



IP PERSPECTIVES

INTELLECTUAL PROPERTY AND TECHNOLOGY LAW NEWSLETTER

Autumn 2010

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Bill C-32: Modernization of the *Copyright Act*

The Canadian government has tabled Bill C-32, *An Act to Amend the Copyright Act*, with first reading having taken place on June 2, 2010. This is the third attempt by governments in Canada to update the *Copyright Act* to better handle issues relating to digital content and to implement the WIPO Internet Treaties. The last two attempts resulted in bills that died on the table, the most recent attempt being Bill C-61, which could not be passed before the dissolution of Parliament in September 2008.

Bill C-32, like Bill C-61, includes provisions directed toward balancing copyright protection to meet the needs of the digital age. Both bills deal with the liability of service providers, clarify and add exceptions to infringement, detail rights related to technical protective measures ("TPMs") and rights-management information, and make clarifications regarding the liability of individuals relating to reproductions made for personal (non-commercial) purposes.

Like Bill C-61, the apparent intent under Bill C-32 is to provide strong protection for TPMs used to prevent copyright infringement while

limiting the relief available against non-commercial, personal-use infringement.

With respect to service providers, clear exceptions are outlined for "providers of network services or information location tools," coupled with a notice-and-notice system intended to assist rights holders in addressing online infringement. While there was criticism of the notice-and-notice provisions during consultations held in the summer and fall of last year, Bill C-32 includes essentially the same provisions as Bill C-61. However, a provision has been added that specifically makes it an infringement of copyright for a person to provide a service that they know or should know is designed primarily to enable acts of copyright infringement. In essence, a contributory liability regime is proposed in respect of service providers whose economic viability is dependent upon facilitating infringement. Such a provision may impact on, for instance, operators of BitTorrent websites.

As noted, Bill C-32 also provides and seeks to clarify exceptions to infringement. The most significant change is likely the expansion of

the “fair dealing” exception to add “education, parody or satire” to the existing categories of research and private study.

There are also provisions that deal with making copies for private purposes of works that were legitimately and legally obtained. The private-copying exception is very broad, so long as the reproductions are “used only for private purposes.” However, the exceptions will not apply if TPMs have been circumvented to allow creation of the copies. It is also made clear that all copies must be destroyed once the user gives up possession of the legitimate source copy and that the user is not entitled to provide reproductions to others for their private use.

Exceptions are also provided for non-commercial use of copyrighted works in user-generated content. These exceptions are clearly directed toward the current social networking environment, where users commonly generate “free” content while making liberal use of the copyrighted works of others.

Again emphasizing the trend toward minimizing liability for private use, provisions dealing with statutory damages have been

amended. These provisions reduce the maximum fine for personal-use infringement and make it clear that the owner of a copyrighted work may only claim statutory damages once for all similar prior infringements. After the first case, rights holders will need to prove actual damages in order to collect. Further, the maximum award for statutory damages is \$5,000 for all works (as opposed to a maximum of \$20,000 per work regarding infringements for commercial purposes).

While it is believed that there is still reason for concern regarding the ability to enforce against online infringement of copyrights in a cost-effective manner, Bill C-32 is clearly helpful in addressing commercial copyright piracy in particular. Further, the strong provisions against interfering with TPMs imply intent to use market forces and technological measures to find a balance between the rights of copyright owners and the disseminators and users of copyrighted works.

The complete text of the Bill may be reviewed at: <http://www2.parl.gc.ca/HousePublications/Publication.aspx?Docid=4580265&file=4>

Brian P. Isaac, Toronto

Smart & Biggar successfully represents plaintiffs in patent infringement action in Federal Court

The Federal Court has ruled that liability for inducing and procuring infringement does not require prior knowledge of the patent.



François Guay of Smart & Biggar’s Montreal office and Jeremy Want of Smart & Biggar’s Ottawa office recently successfully represented the plaintiffs, Bauer Hockey Corp. (“Bauer”) and Nike International Limited, in *Bauer Hockey Corp. and Nike International Limited v. Easton Sports Canada Inc.*, 2010 FC 361, a patent infringement action involving hockey skates. In the decision, the Federal Court found the patent at issue to be valid and infringed by the defendant, Easton Sports Canada Inc. (“Easton”), both directly and through inducing and procuring a third party to manufacture hockey skates in Canada that incorporate the invention of the patent.

The plaintiffs were awarded each category of remedy sought in the action, including:



1. an injunction against manufacturing, using or selling to others, or inducing and procuring others to manufacture, infringing skate boots;
2. delivery up to the plaintiffs of all infringing skate boots in Easton's possession or under its authority or control;
3. damages or an accounting of profits, as the plaintiffs may elect, the quantum of which is to be determined on a reference;
4. reasonable compensation in the form of a reasonable royalty for acts of infringement after publication of the patent and prior to issuance;
5. pre-judgment and post-judgment interest; and
6. costs.

In rendering its decision, the Federal Court considered for the first time whether prior knowledge of the patent at issue was a requirement for finding a party liable for inducing and procuring infringement.

The patent at issue related to a quarter for a skate boot and a method of manufacturing skates comprising such a component. The inventive component was first incorporated into Bauer's VAPOR line of ice hockey skates launched in the 1997-98 hockey season, which enjoyed significant and rapid commercial success both at the NHL level and with consumers. Easton entered the hockey skate market in 1998 and began selling hockey skates that were alleged to incorporate the patented component in 2000. From 2000 to 2003, various models of Easton's skates were manufactured in Canada by a third-party

Canadian company (although by 2004 the manufacture of Easton's skates had been entirely transferred to China).

Easton was found to be liable for direct infringement for the skates it sold in Canada. However, several models of Easton's skates that were alleged to infringe were manufactured by Easton's third party Canadian manufacturer and then shipped directly to international markets, primarily in the U.S. and Europe, based on purchase orders placed by third parties. The plaintiffs asserted that Easton had induced and procured its Canadian manufacturer to infringe the patent, and Easton was therefore liable for all infringing skates constructed by the manufacturer in Canada, regardless of where or to whom the skates were sold.

In considering the issue of inducing and procuring infringement, the Court applied the test set out in *MacLennan v. Produits Gilbert Inc.*, 2008 FCA 35, namely that:

1. the acts of infringement must have been completed by the direct infringer (Easton's Canadian manufacturer);
2. the completion of the acts of infringement must be influenced by the acts of the alleged inducer (Easton); therefore, without said influence, the infringement would not otherwise take place; and
3. the influence must knowingly be exercised by the inducer (Easton) — meaning that the inducer must know that its influence will result in the completion of the acts of the infringement.

With respect to the first two elements of the test, the Court found on the evidence that:

the patent was infringed by Easton's Canadian manufacturer, the acts of infringement were influenced by Easton, and the infringement would not have taken place without Easton's influence. In this regard, the Court referred, *inter alia*, to Easton's involvement in the conception and design of the skates, the development of prototypes, the adjustment of patterns for the skates, and Easton's ownership of the dies that the manufacturer used to cut the components. The Court was also influenced by the fact that an employee of Easton worked out of an office located on the premises of the Canadian manufacturer.

With respect to the third element of the test, namely that "the influence must knowingly be exercised by the inducer," Easton argued that it could only be found to have induced and procured infringement if it had prior knowledge of the patent at issue and knew that the patent was valid and infringed by the skates manufactured at the Canadian company. Easton's position was tantamount to suggesting that in the case of inducing and procuring infringement, there was a requirement of an intention to infringe. The plaintiffs disagreed, arguing that "knowingly" merely referred to Easton's knowledge that its influence would result in the acts of the direct infringer — knowledge of the patent was not a requirement.

In reviewing the jurisprudence, the Court noted that there were no previous cases where the Court had stated clearly that a defendant could not infringe by inducement or procurement unless it knew of the patent at issue. The Court commented that it is important to consider that inducing and procuring another to make or construct a

patented invention is not a tort distinct from that of direct infringement.

The Court held that there was no legal rationale for requiring an intention to infringe on the part of an inducer or procurer when there was no such requirement for a direct infringer. By contrast, and consistent with the interpretation of the third element of the test suggested by the plaintiffs, the Court agreed that the inducement must be done knowingly or deliberately. In effect, it would be unjust to find a party guilty of infringement by inducement if that party did not know that its actions would induce another to do something that would later be held to constitute infringement. The Court ultimately concluded that to require infringement by inducement and procurement to not only be done deliberately but also with knowledge of the patent at issue would be to create an unwarranted and unjustifiable distinction between companies who manufacture their own products (direct infringement) and those who choose to have them manufactured by others according to their detailed specifications (inducing infringement).

As a result, the Court found that, in the circumstances of the case, Easton was liable for all of the skates manufactured by the Canadian third party in accordance with Easton's directions and specifications. This decision establishes for the first time that the test for establishing infringement by inducement and procurement does not require the inducer to have prior knowledge of the patent at issue.

The decision is presently under appeal.

Daniel M. Anthony, Ottawa

Use of competitors' names in keyword advertising held to be fair game

The BC Supreme Court has ruled that the use of competitors' business names as keywords for online advertising is not deceptive or misleading.

On May 28, 2010, the British Columbia Supreme Court became the first Canadian court to weigh in on the issue of keyword advertising. In *Private Career Training Institutions Agency v. Vancouver Career College (Burnaby) Inc.*, 2010 BCSC 765, Justice Gaul held that the use of competitors' business names in keyword advertising is not false, deceptive, or misleading and may in fact be good for the consumer by providing an opportunity to examine a

number of competitors offering similar products and services.

Private Career Training Institutions Agency (the "Agency") is a provincial regulatory body created to establish basic education standards for registered career training institutions operating in British Columbia and to provide consumer protection to prospective students. The Agency is permitted to enact bylaws that

regulate advertising by registered institutions. Bylaw 29(1) states that an institution “must not engage in advertising ... that has the capability, tendency or effect of deceiving or misleading a consumer.”

In April 2009, the Agency began receiving complaints from several member institutions regarding the keyword advertising practices of Vancouver Career College (Burnaby) Inc. (“VCC”). Keyword advertising services such as Google AdWords allow an advertiser to pay to have its advertisement associated with specific keywords so that when a user enters one of those words into the search engine as a search term, the advertisement is prominently displayed to the user along with the search results as a “sponsored link.” An advertiser can place a bid for a keyword, and the bid amount determines the advertiser’s rank in the list of sponsored links when that keyword is searched. If the user clicks on one of the sponsored links, that advertiser is charged according to the bid it has submitted.

VCC admitted that it employed an extensive keyword advertising strategy, bidding on more than 7,000 keywords through Google and Yahoo. Ultimately, VCC began using the business names of its competitor institutions as triggers for keyword advertising in 2008 with the result that VCC school names came up as the first sponsored links when the names of various competitors were searched.

In response, the Agency sought a permanent injunction restraining VCC from using the business names of other member institutions in connection with its Internet advertising. The Agency alleged that VCC’s strategy of using competitors’ business names as keywords in its Google and Yahoo advertisements amounted to false, deceptive or misleading advertising contrary to Bylaw 29. More specifically, the Agency alleged that VCC designed its strategy to lead students seeking information about a competitor’s institution away from that institution and towards one of its own. Arguing that the issue should be examined from a consumer protection perspective, the Agency further asserted that no exception should be made for advertisements that mislead students, even if only temporarily. As evidence of deception, the Agency proffered the experiences of two students who claimed they had been misled by VCC advertising. For its part, VCC denied that such advertising practices are false, deceptive or misleading and likened its approach to the commonly accepted practice

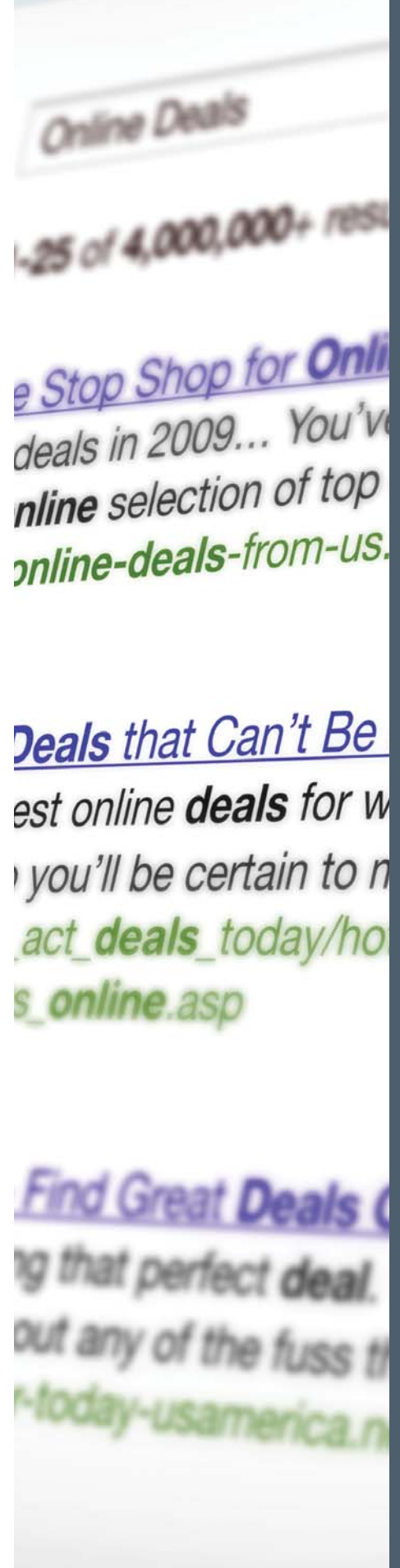
of competitors placing advertisements in close proximity.

Acknowledging the dearth of Canadian jurisprudence on the propriety of keyword advertising using the business names of competitors, the Court surveyed American case law on the issue before resorting to established Canadian trade-mark law to determine what is meant by the terms “confusing” and “misleading” in the context of improper advertising. Citing *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.), the Court held that it must make a determination of an advertisement’s effect on those persons who normally comprise the relevant market. Importantly, the Court held that the average consumer is not “generally completely devoid of intelligence or normal powers of recollection” nor “totally unaware or uninformed as to what goes on around them.”

Ultimately, the Court was not persuaded that VCC’s keyword advertising strategy had led or could lead a potential student astray. Moreover, the Court found that any confusion suffered by the two students flowed from their own imprudence and that they had not been led astray by anything other than their own oversight. If a student erroneously chooses to examine a VCC sponsored-link website, the Court was satisfied that the information readily available on the VCC websites is sufficient to inform the student that the website belongs to a VCC institution and not the institution named in the search terms. In the Court’s opinion, an Internet search does not force, trick, or tell a consumer to examine those entities located in the sponsored links. A consumer who chooses to investigate the sites of those other parties does so of his or her own volition. Having done so, the consumer is able to quickly and easily retreat from that inquiry and return to the original search results page with no harm done.

The Court further agreed with VCC’s contention that its practice of using keyword advertising is no different than the time-honoured and generally accepted marketing practice of locating an advertisement close to that of a competitor in traditional media. Accordingly, the decision vindicates the advertising solutions provided by Google and Yahoo and cautions businesses to bid high for their own trade-marks and trade-names to ensure that their businesses take precedence in search results for their own products and services.

Mark Pidkowich, Vancouver



Google revises trade-mark policy for Canadian advertisements

Effective September 14, 2010, Google will allow online advertisers running their advertisements in Canada to use a third-party trade-mark in their advertisement text even if they do not own that trade-mark or have explicit approval from the trade-mark owner to use it.

The policy change will affect sellers and resellers of component, replacement or compatible parts bearing the third-party trade-mark as well as informational websites. For example, resellers of jeans will be able to

highlight the actual brands they sell in their online advertisement text.

Trade-mark owners will be able to use Google's complaint procedure to police uses of trade-marks from unauthorized resellers.

The policy change has affected U.S. advertisers since June 2009. In addition to Canada, the policy will also be extended to the U.K. and Ireland.

Elliott S. Simcoe, **Ottawa**

Front-of-the-line treatment of “green innovations” coming soon to the Canadian Intellectual Property Office

A new expedited examination procedure is intended to promote the development and commercialization of environmentally friendly inventions.

In view of the increasing global importance of so-called “green” or “clean” technological solutions and in an effort to encourage further investment in such technologies, the Canadian Intellectual Property Office (CIPO) announced on May 19, 2010, that it is developing a targeted program for accelerating the examination of green patent applications. The program will be implemented by way of proposed amendments to the *Patent Rules* and will be published for a consultation period in the fall of 2010.

Green technologies, such as those relating to the environmental, biotechnology and energy sectors, often integrate several pre-existing technologies from various scientific and engineering disciplines. The advantages of patenting are particularly important for companies innovating in green technology sectors because the nature of their innovations may necessitate greater time and investment before achieving commercialization. CIPO has indicated that the proposed amendments to the *Patent Rules* are in line with the Government of Canada's priorities on science and technology, supporting the growth of small and medium-sized businesses, developing a clean energy economy and taking government action on global warming and capacity building. CIPO has further indicated that

expediting the prosecution of patent applications relating to green technologies will foster investment and the advancement of commercialization of technologies that mitigate environmental impact and conserve the natural environment and resources.

Under the proposed initiative, no additional fee would be required for advancing the examination of green technology patent applications. To be granted access to the expedited procedure, an applicant will simply need to submit a declaration stating that the application relates to “a technology which could help to resolve or mitigate environmental impacts or conserve the natural environment and resources if commercialized.” Under proposed new service standards for expedited applications, CIPO would aim to issue a substantive Office Action within two months after receiving either the applicant's request for expedited examination or the applicant's response to the preceding Office Action. These proposed turnaround times are substantially shorter than those associated with regular examination procedures in which it is not uncommon for more than three years to elapse following the request for examination before a first Office Action will issue. The applicant's response will be required within three months from the date of the Office

Action. Furthermore, it has been proposed that any prosecution delay caused by the applicant, such as requesting an extension of time or allowing the application to fall abandoned, will disqualify the application from expedited examination. At this early stage of the initiative, no other requirements have been identified by CIPO.

CIPO's proposed green technology initiative appears to be in line with similar initiatives recently implemented by various other national patent offices, including offices in the United States, Australia, Japan, China, Korea and the United Kingdom. However, all of these jurisdictions have their own requirements for entry into the program, including definitions of what technologies are eligible for expedited examination, what types of applications qualify and what types of claims may be included.

The proposed amendments may be regarded as a way to stimulate the creation and protection of green technologies by providing efficient access to Canada's strong intellectual property regime. The amendments may also contribute to an effective response to environmental issues by helping to ensure that environmentally beneficial technologies reach the marketplace more rapidly. The ongoing development of green initiatives at CIPO and other patent offices may also lead to harmonization and work-sharing initiatives similar to the current Patent Prosecution Highway ("PPH") programs to speed up the prosecution of foreign corresponding applications. Expedited examination may be particularly attractive for start-up or emerging companies with green technology platforms for which patents may be of paramount importance for securing investment or strategic partnerships.

However, as is true with the PPH programs, the accelerated green patenting initiatives may not be appropriate for all green technology patent applications as other avenues to expedite examination and to maximize claim scope may be a better fit for a particular applicant. Green technology applicants should consult a patent attorney in the jurisdiction of interest before committing to a particular patenting strategy.

The success of CIPO's green patenting initiative and related initiatives at foreign patent offices remains to be seen and may be dependent on how receptive applicants are to using such programs, how well the programs address the applicants' patenting needs and how effectively the applicants may deal with

any restrictions imposed. Regardless of whether companies with green innovations participate in the fast-track examination initiatives, they are well-positioned to prosper as global endorsement and stimulus relating to this sector will likely continue to intensify in the near term.

Kathy Rzeszutek, Vancouver



Canadian Intellectual Property Office news

Patent branch

CIPO issues new practice notice on unity of invention. On March 26, 2010, the Canadian Intellectual Property Office (CIPO) issued a practice notice on unity of invention that is intended to provide further guidance regarding a CIPO notice on the same subject that was issued in 2009. According to the new notice, if an impasse is reached between the patent Examiner and the applicant as to whether patent claims are directed to more than one invention in violation of section 36 of the *Patent Act*, the Examiner will refer the application to the Commissioner of Patents. Subsequently, if the Commissioner determines that the application complies with section 36 of the *Act*, the Examiner will resume prosecution. However, if the Commissioner finds that the application contravenes section 36, a letter will be sent to the applicant directing that the claims be limited to one invention only. If the applicant's response to the letter fails to satisfy the Commissioner with respect to unity of invention, the application may be refused under section 40 of the *Act*.

CIPO releases draft examination guidelines for computer-implemented inventions. On June 16, 2010, as part of its efforts to update the Manual of Patent Office Practice (MOPOP), CIPO released a new draft version of Chapter 16 for public consultation. Chapter 16 is intended to provide guidance on the patenting of computer-implemented inventions. Interested parties had until August 19, 2010, to provide their comments to CIPO. While some aspects of the existing chapter remain unchanged, the draft includes extensive revisions to reflect CIPO's controversial new views on statutory subject matter as outlined in the new versions of Chapters 12 and 13 of the MOPOP, which were released on December 4, 2009 (as reported in the [Spring 2010](#) edition of *IP Perspectives*). As pending litigation before the Federal Court may affect the implementation of Chapter 16, patent applicants are encouraged to maintain their usual Canadian filing and prosecution strategies and to seek the advice of an expert Canadian practitioner before proceeding with accelerated examination of applications that relate to computer-implemented inventions.

Trade-marks branch

Confirmation that applicant is a "person" no longer required. In a practice notice issued on June 3, 2010, CIPO announced that

the Registrar will generally no longer require an applicant seeking to register a trade-mark to confirm that it is a "person" as defined in section 2 of the *Trade-marks Act*. Ultimately, the onus rests with the applicant to ensure compliance with the *Act*.

Priority claims. A practice notice was issued on September 2, 2010, relating to the processing of applications containing priority claims.

The Registrar will now require the number (or certified copy) of an earlier-filed application in addition to the date and country of the earlier application. Amendments to correct errors in the number can be made at any time before registration. This is in contrast to the date and country of the earlier application, which must be corrected during the six-month priority period.

With respect to wares or services, it is sufficient for the priority claim to indicate that the priority application was filed for registration of the same or substantially the same trade-mark for use in association with the same kind of wares or services. However, should an applicant choose to limit the priority declaration to wares only, to services only, or to specified wares and/or services, the limitations to the wares or services covered by the priority declaration may be made at any time within the six-month priority period. After the expiry of the six-month period, no amendment to remove any such limitation will be permitted.

Claims to registration and use abroad. As for a claim to registration and use abroad under section 16(2) of the *Act*, a proposed notice specifies that such a claim will be complete when it indicates:

- the particulars of the application or registration of the trade-mark in or for the country of origin of the applicant; and
- the name of a country in which the trade-mark has been used.

Should the application not contain a claim to registration and use abroad at the time of filing or contain an incomplete claim, the applicant may add or substitute a complete claim prior to the decision of the Registrar of Trade-marks to advertise the application in the Trade-marks Journal.

Amendments to trade-mark opposition procedures proposed. The Trade-marks Opposition Board recently published a pre-

consultation notice regarding proposed amendments to the *Trade-marks Regulations* (“the *Regulations*”) aimed at modernizing and streamlining the current regulatory framework.

One proposed amendment permits the filing of evidence electronically with the Registrar, consistent with the rules of the Federal Court of Canada and other tribunals. Another proposed amendment permits parties to serve small documents by facsimile without consent or to serve documents electronically, including by email, on consent. Given that opponents rarely file reply evidence, consideration is also being given to deleting section 43 of the *Regulations*, which allows an opponent to file reply evidence as of right.

With respect to cross-examinations, the notice provides for a three-month period after service of the applicant’s evidence for both parties to complete cross-examination. It also proposed to require the parties to confirm in writing the intent to conduct cross-examination.

The amendments also shift the responsibility of filing undertakings to the party whose affiant was cross-examined while providing a one-month deadline after the completion of cross-examination for filing transcripts and undertakings.

A particularly notable proposal relates to the sequential filing and serving of written arguments within set deadlines, providing the applicant with the advantage of viewing the opponent’s written argument prior to preparing its own. Parties will also be required to file a request to be heard at a hearing within one month of service of the applicant’s written argument.

In a related practice notice, the Registrar announced that it no longer plans to issue a first notice indicating that an opposition will be treated as withdrawn before issuing a notice that an opposition is deemed to have been withdrawn in circumstances where an opponent does not file either evidence or a statement that it does not wish to submit evidence. The Registrar considers that there is no authority to grant a retroactive extension of time after an opposition is deemed to have been withdrawn under the *Trade-marks Act*. An application under opposition will similarly be deemed to have been withdrawn where the applicant does not submit either evidence or a statement that it does not wish to submit evidence.

If adopted, the amendments will decrease the length of and provide consistency to opposition proceedings.

Applications deemed abandoned for failure to file a Declaration of Use. The *Trade-marks Act* provides that an application to register a proposed trade-mark shall be deemed abandoned if a Declaration of Use is not received by the Registrar before the later of either six months from the date of the notice of allowance or three years from the date of filing the application in Canada. However, where a timely request is filed on satisfactory grounds, a retroactive extension of time to file a Declaration of Use has been available to applicants.

The Registrar is considering implementing a change whereby retroactive extensions of time will no longer be granted after an application has been deemed abandoned as a result of a failure to file a Declaration of Use.

Through a public consultation process, members of the intellectual property profession have submitted comments to CIPO opposing this change in practice, arguing that it could result in unfair and unintentional abandonment resulting in a loss of rights.

CIPO has not yet announced whether it will go ahead with this change in practice.

Description of colour claims. On September 2, 2010, CIPO announced that it will not proceed with a proposal that, where a trade-mark application includes a colour claim and the colour is not already recognized in the *Trade-marks Regulations*, the applicant would be required to include a description of the colour code and reference system for each colour claimed.

Through a public consultation process, comments were submitted to CIPO opposing this new rule on the ground that applicants could obtain broader rights for colours already recognized under the *Regulations* but narrower protection for any other colour. Instead, it has been suggested that applicants be permitted the flexibility to select the most appropriate method to describe colours not already covered by the *Regulations* whether in words, by listing a recognized colour code, or otherwise.

Jeffrey D. Morton, Vancouver and Heather E. Robertson, Toronto

Firm recognized in *The Best Lawyers in Canada* and the *The Canadian Legal LEXPERT Directory*

Firm dominates in IP rankings in *The Best Lawyers in Canada*. In the 2011 edition of *The Best Lawyers in Canada* (Copyright 2010 by Woodward/White, Inc., Aiken, SC.), Smart & Biggar/Fetherstonhaugh has once again been chosen as the top-ranked firm in the areas of intellectual property law and biotechnology law. In total, 18 of our lawyers have been selected in the areas of intellectual property and biotechnology.

Recognized in intellectual property:

John Bochnovic
Daniel S. Drapeau
Mark K. Evans
Gunars A. Gaikis
Steven B. Garland
François Guay
Brian G. Kingwell
Timothy P. Lo
Michael D. Manson
John R. Morrissey
Joy D. Morrow
J. Christopher Robinson
Keltie R. Sim
Alistair G. Simpson
Theodore W. Sum
Glen B. Tremblay
Matthew Zischka

Recognized in biotechnology:

Gunars A. Gaikis
Brian G. Kingwell
Joy D. Morrow
J. Christopher Robinson
David E. Schwartz

Firm achieves top ranking in IP law in the 2010 edition of *The Canadian Legal Lexpert Directory*. Smart & Biggar/Fetherstonhaugh has been recognized as having more lawyers listed in the area of intellectual property than any other firm in Canada in the 2010 edition of *The Canadian Legal Lexpert Directory*. In total, the firms have 16 lawyers listed in the areas of intellectual property, IP litigation and biotechnology. No other firm in Canada has more lawyers listed across all three areas.

Selected in intellectual property:

John Bochnovic
Daniel S. Drapeau
Mark K. Evans
Ronald D. Faggetter
Gunars A. Gaikis
Steven B. Garland
François Guay
Brian P. Isaac
Yoon Kang
Brian G. Kingwell
Timothy P. Lo
Michael D. Manson
John R. Morrissey
Joy D. Morrow
J. Christopher Robinson
Matthew Zischka

Selected in IP litigation:

Daniel S. Drapeau
Gunars A. Gaikis
Steven B. Garland
François Guay

Selected in biotechnology:

Brian G. Kingwell
Joy D. Morrow
J. Christopher Robinson

Notes

Announcements

Jyoti J. Dasanjh has returned from her articles to join our Vancouver office as an associate. Ms. Dasanjh holds a B.Sc. (Biochemistry) from the University of British Columbia and an LL.B. from the University of Victoria.

Jean-Sébastien Dupont has returned from his articles to join our Montreal office as an associate. Mr. Dupont took introductory courses in Chinese Law at the China University of Political Science and Law in

Beijing and has an LL.B from the University of Montreal.

Jeff Leuschner has joined our Ottawa office as a patent agent. Mr. Leuschner holds a B.Sc. (Electrical Engineering) and an M.Sc. (Electrical Engineering) from Queen's University.

Patrick Roszell has returned from his articles to join our Toronto office as an associate. Mr. Roszell holds a B.Sc. (Mechanical Engineering) from Queen's University and a J.D. from the University of Toronto.

Jayda A. Sutton has returned from her articles to join our Toronto office as an associate. Ms. Sutton holds a B.Sc. Hons. (Biology) and an M.Sc. (Pathology and Molecular Medicine) from Queen's University and a J.D. from the University of Toronto.

Philip Lapin has been appointed to the Canadian Trade-mark Agent Examination Board for the 2010-13 term. His duties will involve establishing and marking the examinations to be taken by prospective Canadian trade-mark agents.

Jeffrey D. Morton has been appointed Chair of the Intellectual Property and Technology Law subsection of the BC Branch of the Canadian Bar Association for the 2010-11 term.

Seminars and Presentations

Mark Pidkowich and **Lisa M. Thorne** taught the course "The Law and New Media" at the British Columbia Institute of Technology's New Media Design & Web Development program from April to June 2010.

Daphne C. Lainson was a member of the AIPLA IP Practice in Japan Committee's delegation to Tokyo where she presented on the topic of "*Association for Molecular Pathology v. USPTO* — Implications for the Genetic Screening Industry" on April 21, 2010.

Jeffrey E. Coles co-wrote a paper titled "Canadian Patent Litigation as Part of a Global Enforcement Regime" which was included in the conference materials for the AIPLA Spring Conference, held in New York, NY, from May 6 to 8, 2010.

Michael D. Manson spoke on the topic of "North American Comparative Trademark Review" at the INTA Annual Meeting, held in Boston, MA, from May 22 to 26, 2010.

Joy D. Morrow presented on the topic of "Personalized Medicines: Patent and Related Regulatory Issues" at The International Economic Forum of the Americas Conference of Montreal on June 10, 2010.

Karen F. MacDonald spoke on the topic of "Counterfeiting: The Crime of the 21st Century" at the Canadian Bar Association Intellectual Property and Technology Law Section meeting, held in Vancouver on June 17, 2010.

Sanro Zlobec led a workshop on patent claim drafting as part of the IPIC-McGill summer program Understanding Patents, held in Montreal from July 26 to 30, 2010. **Marc Gagnon** also led a workshop titled "Patent Office procedures and responses to Office Actions" as part of the same program.

Daniel S. Drapeau spoke on the topic of "Copyright Enforcement and Remedies" as part of the IPIC-McGill summer program The Business of Copyright, held in Montreal from August 9 to 11, 2010.

Stephen J. Ferance and **Michael D. Manson** are once again teaching the Patent Law course at the University of Victoria Faculty of Law from September to December 2010.

Michael D. Manson will participate in a panel discussion on the topic of North American Anti-counterfeiting at the 2010 International AntiCounterfeiting Coalition (IACC) Annual Fall Conference, to be held in Scottsdale, AZ from October 13 to 15, 2010.

Michael D. Manson will speak on the topic of landlord liability at the INTA Anti-Counterfeiting Conference, to be held in Hong Kong on October 21 and 22, 2010. Mr. Manson will also speak on the topic of managing important customs issues (anti-counterfeiting) as part of the same conference.

Daniel S. Drapeau will speak on the topic of Internet law and trade-marks at the Federated Press conference *Droit de l'internet*, to be held in Montreal on November 2 and 3, 2010.

Gunars A. Gaikis will speak as part of the session "Minimizing the Risks of Section 8 Damages" at the Canadian Institute's Ninth Annual Forum on Pharma Patents, to be held in Toronto on November 4 and 5, 2010.

Steven B. Garland will speak on the topic of "Avoiding Drug Patent Invalidity by Meeting the Duty of Good Faith Patent Prosecution Post-*Lundbeck Canada Inc. v. ratiopharm Inc.*" as part of the same conference.

Mark K. Evans will present on the topic of "How the Bill Will Affect the Availability of Statutory Damages" at the Understanding Bill C-32: *Copyright Modernization Act* seminar, to be held in Toronto on November 17, 2010.



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