

Jean-Sébastien Dupont

Partner

Montreal

Barrister and Solicitor,
Patent and Trademark Agent



CONTACT

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YEAR OF CALL

Quebec Bar 2010

QUALIFICATIONS

- Université de Montréal LL.B. (Dean's List) 2009
- University of Cambridge LL.M. 2012; thesis titled *Uncharted territories of trademark use*
- Registered Trademark Agent 2012
- Registered Patent Agent 2016

PRACTICE AREAS

Litigation
Trademarks
Patents
Copyright & Media
Software/Information
Technologies
Domain Names & Internet Law

LANGUAGES SPOKEN

English
French

PROFILE

A business-minded approach to intellectual property litigation

An accomplished IP litigator, Jean-Sébastien is committed to providing legal solutions and achieving results that fit with his clients' short- and long-term business plans. Clients rely on him to present potential options and to provide decisive guidance on the best course of action. Earning trust is key to Jean-Sébastien's effectiveness, enabling him to act on behalf of his clients in a timely and strategic manner.

Never one to compromise on quality, he is diligent in preparing and advocating for clients in court, while anticipating issues and challenges that may arise from the opposing side. Focusing on intellectual property litigation in the areas of trademarks, patents and copyright, Jean-Sébastien is involved in all aspects of litigation from preparing and initiating new court proceedings to bringing complex cases to trial.

Diverse trial and appellate expertise for a broad range of clients

His practice includes finding and working with technical and financial experts; preparing and arguing various motions; as well as preparing and presenting evidence, witnesses and submissions at trial before the Federal Court and Quebec Superior Court. Jean-Sébastien also has significant experience in the conduct of appeals before the Federal Court of Appeal.

His client activities involve small to large Canadian and foreign corporations in different fields such as dental prosthetics (Nobel Biocare), tobacco (Imperial Tobacco Canada), hockey equipment and apparel (Bauer Hockey), transport (Camso) and steel (Lainco).

Jean-Sébastien's technical background is in computer science. He completed a three-year CEGEP program as first in his class and subsequently worked as a quality assurance analyst in a software engineering firm before pursuing legal studies. In 2008, Jean-Sébastien completed introductory courses in Chinese law at the China University of Political Science and Law in Beijing.

He received numerous awards and accolades from the Université de Montréal during the course of his legal studies. In his final year of law school, Jean-Sébastien acted as a research assistant to a Justice of the Quebec Court of Appeal.

He was awarded a First-Class grade from the University of Cambridge for his Master of Law thesis, which focused on the notion of trademark use and addressed the issue of invisible use of trademarks in meta tags and keyword advertising, as well as the subliminal use of trademarks in new marketing techniques.

Rankings and recognition

- Recognized in the 2019 edition of *The Best Lawyers in Canada* under Intellectual Property Law

EXPERIENCE

Bessette c Québec (Attorney General of Québec), [2019 CF 393](#) — With François Guay and Camille Lachance-Gaboury, successfully represented Dr. Luc Bessette in this milestone patent infringement case brought against the Québec government in relation to the Québec Health Record, a system providing health professionals in Québec with access to essential patient medical information, such as pharmacological profiles, laboratory test results and medical imaging results. The Court found that most of the claims of the two asserted patents were valid and were infringed both directly by the defendants and for inducing infringement by health professionals.

Canadian National Railway Company v BNSF Railway Company, [2019 FC 142](#) — Successfully represented CN in defending a motion brought by the defendant seeking a stay of the continued prosecution and issuance of certain of CN's patent applications before the Canadian Patent Office pending the determination by the Federal Court of the validity of related previously-issued patents. The motion was dismissed by the Associate Chief Justice and costs awarded to CN.

Bauer Hockey Ltd v Sport Maska Inc. dba CCM Hockey, 2018 FC 832 affirming 2017 FC 1174 — With François Guay, successfully represented Bauer Hockey Ltd. in defending a

motion brought by the Defendant CCM Hockey in three related IP infringement actions to have all 3 actions dismissed for an alleged failure to comply with the procedural requirement of Rule 117 following the assignment of the actions to a new corporate entity.

MIPS AB v Bauer Hockey Ltd, [2018 FC 485](#) — With François Guay and Jeremy Want, represented the defendants, Bauer Hockey Ltd. and Bauer Hockey, LLC, who were largely successful in this patent infringement and impeachment action brought by Sweden-based MIPS AB. The Federal Court found that Bauer Hockey independently developed its SUSPEND-TECH rotational impact protection technology for hockey helmets and that Bauer Hockey's RE-AKT helmets do not infringe upon MIPS' Canadian patent. The Court also confirmed the validity of Bauer Hockey's four (4) Canadian patents on its technology, except for one independent claim. The Smart & Biggar team received the **National Impact Case of the Year** from Benchmark Litigation Canada for their representation of Bauer Hockey in this case.

LeddarTech Inc v Phantom Intelligence Inc, [2017 CAF 224](#) — Successfully represented LeddarTech Inc in having the Federal Court of Appeal overturn the decisions of the Federal Court judge and of the Prothonotary that had erroneously struck so-called "open-ended" allegations of patent infringement from LeddarTech's Statement of Claim.

Lainco Inc v Commission Scolaire Des Bois-Francis et al, [2017 CF 825](#) — With François Guay, successfully represented the plaintiff at trial in this case in which the Federal Court confirmed that the plaintiff's steel structure for an indoor soccer complex could benefit from copyright protection as an "architectural work" under the *Copyright Act*. The plaintiff's copyright were found to be infringed by the defendants — a school board, engineering firm, architecture firm and general contractor — who together had designed and built a nearly identical structure. This was the first time in nearly 50 years that copyright protection was recognized by Canadian courts in a building structure. All defendants were held to be jointly and severally liable for the plaintiff's damage, which were assessed at over \$700,000 (plus interests and costs).

Wesley (Mtlfreetv.com) v Bell Canada, [2017 FCA 55](#) — With François Guay and Guillaume Lavoie Ste-Marie, successfully represented Canadian broadcasters and broadcast distribution undertakings in having the Federal Court of Appeal uphold an interlocutory injunction issued by the Federal Court and directed at retailers of television set-top boxes that are configured, or "pre-loaded", with various applications that provide their users with unauthorized access to copyrighted television content.

Camsco Inc v Soucy International Inc, [2016 FC 1116](#) — Successfully represented Camsco Inc. in having the Federal Court stay re-examination proceedings initiated before the Patent Office on behalf of one of the defendants to this action *after* infringement (and invalidity) of this particular patent were alleged in the Court proceedings. The Court also awarded costs to Camsco Inc. on a lump-sum basis, payable forthwith.

Emerson Electric Co v Canadian Tire Corporation Limited, [2016 FC 308](#) — Successfully represented Emerson Electric Co. and Emerson Electric Canada Limited (Emerson) in defending a motion brought by Canadian Tire to strike out Emerson's open-ended allegations of patent infringement. The motion was dismissed by the Federal Court and costs awarded to Emerson.

Bauer Hockey Corp v Easton Sports Canada Inc, 2014 FC 594 confirmed on appeal to the Federal Court ([2014 FC 853](#)) and Federal Court of Appeal ([2016 FCA 44](#)) — With François Guay and Ekaterina Tsimberis, successfully represented Bauer Hockey Corp. in having the Federal Court and Federal Court of Appeal dismiss a motion brought by Bauer's competitor, Reebok-CCM, to intervene in this appeal initiated by Bauer from a decision of the Registrar of Trademarks following the issuance of a Section 45 Trademarks Act notice at the request of another of Bauer's competitors, Easton Sports.

Philip Morris Products SA v Marlboro Canada Limited, 2015 FC 364 confirmed on appeal [2016 FCA 55](#) — With François Guay, successfully represented the plaintiffs by counterclaim Imperial Tobacco Canada Limited and Marlboro Canada Limited in this precedent-setting decision whereby the Court confirmed that Imperial Tobacco and Marlboro Canada are entitled to elect an accounting of the defendants' (Philip Morris and Rothmans, Benson & Hedges) profits resulting from the infringement of their rights in the MARLBORO trademark in Canada.

Philip Morris Products SA v Marlboro Canada Limited, 2014 FC 2 confirmed on appeal [2015 FCA 9](#) — With François Guay, successfully represented the plaintiffs by counterclaim Imperial Tobacco Canada Limited and Marlboro Canada Limited in recovering an important portion of the legal costs and disbursements incurred for the trial of this trademark infringement action for a total award exceeding 1 million dollars.

Bauer Hockey Corp v Sport Maska Inc, [2014 FCA 158](#) — With François Guay, successfully represented Bauer Hockey Corp. in having the Federal Court of Appeal overturn an interlocutory decision of the Federal Court which had refused that Bauer Hockey amend its Statement of Claim in this trademark infringement and passing off action to claim punitive damages.

Magasins Best Buy Itée c Québec (Procureur général), [2014 OCCC 142](#) confirmed on appeal [2015 OCCA 747](#) — With François Guay and Christian Bolduc, successfully represented the International Trademark Association (INTA) as an intervener in this proceeding. The Court confirmed, in line with the plaintiffs' and INTA's arguments, that businesses can continue using their registered trademarks on public signs outside their

premises in the Province of Québec without the need to add French generic language. My colleagues and I recently received the **2015 Canadian Trademark Milestone Case of the Year** award from *Managing Intellectual Property* (U.K.) for our success in this case.

Phostech Lithium Inc v Valence Technology Inc, [2011 FCA 107](#) — With François Guay and Jeremy Want, successfully represented Phostech Lithium Inc. in having the Federal Court of Appeal stay execution of a Federal Court judgment in a patent infringement case until issuance of the decision on appeal.

UGroupMedia Inc v Bell Canada Inc, Quebec Superior Court 500-17-062683-100 — With Daniel Drapeau, successfully represented Bell Canada in opposing motions for an interim injunction and safeguard measures seeking to prevent Bell from offering its free Magic Santa interactive Christmas cards for kids based on copyright infringement allegations.

PROFESSIONAL INVOLVEMENT

Memberships

- Associate, Intellectual Property Institute of Canada
- Member, Canadian Bar Association
- Member, *Association du jeune Barreau de Montréal*

Speaking engagements

- "Contrefaçon de marques de commerce et recouvrement de dommages-intérêts ou de profits : à qui le choix?", Regroupement des Praticiens du droit des Marques de commerce (RPM), Montreal, March 25, 2015
- "Internet : les marques de commerce sans frontières," Développements récents de propriété intellectuelle, Barreau du Québec, Montreal, November 14, 2014

Teaching activities

- Guest lecturer at the *Université de Montréal* for the Torts graduate course (DRT-6567) re: passing-off, November 2014; October 2015 and November 2016

MEDIA

Publications

- "[Top five reasons to consider patent litigation in Canada](#)" (co-author: Steven Garland), *International Law Office*, June 25, 2018
- "[Federal Court of Appeal upholds interlocutory injunction directed at retailers of set-top boxes loaded with copyright-infringing applications](#)," *IP Update — Canada*, March 21, 2017; *Mondaq*, March 21, 2017; *Lexology*, March 21, 2017; *JD Supra*, March 22, 2017; *International Law Office Intellectual Property Newsletter* - April 03, 2017
- "[Precedent-setting Marlboro decision provides guidance on entitlement to claim profits in trademark infringement cases](#)," *IP Update — Canada*, March 24, 2015; *Lexology*, March 24, 2015; *Mondaq*, March 25, 2015; *CCCA Members Knowledge Centre*, March 2015; quoted in the *Financial Post*, March 25, 2015; *World Trademark Review Daily*, March 31, 2015; *International Law Office Intellectual Property Newsletter*, May 5, 2015
- "[Do you actually own the IP generated by your Canadian employees?](#)" (co-author: Guillaume Lavoie Ste-Marie), June 16, 2014; *Lexology*, June 16, 2014; *Mondaq*, June 18, 2014; *CCCA Members Knowledge Centre*, June 2014; *International Law Office Intellectual Property Newsletter*, July 7, 2014; *Commerical Times*, July 2014, No. 564, pp. 1-3
- "[Québec appeals the French Charter decision on public display of trademarks](#)," *IP Update — Canada*, May 13, 2014; *Lexology*, May 13, 2014; *Mondaq*, May 14, 2014; *World Trademark Review Daily*, May 20, 2014; *CCCA Members Knowledge Centre*, May 2014; *International Law Office Intellectual Property Newsletter*, June 2, 2014
- "[Retailers and the International Trademark Association prevail in Québec's French Charter proceeding](#)," *IP Update — Canada*, April 10, 2014; *Lexology*, April 10, 2014; *Mondaq*, April 12, 2014; *INTA Bulletin*, May 1, 2014, Vol. 69, No. 9, pp. 1, 3; *International Law Office Intellectual Property Newsletter*, May 5, 2014
- "[Product placement as evidence of a trademark's fame](#)," *IP Update — Canada*, November 19, 2013; *Lexology*, November 19, 2013; *Mondaq*, November 19, 2013; *CCCA Members Knowledge Centre*, November 2013; *International Law Office Intellectual Property Newsletter*, December 16, 2013
- "[The International Trademark Association is granted leave to intervene in Quebec proceedings pertaining to the interpretation of Quebec's French Charter](#)" (co-author: Philip Lapin), *IP Update — Canada*, October 3, 2013; *Lexology*, October 3, 2013; *Mondaq*, October 5, 2013; *International Law Office Intellectual Property Newsletter*,

October 21, 2013

- "Uncharted territories of trade mark use", I.P.Q. 2013, 2, 139-165
- "Surveys: a useful tool to gauge consumers' perception" (co-author: Ekaterina K. Tsimberis), *IP Connections*, September/October 2011
- "Republic of Cyprus (Commerce and Industry) v. International Cheese Council of Canada" (co-author: Daniel S. Drapeau), *Canadian ReMARKS*, July/August 2011
- "Chaussures Régence Inc. v. Naturmania Inc." Case Brief in *Canadian ReMARKS*, May/June 2011
- "Ontario Teachers' Pension Plan Board v. Canada (A.G.)" Case Brief in *Canadian ReMARKS*, March/April 2011