IP OSGOODE

Intellectual Property Law & Technology Program

# The IPIGRAM (21 July 2014)

## Events

**September 18-19, 2014**
***Congress: ALAI Brussels 2014***
"Moral Rights in the 21st Century - The changing role of the moral rights in an era of information overload". Click for details.

**October 15-17, 2014**
**IPIC 88th Annual Meeting**
IP Osgoode's advisory board member **Sylvain Laporte** will be speaking. Click for details.

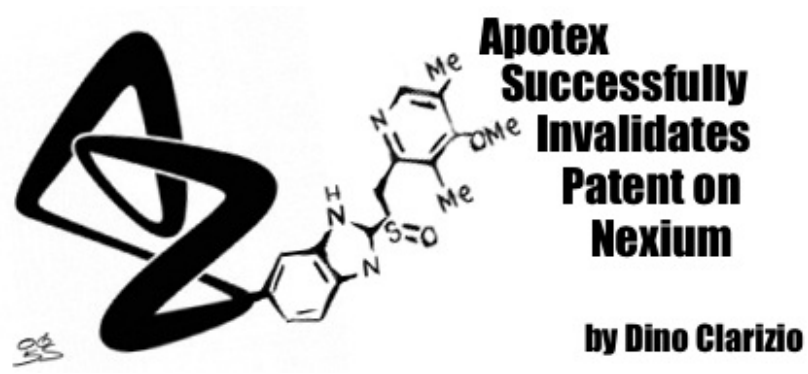
## IP Notes

**Amendments to the *Trademarks Act* Receive Royal Assent**
Amendments to the *Trademarks Act* in the *Budget Implementation Act* (BIA) that will allow Canada to accede to three trademark treaties: Madrid Protocol, Singapore Treaty and Nice Agreement, received royal assent on June 19, 2014.

Osgoode Adjunct Professor **Ruth Corbin** receives honorary degree from Carleton University for contributions in intellectual property law. Click for details.

Congratulations to IP Osgoode's own **Professor Carys Craig** on her new appointment as Associate Dean, Research & Institutional Relations at

## Feature Posts




**Apotex Successfully Invalidates Patent on Nexium**

July 17, 2014 by Dino Clarizio

AstraZeneca has been selling Nexium in Canada for 13 years. It is prescribed to treat ulcers, gastroesophageal reflux disease (GERD) and related diseases. The active ingredient in Nexium is esomeprazole, one of the enantiomers of omeprazole. Omeprazole is also prescribed to treat these same diseases.

Canadian patent no. 2,139,653 (the 653 patent) claims esomeprazole with a specified level of optical purity, and its use in the treatment of these diseases. After a 32-day trial (AstraZeneca Canada Inc. et al v. Apotex Inc. et al, 2014 FC 638), Justice Rennie found the claimed invention to be new and inventive. However, he held the 653 patent was invalid because it failed to meet the third basic requirement for patentability – utility. Specifically, the Court found that the inventors could not have soundly predicted one of the utilities promised in the patent at the time of filing the application.

Justice Rennie's detailed and comprehensive Reasons for Judgment will be of interest to not only litigators engaged in the drug wars in Canada, but also to patent practitioners generally. What follows is a summary of three

Osgoode Hall Law School.

Congratulations to IP Osgoode's own **Professor Ikechi Mgbeoji** for attaining the rank of Full Professor at Osgoode Hall Law School.

IP pick of the week

The World Intellectual Property Organization (WIPO) has unleashed The Accessible Books Consortium (ABC). ABC aims to improve book accessibility to the blind and vision impaired by working to increase the number of books that are available in braille, audio format, and large print. Feel free to contact ABC if you are interested in contributing to or participating in this admirable project. Click here to watch WIPO's ABC video.

key issues in that case, but readers of the Court's Reasons will note that Justice Rennie dealt in detail with several other issues.

Read more

*Dino Clarizio is a partner at the Toronto office of Goodmans LLP, and also a registered patent and trade-mark agent. His work includes all types of intellectual property litigation and, in particular, patent litigation in the chemical and pharmaceutical area. Mr. Clarizio received an LLB from Osgoode Hall Law School ('89) and a Bachelors of Engineering from McGill University ('86).*

## The Washington Wrong-Skins: A Moral Victory over Tasteless Trademarks

July 2, 2014 by Jaimie Franks

The football field is for helmets not headdresses. In the much talked about June 18, 2014 decision in *Blackhorse v Pro Football, Inc.* the United States Patent and Trademark Office (USPTO) made a clear statement that culturally-insensitive trademarks would not be tolerated. The Trademark Trial and Appeal Board (TTAB) decided to cancel six federal trademark registrations for the name "Washington Redskins," concluding that the football team's moniker was "disparaging to Native Americans." Although the issue is far from being settled, it is a substantial step in the fight against racially offensive mascots and names.

Read more

*Jaimie Franks is an IPilogue Editor and a JD Candidate at Osgoode Hall Law School.*

## Grand Theft Likeness: The Story of Lindsay Lohan and Lacey Jonas

July 18, 2014 by Adam Chan

Avid players of the popular video game Grand Theft Auto V may recognize this scenario: your character is tasked with transporting a female celebrity named Lacey Jonas home from where she is hiding in an alleyway. During the mission, you evade the paparazzi while Lacey spouts bons mots like "I'm really famous. I didn't do anything!" Does this remind you of anyone? Lindsay Lohan certainly thinks so. In a complaint filed

on July 1 with the Supreme Court of the State of New York, Lohan alleges that Rockstar Games, the publisher of Grand Theft Auto V, used her likeness without authorization in the creation of the Lacey Jonas character. While Lohan and Lacey certainly share some similarities -- both are blonde women, for a start -- are they similar enough to convince a court that Rockstar has wrongfully appropriated Lohan's likeness?

Read more

*Adam Chan is an IPilogue Editor and graduate of the University of British Columbia Faculty of Law.*

## Recent Posts

### Alice Corp., Software Patents, and Lighting the Rabbit Hole of Abstract Ideas

July 15, 2014 by Joseph Turcotte

It's often hard to recognize the evolving nature of legal regimes amidst the fast-paced and so-called revolutionary social and technological changes facilitated by digital and networked technologies. Laws, norms, and conventions developed over centuries are being problematized and rethought as new social, technological, and economic realities emerge. Computer software, a technology that's mainstream adoption is but some three decades old, is arguably challenging the contours of patent regimes, which the innovation and economies of many states are built upon. The Supreme Court of the United States' (SCOTUS) recent decision in the case of *Alice Corp. Pty. Ltd. v. CLS Bank International, et al* has moved the United States' legal system one step closer to accounting for new, digitally-based business practices.

Read more

*Joseph F. Turcotte is an IPilogue Editor, a PhD Candidate and SSHRC Doctoral Fellow in the Communication & Culture Program (Politics & Policy) at York University, and a Nathanson Graduate Fellow at the Jack & Mae Nathanson Centre on Transnational Human Rights, Crime and Security at Osgoode Hall Law School.*

OSGOODE HALL LAW SCHOOL | YORK UNIVERSITÉ UNIVERSITY

IP Osgoode | Intellectual Property Law & Technology Program
Osgoode Hall Law School | York University
416.650.8449 | iposgoode@osgoode.yorku.ca | www.iposgoode.ca