# ***Protect Your Intellectual Property in Canada***

*November 2022*

All businesses have an interest in intellectual property ("**IP**") – both to ensure protection and maximization of a business' assets and to limit the risk of infringing the IP rights of others.

Canada recognizes a wide range of IP rights, including patents, trademarks (both registered and unregistered), copyright, industrial designs, trade secrets and other forms of confidential information, plant breeders rights and personality rights.

Businesses starting, entering or operating in Canada should develop a comprehensive IP strategy that aligns with the current stage of the business as well as future goals. Steps that all businesses should take with their IP advisors include:

- **Identify** – review and identify the business IP, including trademarks (product/service name, logos, key taglines), social media handles and domain names, copyright material (can include marketing materials, manuals, website layout and design, software), patentable inventions, protectable designs/trade dress, trade secrets and confidential information (including client lists, know-how, processes).
- **Protect** – triage the business IP and seek registration in Canada for rights pertaining to key brands, processes, products and/or services.
- **Verify** – ensure proper contractual language is in place concerning ownership of any IP, including in employment contracts, contractor agreements, supply/supplier agreements and service provider agreements. Be wary of using templates developed for other countries, as some IP ownership defaults in Canada are different than, for example, the U.S.
- **Clear** – ensure clearance in Canada for key branding, products and processes. Is there another business using a similar name or logo in Canada? What types of protection do key competitors have in Canada? Just because a name or process was used in one country does not mean that a business will have clearance to use it in another.
- **Establish** – set up processes to help identify, protect and monitor IP that is being generated by the business. Conduct regular reviews of IP assets and establish policies to maintain IP rights, including branding guidelines, policies for the handling of confidential information, processes for reporting new inventions and designs, and exit processes for departing employees.
- **Monitor** – establish processes to monitor third party activities to ensure they are not treading on your business' IP, and consider enforcement action, when needed, in respect of key assets.

## Protect IP When Expanding Abroad

Canadian companies looking to grow abroad should ensure that their IP is protected. IP rights are country specific – e.g., a registered trademark in Canada does not confer trademark rights in the US or elsewhere. Consequently, companies need to tailor their IP strategy for every country that they enter. Any business expansion plan should include strategies to Identify, Protect, Verify, Clear, Establish and Monitor its IP in each new jurisdiction.

We have IP specialists who can help your business build and tailor its IP strategy.

*Disclaimer: This article offers general comments on legal developments of concern to business organizations and individuals and is not intended to provide legal advice. Readers should seek professional legal advice on the particular issues that concern them.*

## Contacts



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Fiona has extensive experience advising international businesses entering the Canadian market. To date, she has advised more than 100 companies expanding into Canada. Fiona advises clients in this space all day, every day. She has been practising for more than a decade and is a regular speaker and writer on market expansion matters. Fiona is proud to have been recognized by *The Best Lawyers in Canada, The Canadian Legal Lexpert Directory* and *Benchmark Canada.*

A proactive and comprehensive approach is required to succeed in a new market. Fiona manages teams of other lawyers and patent agents to provide her clients with a full range of legal services to help their businesses grow. She acts as project manager to ensure her clients receive seamless legal services in all relevant areas.

Fiona takes great care to understand her clients' businesses and deliver advice that is tailored to meeting their specific needs. Her responsiveness, dedication to clear communication and hands-on approach show that she is personally invested in the success of her clients.



**Amy Grenon**
Partner

Amy is a member of the firm's Intellectual Property and Litigation & Dispute Resolution Groups. She represents a wide variety of clients, including startup and scaling companies, multinational organizations and Fortune 500 companies, across sectors such as life sciences, technology, manufacturing, energy, and food and consumer packaged goods.

Leveraging her degree in biochemistry and intellectual property expertise, Amy has a thorough understanding of how the innovative and generic sides of the pharmaceutical industry operate and their respective regulatory constraints. She has represented various life sciences clients, including pharmaceutical and medical device companies, in patent infringement and impeachment actions. Amy regularly advises such clients on regulatory matters, advertising and licensing issues and has supported various corporate transactions of IP assets.

Amy guides clients on branding and copyright issues, trademark portfolio management and strategy, and has represented clients in trademark oppositions, trademark and copyright infringement and passing-off proceedings.

Her practice includes all areas of intellectual property law, with a particular emphasis on complex interjurisdictional IP litigation. She has appeared before the Federal Court, the Federal Court of Appeal, the Ontario Superior Court of Justice and specialized tribunals such as the Trademarks Opposition Board. Amy frequently presents and contributes to publications in the intellectual property field.