

Intellectual Property

Canadian Government Ignites National Intellectual Property Strategy

In 2018, the Government of Canada launched a national Intellectual Property (IP) strategy intended to help Canadian businesses and innovators learn about and gain access to IP protection. The national IP strategy created various platforms that enable IP-focused conversations for many Canadian small and medium-sized enterprises (SMEs), which often overlook IP protection. This is a significant step in prioritizing the growth and protection of Canadian IP.

The national IP strategy sets out to address: (1) awareness, education, and advice, (2) strategic tools for growth, and (3) legislation changes to clarify practices associated with IP rights.

As part of the IP awareness campaign, the Canadian Intellectual Property Office (CIPO) generated significant online resources that include practical tools and materials to support innovators. The national IP strategy also granted funding for IP-focused legal clinics within Canadian law schools to offer access to basic IP advice.

Several new programs were also developed to offer funding to support Canadian SMEs and innovators in developing and implementing an IP strategy. These include:

- **IP Assist Program**, which is a tiered program targeting SMEs who qualify for support from the Industrial Research Assistance Program (IRAP). This program offers these SMEs access to direct IP education, planning, and action. The funding available for each of the planning stage and the action stage can range from \$18,000+. Although the funds from the IP Assist Program are not intended to cover IP filing and prosecution fees, this program has removed barriers to IP protection for many Canadian SMEs, and encourages IP-focused discussions to take place. Program participants are also able to select their preferred IP practitioners if they are already connected with one, or alternatively, they are assigned one by the program administrator.

- **Elevate IP** is a 4-year program set to begin later in 2023 to help accelerators and incubators provide start-ups with the tools for understanding and strategically managing their IP. The federal funding is allocated to specific incubators across Canada.

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Another new initiative is **ExploreIP**, which is a marketplace through which public sector institutions can offer licensing opportunities with respect to their IP. Commercialization of IP requires specialized experience and is often difficult for SMEs to access. ExploreIP offers institutions more commercialization opportunities by making the available IP more accessible. This not only helps foster and grow collaboration with public sector institutions, but also encourages public sector institutions to prioritize growth of their IP portfolio.

Provincially, there has been a similar push for IP awareness and growth. For example, **IP Ontario (IPON)** offers support to Ontario-based companies, including subsidizing costs relating to IP protection and commercialization services for up to \$25,000. The IPON funding can be used for limited IP filings. Initial applications for this program were opened to priority technology sectors: medical, automotive and artificial intelligence. Participants of IPON can choose to work with their preferred IP practitioner or select from a pre-screened roster of IP practitioners. IP is typically a federal concern and so, it is reassuring that IP is a priority even at the provincial level.

The increasing number of government programs is a positive movement towards growing, retaining, and commercializing Canadian IP. It is important for Canadian businesses to be aware of these opportunities and to maximize the value that these programs can add to their business.



Practice Area News

Excess Patent Claim Fees Introduced in Canada.

For any patent application for which examination was requested after October 3RD, 2022, excess claim fees will be payable for each additional claim in excess of 20. The fees payable are evaluated at the time examination is requested and again when the final fee is paid. The fees are determined based on the greatest number of claims presented since examination was requested – regardless of the total number of claims allowed.

Rules for non-French Trademarks in Quebec changed by Bill 96. Bill 96 amends several provisions of the *Charter of the French language (Charter)* related to the use of non-French trademarks in commercial advertising and public signage in Quebec. Previously, non-French trademarks could be used provided they were “recognized” (i.e. registered or unregistered) and a French registered version did not exist. Quebec’s businesses now have until June 1st, 2025 to comply with the *Charter* amendments or be exposed to hefty fines

Appeal of Federal Court’s Decision to Adopt 3-Step Patentable Subject-Matter Framework.

In early 2023, the appeal of *Benjamin Moore v Canada (2022 FC 923)* was heard. The Federal Court decision adopted a 3-step framework for evaluating patent-eligibility of computer-related inventions. The framework required purposive construction in accordance with well-established jurisprudence, contrary to the Patent Office guidance in recent years to follow “actual invention” and “problem-solution” approaches. The Court of Appeal decision is expected to be released in mid-2023.

Simplified Test for Accounting of Profits for Patent Infringement. In *Nova Chemicals Corp. (2022 SCC 43)*, the Supreme Court of Canada simplified the test for accounting of profits for patent infringement. Previously, courts applied different approaches to determine accounting of profits, which caused uncertainty. The simplified test involves calculating actual profits earned with the infringing product. If there is a non-infringing option, profits that could have been made with the non-infringing option are subtracted from the actual profits.

In the Firm

Awards and Accolades

- *Benchmark Litigation* - Recommended firm
- Chambers Global – Top ranked Litigation firm
- Chambers Global - Top ranked IP firm
- Chambers Canada – Top ranked IP firm



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