

★★★ TOP BOUTIQUES ★★★



will be able to file in Canada without using Canadian law firms.

“There’s an onus on firms to prepare for this in terms of maintaining their contacts with their clients so that when there are examiners’ reports and prosecution to do, we’re top of mind and they stay with us for that work,” Sotiriadis says.

“There’s also the purely economic aspect of having to optimise to make sure you’re as nimble as possible to take the diminishing filing income that you’re going to be not getting and addressing your energies to representing local clients, Canadian clients, who might be tempted to use the treaty so they don’t have to go through firms in other countries.”

James Kosa, partner at Deeth Williams Wall, says the changes to Canada’s Trademarks Act to comply with the international Madrid Protocol are driving changes in how people register and police their marks, adding that for boutique practitioners this has been “very interesting.”

The changes include removing the “use” requirement, which has led to changes in the practice of trademark law.

“We’re seeing more registrations and more disputes or potential for disputes in trademarks,” Kosa says.

“The changes are going to be in effect soon, but we’re already seeing it happen now because people are anticipating it.”

The need for IP

Trademark Act amendments are just one of the many changes driving the need for intellectual property boutiques

By Mallory Hendry

Since *Canadian Lawyer* last listed the top intellectual property boutiques, there’s been a lot of change in the area.

Take the Madrid Protocol, an internationally recognized trademark convention that will mean trademark owners in member countries will be able to register their rights in multiple jurisdictions by filing a single application in their home countries.

The pending protocol has been on Quebec firm Robic LLP partner Bob Sotiriadis’ radar for some time now and he predicts it’s going to be a challenge for traditional IP boutiques who file trademarks on behalf of foreign applicants because those applicants



Also in the trademark space, John Simpson at Shift Law — which landed on the top 10 for the first time this survey — is seeing “very local types of businesses that haven’t been traditionally as concerned about getting national protection for their brands have been increasingly concerned with protecting their brands.”

He chalks this up to the fact that someone across the country with another localized business could go register their brand and tell the other business they have to change their name because they’ve got a trademark registration for it — and they found out because of their internet presence.

It becomes more of an issue with more businesses setting up websites, he says.

Simpson also notes he’s finding “an increasing rush by businesses in the micro-brewery and cannabis industries to jump on great brands.”

“We’re seeing a real increase in trademark applications from those industries and a corresponding increase in disputes between players in those industries — trademark oppositions and even some infringement action. That’s a reflection of where there is new economic activity.”

Sotiriadis says his firm has “made a huge effort to become the go-to firm for cannabis-related issues.”

One of his colleagues has made it a priority to be everywhere the cannabis industry is meeting and has handled a couple of patent matters for cannabis clients, Sotiriadis says.

“We’re getting consulted by general practice firms from other provinces, American lawyers, we have some smaller transactional files we’ve opened, we have some regulatory files, some patent files — things like extraction and processes and things like that — right across the spectrum of intellectual property. It’s very promising for us — we’re off on the right foot.”

For Kosa, his business is interesting because the firm not only does intellectual property but also technology law and he says the technology law section “is, for us, booming.”

Because of the complexity and breadth of emergent technologies, now more than ever before people need more specialized advice in addressing particu-

lar technologies, he notes.

“We’re getting asked to opine on things like how should we incorporate new block chain technologies into our contracts? How should we use artificial intelligence in our law practice or our clients’ practice? All these really interesting questions that revolve around brand new technologies,” he says.

Kosa says technologies are driving a lot of legal work and he thinks “there’s a lot of room in that space for agile practitioners — smaller practitioners and boutique firms.”

Change is always good for lawyers, including intellectual property lawyers, Simpson says.

“I think increasingly clients are becoming aware that some of the smaller firms, in my case very small firms, provide the same quality of service as some of the more traditional larger firms,” he says.

“It’s a good time for boutiques.”

TOP 10 INTELLECTUAL PROPERTY BOUTIQUES



Shift Law

Toronto
shiftlaw.ca

Since launching six years ago, Shift Law has had a number of litigation successes including in trademark infringement, copyright infringement and breach of confidence cases. The firm has serviced hundreds of clients, including individual artists, microbreweries, technology start-ups, an iconic Canadian clothing company and institutional clients with large trademark portfolios. Its mandates include acting for the Heart and Stroke Foundation of Canada and other charitable organizations in day-to-day intellectual property matters. Shift Law’s founder, John Simpson, credits the firm’s success to its personalized approach to client service.

“Exemplary service and professionalism.”

“Very service oriented and great attention to detail.”

“Big Law dedication to excellence in technical matters and client service, with boutique-level humanness and rate structures and flexibility.”