Hot-Button Topics in Intellectual Property Law

Wednesday, June 6, 2012
Seminar Agenda

Hot-Button Topics in Intellectual Property Law

Wednesday, June 6, 2012

AGENDA

8 – 8:45 a.m.     Registration and Breakfast

8:45 – 8:50 a.m.  Welcome and Opening Remarks

8:50 – 10:20 a.m. PRESENTATIONS

10:20 – 10:25 a.m. Q&A

10:25 – 10:40 a.m. Coffee Break

10:40 – 11:50 a.m. PRESENTATIONS

11:50 – 12:05 p.m. Q&A

12:05 – 1:30 p.m.  Lunch and Networking
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Hot-Button Topics in Intellectual Property Law
Wednesday, June 6, 2012

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   Alan Aucoin

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Business Class: Hot-Button Topics in Intellectual Property Law

June 6, 2012

Welcome: John Orange
Access to Information: What You Need to Know About What You Want to Know

Alice Tseng

Merck v. Canada (Health)

Merck ("Third Party")

Merck applies for drug approval for SINGULAIR

Requester (could be competitor, media, plaintiff’s lawyer)

Made access to information request

Health Canada ("Government Institution")

• Merck’s drug submission
• HC reviewer’s report
• Correspondence between HC and Merck

Procedural Issue

Merck’s Arguments

1. Health Canada should have notified Merck before disclosing records

2. Health Canada cannot shift entire review of records onto Merck

SCC Decision

1. Low threshold for notice requirement

2. Government institution must make initial determination of what is exempt from disclosure
### Substantive Issue

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<th>Merck’s Argument</th>
<th>SCC Decision</th>
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| 1. Records should be exempt from disclosure pursuant to Sections 20(1)(a), (b) and (c) of the Access to Information Act | \n| a. Section 20(1)(a) trade secret exemption – four-part test | \n| b. Section 20(1)(b) confidential information exemption – government institution must consider content, not form, in determining whether information was “supplied by the third party” | \n| c. Section 20(1)(c) harm-based exemption – “reasonable expectation of probable harm” is the correct test | \n
### Implications of Case

- Shift in responsibility for initial review
- Timing – delay
- Can be more aggressive in redacting information
Exploring the Amazon: Business Method Patents and Beyond

Brett Slaney

Misfits or Misunderstood?

- Patent eligibility spectrum:

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- Business methods may require underlying technology or interact with physical world, or may not: no clear slot in spectrum
- Not always publicly embraced

Amazon: An Update

- Commissioner appeals – Federal Court of Appeal provides some guidance but returns application to examiner
- Examiner allows application and patent issues
- Result: business methods still in play, subject matter eligibility should be determined based on a purposive construction of Invention as claimed
- Has CIPO listened?: NOT YET
- Result: Proposed practice notices on inventive concept and patentable subject matter

Business Class
How Does Canada Compare?

- Canadian Patent Act relies on definition of invention instead of subject matter exclusions
- The courts have made it clear that the claims as purposively construed define the subject matter
- CIPO insists on trying to impose restrictions not supported by the Act or the courts: e.g., based on the “inventive concept”
- Restrictions could impact other types of inventions (current and future)
- Restrictions could also impact Canadian economy

Protecting Business Methods

- Business method patents should still be considered a viable option in Canada
- Existing applications are still in play
- Consider whether or not the business method overlaps the physical or virtual portions of the “patentable spectrum”
- For example: determine if software or electronic communications are used

Summary

- The courts have confirmed that business methods are patentable
- For now, actually obtaining patent protection in Canada may be easier said than done
- Accept that business methods have yet to find a clear slot in the patentable spectrum so be creative
- Prepare for a challenge!
Everything Old is New Again: The Impact on Drug Regulation When Old Drugs Find New Life

Leah Rodin

History of Thalidomide

- 1957: Launch of Thalidomide
- 1960: Approved in Canada
- 1961: Linked to Birth Defects
- 1962: Withdrawn From Sale in Canada

Notice of Compliance (NOC) Regulations

- Safety and Efficacy
- Innovator – New Drug Submission (NDS)
- Generic – Abbreviated New Drug Submission (ANDS)
- Patent List
Resurgence of Thalidomide

1964
Research for use in Treatment of Leprosy, Cancer etc.

1992
Celgene in-licenses thalidomide

1995
Thalidomide available through SAP

2009
Celgene files NDS for THALOMID®

2010
NOC issued for THALOMID®

Patented Medicines Price Review Board (PMPRB)

- PMPRB established to prevent excessive prices for drugs under patent protection
- 2011 Supreme Court finds sale of Thalidomide under the Special Access Program (SAP) falls under control of PMPRB

Data Protection

- Data protection provided for proprietary information submitted in NDS for “innovative drugs”
- 6 years before generic can file an NOC, plus min. 2 years for approval; 6 months pediatric extension
- 2012 Federal Court found Thalidomide is an “innovative drug” and qualifies for data protection
Mayo vs. Prometheus: A Tragedy Unfolds in Biotech Patents

Santosh Chari

Background

- Prometheus Laboratories: licensee of patent directed to method of "optimizing therapeutic efficacy" for treating autoimmune disorders (such as Crohn's disease); sold test kits covering the method
- Claimed method:
  a. Administer drug (6-MP) that provides a metabolite (6-TG) to a patient
  b. And determine the level of 6-TG in patient
  c. Wherein the level of 6-TG indicates a need to increase or decrease amount of drug administered
- Helps physicians determine effective and non-toxic dosage
- Mayo Laboratories: previously purchased Prometheus’ test but later announced intention of using its own test and selling it to other hospitals

The Battle Begins

- Round 1:
  - Patent claims found to be infringed but invalid for being directed to non-patentable subject matter: the correlations between metabolite level and efficacy/toxicity were "natural phenomena"
  - "Inventors did not invent the claimed correlation … inventors merely observed the relationship"
- Round 2:
  - On appeal, the court relied on “machine or transformation” (MTM) test; decision reversed on basis that administration of drug causes transformation of a patient’s body
The Battle (Cont’d)

- Round 3:
  - Mayo appeals to Supreme Court
  - *Bilski*: MTM not only test; can’t patent law of nature abstract idea or formula but may be able to patent its application to a known structure or process
- Round 4:
  - FedCir reviewed claims using *Bilski* guidelines
  - Patent claims again upheld: “[method] steps involve a particular application of … natural correlations: the treatment of a specific disease by administering specific drugs and measuring specific metabolites”

The Battle Reaches Its Apex

- Round 5 (March 2012):
  - Mayo appeals again to Supreme Court
  - Unanimous USSC finds claims invalid: correlation between metabolite level and drug efficacy was a “natural law” and therefore not patentable
  - “The claims inform an audience about certain laws of nature,” “appending conventional steps … to laws of nature … cannot make those laws … patentable”
  - “There is a danger that … patents that tie up [use of natural laws and principles] will inhibit future innovation”

Ramifications?

- USSC has introduced a public policy aspect to determining patentable subject matter: inhibition of future innovation
- *Myriad* case: USSC vacated and remanded FedCir’s decision
- Effect on “personalized medicine”?
- Prometheus already being cited by courts
Intrusion on Seclusion: A New Reason to Mind Your Own Business

Jennifer Smith

The Scenario

Lucy + Dave-the-Dad

Dave-the-Dad + Curious Georgia

Jones v. Tsige – Elements of the New Tort

1. The defendant’s conduct must be intentional or reckless.
2. The defendant must have invaded the plaintiff’s private affairs or concerns without lawful justification.
3. A reasonable person would regard the invasion as highly offensive, causing distress, humiliation or anguish.
What Is ‘Highly Offensive’?

- Only financial or health records, sexual practices and orientation, employment, diary or private correspondence will qualify
- Intended for “deliberate and significant invasions of personal privacy”
- Damages capped at $20,000

New Risks for Employers

- Claims based on the improper collection, use or disclosure of employee personal information
  - may increase damage awards in wrongful dismissal claims
- Risk that employers could be held vicariously liable for the actions of their employees

Steps to Limit Liability

- Create and update workplace privacy policies and procedures
- Limit collection to what is reasonably necessary
- Obtain consent before disclosing employment-related information to third parties
- Implement appropriate safeguards
- Investigate suspected or reported privacy breaches
- Take appropriate disciplinary action
Social Media: (P)interesting Things to Share

Athar K. Malik

Here Today; Gone Tomorrow

- MYSPACE: until early 2008 was the most visited social networking site in the world
  - overtaken by something called Facebook...
- PINTEREST, a social sharing website launched only in March 2010
  - as of January 2012, over 10 million unique visitors; only site to reach that milestone so quickly
  - currently valued at around $1.5 billion
  - one of the top 20 most visited sites in Canada—ahead of many news websites, banks, NHL.com and TSN.ca!

Everyone “Likes” Contests

- A contest on social media is still a contest
  - still subject to the rules and regulations applicable to a contest
- But, in addition, a social media website is a service provided by someone
  - social media websites have TOS that may impact if/when/how a contest is run
  - sometimes they will have TOS specifically for contests, e.g., Facebook’s Promotions Guidelines, Twitter’s Guidelines for Contests, etc.
I Am the Gatekeeper!

• Who is the keeper of the username/password?
  – is it just one person?
• What happens if the keeper leaves?
  – practical answer is that you must keep/safeguard records of login details, like any other important proprietary information → it is like a safe combination
• Specific terms in employment agreements dealing with such credentials may be helpful

If a Tweet Falls in a Forest…

• Who in your organization “vets” what gets posted?
• Do multiple people have the ability to post?
• A social media post is still a public post
  – should be treated no differently than a press release or public advertisement
  – subject to rules relating to public disclosure by companies
  – disclosure of confidential or proprietary information can occur over social media, like any other medium

Pyrrhic Victories and Rewarding Losses

• Social media can change the IP protection paradigm:
  – Not a determinative factor but a necessary consideration in the world of social media
  – Cautionary tales:
    • Scrabulous
    • Lassonde v. L’Oasis d’Olivia

Public Fallout?
The Naked Pun: Parody and Satire Under the Copyright Act

Anil Bhole

Fair Dealing

- “Fair Dealing” is a user right enabling copying without permission or payment
- Copyright Act permits fair dealing for:
  - research or private study (section 29)
  - criticism or review, with attribution (section 29.1)
  - news reporting, with attribution (section 29.2)
- In CCH v. LSUC, SCC set out factors to assess fair dealing
- Commercial uses may qualify as fair

Parody Currently

- Michelin v. C.A.W. Canada (1997 FCTD)
  - union’s pamphlet had Michelin Man crushing worker
  - court held parody is not a form of criticism and not a defence to copyright infringement
- Canwest v. Horizon (2008 BCSC)
  - defendant published fake Vancouver Sun
  - court cited Michelin decision

Parody is not a defence to copyright infringement
Bill C-11: Copyright Modernization Act

- Section 29. Fair dealing for the purpose of research, private study, education, parody or satire does not infringe copyright
- No attribution requirement
- Bill does not address CCH factors

Parody vs. Satire

- U.S. cases indicate that parody and satire may be held to different fairness standard
  - parody comments on original work: requires copying
  - satire comments on external concept: other means
- CCH factors may accommodate the distinction in Canada

Advertising Using Parody

- Parody/satire permitted if the dealing is fair
- Commercial uses may be fair
- Opens doors to use pop-culture content in Canadian ad campaigns
- BUT... must still consider authors’ moral rights, trademark issues, defamation
Comparative Advertising: The Best Presentation of This Seminar

Anthony Prenol

Background

- Untrue or misleading comparative advertising actionable
- Copyright issues
- But what about accurate comparative advertising?
- Permissible in other common law jurisdictions

Canada

- Section 22 of Trade-marks Act: no person shall use a trade-mark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto
- Threshold question of “use” of a trade-mark
- “Use” defined in Trade-marks Act
- For wares: displayed on wares or their packaging, or otherwise drawn to customer’s attention at time of transfer of property in or possession of wares (e.g., displayed on point of sale materials)
- For services: used or displayed in performance or advertising of services
Traditional Approach

- Comparative advertising of wares: permissible unless display competitor’s mark on your wares
- Comparative advertising of services: advertising depreciates goodwill of competitor’s mark because convinces customers to buy from you instead of competitor (violation of Section 22)
- Some variations on theme; for example, Future Shop v. A & B Sound

Veuve Clicquot

- Section 22 reserved for cases where “threat of interference is substantial”
- Four-part test for section 22 violation:
  1. use: defendant has ‘used’ registered mark
  2. reputation: plaintiff’s mark sufficiently well known to have significant goodwill
  3. linkage: plaintiff’s mark used in way that likely to have an effect on that goodwill
  4. depreciation: likely effect must be to depreciate goodwill

The Future for Comparative Advertising?

- Application of the Veuve criteria
- Has there been a trade-mark “use”?
- Has there been depreciation?
- Will a fair and accurate comparative advertisement:
  - be protected by freedom of expression right under Charter?
  - meet threshold test in Veuve of creating a substantial threat of interference?
How Savvy Are You?
The Supreme Court Weighs in on Misleading Advertising
Laura Weinrib

Direct-Mail Advertisement

If you have and return the Grand Prize winning entry in time and correctly answer a skill testing question, we will officially announce that

OUR SWEEPSTAKES RESULTS ARE NOW FINAL:
MR. JEAN-MARC RICHARD HAS WON A CASH PRIZE OF $833,337.00!

Richard v. Time Inc.

- February 28, 2012, Supreme Court of Canada decision
- Primary issue: Did Time violate the Quebec Consumer Protection Act (CPA) in their sweepstakes results letter mailed to potential consumers?
- Provides guidance on interpretation of “general impression test” and “average consumer” that may be applied more broadly, including to the Competition Act
- SCC endorses “seller beware” rather than “buyer beware”
Quebec CPA vs. Competition Act

- S. 218 of Quebec CPA:
  - "To determine whether or not a representation constitutes a prohibited practice, the general impression it gives, and, as the case may be, the literal meaning of the terms used therein must be taken into account."

- S. 52.1(5)/74.01(5) of Competition Act:
  - "The general impression conveyed by a representation as well as its literal meaning shall be taken into account in determining whether or not the person who made the representation engaged in the problematic conduct."

General Impression Test

- General impression must be analyzed from the perspective of the "average consumer" without considering the personal attributes of any one consumer
- Entire ad must be taken into account rather than portions of its contents
- The test is that of "first impression"
  - it is not the impression formed as a result of a rushed or partial reading of an advertisement
  - it does not involve the minute dissection of the entire text
- General impression is the one a person has after initial contact with the entire ad and relates to both the layout of the ad and the meaning of the words used

Average Consumer

- Must consider the general impression test from a perspective similar to that of an "ordinary hurried purchaser"
- Average consumer is **not**:
  - "a reasonably prudent, diligent or well-informed person"
  - of "an average level of intelligence, scepticism and curiosity"
- Average consumer is "credulous and inexperienced"
Cloud Computing: Tips for Avoiding Bad Weather

Christine Ing

Cloud Models

- Software as a Service (SaaS)
- Platform as a Service (PaaS)
- Infrastructure as a Service (IaaS)
- Private vs. Public Clouds

Risks and Mitigation

- Risk of Non-Performance
- Data Management and Control Risk
Goal: Risk Management

Cloud Computing Policy – Elements

- Objectives of customer organization in moving to cloud
- "Cloud" team to evaluate cloud initiatives, act as gatekeepers
- Requirement for business case (why cloud and not internal? suitability for cloud? impact on organization’s insurance – insurance coverage?)
- Requirement for due diligence and audit of provider
- Technical requirements of customer organization that must be satisfied (e.g., application portability, data portability)
- When inappropriate to place applications or infrastructure in cloud (e.g., significant customization)
- When inappropriate to place data of certain types in cloud (e.g., personal info in public cloud)

Due Diligence

- Provider viability
- Service availability
- Service continuity
- Privacy and security
- Data accessibility/return
- Transition out
You're Not Just a Customer; You're the Product: Online Tracking and Behavioural Advertising

Dara Lambie

What Is Behavioural Advertising?

- Tracking an individual’s online activities over time
  - web pages visited; length of time on each page; links clicked on; purchases made
  - geo-location data (IP address; mobile devices)
- Delivering advertising targeted to the individual’s perceived interests based on tracking

Benefits and Concerns for Consumers

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<th>Privacy Concerns</th>
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<td>More relevant content; reduces unwanted advertising</td>
<td>Consumers unaware of data collection</td>
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<tr>
<td>Free user content; advertising generates revenue</td>
<td>Lack of disclosure about collection, use and disclosure of personal information</td>
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<td>Lack of consent</td>
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Privacy Concerns

- Security
- More relevant content; reduces unwanted advertising
- Free user content; advertising generates revenue
- Consumers unaware of data collection
- Lack of disclosure about collection, use and disclosure of personal information
- Lack of consent
- Security
Privacy Commissioner Behavioural Advertising Guidelines

“[I]nformation involved in online tracking and targeting for the purpose of serving behaviourally targeted advertising to individuals will generally constitute personal information.”

- An individual’s knowledge and consent is required for the collection and use of online information
- Opt-out consent is acceptable provided individuals are:
  - made aware of collection of online activity before or at the time of collection
  - informed about various parties involved
  - able to easily opt-out and opt-out is persistent and does not render the service unusable

How to Comply

- Understand what is happening on your website
  - do you collect online data of users of your website?
  - how do you use the information collected?
  - who serves the ads to your website?
  - what technologies are used?
- Consider privacy implications on the front end

How to Comply (Cont’d)

- Provide clear and complete disclosure to users regarding online tracking and behavioral advertising
  - do not bury in privacy policy; prominent location on website
- Provide users with an easy way to opt-out
  - do not use technologies that circumvent users’ attempts to disable tracking technologies
  - observe “Do Not Track” browser settings
  - ensure third parties serving ads on your website comply
America Invents Act:
Get to the Front of the Line

Wilfred So

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America Invents Act

- Signed into law by President Obama on September 16, 2011
- New changes affect:
  - patent prosecution
  - patent litigation
  - administrative proceedings
- Changes take effect at different dates

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On Your Mark! Get Set! File!

- First inventor to file
- New law is based on filing date
- Previous law is based on date of invention
Soft Litigation Gives Hard Results

- Third party’s offensive options:
  - submit prior art with comments against application
  - request post-grant review of patent
  - request inter-parties review of patent
- Patent owner’s defensive option:
  - Request supplemental examination of patent

Getting Down to Business

- Tax strategies are not patentable
- Technologies for preparing taxes and financial management are not considered tax strategies
- Alleged infringer of a business method patent can request post-grant review

Is This Patented?

- False-marking law suits are limited to entities that have suffered competitive injury
- Virtual marking: e.g., “Patent www.coffeelidsRus.com”
**Mi Casa Su Casa: Terms of Use for Your Online Home**

Gary Daniel

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**Century 21 v. Rogers**

- Zoocasa’s robot accessed Century 21 website daily; first uses full descriptions then switches to truncated descriptions
- Oct. 2008, Century 21 posts terms of use (TOU), which prevent commercial use of its website
- Zoocasa continues indexing Century 21 listings until March 2010
- Dec. 2010, Century 21 sues for breach of contract, as well as copyright infringement and trespass to chattels
- TOU on Century 21 website not drawn to user’s attention in any active way

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**Terms of Use**

- User of website not required to agree to terms before accessing website
- TOU state that upon accessing website user bound by TOU
- Zoocasa denied that it had ever agreed to TOU or that there was any consideration for contract
- Zoocasa acknowledged it was aware of Century 21 TOU, that Century 21 TOU were industry standard, and what conduct was deemed to be acceptance
- Zoocasa had similar TOU on the Zoocasa website
Court’s Holding

• Accepting the service with notice of TOU and knowledge that use is deemed agreement with TOU sufficient to form binding contract
• Consideration for contract found in benefit of information on website
• When a benefit is offered subject to stated conditions, the offeree decides to take benefit with knowledge of terms of offer; the taking constitutes an acceptance of the terms which bind them

Court’s Holding (Cont’d)

• Consideration will be given to whether user is an individual consumer or a commercial entity and whether one-time or frequent user of site
• A publicly available website does not necessarily give a right of access free of contractual terms
• Browsing past the initial page of website is conduct indicating agreement with the TOU if:
  i. terms provided with sufficient notice
  ii. are available for review prior to acceptance
  iii. clearly state that proceeding further is acceptance of the terms

Securing Your Online Home

• Remember: TOU can be a binding agreement
• Consider whether your website TOU are appropriate to safeguard your information, pricing, etc.
• As website evolves, so should TOU
Domain Names: Surviving the Land Rush or Lessons from the Online Red Light District

Antonio Turco

The Land Rush: New gTLDs

- Proposed system would allow any public or private entity to operate domain name registry with unique top-level domain (TLD); for example, <.blakes> or <.stampcollector>
- Operation may be subcontracted out
- Objection procedure available to protect against adoption of marks of others as name of TLD
- Has already started: <.xxx>

New gTLDs: Overview

- 100s to 1,000s of new extensions expected
New gTLDs: What’s Coming?

- Geography: .london, .miami
- Interest: basketball, rugby,
- Trade-marks: deloitte, canon
- Industry: .bank, .sex, .pharmacy
- Internationalized: .布雷克

New gTLDs: Issues

- Many more gTLDs in which cybersquatters may register domain names
- Strategic decisions regarding defensive registration of domain names in various new gTLDs

New gTLDs: Best Practices and Other Lessons from <.xxx>

- Monitor applications
- Keep eye on launch dates and sunrise provisions
- Become familiar with rights protection mechanisms, types of objections and procedures for employing them
- Register selectively
Retweeting and Linking: Avoiding a Chain of Liability

Sheldon Burshtein

What Linking Is

- **Link**: hypertext (HTML) reference on first page to second page on same or another site
- **Deep link**: link to page other than home page of other site
  - bypasses information, terms of use, disclaimers, advertising
- **Inline link**: display on first page content from linked page
- **Frame**: display in window on first page content from linked page surrounded by material from first page
- **Inlining and framing**: user does not leave first page
- **Cdn and U.S. courts**: linking of core significance to Internet

Potential Linking Risks

- **Right to link**
  - right to link unless limited by contractual terms
  - contract may arise by click, browse or conduct
- **Examples of potential liabilities**:
  - defamation: republication of defamatory statement
  - copyright infringement: reproduction of content
  - violation of trade-mark, personality rights: framing or linking in way to suggest unauthorized connection
  - misleading advertising
  - regulatory violation: e.g., insufficient disclaimer for drug
**Crookes v. Newton**

- Plaintiff claimed that links by defendant to allegedly defamatory content of third party defamed plaintiff
- Trial and appellate (2-1) courts:
  - link analogous to footnote
  - mere link to other content not publication so no defamation
- Majority (6 of 9) in SCC
  - link a mere reference, like footnote
  - mere link to other content not publication
  - liability for defamation only where linking party repeats content

**Other Perspectives**

- Minority (3 of 9) in SCC
  - (2 justices) Where page with link contextually adopts or endorses linked content, link ceases to be mere reference
  - (1 justice) Majority ignores differences in links and footnotes
  - (1 justice) Should consider several factors in assessing liability
- Recent Canadian decision: *Tjella v. Wang* (BCSC):
  - liability where defamatory content called “truth” by linking party
- Very recent English decision: *McGrath v. Dawkins*
  - websites associated and link hidden
  - in referring to Crookes, court said issue may be fact sensitive
  - may be liability for linking to website with defamatory statements

**Avoiding Chain of Liability**

- Before linking, carefully review content to be linked
- Avoid adoption, endorsement or repetition of linked content without careful review
- Periodically review linked content as it may change
- Retweeting: analogous to linking but may be republication and so may incur more risk
- Retweet with prudence
- Don’t risk being a link in a chain of liability
Profile

John Orange is a senior member of the Intellectual Property Group. For more than 25 years, he has provided strategic advice on the development and enforcement of intellectual property rights for Canadian companies in the mechanical and electrical fields. His professional experience includes involvement in the licensing program for the compact disc industry, developing IP portfolios and working in the area of encryption.

John has played a leading role in developing formal patent training courses around the world. He has trained a number of entrants to the profession and lectures at the Patent & Trademark Institute of Canada patent agency course at McGill University.

John has obtained international recognition as a leading IP professional. He is listed as a patent expert in the *Guide to the World's Leading Patent Experts* published by Legal Media Group. He is past president of the International Federation of Intellectual Property Attorneys (FICPI), an international organization having close working relationships with international establishments such as the World Intellectual Property Organization, the World Trade Organization, the European Patent Office, and the European Commission, as well as the national patent offices.

John is a fellow of the Intellectual Property Institute of Canada and has served on its council. He is president of the Communications Committee of FICPI, a member of the International Association for the Protection of Intellectual Property (AIPPI), and co-chair of the Special Committee on Patent Agents for the American Intellectual Property Law Association. He became a registered patent agent in 1979 and qualified as a trade-mark agent in 1981. He is qualified to practise before the U.S. Patent and Trademark Office.

Education

Registered Trade-mark Agent (Canada) - 1981
Registered to practise before the United States Patent and Trademark Office - 1980
Registered Patent Agent (Canada) - 1979
B.Sc. (Mechanical Engineering), Lanchester Polytechnic, Coventry, England - 1970
Profile

Alice Tseng is a Partner in the Intellectual Property Group. She graduated from the Faculty of Pharmacy and the Faculty of Law at the University of Toronto and is a licensed pharmacist, lawyer and patent agent.

Alice’s practice consists primarily of advising companies in the pharmaceutical, medical device and natural health product industries. She advises these clients on a diverse range of matters, including pricing and reimbursement (e.g., rebate and pricing restrictions, formulary listing agreements, agreements with hospital buying groups); regulatory matters relating to safety (e.g., recalls, health professional communications, public advisories) or licensing (e.g. of products or establishments); health-care compliance (e.g., Rx&D, PAAB and MEDEC codes of conduct); advertising and marketing programs and trade disputes; public relations activities (e.g., communications to the media); access to information and freedom of information matters; privacy, including personal health information matters; the sale of drugs through Internet pharmacies; and the purchase and sale of pharmacies.

Blakes is ranked in *PLC Which Lawyer? 2012* as a highly recommended firm in the Life Sciences Regulatory category and a leading firm in the Life Sciences Pricing and Reimbursement category, and Alice is recognized as a highly recommended lawyer in the area of Life Sciences Regulatory.

Alice also advises clients in a variety of industries, especially the food industry, on advertising and marketing issues generally.

Education

Admitted to Ontario Bar - 1998  
LL.B., University of Toronto - 1996  
B.Sc.Phm. (Pharmacy), University of Toronto - 1993
Profile

Brett Slaney is a Patent Agent with the Intellectual Property Group. His areas of expertise include patent drafting and prosecution, portfolio management, and opinion work regarding patentability, infringement, and validity. Brett’s practice focuses on patent-related issues in the electrical, software and mechanical fields, with particular emphasis on multidisciplinary systems. His professional experience includes servicing clients in the data security, wireless telecommunications, automotive electronics, fishing instrumentation, process automation, consumer product, and software industries.

Brett also has an active practice in industrial designs and design patents, as well as litigation support and patent issues arising during corporate transactions.

Brett has been a member of the Intellectual Property Institute of Canada (IPIC) since 2004, the Toronto Intellectual Property Group (TIPG) since 2005, the American Intellectual Property Law Association (AIPLA) since 2006, and FICPI (The International Federation of Intellectual Property Attorneys) since 2006.

Brett is active in professional committees in both FICPI and IPIC related to software and business method patents. He has also served as a guest lecturer at the engineering undergraduate level regarding patent issues and is actively involved in educating and training engineering students in the field of patent law through a co-operative program with the University of Waterloo.

Brett qualified on the 2005 patent agent’s examinations and was registered as a Canadian patent agent in 2006. He was also registered to practise before the United States Patent & Trademark Office on behalf of Canadian-based inventors in 2006.

Education

Registered Canadian Patent Agent - 2006
Registered to practise before the United States Patent and Trademark Office in Patents (Canadian Applicants) - 2006
B.A.Sc. (Hon.) (Systems Design Engineering), University of Waterloo - 2004
Profile

Alan practises litigation in a number of areas that span commercial, regulatory, intellectual property and technology. His practice includes appearances and opinions relating to, among others, conflicts of law and jurisdiction concerns, regulatory issues in the financial services sector, partnership and shareholder disputes, technology disputes and satellite technology licensing. Alan also advises on issues relating to biometrics, oil and gas pipelines, pharmaceutical development and varied patent, trade-mark and copyright disputes.

Alan has appeared before the Supreme Court of Canada as well as the trial and appellate divisions of the Ontario Court of Justice and the Federal Court of Canada. He also appears before administrative tribunals and in domestic and international arbitrations and mediations.

Professional Activities

In addition to his litigation practice, Alan taught contract remedies at Osgoode Hall Law School for a number of years. He has also participated as a demonstrator in The Law Society of Upper Canada's bar admission program.

Alan has been a member of the Ontario division of the Canadian Bar Association's Alternate Dispute Resolution Committee. He is currently a member of the Intellectual Property Institute of Canada and chair of the Intellectual Property Institute of Canada's Competition/Intellectual Property Committee. Alan is also an associate member of the American Bar Association and the American Intellectual Property Law Association and a member of Fédération International des Conseils en Propriété Intellectuelle (FICPI).

Awards and Recognition

As reported for the past four years in The Best Lawyers in Canada, Alan has been voted by his peers as one of the leading intellectual property lawyers in Canada.

Education

Registered Trade-mark Agent, Canada - 1986
Admitted to the Ontario Bar - 1984
LL.M., University of Toronto - 1982
(Duff-Rinfret Scholar)
LL.B., University of Windsor - 1981
B.A. (Hon.), University of Toronto - 1977
Leah Begleiter Rodin is a Patent Agent in the Intellectual Property Group. She counsels clients on protecting their intellectual property, with an emphasis on chemical and life-science inventions. Her practice includes drafting and prosecuting patents and preparing opinions on patentability, validity, infringement and freedom to operate. She also advises on portfolio management and patent-filing strategy.

Leah has been registered as a Canadian patent agent since 2005 and as a U.S. patent agent since 2006. She was the recipient of the Intellectual Property Institute of Canada (IPIC) Marie Morency Memorial Prize, which is awarded to the person who achieves the highest mark on the patent-drafting section of the patent agent qualifying examination.

Leah is a member of the Chemical Institute of Canada (CIC), the Intellectual Property Institute of Canada (IPIC), the Toronto Intellectual Property Group (TIPG) and the Technology Transfer Committee of IPIC.

Education

Registered Canadian Patent Agent - 2005
M.Sc. (Chemistry, Organic), University of Toronto - 1997
B.Sc. (Hon., Chemistry), University of Manitoba - 1995
Profile

Santosh Chari is a senior member of the Intellectual Property Group and has over 20 years of experience in the patent profession. Santosh advises clients on the protection of intellectual property, including the preparation and prosecution of patent and industrial design applications. He also advises on infringement and validity issues relating to intellectual property and on licensing and patent portfolio management issues.

Santosh has expertise in various technologies including biotechnology, pharmaceutical and chemical subject matters and medical devices, as well as mechanical and software inventions.

Santosh has managed the prosecution of patent and industrial design applications before many intellectual property offices throughout the world and has represented clients of various sizes, including private enterprises and public institutions, such as universities and government departments.

Santosh is a regular speaker at domestic and international conferences held by various organizations.

Santosh is a fellow of the Intellectual Property Institute of Canada (IPIC) and a member of the American Intellectual Property Law Association (AIPLA), the Intellectual Property Owners Association (IPO) and the International Association for the Protection of Intellectual Property (AIPPI). He is chair of the IPIC International Patent Issues Committee and a member of the IPIC committees on biotechnology patenting and biotechnology legislation. He is also a member of the IPO International Patent Law and Practice Committee.

Santosh is recognized as an endorsed professional in the Life Sciences: Patent Counselling category by *PLC Which Lawyer? 2012*.

Education

P.Eng., Ontario - 1993
B.A.Sc., Chemical Engineering, University of Ottawa - 1988
B.Sc., Biochemistry, University of Ottawa - 1984
Profile

Jennifer Smith is a licensed pharmacist and lawyer practising in the Intellectual Property Group. Her practice focuses on matters involving the pharmaceutical and medical device industries, including advertising and marketing, regulatory, privacy and access to information issues. Jennifer also advises clients on various aspects of clinical research, including negotiation of clinical trial agreements as well as legal and ethical requirements for informed consent.

Jennifer works closely with the Firm’s Litigation Group, assisting with the defence of class action law suits and product liability claims, and recently spent time working with the Firm’s Competition, Antitrust & Foreign Investment Group, where she assisted with the merger of Merck & Co., Inc. and Schering-Plough Corporation.

Jennifer obtained her LL.B. from Dalhousie Law School and her bachelor of science in pharmacy from the University of Saskatchewan. Before attending law school, she practised pharmacy for several years. She worked as a retail pharmacist at Shopper’s Drug Mart and as a lecturer and drug information consultant at the College of Pharmacy and Nutrition, University of Saskatchewan. She also worked as a clinical research associate at the Saskatchewan Drug Research Institute, where she provided various site-management services to researchers conducting human clinical trials.

Education

Admitted to the Ontario Bar - 2007
LL.B., Dalhousie University - 2006
B.S.P. (Pharmacy), University of Saskatchewan - 1996
Athar's practice is focused on intellectual property matters. He is involved in providing opinions on the availability of trade-marks, as well as the filing and prosecution of trade-mark applications and the handling of trade-mark oppositions, in Canada. His practice also involves litigation relating to all aspects of intellectual property rights, including disputes relating to patents, trade-marks, copyright, industrial designs, and other similar rights.

**Professional Activities**

Athar is a member of the editorial board of the *Canadian Intellectual Property Review*. He also serves on the Litigation and Trade-mark Legislation committees of the Intellectual Property Institute of Canada.

Athar's other professional affiliations include the American Bar Association, the American Intellectual Property Law Association, the Canadian Bar Association, the International Association for the Protection of Intellectual Property, the International Trademark Association, the Licensing Executives Society and The Advocates' Society. He is also a member of the Osgoode Society for Canadian Legal History.

**Education**

Registered Trade-mark Agent, Canada - 2010  
Admitted to the Ontario Bar - 2008  
J.D., University of Toronto - 2007  
B.Com. (Hon.), Queen's University - 2004
Profile

Anil Bhole is an Associate in the Intellectual Property Group. His practice encompasses all aspects of intellectual property (IP) law, primarily focusing on patent and trade-mark prosecution, industrial design, copyright, and various information technology law matters. Anil assists his clients to obtain protection for innovations, including for mobile devices, mobile applications, search systems, wireless signals, VLSI technologies and cleantech.

Anil is particularly enthusiastic about assisting start-up companies to develop IP strategies and pursue protection for key aspects of their technologies. He has also assisted established companies to formulate best practices for managing their IP portfolios and leveraging IP assets.

Anil also works closely with the next generation of innovators and entrepreneurs. He has conducted guest lectures at the University of Waterloo and worked with entrepreneurial students to assist them in commercializing their technologies.

Prior to joining Blakes, Anil was employed by another Toronto-based national law firm where he worked extensively with small to medium-sized technology companies.

Anil was called to the Ontario Bar in 2008 and is a registered Canadian and United States patent agent and registered Canadian trade-mark agent. He holds a bachelor of applied science in computer engineering and, prior to studying law, gained experience in the high-tech, automotive, financial and medical devices sectors. As an engineer in the medical devices industry, he was heavily involved in IP litigation and in ensuring compliance with various standards and regulations from ISO, Health Canada, and the U.S. Food and Drug Administration.

Education

Registered Canadian Patent Agent - 2010
Registered United States Patent and Trademark Agent - 2010
Registered Canadian Trade-Mark Agent - 2009
Admitted to the Ontario Bar - 2008
LL.B., Osgoode Hall Law School - 2007
Anthony M. Prenol
Partner, Toronto Office
Blake, Cassels & Graydon LLP
Direct  416-863-4292
Facsimile  416-863-2653
anthony.prenol@blakes.com

Profile

Anthony Prenol is a Partner in the Intellectual Property Group. He is involved in all aspects of the clearance, prosecution and enforcement of intellectual property rights. He is a lawyer, patent agent and trade-mark agent.

Anthony's practice focuses primarily on patent litigation, trade-mark litigation and copyright litigation. He has represented clients at all levels of court up to the Ontario Court of Appeal and the Federal Court of Appeal, and before various administrative tribunals.

Anthony has been chosen as one of the "World's Leading Patent Law Practitioners" by Managing Intellectual Property and has been ranked in each of the IP: Patent Litigation, IP: Non-Patent Litigation and Life Sciences: Patent Litigation categories in PLC Which Lawyer?. In The Best Lawyers in Canada, he was voted by peers as one of the leading intellectual property lawyers in Canada. He has also been recognized as an "IP Luminary" in a survey of the IP community published by Informa Law. Anthony has been ranked in the World Trademark Review 1000: The Definitive Guide to Trademark Legal Services. He has also been selected as being among the world's pre-eminent trade-mark lawyers in Law Business Research's The International Who's Who of Trademark Lawyers and The International Who's Who of Business Lawyers. Anthony has also been listed in IAM (Intellectual Asset Management) Patent 1000: The World's Leading Patent Practitioners (2012).

Anthony is the editor of Intellectual Property World Desk Reference: A Guide to Practice by Country, State, and Province, a two-volume summary of intellectual property laws and procedures in nearly 150 jurisdictions around the world. He is also a member of the advisory board for IP Litigator magazine.

Anthony is a member of the Trademark Law & Practice (International) Committee of the Intellectual Property Owners Association (IPO). He has previously served on the International Trademark Association's editorial board for The Trademark Reporter and as a member of their Alternative Dispute Resolution Committee.

Education

Registered Patent Agent, Canada - 1997
B.Math, University of Waterloo - 1992
Admitted to the Ontario Bar - 1990
Registered Trade-mark Agent, Canada - 1990
LL.B., University of Toronto - 1988
Profile

Laura Weinrib is a Partner practising with the Intellectual Property Group. Her practice emphasizes pharmaceutical, medical device, natural health product, food and consumer product law, and the marketing and advertising of these products. Laura has advised clients on such matters as drug, medical device, natural health product, consumer product and food labelling, and other regulatory issues arising under Canadian legislation, including licensing and product safety issues. She has also provided advice regarding clinical trial agreements, contract research organization agreements, promotional programs, advertising, product claims, the purchase and sale of pharmacies, hospital supply agreements, and consulting and advisory board agreements.

Laura also practises in the area of trade-mark prosecution and opposition.

Laura was recently seconded on a part-time time basis to the Canadian offices of a major pharmaceutical company where she provided a broad range of legal services as in-house counsel. She has also spent time working in the Firm's corporate practice, where she assisted with a full range of corporate matters.

Laura is a graduate of the Faculty of Law at the University of Toronto. Prior to law school, she received her master of science from the Department of Medical Biophysics, division of experimental therapeutics, at the University of Toronto. While completing her degree, she conducted research and published articles in the field of gene therapy. Laura also received her bachelor of science from McGill University, where she majored in microbiology and immunology.

Education

Registered Trade-Mark Agent, Canada - 2010
Admitted to the Ontario Bar - 2004
J.D., University of Toronto - 2003
M.Sc., University of Toronto - 2000
B.Sc., McGill University - 1998
Profile

Christine's practice focuses on commercial transactions involving information technology and intellectual property. She has extensive experience in all aspects of information technology law, including outsourcing, systems and software acquisitions, systems and software development, licensing, various ASP and SAAS arrangements, complex services agreements and distribution/reseller agreements.

Having a strong background in intellectual property, Christine's work also includes technology-based joint ventures and strategic alliances, teaming arrangements and patent and other technology licensing in a broad range of industries, including telecommunications, financial services, insurance, pharmaceutical and defence. She also assists clients with various trade-mark and branding matters.

Select Experience

Significant recent matters include:

- Advising a significant U.S.-based technology company on the distribution and licensing of proprietary software solutions in the Canadian marketplace

- Assisting a Canadian-based technology company structure and negotiate a three-party billing systems implementation and support agreement

- Assisting a medical device company structure and negotiate a software-based medical system supply and service agreement with a group of hospitals

- Acting for a leading Canadian pharmaceutical company on the structuring, preparation and negotiation of a long-term collaboration agreement for the development and commercialization of a drug for the treatment of certain neurological conditions, including the securing of key patent and technology licences from a large U.S.-based biotech company

- Acting for a leading disaster-recovery provider in an outsourcing deal pursuant to which the existing and new nationwide managed hosting business of a Canadian telecommunications company would be fulfilled by such provider

Awards and Recognition

Christine has been identified by *Intellectual Asset Management* (IAM) magazine as one of the world's leading patent and technology lawyers in *IAM Licensing 250: The World's Leading Patent & Technology Licensing Lawyers*. 
Education

Admitted to the Ontario Bar - 1995
Registered Trade-mark Agent, Canada - 1995
LL.B., Osgoode Hall Law School - 1993
B.A.Sc. (Hon.) (Industrial Engineering), University of Toronto - 1990
Profile

Dara Lambie is an Associate practising with the Intellectual Property Group. Her practice focuses on health, drug, advertising and marketing regulatory matters, consumer product safety issues, as well as privacy and access-to-information law.

Dara routinely advises clients in responding to access to information and freedom of information requests made to federal and provincial government bodies. She advises in all areas of privacy law with a particular emphasis on privacy in the health information context and in online privacy. She also has significant experience in regulatory compliance with consumer product safety law as well as incident reporting and product recalls.

In the areas of advertising and marketing, Dara provides advice regarding promotional contests, review of advertising copy and compliance with product labelling laws. She also advises regarding compliance with Canada's new anti-spam legislation.

Dara articled with Blakes after graduating with her J.D. from the University of Western Ontario. She obtained her honours B.Sc. in biology, specializing in genetics, from McMaster University. While at law school, Dara was appointed to the Dean's Honour List for each year of study and graduated with distinction. She was also the recipient of the 2007 Blake, Cassels & Graydon LLP Scholarship for the University of Western Ontario. She has published and presented academic papers in the areas of privacy and personal information protection as well as freedom of expression and advertising.

Dara holds leadership roles with Camp Hermosa, a not-for-profit children's summer camp in Goderich, Ontario, and is actively involved in several pro bono initiatives at Blakes, including the Small Claims Court Duty Counsel Project.

Education

Admitted to the Ontario Bar - 2010
J.D., University of Western Ontario - 2009
B.Sc. (Genetics), McMaster University - 2006
Profile

Wilfred So is a Patent Agent with the Intellectual Property Group. His work involves the preparation and prosecution of patent applications, as well as patentability reviews and dealing with issues of infringement and validity. Wilfred's technical background includes electrical, software, biomedical and mechanical fields, and the integration of multidisciplinary systems. During his final thesis project, he developed an autonomous system to control the flight of multiple radio-controlled helicopters. Tools such as image processing, pattern recognition, fuzzy logic, wireless communications and control systems were used to co-ordinate the swarm of intelligent helicopters.

Prior to joining Blakes, Wilfred gained experience while working in the aerospace industry. He was also exposed to various other industries in a consulting role, including tire manufacturing, production of heavy tractors, textile manufacturing, chemical production and electrical turbine production.

Wilfred has been a member of the Intellectual Property Institute of Canada since 2008. He qualified on the 2009 patent agent's examinations and was registered as a Canadian patent agent in 2009. He was also registered to practise before the United States Patent & Trademark Office on behalf of Canadian-based inventors in 2010.

Education

Registered to Practise Before the United States Patent and Trademark Office in Patents (Canadian Applicants) - 2010
Registered Canadian Patent Agent - 2009
B.A.Sc. (Hon., with Distinction, Systems Design Engineering), University of Waterloo - 2008
Profile

Gary advises clients regarding obtaining, enforcing and licensing trade-marks and copyright in Canada. His practice involves adversarial and advocacy-based proceedings before the Trade-marks Opposition Board and the Ontario and Federal Courts. He also counsels clients on trade-mark and copyright issues involved in corporate transactions and financings.

Gary represents clients both within and outside Canada, including a major professional sports league, a motor sports organization, a pharmaceutical company, a well-known cartoonist, retailers and consumer product companies, and interests in the jewellery and wines and spirits industries.

From 2007 to 2009, Gary was Practice Group Leader of the Intellectual Property Group.

Gary is fluent in both English and French.

Professional Activities

Gary has written and spoken on a wide range of topics in the area of intellectual property law. He is a fellow of the Intellectual Property Institute of Canada (IPIC) and is currently chair of the IPIC's Trade-mark Legislation Committee (2011-13) and was a past chairman of the Canadian Legislation Analysis Subcommittee of the International Trademark Association (INTA). He is also the past vice-chair of the INTA Emerging Issues Committee and past vice chair of INTA's Famous and Well-Known Marks Committee.

Gary is involved in charitable organizations and sits on the National Board of Directors of Special Olympics Canada, where he chairs the Human Resources Committee and acts as Ombudsman.

Awards and Recognition

Gary is recognized as a leading Canadian lawyer in the field of intellectual property law by the following publications:

Education

Certified Specialist in Intellectual Property (Trade-Mark and Copyright) Law - 2003
Admitted to the Ontario Bar - 1989
Registered Trade-mark Agent, Canada - 1989
LL.B., University of Toronto - 1987
B.A., Cornell University - 1984
Profile

Antonio’s practice focuses on litigation related to intellectual property rights, including disputes related to patents, copyright, trade-marks, industrial designs and trade secrets.

Antonio has represented clients in domain name disputes under both the Uniform Domain Name Dispute Resolution Policy and the CIRA Domain Name Dispute Resolution Policy. He also represents clients in general commercial disputes. He is involved in searching the availability of trade-marks, the filing and prosecution of trade-mark and copyright applications in Canada, as well as trade-mark opposition and non-use proceedings.

On the commercial side, Antonio also assists clients in commercial transactions involving intellectual property and technology, such as electronic commerce and licensing.

Professional Activities

Antonio is a member of the Intellectual Property Institute of Canada, the International Trademark Association and the Toronto Intellectual Property Group.

Antonio has written and spoken on a range of topics relating to trade-marks, copyright reform, domain name disputes and trade-mark litigation. His articles have been published in the World Trademark Law Report, the World Copyright Law Report and the World Internet Law Report. Antonio was also a speaker at the Entrepreneurship and the Internet Symposium presented by the Centre for the Study of Nascent Entrepreneurship and Exploitation of Technology.

Education

Registered Trade-mark Agent, Canada - 2005
Admitted to the Ontario Bar - 2002
LL.B., Queen’s University - 2001
B.A. (Hon.), University of Toronto - 1997
Profile

Sheldon Burshtein is a Partner of Blake, Cassels & Graydon LLP. He practises in the Toronto office as a member of the Intellectual Property, Information Technology, Life Sciences, Sports & Entertainment, Franchising, and Alternative Dispute Resolution Groups.

Qualifications. Sheldon received his B. (Civ.) Eng. from McGill University and is a registered professional engineer in the province of Ontario. He also has two law degrees, his civil law B.C.L. and his common law LL.B., from McGill University. He is a member of The Law Society of Upper Canada and has been certified by The Law Society as a Specialist in Intellectual Property (Patent, Trade-mark and Copyright) Law. Sheldon is registered as a patent agent and as a trade-mark agent in Canada. He is also registered to practise before the United States Patent and Trademark Office on behalf of Canadian applicants. Sheldon has been accredited as a Certified Licensing Professional.

Practice. Sheldon practises exclusively in the fields of intellectual property and technology. His work includes the clearance, prosecution, acquisition, enforcement and exploitation of patents, trade-marks, copyright, industrial designs and other forms of intellectual property. His practice emphasizes commercial transactions involving intellectual property and information technology, such as licensing and other transactions involving pharmaceuticals and life sciences, electronic commerce, and other technologies, as well as franchising. He is significantly involved in counselling on intellectual property matters.

Leader. Sheldon is a leader of the Intellectual Property and Technology bar. Law Business Research's The International Who's Who of Patent Lawyers has identified him as "the most frequently named Canadian" patent lawyer and The International Who's Who of Trademark Lawyers consistently ranks Sheldon among the 10 top trade-mark lawyers in the world. World Trademark Review 1000: The Definitive Guide to Trademark Legal Services said Sheldon is "uniformly outstanding; his ability to translate his unparalleled knowledge of trademark law into concrete, practical advice is exceptional." Managing Intellectual Property has referred to him as "the foremost copyright expert in Canada." PLC Cross-border Intellectual Property Handbook has selected him as the leading commercial intellectual property lawyer in Canada. The International Who's Who of Business Lawyers refers to him as an "excellent attorney" and a "leader in his field."

Canadian Recognition. Sheldon has been continuously listed in The Lexpert/American Lawyer Guide to the Leading 500 Lawyers in Canada from inception. He has been continuously rated among the most frequently recommended lawyers for "Intellectual Property" in The Canadian Legal Lexpert Directory from inception, and is also recognized in the "Computer and Information Technology" and "Technology" categories. He has been continuously listed in The Best Lawyers in Canada in the "Intellectual Property" and "Technology" categories since inception. Sheldon was named in the Who’s Who Legal: Canada 2010 special report for both "Patents" and "Trademarks." He is also referenced in the Canadian Who's Who. He has received a Special Recognition of Achievement Award from the Intellectual Property Institute of Canada.
**International Recognition.** Sheldon has been continuously ranked for "Intellectual Property" by *Chambers Global: The World's Leading Lawyers for Business* since inception. He has been named in Law Business Research's *The International Who's Who of Business Lawyers* and in both its "Patent" and "Trademark" categories. He has been honoured as an "Intellectual Property Luminary" by the publishers of *Patent World, Trademark World* and *Copyright World*. Sheldon has been selected by Mondaq as one of the "World's Leading Intellectual Property Lawyers." He has been named an "Expert's Expert" by *World Trademark Review*. Sheldon has been listed in the *World Trademark Review 1000: The Definitive Guide to Trademark Legal Services* since inception. He has been ranked as one of the leading "Intellectual Property" experts in the *PLC Cross-border Intellectual Property Handbook* since inception. Sheldon has been ranked in the *IAM Licensing 250: The World's Leading Patent and Technology Licensing Lawyers* since inception. He has been referenced in the *European Counsel Life Sciences Specialist 500* of the "Top-Ranking Life Sciences Lawyers Worldwide." Sheldon has been continuously named by Practical Law Company among the leading "Life Sciences Lawyers" since inception. He has been ranked by Practical Law Company as one of the leading "E-Commerce and Information Technology Lawyers." He has been named an "Expert's Expert" by *World Trademark Review*. He has been selected one of the "World's Top 50 Trade Mark Law Practitioners" by *Managing Intellectual Property*. The same publication selected Sheldon one of the "Worldwide Leading 25 Trade-mark Experts." He has consistently been selected as one of the "Most Highly Regarded Individuals Global - Trademarks" in *The International Who's Who of Trade Mark Lawyers* published by Law Business Research. In 2010, he was again identified as one of the world's top 10 by that publication.

**Patents.** Sheldon acts for numerous businesses in various industries in the management, prosecution, licensing and enforcement of patent rights. He has authored a book on Canadian patent law. He has been consistently chosen one of the "World's Leading Patent Experts" by *Managing Intellectual Property* since inception. Sheldon has been consistently recognized in *The International Who's Who of Patent Lawyers* by Law Business Research since inception, and has been identified as the most frequently named Canadian. Sheldon received the Marie F. Morency Memorial Prize awarded by the Intellectual Property Institute of Canada for the highest national standing in the patent agents drafting examination.

**Trade-marks.** Sheldon represents numerous clients in brand counselling and the protection, licensing and enforcement of trade-mark, trade dress and trade name rights, as well as in domain name issues. He has authored a multiple-volume book and co-authored two other books on trade-mark law. He has been consistently chosen one of the "World's Leading Trademark Law Experts" by *Managing Intellectual Property* since inception. Sheldon has been named an "Experts' Expert" by *World Trademark Review*. He has been selected one of the "World's Top 50 Trade Mark Law Practitioners" by *Managing Intellectual Property*. The same publication selected Sheldon one of the "Worldwide Leading 25 Trade-mark Experts." He has consistently been selected as one of the "Most Highly Regarded Individuals Global - Trademarks" in *The International Who's Who of Trade Mark Lawyers* published by Law Business Research. In 2010, he was again identified as one of the world's top 10 by that publication.

**Copyright.** Sheldon advises a major broadcaster, a television station, a major newspaper, book publishers, major recording companies and others on copyright protection, transaction and enforcement issues. He has co-authored a book on Canadian copyright law and has also been involved in drafting sections of the *Copyright Act*. He has been consistently selected in the *Managing Intellectual Property* surveys as one of the "World's Leading Copyright Law Experts" from inception and was said to be "the foremost copyright expert in Canada."

**Domain Names.** Sheldon advises numerous clients on domain name strategy, transactions and proceedings. He led a Blakes team in the structuring and set up of the ".ca" domain name registry. Sheldon has authored a multiple-volume book on Internet trade-mark and domain name law. He has been ranked by Practical Law Company as one of the leading "E-Commerce and Information Technology Lawyers." Sheldon has been named in the *PLC Cross-border Information and E-Commerce Handbook* and was selected in *PLC Which Lawyer? Yearbook* in the category of "IT and E-commerce."

**Licensing, Technology Transfer and Franchising Transactions.** Sheldon has been accredited as a certified licensing professional. He has acted in the licensing of various types of intellectual properties in
virtually every industry, and represents major clients in connection with technology and other licensing, franchising and merchandising programs. Sheldon has been involved in transactions involving some of the most valuable Canadian and international intellectual properties. He has been selected by *PLC Cross-border Intellectual Property Handbook* as the leading commercial intellectual property lawyer in Canada. He has co-authored several books on licensing and on intellectual property and information technology in commercial transactions. Sheldon authors a monthly column on "Licensing Fundamentals" in *World Licensing Law Report* and *World Intellectual Property Report*. He is ranked in the *IAM Licensing 250: The World's Leading Patent and Technology Licensing Lawyers*. Sheldon has received an Achievement Award from the Licensing Executives Society USA/Canada.

**Pharmaceuticals and Life Sciences.** Sheldon acts for a number of major international and domestic pharmaceutical companies and has served as a director of one of Canada's largest pharmaceutical companies. He has been referenced in the European Counsel *Life Sciences Specialist 500* of the "Top-Ranking Life Sciences Lawyers Worldwide." Sheldon has been continuously ranked among the leading lawyers in the *PLC Cross-border Life Sciences Handbook* since inception. He is recommended by *PLC Which Lawyer?* in the category of "Life Sciences-Intellectual Property." He has written a regular column in *Pharmaceuticals Canada*.

**Internet, E-commerce, Information Technology and Social Media.** Sheldon acts for a number of leading Internet e-commerce, information and technology based companies and advises other businesses on those issues, including social media. For example, he led a Blakes team in the structuring and set up of the "ca" domain name registry. Sheldon has authored a multiple-volume book on Internet trade-mark and domain name law. He has been selected in Law Business Research’s *The International Who’s Who of Internet, e-Commerce and Data Protection Lawyers*. He has been ranked by Practical Law Company as one of the leading "E-Commerce and Information Technology Lawyers". Sheldon was selected by Practical Law Company as an "Expert in Communications Law." He has been named in the *PLC Cross-Border Communications Handbook*, the *PLC Communications Industry Report* and the *PLC Cross-Border Information Technology and E-Commerce Handbook*. He was selected in the *PLC Which Lawyer?* in the category of "IT and E-commerce". He has also been chosen one of the "Personalities in Canadian Technology".

**Sports and Entertainment.** Sheldon is active on behalf of numerous clients in the sports and entertainment industries. For example, he has acted for most of the major North American professional sports leagues, a leading sports sanctioning body and several major professional sports teams. He has represented newspaper, book and magazine publishers, major recording companies, and a major television network.

**Alternative Dispute Resolution.** Sheldon serves as an arbitrator and as a mediator. He is a member of the panel of IP Neutrals of Canada and the Canadian Panel of Neutrals for the International Trademark Association. He is also a member of the panel of the Intellectual Property Division of National Arbitration and Mediation and the panel of the Alternative Dispute Resolution Center. Sheldon has authored a book on domain name arbitration.

**Books and Articles.** Sheldon is an author of several books on Canadian intellectual property law, such as *The Corporate Counsel Guide to Intellectual Property Law* (Canada Law Book), *Patent Your Own Invention* (International Self Counsel Press), and *The Law of Domain Names and Trade-marks on the Internet* (Carswell). He has co-authored a book on international trade-mark law and has contributed chapters to numerous domestic and international books on trade-marks, copyright, other intellectual property, licensing, merchandising, intellectual property in commercial transactions, intellectual property disputes, electronic commerce, as well as pharmaceuticals and biotechnology. Sheldon is the author of hundreds of articles and papers on intellectual property and technology topics. He authors regular columns in various publications. He has also spoken often in all of these areas.
**Teaching.** Sheldon lectures annually at the McGill University/Intellectual Property Institute of Canada Trade-marks I course and the Copyright course. He is a member of the faculty in the Osgoode Hall Law School e-commerce LL.M. program and has been a lecturer in the Osgoode Hall Intellectual Property LL.M. program and the Osgoode Hall Intensive Program in Business Law.

**Organizations.** Sheldon is a member of many professional organizations in the legal, intellectual property and engineering fields and has chaired and sat on numerous committees in organizations such as the American Bar Association, the Canadian Bar Association, the Intellectual Property Institute of Canada, the International Association for the Protection of Industrial Property, the International Trademark Association and the Licensing Executives Society. He is a past chair of the Toronto Patent and Trademark Group.

**Education**

Certified Licensing Professional - 2008, 2011  
Registered Patent Agent, Canada - 1987  
Registered to practise before the United States Patent and Trademark Office in Patents (Canadian Applicants) - 1987  
Registered to practise before the United States Patent and Trademark Office in Trademarks (Canadian Applicants) - 1982  
Admitted to the Ontario Bar - 1980  
Registered Trade-mark Agent, Canada - 1980  
Registered Professional Engineer (Ontario) - 1980  
LL.B., McGill University - 1978  
B.C.L., McGill University - 1977  
B. (Civ.) Eng., McGill University - 1974