

Integrated Circuit Topography Act (1990, c. 37)

Act current to January 25th, 2011

Attention: See coming into force provision and notes, where applicable.

Integrated Circuit Topography Act

1990, c. 37

[Assented to June 27th, 1990]

An Act to provide for the protection of integrated circuit topographies and to amend certain Acts in consequence thereof

Her Majesty, by and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows:

SHORT TITLE

Short title

1. This Act may be cited as the *Integrated Circuit Topography Act*.

INTERPRETATION

Definitions

2. (1) In this Act,

"commercially exploit"

« *exploitation commerciale* »

"commercially exploit" means to sell, lease, offer or exhibit for sale or lease, or otherwise distribute for a commercial purpose;

"filing date"

« *date de dépôt* »

"filing date", in respect of an application for registration of a topography, means the filing date of the application as determined in accordance with section 17;

"integrated circuit product"

« *circuit intégré* »

"integrated circuit product" means a product, in a final or intermediate form, that is intended to perform an electronic function and in which the elements, at least one of which is an active element, and some or all of the interconnections, are integrally formed in or on, or both in and on, a piece of material;

"Minister"

« *ministre* »

"Minister" means the Minister of Industry;

"national"
« *ressortissant* »

"national", in respect of a country, includes an individual who is a citizen or resident of, or is domiciled in, that country;

"prescribed"
« *Version anglaise seulement* »

"prescribed" means prescribed by regulations;

"register"
« *registre* »

"register" means the register kept pursuant to section 15;

"registered topography"
« *topographie enregistrée* »

"registered topography" means a topography that is registered under this Act;

"Registrar"
« *registraire* »

"Registrar" means the Registrar of Topographies designated pursuant to section 25;

"topography"
« *topographie* »

"topography" means the design, however expressed, of the disposition of
(a) the interconnections, if any, and the elements for the making of an integrated circuit product, or
(b) the elements, if any, and the interconnections for the making of a customization layer or layers to be added to an integrated circuit product in an intermediate form.

Deemed importation or commercial exploitation

(2) For the purposes of this Act, where an integrated circuit product forms part of an article that is imported or commercially exploited, the integrated circuit product shall be deemed to be imported or commercially exploited, as the case may be.

First commercial exploitation of topography

(3) For the purposes of this Act, a topography is first commercially exploited when the topography or a substantial part thereof, or an integrated circuit product that incorporates the topography or a substantial part thereof, is commercially exploited for the first time in any place in the world by or with the consent of the person who owns the right to so commercially exploit the topography at that time and in that place.

Deemed creator of topography

(4) For the purposes of this Act, where a topography is created in the course of employment or pursuant to a contract, the employer or party to the contract for whom the topography was created shall be deemed to be the creator of the topography unless the employer and employee or the parties to the contract, as the case may be, otherwise agree.

1990, c. 37, s. 2; 1992, c. 1, s. 145(F); 1995, c. 1, s. 62.

HER MAJESTY

Binding on Her Majesty

2.1 This Act is binding on Her Majesty in right of Canada or a province.

1994, c. 47, s. 129.

EXCLUSIVE RIGHT

Exclusive right on registration

3. (1) Subject to this Act, the registration of a topography under this Act, unless shown to be invalid, gives to the creator of the topography or, where the topography has been transferred, the successor in title thereto, an exclusive right in the topography for the duration of the period referred to in section 5.

Scope of exclusive right

(2) The exclusive right in a registered topography consists of the exclusive right to

(a) reproduce the topography or any substantial part thereof;

(b) manufacture an integrated circuit product incorporating the topography or any substantial part thereof; and

(c) import or commercially exploit the topography or any substantial part thereof or an integrated circuit product that incorporates the topography or any substantial part thereof.

Rights not conferred

(3) Nothing in this section confers any rights in relation to any idea, concept, process, system, technique or information that may be embodied in a topography or an integrated circuit product.

Conditions of registration

4. (1) Subject to subsection (4), a topography is registrable under this Act only if the following conditions are met:

(a) the topography is original;

(b) an application for registration of the topography, containing the information and material required by subsection 16(2) and accompanied by the fee required by subsection 16(3), is filed with the Registrar before the topography is first commercially exploited or within two years thereafter; and

(c) the creator of the topography is, at the time of its creation or on the filing date of the application,

(i) a national of Canada or an individual or legal entity that has in Canada a real and effective establishment for the creation of topographies or the manufacture of integrated circuit products,

(ii) a national of a country that, either directly or through its membership in an intergovernmental organization, affords protection for topographies in accordance with a convention or treaty to which that country or intergovernmental organization and Canada are contracting parties, or an individual or legal entity that has in such a country or in the territory of a member state of such an intergovernmental organization an establishment of the kind referred to in subparagraph (i),

(iii) a national of a country or of a member state of an intergovernmental organization that the Minister has certified by notice published in the *Canada Gazette* to be a country or intergovernmental organization that confers protection on nationals of Canada or legal entities that have an establishment of the kind referred to in subparagraph (i) that is substantially equal to the protection conferred by this Act, or an individual or legal entity that has in such a country or in the territory of a member state of such an intergovernmental organization an establishment of that kind, or

(iv) a national of a WTO Member.

Originality

(2) For the purposes of subsection (1), a topography is original if the following conditions are met:

(a) it has not been produced by the mere reproduction of another topography or of any substantial part thereof; and

(b) it is the result of an intellectual effort and is not, at the time of its creation, commonplace among creators of topographies or manufacturers of integrated circuit products.

Combinations of elements or interconnections

(3) Where a topography consists of a combination of elements or interconnections that are commonplace among creators of topographies or manufacturers of integrated circuit products, the topography shall be considered to be original only if the combination, considered as a whole, meets the conditions referred to in subsection (2).

Exception

(4) A topography that is not registrable by reason that the condition set out in paragraph (1)(c) cannot be met is registrable if the topography is first commercially exploited in Canada.

Definitions

(5) In this section,

"Commissioner"
« *commissaire* »

“Commissioner” means the Commissioner of Patents;

“WTO Agreement”

« *Accord sur l'OMC* »

“WTO Agreement” has the meaning given to the word “Agreement” by subsection 2(1) of the *World Trade Organization Agreement Implementation Act*;

“WTO Member”

« *membre de l'OMC* »

“WTO Member” means a Member of the World Trade Organization established by Article I of the WTO Agreement.

1990, c. 37, s. 4; 1993, c. 15, s. 25; 1994, c. 47, s. 130.

Duration of exclusive right

5. The exclusive right in a registered topography shall subsist for a period
(a) commencing on the filing date of the application for registration of the topography; and
(b) terminating at the end of the tenth calendar year after the earlier of the calendar year in which the topography is first commercially exploited and the calendar year of the filing date of the application.

Infringement

6. (1) The exclusive right in a registered topography is infringed by any person who does any act referred to in subsection 3(2) without the consent of the owner of the registered topography.

No infringement

(2) Notwithstanding subsection (1), it is not an infringement of the exclusive right in a registered topography for any person
(a) to do any act referred to in paragraph 3(2)(a) or (b) in relation to that registered topography for the sole purpose of analysis or evaluation or of research or teaching with respect to topographies;
(b) to do any act referred to in subsection 3(2) in relation to another topography that is created on the basis of the analysis, evaluation or research referred to in paragraph (a) and that is original within the meaning of subsection 4(2) or (3);
(c) to do any act referred to in paragraph 3(2)(c) in relation to a particular integrated circuit product that incorporates that registered topography or a substantial part thereof, at any time after the time at which that particular integrated circuit product is sold in any place by or with the consent of the person who owned the right to sell that registered topography at that time and in that place;
(d) to do any act referred to in subsection 3(2) where that act is done for a private and non-commercial purpose; or
(e) to bring an integrated circuit product that incorporates that registered topography or a substantial part thereof temporarily into Canada if that integrated circuit product forms part of a vehicle, vessel, aircraft or spacecraft registered in a country other than Canada that enters Canada temporarily or accidentally and is used for a purpose that is necessary or ancillary to that vehicle, vessel, aircraft or spacecraft.

No infringement

(3) For greater certainty, it is not an infringement of the exclusive right in a registered topography for any person to do any act referred to in subsection 3(2) in relation to another topography that is independently created.

Transfer of topography

7. (1) A topography, whether registered or unregistered, is transferable, either as to the whole interest therein or as to any undivided portion thereof.

Licence

(2) A topography, whether registered or unregistered and either as to the whole interest therein or as to any portion thereof, may constitute the subject-matter of a licence.

Government may apply to use registered topography

7.1 (1) Subject to section 7.2, the Commissioner may, on application by the Government of Canada or the government of a province, authorize the public non-commercial use of a registered topography by that government.

Terms of use

(2) Subject to section 7.2, the use of the registered topography may be authorized for such purpose, for such period and on such other terms as the Commissioner considers expedient, but the Commissioner shall settle those terms in accordance with the following principles:

- (a) the scope and duration of the use shall be limited to the purpose for which the use is authorized;
- (b) the use authorized shall be non-exclusive; and
- (c) any use shall be authorized predominantly to supply the domestic market.

Notice

(3) The Commissioner shall notify the owner of the registered topography of any use of the registered topography that is authorized under this section.

Payment of remuneration

(4) Where the use of the registered topography is authorized, the authorized user shall pay to the owner of the registered topography such amount as the Commissioner considers to be adequate remuneration in the circumstances, taking into account the economic value of the authorization.

Termination of authorization

(5) The Commissioner may, on application by the owner of the registered topography and after giving all concerned parties an opportunity to be heard, terminate the authorization if the Commissioner is satisfied that the circumstances that led to the granting of the authorization have ceased to exist and are unlikely to

recur, subject to such conditions as the Commissioner deems appropriate to protect the legitimate interests of the authorized user.

Authorization not transferable

(6) An authorization granted under this section is not transferable.

1994, c. 47, s. 131.

Prescribed uses

7.2 The Commissioner may not, under section 7.1, authorize any use that is a prescribed use unless the proposed user complies with the prescribed conditions.

1994, c. 47, s. 131.

Appeal

7.3 Any decision made by the Commissioner under section 7.1 or 7.2 is subject to appeal to the Federal Court under the *Patent Act*.

1994, c. 47, s. 131.

Regulations

7.4 (1) The Governor in Council may make regulations for the purpose of implementing, in relation to registered topographies, paragraph 2 of Article 37 of the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement.

Definition of "WTO Agreement"

(2) In subsection (1), "WTO Agreement" has the same meaning as in subsection 4(5).

1994, c. 47, s. 131.

LEGAL PROCEEDINGS

ACTION FOR INFRINGEMENT

Action for infringement

8. (1) An action for infringement of the exclusive right in a registered topography may be brought in any court of competent jurisdiction by the owner of the registered topography or by a licensee of any right therein, subject to any agreement between the licensee and the owner.

Each owner to be party

(2) Each owner of a registered topography shall be or be made a party to any action for infringement of the exclusive right therein.

Power of court to grant relief

9. In an action for infringement of the exclusive right in a registered topography, a court of competent jurisdiction may make such orders as the circumstances

require, including orders providing for relief by way of injunction, the payment of royalties and the recovery of damages or profits, for punitive damages, and for the disposal of any infringing integrated circuit product or any article of which an infringing integrated circuit product forms a part.

Innocent infringement

10. Where the exclusive right in a registered topography is infringed by reason of the commercial exploitation or importation of an integrated circuit product that incorporates the registered topography or a substantial part thereof and the defendant in an action for infringement establishes that, at the time the defendant acquired the integrated circuit product, the defendant did not know and had no reasonable grounds to believe that the integrated circuit product was manufactured and sold for the first time without the consent of the owner of the registered topography, the defendant

(a) is not liable for royalties, damages, profits or punitive damages in respect of any dealings with the integrated circuit product prior to the time when the defendant had actual knowledge that the product was manufactured and sold for the first time without the consent of the owner; and

(b) shall have the right to dispose of any inventory of the integrated circuit product or of the article of which the integrated circuit product forms a part that was acquired before the defendant had that knowledge, subject to the condition that the defendant pay a reasonable royalty in respect of that inventory in such amount and at such time as the court may determine.

Infringement after commercial exploitation in Canada

11. (1) Where an integrated circuit product that incorporates a registered topography or a substantial part thereof is commercially exploited in Canada by or with the consent of the owner of the registered topography and an action for infringement is commenced in respect of an act of infringement committed after that commercial exploitation, the plaintiff is not entitled to any relief under section 9 other than by way of an injunction if the defendant establishes that, at the time of the infringement, the defendant was not aware and had no reasonable grounds to suspect that the topography was registered.

Exception

(2) Subsection (1) does not apply if the plaintiff establishes that all or substantially all of the integrated circuit products that were commercially exploited in Canada by or with the consent of the owner of the registered topography before the infringement, or all or substantially all of the containers housing those integrated circuit products, were visibly marked with a title of the topography that is substantially the same as a title thereof that, at the time of the infringement, appeared on the register.

Limitation period

12. (1) Subject to subsection (2), no royalties, damages, profits or punitive damages may be awarded for any act of infringement committed more than three years before the commencement of the action for infringement.

Exception

(2) The limitation period described in subsection (1) does not apply if

- (a) the infringement is of such a nature that, at the time of its commission, it would not have come to the attention of a reasonably diligent owner or licensee of any right in the registered topography; and
- (b) the action for infringement is commenced within three years after the infringement came or should have come to the attention of the plaintiff.

Changes in register not applicable

13. If any person has relied to the detriment of that person on any entry in the register as it read before being expunged or amended pursuant to this Act or any other Act of Parliament, a court of competent jurisdiction may order that the expungement or amendment not apply in any action for infringement of the exclusive right in a registered topography taken against that person or against any other person who has acquired from that person an integrated circuit product that incorporates the topography or a substantial part thereof.

OTHER PROCEEDINGS

Detention of infringing integrated circuit products

14. (1) Where it is made to appear to a court of competent jurisdiction that an integrated circuit product has been imported into Canada or is about to be commercially exploited in Canada contrary to this Act, the court may make an order for the interim detention of the integrated circuit product or any article of which the integrated circuit product forms a part, pending a final determination of the legality of the importation or commercial exploitation in an action commenced within such time as is specified in the order.

Security

(2) Before an order is made under subsection (1), the plaintiff or petitioner may be required to furnish security, in such form and in such amount as the court may determine, to answer any damages that may by reason of the order be sustained by the owner or consignee of the integrated circuit product or article and for any costs of storage or amount that may become chargeable against the integrated circuit product or article while it remains in detention under the order.

Indemnity

(3) Subject to paragraph (4)(c), the plaintiff or petitioner in an action referred to in subsection (1) shall be liable to indemnify Her Majesty in right of Canada against any liability or expense that may result from the detention of an integrated circuit product or article pursuant to any order made under subsection (1), whether or not security is furnished pursuant to subsection (2).

Lien, disposal and indemnity

(4) Where, by the judgment in an action referred to in subsection (1) that finally determines the legality of the importation or commercial exploitation of the

integrated circuit product, the court finds that the importation is or the commercial exploitation would be contrary to this Act,

(a) any lien for charges against the integrated circuit product or article, or any hypothecs, prior claims or rights of retention within the meaning of the *Civil Code of Québec* or any other statute of the Province of Quebec with respect to the integrated circuit product or article, that existed prior to the date of an order made under subsection (1) has effect only so far as may be consistent with the due execution of the judgment;

(b) the court may make any order for the disposal of the integrated circuit product or article, including by way of exportation, distribution or destruction, after payment has been made of any taxes or duties owing in respect thereof under any Act of Parliament; and

(c) the owner or consignee of the integrated circuit product or article thereupon becomes jointly and severally liable, with the plaintiff or petitioner, to indemnify Her Majesty in right of Canada under subsection (3).

Who may make applications

(5) Any order under subsection (1) may be made on the application of any interested person either in an action or otherwise and either on notice or *ex parte*.

1990, c. 37, s. 14; 2001, c. 4, s. 90.

GENERAL

REGISTRATION

Register

15. (1) There shall be kept under the supervision of the Registrar a register for the registration of topographies and of information and material relating to each registered topography.

Register to be evidence

(2) The register is evidence of the particulars entered therein and documents purporting to be copies of entries therein or extracts therefrom, that are certified by the Registrar, are admissible in evidence in any court without further proof or production of the originals.

Application for registration of topography

16. (1) The creator of a topography or, where the topography has been transferred, the successor in title thereto may apply to the Registrar for registration of the topography.

Content of application

(2) An application for registration of a topography shall contain the following information and material:

(a) one or more titles to identify the topography that conform to the prescribed requirements;

- (b) the date on which, and place at which, the topography was first commercially exploited or, if the topography has not been commercially exploited, a statement to that effect;
- (c) the name and address of the applicant;
- (d) a statement describing the interest that the applicant holds in the topography; and
- (e) such other information or material as may be prescribed.

Fee

(3) An application for registration of a topography shall be accompanied by the prescribed fee or a fee determined in the prescribed manner.

Filing date

17. (1) Subject to subsection (2), the filing date of an application for registration of a topography is the date on which the Registrar has received, in respect of the application, the information and material required by subsection 16(2) and the fee required by subsection 16(3).

Exception

(2) The Registrar may, in such circumstances as are prescribed, assign a filing date to an application for registration of a topography notwithstanding that the requirements of subsection (1) have not been met.

Notice to applicant

(3) Where the Registrar assigns a filing date to an application for registration of a topography pursuant to subsection (2), the Registrar shall notify the applicant of that date, of any information or material that is required to complete the application and the amount of the fee, if any, that remains unpaid.

Obligations of applicant

(4) An applicant to whom notice is given in accordance with subsection (3) shall, within the prescribed period, file with the Registrar the information or material, if any, that is required to complete the application and the amount of the fee, if any, that remains unpaid and, in default thereof, shall be deemed to have abandoned the application.

Registration of topography

18. (1) Subject to subsection (3), where the Registrar has received the information and material required by subsection 16(2) and the fee required by subsection 16(3) in respect of an application for registration of a topography, the Registrar shall register the topography by entering in the register the following:

- (a) the filing date of the application;
- (b) the title or titles of the topography that are contained in the application and that conform to the prescribed requirements; and
- (c) such other information or material as may be prescribed.

No inquiry

(2) The Registrar shall not inquire as to the accuracy of any information or material contained in an application for registration of a topography.

Registrar may refuse to register

(3) The Registrar may refuse to register a topography if it appears to the Registrar, on the basis of any information or material contained in the application for registration, that the application was filed more than two years after the topography was first commercially exploited or that neither the condition set out in paragraph 4(1)(c) nor the condition set out in subsection 4(4) has been met.

Certificate of registration

19. (1) The Registrar shall issue a certificate of registration in respect of each topography registered under this Act.

Contents of certificate

(2) A certificate of registration issued in respect of a topography shall include the filing date of the application for registration of the topography, the date of expiration of the exclusive right therein and such other particulars as may be prescribed.

Presumptions

(3) A certificate of registration issued in respect of a topography that purports to be signed by the Registrar is, without proof of the signature, admissible in any court as evidence of the facts therein alleged and is, in the absence of evidence to the contrary, proof that

- (a) the topography was registrable under this Act at the time of the registration; and
- (b) the application for registration of the topography was correct in all material particulars and did not omit any material information.

Correction of errors

(4) The Registrar may, for the purpose of correcting any typographical or clerical error in a certificate of registration, amend the certificate or issue a new certificate in substitution therefor.

Invalidity of registration

20. The registration of a topography is invalid if

- (a) the topography was not registrable under this Act at the time of the registration; or
- (b) the application for registration of the topography was incorrect in a material particular or omitted any material information, unless the incorrectness or omission occurred by mistake.

Registration of other particulars

21. (1) The Registrar shall enter in the register particulars of any transfer of an interest or grant of a licence affecting a registered topography on being furnished with evidence of the transfer or grant that is satisfactory to the Registrar.

Changes in information

(2) The Registrar may amend any entry in the register, or make new entries, for any of the following purposes:

- (a) to reflect any change in the name or address of an owner of a registered topography;
- (b) to reflect any change in a registered title of a topography or the use of a new title;
- (c) to reflect any prescribed change of information; and
- (d) to correct any typographical or clerical error.

Public inspection

22. Subject to the regulations, the register, applications for registration of topographies and material filed with the Registrar in relation to any registered topography shall be made available for public inspection during regular business hours.

JURISDICTION OF FEDERAL COURT

Concurrent jurisdiction

23. The Federal Court has concurrent jurisdiction to hear and determine

- (a) any action for the infringement of the exclusive right in a registered topography; and
- (b) any question relating to the ownership of a topography or any right in a topography.

Exclusive jurisdiction

24. (1) The Federal Court has exclusive original jurisdiction, on application of any interested person, to order that the registration of a topography or any other entry in the register be expunged or amended on the ground that the registration is invalid or that, at the date of the application, the entry as it appears does not accurately express or define the existing rights of any person appearing on the register as the owner of the topography.

Application

(2) An application under subsection (1) may be made by the filing of an originating notice of motion, by counter-claim in an action for infringement or by statement of claim in an action claiming additional relief under this Act.

Definition of "interested person"

(3) In subsection (1), "interested person" includes the Registrar, the Attorney General of Canada and persons who are affected or who reasonably apprehend that they may be affected by any entry in the register.

REGISTRAR

Appointment of Registrar

25. (1) There shall be a Registrar of Topographies who shall be designated by the Minister from among persons employed in the Department of Industry.

Duties

(2) The Registrar shall perform the duties assigned to the Registrar by this Act and such duties as may be assigned to the Registrar by the regulations or by the Minister.

Acting Registrar

(3) Where the Registrar is absent or unable to act or the office of Registrar is vacant, the Minister may designate any other person employed in the Department of Industry to perform the duties and exercise the powers of the Registrar for the time being.

1990, c. 37, s. 25; 1992, c. 1, s. 145(F); 1995, c. 1, s. 63.

OTHER RIGHTS

Relationship to other law

26. Except as provided in this Act, nothing in this Act shall affect any right granted by or under any other law.

REGULATIONS

Regulations

27. The Governor in Council may make regulations

- (a) governing the form of the register, including any indexes thereto, and the entries to be made therein;
- (b) governing the filing of copies of documents in the register;
- (c) governing public inspection of the register, of applications for registration of topographies and of material filed with the Registrar in relation to any registered topography;
- (d) governing, restricting or prohibiting the making or providing of copies of applications for registration of topographies and of material filed with the Registrar in relation to any registered topography;
- (e) assigning duties to the Registrar;
- (f) prescribing fees, or the manner of determining the fees, to be paid for any act or service rendered by the Registrar;
- (g) prescribing any other matter or thing that by this Act is to be or may be prescribed; and
- (h) generally for carrying out the purposes and provisions of this Act.

MINISTERIAL REVIEW

Review of Act

28. (1) Five years after the coming into force of this Act, the Minister shall undertake a review of the provisions and operation of this Act.

Report to Parliament

(2) The Minister shall, within one year after undertaking the review referred to in subsection (1), submit a report on the review to each House of Parliament.

CONSEQUENTIAL AMENDMENTS

29. to 34. [Amendments]

COMING INTO FORCE

Coming into force

* **35.** This Act shall come into force on a day to be fixed by order of the Governor in Council.

* [Note: Act in force May 1, 1993, see SI/93-68.]

RELATED PROVISIONS

— **1994, c. 47, s. 131(2):**

No liability

(2) Her Majesty in right of Canada or a province is not, by reason only of the enactment of subsection (1), liable for any use of a registered topography before the day on which subsection (1) comes into force.