

Cassels

Cassels on IP: September 2024

Kassandra Shortt, Steven Henderson, Claire Stempien, Andrew Skodyn, Mariam Awadalla, Omar Hamed

September 10, 2024

In this edition: A review of recent IP litigation in Canada and abroad, updates on Quebec’s much-discussed Bill 96, Cassels lawyers recognized by Managing Intellectual Property and Best Lawyers, and more...

Hot Off the Press

[**Will AI Companies Face the Music? Major US Record Labels Sue for Copyright Infringement over AI-Generated Recordings >**](#)

Two new copyright infringement lawsuits brought by the Recording Industry Association of America against two popular artificial intelligence music generation platforms in the United States have reignited the tension between the music industry and the rapidly growing AI music generation industry. The lawsuits raise several unanswered questions about the intersection between copyright law and AI-generated works which are likely to be relevant in Canada.

[**CRTC Releases Final Order Imposing Financial Contribution Requirement on Foreign Online Streaming Services >**](#)

On August 29, 2024, the CRTC published its final order following its policy decision released earlier this year establishing a base financial contribution requirement on foreign online streaming services to support Canada’s domestic film, television, and media industry. The order is effective starting with the 2024-2025 broadcasting year, meaning that all foreign online streaming services that earned more than \$25 million in annual Canadian revenue from broadcasting activities in the 2023-2024 broadcasting year will be required to make specified financial contributions to certain Canadian industry funds by August 31, 2025. The final order follows a proposed order that the CRTC first published in June 2024, [which the Cassels IP team discussed in detail here.](#)

[**The New IP Ontario “Mining Technology Patents” Report and Your Patent Strategy >**](#)

Intellectual Property Ontario recently released the “Snapshot Report: Mining Technology Patents,” providing an overview of patent rights within the global mining sector with a particular focus on stages of

Cassels

mining, critical minerals, and support service. In addition to summarizing key trends in patent filings within the mining category, the report also provides helpful recommendations and considerations relating to patent strategy in the mining sector.

Cassels Wins

[Casey Chisick Included on Billboard Canada's Power Players List >](#)

Casey Chisick, a partner and the Chair of the Intellectual Property and Entertainment, Media & Sports practices at Cassels, has been included on Billboard Canada's 2024 Power Players list. Casey is included as one of just three Legal Power Players in the country.

[Cassels' Investment in Patent Litigation Recognized by IAM Patent 1000 2024 >](#)

Cassels is excited to be recognized among Canada's leading law firms by IAM Patent 1000 2024, a go-to resource for those seeking legal patent expertise. IAM praises the firm's work on complex matters, and specifically recommends partners Andrew Skodyn and Mark Davis.

[Cassels Lawyers Recognized Among the Best in the Country by Best Lawyers 2025 >](#)

Cassels is thrilled to have had its strongest showing ever in Best Lawyers in Canada, with over 105 of our lawyers being named to the 2025 edition. Included in that list are nine lawyers from the Cassels IP Group: Casey Chisick, Mark Davis, Leonard Glickman, Steven Kennedy (ranked for the first time), Karen MacDonald, Eric Mayzel, Jennifer McKenzie, Andrew Skodyn, and Jessica Zagar (ranked for the first time). Best Lawyers is universally regarded as a definitive guide to legal excellence around the world.

[Cassels Lawyers Recognized Among the Best in the Country by Best Lawyers: Ones to Watch 2025 >](#)

Cassels is excited to announce that it also had its strongest showing ever in Best Lawyers: Ones to Watch, with 39 of our lawyers being named to the 2025 edition. Included in that list are three lawyers from the Cassels IP Group: Noah Leszcz, Kassandra Shortt and Eleanor Wilson. The Ones to Watch list recognizes practitioners for outstanding professional excellence early in their careers.

[Karen MacDonald Named Among the Top 250 Women in IP For 2024 By ManagingIP >](#)

Cassels is proud to note that partner Karen MacDonald has been honoured by Managing Intellectual

Cassels

Property as among the “Top 250 Women in IP” in the world. She is one of a select group of Canadians recognized on a listing dominated by practitioners from the United States and Europe. This list recognizes IP practitioners in private practice who have performed exceptionally for their clients and firms in 2024.

[Cassels Partners Recognized as 2024 IP Stars by ManagingIP >](#)

Cassels is excited to see multiple Cassels partners recognized as “IP Stars” by the 2024 edition of Managing Intellectual Property. This year’s listees include Casey Chisick, Mark Davis, Karen MacDonald, Chandimal Nicholas, Stephen Selznick, Andrew Skodyn, and Jessica Zagar.

Cassels Secures Multiple IP Litigation Victories

Cassels is proud to have successfully represented its clients in several intellectual property litigation matters before the Federal Court of Canada in recent months. Some of the Cassels IP team’s recent litigation victories include:

- *Louis Vuitton Malletier S.A. v. Torf*, [2024 FC 1152](#): Karen MacDonald and Claire Stempien successfully represented the Plaintiffs, Louis Vuitton Malletier S.A. and Louis Vuitton Canada Inc., in a trademark and copyright infringement action against seven individual Defendants and two corporate Defendants involved in the sale of counterfeit goods bearing the Plaintiff’s trademarks and copyright design. The Plaintiffs brought a motion for a summary trial against the Defendants after the Defendants had continued to advertise the counterfeit goods notwithstanding an injunction that had been issued against them prohibiting that activity. The Federal Court granted the Plaintiffs’ motion for a summary trial against certain of the Defendants and awarded both compensatory and punitive damages to the Plaintiffs.
- *Williams v. Music and Entertainment Rights Licensing Independent Network Ltd.*, [2024 FC 861](#) and [2024 FC 1145](#): Casey Chisick, Eric Mayzel, and Steven Henderson successfully represented three music industry Respondents in a Federal Court application brought against them for copyright infringement, as well as the subsequent costs decision. The Applicant alleged that the Respondents had infringed the copyright in the Applicant’s music catalogue by allowing it to be made available on certain online streaming services and through certain distribution methods that the Applicant claimed to have not approved. The Federal Court dismissed the application in its entirety, adopting each of the Respondents’ submissions on issues relating to copyright, contract law, and jurisdiction. The Federal Court also granted the Respondents’ requested order for an elevated costs award.
- *Red Maple Manufacturing Inc. v. Red Maple Bio Inc.*, [2024 FC 817](#): Karen MacDonald and Steven Henderson successfully represented the Applicant, Red Maple Manufacturing Inc., in an appeal from a trademark non-use cancellation proceeding decided by the Trademarks Opposition Board. The Board initially ordered that the Applicant’s trademark registration be amended to remove the associated goods due to a lack of use by the Applicant. On appeal to the Federal Court, the Applicant tendered new evidence demonstrating use of the mark in association with the relevant

Cassels

goods. The Court found that this new evidence was sufficient to satisfy the test for use, granted the appeal, and ordered that the Applicant's registration be maintained with respect to all its goods and services.

In Case You Missed It

[Trademarks In Quebec: New Regulations Offer Clarity to Brand Owners >](#)

The much-awaited final version of the regulations to Quebec's Bill 96, which amended Quebec's Charter of the French Language, was published in June 2024. The final regulations address many of the questions and concerns raised in relation to the display of non-French trademarks on products and signage since Bill 96 received royal assent.

[Where Does Infringement Arise? Untangling the Knot of Patent Infringement Limitation Periods >](#)

This article examines the Alberta Court of Appeal's decision in *JL Energy Transportation Inc. v. Alliance Pipeline Limited Partnership*, in which the Court granted the applicant leave to argue on appeal that the Court's previous decision in *Secure Energy Services Inc. v. Canadian Energy Services Inc.* should be reconsidered. That decision held that Alberta's *Limitations Act* applied to patent infringement claims and that patent infringement is not subject to a rolling limitation period. The outcome of this appeal should provide helpful guidance to parties regarding determining where an act of patent infringement arises, which limitations law applies, and the practical consequences of choosing to sue in a provincial superior court.

[CRTC Issues Final Decision: Telcos Must Provide "Fibre-to-the-Premises" Internet Network Access to Competitors >](#)

On August 13, 2024, the CRTC concluded its long-running consultation on "fibre-to-the-premises" (FTTP) internet network access by ordering certain large telecommunications companies to provide their competitors with access to their FTTP networks starting in February 2025. The order is intended to balance the need for greater consumer choice and competition in the market for internet services with the need to incentivize investment and development of fibre internet network infrastructure.

[CRTC Launches Two New Public Consultations on Accessible Programming by Online Streaming Services >](#)

On June 25, 2024, the CRTC launched two new public consultations relating to the provision of accessible programming by broadcasters in Canada as part of its efforts to modernize Canada's broadcasting

Cassels

framework following the passage of the *Online Streaming Act*. The new consultation provides further examples of the rapidly changing system under which online streaming services, including foreign streaming services, must now operate in Canada.

[CRTC Launches Public Consultation Regarding Possible Exemption from Bargaining Framework Under the *Online News Act* >](#)

Earlier this year, the CRTC held a public consultation regarding the potential grant of an exemption order from the requirement under the *Online News Act* for digital news intermediaries to participate in a mandatory bargaining process intended to compensate Canadian news businesses for sharing their news content. This public consultation, and the exemption order that may follow, will likely have significant implications for how the *Online News Act*'s requirements and exemption criteria will be interpreted by the CRTC on a go-forward basis.

A Few More Things...

On The Horizon

- [Casey Chisick](#) will present on the topic “Economic Rights Today: Technological Neutrality” at the Association Littéraire & Artistique Internationale Canada’s Centennial Symposium in Gatineau, Quebec on September 19, which is being held in celebration of the hundredth anniversary of the coming into force of Canada’s *Copyright Act*.
- [Steven Kennedy](#), [Sazia Aftab](#), and [Janice Yuen](#) are attending the Trademark Administrators & Practitioners (TMAP) Meeting taking place from September 22-24 in Philadelphia. Steven is also a panelist at this conference, discussing “Generative AI: Navigating Legal Risks and Challenges.”
- [Karen MacDonald](#) will be a panelist at the Intellectual Property Institute of Canada’s 2024 Annual Conference, taking place from September 25-27 in St. John’s, Newfoundland, where she will be discussing “Injunctions: The Good, the Bad, and the Ugly.” [Andrew Skodyn](#) and [Claire Stempien](#) will also be attending the conference.
- [Mackenzie Stewart](#) has joined the editorial team of The Journal of the Copyright Society and will draft the Journal’s Canadian updates
- [Steven Henderson](#) has been elected a member-at-large on the executive team of the Ontario Bar Association’s Information Technology and Intellectual Property Law section and will serve for the upcoming 2024-2025 term.

Where We've Been

Cassels

- [Kassandra Shortt](#) moderated a webinar on “Refusals Motions in the Federal Courts – Strategies for IP Lawyers” on September 10. The webinar was run by the Intellectual Property Institute of Canada (IPIC) and featured Associate Judge Steele and Associate Judge Duchesne of the Federal Court of Canada.
- [Eric Mayzel](#) and [Jessica Zagar](#) both presented at the Osgoode Hall Law School Intellectual Property Law & Technology Intensive Program. Eric presented on “Copyright Collective Administration & Reform” on September 4, 2024, and Jessica presented on “IP Rights in Fashion” on August 29.
- At this year's IPIC/McGill Summer IP Program, [Jennifer McKenzie](#) presented “Fundamentals of the Madrid System for Canadian Practitioners” during the Understanding Trademarks Course which ran July 8-12, and [Casey Chisick](#) presented “Technological Neutrality in Copyright” as part of the Copyright Master Class held July 22-24.
- [Mark Davis](#) was Co-Director of the IPIC/McGill School of Continuing Studies nine-week course on “IP Strategy for Business.”
- [Casey Chisick](#), [Eric Mayzel](#), and [Jessica Zagar](#) attended the Copyright Society Annual Meeting, held June 9-11 in Cleveland.
- [Chandimal Nicholas](#), [Kassandra Shortt](#), and [Dakota Bundy](#) attended the BIO International Convention, held June 3-6 in San Diego.
- [Stephen Selznick](#) wrote two articles for the June 5 edition of the INTA Bulletin (the International Trademark Association’s online publication distributed to 34,000 members each week). Stephen is the North American Co-Chairman of the INTA Bulletins Committee. His articles report on the new Federal Court of Canada Guidelines for Use of AI in Court Proceedings, and new procedural hurdles when enforcing IP rights infringement in Canada in consequence of the Supreme Court of Canada’s decision in *R. v. Bykovets* ([2024 SCC 6](#)). The August 21 edition of the INTA Bulletin also featured an article written by [Jennifer McKenzie](#) about the final version of the regulations to Quebec’s Bill 96.
- [Andrew Skodyn](#), [Sean Jackson](#), [Kassandra Shortt](#), and [Mark Davis](#) attended the CBA IP Day and Federal Courts Judges’ Dinner on May 30.
- [Stephen Selznick](#) was interviewed by CBC Radio on May 23 for comment on the alleged upstream (affecting performing artists) and downstream (affecting consumers) anti-competitive conduct and privacy issues detailed in the just issued US federal court Complaint by the US Department of Justice and several States Attorney General against Live Nation Entertainment and its subsidiary, Ticketmaster.
- [Mark Davis](#), [Steven Kennedy](#), [Karen MacDonald](#), [Jennifer McKenzie](#), [Chandimal Nicholas](#), and [Stephen Selznick](#) attended the INTA Annual Meeting from May 18-22 in Atlanta, GA.
- [Claire Stempien](#) presented “Intellectual Property and the Top Five IP Mistakes Entrepreneurs Unwittingly Make” at The Forum’s E-Series conference in May.