

IP PERSPECTIVES

INTELLECTUAL PROPERTY AND TECHNOLOGY LAW NEWSLETTER

June 2008

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Louis Vuitton awarded record-setting damages against counterfeiters

Canadian courts are stepping up to the challenge and are increasingly protecting rights holders from recidivist offenders.

Louis Vuitton, represented by Michael Manson, Karen MacDonald and Jonas Gifford of our Vancouver office, has been granted what is believed to be the highest award of damages in Canada against purveyors of counterfeit goods. Following several recent Federal Court decisions that cracked down on counterfeiters, on June 19, 2008, the British Columbia Supreme Court expressed its disapproval of counterfeiting activities in *Louis Vuitton Malletier S.A. v. 486353 B.C. Ltd.*, 2008 BCSC 799. In a summary trial decision, Madam Justice Boyd ordered a first group of defendants to pay a total amount of \$980,000, including compensatory, punitive and exemplary damages, to the plaintiffs, Louis Vuitton Malletier S.A. and Louis Vuitton Canada, Inc. The Court also awarded costs in an additional amount to be assessed and adjourned its deliberation of damages against a remaining defendant until later this year.

The defendants included two corporations and four individuals who were operating stores in the greater Vancouver area through which they were selling counterfeit Louis Vuitton merchandise.

The first group of defendants, against whom the collective \$980,000 award of damages was made, was operating three stores under the name Wynnies Fashion Club and one store under the name Franciscas Fashion Club. In August 2004, the plaintiffs executed an Anton Piller Order against two of the Wynnies Fashion Club locations, seizing hundreds of counterfeit Louis Vuitton products. Despite that seizure and a subsequent judgment obtained in the Federal Court, the defendants continued to sell counterfeit Louis Vuitton merchandise. The defendant Wynnies, who was the principal player in the Wynnies Fashion Club stores and the importer of the goods being sold, entered into a settlement agreement with the plaintiffs in March 2006 after being served with a cease and desist letter, but subsequently continued to breach both that agreement and the Federal Court judgment. Between January 2006 and January 2008, numerous purchases and observations of counterfeit Louis Vuitton merchandise were made at the various locations, including several after the plaintiffs had commenced their action in the British Columbia Supreme Court.



for breach of contract, trade-mark infringement, passing off and copyright infringement.

In addressing the issue of damages for trade-mark infringement, the Court considered the decision and reasoning of the Federal Court in *Louis Vuitton Malletier S.A. v. Pi-Chu Lin*, 2007 FC 1179, although the evidence before the Court in the present action permitted the Court to grant a significantly greater award of damages. In the *Pi-Chu Lin* case, the Federal Court had granted the traditional nominal damages award of \$7,250 (\$6,000 adjusted for inflation) on a per instance of infringement basis in a default judgment. In the present action, the defendants had defended the action and had been examined for discovery, yielding evidence that their turnover of inventory occurred approximately three times per year, enabling the Court to apply the \$7,250 damages award on a per turnover of inventory basis. Moreover, as the traditional award of \$7,250 was designed to reflect the activities at a single retail location for a single plaintiff, the Court also made this per inventory turnover award at each retail location and for each of the two plaintiffs.

The Court also made an additional award of damages against the principal player and importer of the counterfeit goods, Wynnie Lee, using \$29,000 (\$24,000 adjusted for inflation) as a starting point for nominal damages against her as an importer/distributor, and again applying that amount on a per inventory turnover and per plaintiff basis, but deducting Wynnie Lee's liability at the retail level to avoid double jeopardy on the calculation of trade-mark infringement damages.

In addition, the Court awarded full statutory damages of \$20,000 per work for the instances of copyright infringement by the various defendants, citing the defendants' misconduct both before and during the proceeding.

Further, following the test set out by the Supreme Court of Canada in *Whiten v. Pilot Insurance Co.*, 2002 SCC 18, and finding that

the defendants' "previous and ongoing actions are clearly knowing, planned and deliberate"; the Court also granted an award of \$200,000 in punitive and exemplary damages against Wynnie Lee and \$100,000 in punitive and exemplary damages against the other three defendants acting in concert with Wynnie Lee. The Court also granted special costs against this group of defendants, citing the deliberate and inexcusable repeat infringement of the plaintiffs' rights and the failure of the defendants to cooperate to any significant degree in the litigation.

While the Court declined to levy a fine for contempt of the previous Federal Court judgment, it was noted that the punitive and exemplary damages awards granted included an element of rebuke for the defendants' breach of that judgment.

The Court also found liability of the remaining defendant, Jacqueline Lee, who imported and distributed counterfeit Louis Vuitton merchandise through two retail outlets operating under the trade name *Coloro Collection*. However, the Court deferred the issue of quantum of damages against this self-represented defendant, who had appeared on the first morning of the summary trial and unsuccessfully sought an adjournment for the purpose of retaining counsel. The determination of damages against this last defendant has been adjourned until later this year.

As with the previous *Louis Vuitton* decision, this judgment will hopefully send another strong message to counterfeiters in Canada and provide an additional precedent for IP rights holders to seek enhanced damages against recidivist offenders. These decisions also illustrate an important consideration for IP rights holders: damage awards in these types of scenarios can be maximized by gathering evidence of repeated sales of counterfeit products over a period of time, and/or other reliable evidence of inventory turnover.

Karen F. MacDonald, Vancouver

Canada's proposed amendments to the Copyright Act – Bill C-61

The Government of Canada has tabled proposed legislation designed to update Canada's *Copyright Act* to address the Internet and digital technology and to ratify WIPO Internet treaties to which Canada is a signatory. Bill C-61, *An Act to Amend the Copyright Act*, was tabled June 12, 2008 and attempts to balance the interests of Canadian consumers who use digital technology to view and reproduce content with those of rights holders who create content.

Overview. Bill C-61 expands rights associated with photographs, performers' rights and rights in sound recordings. It also includes provisions dealing with Internet service provider (ISP) liability both in respect of ISPs facilitating communication over the Internet and those providing tools for locating information on the Internet. It also deals with liability for tampering with digital rights management information and technological means used to protect copyright and other rights protected under the Act. The Bill also provides that making copies of printed matter or sound recordings onto another medium, circumventing protective measures for the sole purpose of rendering software compatible, or making copies of works communicated by telecommunication for time-shifting purposes, do not infringe. There are also specific limitations associated with each of the new rights and with the use by educational institutions of materials in which copyright and the other rights covered by the Act subsist.

Expanded rights. The Bill expands performers' rights by adding a number of specific rights relating to performances. So long as a performance is not fixed, the owner of the rights therein has the sole right to fix the performance (*i.e.*, record it), to communicate the performance to the public by telecommunication, and to perform it in public if it is communicated to the public by any form of telecommunication other than radio waves. If the performance is recorded, the owner maintains the sole right to authorize reproduction. Similarly, the owner of rights in a performance is provided with the sole right to authorize rental of a recording thereof, to telecommunicate it in such a way that allows access at a time and place chosen by the public (file sharing), or to sell or otherwise transfer ownership of a recording that can be put into circulation as a tangible object if the sound recording of the performance has never previously been transferred with the

authorization of the performer (making available).

The Bill also provides that royalties collected by collective societies in Canada, and the collective royalty regime in general, will apply to sound recordings once published but do not apply to file sharing.

In addition to the rights discussed above, Bill C-61 explicitly provides performers with moral rights in their performances.

Anti-circumvention and rights management information. Bill C-61 provides that it is an infringement to circumvent technological measures used to control access to a work, performance or sound recording, or to offer services or devices whose primary purpose is circumventing such technological measures. Similarly, Bill C-61 states that it is an infringement to remove rights management information if it is done with knowledge that the removal will conceal infringement or reduce royalties payable to a collective society. A criminal provision is specifically added to the *Copyright Act* to deal with circumvention activities, but not removal of rights management information.

Exceptions to infringement. In balancing the rights of intellectual property owners against the interests of Canadian consumers, certain exceptions to infringement and limitations on liability are included in Bill C-61. Many of the exceptions reflect the reality of what has been occurring in Canadian society for decades. For example, one of the exceptions provides that it



is not an infringement to copy certain types of works from one medium onto another (e.g., from videocassette to digital memory) if certain stringent conditions are satisfied. In particular, the original work being copied must not have infringed, the original work must have been legally obtained and must not have been borrowed or rented, and it is not permitted to overcome technological protective measures in making the copy. Only one copy may be made per medium, the copy must be used only for private purposes and all copies must be destroyed if the original copy of the work is transferred.

Bill C-61 also specifically provides an exception to infringement in respect of time-shifting, the common practice whereby people record works communicated by broadcasters for enjoyment at a later time. Interestingly, the time-shifting exception specifically does not apply to Internet broadcasts unless they are simultaneously broadcast via radio or television.

Exceptions regarding the various rights of educational institutions are specified and clarified.

The anti-circumvention provisions are also subject to certain exceptions, including the following: the government may circumvent without liability in certain circumstances; anyone may circumvent to render a program compatible with another computer program; circumvention may be used if legitimate for decryption or security research; and circumvention is allowable to the extent required to prevent collection of personal information or to overcome a disability, so long as it is used solely for those purposes.

Finally, Bill C-61 prescribes a limitation on the statutory damages available under the *Copyright Act* when asserted against an individual who infringes solely for personal purposes. The provisions limit statutory damages to a maximum of \$500.00 for all infringement by an individual solely using infringing copies for personal purposes.

ISPs. Bill C-61 codifies prior jurisprudence in Canada to the effect that an ISP does not infringe copyright solely by providing means for telecommunication or reproduction of works or other subject matter through the Internet or other networks. Similarly, caching works or other subject matter for the purposes of efficiency of telecommunication does not infringe. However, ISPs who provide digital memory in which another person stores a work or other subject matter will infringe copyright if doing so while being aware of a court decision to the effect that the person storing the work infringes copyright.

Bill C-61 also allows a rights holder to send a notice of claimed infringement to an ISP, including those facilitating communication over the Internet and those providing “information location tools” (search engines, etc.), and requires that the ISP shall, on being paid a fee lawfully charged, forward the notice electronically to the alleged infringer and retain records allowing identification thereof. Liability of ISPs is limited to statutory damages in an amount between \$5,000.00 and \$10,000.00 if they fail to perform their prescribed obligations. Remedies against providers of information location tools are limited to injunctive relief.

Discussion. Bill C-61 has raised considerable debate in Canada regarding its efficacy, from the perspectives of both rights holders and consumers. For instance, providing a notice-and-notice (as opposed to notice-and-takedown) system for ISPs, and the need to obtain a decision of a court before the ISP can be required to remove offending content, are exemplary of difficulties still facing rights holders in addressing the digital/Internet market in Canada. Difficulty proving legitimacy of personal copies is an example of an issue raised by consumer groups. Nevertheless, the implementation of the WIPO Internet treaties and generally taking steps to deal with the reality of the Internet and digital piracy are long overdue in Canada. The introduction of this Bill by the Canadian government must be applauded as a significant step in these respects.

Brian P. Isaac and Junyi Chen, Toronto



CIRA restricts the availability of information regarding certain types of domain name registrants

It will now be more difficult to determine the identity of .ca domain name registrants who are individuals.

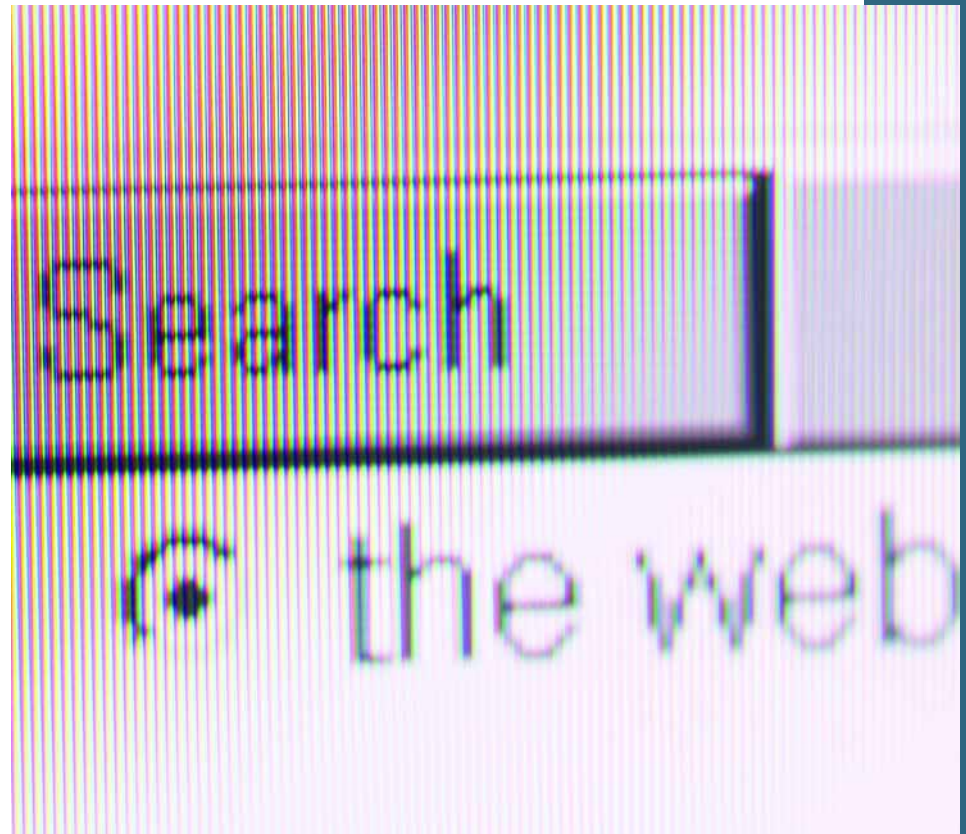
The Canadian Internet Registration Authority (CIRA), the organization responsible for managing Canada's dot-ca (.ca) domain names, has recently implemented significant changes to its online WHOIS directory service used by members of the public to search for information regarding registered .ca domain names. As of June 10, 2008, the WHOIS service no longer provides personal information (i.e., registrant name, address, telephone number, fax number and email address) of .ca domain name registrants who are individuals.

This change to the WHOIS service is presumably to protect the privacy of individual registrants. The new restrictions do not apply to domain name registrants who are not individuals (e.g., corporations), for whom personal information will continue to remain publicly available.

To address the concerns of intellectual property owners and law enforcement agencies that the new restrictions will hinder efforts to stop illegal activity by individual registrants (e.g., cybersquatting, trade-mark infringement or identity theft through phishing websites), CIRA has provided two separate mechanisms for contacting individual registrants in certain limited circumstances.

The first mechanism is a blind message delivery system whereby any member of the public may, through the use of web-based electronic forms at the CIRA web site, submit an electronic message that will be sent to the registrant's email address without revealing the registrant's address to the sender. A disadvantage of this mechanism is that it cannot be known whether the message was ever received, read or acted upon.

The second mechanism involves the submission of a request to CIRA for disclosure of registrant information by a requestor who reasonably believes in good faith that the registrant's domain name and/or its content: (a) infringes the requestor's Canadian registered trade-mark, registered copyright or issued patent; (b) infringes the requestor's Canadian registered (federal or provincial) corporate, business or trade name; or (c) is making use of the requestor's personal information without



their knowledge or consent to commit a crime (such as fraud, theft or forgery), or to procure money, credit, loans, goods or services without authorization. If CIRA considers one of these types of good-faith disputes to exist, individual registrant information will be released to the requestor. It is too early to know the standards that CIRA will apply when making this determination.

It is noteworthy that the content of a website associated with a registered .ca domain name, and not just the domain name itself, may form the basis of a good-faith request for the personal information of an individual domain name holder. Accordingly, it should be possible to obtain individual registrant information for a .ca domain name where an associated website infringes a Canadian trade-mark, copyright or patent.

Peter A. Elyjiw, Toronto

Special relationship precluded anticipatory public disclosure

A written disclosure of the invention by the inventor to a third party, for the purpose of obtaining manufacturing advice, was held not to constitute prior art due to the special relationship between the parties.

A recent Federal Court decision serves as a reminder that not every enabling disclosure of an invention prior to the critical date of a patent application will act as an anticipatory statutory bar to patentability. Even in the absence of a formal confidentiality agreement, a special relationship between the disclosing and receiving parties may prevent the disclosure from constituting a prior art publication or public disclosure.

In *Johnson & Johnson Inc. v. Boston Scientific Ltd.*, 2008 FC 552, the plaintiffs sued for infringement of two Canadian patents relating to balloon-expandable stents for the treatment of coronary heart disease. The relevant claims of patent no. 1,281,505 (the '505 patent) defined an expandable stent formed from a thin-walled

tubular member having a plurality of longitudinal slots and a substantially uniform thickness. The stent was expandable, from a first diameter that permits intraluminal delivery or insertion, to a second, deformed diameter to expand and support the lumen, by applying a radially outward force from the interior of the tubular member. The second diameter was variable and dependent upon the amount of radially outward force applied. Forming such a stent by cutting longitudinal slots in a solid tubular member provided numerous advantages over previous coiled-spring and wire mesh stents, including improved control and adjustability of the final expanded diameter of the stent.

The defendants attacked the validity of the '505 patent on various grounds, including an allegation that a paper by the inventor, referred to as the 1983 Monograph, anticipated the claims at issue. The inventor, Dr. Palmaz, had given the 1983 Monograph to a technician, Werner Schulz, prior to the critical date of the '505 patent application, to seek Mr. Schulz's advice as to how to manufacture a stent as shown and described in the Monograph. The defendants succeeded in showing that the 1983 Monograph disclosed all of the elements of the asserted claims of the '505 patent. However, the defendants failed to establish that the 1983 Monograph constituted a printed "publication" to qualify as citable prior art under the applicable version of the *Patent Act*.

In this regard, the Court first discussed prior jurisprudence holding that a document is considered to have been published if it has become generally available, without restriction, to at least one member of the public. To be categorized as a member of the "public", the person or persons receiving the document must have no special relationship to the author of the publication. The Court noted that the case law did not fully flesh out the meaning of such a special relationship, although a relationship that "smacks of a joint venture" may be one example. The information must have been received with no inhibiting fetter. The party attacking the validity of the patent has the onus of proving publication.

Applying these principles to the facts, the Court noted that the defendants had failed to



provide evidence showing that the 1983 Monograph had been utilized by Mr. Schulz in such a way as to leave the impression that it had been disclosed to him without confidence. The inventor Dr. Palmaz had testified that he had a general recollection that there was a statement of confidentiality in his verbal discussions with any individual recipients of the Monograph, and the defendants had failed to provide contradictory evidence. The Court emphasized that Dr. Palmaz had approached Mr. Schulz to obtain his advice as to how to manufacture the stent and that there was no evidence that Mr. Schulz had viewed himself as free to take Dr. Palmaz's ideas as his own or to use Dr. Palmaz's invention. The Court therefore held that the defendants had failed to establish that the 1983 Monograph constituted a "publication" within the meaning of the applicable version of the *Patent Act*, apparently on the ground that Mr. Schulz was not a member of the "public".

Thus, the main factors that influenced the Court's decision were the inventor's general, non-specific recollection of a verbal statement of confidentiality, the purpose for which the disclosure was made, and the recipient's subsequent treatment of the disclosed information.

The *Johnson & Johnson* judgment was decided under the provisions of the version of Canada's *Patent Act* that was in force immediately prior to October 1, 1989, due to the filing and issue dates of the '505 patent. However, the principles expressed by the Court relating to the meaning of the public apply equally to the novelty provisions in section 28.2 (1)(a) and (b) of the *Patent Act* in force today. These sections focus on whether the subject matter of the claim under attack was disclosed in such a manner that it became "available to the public" before the critical date.

Accordingly, in assessing the effect of any prior disclosure in Canada, the surrounding circumstances of the disclosure should be carefully considered. Even in the absence of a formal confidentiality agreement, numerous factors may weigh in favour of a finding of a special relationship between the parties, which would preclude the disclosure from having been made to the public. Particularly in the case of proposed new applications, whose commercial value often remains to be ascertained, advice from expert Canadian patent counsel should be sought before jumping to any conclusions regarding patentability.

Stephen J. Ferance, Vancouver

Cape Breton distiller loses right to use GLEN for whisky



In a recent decision, the Federal Court attempted to answer the question: when is Scotch whisky not Scotch whisky? The answer, it would seem, is when it is not distilled in Scotland.

The case involved a November 2000 application by Glenora Distillers International Ltd., a distiller on Cape Breton Island, Nova Scotia, to register the trade-mark GLEN BRETON for use in association with its single malt whisky. The Scotch Whisky Association opposed the application, contending that the word GLEN had become recognized as designating whisky from Scotland – that is, Scotch whisky – and therefore the use of GLEN BRETON was likely to mislead.

In support of its opposition, the Scotch Whisky Association filed the following evidence: (1) sales volumes of Scotch whisky in Canada; (2) third party uses of the word GLEN in association with Scotch whisky by way of price lists from liquor stores; and (3) third party

registrations for trade-marks for use in association with whisky having the word GLEN as a prefix. The Scotch Whisky Association also relied on definitions showing the Scottish origin of the word GLEN. In reply, Glenora filed evidence that the trade-mark GLEN BRETON was chosen because of the association with Cape Breton Island, and the glen stream MacLellan's Brook, which was the water source for its whisky.

In rejecting the opposition, the Registrar concluded that based upon the evidence before him, Canadian users and purchasers of whisky had not been educated to associate the word GLEN solely with Scotch whisky.

The Scotch Whisky Association appealed the Registrar's decision to the Federal Court. On April 3, 2008, the Court handed down a decision allowing the appeal and directing the Registrar to refuse Glenora's application to register the trade-mark GLEN BRETON (*Scotch Whisky Association v. Glenora Distillers International Ltd.*, 2008 FC 425).

For the appeal, the Scotch Whisky Association filed additional evidence consisting of more complete sales records broken down by brand, as well as more product listings from liquor stores in different provinces and various bar lists and other indicia that might lead to confusion in the marketplace. The Court was of the view that if the record before it had been before the Registrar, he would have allowed the opposition of the Scotch Whisky Association and refused Glenora's application.

More specifically, the Court found as a fact that before the year 2000, the year when Glenora filed its application, there was no whisky sold in Canada that had the word GLEN as part of its name that was not a Scotch whisky. Scottish Glens had in fact been sold in Canada since at least 1888. In the year 2000, there were about 22 Glen whiskies sold in Canada, all of them being Scotch whiskies. The record also showed that in the year 2000, some 896,607 cases of Scotch whisky were imported into Canada, which translates to more than 10 million 75 cl bottles. The Court found that had the Registrar had this data before him, he would not have come to the conclusion that not many individuals in Canada were familiar with marks for Scotch whisky having the word GLEN as a prefix, or that the Canadian consumer had not been educated to associate the word GLEN with Scotch whisky.

Glenora argued that the use of the word GLEN was not exclusively associated with Scotch whisky in Canada. Glenora relied upon malt whisky produced in the 1980s in British

Columbia under the name Glenogopogo. However, there was no evidence that this product was ever sold in Canada. It also relied on an American distillery called Glenmore that sold Glenmore Kentucky bourbon whisky in the United States and Kentucky Tavern bourbon in Canada, and a series of advertisements in Life magazine for the distillery's bourbon. However, the last recorded sales of Kentucky Tavern bourbon were in 1985. Moreover, the ads in evidence were from the 1939 to 1950 timeframe.

The Court gave no weight to the Glenmore whisky argument. The Court pointed out that the test for confusion is the first impression in the mind of a casual consumer somewhat in a hurry and noted that this casual consumer "is not imprinted with advertisements from old American magazine issues, published before most Canadians were born".

Moreover, the Scotch Whisky Association submitted considerable evidence of actual confusion between GLEN BRETON whisky and the various GLEN Scotch whiskies documented in price lists and drink lists from liquor stores, restaurants and bars, many of which included Glen Breton in the category of single malt Scotch whiskies. The Court found that if the trade (*i.e.*, liquor stores, restaurants and bars) was confused, so was the ultimate consumer.

The Court emphasized that it found in favour of the Scotch Whisky Association not because of the origin of the word GLEN, which the Scotch Association had argued is Scottish in origin, but because of its long use in Canada by distillers of Scotch whisky. As the Court stated, "it is the association in the mind of the consumer, and not the origin of the word, which is relevant". While the Court appreciated that Cape Bretoners are "rightly proud of their heritage and are entitled to evoke it ... it is too late to use the word 'glen'".

Geneviève M. Prévost, Toronto



Canadian Industrial Design Office eliminates certain document recordal fees

The Canadian Industrial Design Office has announced a change in its policy concerning the recordal of documents against industrial design applications and registrations. Previously, the Industrial Design Office had charged a recordal fee for any document recorded. Effective May 12, 2008, the recordal fee only applies to assignments and licences. Other

documents, such as changes of name and security agreements, are no longer subject to a fee. The intent of the change is to encourage the updating of owner information so the searchable Canadian Industrial Design Database contains current information.

Christine N. Genge, Ottawa

Patent Cooperation Treaty (PCT) fees for the Canadian Receiving Office

A number of the fees associated with a PCT application, such as the International Filing Fee, are set in Swiss francs. The Canadian Receiving Office periodically publishes a schedule of PCT fees that takes into account the exchange rate to Canadian dollars. Recently, revised schedules

have been issued more frequently. Fee schedules have now been published with successive effective dates of May 15, 2008, July 1, 2008 and September 15, 2008.

Christine N. Genge, Ottawa

Smart & Biggar/Fetherstonhaugh recognized as Canadian trade-mark firm of the year by *Managing Intellectual Property* magazine

Smart & Biggar/Fetherstonhaugh has been named Trade-mark Prosecution Firm of the Year and Trade-mark Contentious Firm of the Year for 2008 by U.K. publication *Managing Intellectual Property* magazine (MIP). Smart & Biggar/Fetherstonhaugh is the first Canadian law firm to be awarded this honour in two of MIP's five categories recognizing excellence in the field of Canadian intellectual property law.

The awards were presented at MIP's inaugural North America Awards ceremony, held on April 3, 2008 in Washington D.C. MIP has for several years recognized Smart & Biggar/Fetherstonhaugh as a highly ranked IP firm in patents, trade-marks and copyrights.

MIP was founded in 1990 and is now firmly established as the leading international magazine for IP owners. The magazine is published 10 times annually and is distributed globally to more than 8,000 readers. The publication covers developments affecting intellectual property from both a legal and business perspective.

The results of the magazine's inaugural North America Awards were based on extensive

interviews with in-house IP and business leaders conducted in late 2007 and early 2008 in connection with its World IP Survey in the United States and Canada.



Firm achieves top-level rankings in three major surveys

Firm recognized in *Managing Intellectual Property's* "top tier" of Canadian patent and trade-mark firms. The results of *Managing Intellectual Property's* annual World IP Survey of international patent and trade-mark firms have been released, and Smart & Biggar/Fetherstonhaugh has been recognized as a Tier One firm in all four categories relating to intellectual property: trade mark prosecution; trade mark/copyright contentious; patent prosecution; and patent contentious.

Firm repeats top tier ranking in *Chambers Global Guide*. The *Chambers Global Guide*, a research-based survey published by Chambers & Partners, has released its most recent survey of Canadian law firms. Smart & Biggar/Fetherstonhaugh has once again ranked as a top tier firm in the area of intellectual property. Additionally, a number of our partners were singled out for individual recognition as leading practitioners in the areas of intellectual property and intellectual property litigation:

Leading individuals in Intellectual Property:

John Bochnovic
Mark K. Evans
Michael D. Manson
Joy D. Morrow

Leading individuals in Intellectual Property Litigation:

Gunars A. Gaikis
Steven B. Garland
A. David Morrow

Firm Repeats Top Ranking *PLC Which Lawyer? Handbook*. The *PLC Which Lawyer?*

2008-2009 IP in Business Transactions Handbook has been released, outlining the results of PLC's most recent survey of law firms worldwide. Smart & Biggar/Fetherstonhaugh has once again ranked as a leading firm in Canada in the areas of patent litigation and non-patent litigation. Additionally, a number of our practitioners were singled out for individual recognition within both areas:

Individuals listed in Non-patent Litigation:

John Bochnovic
Mark K. Evans
Brian P. Isaac

Individuals listed in Patent Litigation:

Gunars A. Gaikis
A. David Morrow
François Guay
John Bochnovic
John R. Morrissey

Notes

Announcements

Jacqueline Chernys has joined our Ottawa office as an associate. Ms. Chernys holds a B.Sc. in biology and an Hons. Dipl. in plant sciences from the University of Ottawa, a Ph.D. in genetics from Michigan State University and an LL.B. from the University of Alberta.

Andrew Mandlsohn has joined our Toronto office as an associate. Mr. Mandlsohn holds a B.Sc. in pharmacy from the Massachusetts College of Pharmacy and a J.D. from Suffolk University Law School.

Jeffrey D. Morton has joined our Vancouver office as an associate. Mr. Morton holds a B.Sc. in biology from the University of Victoria, a Ph.D. in immunology from Washington University in St. Louis, and an LL.B. from the University of British Columbia.

Jasminder S. Brar has joined our Vancouver office as an associate. Mr. Brar holds a B.Sc. in computer engineering and an LL.B. from the University of Manitoba.

Seminars and Presentations

Peter A. Elyjiw spoke on the topic of Patents for Engineers at the Gleason College of Engineering of the Rochester Institute of Technology on April 14, 2008.

Alistair G. Simpson gave a presentation on the topic of Business Method Patents – Implications for Canadian IT Deals at the 8th Annual IT Law Spring Training Program, held in Toronto on May 1 and 2, 2008.

Nancy P. Pei spoke on the topic of Selecting the Right Expert at the Canadian Bar Association's program on Advocacy Before the

Federal Court in Intellectual Property Matters – Expert Witnesses, held in Ottawa on May 8, 2008. **François Guay** also participated in this event by acting as the Cross-Examining Counsel in a Demonstration of Examination of Expert Witness.

Steven B. Garland presented on the topic of Intellectual Property Advisor-Client Privileged Communications: Canada and Other Jurisdictions at the WIPO/AIPPI Conference on Client Privilege in Intellectual Property Professional Advice, held in Geneva, Switzerland on May 22 and 23, 2008.

Brian P. Isaac spoke on the topic of An Introduction to Intellectual Property and IP Crime at the Canadian Anti-Counterfeiting Network's 2008 Canadian Reality Tour meetings, held in Regina on May 7, 2008 and Toronto on June 3, 2008. Mr. Isaac spoke on the same topic at Henry Braun Public School in Regina, SK on May 7, 2008 and at St. Jean de Brebeuf High School in Vaughan on June 3, 2008.

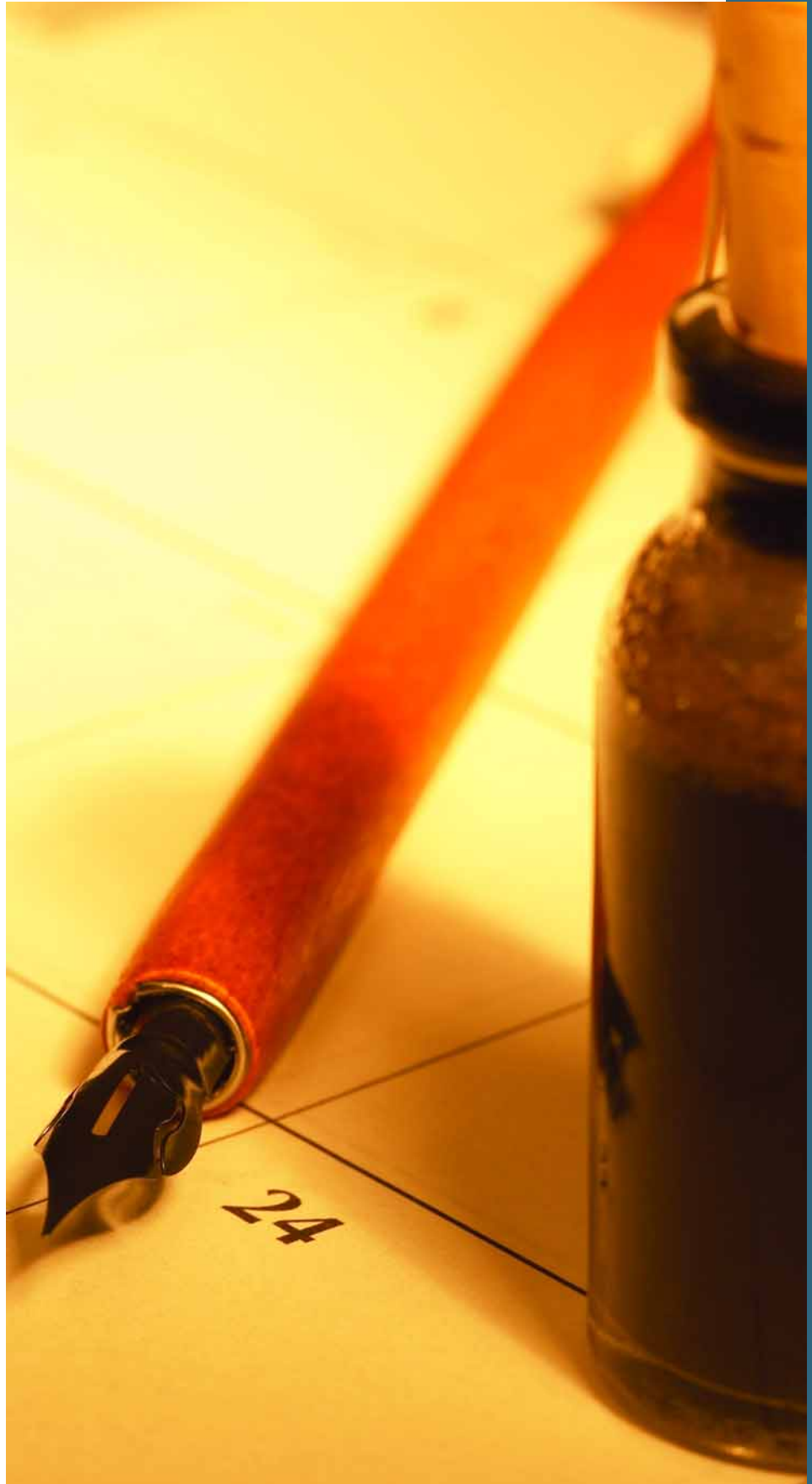
John W. Knox presented on the topic of Declarations of Entitlement in Canada at The International Federation of Intellectual Property Attorneys ABC meeting, held in Charleston, South Carolina on June 6, 2008.

Ronald D. Faggetter was a presenter at The Intellectual Property Institute of Canada's Advanced Patent Claim Drafting Session for IT Practitioners, held in Ottawa on June 10, 2008. Mr. Faggetter also facilitated an Advanced Patent Claim Drafting session at the same event.

Michael D. Manson spoke on the topic of Managing IP Crime Prosecutions at the 2008 International Law Enforcement IP Crime Conference, held in Halifax, NS on June 24-26, 2008.

Philip D. Lapin will be presenting a paper and speaking on the topic of Opposition Proceedings: Overview, Context and Strategy as well as leading a workshop entitled Tips and Strategies in Opposition Proceedings at the Understanding Trade-marks Course at McGill University in Montreal, to be held on August 7, 2008.

Mark K. Evans will be speaking on the topic of Copyright Remedies at the Intellectual Property Institute of Canada and McGill University Business of Copyright course, to be held in Montreal on August 13, 2008.



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