

Intellectual Property Weekly Abstracts Bulletin — Week Of May 22, 2017

May 24, 2017

Copyright Decisions

Four copyright registrations expunged where Respondent was not the author and owner of the works

[Gemstone Travel Management Systems Inc. v. Andrews, 2017 FC 463](#)

The Court granted Gemstone's application to expunge four copyright registrations and to amend one copyright registration to replace "Gemstone Travel Management Systems" with "Gemstone Travel Management Systems Inc". As a preliminary matter, the Court declined to consider the Respondent Andrews' irregular and late-filed submissions. Andrews had filed neither a record nor a memorandum of fact and law, but did make a number of written submissions in a letter submitted to the Court on the scheduled hearing date.

In an earlier application, the Court had dismissed Andrews' application for declarations and remedies relating to alleged copyright infringement and infringement of moral rights, but had concluded that, in the absence of a cross-application, the Court was without jurisdiction to expunge the copyright registrations sought by the Respondents in that **application** (see [2016 FC 624](#), [our summary here](#)). The present application was brought by Gemstone to remedy this jurisdictional defect.

The Court had previously concluded that Andrews was not an author of the software in the registrations at issue, or a joint author, and therefore, his application must fail since it is based on him being an author. The other registered owner and author of the registrations at issue did not object to their expungement from the Register in this application.

Other Decisions of Interest

Order of Mandamus requiring Health Canada to issue a Product Licence Application is overturned on appeal

[Canada \(Health\) v. The Winning Combination Inc., 2017 FCA 101](#)

The Federal Court of Appeal has overturned an earlier decision of the Federal Court (see [2016 FC 381](#), [our summary here](#)) relating to the non-issuance of a Product Licence Application (PLA) for the Winning Combination's natural health product RESOLVE, a smoking cessation aid.

The Federal Court had earlier found that several decisions by the Natural and Non-Prescription Health Products Directorate and its predecessor in Health Canada were **made in breach of procedural fairness**. Mandamus was ordered, requiring Health Canada to issue a PLA within 30 days.

On appeal, the Attorney General conceded that the licensing decision and **reconsideration process under the Regulations had not been reached in accordance** with procedural fairness. However, the Attorney General maintained her position that the **order of mandamus be set aside and that the question of whether a Natural Product Licence should be issued in respect of Resolve be remitted to the Minister for redetermination**.

The Court of Appeal agreed that the judge erred in granting mandamus for two reasons. The first related to the finding of systemic bias and the finding that no adequate remedy was available to Winning Combination. The Court of Appeal stated that the finding of bias on the part of the government officials did not, in the absence of further evidence, justify the conclusion that the Department as a whole was systemically incapable of making a fair assessment of the Winning Combinations' application.

The second error in granting mandamus related to fresh evidence provided on appeal as to whether the product is a Natural Health Product or a drug. This decision would guide which regulatory regime governs the product. It was found that a serious scientific question exists that is best addressed through an expedited redetermination, not a directed verdict.

The argument that the Minister was functus officio was balanced with the need for the Minister to ensure the safety of licenced products to be consumed by Canadians. There was nothing found in the regulatory scheme that supports the position that the Minister may not revisit all licensing requirements.

Ultimately the decision was remitted to the Minister for redetermination within 90 days of the decision. Solicitor and client costs were awarded to the Winning Combination and the prior Federal Court decision to award the Winning Combination solicitor and client costs was upheld.

Industry Updates

Health Canada has released a [Notice: Publication of Update to the Guidance Document: Data Protection under C.08.004.1 of the Food and Drug Regulations](#).

On 24 March 2017, the Canadian Intellectual Property Office (CIPO) released [a Notice withdrawing their notification of incompatibility that was submitted under Section 703\(f\) of the Administrative Instructions under the Patent Cooperation Treaty](#). The Notice indicates that CIPO now accepts electronic filings of international applications that conform to Section 703(b), items (ii) to (iv) of the Administrative Instructions.

By

[Chantal Saunders](#), [Beverley Moore](#), [Adrian J. Howard](#), [Jillian Brenner](#)

Expertise

[Intellectual Property](#), [Copyright](#), [Licensing](#), [Patents](#), [Trademarks](#)

BLG | Canada's Law Firm

As the largest, truly full-service Canadian law firm, Borden Ladner Gervais LLP (BLG) delivers practical legal advice for domestic and international clients across more practices and industries than any Canadian firm. With over 725 lawyers, intellectual property agents and other professionals, BLG serves the legal needs of businesses and institutions across Canada and beyond – from M&A and capital markets, to disputes, financing, and trademark & patent registration.

blg.com

BLG Offices

Calgary

Centennial Place, East Tower
520 3rd Avenue S.W.
Calgary, AB, Canada
T2P 0R3

T 403.232.9500
F 403.266.1395

Ottawa

World Exchange Plaza
100 Queen Street
Ottawa, ON, Canada
K1P 1J9

T 613.237.5160
F 613.230.8842

Vancouver

1200 Waterfront Centre
200 Burrard Street
Vancouver, BC, Canada
V7X 1T2

T 604.687.5744
F 604.687.1415

Montréal

1000 De La Gauchetière Street West
Suite 900
Montréal, QC, Canada
H3B 5H4

T 514.954.2555
F 514.879.9015

Toronto

Bay Adelaide Centre, East Tower
22 Adelaide Street West
Toronto, ON, Canada
M5H 4E3

T 416.367.6000
F 416.367.6749

The information contained herein is of a general nature and is not intended to constitute legal advice, a complete statement of the law, or an opinion on any subject. No one should act upon it or refrain from acting without a thorough examination of the law after the facts of a specific situation are considered. You are urged to consult your legal adviser in cases of specific questions or concerns. BLG does not warrant or guarantee the accuracy, currency or completeness of this publication. No part of this publication may be reproduced without prior written permission of Borden Ladner Gervais LLP. If this publication was sent to you by BLG and you do not wish to receive further publications from BLG, you may ask to remove your contact information from our mailing lists by emailing unsubscribe@blg.com or manage your subscription preferences at blg.com/MyPreferences. If you feel you have received this message in error please contact communications@blg.com. BLG's privacy policy for publications may be found at blg.com/en/privacy.

© 2024 Borden Ladner Gervais LLP. Borden Ladner Gervais LLP is an Ontario Limited Liability Partnership.