Examination Identification Number: _________

FACULTY OF LAW

LAW 518: B2 — INTELLECTUAL PROPERTY (PROF. RENKE)
FINAL EXAMINATION - APRIL 28, 2003

Time Allotted: Three hours (180 minutes) plus 15 minutes reading time.

Code Number: DO NOT ENTER YOUR NAME ON ANY ANSWER SHEETS OR BOOKLETS. A list shall be circulated and your name is to be entered opposite a number on that sheet. That number shall be your codenumber FOR THIS EXAMINATION ONLY and should be entered on THIS EXAMINATION in the space provided above. Following these procedures will ensure anonymity during marking.

Special Instructions: 1. This examination consists of 23 questions on 36 pages (including this page). Check to ensure that the examination is complete before starting.

2. Answer ALL questions and parts of questions. READ ALL INSTRUCTIONS IN QUESTIONS. IN YOUR RESPONSES, REFER TO ALL PERTINENT CASES AND STATUTES.

3. This is a CLOSED BOOK examination, except that you may use an unannotated Consolidated Intellectual Property Statutes and Regulations.

4. The examination is graded out of 100 marks, and is worth 70% of the marks for your final grade. This examination is “fail-safe” (if the percentage scored on this examination is higher than the percentage on your mid-term examination, then only the mark for this examination will be used for the calculation of your final grade; if the mark for this examination is lower than the mark for your mid-term examination, then this examination is worth 70% of the marks for your final grade).

5. Do not make up facts.

6. Write legibly.

7. Adhere to the time limitation imposed on this examination strictly. Failure to do so may lead to a reduction of grade or a refusal to accept the examination paper.

8. To avoid disrupting students finishing the examination, no person shall leave the examination room during the last 15 minutes of the examination period.

9. Times for responses to questions are SUGGESTIONS ONLY.

10. Write your answers in the spaces provided in THIS EXAMINATION. Feel free to write on backs of pages, or in examination booklets, if you require more space.
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TOTAL/100

midterm: 
midterm + final:  
GRADE:
Suggested Time for Questions 1, 2, and 3: 15 Minutes Total

(3) 1. Which Cabinet Minister/Ministers is/are responsible for copyright matters? Does this arrangement make sense? Why or why not? Explain. Do not provide the Minister or Ministers’ personal name or names.
(2) 2. Besides extending convention standards to an extended group of nations, what is the main advantage in bringing intellectual property rules within international trade agreements, such as NAFTA and TRIPs?

(3) 3. An inventor has developed a “super dog.” The inventor modified some genetic material and injected it into a fertilized bloodhound egg. The resulting hound, and all of its offspring, have a highly heightened sense of smell. The hounds’ ability to track persons (e.g. in search and rescue or criminal pursuit contexts) has been greatly enhanced. Assuming that the “super dog” would satisfy the other criteria for patentability, could the “super dog” (not the process of producing it) be a potentially patentable “composition of matter” under current Canadian law? Why or why not? Explain.
Dr. Yu, a full professor appointed to the Faculty of Agriculture, Forestry, and Home Economics of the University of Alberta (the “University”), has developed an edible product known as the “Thermo Bar.” It looks and tastes like a chocolate bar. Its active ingredients are chocolate, honey, and the palemino bean – all naturally occurring, common substances. Through experimentation, Dr. Yu established that if these ingredients are mixed in certain precise proportions, they have a “thermogenic” effect for persons who consume the bars – they cause consumers to metabolize (burn) stored bodily fat quickly, and not to burn carbohydrates or proteins. This metabolic effect allows consumers to stay warm in cold environments, and enhances their physical performance in high-intensity sports. Dr. Yu’s research leading to the Thermo Bar was done as part of her duties as an academic staff member at the University using University equipment and involving other University staff and students. She was not hired by the University to create thermogenics generally or a thermogenic bar in particular. It was her choice to do research respecting thermogenics. The University does not have a “research and development” department, as may be found in large private corporations.

(4) 4. Assuming that the “Thermo Bar” is an “invention” and that the research funding arrangements contained no relevant provisions,

(a) does the Patent Act provide guidance respecting the ownership of the invention?

(b) what sorts of inquiries should you make to determine the ownership of the invention?

Explain.
(3)  5. Assume that the “Thermo Bar” is an invention and that Dr. Yu owns that invention. Dr. Yu has not yet applied for a Canadian patent for the Thermo Bar. She wishes to publish a paper concerning the biochemistry of the bar in a well-known, well-read, and respected Canadian scientific journal. **What advice should you provide to Dr. Yu respecting Canadian patent law? Explain.**
6. There is a significant literature about “thermogenics” and there are many “thermogenic” products. While ordinary persons and scientists have known about the substances for centuries, no one had previously thought to use chocolate, honey, and the palemino bean together as a thermogenic. **On the basis of this and the preceding information (limited as it is!), is the Thermo Bar patentable? Why or why not? Explain.**
The following facts apply to Questions 7 - 9

The Alberta Paralegal Association (the “APA”) is a self-regulated professional body, constituted under the Alberta Societies Act. It requested the Registrar of Trade-marks to give public notice that the APA has adopted and used as official marks for services the words “paralegal” and “legal technician”, and the Registrar gave this public notice in the Trade-marks Journal on January 7, 2003. The Law Society of Alberta (the “LSA”) wishes to challenge the Registrar’s decision to give public notice.

(2) 7. What remedy, if any, is available to the LSA to challenge the Registrar’s decision? Explain. Assume that any remedy would not be time-barred.

(2) 8. What is the test for determining whether the APA is a “public authority” within the meaning of s. 9 of the Trade-marks Act? Do not apply the test to the APA.
(5) 9. Assume that the LSA’s challenge of the Registrar’s decision was unsuccessful and that no other person has challenged or will challenge the Registrar’s decision. “Ticket Busters” (“TB”) is an incorporated Edmonton firm of non-lawyers who act as agents for persons charged with traffic offences in Provincial Court. It has carried on business in Alberta since 1999. It describes its services in its advertisements as “paralegal” services.

(a) Will TB be entitled to continue to use the term “paralegal” to describe its services after January 7, 2003?

(b) If TB applied to register the words “Ticket Busters Paralegal Services” as a trademark, would the APA have any basis for opposition (on the basis of the limited facts only)?

(c) If the APA did oppose TB’s application for registration, should TB seek to establish that the APA does not provide any litigation or court-related services to the public, and that the APA’s services are provided only to members of the APA?

Explain.
(6) 10. True story: Molson Canada, a Canadian corporation that manufactures and sells beer, owns the following registered trade-mark (TMA 123687): “Molson’s Canadian Lager Beer” (the “Mark”). Note: “lager” is a type of beer, distinguished from “ale,” the other main type of beer.

(a) “Molson” is a surname. Does its use in the Mark pose difficulties for the registrability of the Mark? Why or why not?

(b) Could the single word “Molson” or “Molson’s” be registered as a trade-mark for use in association with beer and sales of beer? What, if anything, would have to be established to support registration?

(c) What features of the Mark might impede or prevent its registration? How might the difficulties posed by those features of the Mark be addressed, so that it could be registered?
(6) 11. Molson Canada (“Molson”, described in the preceding question) has developed a series of television advertisements, aimed at the Law Student market. The ad’s concern “blind taste tests” in which students at various Law Schools across this great country try two different mystery beers, and loudly proclaim that they prefer the beer subsequently identified as “Molson Canadian”, as opposed to the other beer tested, subsequently identified as “Labatt’s Blue.” Labatt Brewing Company Limited, a Canadian corporation (“Labatt’s”) owns the registered trade-mark “Labatt’s Blue”, used in association with beer and the sale of beer. Has Molson violated s. 19 or s. 22 of the Trade-marks Act through the reference to Labatt’s trade-mark in the ad’s? Explain. Assume that Labatt’s has admissible evidence that establishes both the goodwill attached to the “Labatt’s Blue” mark and the financial losses Labatt’s has sustained as a result of this particular ad campaign.
(15) 12. 1234 Alberta Ltd. ("AltaCo") is a corporation incorporated under the Alberta Business Corporations Act. It has carried on the furniture moving business under the name “Metallica Movers” in Edmonton, Alberta, since June 2002. The three principals of AltaCo are fans of the musical group “Metallica”, and wanted their business to bear the name of their favourite band. AltaCo advertises its services mainly on Edmonton FM radio stations that play metal and classic rock and on the U of A’s CJSR radio station. AltaCo has sought to corner the niche market in student and younger adult moving clients. The principals of AltaCo believe that their business name will assist in attracting these customers – the name “Metallica,” they believe, has significant “drawing power” for future clients. AltaCo has applied to register the words “Metallica Movers” as a trade-mark used in association with furniture moving services. AltaCo sells no wares except cardboard boxes used for moving. No other firm uses the term “Metallica” in association with moving services.

The musical group “Metallica” (the “Band” – a “California General Partnership”), however, registered the name “Metallica” as a trade-mark under the Trade-marks Act in 1996 [this is true]. This mark has been used in Canada since 1982. The “Metallica” mark is registered for use in relation to a variety of goods or wares (but not cardboard boxes), and in association with entertainment services, including live musical performances. Assume that this registration is valid and unchallengeable.

AltaCo’s application was advertised, and the Band duly filed an opposition, alleging that AltaCo’s mark was “confusing” with its own trade-mark. Assume that you are the individual acting as the “Trade-marks Opposition Board”, that the application conformed with the s. 30 requirements, that all appropriate procedural steps were taken, and that the foregoing facts were established in the hearing. Should AltaCo’s application be rejected or should the Band’s opposition be rejected? Explain. Be sure to set out all the steps of your argument.
The following facts apply to Questions 13 - 23

*Suggested Time for Questions 13 - 18: 35 Minutes*

Spike is a Ph. D. candidate with the Faculty of Arts, University of Alberta (the “University”); he is in the Film Studies program. Spike’s Ph. D. dissertation concerns “the fabrication of the physical appearance of the American male through the movies of Howard Hawks.” Hawks, a famous director, died in 1977. Spike is particularly concerned with five Hawks’ movies (film dramas) starring John Wayne (the “Movies”). Spike wishes to reproduce “stills” (particular photographic frames) of the Movies in his dissertation (the “Stills”); he intends to comment on the Stills in the text of the dissertation, describing how the elements of the Stills contributed to the social construction of the male body image. He wishes to use about 50 Stills from the five Movies. Each still represents only a tiny fraction of the total number of film frames in a complete Movie. The Stills could be produced for Spike by Technical Services Ltd. (“Tech Services”) from DVDs of the movies. Tech Services could run the DVDs, make electronic copies of images selected by Spike, and insert these images in the dissertation text (which is in electronic, word-processed form). Spike would purchase or rent the DVDs of the Movies.

The Movies were made and shown in North America from 1948 - 1970. Assume that Hawks, a US citizen and resident, was the sole author of the Movies, and that he validly assigned all of his copyright in the Movies to Paramount, a US motion picture corporation, in 1971.

Spike’s dissertation (once complete and successfully defended) is to be published through the provision of copies to the National Library of Canada and to the University libraries, where the dissertation will be available to other researchers. Spike shall receive no financial compensation for this publication.

Hawks is survived by his wife, Marie, and his sons Biff and Brick. Hawks made no mention of intellectual property in his will, but Marie is entitled to the residue of his estate under his will.

[you may tear out this page]
13. Is copyright in the Movies recognized under Canada’s Copyright Act? Assume that the term of copyright would continue to subsist, if copyright could be recognized.
(3) 14. Assume that copyright in the Movies could be recognized under the Copyright Act. Have the Movies gone into the public domain or does the term of copyright continue to subsist? If the term continues to subsist, when would copyright in the Movies expire?
(3) 15. Assume that copyright in the Movies is recognized under the Copyright Act and that the term of copyright continues to subsist. Who owns the copyright? Explain.
(2) 16. Assume that copyright in the Movies is recognized under the Copyright Act and that the term of copyright continues to subsist, but assume that Spike does not have a copyright interest in the Stills. **Do the Stills receive copyright protection? Explain.**

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(3) 17. Assume that copyright in the Stills is recognized under the *Copyright Act*, that Spike does not have any copyright interest in the Stills, and that the term of copyright continues to subsist. Who owns the moral rights in the Stills? Explain.
(4) 18. Ignore the role/legal position of Tech Services. Assume that copyright in the Stills is recognized under the Copyright Act, that Spike does not have any copyright interest in the Stills, and that the term of copyright continues to subsist. **Would Spike’s proposed use of the Stills violate any relevant moral rights?**
(12) 19. Ignore the role/legal position of Tech Services. Assume that copyright in the Stills is recognized under the Copyright Act, that Spike does not have any copyright interest in the Stills, and that the term of copyright continues to subsist. **Does Spike require the express permission of the copyright owner to use the Stills in the dissertation, in the manner described? What advice would you give to Spike? Explain.** Assume that Spike is not acting for the University or any other institution in his use of the Stills. Do not discuss breach of contract issues.
(4) 20. Assume that copyright in the Stills is recognized under the Copyright Act, that Spike does not have any copyright interest in the Stills, and that the term of copyright continues to subsist. Would Tech Services’ dealings with the Stills infringe copyright? Feel free to refer to any relevant answers to previous questions.
(2) 21. Assume that copyright in the Stills is recognized under the Copyright Act, that neither Spike nor Tech Services has any copyright interest in the Stills, and that the term of copyright continues to subsist. Assume that Spike did need express permission to use the Stills. Practically, this permission would be obtained in writing. **Legally, must the permission be in writing?** Explain.

(3) 22. Assume that copyright in the Stills is recognized under the Copyright Act, that the owner of copyright in the Stills is neither Spike nor Tech Services, but that Spike’s use of the Stills does not infringe copyright. Floyd, a lazy graduate student, copied 100% of Spike’s dissertation, and sought to pass it off as his own. Assume that no defence to infringement is available to Floyd. **Is Floyd liable for copyright infringement to the owner of copyright in the Stills?** Explain.
(3) 23. Assume that Spike’s use of the Stills would infringe copyright, and the University advised Spike that the dissertation could not be used to fulfill his Ph. D. requirements until he obtained the requisite permissions. Spike, as part of a protest, made an electronic version of his dissertation available for reading and reproduction on his Internet website. Spike’s website relies on his University computing account and on the Faculty of Arts server and other University computing facilities. Is the University responsible for copyright infringement? Explain.