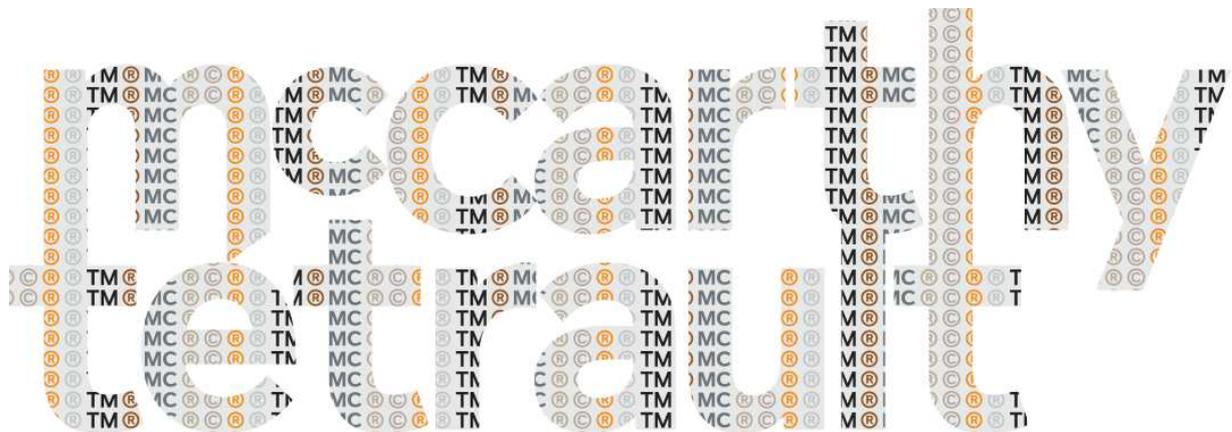


Responding to Allegations of Patent Infringement

**TIMOTHY ELLAM
KARA SMYTH
STEVEN TANNER**

MARCH 27, 2013



Responding to Allegations of Patent Infringement: e-Resources

<p><i>Patent Act and Rules</i></p>	<p>Patents are statutory instruments granted in accordance with the Patent Act and Patent Rules.</p> <p><i>Patent Act:</i> http://laws-lois.justice.gc.ca/eng/acts/P-4/index.html</p> <p><i>Patent Rules:</i> http://laws-lois.justice.gc.ca/eng/regulations/SOR-96-423/index.html</p>
<p><i>Federal Courts Act and Rules</i></p>	<p>The Federal Courts have non-exclusive jurisdiction to adjudicate patent disputes. Cases are often brought in Federal Court due to its expertise and speed in adjudicating patent cases.</p> <p><i>Federal Courts Act:</i> http://laws-lois.justice.gc.ca/eng/acts/F-7/</p> <p><i>Federal Courts Rules:</i> http://laws-lois.justice.gc.ca/eng/regulations/SOR-98-106/index.html</p>
<p><i>Alberta Rules of Court</i></p>	<p>The Alberta Court of Queen's Bench has inherent jurisdiction to adjudicate patent disputes with a proper connection to Alberta.</p> <p><i>Alberta Rules of Court:</i> http://www.albertacourts.ab.ca/LinkClick.aspx?fileticket=nE63Bp0FCIQ%3D&tabid=310</p>
<p><i>Canadian Intellectual Property Office ("CIPO")</i></p>	<p>CIPO is the government body that houses all patents and provides free resources relating to patents.</p> <p>CIPO: http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/Home</p> <p>Manual of Patent Office Practice: http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr00720.html</p>
<p><i>IP Practice</i></p>	<p>Practitioner-run website which allows for easy patent retrieval and Federal Court docket monitoring.</p> <p>Patent downloads: http://www.ippractice.ca/patent-retriever/</p> <p>Docket monitoring: http://www.ippractice.ca/file-browser/</p>

10 Steps to Effectively Respond to Any Allegation of Patent Infringement

1	Investigate business relationship with the patentee / complainant
2	Review patent portfolio for potential counterclaims
3	Retain experienced patent counsel to assess merits of threatened litigation
4	Retain a properly qualified expert in the field of technology of the patent
5	Determine potential liability
6	Project Management
7	Limit Your Potential Losses
8	Document retention
9	Consider patent impeachment action in the Federal Court
10	Consider settlement

Our Faculty



Timothy Ellam

Partner, Litigation
403-260-3533 · tellam@mccarthy.ca

Timothy St. John Ellam is a partner in our Litigation and Intellectual Property Groups in Calgary and is also a member of the Firm's Board of Partners.

Mr. Ellam advises clients over disputes relating to intellectual property, related commercial matters and with international arbitrations. He has appeared as senior litigation counsel in patent, licensing, copyright and technology related trials, arbitrations and hearings. Recent cases where he was lead counsel are recognized in *Chambers Global* (2011, 2012 and 2013) and *Lexpert* (2010). He frequently works with the Firm's London office on significant international arbitration matters and on litigation proceedings in the High Court of Justice (Commercial Court).

Mr. Ellam is also a Solicitor Advocate (Higher Courts – Civil) in the Law Society of England and Wales and holds Rights of Audience in the Higher Courts in that jurisdiction. He is an IBA Fellow in International Legal Practice; a distinction granted by the International Bar Association and the College of Law of England and Wales in 2005. He is the first lawyer in Canada to be awarded this designation.

Mr. Ellam is a member of the Law Society of Alberta, The Law Society of England and Wales, the Canadian Bar Association, the International Bar Association, the American Bar Association, the International Association of Defense Counsel, the American Intellectual Property Law Association and the Solicitors Association of Higher Court Advocates (UK). He was recently elected as a Fellow of the American Bar Foundation.



Kara Smyth

Partner, Litigation
403-260-3724 · ksmyth@mccarthy.ca

Kara Smyth is a partner in our Litigation Group in Calgary. Her practice focuses on corporate commercial, class action and intellectual property litigation.

Ms. Smyth has appeared before all levels of court in Alberta, including complex interlocutory motions, administrative reviews, trials and appeals. She has represented clients from a wide range of industries such as financial services, brokerage, oil and gas, wind farm development, commercial real estate, pharmaceuticals, agrosiences and technology in disputes concerning commercial contracts, class actions, director liability, departing fiduciary obligations, product liability and a variety of other matters concerning complex commercial transactions. Ms. Smyth has also represented clients with respect to copyright, patent and licensing disputes.

Ms. Smyth has represented clients such as: Canada Mainstream and Renewable Power; Costco Canada Liquor Inc.; Dow AgroSciences Canada; Edward Jones; Emergo; ENMAX; Hopewell Development Corp.; IROC Energy Services; NaturEner Renewable Energy; NovAtel Inc.; Olymel; Scotia Capital; Shell Canada; Spectra Energy; and TransCanada Pipelines.

Ms. Smyth is a member of the Canadian Bar Association and the Law Society of Alberta. She is also the editor and Alberta regional representative of McCarthy Tétrault's national litigation publication, Litigation Co-Counsel; and co-chair of the firm's Student Committee.



Steven Tanner

Associate, Litigation

416-601-8193 · stanner@mccarthy.ca

Steven Tanner is a senior associate in our Intellectual Property Litigation Group in Toronto. He practices exclusively in the areas of Intellectual Property and Litigation, with an emphasis on pharmaceutical patent litigation.

Mr. Tanner appears frequently in the Federal Court and Federal Court of Appeal, primarily in patent disputes.

A primary focus of Mr. Tanner's practice relates to pharmaceutical litigation brought pursuant to the PM(NOC) Regulations.

Mr. Tanner's practice also focusses on patent infringement actions relating to pharmaceuticals. Mr. Tanner's significant work on behalf of innovative drug companies includes *Abbott Laboratories Limited et al v. Janssen Inc.* (T-1310-09) which is the first Canadian biologics case.

Beyond pharmaceutical litigation, Mr. Tanner has actively represented clients in patent infringement actions in an array of diverse industries, including consumer products (as counsel for Costco Wholesale), life sciences (as counsel for Fresh Headies Internet Sales), machinery (as counsel for Beverly Turf Farms), paper products (as counsel for Kimberly-Clark) and oilfield drilling (as counsel for Wenzel Downhole Tools).

Mr. Tanner's litigation experience extends beyond patent law and includes significant representation in matters involving defamation, trade-secrets, aboriginal issues and enforcement of Anton Piller orders.

Mr. Tanner is a member of the Toronto Intellectual Property Group (TIPG), the Intellectual Property Institute of Canada (IPIC), the Law Society of Upper Canada (LSUC), the Ontario Bar Association (OBA) and the Canadian Bar Association (CBA).