

Cassels on IP: February 2024 - 2023 Year in Review

Sebastian D. Beck-Watt, Kassandra Shortt, Jessica Zagar, Mark Davis, Tushar Sharma, Andrew Stavros
February 27, 2024

In this edition: A review of 2023's significant developments in Canadian intellectual property law, unfounded claims of IP infringement present significant risks, news from our growing team, and more...

Review of Canadian Intellectual Property Law in 2023

The Cassels intellectual property team has discussed some of the most notable cases and developments in Canadian patent, trademark, and copyright law in 2023.

Patents: 2023 Year in Review & Notable Cases and Trends for 2024 >

The Cassels patent litigation team provides an update on some of the most notable patent law developments in 2023. Mark Davis, Andrew Skodyn, Sean Jackson, and Kassandra Shortt explored the use of "skinny labels," expert evidence, infringement that did not result in an injunction, and many more of 2023's patent law developments.

Trademarks: 2023 Year in Review >

From CIPO's recovery plan to the need for control over goodwill and enhanced remedies for brand owners, Mark Davis and Sebastian Beck-Watt summarized some of the most notable updates and decisions in trademarks law in 2023.

Copyright: 2023 Year in Review >

2023 was a big year for copyright law. The Federal Court issued its guidance on the use of AI, a consultation was held to assess the impact of generative AI on copyright law, the *Online News Act* ushered in a new era for broadcasting regulation in Canada. Casey Chisick, Eric Mayzel, Jessica Zagar, Alexander De Pompa, and Lina El Mugammar look into those and many other copyright developments that took place in 2023.

Chambers Global Guides: Patent Litigation > and Trademarks & Copyright >

Cassels

In addition, our lawyers joined experts from around the globe to author the Canada chapters for various guides published by Chambers & Partners.

Mark Davis, Andrew Skodyn, Sean Jackson, Kassandra Shortt, and Mackenzie Stewart authored the Canadian chapter of Chambers' 2024 Patent Litigation Guide. The full Patent Litigation chapter can be found [here](#).

Casey Chisick, Steven Kennedy, Karen MacDonald, Jessica Zagar, Sebastian Beck-Watt, Alexander De Pompa, and Steven Henderson authored the Canadian chapter of Chambers' 2024 Trademarks & Copyright Guide. The full Trademarks & Copyright chapter can be found [here](#).

Cassels Wins

Cassels Lawyers Recognized in the 2024 Lexpert/American Lawyer Guide to The Leading 500 Lawyers in Canada >

Casey Chisick (Intellectual Property – Copyright) and Mark Davis (Intellectual Property – Patents) were amongst eight Cassels lawyers included in the 2024 edition of the *Lexpert/American Lawyer Guide to the Leading 500 Lawyers in Canada*. This guide comprises an exclusive group of lawyers ranked highest in the annual Lexpert survey in practice areas of importance to an American audience.

Cassels Lawyers Named Global Elite Thought Leaders by Who's Who Legal >

Casey Chisick (Intellectual Property – Copyright) was amongst six Cassels partners named Global Elite Thought Leaders by *Who's Who Legal* (WWL). Global Elite Thought Leaders represent the best of the best of WWL research, and this ranking is achieved by only 5% of WWL-listed practitioners. We congratulate all members of our Cassels team on this achievement.

Cassels Lawyers Appointed to INTA Committees >

Eight Cassels lawyers have been appointed or re-appointed to INTA committees for 2024-2025.

Hot Off the Press

Unfounded Claims of IP Infringement Present Significant Risks: Competitor's False Amazon Infringement Notices Lead to Damages >

Making unfounded claims of intellectual property infringement to third parties can have significant repercussions. For instance, submitting unfounded complaints to Amazon or other retailers that a competitor's product infringes your patent, copyright or trademark rights can expose you to liability. Section 7(a) of the *Trademarks Act* prohibits the making of false or misleading statements about a competitor if there are not sufficient grounds for the allegations. These risks were highlighted in the recent summary trial decision of the Supreme Court of British Columbia in *Keezio Group, LLC v The Shrunk's Family Toy Company Inc.*, 2024 BCSC 64.

In Case You Missed It

Whack-A-Mole No More? Federal Court Grants Rolling Order and Third-Party Disclosure to Combat the Sale of Counterfeit Goods >

The recent Federal Court decision *Burberry Limited and Chanel Limited, et al v Ward et al* marked a significant enhancement in the remedies available to rights-holders against purveyors of counterfeit goods.

Trademarks In Québec: Draft Regulations Provide a Little More Certainty for Brand Owners >

One and a half years after the Bill 96 amendments to the *Charter of the French Language*, the Québec government has released draft regulations which has answered some questions for trademark owners. These draft regulations are open for a 45-day consultation period, and subject to any changes, the draft regulations are scheduled to come into force on June 1, 2025.

Final Regulations Under the *Online News Act* Are Now in Force >

The *Online News Act* has recently received a finalized set of regulations, titled the *Online News Act Application and Exemption Regulations*, which came into force on December 19, 2023. This finalized set of regulations is the result of the negotiated outcome between Google and the Canadian government, but the implementation of the *Online News Act* is still not completely settled. The Canadian Radio-television and Telecommunications Commission is tasked with creating a framework and code of conduct for the bargaining process, which is set to be published in the summer of 2024.

Ring In the New Year with Apostille Cheer >

As of January 11, 2024, Canada has become a member of the Apostille Convention. This increases efficiency for Canadian companies conducting business abroad by implementing a streamlined and cost-effective method to legalize corporate documents.

Federal Court Provides Guidance on Artificial Intelligence In Court Proceedings >

On December 20, 2023, the Federal Court of Canada published two new documents providing key guidance on the use of AI in court proceedings. First, the “Notice to the Parties and the Profession on the Use of Artificial Intelligence in Court Proceedings,” implements procedural safeguards for the use of generative AI by parties, counsel, and interveners in Court proceedings. Second, the “Interim Principles and Guidelines on the Court’s Use of Artificial Intelligence,” provides principles and guidelines respecting the Federal Court’s own use of AI.

ISED Minister Publishes Letter on Amendments to The *Artificial Intelligence and Data Act* >

On November 28, 2023, the text of proposed amendments to the *Artificial Intelligence and Data Act* and accompanying rationale for each amendment were published in a letter from the Minister of Innovation, Science and Industry to the Chair of the Standing Committee on Industry and Technology, providing more visibility into the direction of artificial intelligence legislation in Canada. This article summarizes the main amendments and how they may affect businesses and organizations.

Canadian Intellectual Property Office Compresses the Schedule for Trademark Oppositions and Non-Use Cancellation Proceedings >

Canada’s Trademarks Opposition Board has announced changes compressing the schedule in trademark opposition and non-use cancellation proceedings. The changes come into effect on December 1, 2023, and are intended to promote more timely and efficient proceedings.

PMPRB Announces Next Steps in Guidelines Consultation Process >

The Patented Medicine Prices Review Board (PMPRB) recently adopted its Amended Interim Guidance, providing information on how the PMPRB reviews the prices of patented medicines in Canada and will be in force until the New Guidelines are developed and implemented. The PMPRB has now announced the launch of the first phase of consultations on its new guidelines and invited stakeholders to participate in Policy Roundtable discussions.

A Few More Things...

Team News

Cassels is excited to welcome two new partners and two new associates to its growing National Intellectual Property Group.

Andrew Skodyn has joined Cassels as a partner, as a very experienced intellectual property and commercial litigator, with particular emphasis on patent litigation, trademark litigation, complex commercial disputes, product liability defence and class actions. His intellectual property litigation experience covers a wide range of industries, including pharmaceuticals and life sciences, information technology and social media, professional services, manufacturing, agribusiness, and oil and gas.

Sean Jackson has joined Cassels as a partner, specializing in complex intellectual property litigation where he represents clients from a range of industries, including pharmaceuticals, medical products, cannabis, oil and gas, and telecommunications. Sean has particular expertise in representing clients from the pharmaceutical industry in proceedings under the *Patented Medicines Notice of Compliance Regulations* (PM(NOC) Regulations). Sean has appeared before various levels of court, including the Federal Court and the Federal Court of Appeal and was part of a trial team that secured a damages award exceeding \$120 million.

Eleanor Wilson has joined Cassels as an associate, focusing on intellectual property litigation across a variety of industries, including pharmaceuticals and life sciences, technology, cannabis, and consumer goods. Eleanor regularly combines her legal expertise with her science background to advocate for clients and find creative approaches to complex issues.

Claire Stempien has joined Cassels as an associate, assisting clients with a variety of intellectual property matters. In her litigation practice, Claire has appeared in the Federal Court, Federal Court of Appeal, and the Supreme Court of British Columbia to assist clients in a number of complex matters in the areas of patents, copyright, trademarks, trade secrets/confidential information, privacy, and breach of contract.

On the Horizon

- Eric Mayzel will present on Copyright Law for the Intellectual Property Institute of Canada's Year-in-Review in IP Law 2024, taking place virtually on February 27, 2024.
- Kassandra Shortt will be attending International Women's Day Toronto, presented by Toast, on March 1, 2024.?
- ?Cassels is sponsoring the University of Toronto's "Pitch with a Twist" pitch competition for women-identifying early-stage ventures. Kassandra Shortt will be judging and presenting awards at the competition on March 6, 2024.

- Chandimal Nicholas will address “What Business Lawyers Need to Know about Intellectual Property Law” on March 19, 2024, at the Law Society of Ontario’s “Buying or Selling a Business 2024” conference.
- Mark Davis will address bad faith filings in the context of international trademarks at the DRI Business and Intellectual Property Litigation Super Conference. The conference is set to start on March 20, 2024, in Philadelphia, Pennsylvania. Kassandra Shortt and Steven Kennedy will also attend the conference.
- Mark Davis will co-chair the IP Strategy for Business arranged by IPIC and the McGill School of Continuing Studies from April to June 2024.

Where We’ve Been

- Mark Davis served as a moderator and program coordinator for IPIC’s inaugural IP Strategy Series.
- Eric Mayzel and Jessica Zagar participated at the Law Society of Ontario’s 28th Intellectual Property Law: The Year in Review event in Toronto on January 22, 2024. Eric Mayzel spoke at the “AI in an IP Legal Practice” panel. Jessica Zagar co-chaired and moderated three panels: “AI in an IP Legal Practice,” “Views from the Bench: Best Practices for Appearing Before the Federal Court on an IP Matter,” and “Copyright Update.”
- Eric Mayzel discussed Content Protection for Live Events, at the Copyright Society’s 2024 Midwinter Meeting, in Rancho Mirage, California on January 28, 2024.
- Stephen Selznick and Sebastian Beck-Watt served as panelists for the 2024 National Harold G. Fox Intellectual Property Moot on February 23 and 24, 2024. Eric Mayzel, Chandimal Nicholas, Kassandra Shortt, and Steven Henderson coached the teams from Osgoode Hall Law School.