

# THE AMERICAS

## CANADA

Bereskin & Parr LLP is a leading Canadian intellectual property law firm serving clients of all sizes in various industries, both domestic and international. The firm was founded in 1965 and has grown to be one of the largest IP law firms in Canada, with four offices in major economic or technology centres. Bereskin & Parr is made up of more than 70 lawyers and patent and trademark agents, many of whom are recognised as leading practitioners in their respective fields. Cynthia Rowden is a partner and Head of one of Canada's largest trademark teams. She specialises in all areas of trademark and copyright law. Victor Krichker is a member of the firm's Executive Committee and Electrical & Computer Technology and Mechanical & Industrial Processes practice groups. He specialises in patent and technology law.



## Meeting the intellectual challenges

**Q** Why did the firm decide to specialise in intellectual property law, one of the most challenging disciplines in the profession?

**A** Bereskin & Parr was founded by two established IP professionals in 1965. Now the firm has become one of the two largest IP boutiques in Canada, is known world-wide, and has the depth of legal talent and systems to serve clients in every aspect of patent, trademark and copyright law, and litigation.

**Q** How has the rise of China and other Asia countries – where counterfeiting is rife – affected your work?

**A** The importance of Chinese and other Asian markets cannot be ignored. Trademark protection strategies often include registration of marks in countries of use, and countries known to be a source of counterfeiting or infringement. We advise Canadian clients to pay particular attention to the protection of their trademark rights in both English and local languages, and even transliterations, in China specifically, and Asia generally. In China residents file trademarks in huge numbers (over 1.5 million in 2012), and many of those applications are identical to, or very close to leading brands in other countries. Failure to act quickly may result either in lost rights, or long and expensive battles to regain control over marks. Similarly, many of our clients are seeking patent protection in Asia in the hope that IP enforcement will improve and provide them with sound business advantages.

**Q** The Canadian market is regarded as one of the most honest and straightforward

places to do business in the world. Are there any pitfalls facing foreign companies looking to invest there?

**A** One potential pitfall is different regulatory environments, such as the Province of Quebec and its French language requirements for marketing and labeling of products sold in that province. Similarly, there are national packaging and labelling requirements that apply to all goods, or to specialised products such as drugs, medical devices and textiles. Awareness of these requirements is important.

**Q** With business becoming ever more virtual and advanced, what do you see as the main challenges facing intellectual property law in the coming years?

**A** The largest challenge for Canadian patent law is keeping up with the advancements in technology. Currently, Canadian courts are struggling with defining the type of software and computer-implemented method inventions that should be eligible for patent protection. We expect advancements in the areas of "internet-of-things" and wearable computing to continue to challenge Canadian Courts. For trademark and copyright owners, the ease of international travel and awareness of international marketing practices suggests businesses must ensure timely steps to protect their marks, including new non-traditional marks, as quickly as possible to avoid being in the position of trying to get rights back.

**Bereskin & Parr**  
INTELLECTUAL PROPERTY LAW

**Q** Your firm has won a whole clutch of accolades. Which have given you the most satisfaction?

**A** Bereskin & Parr has been recognised as a "stand-out IP boutique that conducts much of the highest-quality work that is generated in Canada" in IAM Patent 1000 – The World's Leading Patent Practitioners. However, our most significant accolade this year was when Daniel Bereskin was inducted into the Intellectual Asset Management IP Hall of Fame – the first Canadian inductee.

**Q** How has your firm helped British and European firms?

**A** The firm's U.K. and other European patent clients range from pharmaceutical multinationals to financial services companies to wind energy companies. We assist these clients with navigating aspects of Canadian patent law that are different from European patent law. We also inform them about the competitive landscape in the Canadian market. We have many British and European trademark clients, including some of the world's biggest brewers, cosmetic companies and fashion companies.

**Q** What qualities keep Bereskin & Parr at the top of the legal tree in Canada?

**A** Bereskin & Parr provides a full range of IP services which gives us the ability to apply a pragmatic business approach. Many of our professionals have advanced education in technical fields, as well as diverse industry knowledge and experience. This expertise allows us to maintain our reputation as a top-tier firm.

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