Cassels



Mark Davis

Partner

Contact Information

416 642 7470
mdavis@cassels.com

Office

Toronto

Expertise

- Intellectual Property
- Commercial Litigation
- U.S. Cross-Border
- Appellate Advocacy

Biography

Mark Davis* (he/him/his) is a partner in the Intellectual Property Group at Cassels. An accomplished intellectual property litigator, he is certified as a Specialist in Intellectual Property (Patents/Trademarks/Copyright) by the Law Society of Ontario. Mark offers significant experience in patent and trademark litigation, including in proceedings involving pharmaceutical and biologic products under the *Patented Medicines (Notice of Compliance) Regulations*, as well as in anti-counterfeiting, trade secret and breach of confidence, copyright and industrial design disputes. Mark has successfully argued numerous precedent-setting intellectual property cases at trial and on appeal.

Described as a “gifted appellate and trial lawyer” who “inspires confidence” and provides “smart and practical” advice, Mark is consistently recognized by clients and peers for both his trademark and patent litigation skills in publications such as *Chambers*, *Lexpert*, *IAM Patent 1000*, *WTR Trademark 1000*, *IP Stars*, *Best Lawyers in Canada,* and the *Lexpert Guide to the Leading 500 Cross-Border Lawyers in Canada*.

Mark is also a Registered Trademark Agent who designs brand strategies and manages trademark portfolios for some of the world’s largest companies.

Recent representative experience includes:

- *McCain Foods Limited v. J.R. Simplot Company*, 2019 FC 1635, 2021 FC 890, 2021 FCA 4, 2021 CanLII 58911 (SCC) – representing McCain Foods in patent litigation relating to pulsed electric field technology
- *J.R. Simplot Company v. McCain Foods Limited*, Court File No. T-569-17 – represented McCain Foods in an industrial design infringement action relating to the design of twisted potato products
- The Clorox Company – representing Clorox in Canadian litigation and brand strategy
- *Bayer Inc. v. Fresenius Kabi Canada Ltd.*, 2016 FC 581 and 2016 FC 970 – obtained an order under the *Patented Medicines (Notice of Compliance) Regulations* preventing approval of generic

equivalent to Bayer's AVELOX I.V. product – this decision is significant because it is one of the rare times a prohibition order was granted on the basis that the notice of allegation was insufficient

- *Canadian Urban Transit Association v. Dovden Investments Ltd*., Federal Court File No. T-1337-13 – successfully argued that the Canadian Urban Transit Association, an industry association, had standing to bring a patent impeachment proceeding in a representative capacity on behalf of its members against the defendant, Dovden, a non-practicing entity [patent troll] in this precedent-setting case
- *Denturist Group of Ontario v. Denturist Association of Canada*, 2014 FC 989 – successful application to expunge certain trademark and copyright registrations that were being asserted by the Denturist Association of Canada and the Denturist Association of Ontario against members of a rival professional organization
- *Meyer Housewares Canada Inc. ats. Bodum USA, Inc*., 2012 FC 1450; affirmed 2013 FCA 240 – successfully argued eight-day trademark infringement, passing off and depreciation of goodwill case – counterclaim successfully resulted in FRENCH PRESS trademark being declared invalid – marshalled overwhelming fact and expert evidence showing that French Press did not function as a trademark
- *Michael Kors, LLC v. Beyond the Rack Enterprises Inc*., 2012 FC 1355; affirmed Beyond the Rack Enterprises Inc v. Kors, 2013 FCA 107 – trademark infringement, passing off, depreciation of goodwill, unfair competition and copyright action on behalf of Michael Kors against unauthorized Internet reseller – precedent setting Federal Court of Appeal case established that "…as a practical matter BTR may well be unable to defeat MK's claims by simply asserting that it acquired the goods from an authorized distributor, without producing any supporting evidence…"
- *Timbercon, Inc. ats Oz Optics Limited*, 2011 ONCA 714 – appeal from successful trial judgment (2010 ONSC 310) in defence of breach of confidence action – the Ontario Court of Appeal reversed the trial judge on the limited issue of negligent misrepresentation

A prolific writer and popular speaker, Mark has taken active leadership roles in many important professional associations for intellectual property law in Canada and the United States. Recent publications and presentations include:

Publications

- “Costs,” Intellectual Property Disputes: Resolutions and Remedies, Toronto: Thomson Reuters Canada, 2022
- “Canadian Law of Industrial Design,” Canadian Copyright/Industrial Designs Benchbook, Second Edition, Toronto: Thomson Reuters Canada, 2022
- “Trademark Disputes,” Lexis Practice Advisor® Canada, Intellectual Property and Technology Module – practical online resource for lawyers includes precedents, checklists, practice notes and more
- “Trade-mark Litigation,” Intellectual Property Litigation Forms and Precedents, Toronto: LexisNexis, 2016
- “2015 Patent Law Year in Review,” 20th Annual Intellectual Property Law: The Year in Review, Law Society of Upper Canada, Toronto, January 21, 2016

Presentations

- “Valuing and Invention – The Supreme Court of Canada Accounts for Profits, *Nova v. Dow*, 2022 SCC 43,” Intellectual Property Institute of Canada, December 6, 2022
- “Patents and Trade Secrets – Identifying, Protecting and Enforcing Your Competitive Advantage”, Cassels IP Day, November 30, 2022
- “Summary Judgment and Summary Trial in Patent Cases,” University of Toronto’s 9 Annual Patent Colloquium, November 20, 2020
- “Financing Strategies for IP-Rich Companies,” Intellectual Property Institute of Canada webinar, November 26, 2020
- “COVID-19 & IP Practice: Insurance and Employment Issues,” Intellectual Property Institute of Canada webinar, April 14, 2020
- “Where the Shoe Pinches: The Search for Efficient Patent Trials,” Intellectual Property Institute of Canada webinar, February 15, 2019
- “Confusion about Confusion: Unpacking the Wenger Decision,” Intellectual Property Institute of Canada webinar, January 22, 2018
- “Anticipation,” Patent Case Law Review, Intellectual Property Institute of Canada webinar, 2016, 2017, 2018, 2019 and 2020

Prior to practicing law, Mark taught elementary school at The Children’s Storefront, a not-for-profit, tuition-free school in Harlem,

New York.

*Services provided through a Professional Corporation

Achievements

- *Best Lawyers in Canada* (Intellectual Property)
- *Canadian Legal Lexpert Directory* (Intellectual Property – Most Frequently Recommended, Litigation: Intellectual Property – Consistently Recommended)
- *Chambers Canada* (Intellectual Property)
- *Chambers Global* (Intellectual Property)
- *IAM Patent 1000* (Patent Litigation)
- *IAM/WTR Copyright 1000*
- *Lexology Index: Canada* (Patents)
- *Lexology Index*: *Healthcare & Life Sciences* (Patent Litigation)
- *Lexpert Special Edition*, Health Sciences
- *Lexpert Special Edition*, Litigation
- *Lexpert Special Edition*, Technology
- *Lexpert Guide to the Leading 500 Cross-Border Lawyers in Canada* (Intellectual Property)
- *Managing Intellectual Property*, IP Star (Trademark, Patent)
- *World IP Review,* WIPR Leader
- *WTR1000: The World's Leading Trademark Professionals* (Enforcement and Litigation)
- Registered Trademark Agent (2003)

Client Commentary

- "Mark stands out for being responsive and very pragmatic. He understands the commercial risk and environment and sets out great strategies." – *Chambers Canada (Intellectual Property: Litigation)*
- "Mark is very practical and always available." – *Chambers Canada (Intellectual Property: Litigation)*
- "Mark is very responsive and understanding of the issues and business." – *Chambers Canada (Intellectual Property: Litigation)*
- "Mark is great to work with, very knowledgeable and very practical and business-oriented in his advice." – *Chambers Canada (Intellectual Property: Litigation)*
- "Davis shines at trial and in appellate courts, providing practical advice at every level of proceedings." – *IAM Patent 1000 (Patent*

Litigation)

- "He is very responsive, provides practical advice and understands his clients' business models." – *Chambers Canada (Intellectual Property)*
- "Mark Davis offers very practical and strategic advice. He is a skilled and effective litigator that you can truly rely on to deliver results." – *IAM Patent 1000 (Patent Litigation)*
- "He has been amazing at helping us navigate patent litigation. Mark is great." – *Chambers Canada (Intellectual Property: Litigation)*
- "Described as a "gifted appellate and trial lawyer" who "inspires confidence" and provides "smart and practical" advice." – *Chambers Canada (Intellectual Property: Litigation)*
- "Mark Davis is responsive, practical and well regarded in his field." – *Chambers Canada (Intellectual Property: Litigation)*

Insights

- The More Things Change, The More They Stay The Same: The Supreme Court Determines the Patentability of Methods of Medical Treatment
- Federal Court Introduces Guidelines for Summary Judgment and Summary Trial Motions in Intellectual Property Proceedings
- Intellectual Property Ontario (IPON) Launches New Subsidized IP Insurance Program

Education / Bar Admissions

- LL.B., University of Victoria, 1999
- B.A. (Hons.), Western University, 1993

- Ontario, 2001

Associations

- American Bar Association (Intellectual Property Section)
- American Bar Foundation, Life Fellow
- Canadian Bar Association, Intellectual Property Law Section
- Intellectual Property Institute of Canada; Fellow, Director
- International Trademarks Association; Co-Chair, Non-Use Cancellations Task Force
- The Advocates' Society

Client Commentary

“Davis shines at trial and in appellate courts, providing practical advice at every level of proceedings.” – IAM Patent 1000 2025 (Patent Litigation)