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BIOGRAPHICAL DATA

Daniel R. BERESKIN, Q.C.
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Date of Birth: February 2, 1938

Nationality: Canadian

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

B.Sc., Engineering Physics, University of Saskatchewan, 1962;
LLB., University of Saskatchewan, 1962.

Appointed Queen's Counsel, 1982;
Admitted to the Ontario Bar, 1964.

Registered patent and trademark attorney, Canada and USA.

LANGUAGES

English

PRESENT POSITION

Senior Lawyer, Co-founder of Bereskin & Parr LLP, a law firm practicing exclusively in Intellectual Property Law in four Canadian cities, Toronto, Montréal, Mississauga and Waterloo. Today, it is the largest IP specialist firm in Toronto and one of the two largest in Canada.

September 14, 2018

AREAS OF SPECIALIZATION

Intellectual Property Law: Trade Marks, Domain Names, Patents, Licensing, Copyright.

MEMBERSHIP IN PROFESSIONAL BODIES

Foreign Associate Member, International Trademark Association;
 Former member, Board of Directors of INTA and INTA Legal Counsel, 1999-03;
 Fellow, Patent and Trademark Institute of Canada;
 Member, Pharmaceutical Trademark Group;
 Member, Association of Professional Engineers of Ontario;
 Member, AIPPI.

EXPERIENCE IN INTELLECTUAL PROPERTY

50+ years of experience as private practitioner in all aspects of IP law and practice including litigation of patent, trade mark and copyright actions; negotiating and drafting IP licenses and joint venture agreements; settlement of IP disputes; patent and trade mark opinions; drafting and prosecuting patent and trade mark applications, and other aspects of the practice of IP law;
 Author of more than 50 papers on various intellectual property law subjects, frequent speaker at seminars in Canada, the United States of America, Europe and Japan.
 Member, Editorial Board of Trademark Reporter;
 Former Adviser, American Law Institute on a study entitled "Intellectual Property: Principles Governing Jurisdiction, Choice of Law, and Judgements in Transnational Disputes";
 Intellectual Property Adjudicator/Mediator, ADR Chambers, Toronto.
 Inducted into IAM's IP Hall of Fame 2014.
 Named "Trademarks Lawyer of the Year" worldwide for seven consecutive years by *Who's Who Legal*.
 Named as a Senior Statesmen in *Chambers Global* 2016.
 Awarded the INTA President's Award, 2004.
 Awarded IP World's World Leaders International IP Award for Lifetime Achievement.
 Received a Lifetime Achievement Award by *Managing Intellectual Property*.
 Lifetime Member, Law Society of Ontario.

EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Providing advice and assistance to others in the firm engaged in prosecuting domain name disputes.

MAJOR PUBLICATIONS

Treatise: "International Trademark Dilution", published annually by Thomson Reuters.

Articles:

"Masterpiece Revisited", Intellectual Property Journal, Volume 29 no. 3 (August 2017).

"Canada's Ill-Conceived New Trademark Law: A Venture into Constitutional Quicksand" 104 Trademark Rep. 1112 (2014).

"Anti-Dilution/Anti-Free-Riding Laws in the United States, Canada, and the EU: Bridges Too Far" 101 Trademark Rep. 1710 (2011).

"Crocker Revisited: The Protection of Trademarks of Foreign Nationals in the United States" (2004) 93 *TMR* 1;

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- “Legal Protection of Geographical Indications in Canada”, paper delivered to Annual Meeting of Intellectual Property Institute of Canada, September 2003.
- Trade Marks chapter, “Intellectual Property Disputes: Resolutions and Remedies” *Carswell*, published annually.
- “Trademark “Use” in Canada” (1997) *87 TMR 301*;
- “Famous and Well-Known Marks” *Butterworths 1997* (text by Frederick W. Mostert, chapter on Canada contributed by Daniel R. Bereskin) and of second edition published by INTA in 2004;
- “Trademark Licensing in Canada” (1995) *85 TMR 34*;
- Co-authored with Isis Caulder “The Impact of NAFTA on North American Intellectual Property Laws” (1994) *19 Journal of AIPPI Japan*, No. 5, p. 220 ();
- “Commentary on Recent Changes to the Canadian Trade-marks Act” (1994), *84 T.M.R. 186*;
- “A Comparison of the Trademark Provisions of NAFTA and TRIPs” (1993) *83 T.M.R. 1*;
- “NOTES FROM CANADA: The Lone Star Case” (1992) *TMR 270*;
- “Licensing: Defining a Relationship” *Business Transactions Involving Intellectual Property, Acquisition, Licensing and Pledging of Patents, Trademarks, Copyrights, Know-how and Other Intellectual Properties*, INSIGHT, September 25, 1991;
- “Key Employees on the Move, Protection of Confidential Information” *Corporate Counsel, New Problems - Different Solutions*, The Canadian Institute, January 17-18, 1991;
- “Employees on the Move, Check-List of Legal and Practical Issues” *Corporate Counsel, New Problems - Different Solutions*, The Canadian Institute, January 17-18, 1991;
- “NOTES FROM CANADA: Trademarks as Weapons in Battles Between “Innovative” and “Generic” Pharmaceutical Manufacturers in Canada” (1991) *81 T.M.R. 415*;
- “The Canada-United States Free Trade Agreement: Are Trademarks a Barrier to Free Trade?” (1990) *80 T.M.R 272*;
- NOTES FROM CANADA: The Case of the Corpulent Penguin” (1990) *80 T.M.R. 571*;
- “Making Known” A Foreign Trademark: Has Canada Fulfilled Its Convention Obligations?” (1989) *4 I.P.J. 329*;
- “Intent-to-Use in Canada After Three Decades” (1989) *79 T.M.R. 379*;
- “Federal v. Provincial Trade-Mark and Trade Name Rights: Is the Tension at the Breaking Point?” (1989) *6 C.I.P.Rev. 233*;
- “International Technology Joint Ventures” *New Growth Opportunities Through Technology Transfers*, INSIGHT, 89-5900078-007, November 2, 1989;
- “Brand Extension and Collateral Licensing” (1989) *22 Trademark World 3*;
- “Selection, Proper Use and Maintenance of Trade Marks” *Fundamentals of Trade Mark Practice*, The Law Society of Upper Canada, Department of Education, Toronto (#575), January 10, 1989;
- “Licensing of Trade Marks, Trade Names and Athletes” *The Business of Sports in Canada, Capitalizing on Opportunities in Dynamic Industry*, The Canadian Institute, May 8-9, 1989;
- “Merchandising Rights: Identifying the Legal Bases for Protection” *Entertainment, Advertising & Media Law*, The Law Society of Upper Canada, Continuing Legal Education, Toronto (#640), April 14-15, 1989;

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- “The Source Theory of Trademark Law: Its Effect on Trademark Licensing” (1988) 16 *Trademark World* 47;
- “A Paper on “Key Provisions in Technology License Agreements” *Domestic and International Technology Transfers, Licensing for Profit*, The Canadian Institute, May 16-17 1988;
- “Hip Hip Hooray for the COA! A Tribute to the Canadian Olympic Association” (1988) 13 *Trademark World* 1;
- “NOTES FROM CANADA: Canadian Trademark Law” (1988) 78 *T.M.R.* 410;
- “Agreements for Supporting R&D” *Research and Development, Uncovering New Opportunities*, The Canadian Institute, October 7, 1988.
- “Research and Development in Canada”, text book, *Butterworths*, 1987 (Daniel R. Bereskin, editor)
- “NOTES FROM CANADA: Judicial Interpretation of Canadian Constitution and Its Effects on Trademark Law” (1987) 77 *T.M.R.* 15;
- “Financing The Research and Development Company” *Research and Development, Achieving the Competitive Edge, Financing Options*, The Canadian Institute, October 28, 1987;
- “The Effects of Insolvency, Bankruptcy and Receivership on Rights Associated with Intellectual Property” *Impact of Insolvency on Business Relationships*, Canadian Bar Association - Ontario, Institute of Continuing Legal Education, February 6, 1987;
- “Legal Considerations: Choosing and Using Legally Defensible Trade Marks and Trade Names” *Trade Marks and Trade Names, How to Select and Clear Effective Brand and Corporate Names*, INSIGHT, 88-588094-002, November 20, 1986;
- “The Joint Venture” *Exploiting Technology, From Conception to the Marketplace*, The Canadian Institute, October 29, 1986;
- “NOTES FROM CANADA: Unauthorized Use in Canada of a Well Known United States Trademark Never Registered in Canada” (1986) 76 *T.M.R.* 173;
- “The Source Theory of Trade Mark Law and Its Effect on Trade Mark Licensing” (1987) 3 *C.I.P.Rev.* 322. (A Paper Presented at the Sixtieth Annual Meeting of the P.T.I.C., September 1986.);
- “Merchandising the Artist and the Artist’s Endorsement: Identifying the Legal Bases for Protection” *Entertainment and Sports Law*, The Canadian Bar Association - Ontario, The Institute of Continuing Legal Education, Toronto, March 24-30, 1985,
- “NOTES FROM CANADA: The Seiko Decision” (1984) 74 *T.M.R.* 454;
- “Licensing and Franchising in Canada” *How to Structure and Operate a Franchise System: The Essential Legal and Financial Components*, INSIGHT, May 17, 1984;
- “NOTES FROM CANADA: Canadian Trademark Law” (1983) 73 *T.M.R.* 332;
- “Licensing & Franchising in Canada” *Trade-Marks for the General Practitioner*, The Law Society of Upper Canada, Continuing Legal Education, Toronto, June 2, 1983;
- “The Trade Marks Act and the Constitution” (1982) 12 *P.T.I.C. Bulletin* 687;
- “NOTES FROM CANADA: A Trade Dress Trilogy” (1982) 72 *T.M.R.* 216;
- “NOTES FROM CANADA: Interpretation of “Distinctive” in Trade Mark Law” (1981) 71 *T.M.R.* 76;
- “NOTES FROM CANADA: The Common Law Tort of Passing “ (1981) 71 *T.M.R.* 59;

“NOTES FROM CANADA: The Johnny Carson Trademark Case” (1980) 70 *T.M.R.* 165;

“NOTES FROM CANADA: Canadian Trademark Law” (1979) 69 *T.M.R.* 183;

“NOTES FROM CANADA: Canadian Trademark Law” (1978) 68 *T.M.R.* 89;

“NOTES FROM CANADA: Canadian Trademark Law” (1977) 67 *T.M.R.* 301;

“NOTES FROM CANADA: Canadian Trademark Law” (1976) 66 *T.M.R.* 546;

“Trademark Licensing and Registered Users in Canada” (1973) 63 *T.M.R.* 313;

“Trademark Licensing and Registered Users in Canada” (1973) 33 *P.T.I.C. Bulletin* 366;

“The Registrability of Surnames” (1966) 18 *P.T.I.C. Bulletin* 8;

OTHER

“Intellectual Property”, a quarterly, *Federated Press*, 1994, Montreal as part of their “Corporate Law” series (Daniel R. Bereskin, Editor-in-Chief).

EXPERIENCE IN COURT LITIGATION

Extensive experience over past 50+ years in IP litigation including major patent and trade mark litigations, and appearances before the Supreme Court of Canada.

PROFESSIONAL TRAINING IN MEDIATION

Completed CPR Institute for Dispute Resolution training program.

EXPERIENCE IN MEDIATION

Counsel to IP clients for decades in mediations and negotiations of IP disputes.
