



**R. Scott MacKendrick**  
B.A.Sc. (Chem. Eng.), LL.B.

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## Experience

Scott MacKendrick is a partner with Bereskin & Parr LLP, a member of the firm's Executive Committee, and the past chair of the firm's Diversity & Inclusion Committee.

Scott's practices cover all areas of intellectual property law, with a particular focus on litigation. He has represented domestic and multinational clients in patent litigation in pharmaceutical, medical device, chemical, mechanical and software technologies, and has considerable experience in trademark, copyright, industrial design and trade secret litigation, and in domain name dispute resolution proceedings. Much of his litigation experience has been as part of international teams fighting large multinational IP disputes. He also has an active practice before the Canadian Trademarks Opposition Board, and advises clients on trademark portfolio and dispute strategies.

Scott is one of a handful of Canadian lawyers recognized for his notable skills in both patent and trademark matters. He creatively brings those skills to bear in complex and challenging disputes; and he focuses on developing effective, client-oriented strategies to get to a successful resolution as efficiently as possible. He has been described by clients, colleagues and adversaries in various independent ranking publications as: "one of the top practitioners in Canada" (*Who's Who Legal: Canada*); "a leading light in the Canadian IP space" (*WTR 1000*); "top-notch" (*Who's Who Legal: Patents*); "a super-smart litigator with a remarkable ability to anticipate adversaries' moves" (*AM Patent 1000*); "at home when acting in hefty disputes" (*IAM Patent 1000*); "[his] foresight and level-headed approach make him a superb choice for challenging enforcement mandates" (*WTR 1000*); "knows the case law back to front" (*IAM Patent 1000*); a "formidable, tenacious and classy courtroom sharpshooter" (*WTR 1000*); "a clear, attentive communicator who provides business-minded advice" (*IAM Patent 1000*); "goes above and beyond the call of duty to get the job done" (*WTR 1000*); "provides outstanding service and practical, budget-conscious advice" (*IAM Patent 1000*); a "tremendous, smart lawyer who is good at finding practical solutions that benefit all parties" (*WTR 1000*); "a very pure and balanced advocate and

## Practice Groups

Artificial Intelligence (AI)  
Chemical  
Copyright & Digital Media  
Dispute Resolution  
Industrial Designs  
Litigation  
Mechanical & Industrial Processes  
Medical Devices  
Patents  
Privacy, Cybersecurity & Data Protection  
Regulatory, Advertising & Marketing  
Trademarks

## Education

LL.B., Queen's University, 1985  
B.A.Sc. (Chem. Eng.), University of Toronto, 1982

## Qualifications

Admitted to the Ontario Bar, 1987  
Registered Canadian Trademark Agent, 1987

## Professional Memberships

American Bar Association (ABA)  
American Intellectual Property Law Association (AIPLA)  
Canadian Bar Association (CBA)  
Intellectual Property Institute of Canada (IPIC), Fellow  
International Trademark Association (INTA)  
Law Society of Ontario (LSO)  
Toronto Intellectual Property Group (TIPG)



brilliant to work with, whether on the same side or against" (*WTR 1000*); "boasts an impressive understanding of disputes in the pharmaceuticals, mechanical and chemical spheres" (*IAM Patent 1000*); and "expertly represents clients in complex trademark oppositions, enforcement, and brand protection" (*Who's Who Legal: Trademarks*).

Scott was lead counsel on *Managing IP Awards' Impact Case of the Year, 2021*, for the trademark decision in *Pentastar Transport Ltd v FCA US LLC*. In 2022, Scott received the *Lexology Client Choice Award* in the "Intellectual Property - Trademark Agents & Attorneys" category (the *Client Choice Award* recognizes those lawyers that stand apart for the excellent client care they provide and the quality of their advice and service; the criteria for this recognition focus on the ability to add real value to a clients' business above and beyond the other players in the market).

Scott is dedicated to the advancement of the IP profession. He is a past member of the International Trademark Association (INTA) Board of Directors. He is the past Chair of the INTA Board's Compensation and Benefits Committee, a past member of INTA's North America Global Advisory Council, and was, amongst other committee assignments, the co-Chair of the INTA Course on International Trademark Law and Practice. Scott is and has also been an active committee member for a number of IP organizations, including the Intellectual Property Institute of Canada (IPIC) – serving at present on its Conference Committee and its Indigenous IP Advisory Group, and having chaired other IPIC committees for more than a dozen years – as well as serving on committees of the Canadian Bar Association, the American Bar Association's Section of Intellectual Property Law, and the American Intellectual Property Law Association.

Scott is a passionate supporter of the University of Toronto. He is a member of Governing Council, the senior governance body of the University of Toronto. He is, and has been since 1999, an Adjunct Professor of Patent and Trade Secret law at the University's law school. He is a past President of the University of Toronto Alumni Association, a past Chair of the University's College of Electors, a past board member of the University of Toronto Engineering Alumni Association Executive, and has chaired and been a member of other University committees and award panels. Scott is also a recipient of the University of Toronto Arbor Award in recognition of his many contributions to the University.

Scott speaks frequently on a wide variety of intellectual property topics. He has also taught at Osgoode Hall Law School at York University and at the University of Victoria, and was repeatedly an instructor at the McGill University-IPIC Trademark Practitioner Advanced Course. Additionally, Scott is an author of numerous intellectual property publications, including co-authoring chapters on the conduct of an IP trial in *Intellectual Property Disputes, Resolutions and Remedies*, on trademark opposition proceedings in the *Canadian Trademark Law Benchbook*, and on patent law essentials for IT



in *Electronic Commerce: A Practitioner's Guide*.

### Recent Articles

- Order Vacated; Order Restored—BOMBAY FRANKIE Injunction Appeal Allowed
- The world is getting bigger – Marks that are a “place of origin” interpreted broadly by the Federal Court
- 2021 Year in Review: Key Trademark Cases in Canada
- Trademark bad faith considered by the Federal Court
- Access Copyright v York University – School’s Out! No mandatory tariff; no declaratory relief of fair dealing; and “public access to and dissemination” of works is a primary goal of copyright in Canada.

### Accolades

- Bereskin & Parr Recognized in The 2023 Lexpert®/American Lawyer Guide to the Leading 500 Lawyers in Canada
- Partners Philip Mendes da Costa and Scott MacKendrick, Winners of Lexology Client Choice Awards 2022
- Who's Who Legal: IP 2022 Recognizes B&P's Leading Professionals
- Bereskin & Parr Recognized in IAM Patent 1000 2022
- Twelve Bereskin & Parr Professionals Listed in Lexpert Special Edition - Technology and Health Sciences 2022