

# Summer Courses in Intellectual Property

PATENTS TRADE-MARKS COPYRIGHT

INTRODUCTORY AND ADVANCED  
2-DAY TO 5-DAY COURSES

AUGUST 2006

*Jointly sponsored  
by the  
Intellectual Property  
Institute of Canada  
and  
McGill University*



**IPIC**



**McGill**



# Summer Courses in Intellectual Property

Presented by

**INTELLECTUAL PROPERTY INSTITUTE OF CANADA**

and

**McGILL UNIVERSITY**

Since 1994, the Intellectual Property Institute of Canada and McGill University have gathered some of the **best practitioners in the field** to conduct a series of intensive, practical summer courses in intellectual property. More than 1000 professionals from the business, legal and public sectors have gained valuable insight and hands-on strategies by participating in our unique summer program. Our introductory and advanced courses are an excellent opportunity to **network with individuals from diverse backgrounds** who, like you, have an interest in Canadian intellectual property.

**Chart your individual course for success** by selecting a comprehensive course or a short, targeted module.

## **MONTREAL – MCGILL UNIVERSITY**

**Understanding Patents** AN INTRODUCTORY COURSE (July 31 - August 4, 2006)

MODULE 1 (2-DAY) – *The Beginning: Obtaining a Patent* (July 31 - August 1, 2006)

MODULE 2 (3-DAY) – *Exploiting IP Rights: A Worldwide Strategy for Attacking and Defending a Patent* (August 2-4, 2006)

**Understanding Trade-marks** AN INTRODUCTORY COURSE (August 7-11, 2006)

MODULE 1 (2-DAY) – *Basics of Canadian Trade-mark Procurement* (August 7-8, 2006)

MODULE 2 (3-DAY) – *Fundamentals of Trade-mark Management and Contentious Proceedings* (August 9-11, 2006)

**The Trade-marks Practitioner** AN ADVANCED COURSE (August 14-18, 2006)

MODULE 1 (2-DAY) – *Licensing and Current Topics in Trade-mark Law* (August 14-15, 2006)

MODULE 2 (3-DAY) – *Trade-mark Opposition and Litigation* (August 16-18, 2006)

## **TORONTO – HILTON TORONTO HOTEL**

**Understanding the Business of Copyright**

(August 21-23, 2006)



**IPIC**

 **McGill**

[www.ipic.ca](http://www.ipic.ca)

[www.cce.mcgill.ca/ip](http://www.cce.mcgill.ca/ip)

# Mark Your Calendar!

August 2006						
Sunday	Monday	Tuesday	Wednesday	Thursday	Friday	Saturday
	July 31	1	2	3	4	5
	<b>UNDERSTANDING PATENTS</b>					
	Module 1: The Beginning: Obtaining a Patent		Module 2: Exploiting IP Rights: A Worldwide Strategy for Attacking and Defending a Patent			
6	7	8	9	10	11	12
	<b>UNDERSTANDING TRADE-MARKS</b>					
	Module 1: Basics of Canadian Trade-mark Procurement		Module 2: Fundamentals of Trade-mark Management and Contentious Proceedings			
13	14	15	16	17	18	19
	<b>THE TRADE-MARKS PRACTITIONER</b>					
	Module 1: Licensing and Current Topics in Trade-mark Law		Module 2: Trade-mark Opposition and Litigation			
20	21	22	23	24	25	26
	<b>UNDERSTANDING THE BUSINESS OF COPYRIGHT</b>					
27	28	29	30	31		

## Spaces are Limited – Register Early!

Please fill out the enclosed registration form and submit it along with your payment and a photocopy of a piece of identification before June 16, 2006. Additional registration forms can be found on McGill University's website at [www.cce.mcgill.ca/ip](http://www.cce.mcgill.ca/ip). Registration will be accepted on a first-come, first-served basis. If you have missed the registration deadline, please contact us to inquire about remaining spaces at (514) 398-5454.

## Cancellation Policy

Written cancellations will be accepted until June 30, 2006 with a \$100 cancellation fee. No refunds will be issued after this date. Those who fail to attend are liable for the full course fee. Pre-approved substitutions will be permitted; please inform us at least 7 working days prior to the start of the course.

IPIC and McGill University reserve the right to cancel a course up to one month prior to the start of the course. They reserve the right to make changes to the program without prior notice.

# Understanding Patents



## AN INTRODUCTORY COURSE

Monday, July 31 to Friday, August 4, 2006

**MODULE 1 (2-DAY) THE BEGINNING: OBTAINING A PATENT (JULY 31 - AUGUST 1, 2006)**

**MODULE 2 (3-DAY) EXPLOITING IP RIGHTS: A WORLDWIDE STRATEGY FOR ATTACKING AND DEFENDING A PATENT (AUGUST 2-4, 2006)**

McGILL UNIVERSITY, MONTREAL, QC

## Get Into The Game – Improve Your Career Prospects

A five-day intensive, practical course divided in two modules, the first one, two-days long, provides an overview of patents and patenting, while the second module of three days completes the week and offers insights into the strategies relating to establishing and exploiting the patent system, as well as enforcing or attacking a patent.

## Who Should Attend

Understanding Patents is a must for engineers involved in patents and patenting, patent agents in training, new patent agents, lawyers (in-house or corporate counsel) and contract managers – anybody who encounters patents in their work and needs to have a better understanding of the nature and scope of the patent system, how patents are obtained, how to manage a patent portfolio.

*“As a patent agent trainee, I found the course very useful in providing a broad overview of patent drafting and prosecution in Canada as well as giving practical advice relating to strategizing and securing patent rights for clients.”*

MELANIE CARPENTIER, PH.D.

PATENT AGENT TRAINEE

GOUDREAU GAGE DUBUC

## Key Benefits

Lectures and workshops deal with the protection of inventions using the patent system, including the processes for obtaining and maintaining patents, in Canada and abroad. The theoretical and practical issues which will be addressed include:

Module 1:

- patents as an intellectual property right
- the nature of the patent right
- the patent system
- what can be patented
- understanding the patent document
- drafting patent applications and claims

Module 2:

- enforcing patents
- managing an international patent portfolio
- extracting value from patents in business

## MONDAY, JULY 31, 2006

### MODULE 1 – THE BEGINNING: OBTAINING A PATENT

- 8:30 OPENING REMARKS**  
Christian Cawthorn *Ogilvy Renault*  
Program Director  
Nathalie Rizcalla *Matrox Electronic Systems Ltd.*  
Assistant Program Director
- 8:50 PATENTS: AN OVERVIEW**  
Joan M. Van Zant *Ogilvy Renault*
- Patents as a form of intellectual property
  - What can be patented? Novelty, non-obviousness and subject-matter
  - Meeting the inventor and identifying the invention
  - Decisions to patent
- 10:15 PATENTABLE SUBJECT MATTER AND PATENT CLAIMS**  
John Bochnovic *Smart & Biggar/Fetherstonhaugh*  
Matthew Zischka *Smart & Biggar/Fetherstonhaugh*
- Proper subject matter for patents
  - Nature of patent grant
  - Drafting patent claims
  - Defining the invention
  - Types of claims
- 2:00 WORKSHOP: MEETING THE INVENTOR AND IDENTIFYING THE INVENTION**
- Role-playing
  - Group study: patent claims drafting
- 5:00 COCKTAIL RECEPTION**

## TUESDAY, AUGUST 1, 2006

### MODULE 1 – THE BEGINNING: OBTAINING A PATENT (cont'd)

- 8:30 FROM INVENTION TO PATENT: PART 1**  
James Anglehart *Bereskin & Parr*  
Joan M. Van Zant *Ogilvy Renault*
- Novelty searching
  - Indexing of patents
  - Patenting time line
  - Maintenance and renewal fees
- 10:30 FROM INVENTION TO PATENT: PART 2 – PREPARING AND PROSECUTING THE APPLICATION**  
Andrew Hicks *Hicks & Penman Ltd.*  
Michel Sofia *BCF*
- Need for utility, clarity, enabling description, abstract
  - Structure of patent specifications
  - Responding to Patent Office official actions
  - Amending applications and patents
  - Importance of time limits
  - Re-examination and reissue
- 2:00 WORKSHOP: PATENT OFFICE PROCEDURE AND RESPONSES TO PATENT OFFICE OFFICIAL ACTIONS**
- 7:30-9:30 CLAIMS DRAFTING (OPTIONAL)**

## WEDNESDAY, AUGUST 2, 2006

### MODULE 2 – EXPLOITING IP RIGHTS: A WORLDWIDE STRATEGY FOR ATTACKING AND DEFENDING A PATENT

- 8:30 INDUSTRIAL DESIGNS**  
**Robert Storey** *Bereskin & Parr*
- What is a design?
  - Registrable/unregistrable subject matter
  - Interface with patents and copyrights
  - Originality
  - Proprietorship
  - Application preparation
  - Prosecution
  - Enforcement
- 9:30 EXPLOITING IP RIGHTS**  
**Glen Tremblay** *Smart & Biggar/Fetherstonhaugh*
- Patents in contrast with other intellectual property rights
  - Confidentiality, trade secrets
  - Copyrights and trade-marks
  - Ownership of inventions; assignment and licensing
  - Additional considerations: anti-trust, export controls, working the invention, marking and compulsory licensing
- 10:45 PATENTS IN THE COMMERCIAL MILIEU**  
**Douglas McIntyre** *QNX Software Systems Ltd.*
- A practical, commercial perspective on intellectual property licensing
  - Negotiating licences: rights, returns, risks and responsibilities
  - Buying and selling businesses that depend on patent licences
- 2:00-5:00 WORKSHOP: SIMULATED PATENT LICENCE NEGOTIATION**
- 5:20-6:20 AN INVENTOR'S BUSINESS EXPERIENCE**  
**Paul Gallant** (*Wrebbit The Puzzle Innovators*)

## THURSDAY, AUGUST 3, 2006

### MODULE 2 – EXPLOITING IP RIGHTS: A WORLDWIDE STRATEGY FOR ATTACKING AND DEFENDING A PATENT (cont'd)

- 8:30 PATENTS WORLDWIDE: THE STRATEGY**  
**Stephen M. Beney** *Bereskin & Parr*  
**John R.S. Orange** *Blake, Cassels & Graydon*
- Assessment of similarities and differences between the various national and multi-national systems including Paris Convention
  - Patent Cooperation Treaty
  - European Patent Convention
  - U.S. system
  - Canadian system
- 10:30 PATENTS WORLDWIDE: THE COSTS AND VALUE**  
**John R.S. Orange** *Blake, Cassels & Graydon*  
**Danièle Ethier** *Virochem Pharma*
- Value and costs of obtaining, using and maintaining patents in various countries/communities
  - Managing patents as a corporate asset
- 12:15 STUDENT LUNCH**
- LUNCH SPEAKER – CHANGE AND CHALLENGE IN THE PATENT WORLD**  
**John R.S. Orange** *Blake, Cassels & Graydon*

- 2:00-5:00 WORKSHOP: STUDENTS WILL DEVELOP A FILING PROGRAM BASED ON AN ASSIGNED BUDGET, COST INFORMATION, DEMOGRAPHICS, ETC.**

## FRIDAY, AUGUST 4, 2006

### MODULE 2 – EXPLOITING IP RIGHTS: A WORLDWIDE STRATEGY FOR ATTACKING AND DEFENDING A PATENT (cont'd)

- 8:30 PATENT ENFORCEMENT: INFRINGEMENT**  
**Warren Sprigings** *Hitchman and Sprigings*  
**Douglas N. Deeth** *Deeth Williams Wall*
- Nature of infringing act
  - Importance of products of patented processes
  - Mechanical equivalents and means claims
  - Contributory infringement
  - Prior acquisition of invention
  - Alternative dispute resolution
  - Awards: damages and lost profits; reasonable royalty
  - Injunction: permanent and temporary
- 10:30 PATENT ENFORCEMENT: VALIDITY**  
**Douglas N. Deeth** *Deeth Williams Wall*  
**Gordon J. Zimmerman** *Borden Ladner Gervais*
- Anticipation
  - Obviousness
  - Claims broader than invention
  - Insufficient description
  - Inutility
- 2:00-5:00 WORKSHOP: A MOOT COURT WILL BE HELD BASED ON A CASE OF PATENT INFRINGEMENT**

#### FEES:

*An Introductory Course*  
JULY 31-AUGUST 4, 2006  
IPIC MEMBER \$2,100  
NON-MEMBER \$2,300

#### Module 1

JULY 31-AUGUST 1, 2006  
IPIC MEMBER \$1,000  
NON-MEMBER \$1,200

#### Module 2

AUGUST 2-4, 2006  
IPIC MEMBER \$1,400  
NON-MEMBER \$1,700

#### LOCATION:

MCGILL UNIVERSITY, MONTREAL

*"The McGill/IPIC course, Introduction to Patents, allowed me to consolidate my understanding of the patent system that I had acquired in private practice. In a week, we had reviewed the main topics of interest. I appreciated the fact that the presentations were made by knowledgeable persons in the field. During the course, I also had the opportunity to meet with people throughout Canada from different training backgrounds and career paths."*

MICHELINE AYOUB PH.D.

ROBIC

# Understanding Trade-marks

AN INTRODUCTORY COURSE

Monday, August 7 to Friday, August 11, 2006

MODULE 1 (2-DAY) BASICS OF CANADIAN TRADE-MARK PROCUREMENT (AUGUST 7-8, 2006)

MODULE 2 (3-DAY) FUNDAMENTALS OF TRADE-MARK MANAGEMENT AND CONTENTIOUS PROCEEDINGS (AUGUST 9-11, 2006)

McGILL UNIVERSITY, MONTREAL, QC

## Get Into The Game – Improve Your Career Prospects

A five-day intensive, practical course and modules that will cover Trade-mark procurement, management and contentious proceedings in Canada and abroad.

## Who Should Attend

An introduction to trade-mark law and practice for trade-mark agent trainees, trade-mark agents and lawyers, trade-mark portfolio managers, in-house corporate counsel, and advertising employees.

## Key Benefits

The lectures and workshops cover the theoretical and practical aspects of trade-mark procurement, trade-mark management and contentious proceedings. Although the focus is on Canada, comparative

reviews of trade-mark law and practice in the U.S. and Europe are provided. The issues addressed include:

- history of trade-marks and trade-mark use
- preparing trade-mark applications and responding to Examiners' Reports
- trade-mark searches and opinions
- selecting great trade-marks
- maintaining trade-mark registrations and managing trade-mark portfolios
- a corporate perspective on management and exploitation of trade-marks
- opposition proceedings
- overview of trade-mark litigation in Canada and the U.S.
- trade-mark procurement in the U.S., the European Community and via the international Madrid System

*"As trade-mark counsel for a large multinational U.S. company, I had some exposure to Canadian trade-mark issues over the years. When we decided to handle Canadian trade-mark matters in-house, I looked for a crash course with particular emphasis on practicing before the Canadian Intellectual Property Office. This course was just what I needed. The course was thorough, but precise, and provided many practical tips."*

TIMOTHY G. GORBATOFF

TRADE-MARK COUNSEL

GENERAL MOTORS CORPORATION

## MONDAY, AUGUST 7, 2006

### MODULE 1 – BASICS OF CANADIAN TRADE-MARK PROCUREMENT

- 8:30 OPENING REMARKS**  
Justine Wiebe Bereskin & Parr  
Program Director  
Jean-Nicolas Delage BCF  
Assistant Program Director
- 8:45 WHAT IS A TRADE-MARK/WHY A TRADE-MARK?**  
Sheldon Burshtein Blake, Cassels & Graydon
- Philosophy and history of trade-marks
  - Common law trade-marks
  - Interface with trade names
  - Purpose and advantages of registration
  - Interplay with copyright and industrial design
- 10:45 PREPARING TRADE-MARK APPLICATIONS AND USE AND REGISTRABILITY OPINIONS**  
Christian Bolduc Smart & Biggar/Fetherstonhaugh
- Introduction to the Trade-marks Office
  - Preparing and filing trade-mark applications
    - procedure and forms
    - information required in applications
    - bases of application and priority dates
    - registrability restrictions
  - Types of searches to assess availability of trade-marks for use & registration; risk factors; follow-up investigations.
- 1:45 PREPARING TRADE-MARK APPLICATIONS (cont'd)**
- 3:30 WORKSHOP: TRADE-MARK FILING STRATEGIES**  
Christian Bolduc Smart & Biggar/Fetherstonhaugh  
Justine Wiebe Bereskin & Parr  
Jean-Nicolas Delage BCF  
Marie-Josée Lapointe BCF  
Isabelle Jomphe Goudreau Gage Dubuc

5:00 COCKTAIL RECEPTION

## TUESDAY, AUGUST 8, 2006

### MODULE 1 – BASICS OF CANADIAN TRADE-MARK PROCUREMENT (cont'd)

- 8:30 CONCEPT OF USE**  
Sheldon Burshtein Blake, Cassels & Graydon
- Recap of Day 1
  - Concept of use (wares, services, export)
- 10:45 CONCEPT OF USE (cont'd)**
- 11:15 DIFFERENT TYPES OF APPLICATIONS, EXAMINERS' REPORTS AND RESPONSES, POST-ADVERTISEMENT MATTERS**  
Brigitte Chan Bereskin & Parr
- Special applications
    - certification marks
    - distinguishing guises
    - official marks
  - Amendments to applications
  - Examiners' Reports & responses
  - Other legislation affecting trade-marks
  - Voluntary withdrawal and abandonment
  - Extensions of time
  - Final Examiners' Reports
  - Appeal from Registrar's decisions
  - Advertisement & allowance
- 1:45 DIFFERENT TYPES OF APPLICATIONS (cont'd)**
- 3:15 WORKSHOP: RESPONDING TO EXAMINERS' REPORTS**  
Jean-Nicolas Delage BCF  
Isabelle Jomphe Goudreau Gage Dubuc  
Jean-François Nadon Robic  
Brigitte Chan Bereskin & Parr  
Marie-Josée Lapointe BCF  
Beth Trister Smart & Biggar/Fetherstonhaugh

## WEDNESDAY, AUGUST 9, 2006

### MODULE 2 – FUNDAMENTALS OF TRADE-MARK MANAGEMENT AND CONTENTIOUS PROCEEDINGS

#### 8:30 LIFE AFTER REGISTRATION

**Jonathan Colombo** *Bereskin & Parr*

- Term of registration
- Renewal & maintenance
- Guidelines to proper use and marking
- Summary cancellation due to non-use
- Expungement based on invalidity
- Amendments and extensions to registrations
- Assignments
- License agreements & security interest agreements
- Policing & other diligent steps

#### 10:30 SELECTING GREAT TRADE-MARKS

**Jean-Nicolas Delage** *BCF*

- Legal considerations
  - spectrum of inherent distinctiveness
  - acquired distinctiveness
  - notion of confusion - relevance of third party marks on the register and in the marketplace
- Marketing considerations
  - visual impact
  - aural impact
  - significance of trade-mark in other languages/cultures
- Impact of foregoing on searching, protection, exploitation, and enforcement

#### 11:30 CORPORATE PERSPECTIVE

**Pascale Mercier** *BCE Intellectual Property Group*

- Dealing with outside counsel
- Searching and filing strategies
- Management and exploitation of trade-mark portfolios
- Educating the in-house marketing department about proper trade-mark use
- Use of opposition & other proceedings as a corporate strategy

#### 1:45 TRADE-MARKS AND DOMAIN NAMES: TWO SIDES OF THE SAME COIN?

**Michael Erdle** *Deeth Williams Wall*

- Domain names versus trade-marks
- Conflicts & solutions
- Domain name dispute resolution procedures
- New international dispute resolution initiatives
- Overview of case-law involving conflict between domain names and trade-marks

#### 3:15 WORKSHOP: TRADE-MARK SEARCHES AND RISK ASSESSMENTS

**Justine Wiebe** *Bereskin & Parr*

**Jean-Nicolas Delage** *BCF*

**Marie-Josée Lapointe** *BCF*

**Stella Syrianos** *Robic*

**Brigitte Chan** *Bereskin & Parr*

**Beth Trister** *Smart & Biggar/Fetherstonhaugh*

extensions

- Why oppose?
- Length of oppositions, costs, & tactics
- Options for settlement

#### 1:15 OPPOSITION PROCEEDINGS (cont'd)

#### 2:30 WORKSHOP: TIPS AND STRATEGIES IN OPPOSITION PROCEEDINGS

**Philip Lapin** *Smart & Biggar/Fetherstonhaugh*

**Christian Bolduc** *Smart & Biggar/Fetherstonhaugh*

*Fetherstonhaugh*

**Justine Wiebe** *Bereskin & Parr*

**Jean-Nicolas Delage** *BCF*

**Pascal Lauzon** *BCF*

**Laurent Carrière** *Robic*

## FRIDAY, AUGUST 11, 2006

### MODULE 2 – FUNDAMENTALS OF TRADE-MARK MANAGEMENT AND CONTENTIOUS PROCEEDINGS (cont'd)

#### 8:00 U.S. AND CANADIAN TRADE-MARK PROSECUTION: A COMPARATIVE ANALYSIS

**Michael Lasky** *Altera Law Group*

- Preparation and filing of U.S. applications
  - different types of applications
  - classification of goods & services and class fees
- U.S.P.T.O. procedures
- Brief overview of opposition & cancellation proceedings
- U.S. trade-mark searching – special issues
- Post registration issues
- Assignments

#### 10:00 THE COMMUNITY TRADE-MARK AND THE MADRID PROTOCOL

**Mark Hiddleston** *Elkington & Fife*

- Filing strategies: an overview of the CTM, Madrid (international), and national filing systems
  - differences between the CTM and the Madrid Protocol systems, including advantages and disadvantages
- Registration and post-registration issues; enforcement

#### 2:00 OVERVIEW OF TRADE-MARK LITIGATION IN CANADA – INFRINGEMENT, PASSING OFF AND DEPRECIATION OF GOODWILL

**Hughes Richard** *Robic*

- Jurisdiction: federal vs. provincial courts
- Key causes of action
- Remedies
- Defences

#### 3:45 TRADE-MARK LITIGATION IN THE U.S. – WHAT CANADIAN PRACTITIONERS NEED TO KNOW

**Douglas Rettew** *Finnegan Henderson Farabow*

*Garrett and Dunner*

- An overview of trade-mark litigation in the U.S.
- Tips on strategies and precautions

#### FEES:

*An Introductory Course*

AUGUST 7-11, 2006

IPIC MEMBER \$2,100

NON-MEMBER \$2,300

#### Module 1

AUGUST 7-8, 2006

IPIC MEMBER \$1,000

NON-MEMBER \$1,200

#### Module 2

AUGUST 9-11, 2006

IPIC MEMBER \$1,400

NON-MEMBER \$1,700

#### LOCATION:

MCGILL UNIVERSITY, MONTREAL

*"I found the course to be excellent! The material was easy to understand and well presented by very knowledgeable instructors. An invaluable asset for anybody starting in the trade-mark field – I would highly recommend it."*

COLLEEN CAISSIE-DUPUIS

TRADE-MARK PARALEGAL

SPIELO (A GTECH COMPANY)

## THURSDAY, AUGUST 10, 2006

### MODULE 2 – FUNDAMENTALS OF TRADE-MARK MANAGEMENT AND CONTENTIOUS PROCEEDINGS (cont'd)

#### 8:30 OPPOSITION PROCEEDINGS: OVERVIEW AND CONTEXT

**Philip Lapin** *Smart & Biggar/Fetherstonhaugh*

- Context (advertisement and prescribed opposition deadline)
- Procedures & steps
- Extensions of time including retroactive

# The Trade-marks Practitioner



AN ADVANCED COURSE

Monday, August 14 to Friday, August 18, 2006

MODULE 1 (2-DAY) LICENSING AND CURRENT TOPICS IN TRADE-MARK LAW (AUGUST 14-15, 2006)

MODULE 2 (3-DAY) TRADE-MARK OPPOSITION AND LITIGATION (AUGUST 16-18, 2006)

McGILL UNIVERSITY, MONTREAL, QC

## Get Into The Game – Improve Your Career Prospects

A five-day, intensive, practical, hands-on course and modules. The Trade-marks Practitioner offers you the opportunity to attend a mock cross-examination and a mock oral hearing with experienced practitioners, including the former Chairman of the Trade-mark Opposition Board and a Federal Court Judge.

## Who Should Attend

A must for anyone working at the leading edge of the trade-mark field. The Trade-marks Practitioner is designed specifically for experienced trade-mark agents, in-house trade-mark managers, in-house counsels, and lawyers who specialize in the

trade-mark area, whether in private or corporate practice, with at least 3 to 5 years experience in the area of trade-mark law.

## Key Benefits

This course addresses advanced issues that are faced by the trade-mark practitioner on a regular basis. Some of the important topics examined include:

- all aspects of licence agreements (Module 1)
- opposition and summary expungement proceedings (Module 2)
- factual and expert evidence (Module 2)
- affidavit evidence (Module 2)
- cross examinations and written submissions (Module 2)

*“Trade-marks II exceeded all my expectations, from the course materials to the speakers. Whether you have been working in the field of trade-marks for three years or ten years, I highly recommend this course.”*

TANYA REITZEL

TRADE-MARK AGENT

COASTAL TRADE-MARK SERVICES

## MONDAY, AUGUST 14, 2006

### MODULE 1 – LICENSING AND CURRENT TOPICS IN TRADE-MARK LAW

- 8:30 OPENING REMARKS**  
**Paul William Donovan** Gibson & MacLaren  
Program Director  
**Allison Huff** Fasken Martineau DuMoulin  
Assistant Program Director
- 8:45 HISTORY & PURPOSE OF LICENSE**  
**Lee Webster Osler, Hoskin & Harcourt**  
**Frank Politano** AT&T Corp.  
▪ Overview of history of licensing  
▪ Requirements of the Trade-marks Act
- 9:45 SPECIFICS ABOUT TERMS AND CONDITIONS AND NEGOTIATING AND STRUCTURING LICENSE**  
**Lee Webster Osler, Hoskin & Harcourt**  
**Frank Politano** AT&T Corp.  
▪ Defining the licensing rights  
▪ Exclusive, non-exclusive, sole license  
▪ Specific provisions  
▪ Negotiation strategies  
▪ Post-licensing issues  
▪ Remedies and enforcement
- 10:45 SPECIFICS ABOUT TERMS AND CONDITIONS AND NEGOTIATING AND STRUCTURING LICENSE (cont'd)**  
**Lee Webster Osler, Hoskin & Harcourt**  
**Frank Politano** AT&T Corp.  
▪ Negotiating strategies  
▪ Anticipating post-licensing issues, such as additional trade-marks, bankruptcy, remedies and enforcement
- 1:15 SPECIFICS ABOUT TERMS AND CONDITIONS AND NEGOTIATING AND STRUCTURING LICENSE (cont'd)**

### 3:00 INTERACTIVE WORKSHOP ON LICENSING NEGOTIATIONS

**Annie Gauthier** Ogilvy Renault  
**Lee Webster Osler, Hoskin & Harcourt**  
**Frank Politano** AT&T Corp.  
**Marie Mandeville** McGill University

- Points of view of both the licensee and licensor
- Assess the issues, recommend the fairest position or compromise

### 6:00 COCKTAIL RECEPTION

## TUESDAY, AUGUST 15, 2006

### MODULE 1 – LICENSING AND CURRENT TOPICS IN TRADE-MARK LAW (cont'd)

- 8:30 INTERPLAY OF TRADE-MARKS, DOMAIN NAMES AND THE INTERNET**  
**R. Scott MacKendrick** Ogilvy Renault  
▪ Understanding the jargon  
▪ Passive and active web sites  
▪ Cybersquatting and other infringing activities  
▪ Domain name registration  
▪ Dispute resolution using ICANN and CIRA
- 10:15 INTERACTIVE COMPARATIVE DISCUSSION OF U.S. AND CANADIAN TRADE-MARK PROSECUTION PRACTICE**  
**Kimberley Brûlé** Ridout & Maybee  
**Joseph T. Nabor** Fitch, Even, Tabin & Flannery  
▪ Searching  
▪ Preparation and filing of different types of applications  
▪ U.S. Patent and Trademark Office fees and procedures  
▪ Overview of opposition and cancellation proceedings  
▪ Post-registration issues  
▪ Interacting with U.S. counsel  
▪ Question and answer period

**12:00** **A REVIEW OF THE MADRID PROTOCOL FROM A U.S. PERSPECTIVE**  
*Joseph T. Nabor Fitch, Even, Tabin & Flannery*

**2:00** **NON-CONVENTIONAL TRADE-MARKS**  
*Colleen Morrison Marks & Clerk*  
*Gary Partington Marks & Clerk*

- Distinguishing guise
- Two & three-dimensional marks
- Colour
- Animated moving-image marks
- Sounds and scents
- Official marks
- Famous marks

**1:30** **MOCK CROSS-EXAMINATION OF AFFIANT ON EVIDENCE FILED**  
*Robert MacDonald Gowling Lafleur Henderson*  
*Gordon Zimmerman Borden Ladner Gervais*  
*Robert Gould Smart & Biggar/Fetherstonhaugh*

- The good, the bad and all that

**3:15-6:00** **MOCK ORAL HEARING**  
*Robert MacDonald Gowling Lafleur Henderson*  
*Gordon Zimmerman Borden Ladner Gervais*  
*Gary Partington Marks & Clerk*

- Oral submissions by experienced practitioners
- Comments from the former Chairman – Trade-marks Opposition Board

## WEDNESDAY, AUGUST 16, 2006

### MODULE 2 – TRADE-MARK OPPOSITION AND LITIGATION

**8:30** **DIFFICULTIES IN OPPOSITION PROCEEDINGS AND PREPARATION OF EVIDENCE**  
*Cynthia Rowden Bereskin & Parr*

- Review of opposition proceedings
- Advanced issues of pleading
- Evidentiary issues
- Practical issues in drafting affidavits

**10:45** **EXPERT EVIDENCE**  
*David Wotherspoon Fasken Martineau DuMoulin*

- Selection and use of expert evidence in oppositions, cancellation proceedings and litigation

**1:30** **REVIEW OF SECTION 45 PROCEEDINGS – PROVING USE OR NON-USE OF A TRADE-MARK**  
*Cynthia Rowden Bereskin & Parr*

- Review of Section 45 proceedings
- Comparison of Section 45 and abandonment issues
- Evidentiary requirements in Section 45 cases

**3:45-6:00** **WORKSHOP ON OPPOSITION PROCEEDINGS**  
*Cynthia Rowden Bereskin & Parr*  
*Gary Partington Marks & Clerk*

- Drafting affidavit evidence in opposition and Section 45 proceedings
- Question and answer forum with the former Chairman – Trade-marks Opposition Board

## THURSDAY, AUGUST 17, 2006

### MODULE 2 – TRADE-MARK OPPOSITION AND LITIGATION (cont'd)

**8:30** **CROSS-EXAMINATIONS**  
*Robert MacDonald Gowling Lafleur Henderson*  
*Gordon Zimmerman Borden Ladner Gervais*

- To cross-examine or not
- Scope of cross-examination
- Preparation
- Do's and don'ts

**9:30** **WRITTEN SUBMISSIONS**  
*Robert Gould Smart & Biggar/Fetherstonhaugh*

- Format and content
- Typical submissions
- Practical examples

**10:45** **PREPARATION FOR ORAL HEARING**  
*Robert Gould Smart & Biggar/Fetherstonhaugh*

- When is a hearing appropriate
- Preparation and participation

## FRIDAY, AUGUST 18, 2006

### MODULE 2 – TRADE-MARK OPPOSITION AND LITIGATION (cont'd)

**8:30** **APPEAL OF DECISIONS IN SECTION 45 PROCEEDINGS, OPPOSITION PROCEEDINGS AND PROSECUTION**  
*Mr. Justice Roger T. Hughes*  
*Federal Court of Canada*

- Procedures and evidence in appeal from Trade-marks office decisions after prosecution, Section 45 decisions and opposition proceedings decisions

**9:30** **INFRINGEMENT AND REMEDIES**  
*Mr. Justice Roger T. Hughes*  
*Federal Court of Canada*

- What constitutes infringement
- Defences to an infringement action
- Passing off
- Defences to a passing off action
- Remedies
- Grey marketing

**11:00** **PRACTICAL APPROACH TO CO-EXISTENCE AND OTHER SETTLEMENT AGREEMENTS**  
*Daniel Drapeau Ogilvy Renault*

- Should we settle?
- Assessing strengths and weaknesses
- Developing strategies and considering alternatives
- Review of agreement
- Avoiding the pitfalls

**2:00** **MOCK TRIAL WITH ORAL TESTIMONY**  
*Madam Justice Elizabeth Heneghan*  
*Federal Court of Canada*  
*François Guay Smart & Biggar/Fetherstonhaugh*  
*Glen Bloom Osler, Hoskin & Harcourt*

- Court dramatization
- Attorneys conduct examination, cross-examination and make submissions
- Comments from the Judge

#### FEES:

*An Advanced Course*  
**AUGUST 14-18, 2006**  
IPIC MEMBER \$2,100  
NON-MEMBER \$2,300

*Module 1*  
**AUGUST 14-15, 2006**  
IPIC MEMBER \$1,000  
NON-MEMBER \$1,200

*Module 2*  
**AUGUST 16-18, 2006**  
IPIC MEMBER \$1,400  
NON-MEMBER \$1,700

#### LOCATION:

MCGILL UNIVERSITY, MONTREAL

*“The topics covered and the expert speakers are an amazing opportunity to delve into trade-marks on a deep level. The course is outstanding as a great learning experience and helps to reinforce important concepts in trade-mark law as well as to explore current trade-mark topics relevant to anyone working in the field.”*

KELLEY RYSHAK

PARALEGAL

CREO INC.

# Understanding the Business of Copyright

Monday, August 21 to Wednesday, August 23, 2006

HILTON TORONTO HOTEL, TORONTO, ON

## Get Into The Game – Improve Your Career Prospects

A 3-day intensive course with a practical focus which provides not only an overview of the legal principles needed to address copyright issues but also insight into the practical side of publishing, film and television production, music, and computer programs.

## Who Should Attend

A must for all who work in the copyright field. Understanding the Business of Copyright is intended for business managers and in-house counsel working in the publishing, music, information technology, broadcasting, film/TV and performing arts; lawyers and trade-mark agents; licensing executives; government policy-makers; academics and librarians.

## Key Benefits

The lectures and workshops of this course cover the theoretical and practical fundamentals of copyright including originality, fair dealing, computer programs and the Internet. Among the other issues to be addressed are:

- Supreme Court's decisions
- economic rights v. authors' rights
- identifying authors, owners and infringers
- exploiting copyright in business
- dealing with collectives & the Copyright Board
- U.S. & Canadian law contrasted

*"A great source for continuing education on Copyright. Perfect for any career, from young lawyer to seasoned executive; whether you are starting out in Copyright or updating your knowledge."*

PAULA CLANCY

ASSOCIATE

GOWLING LAFLEUR HENDERSON

## MONDAY, AUGUST 21, 2006

- 8:15 OPENING REMARKS**  
**Christine Collard** *Borden Ladner Gervais*  
*Program Director*  
**Ruth Corbin** *Corbin Partners Inc.*  
*Assistant Program Director*
- 8:30 SETTING THE STAGE**  
**Christine Collard** *Borden Ladner Gervais*
- Main themes of copyright
  - Pressures caused by technology advances
  - Are user's rights being ignored?
  - Does reliance on anti-copying technology threaten the public domain?
- 9:00 PAST, PRESENT AND FUTURE OF COPYRIGHT**  
**Giuseppina D'Agostino**  
*Copyright Policy Branch – Ministry of Canadian Heritage*
- History of copyright
  - Developments affecting copyright protection
  - Updating the Copyright Act
- 10:15 WHAT WORKS ARE PROTECTED**  
**Jill Jarvis-Tonus** *Bereskin & Parr*
- Traditional categories of works
  - Unprotected works (unexpressed ideas)
  - Fixation
- 11:15 EXEMPT ACTIVITIES**  
**Diane Cornish** *Osler, Hoskin & Harcourt*
- Research, study, criticism, reviews, news
  - Educational institutions
  - Libraries, archives & museums
  - Parodies
  - Comparison with fair use in U.S.

- 1:15 EXCLUSIVE RIGHTS**  
**Ron Dimock** *Dimock Stratton*
- Basic components of economic rights: produce, reproduce, perform, publish, authorize
  - Subsidiary rights
- 2:15 AUTHORSHIP AND OWNERSHIP**  
**Daniel Drapeau** *Ogilvy Renault*
- Presumption of ownership
  - Meaning of term "author"
  - Collective works and compilations
  - Works of joint ownership
  - Contracts of service
  - Terms of protection
  - Crown copyrights
  - Photographs, engravings and portraits
- 3:30 FOCUS ON THE PUBLISHING INDUSTRY**  
**Kim McArthur** *President & Publisher McArthur and Company Publishing Ltd.*
- How does copyright generate revenue in a book publishing?
  - Discussion of re-occurring copyright problems/issues
  - Business of publishing
- 4:30 COCKTAIL RECEPTION**

## TUESDAY, AUGUST 22, 2006

### 8:30 TERMS AND FORMALITIES

**Peter Wells** *Lang Michener*

- General term rule
- Special rules for certain types of works
- Reversionary interests
- Registration of copyright
- Comparison with U.S. law

### 9:30 ASSIGNMENT AND LICENSING

**David Ayles** *Gowling Lafleur Henderson*

- Necessity for writing
- Implied assignment/licensing
- Recordal of assignments and licences
- Compulsory licences
- Unlocatable owners
- Security agreements

### 11:00 PRIMARY AND SECONDARY INFRINGEMENT

**Hugues Richard** *Robic*

- Specific acts of infringement
- Who is an infringer?
- Unconscious copying
- Indirect copying
- Meaning of "substantial art"
- In-depth discussion of Section 27 (2)
- Innocent infringers

### 1:30 THE COPYRIGHT BOARD OF CANADA

**Sylvie Charron** *Copyright Board Member*

- Copyright Board: mandate, structure, hearings and procedure
- Collective administration of copyright
- Special regimes: retransmission, private copying

### 2:30 INDUSTRY CANADA

**Albert Cloutier** *Acting Director  
Intellectual Property Policy Directorate,  
Industry Canada*

- Developments affecting copyright policy
- Implications of policy changes

### 3:30 ENFORCEMENT

**Mark Evans** *Smart & Biggar/Fetherstonhaugh*

- Interlocutory injunctions
- Anton Piller orders
- Injunctions
- Damages and profits
- Detention of imported copies by customs
- Enforcement of criminal provisions

### 4:30 FOREIGN ISSUES

**Jean-Philippe Mikus** *Fasken Martineau  
DuMoulin*

- The main treaties and their implications for copyright owners
- Management of cross border protection
- Emerging issues

- Probability of successful creation of IP with market potential; potential value to users of IP; share of value to be received; discount rate
- Bargaining advantage – owner of copyright or intermediary?

### 9:30 COPYRIGHT VALUATION WORKSHOP

**Dr. Fred Lazar** *Schulich School of Business  
York University*

**Dr. Ruth Corbin** *CEO & Managing Partner  
Corbin Partners Inc.*

- Hands on workshop in identifying market factors and sources of value that affect tariff setting, licensing, merger negotiations & litigation damages

### 11:00 FOCUS ON THE MUSIC INDUSTRY

**Paul Spurgeon** *Head Counsel, Society of  
Composers, Authors and Music Publishers  
of Canada*

- Music industry issues
- Approach to tariff setting and valuation
- Technological innovations including podcasting
- Lessons for other media
- Practical advice

### 12:00 LUNCH SPEAKER PERSPECTIVE FROM THE CHAIR

**Mr. Justice William J. Vancise** *Chairman  
The Copyright Board of Canada*

### 2:00 FINE ART COPYRIGHT

**Aaron Milrad** *Fraser Milner Casgrain*

- The special world of fine art
- Artists' rights and Art's rights
- Emerging issues for protection and litigation
- Practical advice

### 3:00 MORAL RIGHTS AND PERFORMERS' RIGHTS

**Aaron Milrad** *Fraser Milner Casgrain*

- Identifying and balancing issues of moral rights
- Performers' rights in the digital era

### 4:15 FOCUS ON COMPUTER PROGRAMS

**Sunny Handa** *McGill University / Blake, Cassels  
& Graydon*

- Application of substantive areas of copyright law to computer programs
- Tests for non-literal element infringement
- Understanding source code, data files and structures

#### FEES:

*Understanding Copyright*

AUGUST 21-23, 2006

IPIC MEMBER \$1,400

NON-MEMBER \$1,700

#### LOCATION:

TORONTO HILTON HOTEL,  
TORONTO

## WEDNESDAY, AUGUST 23, 2006

### 8:30 COPYRIGHT VALUATION

**Dr. Ruth Corbin** *CEO & Managing Partner  
Corbin Partners Inc.*

**Dr. Fred Lazar** *Schulich School of Business  
York University*

- Where to start in determining value to owner of copyright
- Protecting IP to create incentives for individuals to invest time and money to create new IP

**PATENTS TRADE-MARKS COPYRIGHT**

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