Cassels



Karen MacDonald

Partner

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Office

Vancouver

Expertise

- Intellectual Property
- Litigation
- U.S. Cross-Border

Biography

Karen MacDonald* (she/her/hers) is a partner in the Intellectual Property Group at Cassels. Karen has extensive experience in litigating matters in all areas of intellectual property, including patents, trademarks, copyright, industrial designs, and confidential information. She has appeared before the Federal Court, the Federal Court of Appeal, the British Columbia Supreme Court, and the British Columbia Court of Appeal.

Karen has particular expertise in anti-counterfeiting enforcement work. She is heavily involved with developing and implementing anti-counterfeiting enforcement programs in Canada for major brand owners worldwide, operating in fields such as luxury goods, apparel, certification marks, and software development, representing right holders in numerous precedent-setting decisions in the field.

Trademark prosecution is another significant element of Karen's practice. She regularly files applications, prepares responses to office actions, and appears before the Trademarks Opposition Board and in section 45 proceedings. She also advises Canadian clients on global filings and portfolio management.

Karen has worked with clients ranging from small companies to large multinational corporations operating both in Canada and internationally and is both a registered Trademark Agent and Patent Agent.

Karen's representative experience includes:

- *Burberry Limited and Chanel Limited, et al v. Ward et al*, 2023 FC 1257 – Successfully obtained novel injunctive relief previously not granted in Canada against a purveyor of counterfeit goods, adding remedies available to right-holders. The novel injunctive relief included third party disclosure requirements and rolling relief to add names and shipments to the Order.
- *David Michaels, J.D. v RE/MAX LLC*, 2020 TMOB 141 - Successfully defended RE/MAX's famous tri-bar red over white over blue rectangles sign design from a section 45 "non-use"

attack before the Trademark Opposition Board, establishing trademark use notwithstanding concurrent use with other trademarks.

- *Biofert Manufacturing Inc. v. Agrisol Manufacturing Inc*., 2020 FC 501 - Representing BioFert, a leading manufacturer of fertilizers, in obtaining judgment against defendants found liable for trademark infringement and passing off, as a result of their launch of an unauthorized competitor intended to divert sales by harnessing historical goodwill.
- *Cascade Aerospace Inc. V. AGNL Avionics Abbotsford Nominee ULC* - Represented Cascade Aerospace obtaining a novel injunction to halt the continued distribution of confidential information, including by parties in knowing receipt of such information.
- *Louis Vuitton et al. v Audrey Wang et al*., 2018 FC 1198; 2019 FC 1389 – Successfully obtained and defended an Anton Piller order and Mareva injunction preserving evidence of the defendants' counterfeiting activities and securing assets for judgment. Obtained final judgment of $740,000 against recidivist defendants.
- *Chanel Limited et al v Lam Chan Kee Company Ltd et al*., 2015 FC 1091; 2016 FCA 111 – Chanel was granted judgment of $380,000, including $250,000 in punitive and exemplary damages, against two corporations and an individual, with the court weighing and rejecting contradictory affidavit evidence from the defendants on a summary trial application. The Federal Court of Appeal confirmed the appropriateness determination of counterfeiting cases by way of summary trial even where credibility issues exist, thereby permitting the trial judge to discard Ms. Lam's evidence. The court also approved the use of a multiplier-based calculation of nominal damages and awarding significant punitive and exemplary damages in this type of case to deter such activities, though the matter was remanded back to the trial judge for confirmation his findings.
- *Chanel S. de R.L. and Chanel Inc. v Jiang Chu*, 2011 FC 1303 – Chanel was granted default judgment of over $320,000 in damages and punitive and exemplary damages, plus solicitor and client costs.
- *Louis Vuitton Malletier S.A. and Burberry Limited et al. v*

Singga Enterprises et al., 2011 FC 776 – Louis Vuitton and Burberry were granted the highest award of damages and costs to date in Canada against purveyors of counterfeit goods, for a total of $2.5 million in damages, including punitive and exemplary damages, plus solicitor and client costs. Judgment was granted on the basis of the Federal Court summary trial rules in the first successful use of such rules.

- *Nintendo of America Inc. and Sony Computer Entertainment America Inc. v COMPC Canada Trading Inc. and Qian (Kenneth) Chen* (22 September 2009) Vancouver S082517 (BCSC) — The British Columbia Supreme Court upheld and granted liquidated damages of $75,000 for a breach of settlement agreement plus $100,000 in punitive and exemplary damages, where the defendants had agreed to cease selling "circumvention devices" and "circumvention software," which allow purchasers to play counterfeit video games by allowing them to bypass technological measures on video game consoles that prevent the playing of counterfeit games.
- *Louis Vuitton Malletier S.A. v 486353 B.C. Ltd et al.*, 2008 BCSC 799 — Louis Vuitton was granted judgment of a total of $980,000 in damages and punitive and exemplary damages, plus special costs, under the BCSC summary trial rules.
- *Louis Vuitton Malletier S.A. v Yang et al*., 2007 FC 1179 and 2008 FC 45 Louis Vuitton was granted damages, punitive and exemplary damages, and solicitor and client costs totaling $263,699, by way of default judgment; the defendants applied to set aside the decision, which was denied and the decision upheld.

Karen is also a prolific author on intellectual property matters and is often called upon to speak at conferences by industry organizations. Recent presentations include:

- *Investigations and Enforcement on E-Commerce Platforms* - 27th Annual Fraud & Anti-Counterfeiting Conference, October 16, 2024
- *Injunctions: The Good, the Bad and the Ugly* - Intellectual Property Institute of Canada Annual Meeting, September 26, 2024

- *Trademark Case Law Review - Use of Marks on the Internet* - Intellectual Property Institute of Canada, March 9, 2023
- *Trademark Year in Review* - Intellectual Property Institute of Canada, February 13, 2023
- *26th Intellectual Property Law: The Year in Review* - Law Society of Ontario, presented Trademark Law Update, January 19, 2022
- *Intellectual Property for Litigators 2021*, CLE BC, November 9, 2021
- *Settling the IP Case: Advanced Tips for Settlements that Stick* - Intellectual Property Institute of Canada, June 8, 2021

Prior to joining Cassels, Karen was a partner of the Intellectual Property Group, based in the Vancouver office, of an international law firm and served as the Canadian head of consumer markets.

**Services provided through a Law Corporation*

Achievements

- *Benchmark Litigation* (Litigation Star: Intellectual Property)
- *Best Lawyers in Canada* (Intellectual Property Law | Advertising & Marketing Law | Technology Law)
- *Best Lawyers in Canada*, Lawyer of the Year (Intellectual Property Law – Vancouver) (2020)
- *Canadian Legal Lexpert Directory* (Advertising & Marketing, Intellectual Property)
- *Expert Guides: Guide to the World's Leading Women in Business Law* (Trademarks)
- *IAM/WTR Copyright 1000*
- *Legal500 Canada* (Intellectual Property) (Leading Individual)
- *Lexpert Special Edition*, Health Sciences
- *Lexpert Special Edition*, Technology
- *Managing Intellectual Property*, IP Stars (Trademark)
- *Managing Intellectual Property*, Top 250 Women in IP
- *ManagingIP Awards*, Canada's Trademark Disputes Practitioner of the Year (2024)
- *WTR1000: The World's Leading Trademark Professionals* (Anti-counterfeiting; Enforcement & Litigation; Prosecution & Strategy)

- *WTR1000: The World's Leading Trademark Professionals* (Global Leader)
- Registered Trademark Agent (2002)
- Registered Patent Agent (2003)

Recent Representative Work

- Cassels Successfully Represents Burberry and Chanel in Obtaining Novel Injunctive Relief Against Recidivist Counterfeiter

Insights

- A Court Order Is Not a Suggestion: Federal Court Finds Counterfeiter in Contempt
- Cassels Academy 2025 (Cassels Webinar)
- A "Distinct" Challenge for Trademark Owners: A Review of the Inherent Distinctiveness Objection in Trademark Examinations

Education / Bar Admissions

- LL.B., University of British Columbia, 2000
- B.Sc. (Genetics and Cell Biology), University of British Columbia, 1997

- British Columbia, 2001
- Ontario, 2026