



AN
INTELLECTUAL PROPERTY
LITIGATION PRIMER

Basic Legal, Procedural and Jurisdictional Considerations

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INTRODUCTION



- Intellectual Property (IP) litigation, unlike the Hobbesian state of nature, is not nasty, brutish and short.
- It can be, though, long drawn out, complex and costly.
- Perhaps the first consideration is just how much one is prepared to spend litigating – obviously if the IP in question is part of the core value of the company, then it is, by definition, a “bet the company” lawsuit.
- As well, there is the reputational/branding risk of letting others take, or nibble away at, the organization’s IP, whether that be patents, trade-marks, copyright works, confidential information, or some combination.

JURISDICTION?



- Federal Court is statutory, some exclusive jurisdiction – s. 20.
- Nationwide.
- But no general jurisdiction – inventorship/patent ownership disputes go to s. 96 Courts – i.e. Queen’s Bench.
- So does confidential information: *Suncor Energy Inc. v. MMD Design and Consultancy Limited*, [2008 FC 488 \(CanLII\)](#).
- *Axia Inc. v. Northstar Tool Corporation* (2005), [2005 FC 573 \(CanLII\)](#), [39 C.P.R. \(4th\) 299 \(F.C.\)](#).
- Significant IP Expertise.
- Injunctions are hard to get.

PROCEDURAL



Federal Court

- Status review.
- Case Management judge (prothonotary).
- Motion records?
- Security for costs required for impeachment.

Queen's Bench

- Parties to move along.
- Do you want case management?
- Do you want to expunge a patent or trade-mark?
- Is a provincial remedy all you need?

PATENTS



- Whatcha got?
- Read the Claims! *Free World Trust v. Électro Santé Inc.*, [2000 SCC 66 \(CanLII\)](#), [2000] 2 S.C.R. 1024; *Whirlpool Corp. v. Camco Inc.*, [10672000 SCC 67 \(CanLII\)](#), [2000] 2 S.C.R.
- No reference to extrinsic evidence.
- *Quadco Equipment Inc. v. Timberjack Inc.*, [2002 FCT 96 \(CanLII\)](#) to the Alberta summary trial rule (para 19).
- *Pallmann Maschinenfabrik G.m.b.H. Co. KG v. CAE Machinery Ltd.* (1995), 98 F.T.R. 125.

PATENTS *CONTINUED*



- Commercial embodiment is not the patent, and patent is not the commercial embodiment.
- Patent isn't what the inventor says it is. It is the monopoly provided by the claims.
- POSITA – Can assist the Court with construction of technical language in claims (but not hijack the process).
- *Eli Lilly and Company v. Teva Canada Limited*, [2011 FCA 220 \(CanLII\)](#).



National

Masterpiece Inc. v. Alavida Lifestyles Inc., [2011] 2 SCR 387, [2011 SCC 27 \(CanLII\)](#).

Jurisdictional limit to infringement no defence

Source Media Group Corp. v. Black Press Group Ltd., [2014 FC 1014 \(CanLII\)](#).

The test of confusion

- “A casual consumer somewhat in a hurry.”
- Valuation.

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- *Cinar Corporation v. Robinson*, [2013] 3 SCR 1168, [2013 SCC 73 \(CanLII\)](#).

What is substantial taking?

- *Geophysical Service Inc v Antrim Energy Inc*, [2015 ABQB 482 \(CanLII\)](#).

Alberta – Seismic data.

CONFIDENTIAL INFORMATION



- Likely s.96 Court – Federal Court jurisdiction doubtful.
- *Lac Minerals Ltd v International Corona Resources*, [1989 CanLII 34 \(SCC\)](#), [\[1989\] 2 SCR 574](#), [61 DLR \(4th\) 14](#).
- Springboard – What’s the value of early market entry.
- *Coco Clark* – Presumption of confidence.
- *Cadbury Schweppes Inc. v. FBI Foods Ltd.*, [1999] 1 SCR 142, [1999 CanLII 705 \(SCC\)](#) – Damages can be difficult to quantify.
- Do what you can: *Klewchuk v. Switzer*, [2003 ABCA 187 \(CanLII\)](#).

SUMMARY *SOME CLOSING THOUGHTS*



- Is it worth it?
- What forum? (And if you didn't choose it, are you stuck there?)
- Depending on whether your claim is defended, what relief do you want? Proof of damages? Stopping infringing acts? What about counterclaims/invalidation?
- If you're going the full litigation route, do you need experts? Get good ones early.

FOR MORE INFORMATION

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