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25 for 25: IP Milestones from the Last Quarter Century

As 2025 draws to a close, we present a curated set of 25 turning points in Canadian intellectual property law from 2001–2025. Each entry touches on a key Canadian IP development and distills why it matters. These decisions, reforms, and treaty-driven changes moved the dial and continue to shape how businesses build IP portfolios, negotiate deals, and win disputes.

Top 25

1. *Apotex Inc v Wellcome Foundation Ltd* (2002, SCC) – Sound Prediction Clarified
Clearly articulated the sound prediction doctrine for utility. Outlined the need for a factual basis, sound line of reasoning, and disclosure. Furthered patent and pharma early?stage inventions and provided guidance for litigating such inventions.

2. *CCH Canadian Ltd v Law Society of Upper Canada* (2004, SCC) – Copyright "User Rights"
Implemented a principled framework for originality and fair dealing with enduring impact. Reframed fair dealing as a user's right and outlined a structured six?factor analysis central to institutions offering reproduction technologies and services including education, libraries, and platform practices.

3. *Monsanto Canada Inc v Schmeiser* (2004, SCC) – Patent Scope and Accounting of Profits
Genetically modified gene and the cells containing it are patentable. Although "higher life forms" were not at issue, the Court confirmed that a patentee of a gene and modified cells can control their use when embodied in a plant. Growing, saving, replanting, and selling seeds containing the patented trait constitutes use under section 42. The invention was appropriated even without spraying herbicide. On remedies, patentees must prove profits flowed from use of the patented advantage. If the user does not exploit the trait, monetary recovery may be limited.

4. *Kirkbi AG v Ritvik Holdings Inc* (2005, SCC) – Functionality and Passing-off Limits
Confirmed functional product configurations cannot be protected through trade dress or passing off; brand owners should rely on patents or designs for function. Trademarks are reserved for

non?functional, source?identifying get?up or ornamentation. Attempts to extend expired patents through trademark claims will not succeed.

5. *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006, SCC) – Fame, Confusion, and Depreciation of Goodwill
Set enduring guidance on how fame cuts both ways in confusion and how section 22 depreciation operates. Influenced brand enforcement and advertising clearance.

6. *Apotex Inc v Sanofi?Synthelabo Canada Inc* (2008, SCC) – Obviousness Revamped
Introduced a multi-part framework for obviousness which became the backbone of analysis in patent cases addressing inventiveness.

7. *Masterpiece Inc v Alavida Lifestyles Inc* (2011, SCC) – The National Marketplace for Confusion
Clarified the test for confusion and priority between trademarks where one party has prior use and the other has a later application/registration. Affirmed that prior use anywhere in Canada can defeat a later application, even if the parties operated in different regions. Emphasized that resemblance between marks can be dispositive.

8. *Amazon.com Inc v Canada (Attorney General)* (2011, FCA) – Computer?implemented Inventions Are Not Per Se Excluded
Rejected automatic exclusions for business-method patents and confirmed they are not categorically excluded. Clarified how to assess subject-matter eligibility using a purposive, claim? centred construction. Impacted the Canadian Intellectual Property Office's (CIPO) approach to granting patents and had significant knock?on effects for prosecution and litigation strategy.

9. *SOCAN v Bell Canada*; *ESA v SOCAN* (2012, SCC) – Fair Dealing and the Digital/Communication Divide
"Research" includes consumer research and is not confined to scholarly or private study. Royalties are not payable for previews of online music. Downloads are reproductions not communications to the public by telecommunication. Streaming may engage the communication right. When assessing technological neutrality, whether someone receives a copy or merely a transmission is important in terms of economic reality.

10. *Teva Canada Ltd v Pfizer Canada Inc* (2012, SCC) – Sufficiency Demands the Real Invention
Invalidated a blockbuster patent for inadequate disclosure and clarified disclosure and enablement requirements. For a patent

to be sufficient it should disclose and enable the effective compound and not invite a research project.

11. *Copyright Modernization Act* (2012) – Canada's Digital Turn
Introduced user?generated content, notice?and?notice, the making?available right, and technological protection measure (TPM) provisions, rebalancing rights and responsibilities for platforms and creators.

12. *Canadian Broadcasting Corp v SODRAC* (2015, SCC) – Technological Neutrality in Copyright
Established how technological neutrality is a controlling principle. Copyright should neither penalize nor favour the use of new technology. Rightsholders are not entitled to extra remuneration simply because a user's workflow requires additional digital copies unless those provide incremental economic value beyond the license uses. No double recovery for the same economic activity.

13. Patent and Trademark Agent–Client Privilege in Force (in force 2016, via Bill C-59) – Candour With Counsel
Statutory privilege for agents protects the freedom to seek advice during drafting and prosecution by removing discovery risks.

14. *Vancouver Community College v Vancouver Career College* (2017, BCCA) – Passing-off in the Digital Age
Clarified how the traditional passing-off test applies to online marketing, search results, and keyword advertising. Invisible keyword bidding is not misrepresentation, but visible use of a competitor's mark in ads, domains, or initial page displays that misleads at first impression can be.

15. *Google Inc v Equustek Solutions Inc* (2017, SCC) – Global De?indexing Injunctions
Leading authority on the court's power to grant worldwide, mandatory injunctions against non?parties to stop ongoing online wrongdoing. Affirmed that Canadian courts can make *in personam* orders with extraterritorial effects where necessary to ensure effective relief, while recognizing limits grounded in comity, freedom of expression, and practicality.

16. *AstraZeneca Canada Inc v Apotex Inc* (2017, SCC) – Death of the "Promise Doctrine"
Ended the promise doctrine after more than a decade in Canadian utility law. Outlined a new test for utility and removed a significant hurdle that had destabilized patents in Canada.

17. *Canada-European Union Comprehensive Economic and Trade Agreement (CETA) Implementation Act* (2017) – *PM(NOC)* Overhaul and CSPs

Overhauled the *Patented Medicines (Notice of Compliance)* (*PM(NOC)*) regime by converting proceedings into full actions, altering litigation timing, evidence, and exclusivity rules. Introduced patent term restoration with certificates of supplementary protection (CSPs).

18. Bill C?86 Trademark Reforms (2019) – The class?based, Madrid?enabled era
Eliminated use as a filing prerequisite, shortened renewal, added bad?faith invalidity. Put Canada onto treaty frameworks of Madrid, Nice, and Singapore.

19. *Energizer Brands LLC v The Gillette Company* (2020, FCA) – Comparative Ads and Depreciation of Goodwill
Clarified that section 22 depreciation of goodwill does not require confusion. Underscored attention to context and suggested a higher evidentiary burden for plaintiffs, especially where defendants use indirect indicia rather than the registered mark.

20. *York University v Access Copyright* (2021, SCC) – Tariffs and Optional Licences
Reshaped collective licensing rights for copyrighted works. Affirmed a robust, user?rights?centric fair dealing analysis. Clarified that institutions may rely on fair dealing without being compelled to take a licence or pay under a general tariff.

21. *Bell Media Inc v GoldTV.biz* (2019, FC; 2021, FCA) – Site ?blocking Enters the Canadian Toolkit
Recognized the Federal Court's equitable jurisdiction to order site?blocking against piracy services. Provided content owners with a practical online enforcement mechanism beyond notice? and?notice and takedowns.

22. *Nova Chemicals Corp v Dow Chemical Co* (2022, SCC) – Accounting of Profits and Non?infringing Alternatives
Endorsed a principled differential?profits approach in accounting of profit assessments and solidified the role of non?infringing alternatives. Material impact on modelling remedies and settlement.

23. Copyright Term Extension to Life +70 (in force 2022, via CUSMA, Article 20.62) – Longer Protection for Works
Extended protection from life plus 50 years by 20 years. Aligned Canada with key trading partners. Delayed public domain entry of copyrighted works. Extended possible monetization of older copyrighted works. Altered clearance, catalogue valuation, and public-domain planning for publishers, platforms, and cultural institutions.

24. *Benjamin Moore & Co v Canada (Attorney General)* (2023, FCA) – Patentable Subject?matter Test in Flux

Reset the approach to computer-implemented inventions. Removed prescriptive directions from the Federal Court decision and instead reinforced purposive construction. Encouraged framing claims that make computer elements essential and supported by the disclosure.

25. CIPO's Updated Guidance on Computer?implemented Inventions (2023) – Practical Reset on CII/AI Examination
Following the proceedings in the Federal Court and Federal Court of Appeal, CIPO issued revised guidance emphasizing purposive construction over problem–solution and sought to clarify when claimed computer elements are essential. Affected claim drafting, prosecution, and litigation for software and AI? adjacent patents.

Conclusion

Over the past 25 years, Canadian IP strategy has become more focused and interconnected. Key trends include:

1. Principled Approach and Market Relevance: Courts increasingly apply structured, principled tests across patents, copyright, and trademarks. Evidence addressing market relevance has increased in importance.

2. Global and Digital Integration: The digital economy and international treaties have transformed IP opportunities and risks. Cross-border enforcement opportunities are expanding and coordinated strategies are of increasing importance.

3. Evolving Patentable Subject Matter: Computer-implemented inventions have been at the forefront of patentable subject matter with the pendulum continuing to swing. We expect further guidance from the SCC in 2026 on patentable subject matter of methods of medical treatment.

On the Horizon

AI will no doubt reshape the next wave of IP disputes, with anticipated issues spanning who (or what) counts as an author or inventor, patentability criteria, and how to enforce AI-generated brands and works. Businesses that thoroughly document development and proactively stress-test for legal risk will be better prepared to face new challenges. Understanding past IP developments while preparing for future change will help businesses optimize IP rights, win on the merits, and settle on value.