

2002 Church and The Law Seminar – November 5, 2002

Update on Trade-Mark & Copyright Law

For Churches & Religious Charities

by Mark J. Wong, B.A., LL.B.

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2002 CHURCH AND THE LAW SEMINAR

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November 5th, 2002

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OVERVIEW OF TOPICS

1. UPDATE ON TRADE-MARK LAW
 - Basic Principles of Trade-mark Law
 - Recent Developments
2. UPDATE ON COPYRIGHT LAW
 - What is copyright
 - Recent Developments

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A. WHAT IS A TRADE-MARK?

- A Trade-Mark is Any Mark Used For the Purpose of Distinguishing Wares or Services Manufactured, Sold, Leased, Hired or Performed From Those of Others.

B. WHAT DO TRADE-MARKS CONSIST OF?

- a Word, i.e. “Coke”
- a Made Up Word/Coined Word, i.e. “Xerox”
- a Symbol, i.e. “The Nike Swoosh”
- a Slogan, i.e. “Have You Had a Break Today”
- a Web Site, i.e. “www.google.com”

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C. WHY ARE TRADE-MARKS IMPORTANT TO CHARITIES?

- A Trade-Mark Is One of the Most Valuable Assets of Charities and Churches
- Trade-Marks Represent the Good Will of a Charity by Providing a Focal Point For:
 - Donations From Regular Supporters
 - Donations From Estate Gifts
 - Enhancing the Reputation of a Charity

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- Trade-Marks Distinguish One Charity From Another and Prevents Other Organizations From Taking the Good Will of a Particular Charity
- Trade-Marks are Fragile Assets That Can be Lost or Seriously Eroded Through Both Error of Commission and Omission

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D. TRADE-MARK PROTECTION AT COMMON LAW

- In Canada, the First User of a Trade-Mark Is Generally Considered to Be the Owner of the Mark and the Person Entitled to Register It
- The Common Law Provides Protection to Restrain a Competitor From Passing Off Its Goods or Services Under the Trade-Mark of Another, The Cause of Action Is Referred to As a “Passing Off” Action
- Common Law Rights Are Difficult to Establish Before a Court and to Enforce
- Common Law Protection Is Limited to Enforcement in the Local Area of Exposure Only

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E. THE BENEFITS OF TRADE-MARK REGISTRATION

- Trade-Mark Registration Provides Owner the Exclusive Right to Use the Trade-Mark with Respect to its Goods and Services for 15 years and is renewable thereafter
- Trade-Mark Registration Provides a Presumption of a Valid Trade-Mark.
- Trade-Mark Registration is Effective Throughout Canada.
- A Trade-Mark Registration Can Become Incontestable in Some Situations after 5 years

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F. WHAT IS AN OFFICIAL MARK?

- An Official Mark Is an Authorized Mark Used by Public Authorities in Canada for Wares and Services.
- Official Marks Are Not Trade-Marks, However They Are Governed by the Trade-Marks Act.
- Examples of Organizations That Have Had Section 9 Official Marks Published
 - Canadian Olympic Association
 - Canadian Baptist Ministries
 - Canadian Society for Crippled Children
 - The Salvation Army of Canada

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G. BENEFITS OF AN OFFICIAL MARK

- A Section 9 Official Mark, Allows the Owner to Prohibit Anyone Else From Using the Specific Official Mark for Any Wares or Services
- There Are No Renewal Fees for Section 9 Official Marks, Whereas a Trade-Mark Registration Is Limited to 15 Years and Can Be Expunged

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H. WHAT IS PUBLIC AUTHORITY

- Public Authority Is Not Defined in the Trade-marks Act
- A Public Authority Is an Entity That Is
 - Under a Significant Degree of Government Control
 - Any Profit Earned by the Entity Is to Be Used For the Benefit of the Public and Not for Private Gain
- In the Past the Trade-marks Office Recognized That Charities Were Public Authorities

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I. RECENT COURT DECISION

- *Canadian Jewish Congress v. Chosen People Ministries* Held That
 - Chosen People is Not a “Public Authority”
 - Chosen People is Not Under a Significant Degree of Government Control
 - Chosen People is Not Entitled to an Official Mark
- Decision in the Chosen People Case is Being Appealed to the Federal Court of Canada
- Trade-marks Office Now Considers Charities Per Se as Not Being Sufficient to be Considered Public Authorities

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J. IMPACT OF DECISIONS ON CHARITABLE ORGANIZATIONS

- Charitable Bodies, Per Se are Not Entitled to Official Marks Simply Because They Are Charities
- Charities Must Ensure That They Have Registered Trade-Marks and not rely on Official Marks
- Charitable Bodies, Currently Holding Official Marks, Must Secure Parallel Registered Trade-Marks in Light of the Decision in Chosen People Ministries
- Possibility That Charities Currently Holding Official Marks May Have Their Official Marks Expunged

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K. DOMAIN NAMES AND TRADE-MARK LAW

- A Domain Name Is an Electronic Address Which Is Used to Locate a Computer on the Internet
- Domain Names Are Granted on a “First to File” System
- As a Result of the First to File System, Domain Name Disputes Are Likely to Occur.

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- Domain Name Disputes, Can Be Resolved Through the Uniform Domain Name Dispute Resolution Policy (UDRP) in the Case of .com, .org., .net, .aero, .biz, .coop, .info, .museum, .name, and .net Top Level Domain Names (TLD’s) As Well As Through the Canadian Internet Registration Authority (CIRA) Domain Name Dispute Policy (CDNDP) in the Case of .Ca TLD’s
- Domain Name Disputes, Can Also Be Resolved Through Trade-mark Law
- Trade-mark Registration Can Assist in Protecting Domain Names, and Can Prevent Disputes Such As Cyber-squatting From Occurring

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- Protecting Domain Names
 - Charities Should Obtain an Internet Domain Name As Soon As Possible Using Its Key Trade-mark
 - Charities Should Consider Obtaining More Than One Domain Name, .com, .ca, .biz
 - Charities Should Obtain Trade-marks in Order to Prevent Other Entities From Using Domain Names With the Charities Trade-mark
 - Charities Should Obtain Trade-marks in Canada, and Possibly Other Jurisdictions Including the U.S., Where They Intend to Have Their Web Site Target

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L. WHAT IS COPYRIGHT?

- Copyright Is a Statutory Right Which Subsists Immediately Upon Creation in any Work Which Meets the Three Basic Criteria for Copyright Eligibility Which Are:
 - Originality
 - Creativity
 - Fixation
- Copyright Means the Right to Control the Reproduction and Distribution of Your Work

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- Copyright Does Not Require Registration, Although There Are Benefits to Registration Including:
 - In Litigation, Automatic Presumption That Copyright Exists and That the Author Named in the Registration Is the Owner
- Copyright Does Not Exist in Facts, Ideas or News
- Copyright Exists in How Ideas Are Presented Rather Than What Ideas Are Presented
- Copyright Does Not Exist in Anything Which Is in the 'Public Domain' Such As Shakespeare

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M. WHO OWNS COPYRIGHT?

- Ownership Normally Resides in the Author of the Work, Except When the Work Is Created in the Course of Employment
- Ownership Can Be Assigned or Licensed Either in Part or in Whole and Either Generally or Subject to Territorial Limitations

N. FOR HOW LONG?

- Copyright Generally Lasts for 50 Years After the End of the Calendar Year in Which the Death of the Author of the Work Occurs

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O. WHAT IS INFRINGEMENT?

- Infringement Occurs When an Unauthorized Party Exercises Any of the Rights Properly the Exclusive Property of the Owner of the Copyright
- Limited Number of Exceptions to Infringement e.g.
 - Fair Dealing for Private Study, Research, Criticism, Review or Newspaper Summary If Source and Author's Name Is Cited
 - Churches, Charities, Colleges, Schools and Religious Charitable and Fraternal Organizations Can Perform Music in a Public Performance If Goal Is to Further a Religious, Educational or Charitable Object

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- In General There Are Few Exceptions, Making It Easy for an Unwitting Person to Infringe
- Such Actions As Downloading Information from the Internet, Taping Music off the Radio, Videotaping Shows off the Television or Photocopying Portions of a Book, Magazine or Newspaper for Personal Entertainment Constitute Infringement

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P. BACKGROUND TO COPYRIGHT AND REFORM

- The Government Last Amended the Copyright Act in 1997
- On October 3rd, 2002, the Government Released its Legislation and Policy Agenda Concerning Copyright Law Reform
- Purpose of Policy Agenda is to Prioritize Copyright Reform Initiatives For at Least the Next Five Years.

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Q. SHORT TERM PRIORITIES (1-2 YEARS)

- **Digital Copyright Reform**
 - Issue: Whether the Copyright Act Should Be Amended to Provide Sanctions Against Persons Who Use Circumvention Technologies to Infringe Copyright by Defeating Protective Technologies Such As Encryption
 - Issue: Whether the Copyright Act Should be Amended to Allow the Showing of Films and Videos in Addition to Performances of Other Works on the Premises of an Educational Institution

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R. MEDIUM TERM PRIORITIES

- Issue: Whether the Copyright Act Should Be Amended to Extend the Term of Copyright Protection

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S. SOME PRACTICAL TIPS A CHURCH OR CHARITY SHOULD KNOW ABOUT COPYRIGHT LAW IN CANADA

- Copyright Laws are Constantly Changing, Churches and Charities Should be Informed About These New Changes to Ensure That They are Not Infringing Copyright
- In the Next Five Years, the Government Will Most Likely Enact New Copyright Laws, Providing More Copyright Protection to Owners

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- In the Next Five Years, the Government Will Most Likely Enact New Copyright Laws, Providing For More Exceptions That May Have an Impact on Charities and Churches. As a Result, Charities Should be Fully Informed of These New Exceptions, to Ensure That They are Not Paying for Something That They Have a Legal Right to Use
- Defense to Infringement Are Limited, Do Not Presume That a Church or Charity Will Have a Defense Available to It If It Decides to Use Someone Else's Work, Regardless of How Innocent Its Usage May Appear

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- In the End, Unauthorized Usage of an Author's Work, Unless an Exception Is Available, Is a Form of Misappropriation
- Do Not Pay for What is in the Public Domain; Ensure What You are Receiving a License for is Even Required
- Employment Situations in the Church or Charity Setting May Give Rise to Questions of Ownership Over Works Created; Assignments Should be Obtained and Employee/Employer Relationship Should be Clearly Defined

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