

Immigration and Intellectual Property: An Overlooked Intersection in Today's Information Economy

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In today's information and technology driven economy, with its increased emphasis on specialized areas of technology – like engineering, computer science and the life sciences – companies are increasingly reliant on the cross-border flow of not only information, but labour as well. This article briefly traces the intellectual property implications that may arise from such mobility, and examines US – Canadian immigration law in a bit more depth.

THE INTELLECTUAL PROPERTY IMPLICATIONS

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Employee mobility in today's information and technology driven economy demands that [intellectual property](#) issues assume greater significance in employers' and employees' minds. The mobility of employees across companies requires a careful examination of the nature and scope of a potential employee's past responsibilities; and a proper drafting/scrutiny of employment contracts (in general) and clauses dealing with intellectual property rights, waivers and assignments (in particular). For instance, there may be trade secrets and other types of confidential information that a potential employee may be barred from using for their future employer. This not only has implications for the employee's potential/actual productivity and usefulness, but it may also have downstream implications in terms of ownership for any patents that the future employer may seek. Different countries also have different approaches to what constitutes a "trade secret" or "confidential information" – adding further confusion to the mix.

Different countries may also have different copyright terms, or differences in the way in which moral rights can be waived. For instance, moral rights can be waived in whole or in part under Canadian law; whereas in some Continental European countries those rights are absolute and cannot be waived. Then there are differences in the very nature of the rights protected: English law permits the acquisition of unregistered design rights (which simply arise automatically), whereas an industrial design can only be acquired in Canada through registration.

Indeed, the comparative body of law around intellectual property matters is simply too complicated to outline in an article like this, however some **general principles and minimum requirements** may be distilled from the Agreement on Trade Related Aspects of Intellectual Property Rights ("TRIPS"):

- Article 12 (Term of Protection for Copyright): "Whenever the term of protection of a work, other than a photographic work or a work of applied art, is calculated on a basis other than the life of a natural person, such term shall be no less than **50 years** from the end of the calendar year of

authorized publication, or, failing such authorized publication within 50 years from the making of the work, 50 years from the end of the calendar year of making.”

- Article 15 (Protectable Subject Matter for Trademarks): “**Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.** Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.”
- Article 27 (Patentable Subject Matter): “... patents shall be available for any inventions, whether products or processes, in **all fields of technology**, provided that they are **new**, involve an **inventive step** and are capable of **industrial application**.”
- Article 39 (Protection of Undisclosed Information – otherwise known as Confidential Information): “Natural and legal persons shall have the possibility of preventing information lawfully within their control from being disclosed to, acquired by, or used by others without their consent in a manner contrary to honest commercial practices (10) so long as such information: (a) is **secret** in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question; (b) has **commercial value** because it is secret; and (c) has been subject to **reasonable steps** under the circumstances, by the person lawfully in control of the information, to keep it secret.”

GETTING YOUR TECHNOLOGY EMPLOYEE TO CANADA

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In general, hiring a foreign technology employee to work in Canada, on a temporary basis, entails a two step process. First, the employer needs to obtain a Human Resources and Skills Development Canada (HRSDC) job offer confirmation. If the HRSDC provides a positive or neutral Labour Market Opinion (LMO), the foreign worker then must obtain a work permit from Citizenship and Immigration Canada (CIC).

STEP ONE: HRSDC CONFIRMATION (LMO)

When assessing an employer’s job offer to a foreign worker, HRSDC and CIC considers the following factors:

- the occupation that the foreign worker will be employed in;
- the wages and working conditions of the position offered;
- the employer's advertisement and recruitment efforts;
- the labour market benefits related to the entry of the foreign worker;

- the consultations, if any, with the appropriate union;
- whether the entry of the foreign worker is likely to affect the settlement of a labour dispute;
- whether the job is within a regulated field, requiring the foreign worker to obtain a license to work in their field.

Occupation

The position offered to the foreign technology employee must fall within one of the job titles in the National Occupational Classification (NOC) system. The specific title of the position being offered to the foreign technology employee will depend on the main duties that the employer expects the foreign worker to perform. The NOC assists the HRSDC and CIC to identify wages and labour market trends which, in turn, may determine whether the wage offered meets or exceeds the prevailing wages within the occupation being offered and whether the foreign worker's entry into the Canadian labour market would have a positive, neutral or negative effect on that market.

Wages and Working Conditions

The wage and benefits offered must be consistent with the wages paid and benefits extended to Canadian citizens and permanent residents working in the same occupation and geographical area. In addition, the wage range identified in the employer's advertisement for the position must also be consistent with the prevailing wage, which is the average hourly wage for the requested occupation in the specified geographical area. However, HRSDC/Service Canada has discretion to set the prevailing wage rate that an employer must offer in order to address unique circumstances in specific cases.

Lastly, employers must offer working conditions that are consistent with federal and provincial standards for the occupation and workplace.

Minimum Advertising Requirements

Employers seeking to hire temporary foreign technology employees must demonstrate that they undertook efforts to recruit Canadian citizens or permanent residents to fill the position offered to the foreign worker.

The minimum advertising requirements for employers of foreign technology employees are as follows¹:

1. Conduct recruitment activities consistent with the practice within the occupation (e.g., advertise on recognized Internet job sites, in journals, newsletters or national newspapers or by consulting unions or professional associations); **and/or**²
2. Advertise on the national Job Bank (or its equivalent in Newfoundland and Labrador, Saskatchewan or the Northwest Territories) for a minimum of fourteen (14) calendar days, during the three (3) months prior to applying for a LMO.

Union Consultation

¹ Advertisement criteria vary slightly in the province of Quebec.

² The minimum advertising requirements require one or both steps depending on the skill type or level required for the IT position being offered (i.e 0, A or B).

The employer must consult with the union if the position being filled by the foreign worker is part of a bargaining unit. These consultations must include efforts to work with the union to identify unemployed Canadian citizens or permanent residents. Furthermore, the employer must confirm that the foreign worker, and the position being offered to him or her, is subject to the conditions of the collective agreement.

Labour Disputes

HRSDC and CIC will not provide a LMO or issue a work permit to a foreign worker where the position being offered to that worker affects current or foreseeable labour disputes or affects the employment of any Canadian citizen or permanent resident involved in labour disputes.

Regulated Occupations

CIC will not issue a work permit to a foreign worker who does not meet certification and licensing requirements for a regulated occupation in Canada. Both the employer and the foreign technology employee must take the necessary steps and arrangements with the relevant regulatory body to ensure that the foreign worker obtains the required certification and licensing, if required.

EXCEPTIONS

The two-step process described above is of general application to all employers in Canada seeking to hire foreign technology employees. However, exceptions apply for employers offering positions to foreign technology employees from countries with whom Canada has specific international trade agreements, such as the North American Free Trade Agreement (NAFTA) and General Agreement on Trade in Services (GATS), and intra-company transferees with highly specialized or advanced knowledge. For employers seeking to hire foreign technology employees who fall into any of these categories, a LMO from HRSDC is not required.

NAFTA

For employers seeking to hire a foreign technology employee who is a citizen of the United States of America or Mexico, an LMO is not required for the following positions:

- Computer Systems Analysts with a Bachelor's degree, or a post-secondary degree, or a post-secondary diploma and three years work experience ;
- Engineers with a Bachelor's degree or state/provincial license ;
- Graphic Designers with a Bachelor's degree, or a post-secondary diploma, or a post-secondary certificate and three years' work.

Foreign workers that meet the conditions above may apply for a work permit abroad or at a port of entry, without the need for providing an LMO from their employer.

GATS

For employers seeking to hire a foreign technology employee who is a citizen of a member country under the GATS, an LMO is not required for the position of senior computer specialist. Applicants for

senior computer specialist positions must possess at least a Master's Degree in computer sciences or related discipline from an accredited academic institution and ten years of experience in computer sciences.

The Canadian government currently imposes a limit of ten senior computer specialist entrants per project. The work permit is also limited to a period of 90 days within any twelve-month period.

Intra-company transferees: Specialized or Advanced Knowledge

Intra-company transferees are exempt from the LMO requirement and may apply for work permits if they:

- (a) are seeking entry to work in a parent, subsidiary, branch, or affiliate of a multi-national company;
- (b) will be undertaking employment at a legitimate and continuing establishment of that company;
- (c) have been employed (via payroll or by contract) by the company outside Canada in a similar full-time position (not accumulated part-time) for one year in the three-year period immediately preceding the date of the application for a work permit.

The worker must demonstrate "specialized knowledge" of a company's product, processes or service or an advanced level of knowledge or expertise in the organization's processes and procedures. The knowledge that the applicant possesses is not generally held knowledge or common in the business; rather, it is uncommon, unusual and knowledge not generally found in a particular industry. It is truly specialized knowledge. Oftentimes, a worker with specialized knowledge is critical to the well-being of the company. On the other hand, advanced knowledge is complex or high-level knowledge. It is not necessarily unique or highly specialized; however, a foreign worker with advanced knowledge has a specific background and extensive experience with the employer who is transferring the worker, or experience from within the same industry as the employer's company. Due to the highly specialized or advanced knowledge of the worker, the employer would need to undertake extensive and time-consuming efforts to recruit such essential workers; accordingly, CIC and HRSDC recognize that an LMO would not be required in such unique cases.

STEP TWO: WORK PERMIT

Once an employer has obtained a positive or neutral LMO from HRSDC, the foreign employee must submit the LMO with his or her work permit application. The foreign employee's credentials, including education and work experience, will be assessed by CIC to determine that the employee meets the requirements for the position offered to him or her. Furthermore, foreign employees must meet the standard requirements for all foreign individuals who wish to enter Canada. For example, all foreign individuals must have a valid travel document, be in good health, and not inadmissible on the basis of criminality.

A work permit allows a foreign employee to work in Canada on a temporary basis. If the employer or employee desires to enter or remain Canada on a permanent basis, the employee must apply for

permanent residence under one of several categories, including federal skilled worker and provincial nominee program.

For more information on Canadian Immigration Law, please click [here](#).

GETTING YOUR TECHNOLOGY EMPLOYEE TO THE UNITED STATES

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In today's global economy, the United States is a major player. Enterprises of all sizes have a presence in the United States, whether through foreign direct investment, strategic alliances or simply having clientele in the U.S. Thus, being able to transfer personnel to the U.S. quickly and seamlessly has become a necessary component of business for many enterprises.

This sub-section discusses three types of U.S. visas that can be used to transfer personnel to the U.S.; the H1B, L1 and TN.

The H-1B Visa: Entering the U.S. to Work in a Specialty Occupation

General

The H-1B visa permits non-U.S. citizens to enter the United States and work within what is referred to as a "specialty occupation." To obtain H-1B status, a U.S. employer must submit a petition on your behalf. This article provides an overview of the basic requirements, rules, and procedures pertaining to the H-1B application process.

Requirements

Specialty Occupation: Four-Year Bachelor's Degree or its Equivalent

To be eligible for an H-1B visa, you must have been offered a position with a U.S. employer to work within a *specialty occupation*. A job may qualify as specialty occupation if it requires at least a four-year bachelor's degree or its equivalent in work and/or educational experience. Professions that will most certainly fall within the definition of a specialty occupation include, but are not limited to, software engineers and most IT professionals, lawyers, accountants, physicians, architects, social workers, professors, artists, pharmacists, chiropractors, librarians, computer system analysts, chemists, and engineers.

If it is unclear as to whether or not your field of work will be considered a specialty occupation, you must assess the requirements of the offered position. If the position you have been offered requires at least a four-year bachelor's degree, there is a good chance it will qualify as a specialty occupation. If the job you have been offered does not require at least a four-year bachelor's degree, then the position must require the *equivalent* of a four-year bachelors' degree in work and/or educational experience. The United States Citizenship and Immigration Services (USCIS) usually wants to see three years of specialized training and/or work experience for every year of university that you would have attended.

Therefore, if you have not attended any university, you must have at least 12 years of professional experience.

Four-Year Bachelor's Degree and/or Equivalent Experience Must be Necessary for the Performance of the Job

It is very important to note that the offered position must **require** a professional with at least a four-year bachelor's degree or its equivalent. Thus, if someone with less experience would be qualified for the offered job, the position is not a specialty occupation. For example, an employer may seek to hire a bookkeeper with at least a four-year bachelor's degree or 12 years of experience in the industry. However, the offered position would not be considered a specialty occupation because, even though the employer prefers to hire someone with extensive experience, such credentials are not *necessary* for the performance of the offered job.

Duration

Your H-1B status will expire after three years. Prior to its expiration, you may extend your H-1B for an additional three years, which means you may stay in the U.S. for a total of 6 years as an H-1B non-immigrant. However, under certain circumstances, you can extend your stay in the U.S. beyond six years as an H-1B visa-holder.

The L-1 Visa: Entering the U.S. as a Company Transferee or Entrepreneur

General

The L-1 visa permits foreign companies to transfer managers, executives or employees with specialized skills to the company's U.S. branch, subsidiary, affiliate or joint venture-partner.

The L-1 visa can be used by individuals and companies that already have a pre-existing business operation in the U.S. or individuals/companies who wish to establish a business in the United States. As such, the L-1 visa is often the visa of choice for established companies that have a presence in the U.S., companies seeking to set up operations in the U.S. and entrepreneurs who wish to open a business in the U.S.

Requirements

Valid Relationship

A valid relationship between the foreign company and U.S. company must exist. A valid relationship will exist if the U.S. company is a parent, subsidiary, 50/50 joint venture partner, branch, or affiliate of the foreign company. In essence, for two companies to have a valid relationship, the U.S. and foreign business entities should have the same owners (i.e. directors, partners, shareholders, etc.).

Foreign Company Must Continue its Operations Abroad

The foreign company must continue to do business outside of the United States for the entire duration of the L-1 visa. Thus, during the term of the non-immigrant's L-1 status, the foreign company may not close all of its non-U.S. operations. However, the company may relocate its non-U.S. operations. For example, a company with its main operation in India and a branch office in the U.S. may move its Indian

operations to Canada after conducting an L-1 transfer. Such relocation is authorized as long as the company maintains an office outside of the United States.

If L-1 companies were permitted to cease all non-U.S. operations, the L-1 visa-holder would not be able to relocate back to the foreign company upon expiration of his L-1 status, which of course would compromise the temporary nature of the visa.

Transferee Must Have Worked Outside of the U.S. for the Foreign Company for at Least One Year within the Three Years Preceding the Date of the Application

For a transferee to be eligible for an L-1 visa, he or she must have held an executive or managerial role in the company or a position requiring specialized knowledge. The transferee must have held such a position with the foreign company for at least one full year within the three years immediately preceding the L-1 visa application date.

It is imperative that the transferee's work was performed outside of the U.S. for at least one full year without interruption. For example, if within the three years prior to the date of the L-1 application, the transferee worked as a manager for one year, but six months of that year was spent working in the United States for the foreign company's U.S. branch, the applicant would not qualify for an L-1 visa. In such a situation the transferee was not working outside of the U.S. as a manager for the company for at least a year without interruption, but instead only worked outside of the U.S. for six months without interruption.

Transferee Must Have Had an Executive Post, Manager Position or Position Requiring Specialized Knowledge within the Foreign Company

As noted above, to be eligible for the L-1 visa the transferee must have held an executive or managerial role in the company or a position requiring specialized knowledge.

Duration

Your L-1 status will be granted initially for one to three years with extensions are available in two-year increments.

If you enter the U.S. as a manager or executive, you will be entering the country as what is referred to as an L-1A visa-holder. Those who enter the U.S. as an employee with specialized knowledge are referred to as L-1B visa-holders. An L-1A visa-holder may stay in the U.S. for up to 7 years while an L-1B transferee may reside in the U.S. for no more than 5 years.

Upon the expiration of your term as an L-1 visa-holder, you must leave the U.S. for at least one year and return to your post within the foreign company.

The TN Visa: Entering the United States as a Canadian or Mexican Professional

General

The NAFTA Treaty visa ("TN") is a product of the North American Free Trade Agreement ("NAFTA"), an agreement signed by the governments of the United States, Canada, and Mexico, which created a trilateral trade bloc in North America.

TN status permits Canadian and Mexican citizens to work in the United States so long as the applicant fits within a certain occupational category. Though the TN is a temporary visa, it may be renewed in 2-3 year increments. Currently, there is no cap on the amount of times it can be renewed. Furthermore, TN applicants may bring their accompanying spouse and children into the United States with them upon entry or after the applicant has been granted TN status.

TN status can be attained at the port of entry into the United States (i.e. the United States border or airport in Canada) generally within 40 minutes or less. Unlike most visas, TN status does not require the completion of forms and is not restricted by quotas or waiting periods. Thus, TN status is generally considered the quickest and most easily attainable work visa for Canadians and Mexicans who qualify.

Requirements

To obtain a TN visa the applicant must meet the following requirements:

1. Citizenship: To obtain a TN-1 visa you must be a Canadian or Mexican citizen. Thus, Canadian/Mexican landed immigrants and non-citizens are ineligible for TN status.
2. Employment Offer: You must have an offer of [employment](#) from a business located in the United States. The employment offer must not be tentative, however. In other words, your employment must be guaranteed on the condition you receive TN non-immigrant status.
3. Temporary Intent: TN status is a non-immigrant visa, which means you may only imstay in the United States temporarily while in TN status. Accordingly, while applying for TN status at the United States port of entry, it is imperative that, if questioned, you express temporary intent – that is, the intent to return to Canada upon the expiration of your visa.
4. Temporary Duration: Your employment in the United States must be intended to last for no longer than 3 years. However, at the end of the 3 year term, you and/or your employer may renew the visa for another 3 year term. There is no limit on the amount of times your TN status may be renewed. Nonetheless, upon each renewal you must have temporary intent.
5. Occupational Category: TN applicants must be offered a position as a professional that falls under the category of occupations listed in Chapter 16 of NAFTA, Appendix 1603.D.1 (the “Schedule of Professions”). The profession must be exactly the same as one of the professions listed in the aforesaid schedule or you will not qualify for TN status.
6. Position Requires a NAFTA Professional: The position you have been offered must actually require a NAFTA professional. For example, if you are seeking to enter the United States under TN status as a lawyer, but you will actually be working as a journalist, and thus the position does not actually require someone who is licensed as a lawyer, then you will not be granted TN status.
7. Educational and/or Experiential Qualification: You must meet the educational and/or experience requirements for the profession as set out in the Schedule of Professions. Unless otherwise noted, each profession requires at least a Baccalaureate or Licenciatura degree that is directly related to the given profession. However, many of the professions listed in the schedule

only require experience and/or post-secondary certification other than a Baccalaureate or Licenciatura degree.

8. Licensure Requirement: If applicable, you must have the relevant license required to engage in the given profession within the particular location in the United States where you will be working. This requirement only applies if licensure is necessary to practice within the given field. This requirement is purely profession specific.
9. No strike or lock-out: To obtain a TN visa, your prospective employer must not be experiencing a strike or lockout. However, even if the company is currently engaged in a strike or lockout, it is possible that this event may not prohibit you from receiving a TN if it is wholly unrelated to your position.
10. Health Care Professionals: Certain health care professionals must complete a visa screening requirement prior to applying at the border.

Spouses and Children

TN family members consists of spouses and children. Thus, a mother, aunt, cousin, brother and so on are not considered a TN family member for admission purposes.

The TN visa-holder's spouse, and unmarried children under the age of 21, may also enter the United States accompanying or following the TN visa-holder, and these individuals are referred to as Free Trade Dependents ("TD"). However, the family member must demonstrate *a bona fide* spousal or parent-child relationship to you.

Spouses and children cannot work while in the United States in TD status, but they are permitted to study.

Non- Canadian Family Member

Unlike TN visa holders, TDs do not have to be citizens of Canada or Mexico to enter the United States as non-immigrants. However, non-Canadian/Mexican TDs must follow an application process that is considerably more extensive and less straight forward than their citizen counter-parts.

For more information on U.S. Immigration Law, please click [here](#).