

Brooks Newsletter

Autumn 2004

“Troubleshooting Your Business”: Intellectual Property Protection For Your Products and Services

This is our first in a five-part series called “*Troubleshooting Your Business*” in which we discuss topics that should interest Canadian business owners and operators. Other topics in this series will include: are your company’s insurance needs being met; are you unwittingly engaging in misleading advertising; and, the difference between using independent contractors and employees.

Brooks Barristers & Solicitors would like to express its thanks to Riches, McKenzie & Herbert LLP and, in particular, Paul Herbert and Jason Leung for contributing the following article dealing with obtaining protection for your intellectual property.

You have recently developed a new product that has the potential to be very successful in the marketplace. Or maybe your business is offering a new service to meet the needs of your customers and will also attract new customers. How can you prevent your competitors from marketing the same product? How can you prevent your competitors from offering the same services while using your company's name? Someone has suggested that you obtain intellectual property protection, but you are not certain whether your product or service is entitled to such protection.

Below is a brief summary of some of the different types of intellectual property protection that you may be interested in obtaining.

1. Patents

In order to obtain a patent, your newly developed product must be:

- (a) new (first in the world);
- (b) useful (functional and operative); and
- (c) it must show inventive ingenuity, and not be an obvious solution to someone skilled in that area.

Patents can be obtained for a product (*e.g.*, a new umbrella), a composition (*e.g.*, a chemical composition used in waterproofing an umbrella), an apparatus (*e.g.*, a machine for making umbrellas), or a process (*e.g.*, a method for making umbrellas).

A patent gives you the right to exclude your competitors from making, using or selling your invention from the day the patent is granted to a maximum of 20 years after the day on which you filed your patent application. A patent can be useful in making a profit by selling it, licensing it or using it as an asset to negotiate funding.

As you are developing your new umbrella, it is highly recommended to conduct a patent search for already issued patents that relate to the same or similar types of products. The purpose of the patent search is twofold:

- (a) to ensure that your new umbrella does not infringe on the patent rights of another; and
- (b) to assess the probability of your being able to obtain a patent for your new umbrella.

2. Trademarks

Your new product or service may have a name or logo by which customers can identify the product or service. This name or logo may be entitled to trade mark protection.

A trade mark is a word, a symbol, a design, or a combination of these. The trade mark distinguishes the products or services of one person or organization from those of competitors

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in the marketplace. Trade marks come to represent not only actual products and services, but also the reputation of the producer.

Registration of your trade mark gives you the exclusive right to use the mark across Canada for 15 years, renewable every 15 years thereafter.

3. Copyright

Your new product may be a literary work, such as a textbook, or an artistic work, such as a painting. Alternatively, your new product may be accompanied by an instruction manual. If this is the case, you may be entitled to copyright protection.

Copyright is the right to copy (as in text). The owner of copyright is allowed to produce or reproduce the work in question or to permit anyone else to do so.

Copyright applies to all original literary, dramatic, musical and artistic works and gives the owner the sole right to publish or use your work in any number of ways.

Generally, copyright lasts for the life of the author, the remainder of the calendar year in which the author dies, and for 50 years following the end of that calendar year. Therefore, copyright protection will expire on December 31 of the 50th year.

4. Industrial Design

Your new umbrella may have features that are merely ornamental, such as the design features of the handle. This may entitle you to industrial design protection.

An industrial design is the features of shape, configuration, pattern or ornament applied to a finished article made by hand, tool or machine.

The design must have features that appeal to the eye.

The registration of an industrial design enables you to prevent others from making, importing for trade or business, renting or selling or offering or exposing for rent or rent any article in respect of which the design is registered and to which the design or a design not differing substantially there from has been applied, for up to 10 years from the date of registration.

5. Remember

Your umbrella is the child of your creativity. Protect it, nurture it and watch it grow as you would for all your children. Take the time to find out how to protect this valuable asset.

For more information about this topic, visit the Canadian Intellectual Property Office Web site: http://strategis.ic.gc.ca/sc_mrksv/cipo/welcome/welcom-e.html

If you require further insight into this or any other legal issue, feel free to contact us at:

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Disclaimer: The foregoing provides only an overview. Readers are cautioned against making any decisions based on this material alone. Rather, a qualified lawyer should be consulted.

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