



# IP PERSPECTIVES

INTELLECTUAL PROPERTY AND TECHNOLOGY LAW NEWSLETTER

## February 2008

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## Canadian courts get tough – recent trilogy of precedent-setting cases against counterfeiters

Defendants in Canadian counterfeit actions will find that the courts are losing patience with those who continue to flout the law after a judgment is made against them.

In recent months, Smart & Biggar has been involved in three separate cases resulting in significant decisions against counterfeiters and pirates in Canada.

It is hoped that this trilogy of cases will send a strong message that recidivism and disdain for previous Court orders will not be accepted. At the least, the precedents will provide IP rights holders with support for seeking increased relief from counterfeiters and pirates, particularly in cases where recidivism may be established.

Court upholds precedent-setting award of damages in favour of Louis Vuitton. The Federal Court recently upheld a precedent-setting award of damages in a default judgment obtained by luxury-brand owner Louis Vuitton, represented by our Vancouver office (*Louis Vuitton Malletier S.A. v. Lin*, 2008 FC 45; upholding *Louis Vuitton Malletier S.A. v. Lin*, 2007 FC 1179).

In December 2001, and again in December 2003, Louis Vuitton executed “John Doe” *Anton Piller* Orders against the defendants, seizing large amounts of counterfeit Louis Vuitton purses. The counterfeiters failed to defend the actions, and default judgments were obtained. Notwithstanding the judgments, attendances by agents, follow-up correspondence and warnings sent by mall management at the request of Louis Vuitton, the defendants continued to sell counterfeit goods.

Louis Vuitton then commenced an action in the Federal Court in July 2007, claiming trademark infringement and passing-off of Louis Vuitton’s famous trade-marks, as well as infringement of copyright in monogram prints. The defendants again failed to defend, and a default judgment against them was granted.

While the total award of \$263,399.14 – which includes compensatory, punitive and exemplary

damages and costs – may not seem high by international standards, it is believed to be the highest of its kind in Canada in relation to a non-defended proceeding concerning counterfeit merchandise. In contrast, the traditional award of damages by the Court in similar circumstances had previously been a mere \$6,000.

In the most recent judgment, one of the defendants moved to have the substantial default judgment set aside on the allegation that her involvement in the business was merely that of a landlord. The Court confirmed its earlier decision, finding at least 20 contradictions or inconsistencies in the defendant's testimony, and that the defendant was "untruthful, contradictory, evasive or inconsistent" on her evidence.

In granting the substantial award of damages and costs on the original motion for default judgment, the Court cited the defendants' continued flagrant activities and "dismissive attitude towards the proceeding and past judgments of [the] Court". It is hoped that the position and reasoning of the Court in both decisions will send a strong message to counterfeiters in Canada.

**Significant victory for Microsoft.** Our Montreal office, representing Microsoft Corporation, sought interlocutory relief against the defendant, a serial software pirate, and a plethora of the defendant's associated companies. Microsoft had previously pursued the defendant for copyright and trade-mark infringement resulting from his sale of pirated copies of Microsoft software. As a result of those proceedings, Microsoft was granted injunctive relief and awarded significant damages for copyright and trade-mark infringement, punitive damages and costs (the total award exceeded \$2,000,000). Despite that

award, the defendant continued to sell pirated Microsoft software.

Microsoft commenced a new action in the Federal Court, and immediately sought and obtained interim relief, including an Anton Piller Order and other injunctions. In *Microsoft Corporation v. Cerrelli*, 2007 FC 1213, the Court granted an interlocutory Mareva injunction freezing all the defendant's assets, granted an interlocutory injunction against further infringement of the MICROSOFT trade-mark, and awarded Microsoft solicitor-client costs.

**Major decision for the Entertainment Software Association.** Our Toronto office, representing the Entertainment Software Association ("ESA"), was involved in criminal proceedings against an individual accused of the manufacture, distribution and sale of pirated video games. The defendant had previously been charged with video game piracy after execution of a search warrant by the RCMP. A plea bargain resulted in the previous charges being dropped, but the defendant's company pled guilty to offences under the *Copyright Act* and the *Criminal Code* and was fined \$67,000. Subsequent investigations and execution of search warrants by the RCMP confirmed that the defendant was continuing his piracy activities from his home, and was supplying pirated video games to stores at a mall in the Toronto area well known for the sale of counterfeit items.

The defendant pled guilty to charges under the *Copyright Act* and the *Criminal Code*. At the sentencing hearing, the Court recognized the significance of the crimes and the recidivist nature of the defendant's activities, and imposed a conditional sentence of the maximum two years less a day house arrest and 200 hours of community service. The Court also ordered forfeiture of funds and goods seized during an RCMP search and seizure (including \$37,000 in cash, computers, materials used in the production of counterfeit video games, etc.), directed payment of \$9,700 to the ESA as restitution, and imposed a fine of \$40,000.

The need for updated tools for combating counterfeiting and piracy in Canada has been recognized by the Canadian Government, and reform is anticipated in the near future. In the meantime, Canadian courts are recognizing the seriousness of the problem, and their willingness evident from this trilogy of cases to address the need for deterrent penalties is to be applauded.

Brian P. Isaac, Toronto and Karen F. MacDonald, Vancouver



# Deemed abandonment provisions pose traps for the unwary

Statutory provisions were construed strictly against the applicants in two recent court decisions.

Although the abandonment and reinstatement provisions in the Canadian *Patent Act* provide patent applicants with useful flexibility in meeting most deadlines, those same provisions also have rigid aspects which can lead to inadvertent loss of rights, as illustrated in two recent Federal Court decisions.

In *DBC Marine Safety Systems Ltd. v. Commissioner of Patents*, 2007 FC 1142, an initial Office Action from the examiner contained two separate requisitions: a requisition under Rule 30(2) for amendments or arguments to comply with the statutory requirements for patentability, and a prior art requisition under Rule 29 for an identification of prior art cited in respect of the applicant's corresponding U.S. and U.K. applications. The applicant's patent agent filed a response to the Office Action three days before the February 10, 2005 response deadline. However, due to an oversight, the response only addressed the Rule 30 requisition, and did not reply to the Rule 29 prior art requisition.

Under section 73(1)(a) of the *Patent Act*, an application is deemed to be abandoned if the applicant does not reply in good faith to "any requisition made by an examiner" by the response deadline. The application can be reinstated within 12 months of the date of abandonment by submitting a reply to the requisition along with a request for reinstatement and a reinstatement fee. If the applicant fails to either take these steps or successfully obtain a discretionary extension of time before the expiry of the 12-month reinstatement deadline, the abandonment becomes irrevocable.

In a September 2, 2003 Practice Notice, the Canadian Intellectual Property Office (CIPO) asserted that an Office Action may contain more than one "requisition", and that a response which is completely silent in respect of any single requisition will result in deemed abandonment for failure to reply in good faith to that particular requisition. CIPO also revised its *Manual of Patent Office Practice* to indicate that in such a case, the applicant would be notified of the insufficiency of its response by a courtesy communication or, if the response deadline had passed, by a notice of abandonment.



Accordingly, in *DBC Marine*, the Commissioner concluded that the application was deemed to have been abandoned on the February 10, 2005 response deadline, because the applicant's response to the Office Action was completely silent in reply to the Rule 29 prior art requisition.

Unfortunately, CIPO did not follow its usual practice of sending either a courtesy communication or a notice of abandonment in a timely fashion to notify the applicant of the deemed abandonment and the reinstatement deadline. In fact, CIPO did not issue the notice of abandonment until May 8, 2006, by which time the 12-month reinstatement deadline had already passed, with the result that the abandonment had already become irrevocable before the applicant learned of its occurrence. Therefore, although the applicant promptly attempted to reinstate the application when it learned of the abandonment, the Commissioner refused to permit reinstatement on the ground that the 12-month reinstatement period had already expired.

The applicant's subsequent request for judicial review by the Federal Court was dismissed. The applicant submitted that the word "requisition" means the Office Action document itself, rather than each individual request contained therein. Therefore, the applicant argued that its response to the Office Action constituted a reply in good faith to the "requisition", despite the absence of a reply to the Rule 29 prior art request. The Court rejected this submission and held that each individual requisition contained in the Office Action requires a separate reply in good faith to prevent a deemed abandonment. Good faith cannot

excuse the complete absence of a reply to a requisition.

The Court further held that the application was deemed to be abandoned by operation of law, and not as a result of any reviewable decision by the Commissioner. Thus, questions of procedural fairness relating to the Commissioner's failure to inform the applicant of the deemed abandonment until after the reinstatement deadline could not relieve the applicant of its statutory obligations. The Court commented that even if the Commissioner had attempted to ease the harsh consequences of the statutory regime, those steps would have been of no effect because they are not authorized by the Act.

In *Rendina v. Commissioner of Patents*, 2007 FC 914, deemed abandonment arose in a different context, relating to the annual maintenance fees that must be paid to keep an application in force. If a maintenance fee is not paid by the due date, the application is deemed to be abandoned under section 73(1)(c) of the *Patent Act*. The application can be reinstated within 12 months of the date of abandonment by submitting a request for reinstatement along with payment of a reinstatement fee and the overdue maintenance fee. If no action is taken by the 12-month reinstatement deadline, the abandonment becomes irrevocable.

In *Rendina*, the applicant was an individual inventor who had initially filed his own patent application, then subsequently appointed a patent agent. The first maintenance fee, due April 4, 2005, was not paid, and CIPO issued a notice of abandonment advising of the deemed abandonment and the reinstatement deadline of April 4, 2006.

On March 21, 2006, the applicant/inventor filed a request for reinstatement with an authorization to charge the required reinstatement and maintenance fees to his credit card. CIPO received this request and processed these fee payments. However, on March 31, 2006, CIPO mailed a notice to the

applicant/inventor advising that maintenance fees for a pending application can only be paid by the "authorized correspondent" (*i.e.*, the appointed patent agent). Therefore, his payments were rejected and would be refunded upon request. Unfortunately, the applicant/inventor did not receive this notice from CIPO until April 5, 2006, the day after the reinstatement deadline. A subsequent request for reconsideration and request for reinstatement filed by the applicant's agent were refused.

On judicial review, the Commissioner relied upon Rule 6(1), which states that "[e]xcept as provided by the Act or these Rules, for the purpose of prosecuting or maintaining an application the Commissioner shall only communicate with, and shall only have regard to communications from, the authorized correspondent". The "authorized correspondent" is defined in Rule 2 to mean an appointed patent agent (the only exceptions did not apply to this application or most other applications).

The applicant attempted to rely upon the opening words of Rule 6: "[e]xcept as provided by the Act or these Rules". The applicant pointed to section 27.1 of the Act, which states that "the applicant" shall pay the required maintenance fees, and Rule 98, which states that "the applicant" shall take the required steps to reinstate an abandoned application. Thus, the applicant argued that these other provisions amount to an exception as contemplated in the opening words of Rule 6. The applicant's argument was even supported by CIPO's own *Manual of Patent Office Practice*, which states in section 24.02.02 that "[o]nly the applicant or the authorized correspondent shall pay maintenance fees".

However, the Court rejected this argument, noting that it would apply equally to a large number of other references to "the applicant" in the Act and Rules. The Court was not willing to conclude that each such reference created an exception to Rule 6, as this interpretation would deprive Rule 6(1) of any meaning. The





Court commented upon the confusion and administrative burden that would result if CIPO were required to communicate with multiple correspondents regarding an application, as well as the potential for conflicting instructions. The Court viewed the purpose of Rule 6(1) as preventing such confusion, and was unwilling to adopt an interpretation that would defeat that purpose.

The harshness of the results in these two cases flows from the rigidity of the deemed abandonment dates and reinstatement deadlines, which arise automatically by operation of law, regardless of whether either the applicant or CIPO is aware of the defect that resulted in abandonment or unsuccessful reinstatement until long after the deadline for correcting it has passed.

Despite this rigidity, Canada's abandonment and reinstatement regime provides applicants

with significant flexibility in meeting most deadlines. Unlike the United States, Canada permits reinstatement even if the application was intentionally allowed to fall abandoned. If necessary, therefore, Canada's abandonment and reinstatement procedures can be used to effectively obtain a one-year extension of deadlines that are technically not extendable, such as the deadlines for requesting examination or paying annual maintenance fees, or the six-month deadline for responding to an Office Action. This approach should be used sparingly, as it erodes a portion of the patent term, which runs for 20 years from the filing date regardless of the issue date. Diligence is also required to avoid any defects in reinstatement that might not otherwise be discovered until after the reinstatement deadline.

Stephen J. Ferance, **Vancouver**

## Update on copyright in Canada



**Proposed copyright amendment Bill sparks public outcry.** A Bill seeking to reform Canada's copyright law had been expected to be introduced in December 2007, but was stalled after thousands of Canadian citizens expressed loud opposition to the Bill through the popular website Facebook. The Bill was intended to implement a number of copyright protections required by World Intellectual Property Organization (WIPO) treaties. The most controversial aspects of the proposed reform relate to provisions holding that the act of circumvention of technological measures constitutes copyright infringement, and a ban on the use of devices to circumvent technological measures.

It had been reported that the proposed Bill resembled the U.S. *Digital Millennium Copyright Act (DMCA)*, but went beyond the protections required by the international treaties. Opponents to the Bill argue that it should only be a violation of the law to circumvent a technological protection measure if the underlying purpose is to infringe copyright. For example, an individual who purchases a CD should be able to transfer songs from that CD onto an MP3 player without infringing copyright.

The Government of Canada is not expected to introduce this legislation for at least several months, while it considers amendments and seeks to achieve consensus among the various stakeholders.

**Copyright Board unable to impose tariff on digital audio recorders.** In a decision dated January 10, 2008 (*Apple Canada Inc. v. Canadian Private Copying Collective*, 2008 FCA 9), the Federal Court of Appeal held that the Copyright Board has no legal authority to certify a tariff which was slated to be introduced later this year on digital storage devices. Had the tariff been authorized by the Court, the sale in Canada of products such as Apple Inc.'s iPod media player would have triggered a tax of between \$5 and \$75. Devices storing more than 30 gigabytes of memory would have been targeted with the highest level of tax.

The Board "has no legal authority to certify a tariff on digital audio recorders or on the memory permanently embedded in digital audio recorders", Judge Karen Sharlow wrote on behalf of the three-member appeal panel.

The decision was made under legislation imposing a private copying tariff scheme. Because of the difficulty in enforcing these rights, the *Copyright Act* recognizes that copying recorded music for private use does not constitute copyright infringement. However, the *Copyright Act* entitles copyright

holders including music labels and publishers to compensation by imposing a levy on a blank "audio recording medium". The rate of the levy is fixed each year by the Copyright Board, on recommendation from the Canadian Private Copying Collective ("CPCC"). Levies collected by the CPCC are then distributed to eligible collective societies for redistribution to the rights holders themselves.

What troubled many in the copyright community in Canada is that the issue had already been decided in *Canadian Private Copying Collective v. Canadian Storage Media Alliance*, 2004 FCA 424. In that case, the Court held that the Board was incorrect in concluding that memory embedded in a digital audio recorder was leviable, because the object actually sold, a digital audio recorder, was not a "medium" as defined under the Act. Subsequent to the decision, however, the CPCC proceeded to file a proposed tariff on digital audio recorders, making it necessary for the Federal Court of Appeal to once again confirm that a levy cannot be applied to digital audio recorders such as an iPod.

Heather E. Robertson, Toronto

## Patent prosecution highway joins Canada and the United States

This pilot program is intended to expedite patent examination in both countries.

The Canadian Intellectual Property Office (CIPO) and the United States Patent and Trademark Office (USPTO) have announced the Canada-U.S. Patent Prosecution Highway (PPH). Under the PPH, it is possible to have an application advanced out of turn for examination where there is at least one claim that has been indicated as allowable by one of the two patent offices. This pilot program is scheduled to run from January 28, 2008 to January 28, 2009, and may be extended for an additional year for further evaluation.

In general, if one of the patent offices indicates that at least one claim in an initial application is allowable, the other patent office may grant advanced examination of a corresponding application filed in the other patent office, if certain documents are filed. There are some exceptions to this generalization, and eligibility

for the PPH is subject to priority claiming requirements which differ somewhat in each country. CIPO is not charging any additional fee for advanced examination during the pilot program, although a petition fee is required by the USPTO. Advanced examination generally means advancing the application to the front of the examiner's queue for immediate examination, allowing the applicant to bypass examination backlogs. In Canada, examination backlogs are usually at least one year and often exceed three years, depending upon the field of technology.

To qualify for advanced examination, all of the claims must correspond (*i.e.*, be the same or similar in scope) or be amended to correspond to the claims that have been indicated to be allowable in the initial application. This may have significant implications for both Canadian

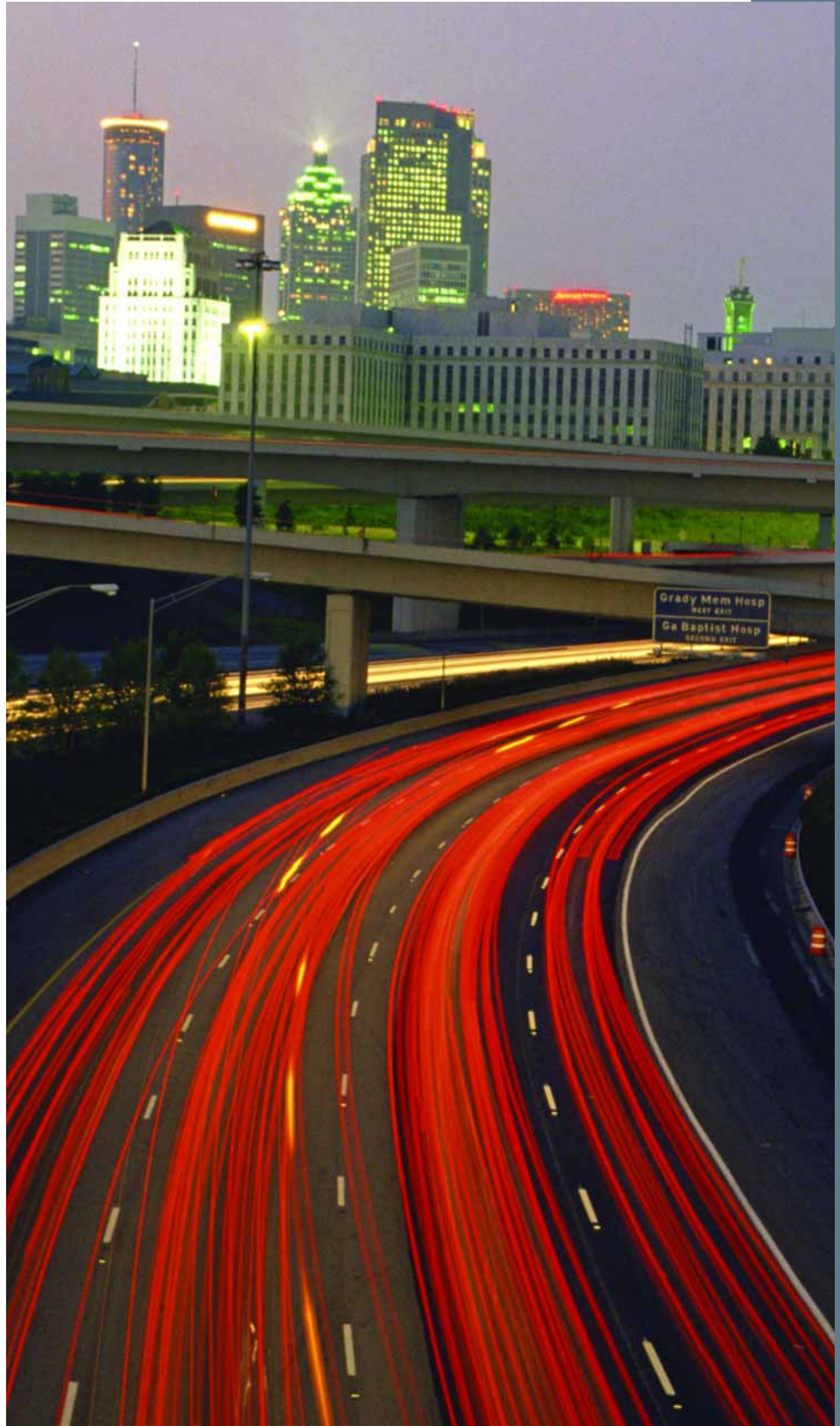
and U.S. applications that participate in this program.

To decide whether it is desirable for a Canadian application claiming priority from a U.S. application to enter the PPH, the U.S. prosecution should be carefully considered. In some situations, acceptable prosecution strategies in the United States may be detrimental in Canada. Differences between our countries' respective double-patenting doctrines give rise to one such example. However, strategies are available to mitigate some of these potential problems. For example, in some cases where multiple continuing applications are pending in the U.S., it may be desirable to defer the request for examination in Canada until all of the desired continuing applications have been allowed in the U.S. More generally, the suitability of this program for Canadian applications should be evaluated on a case-by-case basis, having regard to the technology and subject matter of the application and the state of prosecution in the United States.

Conversely, Canada's unity of invention standard, which is more permissive than U.S. restriction practice, could potentially streamline U.S. prosecution by reducing the number of divisional or continuation applications, if the USPTO gives deference to CIPO's decision to permit multiple claim sets to co-exist in the same application. Once again, however, the Canadian prosecution should be carefully considered before deciding to request advanced examination of the U.S. application. One of the requirements for entry into the program in the U.S. is to provide copies of all of the Office Actions issued during the Canadian prosecution. As such, these documents will officially become part of the USPTO file wrapper, resulting in a distinct possibility that the Canadian prosecution history may give rise to prosecution history estoppel in the U.S.

Careful consideration of the prosecution history of the initial application is required before deciding whether the corresponding application in the other patent office should participate in the PPH program. In general, if early issuance of an application is commercially important, then this program may provide a good opportunity to bypass lengthy examination backlogs.

**Graham J. K. McKinnon, Vancouver**



## Olympic safeguards now in force

In the *June 2007* issue of *IP Perspectives*, we summarized then-pending legislation to fortify protection for Olympic and Paralympic marks in Canada. The pertinent legislation, the *Olympic and Paralympic Marks Act and Regulation*, both came into force on December 17, 2007. The effect of the legislation that is now in force is substantially as we summarized it in June 2007.

As a brief summary, section 3 of the *Act* prohibits adoption or use, in connection with a business, of a mark that is or is likely to be mistaken for an enumerated mark or a

translation thereof. Also, until December 31, 2010, section 4 of the *Act* prohibits directing attention to business, wares, or services in a way that is likely to mislead the public into believing that they are approved, authorized, or endorsed by one of many Olympic or Paralympic organizations, or that a business association exists with any such organization. The usual prerequisite proof of irreparable harm for interim or interlocutory injunctions is not required until December 31, 2010.

Jonas H. Gifford, **Vancouver**

## Canadian Industrial Designs Database now offers complete collection online

The Canadian Intellectual Property Office (CIPO) has announced that the complete collection of Canadian Industrial Design registrations is now available via the Canadian Industrial Designs Database. The database can be accessed and searched through the CIPO website: [http://strategis.ic.gc.ca/sc\\_mrksv/cipo](http://strategis.ic.gc.ca/sc_mrksv/cipo). Searches can be conducted using criteria such as title, classification, current owner, interested parties, description, status and registration date.

CIPO originally launched the Canadian Industrial Designs Database in December 2005, but at that time, the database only included about 10,000 designs dating back to June 15, 2002. In contrast, now that the database contains the complete collection of Industrial

Design registrations, over 110,000 Canadian industrial designs are electronically accessible on CIPO's website dating back to December 1861. Pending applications that have not yet been registered continue to be confidential until their registration.

The upgraded Canadian Industrial Designs Database is a valuable resource for anyone who needs to conduct patentability or registrability searches to assess the prospects of obtaining a patent or design registration for a new invention or design. Similarly, the database is an additional tool for those conducting validity searches to investigate the validity of a particular issued patent or design registration.

David A. Gileff, **Vancouver**

## Firm sponsors award to encourage entrepreneurial spirit in Montreal

For the second year running, Smart & Biggar/Fetherstonhaugh is sponsoring the *Concours des anges financiers de Montréal*. This event aims to encourage entrepreneurs to create or develop their businesses by providing them with an opportunity to present their projects to experienced investors and to the business community. The finalists of this contest are presenting their projects at a Gala on February 28, 2008. In collaboration with the *Fondation du maire de Montréal pour la*

*jeunesse* and the *Jeune Chambre de commerce de Montréal*, the firm will offer the Innovation Award to the entrepreneur who has demonstrated exceptional innovation and originality in the conception and development of his or her product or service. As part of the sponsorship, Brigide Mattar and Sanjay Goorachurn also gave a seminar pertaining to managing intellectual property in a start-up company to the finalists of the contest.



## Recent transitions at Smart & Biggar/ Fetherstonhaugh

**Chair of the firms.** Effective January 1, 2008, John Bochnovic has succeeded A. David Morrow as Chair of Smart & Biggar/Fetherstonhaugh. Mr. Morrow had been Chair of the firms since 2001, and has now moved into the role Of Counsel. The firms express their sincere gratitude to Mr. Morrow, and welcome Mr. Bochnovic, who brings to the role of Chair a long history and extensive experience with the firms.

**New partners.** The partners of Smart & Biggar/Fetherstonhaugh are pleased to announce the newest members of the partnerships, effective January 1, 2008.

*Mark G. Biernacki* is a partner of Smart & Biggar/Fetherstonhaugh. He practises in our Toronto office, devoting most of his practice to litigation in all aspects of intellectual property law including patent, trade-mark, industrial design and copyright matters. Mr. Biernacki was educated at the University of Toronto, where he received a B.A.Sc. in mechanical engineering, and Osgoode Hall Law School, where he received an LL.B. He was called to the Ontario Bar in 1999. He is a registered patent and trade-mark agent.

*Jeremy E. Want* is a partner of Smart & Biggar/Fetherstonhaugh. He practises in our Ottawa office, focusing primarily on intellectual property litigation, including patent, trade-mark and copyright matters. Mr. Want was educated at the University of Western Ontario, where he received a B.Sc. in chemistry, and the University of Manitoba, where he received an LL.B. He was called to the Ontario Bar in 2000. He is a registered patent and trade-mark agent, and is registered to practise before the USPTO for Canadian applicants.

*Sanro Zlobec* is a partner of Fetherstonhaugh. He practises in our Montreal office, where he is responsible for drafting and prosecuting patent applications in the general areas of information technology, telecommunications, business methods and electronic commerce. Mr. Zlobec was educated at McGill University, where he received a B.Eng. and an M.Eng. in electrical engineering. He is a registered patent agent, and is registered to practise before the USPTO for Canadian applicants.

**New counsel.** The partners are pleased to announce the appointment of the following individuals to the position of counsel, effective January 1, 2008.

*Christine N. Genge* practises in our Ottawa office, primarily in the patent, industrial design and trade-mark areas of intellectual property. She was educated at the Memorial University of Newfoundland, where she received a B.Eng. in mechanical engineering, and the University of Ottawa, where she received an LL.B. Ms. Genge was called to the Ontario Bar in 1998. She is a registered patent and trade-mark agent, and is registered to practise before the USPTO for Canadian applicants.

*Solomon M.W. Gold* practises in our Ottawa office, concentrating on the preparation and prosecution of patent applications relating to chemical and biotechnology subject matter. He was educated at the University of Toronto, where he received a B.Sc. in physiology, at York University, where he received an M.Sc. in biology, and the University of Western Ontario, where he received an LL.B. Mr. Gold was called to the Ontario Bar in 1991, and is a registered patent and trade-mark agent.

*Sanjay D. Goorachurn* practises in our Montreal office, where his practice consists primarily of advising clients on the intellectual property and technology aspects of commercial transactions, and counselling clients on the strategic management and exploitation of their IP assets. He was educated at the University of Manitoba, where he received a B.Sc. in chemistry and an LL.B. Mr. Goorachurn was called to the Bar of Ontario in 1992, and the Bar of Quebec in 2006.

*Geneviève M. Prévost* practises in our Toronto office, primarily focusing on the acquisition, clearance, prosecution, enforcement, litigation and licensing of trade-marks, both domestically and internationally. She was educated at Concordia University, where she received a B.Sc. in chemistry, and at Osgoode Hall Law School, where she received an LL.B. Ms. Prévost was called to the Ontario Bar in 1998, and is a registered trade-mark agent.

## Firm achieves top-level rankings in two major surveys

**Managing Intellectual Property.** The results of the annual Managing Intellectual Property international survey of patent firms have been released, and Smart & Biggar/Fetherstonhaugh has been recognized in the coveted 'first tier' as one of only two Canadian firms in the area of patent prosecution, and one of three Canadian firms in the area of patent contentious.

Now in its twelfth year, the publishers of Managing Intellectual Property magazine send out over 4,000 survey questionnaires and conduct 700 in-depth phone interviews with IP practitioners in over 65 jurisdictions around the world. Lawyers may not vote for themselves or any other member of their firm. The results are arranged geographically and then further divided into tiers, with firms in the top tier

"regarded as the leaders in their market with the greatest expertise, experience and broadest coverage", according to the survey's editors.

**LEXPERT/American Lawyer Guide to the Leading 500 Lawyers in Canada.** Smart & Biggar/Fetherstonhaugh is pleased to announce that five of the firms' professionals have been recognized in the 2008 LEXPERT/American Lawyer Guide to the Leading 500 Lawyers in Canada in the areas of intellectual property, intellectual property litigation and biotechnology – more than any other firm in Canada.

We are proud of these recognitions, and wish to congratulate our professionals who have been recognized.

## Notes

### Announcements

**Ivan C. Fong** has joined our Ottawa office as an associate. Mr. Fong holds a B.Sc. from McGill University and an LL.B. from the University of Ottawa.

**Tomek Nishijima** has returned after his articles to join our Montreal office as an associate. Mr. Nishijima holds a B.A. (Economics) from McGill University, an LL.B. from the University of Windsor, and an LL.L. from the University of Ottawa.

**David J. Suchon** has returned after his articles to join our Toronto office as an associate. Mr. Suchon holds a B.Sc. from the University of Toronto and an LL.B. from Queen's University.

Smart & Biggar wishes to congratulate our professionals who became registered Canadian patent agents in 2007. In Ottawa: **T. Nessim Abu-Zahra, Daniel M. Anthony, Paul den Boef, Mark S. Starzomski.** In Toronto: **Joseph J. Fraresso, Cheryl M. Ng.**

### Seminars and Presentations

**Michael D. Manson** and **Stephen J. Ferance** taught the patent law course at the University of Victoria's Faculty of Law from September to December 2007.

**Colin B. Ingram** spoke on intellectual property law and careers in intellectual property at the

University of Ottawa section of the American Society of Mechanical Engineers 2007 Technical Seminar on November 7, 2007.

**Graham J. K. McKinnon** spoke on the topic of "The most important developments that clerks need to understand in the areas of Canadian Practice, PCT Practice and U.S. Practice" at a seminar hosted by the Intellectual Property Institute of Canada, held in Vancouver on November 29, 2007.

**J. Christopher Robinson** was an instructor at the Intellectual Property Institute of Canada's drafting and prosecution module of the patent agent training course from September to December 2007.

**J. Christopher Robinson** is teaching the patents portion of the intellectual property law survey course offered by the Faculty of Law at the University of British Columbia, from January to April 2008. **Timothy P. Lo** and **Karen F. MacDonald** are teaching the trade-mark and copyright sections (respectively) of the same course.

**Sanjay D. Goorachurn** and **Brigide Mattar** gave a presentation titled "Managing and Leveraging IP for Commercial Success" at the *Concours les anges financiers*, held in Montreal on January 14, 2008.

**A. David Morrow** presented a paper on developments in patent law in 2007 at the

annual Update on Intellectual Property Law presented by the Law Society of Upper Canada, held in Ottawa on January 18, 2008. The paper was co-authored by Donald MacOdrum of Lang Michener.

**Sanjay D. Goorachurn** gave a presentation on "IP and Merger & Acquisition: Impact on the Global Economy" at the Osgoode Hall Law School in the context of the 15th Annual Canadian International Law Students' Conference, held in Toronto on February 9, 2008.

**Gunars A. Gaikis** is speaking on the topic of "Pharma Patents and Competition Law Issues: Patentee's Perspective" at Insight Information's Drug Patents and Legal Forum in Toronto on February 27-28, 2008. **A. David Morrow** is speaking on the topic of "Double Patenting in the Context of Pharmaceutical Patents", and **Nancy P. Pei** is speaking on the topic of "The AstraZeneca Decision of the Supreme Court of Canada – Downstream Effects", at the same forum.

**Michael D. Manson** and **Stephen J. Ferance** will be joining Mr. Justice Roger Hughes of the Federal Court, to speak to the IP Law Club at the University of Victoria on March 3, 2008. Mr. Manson will speak on the subject of counterfeit goods, while Mr. Ferance will discuss recent developments in U.S. patent law and their relevance to Canada.

**Brian P. Isaac** will attend as a representative of Canadian industry at a Government and Industry Working Group Meeting on Intellectual Property – SPP Trilateral (Canada, Mexico, and the U.S.) to be held in Vancouver on March 17-18, 2008.

**Brian P. Isaac** will speak on the topic of "Teaming Up to Help Stop Counterfeiting" at the CMX CIPHEX show, to be held in Toronto on March 28, 2008.

**Elliott S. Simcoe** will speak on the subject of "Regulators and Policy Considerations, Challenges and realities of Business Method Patents" at the Patentability of Business Methods Invitational Forum, to be held in Alton, ON on April 4, 2008.

**Gunars A. Gaikis** will speak on the topic of "Successfully Maximizing Product Life Cycle: What Every Innovator Needs to Know" at the Canadian Institute's conference on Life Sciences Business and Legal Guide to Product Life Cycle Management, to be held in Ottawa on April 10-11, 2008.

**Brian P. Isaac** will speak on the topic of "Protecting Your Products and Brands" on a

panel at the Canadian Corporate Counsel Association's Spring Conference, to be held in Toronto on April 14, 2008.

**Elliott S. Simcoe** will moderate a panel discussion titled "Dot com and other dots: choosing top level domains for domain name registration strategies" at the International Trademark Association's Annual General Meeting, to be held in Berlin, Germany on May 17-21, 2008.

**Mark K. Evans** will deliver a lecture on "Trade-Mark Litigation Remedies and Procedures" to the Law Society of Upper Canada in Toronto on June 5, 2008. This lecture is based upon the chapter co-authored by Mr. Evans and Michael D. Manson of our Vancouver office, which is to be published in the upcoming IP Bench Book and will be distributed to Canadian judges by the National Judicial Institute.

## Publications

**Elizabeth A. Hayes**, "Size Matters – Convincing the Patent Office That Big Things Come in Small Packages", *Canadian Chemical News/L'Actualité chimique canadienne (ACCN)* (a publication of The Chemical Institute of Canada), January 2008.

**Brian P. Isaac**, "Canadian Courts Get Tough with Product Counterfeiters", *The Lawyers Weekly*, January 18, 2008.

**Andréanne Auger** and **George Elvira**, "Intellectual Property Rights: a Key Asset for Early Stage Biotechnology Companies", *The Lawyers Weekly Magazine*, February 2008.



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