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Canada in International Law at 150 and Beyond | Paper No. 17 – March 2018

Canada's Role in the Relationship of Trade and Intellectual Property

Howard P. Knopf



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About the Series

Marking 150 years since Confederation provides an opportunity for Canadian international law practitioners and scholars to reflect on Canada's past, present and future in international law and governance. "Canada in International Law at 150 and Beyond/Canada et droit international : 150 ans d'histoire et perspectives d'avenir" is a series of essays, written in the official language chosen by the authors, that provides a critical perspective on Canada's past and present in international law, surveys the challenges that lie before us and offers renewed focus for Canada's pursuit of global justice and the rule of law.

Topics explored in this series include the history and practice of international law (including sources of international law, Indigenous treaties, international treaty diplomacy, subnational treaty making, domestic reception of international law and Parliament's role in international law), as well as Canada's role in international law, governance and innovation in the broad fields of international economic, environmental and intellectual property law. Topics with an economic law focus include international trade, dispute settlement, international taxation and private international law. Environmental law topics include the international climate change regime and international treaties on chemicals and waste, transboundary water governance and the law of the sea. Intellectual property law topics explore the development of international IP protection and the integration of IP law into the body of international trade law. Finally, the series presents Canadian perspectives on developments in international human rights and humanitarian law, including judicial implementation of these obligations, international labour law, business and human rights, international criminal law, war crimes, and international legal issues related to child soldiers. This series allows a reflection on Canada's role in the community of nations and its potential to advance the progressive development of global rule of law.

"Canada in International Law at 150 and Beyond/Canada et droit international : 150 ans d'histoire et perspectives d'avenir" demonstrates the pivotal role that Canada has played in the development of international law and signals the essential contributions it is poised to make in the future. The project leaders are Oonagh Fitzgerald, director of the International Law Research Program at the Centre for International Governance Innovation (CIGI); Valerie Hughes, CIGI senior fellow, adjunct assistant professor of law at Queen's University and former director at the World Trade Organization; and Mark Jewett, CIGI senior fellow, counsel to the law firm Bennett Jones, and former general counsel and corporate secretary of the Bank of Canada. The series will be published as a book entitled *Reflections on Canada's Past, Present and Future in International Law/Réflexions sur le passé, le présent et l'avenir du Canada en matière de droit international* in spring 2018.

About the International Law Research Program

The International Law Research Program (ILRP) at CIGI is an integrated multidisciplinary research program that provides leading academics, government and private sector legal experts, as well as students from Canada and abroad, with the opportunity to contribute to advancements in international law.

The ILRP strives to be the world's leading international law research program, with recognized impact on how international law is brought to bear on significant global issues. The program's mission is to connect knowledge, policy and practice to build the international law framework — the globalized rule of law — to support international governance of the future. Its founding belief is that better international governance, including a strengthened international law framework, can improve the lives of people everywhere, increase prosperity, ensure global sustainability, address inequality, safeguard human rights and promote a more secure world.

The ILRP focuses on the areas of international law that are most important to global innovation, prosperity and sustainability: international economic law, international intellectual property law and international environmental law. In its research, the ILRP is attentive to the emerging interactions among international and transnational law, Indigenous law and constitutional law.

About the Author

Howard P. Knopf is counsel with Macera & Jarzyna, LLP in Ottawa, Canada. He has worked in government and the private sector, mainly in the areas of copyright, trademarks, cyber law, competition and related issues. He has been the chairman of the Copyright Policy Committee of the Canadian Bar Association and was adviser to the Law Commission of Canada on security interests in intellectual property. He edited the resulting book entitled *Security Interests in Intellectual Property*. He spent over a decade in the Canadian federal government and has published extensively, both as author and editor. Since 2000, he has been a member of the faculty of the annual Fordham International Intellectual Property Law and Policy Conference in New York. He has been an adjunct law lecturer at Queen's University and was cited by *Canadian Lawyer* magazine as being one of Queen's law faculty's "best and brightest." He has appeared as counsel before the Copyright Board, the Canadian Artists and Producers Professional Relations Tribunal, the Federal Court, the Federal Court of Appeal and the Supreme Court of Canada. Howard has served as a panellist in cases involving the World Intellectual Property Organization's (WIPO's) Uniform Domain Name Dispute Resolution Policy. He is on the list of neutrals of the WIPO Arbitration and Mediation Center, and has been an adviser on policy issues to the government of Canada and WIPO. His litigation successes include important decisions in the Federal Court, the Federal Court of Appeal and the Supreme Court of Canada on issues involving file sharing, privacy, private copying levies, parallel importation, fair dealing and whether Copyright Board tariffs are mandatory. He has appeared several times on various issues before Parliamentary and Senate committees in Canada. Prior to his legal career, he was a professional clarinetist performing in Canada, the United States and Europe, and frequently for the Canadian Broadcasting Corporation. Howard maintains a widely read blog on copyright law at www.excesscopyright.blogspot.com and is often quoted in Canadian and foreign media.

Acronyms and Abbreviations

ACTA	Anti-Counterfeiting Trade Agreement
BIRPI	United International Bureau for the Protection of Intellectual Property
CETA	Comprehensive Economic and Trade Agreement
CPTPP	Comprehensive and Progressive Agreement for Trans-Pacific Partnership
CUSFTA	Canada-United States Free Trade Agreement
FTAA	Free Trade Area of the Americas
GATT	General Agreement on Tariffs and Trade
ICSID	International Centre for Settlement of Investment Disputes
IP	intellectual property
ISDS	investor-state dispute settlement
KEI	Knowledge Ecology International
NAFTA	North American Free Trade Agreement
PMNOC	Patented Medicines Notice of Compliance
SCC	Supreme Court of Canada
TPP	Trans-Pacific Partnership Agreement
TRIPS	Trade-Related Aspects of Intellectual Property Rights
UCC	Universal Copyright Convention
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

Introduction

This paper will show how Canada has played a provocative, unique, evolving and important role since Confederation in 1867 in the development of international treaties dealing with intellectual property (IP) law. Canada was burdened initially in its role in international IP treaties by its status as a British colony, and later by the powerful economic and political influence of the United States.

Canada has evolved from being a rebellious colony of Great Britain and a naysayer for several decades following the adoption of the landmark 1886 Berne Convention. For a time, from the late 1950s to the early 1980s, Canada had an independent voice on IP policy and asserted its own sovereign interest. It became a key middle-power leader in the movement toward the arranged marriage of IP and trade law, which ultimately resulted in the gestation and birth of the North American Free Trade Agreement (NAFTA) and the Trade-Related Aspects of Intellectual Property Rights (TRIPS) agreement in the late 1980s and early 1990s. Now, with the apparent denouement of the Trans-Pacific Partnership Agreement (TPP), its possible resurrection as the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP) (without the United States and its more excessive demands), the successful conclusion of the Comprehensive Economic and Trade Agreement (CETA) and the renegotiation of NAFTA, Canada stands poised to once again play an influential and even key international role, while striving to act in its own best domestic interests.

While it is now conventional wisdom that IP plays a key role in international so-called free trade treaties, this has not always been so, and there may now be renewed reasons and pressure to question this article of faith. Some would even go as far as to suggest that strong IP rights are the antithesis of free trade.¹

There is a fundamental paradox involving the relationship of IP and international trade law. IP law has historically been national or territorial in nature. Indeed, “[t]he territorial nature of intellectual property rights has long been a problem

1 Joel Lexchin, *Private Profits versus Public Policy: The Pharmaceutical Industry and the Canadian State* (Toronto, ON: University of Toronto Press, 2016) at 155.

to rights holders whose works, inventions, and brands are the subject of transnational trades.”² Moreover, excessively high levels of IP protection can be anti-competitive and can discourage innovation, while international trade law serves to encourage the flow of goods and services across borders. Indeed, “IP is just one — and far from the most significant — factor driving innovation.”³ IP law has always functioned as a kind of private tariff that can trump true free trade.⁴ It has been, at times, very effective in the outright exclusion of competing imported products ranging from books to pharmaceuticals.

The current rhetoric on this topic is couched in terms of competitiveness or, more recently, in terms of innovation. Over the course of the last 150 years, the movement to marry IP with free trade resulted in the crowning multilateral achievement that is the World Trade Organization’s (WTO’s) TRIPS agreement of 1994. The WTO currently has 164 member states,⁵ all of which are bound by the TRIPS agreement, which, in turn, requires that its members be bound by the substantive provisions of the Paris and Berne IP conventions. These are administered by the World Intellectual Property Organization (WIPO) and have 177⁶ and 174⁷ members, respectively.

The TRIPS Voyage

In the 1970s and 1980s, pressure started to build from American industry concerning the international aspects of IP. This interest may have begun with the relatively specific problem of counterfeiting. Counterfeit Levi Strauss blue jeans became an issue in the Tokyo Round of the General Agreement on

Tariffs and Trade (GATT) that preceded the Uruguay Round.⁸ However, this soon evolved into a movement led by some of the giants of American industry, who formed the Intellectual Property Committee (IPC) in 1986. The committee at first comprised Bristol-Myers, CBS, Du Pont, General Electric, General Motors, Hewlett-Packard, IBM, Johnson & Johnson, Merck, Monsanto and Pfizer.⁹ The blueprint for this corporate effort was a seminal paper by Jacques Gorlin entitled “A Trade-Based Approach for the International Copyright Protection for Computer Software.”¹⁰

At around the same time, momentum was building on a different, but interrelated, front. Canada and the United States were working toward the free trade agreement that has since become known as the Canada-United States Free Trade Agreement (CUSFTA),¹¹ concluded in 1987. The Brian Mulroney government of the day made two crucial IP concessions at the outset in the CUSFTA negotiation. First, Canada agreed to get rid of compulsory licensing for pharmaceuticals and to greatly increase drug patent protection.¹² The second concession involved Canada’s agreement to provide a cable retransmission right, which was estimated to be a minor cost at the time, but now costs Canadians approximately \$109 million a year¹³ — an amount that may double, depending on the outcome of a long-awaited decision of the Copyright Board.¹⁴

That agreement was notable because it was the first free trade agreement to specifically include an IP

2 Lionel Bently & Brad Sherman, *Intellectual Property Law*, 3rd ed (Oxford, UK: Oxford University Press, 2009) at 5.

3 *Ibid.*

4 See e.g. Diane P Wood, “The Impossible Dream: Real International Antitrust” (1992) U Chicago Legal F 277 at 282; see also Howard P Knopf, “Parallel Imports & the Internet: Bits, Borders, Barriers & Exhaustion” (2001) 6 Intl IP L & Pol’y 113-1 at 113-7.

5 WTO, “Members and Observers” (29 July 2016), online: <www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm>.

6 WIPO, “WIPO-Administered Treaties”, online: <www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=2>.

7 *Ibid.*

8 Peter K Yu, “TRIPs and Its Achilles’ Heel” (2011) 18 J Intell Prop L 479 at 513.

9 Susan K Sell, “Industry Strategies for Intellectual Property and Trade: The Quest for TRIPS, and Post-TRIPS Strategies” (2002) 10 Cardozo J Intl & Comp L 79 at 91.

10 Jacques Gorlin, *Monograph* (1 September 1985) [unpublished], cited in *ibid* at 89.

11 *Free Trade Agreement between the Government of Canada and the Government of the United States*, 2 January 1988, Can TS 1989 No 3 (entered into force 1 January 1989; suspended 1 January 1994) [CUSFTA], online: <www.international.gc.ca/trade-commerce/assets/pdfs/agreements-accords/cusfta-e.pdf>.

12 The elimination of compulsory licensing for pharmaceuticals and the interplay between this development, the controversial Bills C-22 and C-91 and CUSFTA, NAFTA and TRIPS are succinctly and frankly set forth in a recent important book by Lexchin. Lexchin, *supra* note 1 at 149ff.

13 Copyright Board of Canada, *Annual Report: 2015–16* (Ottawa, ON: Copyright Board of Canada, 2016) at 12, online: <<http://cb-cda.gc.ca/about-apropos/annual-annuel/annual-2015-2016-e.pdf>>.

14 Howard Knopf, “Canada Can Stand Its Ground on Copyright in NAFTA Renegotiations” (9 August 2017), online: CIGI <www.cigionline.org/articles/canada-can-stand-its-ground-copyright-nafta-renegotiations> [Knopf, “Canada Can Stand Its Ground”].

provision. In this case, the provision dealt in some detail with retransmission, a copyright concept that requires payment for the retransmission of distant broadcast signals.¹⁵ The somewhat earlier US-Israel Free Trade Agreement of 1985 contains only a cursory reference to IP,¹⁶ referring to the reiteration of existing obligations — presumably the main WIPO treaties and the Universal Copyright Convention (UCC) — and the affirmation of most favoured nation and national treatment values.

CUSFTA soon thereafter developed into NAFTA,¹⁷ which developed in parallel to the TRIPS agreement, with many of the same key players. Although TRIPS was concluded first, it did not take effect until January 1, 1995 — exactly one year later than NAFTA.

Canada played a key role in both arenas, as one of the “three amigos” in NAFTA, and as one of the “Quad” (the United States, the European Union, Japan and Canada) that was very influential in the TRIPS (then called the GATT) agreement negotiations. Many of the same officials were active in both.¹⁸ The renowned Jon H. Jackson has stated that “[o]ne of the surprisingly strong achievements of the Uruguay Round was the development of a very important and impressive agreement on intellectual property rights (IP).”¹⁹

Despite the great achievement of bringing IP and trade together in a multilateral instrument with a very effective state-to-state dispute settlement mechanism, the Americans were restless and wanted more. This desire soon manifested itself in “TRIPS Plus” initiatives, which called for something beyond what TRIPS requires.

The early years of the current century saw the increasing potential for failure of the multilateral treaty system. The Doha Round, which was intended to renew and rejuvenate the 1994 Uruguay agreement that produced TRIPS, was ongoing for more than 14 years, but seems to have ended in 2016, according

to the editorial board of *The New York Times*, which expressly linked this failure with the development of the more limited, plurilateral proposed TPP.²⁰

The TPP, as originally conceived, involved Australia, Brunei Darussalam, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, the United States and Vietnam.²¹ That agreement contained dozens of proposed terms that would arguably have been contrary to Canada’s interest. Indeed, Canada was a late entrant to the negotiations and started at a considerable disadvantage. At the time of writing, it seems that Canada is reasserting its own voice in negotiations on the TPP without the United States (the CPTPP). Canada has apparently succeeded in the suspension of many, if not most, of the excessive American items included in the IP provisions, “including those involving copyright term, patent extension, biologics protection, internet provider liability, and digital lock rules.”²²

Conversely, there has been the rise of bilateral investment treaties. Indeed, estimates of the numbers of such agreements range from about 300²³ to thousands.²⁴ The International Centre for Settlement of Investment Disputes maintains both alphabetical²⁵ and chronological²⁶ lists of such treaties. The United Nations Conference on Trade

15 CUSFTA, *supra* note 11, art 2006.

16 Frederick M Abbott, “Current Alliances in International Intellectual Property Lawmaking: The Emergence and Impact of Mega-Regionals” (August 2017) CEIPI-International Centre for Trade and Sustainable Development Publication Series on Global Perspectives and Challenges for the Intellectual Property System No 4 at 48.

17 *North American Free Trade Agreement Between the Government of Canada, the Government of Mexico and the Government of the United States*, 17 December 1992, Can TS 1994 No 2, 32 ILM 289, 605 (entered into force 1 January 1994).

18 Abbott, *supra* note 16.

19 *Ibid* at 310.

20 “Global Trade After the Failure of the Doha Round”, Editorial, *The New York Times* (1 January 2016), online: <www.nytimes.com/2016/01/01/opinion/global-trade-after-the-failure-of-the-doha-round.html?_r=0>.

21 Canada, “Comprehensive and Progressive Agreement for Trans-Pacific Partnership” (11 November 2017), online: <www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/tpp-ptp/index.aspx?lang=eng&menu_id=95>.

22 Michael Geist, “No Deal is Better than a Bad Deal: Why Canada Won the TPP By Standing Up for Balanced IP, Culture, and the Auto Sector”, *The Globe and Mail* (11 November 2017), online: <www.theglobeandmail.com/report-on-business/rob-commentary/no-deal-is-better-than-a-bad-deal-why-canada-won-the-tpp-stand-off/article36931537/>. See also “Who needs America? Eleven countries resurrect the Trans-Pacific Partnership”, *The Economist* (16 November 2016).

23 John M Curtis, “Intellectual Property Rights and International Trade: An Overview”, CIGI, CIGI Papers No 3, 18 May 2012 at 7.

24 Legal Information Institute, “Bilateral Investment Treaty”, Wex (blog), online: <www.law.cornell.edu/wex/bilateral_investment_treaty>.

25 International Centre for Settlement of Investment Disputes (ICSID), *Investment Promotion and Protection Treaties Alphabetical Index* (New York, NY: Oxford University Press, 2016), online: <<https://icsid.worldbank.org/en/Documents/resources/Investment%20Treaty%20Series%20Alphabetical%20Index.pdf>>.

26 *Ibid*.

and Development maintains a useful interactive site of international investment agreements.²⁷

In the middle, between multilateral and bilateral agreements, are so-called plurilateral treaties, involving a limited number of countries — but more than two. These agreements generally manifest a common theme: they seek to attain a TRIPS Plus level of IP protection. Attempts to ratchet IP up to TRIPS Plus have also taken place at a multilateral level, as discussed below.²⁸ Generally speaking, TRIPS Plus is what the United States wants and few other countries are willing to provide — at least, not without significant concessions or trade-offs on other fronts.

Early History

Soon after Confederation in 1867, copyright started to become a major domestic and international problem for the new Canadian government. While Canada celebrates Confederation as the beginning of its independence, that milestone, for legal purposes, was only achieved in 1932 when the Statute of Westminster repealed the Colonial Laws Validity Act,²⁹ which had allowed Great Britain to disallow domestic Canadian legislation that did not meet its approval.

Sara Bannerman has provided a notable, meticulous and readable account of what she calls “the struggle for Canadian copyright” from 1840 to 1971. There are many important and still immensely relevant lessons to be learned from that period. The most important for present purposes is that Canada — beginning with Prime Ministers Sir John A. Macdonald and Sir John Thompson — was a great skeptic of Berne on international IP rights. Indeed, Bannerman refers to Canada as intent on being a “Berne Buster.” Canada, it seemed, wanted to encourage its flourishing printing industry, and its population was eager to read cheap reprints of foreign authors. Bannerman

cites the notorious quotation of the then Minister of Justice John Thompson (who later became prime minister) to the effect that Berne would sacrifice the Canadian publishing industry for the “possible benefit to the Canadian author...[who has been described as] belonging rather to the future than the present.”³⁰ Bannerman also documents Canada’s rebellion against British pressure to force it into Berne, which created something of a constitutional crisis and was viewed as “nothing more or less than a Declaration of Independence.”³¹

In 1921, Canada introduced a bill closely modelled after the 1911 UK Copyright Act. However, there were details concerning Berne compliance that were causing consternation in England. Accordingly, the bill was not proclaimed into law until amendments were made and England was satisfied. Bannerman documents the ensuing controversy and how copyright was viewed in 1923 as “the most contentious subject that has ever been before the Parliament of Canada.”³² The new legislation only entered into force in 1924 with revision to satisfy England, and after negotiations with the United States, which, of course, stood far outside of Berne. Not coincidentally, negotiations with the United States resulted in Canada’s issuance of a certificate on December 26, 1923, extending the benefits of Canadian copyright law to the United States, effective January 1, 1924 — the same date on which Canada’s new copyright legislation, as approved by England, entered into force. The United States issued a similar reciprocal certificate on December 27, 1923 — also effective January 1, 1924.

This bilateral arrangement between Canada and the United States was actually the only formal copyright nexus between the nations until Canada adhered to the UCC in 1962.³³ A very useful account of Canada-US relations regarding copyright prior to American accession to Berne was published by Gordon F. Henderson in 1977.³⁴

27 United Nations Conference on Trade and Development, “International Investment Agreements Navigator”, online: Investment Policy Hub <<http://investmentpolicyhub.unctad.org/IIA>>.

28 Sisule F Musungu & Graham Dufield, “Multilateral agreements and a TRIPS-plus world: The World Intellectual Property Organisation (WIPO)” (Ottawa, ON & Geneva, Switzerland: Quaker United Nations Office & Quaker International Affairs Programme, 2003), online: <www.quno.org/sites/default/files/resources/Multilateral-Agreements-in-TRIPS-plus-English.pdf>.

29 *Statute of Westminster*, 1931 (UK), 22 & 23 Geo V, c 4; *Colonial Laws Validity Act* (UK) 1965, 28 & 29 Vict, c 63.

30 Sara Bannerman, *The Struggle for Canadian Copyright: Imperialism to Internationalism, 1842 to 1971* (Vancouver, BC: UBC Press, 2013) at 49.

31 *Ibid* at 54.

32 *Ibid* at 95.

33 Daniel Gervais, “The Emergence and Development of Intellectual Property Law in Canada” in Rochelle Dreyfuss & Justine Pila, eds, *The Oxford Handbook of Intellectual Property Law* (Oxford, UK: Oxford University Press, 2018) at 9, online: <www.oxfordhandbooks.com/view/10.1093/oxfordhb/9780198758457.001.0001/oxfordhb-9780198758457-e-16>.

34 Gordon F Henderson, “Canadian Copyright Law in the Context of American-Canadian Relations” (1978) 35 CPR (2d) 67.

Canada eventually became a party to Berne at the Rome level in 1928 through a “Declaration of Continued Application.”³⁵ However, Canada’s Berne-busting sentiments lasted a long time. The landmark Ilsley Commission, in its 1957 Report on Copyright, seriously asked the question of whether Canada should remain in Berne, and concluded with some reluctance that it should do so. Justice Ilsley noted, “It may be that, in becoming a party to the Berlin Revision of the Berne Convention in 1923, Canada was not too well advised. Apart from Haiti and Brazil, no nations in the Western Hemisphere are members of the Berne Union. Canada became bound, in 1887, to the Berne Convention, by Great Britain’s ratification (made subject to the understanding that the British Government could denounce the convention later for certain British possessions, including Canada).”³⁶

With prescience, Justice Ilsley indicated that Canada should address certain needs to assure “the future growth and proliferation of the entertainment industry” and that the need for registration should be addressed, so that ownership of copyright can be “ascertainable with greater certainty and less difficulty than is now possible.”³⁷ The question of ownership of copyright is still a problem. Canada has a very unsatisfactory regime for dealing with unlocatable copyright owners, and the Copyright Board refuses to enforce provisions requiring copyright collectives to answer requests for information about their repertoire.³⁸

The Ilsley Commission also asked whether Canada’s patent system should be maintained and whether Canada should remain in the Paris convention. It answered in the affirmative, but with reservations and a notable lack of enthusiasm.³⁹

The 1971 Economic Council Report was published just nine years after Canada became a party to the

UCC, discussed below.⁴⁰ It had some trenchant comments about how Canada should approach international agreements: “In terms of such payments, the United States and some other countries are ‘net exporters.’ Canada, in significant contrast, is a heavy net importer, paying more out to foreigners on this account than it takes in. Canada’s situation and interests in this sphere are in some ways closer to those of the developing countries than to those of countries like Britain, France and the United States.”⁴¹

Even the controversial and pro-copyright 1977 report of Andrew A. Keyes and Claude Brunet was skeptical about Canada acceding to later levels of either the Berne Convention or the UCC, and concluded that “[t]he Ilsley Report, the Economic Council Report and the considerations presented here lead inevitably to the same conclusion: that Canada would be ill-advised to accede to the later texts of the copyright conventions.”⁴²

Throughout this evolution of Canadian copyright law, Canada uniquely and successfully integrated many aspects of the often-contrasting common law and civil law “droit d’auteur” (author’s rights) traditions. This can be seen in Canada’s 1931 “first implementation of moral rights in a copyright country” and the inclusion of “Rome-style” neighbouring rights in the 1997 Canadian amendments.⁴³

The Dead-letter UCC

Canada is a party to the UCC, which was adopted on September 6, 1952, in Geneva, Switzerland, and ratified by Canada on August 10, 1962, at the 1952

35 WIPO, “Treaties and Contracting Parties: Contracting Parties/Berne Convention/Canada”, online: <www.wipo.int/treaties/en/remarks.jsp?cnty_id=926C>.

36 Canada, Royal Commission on Patent, Copyright, Trade Marks and Industrial Designs, *Report on Copyright*, (Ottawa, ON: Queen’s Printer and Controller of Stationery, 1957) at 18.

37 *Ibid.*

38 *Copyright Act*, RSC 1985, c C-42, ss 67, 70.11.

39 Canada, Royal Commission on Patent, Copyright, Trade Marks and Industrial Designs, *Report on Patents of Invention*, (Ottawa ON: Queen’s Printer and Controller of Stationery, 1957) at 10ff and 27.

40 *Universal Copyright Convention of 6 September 1952*, 6 September 1952, TRT/UNESCO1/001 (entered into force 16 September 1955) [UCC], online: <www.wipo.int/wipolex/en/other_treaties/text.jsp?file_id=172836>.

41 Canada, Economic Council of Canada, *Report on Intellectual and Industrial Property* (Ottawa, ON: Information Canada, 1971) at 42 [*Report on Intellectual and Industrial Property*].

42 Andrew A Keyes & Claude Brunet, *Copyright in Canada: Proposals for a Revision of the Law*, (Ottawa, ON: Consumer and Corporate Affairs Canada, 1977) at 22.

43 Ysolde Gendreau, “Surfacing: The Canadian intellectual property identity” in Ysolde Gendreau, ed, *An Emerging Intellectual Property Paradigm: Perspectives from Canada* (Northampton, MA: Edward Elgar Publishing, 2008) at 298.

level.⁴⁴ Canada's ratification of the UCC is said to have benefited Canadian publishers and marked a watershed moment that enabled publication of Canadian works in Canada without the need of "conjunction with an American publisher, who could secure copyright in the United States."⁴⁵

The UCC is now essentially a dead-letter document. It served some useful purposes between 1962, when Canada adhered to it, and 1989, when the United States finally joined Berne. It was the basis during that time of Canada-US copyright relations. The United States, which was a "major promoter" of the UCC for many years, ratified the UCC in 1954.⁴⁶ Another important country that was a latecomer to Berne was Russia (then the Soviet Union), which joined the UCC in 1973 and Berne in 1995. As such, the UCC served an important purpose by bringing these economically and politically important nations into the copyright fold.

The main purpose of the UCC was to enable certain important countries that were not compliant with key provisions of Berne to enjoy the benefits of international copyright protection without some of the more rigorous obligations incumbent upon Berne members. For example, the minimum term of protection under the UCC was life plus 25 years. Even shorter periods of 25 years from creation were allowed pursuant to article IV in countries where protection was computed from first publication or registration.⁴⁷ Moreover, of critical importance for countries such as the United States, which had a system at the time that was heavily dependent upon formalities such as registration, was that such countries could maintain formalities for their own nationals, but foreigners could comply with basic formalities, even for works published outside of the country, by means of the now-ubiquitous copyright symbol "©" along with the name of the copyright owner and the year of publication.⁴⁸

The Quad Movement and Canada's Role in the 1980s and Beyond

For a brief period of time in the 1980s and early 1990s, Canada played a very influential role in the inclusion of IP law in the emerging negotiations that would culminate in the Uruguay Round and the 1994 TRIPS agreement. As previously stated, the Quad consisted of Canada, the European Union, Japan and the United States. Given the disparity of economic significance between Canada and the other three Quad members, Canada's presence was somewhat curious. The question is how and why Canada seemed eager to position itself as one of the four leading proponents of higher levels of IP protection when the Economic Council, barely a dozen years earlier, suggested that Canada's interests lay more with the developing countries.⁴⁹

Despite an apparent common interest, there are said to have been significant differences between the Quad members, and the negotiations began to focus, for a time, beginning in the second half of 1991, on internal discussions within the Quad.⁵⁰ There has been criticism of the role of the "highly disturbing" trend of decisions taken by the Quad and allegedly presented to WTO members as a *fait accompli* and as reflecting Western interests, law and values.⁵¹ Perhaps the other WTO members were more receptive than they might otherwise have been at the time, because the Quad group "agreed to eliminate most tariffs in several sectors."⁵² It remains to be seen whether Canada's prominent Quad role ultimately served Canada's interest, or whether Canada was to some extent seduced into being something of a lapdog and enabler for the other much more powerful members of that group.

44 The UCC was revised in Paris, France, on July 24, 1971. The WIPO list of signatories to the UCC with accession and ratification dates is available at WIPO, "Other IP Treaties", online: <www.wipo.int/wipolex/en/other_treaties/parties.jsp?treaty_id=208&group_id=22>.

45 Eli Maclaren, *Dominion and Agency: Copyright and the Structuring of the Canadian Book Trade, 1867–1918* (Toronto, ON: University of Toronto Press, 2011) at 142.

46 Gervais, *supra* note 33 at 9.

47 UCC, *supra* note 40, art IV.

48 *Ibid*, art III(1).

49 *Report on Intellectual and Industrial Property*, *supra* note 41 at 42–43.

50 Susan K Sell, "Industry Strategies for Intellectual Property and Trade: The Quest for TRIPS, and Post-TRIPS Strategies" (2002) 10 *Cardozo J Intl & Comp L* 79 at 94, 96.

51 Ruth Gordon, "Contemplating the WTO from the Margins" (2006) 17 *Berkeley La Raza LJ* 95 at 102–103.

52 Kevin C Kennedy, "The GATT–WTO System at Fifty" (1997) 16 *Wis Intl LJ* 421.

The Trend away from Multilateralism and toward Plurilateral and Bilateral Deals

In the face of growing sophistication on the part of developing countries, changes in geopolitics and the advent of the internet, it is not surprising that the Doha development round of trade negotiations, which would have updated the 1994 WTO agreement, was doomed to failure. In light of the Doha Declaration on the TRIPS Agreement and Public Health, according to Peter Yu, “the European Union, Japan, the United States, and other demandeur countries were understandably reluctant to push for higher intellectual property enforcement standards in the WTO.”⁵³

There is currently little hope of progress toward a new WTO treaty, since the Doha Round seems moribund (even if not yet officially declared to be dead). Even before US President Donald Trump’s effort to withdraw the United States from its traditional international role, more modest plurilateral efforts were foundering. Some notable failed efforts are as follows.

Failed Efforts

The Free Trade Area of the Americas (FTAA) initiative, led by the United States, was to have been an ambitious multilateral agreement, which would have included 34 countries in North and South America, including Canada. However, the Americans misjudged the politics of “Bolivarism,” led by Venezuelan President Hugo Chávez.⁵⁴ The FTAA famously failed on the streets of Miami in 2003, amid much publicity, notwithstanding the concession won by Brazil that would have allowed it to “participate in the FTAA without conceding to the ministerial’s

rule on contentious issues, such as agriculture, intellectual property, and investment policy.”⁵⁵

The catastrophic collapse of the Anti-Counterfeiting Trade Agreement (ACTA) was also a significant blow to plurilateral TRIPS Plus activity. If ACTA had come into force, it would have ultimately included Canada, Australia, the European Union and its member countries, Japan, Korea, Mexico, Morocco, New Zealand, Singapore, Switzerland and the United States.⁵⁶ Global Affairs Canada has provided a convenient repository of documents concerning Canada’s enthusiastic involvement in this initiative.⁵⁷ Canada signed the proposed treaty, which it described at the time as “historic,” on October 1, 2011, along with Australia, Japan, Morocco, New Zealand, the Republic of Korea, Singapore and the United States.⁵⁸

The potential of ACTA to give unwarranted and unnecessary *ex officio* seizure powers to border officials, who could invoke such powers without a court order, was a serious concern. These powers “could be highly disruptive of established user rights and exceptions under Canadian copyright law, such as fair dealing, where the complex nature of the inquiry demands that the proper preserve for the inquiry be with the courts rather than customs officials.”⁵⁹

ACTA was ultimately defeated by civil society protest. The attempts by governments to negotiate in secret were undermined by leaks. The issues were reported widely online and soon became the subject of protests in major European cities. Eventually, the proposed agreement was rejected by the European Parliament in June 2012 by 478 votes to 39, with 165 abstentions.⁶⁰

53 Yu, *supra* note 8 at 505.

54 Kimberly Amadeo, “FTAA: Agreement, Members, Pros and Cons: Why the World’s Largest Trade Zone Failed” (27 October 2016), *the balance* (blog), online: <www.thebalance.com/ftaa-agreement-member-countries-pros-and-cons-3305577>.

55 Joel Wainwright & Rafael Ortiz, “The battles in Miami: the fall of the FTAA/ALCA and the promise of transnational movements” (2006) 24:3 *Environment and Planning D: Society and Space* 349 at 358.

56 *Anti-Counterfeiting Trade Agreement*, October 2011 (not yet in force), online: <www.international.gc.ca/trade-agreements-accords-commerciaux/topics-domaines/ip-pi/acta-text-acrc.aspx?lang=eng>.

57 *Ibid.*

58 Canada, Global Affairs Canada, “Canada Signs Historic Anti-Counterfeiting Trade Agreement” (30 September 2011), online: <www.international.gc.ca/media_commerce/comm/news-communiques/2011/280.aspx?lang=eng>.

59 Elizabeth F Judge & Saleh Al-Sharieh, “Join the Club: The Implications of the Anti-Counterfeiting Trade Agreement’s Enforcement Measures for Canadian Copyright Law” (2012) 49 *Alta L Rev* 677 at 717.

60 Peter K Yu, “TPP and Trans-Pacific Perplexities” (2014) 37 *Fordham Intl LJ* 1129 at 1170–71.

Post-TRIPS Multilateral Limited-success Stories

The limited success and importance of the 1996 WIPO internet treaties appears to have marked the last significant, truly multilateral IP achievement from the viewpoint of rights holders. Of course, from a user point of view, the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled, which was adopted in 2013, was a major, positive, multilateral achievement for the user community, and is discussed further below.

The 1996 WIPO internet treaties comprised two treaties: the WIPO Copyright Treaty;⁶¹ and the WIPO Performances and Phonograms Treaty.⁶² Canada signed both treaties under intense lobbying pressure from American interests in 1997, but did not ratify them until 2014. It has gone largely unnoticed that a related and simultaneous American initiative to establish a database treaty to respond to a European Union directive failed to reach the adoption stage, due in large measure to domestic opposition in the United States.⁶³ It has been suggested that these treaties were instigated at the behest of the American private sector to promote domestic legislation in the United States and elsewhere that might otherwise have been difficult to achieve.⁶⁴ Indeed, the United States' efforts at WIPO in this context were regarded by influential American domestic critics as being "an end run around Congress."⁶⁵

61 WIPO Copyright Treaty, 20 December 1996, WIPO Doc CRNR/DC/94 (entered into force 6 March 2002).

62 WIPO Performances and Phonograms Treaty, 20 December 1996, WIPO Doc CRNR/DC/95 (entered into force 20 May 2002).

63 Julie S. Sheinblatt, "The WIPO Copyright Treaty" (1998) 13 Berkeley Tech L J 535 at 538. Pamela Samuelson, "The U.S. Digital Agenda at WIPO" (1997) 37 Va J Intl L 369 at 425.

64 Musungu & Dufield, *supra* note 28 at 15.

65 Samuelson, *supra* note 63 at 374.

The 2013 WIPO Marrakesh Treaty

The Marrakesh Treaty,⁶⁶ often referred to as the Treaty for the Blind or VIP Treaty, is perhaps the most recent successful, multilateral IP-treaty effort and a welcome change from the relentless trend toward increasing minimum rights for intellectual property right owners in international treaties. The treaty "was designed to alleviate a problem known as the 'book famine' where 'only a small fraction of published books — estimated at less than 7 percent — are made in accessible formats.'"⁶⁷ The treaty was adopted on June 27, 2013, and entered into force on September 30, 2016. Canada was among the first 20 ratifications and implemented the treaty with less than perfect, but still encouraging, legislation⁶⁸ in the form of Bill C-11, which received royal assent on June 22, 2016.⁶⁹

There is little doubt that civil society, effectively led by Knowledge Ecology International (KEI) under the leadership of the redoubtable Jamie Love, played a major role in the adoption of this treaty.⁷⁰ This milestone should serve to encourage and empower future civil society and "distributive justice"⁷¹ efforts.

66 Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled, 27 June 2013 (entered into force 30 September 2016), online: <www.wipo.int/treaties/en/ip/marrakesh/>.

67 Krista L. Cox, "Research Libraries and New Technologies, Promoting Access to Information, Learning, and Innovation for Today and the Future" (2016) 13 I/S: J.L. Pol'y Information Society 261 at 287 [footnote omitted].

68 Dara Lithwick, "Legislative Summary of Bill C-11: An Act to amend the Copyright Act (access to copyrighted works or other subject-matter for persons with perceptual disabilities)" (Ottawa, ON: Library of Parliament Research Publications, 2016), online: <https://lop.parl.ca/About/Parliament/LegislativeSummaries/bills_ls.asp?Language=E&ls=c11&Parl=42&Ses=1&source=library_prb>.

69 Bill C-11, "An Act to amend the Copyright Act (access to copyrighted works or other subject-matter for persons with perceptual disabilities)", 1st Sess, 42nd Parl (2016), online: <www.parl.ca/legisinfo/BillDetails.aspx?billid=8164424&Language=E&Mode=1>.

70 Sara Bosely, "Big Pharma's worst nightmare", *The Guardian* (26 January 2016) online: <www.theguardian.com/society/2016/jan/26/big-pharmas-worst-nightmare>; see also KEI's closing statement at Marrakesh: James Love, "KEI Closing statement at Marrakesh", Knowledge Ecology International (28 June 2013), online: <<https://keionline.org/node/1768>>.

71 Shlomit Yanisky-Ravid, "The Hidden Though Flourishing Justification of Intellectual Property Laws: Distributive Justice, National versus International Approaches" (2017) 21 Lewis & Clark L Rev 1, at 10 et passim.

The Past, Present and Future of WIPO

The Paris Convention for the Protection of Industrial Property was adopted in 1883. The original signatories were Belgium, Brazil, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Serbia, Spain and Switzerland.⁷² Berne was adopted in 1886, with original signatories Belgium, France, Germany, Great Britain, Haiti, Italy, Liberia, Spain, Switzerland and Tunisia.⁷³ Prior to these treaties, international legal mechanisms for the protection of IP were a fragmented and largely ineffective patchwork. The authoritative treatise by Sam Ricketson and Jane Ginsburg on the emergence of the bilateral agreements that preceded Berne indicates that although the first bilateral agreements were between Prussia and the other German states, between 1827 and 1829, the United Kingdom and France were the “main actors” in this movement in the 1840s and 1850s.⁷⁴ An important basis of these early agreements was national treatment,⁷⁵ a concept that is now taken for granted but was novel at the time.

For a century following the adoption of Paris and Berne, the centre of gravity of IP treaties was Switzerland. An important feature of Paris and Berne was that they established a permanent mechanism, or union, that eventually came to include a permanent building in Geneva and the establishment of WIPO. The union created under both these conventions became the United International Bureau for the Protection of Intellectual Property (BIRPI). BIRPI, which had substantial premises next to the current and vastly larger WIPO headquarters,

was assimilated into the United Nations and renamed WIPO⁷⁶ on April 26, 1970.

In its latest budget for 2016/2017, WIPO forecasted income of CHF748,200,000 and expenditures of CHF727,400,000, giving an operating result of over CHF20,800,000.⁷⁷ (At the time of writing, one Swiss franc equals approximately CDN\$1.29.) Despite WIPO’s immense resources, including a staff of 1,247 by mid-2015, it has become essentially ineffective in terms of policy development and the achievement of any actual positive law outcomes in the form of treaties. This is the result of many developments well beyond the scope of this paper.

Canada’s Role in WIPO

For a time, Canada played a very small role in activities concerning either Berne or Paris.⁷⁸ This began to change in the 1970s and, in the 1980s and afterwards, Canada has regularly sent mid-level officials to participate in meetings of experts and diplomatic conferences. However, Canada has never taken proactive steps to secure the appointment of a Canadian IP expert in a significant senior professional policy position at WIPO. Such an appointment clearly could have been mutually beneficial to Canada and WIPO. WIPO appointments at or close to the senior professional level, especially at the director, assistant and deputy director-general levels, require the support and active lobbying of the home country of such an official.

The reason for Canada’s failure to contribute policy expertise to WIPO at a significant professional level may relate to the fact that Canada, unlike the United States, rarely allows its officials with significant IP expertise to rise to high levels, even within the Canadian government. For example, the last Canadian commissioner of patents with a permanent (in other words, not acting) appointment and with

72 International Bureau of Intellectual Property, *The Paris Convention for the Protection of Intellectual Property from 1883 to 1983* (Geneva, Switzerland: WIPO, 1983) at 23.

73 International Bureau of Intellectual Property, *The Berne Convention for the Protection of Literary and Artistic Works from 1886 to 1986* (Geneva, Switzerland: WIPO, 1986) at 19.

74 Sam Ricketson & Jane Ginsburg, *International Copyright and Neighbouring Rights*, 2nd ed (Oxford, UK: Oxford University Press, 2005) vol 1 at 27–29.

75 Sam Ricketson, “The Birth of the Berne Union” (1996) 11 *Columbia-VLA JL & Arts* 9 at 15.

76 Convention Establishing the World Intellectual Property Organization, 14 July 1967, WIPO Doc TRT/CONVENTION/002 (entered into force 26 April 1970), online: <www.wipo.int/wipolex/en/details.jsp?id=12830>.

77 WIPO, “Program and Budget for the 2016/17 Biennium” (14 October 2015), online: <www.wipo.int/export/sites/www/about-wipo/en/budget/pdf/budget_2016_2017.pdf>.[=

78 Bannerman, *supra* note 30 at ch 9, 10.

widely recognized experience and expertise in the patent system was J. H. André Gariépy, who retired in 1992. Indeed, even the role of commissioner of patents is largely operational.

Canada's Interests Re: State-to-State Dispute Settlement and Investor-State Dispute Settlement

Canada agreed in NAFTA to the inclusion of an investor-state dispute settlement (ISDS) regime, whereby a foreign investor could challenge state actions under certain circumstances and claim substantial damages. Such challenges lack the diplomatic nuances and safeguards of state-to-state dispute settlement as exemplified in the WTO. They effectively give foreign investors greater rights than domestic parties and, as shown below, can be used to attempt to overturn a decision of the highest court in a country, such as Canada, where the rule of law is beyond reproach. The details of this mechanism and its long and controversial history are beyond the scope of this paper. However, there is growing belief that the mechanism should be “scrapped” in NAFTA — even in the opinion of Gordon Ritchie, one of the main architects of Canada’s trade policy in the 1980s.⁷⁹

The most interesting and important IP investor-state dispute to date involving Canada has been, by far, the challenge by Eli Lilly, involving the promise doctrine in Canadian patent law.⁸⁰ A number of decisions from the Federal Court of Appeal and the Federal Court had, for more than a decade, held that a promise found in the claims of a patent that could not be either demonstrated or soundly predicted to be accurate would render the patent

invalid for lack of utility. Not being content with the rulings of Canadian courts, Eli Lilly filed its first notice of intent pursuant to Chapters 11 and 17 of NAFTA in 2012. It alleged, *inter alia*, expropriation and denial of fair and equitable treatment. In 2013, Eli Lilly sought leave to appeal one of the adverse decisions to the Supreme Court of Canada (SCC) and was granted the extraordinary and highly unusual opportunity to make oral submissions on this matter. The submissions were heard on May 13, 2013, and the SCC rejected the leave application on May 16, 2013.⁸¹ Shortly afterwards, on June 13, 2017, Eli Lilly withdrew its first notice of intent and filed a second NAFTA ISDS notice.⁸² Canada chose not to preemptively challenge the NAFTA ISDS proceedings on jurisdictional grounds. This strategy not only put at serious and needless risk the particular issue, but also, even more seriously, exacerbated the very real possibility that decisions of Canada’s highest courts could be challenged by a NAFTA arbitration panel.

The SCC apparently had some interest in the international law aspects of this litigation. Then still sitting (now retired) SCC Justice Marshall Rothstein indicated, at a conference in 2013 at Osgoode Hall Law School, that the leave to appeal application might have been granted in this instance if the opinions of the eminent jurists, retired Lord Justice of Appeal Sir Robin Jacob (United Kingdom Court of Appeal) and retired Chief Judge Paul Michel (Court of Appeals for the Federal Circuit in the United States), in support of the leave to appeal application, had been in evidence in the lower court proceedings and had been subjected to cross-examination.⁸³

Soon thereafter, the SCC granted leave to appeal in another promise case, involving Sanofi, but this was settled, controversially, on a confidential basis and was discontinued on November 3, 2014, the eve of

79 Gus Van Harten, “Is It Time to Redesign or Terminate Investor-State Arbitration? A clean break is needed to restore trust, but these stiff tests must be met” (11 April 2017), online: CIGI <www.cigionline.org/articles/it-time-redesign-or-terminate-investor-state-arbitration>, citing Gordon Ritchie, “Canada can’t afford to play nice if Trump triggers NAFTA talks”, *The Globe and Mail*, 9 January 2017.

80 E Richard Gold & Michael Shortt, “The Promise of the Patent in Canada and Around the World” (2014) 30 CIPR 35; Norman Siebrasse, “The False Doctrine of False Promise” (2013) 29 CIPR 3.

81 *Eli Lilly Inc v NovaPharm Ltd*, 2012 FCA 232, leave to appeal to SCC refused, 35067 (16 May 2013), online: <www.scc-csc.ca/case-dossier/info/dock-regi-eng.aspx?cas=35067>.

82 *Eli Lilly & Co v Canada*, Notice of Intent, 7 November 2012, ICSID Case No UNCT/14/2, online: <www.international.gc.ca/trade-agreements-accords-commerciaux/assets/pdfs/disp-diff/eli-01.pdf>. *Eli Lilly & Co v Canada*, Notice of Intent, 13 June 2013, ICSID Case No UNCT/14/2, online: <www.international.gc.ca/trade-agreements-accords-commerciaux/assets/pdfs/disp-diff/eli-02.pdf>.

83 Marshall Rothstein, *Advocacy in Intellectual Property Litigation in the Supreme Court of Canada* (2014) 26 IPJ 145 at 148.

the hearing.⁸⁴ Eventually, the SCC heard a case on the promise doctrine involving AstraZeneca and Apotex. Meanwhile, the NAFTA panel had been deliberating on Eli Lilly's ISDS challenge. There is no doubt, and the record is indeed clear, that the SCC was aware of the NAFTA proceedings, and the NAFTA arbitrators were presumably aware of the pending AstraZeneca litigation in the court.⁸⁵

The nature and timing of the results is both interesting and puzzling. The SCC heard the AstraZeneca case on November 8, 2016.⁸⁶ Four months later, and before the SCC issued its judgment (which it usually issues about six months after the oral hearing), the NAFTA panel issued a final award on March 16, 2017.⁸⁷

The tribunal stated:

Furthermore, the Tribunal finds that Respondent has asserted a legitimate public policy justification for the promise doctrine.... The Tribunal need not opine on whether the promise doctrine is the only, or the best, means of achieving these objectives. The relevant point is that, in the Tribunal's view, the promise doctrine is rationally connected to these legitimate policy goals.

The Tribunal has already concluded that there was no fundamental or dramatic change in Canadian patent law. In the circumstances presented in these proceedings, the evolution of the Canadian legal framework relating to Claimant's patents cannot sustain a claim of arbitrariness or discrimination going to a violation of NAFTA Articles 1105(1) or 1110(1).⁸⁸

This ISDS ruling was, for Canada, "at best a temporary, partial, or even pyrrhic victory."⁸⁹ Less than three months later, on June 30, 2017, the SCC issued its decision in *AstraZeneca v Apotex*.⁹⁰ It has been said that the result indicated that "Canada has conceded the war."⁹¹

The SCC ruled that "the Promise Doctrine undermines a key part of the scheme of the Act; it is not good law."⁹² The decision of the SCC, which was much less detailed than the NAFTA arbitration award, may have brought considerable relief to the "innovative" pharmaceutical industry and its patent practitioners. However, it raises questions that are beyond the scope of this paper, including, for example, whether and how the opinions of retired judges from other jurisdictions on the adequacy of Canadian law should find their way into SCC proceedings, even if only at the application for leave to appeal stage. It remains to be seen whether the promise doctrine is truly dead, or whether this is about to become a story of "the promise doctrine is dead; long live the promise doctrine."⁹³ It is also conceivable that the SCC's decision in *AstraZeneca*, which arguably reversed six decades of steadily evolving Canadian law, now represents a sudden change in Canadian law of a sufficiently egregious nature to attract the attention and potential jurisdiction of another NAFTA ISDS challenge.

The NAFTA award in *Eli Lilly* leaves the door open to future challenges where a tribunal could find that jurisprudence from domestic courts has not progressed in an "incremental and

84 *Apotex Inc v Sanofi-Aventis*, 2013 FCA 186, leave to appeal to SCC granted, 35562 (30 January 2014), discontinued (3 November 2014), online: <www.scc-csc.ca/case-dossier/info/dock-regi-eng.aspx?cas=35562>.

85 *AstraZeneca Canada Inc v Apotex Inc*, 2017 SCC 36 [AstraZeneca decision]. See SCC docket entry of 22 March 2017 [AstraZeneca docket], online: <www.scc-csc.ca/case-dossier/info/dock-regi-eng.aspx?cas=36654>.

86 *AstraZeneca decision*, *supra* note 85.

87 *Eli Lilly & Co v Canada*, Final Award, 16 March 2017, ICSID Case No UNCT/14/2, online: <http://icsidfiles.worldbank.org/icsid/ICSIDBLOBS/OnlineAwards/C3544/DC10133_En.pdf>.

88 *Ibid* at paras 423, 442 [emphasis added, footnote omitted].

89 Brook K Baker & Katrina Geddes, "The Incredible Shrinking Victory: *Eli Lilly v. Canada*, Success, Judicial Reversal, and Continuing Threats from Pharmaceutical ISDS" (6 July 2017) Northeastern University School of Law Research Paper No 296-2017 at 3, online: <<https://ssrn.com/abstract=3012538>>.

90 *AstraZeneca decision*, *supra* note 85.

91 Baker & Geddes, *supra* note 89 at 2.

92 *AstraZeneca decision*, *supra* note 85 at para 51.

93 Apotex very unusually asked the SCC on August 29, 2017, to amend the judgment and for a rehearing. This was rejected. *AstraZeneca docket*, *supra* note 85.

predictable manner.”⁹⁴ As Yu has observed in an important, recent article on ISDS, “if Canada did abandon the doctrine in an effort to settle the investment dispute with Eli Lilly, it would have to stand ready to face ISDS complaints from generic drug manufacturers.”⁹⁵

It is ironic that Canada has now abandoned the promise doctrine and has arguably done so dramatically and abruptly after six decades of consistent jurisprudential development.⁹⁶ Even more ironic is the fact that this reversal comes not at the behest of Parliament, but from the SCC. This development is bound to have an important political effect on the NAFTA renegotiation process, although this was doubtless not the intention of the SCC.⁹⁷ It would be troubling if the potential threat of ISDS proceedings came to be viewed as a way to influence not only the deliberations of Canada’s Parliament, but also of the Canadian courts. One can imagine challenges based upon assertions of “fundamental or dramatic change” arising in IP-related areas, ranging from trademark-related issues involving tobacco and cannabis labelling, to copyright issues related to fair dealing in the context of education.

Canada and CETA

Canada and the European Union signed CETA on October 30, 2016. In order to implement this agreement, certain changes have been made in Canadian IP legislation.

With respect to trademarks, Canada will now be required to comply with the Singapore Treaty on the Law of Trademarks⁹⁸ as well as the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007).⁹⁹ This will result in some changes in trademarks practice and, possibly, some litigation because of the much diminished importance of the requirement of use for trademark registration in Canada. One noted practitioner believes that the new legislation may indeed be unconstitutional insofar as it fundamentally changes the requirement for use.¹⁰⁰ There will also be enhanced protection for geographical indications.¹⁰¹

With respect to patents, there are two main changes resulting from CETA. First, there will be a supplementary protection for pharmaceutical products. This will be in the form of a certificate of supplementary protection available where there are lengthy delays for regulatory approval of new drugs.

More importantly, there will be major changes to the Patented Medicines Notice of Compliance (PMNOC) litigation regime. This will mean the elimination of the troubled two-track PMNOC applications and litigation proceedings regime that has existed for many years in Canada’s Federal Court. Under the new system, as required by CETA, the proceedings will be in the form of a single action with discoveries and live witnesses (in contrast to an application in which there is no oral evidence) and will also deal with *in rem* validity and infringement determinations. All of this must be dealt with within 24 months from beginning to judgment, which will include a hearing of, normally, two weeks maximum, to take place at least three months before the end of the two-year period to allow the judge time to write a

94 Baker & Geddes, *supra* note 89 at 21, citing Robert Howse in “Eli Lilly v Canada: A Pyrrhic Victory against Big Pharma” (26 March 2017), *International Economic Law & Policy* (blog) at 3 online: <<http://worldtradelaw.typepad.com/ielpblog/2017/03/eli-lilly-v-canada-a-pyrrhic-victory-against-big-pharma.html>> and Howard Knopf, “Canada Won the Eli Lilly NAFTA ISDS Battle Bigly but Who Will Win the War?” (1 May 2017), *Excess Copyright* (blog), online: <<http://excesscopyright.blogspot.com/2017/05/canada-won-eli-lilly-nafta-isds-battle.html>> (arguing that Canada made a fundamental mistake by not raising the absence of a fundamental denial of justice as a jurisdictional challenge to Eli Lilly’s case and instead merely arguing that domestic courts must be afforded “substantial deference,” leaving the door open to future ISDS challenges to IP rulings).

95 Peter K Yu, “The Investment-Related Aspects of Intellectual Property Rights” (2017) 66 *Am U L Rev* 829 at 864.

96 Gold & Shortt, *supra* note 80 at 57.

97 Knopf, “Canada Can Stand Its Ground”, *supra* note 14.

98 *Singapore Treaty on the Law of Trademarks*, 16 March 2009, online: WIPO <www.wipo.int/wipolex/en/treaties/text.jsp?file_id=290019>.

99 *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007)*, 12 November 2007, online: WIPO <www.wipo.int/wipolex/en/treaties/text.jsp?file_id=290019>.

100 Daniel R Bereskin, “Canada’s Ill-Conceived New ‘Trademark’ Law: A Venture Into Constitutional Quicksand” (2014) 104:5 *Trademark Reporter* 1112, online: <www.bereskinparr.com/files/file/docs/Canada%20Ill-Conceived%20New%20Trademark%20Law.pdf>.

101 Bassem Awad & Marsha S Cadogan, “CETA and the Future of Geographical Indications Protection in Canada” CIGI, CIGI Papers No 131, May 2017, online: <www.cigionline.org/sites/default/files/documents/Paper%20no.131_WEB_0.pdf>.

decision.¹⁰² The Federal Court of Canada has spelled out how this will be done in its Notice to the Parties and the Profession dated September 21, 2017.¹⁰³

A notable aspect of CETA in respect of IP is what it did not do. Canada clearly stood its ground with respect to the controversial issue of copyright term extension. The European Union has long had a requirement for a life-plus-70 copyright term, and the concern was that this might be urged on Canada in the negotiation process. If this did happen, Canada clearly and successfully resisted. This should serve as a successful precedent and useful ammunition against the expected demands from the US government for a life-plus-70 term in any renegotiated NAFTA. The financial cost of such a measure, based on a careful New Zealand government study, is estimated to be approximately CDN\$454 million per annum, or a present-value cost of more than \$4.2 billion.¹⁰⁴

IP Issues that May Eventually Require International Treaty Consideration

If IP, in its current territorial framework, and truly free trade are ever to be successfully integrated, there are two issues of potentially existential importance for the future of free trade and the internet that may ultimately require resolution at the treaty level. These are parallel importation and jurisdiction with respect to extraterritorial or cross-border orders.

The Parallel Imports/Exhaustion Issue and Free Trade

The exhaustion doctrine entails that, when goods have been placed on the market by or with the consent of the IP owner, nobody can use IP rights to control resale of the product. The IP rights are said to have been exhausted. The doctrine can be applied at the national level, where it is sometimes called the “first sale” doctrine. However, in its pure form, it applies internationally. Many, though not all, IP owners are opposed to the doctrine because it limits or prevents their ability to practise price discrimination and market segmentation. They have sometimes tried to justify rent-seeking with arguments such as that goods sold at the lower price in developing countries will then be reimported back into countries where consumers can pay higher prices, with the result that the benefits and efficiency-enhancing aspects, if any, of benign price discrimination cannot be sustained.

Generally, common-law courts have tended to embrace the international exhaustion doctrine. The same cannot be said for the Court of Justice of the European Union in Europe, which approaches these cases from a civil-law point of view and a strong “Fortress Europe” mentality.¹⁰⁵ There have been some important recent decisions in the Canadian and American supreme courts. In Canada, copyright law was unable to prevent the parallel importation of Toblerone chocolate bars.¹⁰⁶ In the United States, copyright law was unable to prevent the importation and resale of American textbooks lawfully made and purchased abroad at a much lower price than the publisher charged in the US market.¹⁰⁷ Also in the United States, patent law was unable to prevent the importation of patented toner

102 Canada, Federal Court of Canada, “Statistics”, online: <http://cas-cdc-ww02.cas-satj.gc.ca/portal/page/portal/fc_cf_en/Statistics>.

103 Canada, Federal Court of Canada, “Notice to the Parties and the Profession: Guidelines for Actions under the Amended PMNOC Regulations”, 21 September 2017, online: <[http://cas-cdc-ww02.cas-satj.gc.ca/fct-cf/pdf/Notice%20-%20PMNOC%20Guidelines%20\(FINAL\)%2021sept2017%20English-REFORMATTED.pdf](http://cas-cdc-ww02.cas-satj.gc.ca/fct-cf/pdf/Notice%20-%20PMNOC%20Guidelines%20(FINAL)%2021sept2017%20English-REFORMATTED.pdf)>.

104 Howard Knopf, “The Cost of Canadian Copyright Term Extension Capitulation in the TPP – Estimates Based Upon New Zealand Study” (17 November 2015), *Excess Copyright* (blog) online: <<http://excesscopyright.blogspot.ca/2015/11/the-cost-of-canadian-copyright-term.html>>.

105 For international exhaustion as it pertains to the European Union, see Irene Calboli & Edward Lee, eds, *Research Handbook on Intellectual Property Exhaustion and Parallel Imports* (Cheltenham, UK: Edward Elgar Publishing, 2016) and, in particular, Susy Frankel & Daniel Gervais, “International Intellectual Property Rules and Parallel Imports” (*ibid* at 100) and Christopher M Stothers, “The European Internal Market: Exhaustion Plus” (*ibid* at 177).

106 *Euro-Excellence Inc v Kraft Canada Inc*, [2007] 3 SCR 20, 2007 SCC 37 [*Euro-Excellence*]. I should disclose that I made the prevailing arguments in this case on behalf of the intervener, Retail Council of Canada, and presented a brief commentary on the case to the Law Society of Upper Canada: Howard Knopf, “Case Comment on *Euro-Excellence Inc v Kraft Canada Inc*”, 2007 SCC 37, online: <www.macerajarzynna.com/pages/publications/Knopf_Kraft_Canada_Feb2008.pdf>.

107 *Kirtsaeng v John Wiley*, 568 US 519, 133 S Ct 1351 (2013) [*Kirtsaeng*].

cartridges available at a much lower cost than the US patentee was charging in the United States.¹⁰⁸

Treaties have tended to avoid this issue, if they deal with it at all, by explicitly leaving the doctrine open to members without either actively requiring or prohibiting international exhaustion. Attempts at the margins to encourage the export of legitimate medicines to developing countries through compulsory licenses and other work-arounds of patent law have largely failed.¹⁰⁹

In the TRIPS negotiations, the parties apparently concluded that the issue was “intractable.”¹¹⁰ The solution was an explicit exclusion in article 6 of the TRIPS agreement of the issue from the dispute-settlement mechanism, thereby leaving parties, effectively, to do as they wish.

The time may come, although it will not likely be soon and the negotiation will likely be very difficult, when a treaty will be considered that requires member states to provide for international exhaustion with respect to either or both of physical goods and digital communications. Arguably, there can never be truly free trade without such a regime.

Cross-border Issues

On June 23, 2017, the SCC rendered a controversial cross-border enforcement decision in *Google v Equustek*.¹¹¹ It upheld a worldwide injunction requiring Google to de-index certain allegedly infringing websites. The decision illustrates the difficulties that can arise when courts assume jurisdiction to issue judgments with extraterritorial effects involving IP in the age of the internet, and when courts in other countries may or may not be willing to enforce such judgments.

The plaintiffs had succeeded in getting an interlocutory injunction from the lower courts in British Columbia in a case that had proceeded on a default basis, involving unregistered trademark

and trade secrecy issues. So far, this would have been a relatively unremarkable IP case — apart from the fact that interlocutory injunctions in IP cases have been very rare in Canada in recent times. However, the plaintiff persuaded the lower courts to extend the injunction to force Google to de-index all the allegedly offending websites of the defendants, not only in Canada, using a www.google.ca search, but also around the world, using a www.google.com search. Surprisingly, considering the interlocutory state of affairs and very sparse record, the SCC took the case.

The result is a troubling ruling that upholds the worldwide injunction and opens the doors to British Columbia — or any other Canadian jurisdiction that may hand out interlocutory injunctions based on little proven evidence — becoming a tourist destination for tenuous and even simply local IP rights in Canada and for other litigants looking for a one-stop shop to shut down any alleged infringer that depends on Google to be found online. The result might make sense in certain difficult fact situations, such as a revenge porn or a defamation case, in which it is completely impractical for a plaintiff to sue in multiple jurisdictions. However, it makes little sense in an apparently weak IP case involving only local IP rights with almost no evidentiary record. At the time of writing, Google has obtained preliminary injunctive relief against the enforcement of the SCC’s order in an unopposed proceeding in the Northern District of California on the basis that “the Canadian order undermines the policy goals of Section 230 [of the *Communications Decency Act*] and threatens free speech on the global internet.”¹¹² Eventually, a treaty may be needed to deal with the trilogy of issues encompassed by what Paul Goldstein and Bernt Hugenholtz describe as territoriality, national treatment and choice of law.¹¹³

108 *Impression Products Inc v Lexmark International Inc*, 581 US ____ (2017), 137 S Ct 1523 (2017) [Lexmark].

109 Joel Lexchin, “Canada and access to medicines in developing countries: intellectual property rights first” (2013) 9:42 *Globalization & Health*, online: <www.globalizationandhealth.com/content/9/1/42>.

110 See Vincent Chiappetta, “Working toward international harmony on intellectual property exhaustion (and substantive law)” in Calboli & Lee, *supra* note 105 at 125.

111 *Google Inc v Equustek Solutions Inc*, 2017 SCC 34.

112 *Google LLC v Equustek Solutions Inc*, 2017 WL 5000834 (ND Cal), online: <www.eff.org/document/google-v-equustek-nd-cal-order-granting-preliminary-injunction>.

113 Paul Goldstein & Bernt Hugenholtz, *International Copyright: Principles, Law and Practice* (Oxford, UK: Oxford University Press, 2010) at 93.

Final Observations and Conclusions

The high-water mark of Canadian independence from the cross-currents of various pressures to increase IP protection, both domestically and through treaties, was in the 1970s. Canada is now at another crossroad, facing forces once again coming from the United States. Canada has many good arguments that it can and should use to “stand its ground” on issues involving IP and international trade.¹¹⁴ It will be interesting to see whether this will happen.

Canada’s role in recent high-profile developments, such as the negotiations regarding the CPTPP — even in the face of resistance by Japan and Australia — is a signal that Canada is back as an independent voice. By asserting itself in this way, Canada recognizes not only its economic potential in terms of its size, but also its important historical role as an independent and savvy negotiator mindful of its own best national interests and not those of other countries or multinationals. If there ever was a true marriage between IP and trade law, it now seems that its future is at best uncertain. This may bode well for Canada, if it wishes to regain its historic sovereign voice.

Author’s Note

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¹¹⁴ Knopf, “Canada Can Stand Its Ground”, *supra* note 14.



ON CANADA'S PAST, PRESENT AND FUTURE
IN INTERNATIONAL LAW

REFLECTIONS RÉFLEXIONS

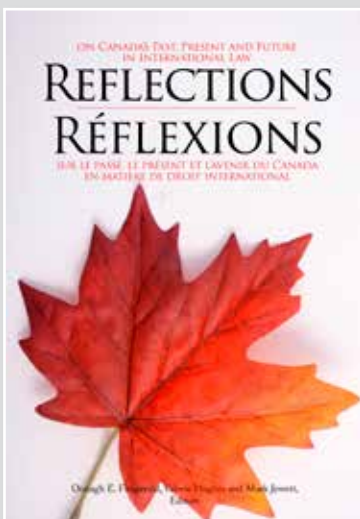
SUR LE PASSÉ, LE PRÉSENT ET L'AVENIR DU CANADA
EN MATIÈRE DE DROIT INTERNATIONAL

Oonagh E. Fitzgerald, Valerie Hughes and Mark Jewett,
Editors

Marking 150 years since Confederation provides an opportunity for Canadian international law practitioners and scholars to reflect on Canada's rich history in international law and governance, where we find ourselves today in the community of nations, and how we might help shape a future in which Canada's rules-based and progressive approach to international law gains ascendancy. These essays, each written in the official language chosen by the authors, provide a critical perspective on Canada's past and present in international law, survey the challenges that lie before us and offer renewed focus for Canada's pursuit of global justice and the rule of law.

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