opposition process has existed for trade-mark registrations for years, administered by the Trade-marks Opposition Board.

Until recently, there was no equivalent for patents. Limited rights to make third party submissions to the patent office have now been added to the Patent Act. There was some debate at the meeting as whether these procedures should be expanded. No one seemed to have strong views on this, possibly a reflection of the fact that, strategically, there is often little point in opposing the issuance of someone else's patent. It may be a better idea, if faced with a patent infringement action, to let the patent issue, and save whatever arguments or evidence one has as to invalidity for the lawsuit.

Copyright Reforms (Phase II)

The "Phase II" amendments to the Copyright Act have been right around the corner now for years (Phase I came into force in the late eighties. Phase II was going to follow within months). Ogily Renault partner Malcolm Macleod spoke about the numerous changes contained in the current draft of Phase II. Essentially Phase II will provide summary procedures for the enforcement of copyright, clarify fair dealing, impose a "blank tape levy", and create various new exemptions to infringement. Matters such as the law governing copyright in compilations (databases) and how copyright applies to internet browsing will likely remain murky.

Intellectual property litigation: does it work?

Intellectual property litigator Scott Joliffe evaluated Canada's litigation system, saying it works well, but takes too long.

Luckily, the Federal Court Rules Committee has the answer: new rules for the Federal Court, where most intellectual property cases are heard. The new rules were due to come into force on January 1, 1998, but this has now been pushed back to late March, 1998. Draft new Rules appeared in the Canada Gazette in late September. Many practitioners have now submitted complaints, comments and objections (such as that the English and French versions differ). The Rules Committee pushed back the implementation date to have time to consider the submissions, according to Roger Hughes, Chair of the Federal Committee, who tells me, "we're saying late March rather than April 1 to avoid all the April Fool's jokes."

The new Rules may merit another column. Briefly, they limit the ability of counsel to get extensions of time (even where both sides consent), and impose a much greater degree of case management by the Court, all with a view to moving litigation along quicker.

Hey, man! Column's done! Time to Limbo!