



Alan Macek

Partner
PATENT AGENT AND TRADE-MARK AGENT

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Alan Macek practises intellectual property litigation and patent prosecution, with a focus on electrical and computer-related technology.

Alan has litigated cases in the Federal Court, Federal Court of Appeal and the Ontario Superior Court. His experience in litigation often involves cross-border proceedings, and he frequently works closely with counsel from the United States to coordinate parallel lawsuits.

Alan publishes a blog and daily email on developments in intellectual property law in Canada and is a regular columnist for *Slaw* on issues in intellectual property.

Prior to earning his J.D., Alan worked at several computer and communication engineering firms.

LANGUAGES SPOKEN

- English

EXPERIENCE

- *E. Mishan & Sons Inc. et al. v. Supertek Canada Inc. et al.* (T-1112-13) – represented the patentee and a licensee in a patent infringement proceeding relating to consumer products
- *Magna Powertrain Inc. v. Stackpole Powertrain International ULC* (T-1274-12) – represented a patentee in asserting an automotive oil pump patent against a competitor
- *Valence Technology Inc. v. Phostech Lithium Inc.* (T-219-07) – represented a patentee assert its patent on lithium-ion battery technology
- *Spin Master Ltd. v. Mattel Inc.* (T-1231-17) and *Spin Master Ltd. v. Alpha Group* (T-222-18) - represented the patentee, Spin Master Ltd., in the enforcement of its patent relating to its successful Bakugan toys
- *Tivo Solutions Inc. and Rovi Guides Inc. v. Videotron Ltd* (T-921-17) - represented Videotron against patent infringement allegations relating to electronic program guides and personal video recording technology

RELATED SERVICES

- Intellectual Property and Technology
- Patent Litigation
- Patent Prosecution and Strategic Patent Counseling
- Trademark and Copyright

RELATED SECTORS

- Technology
- Financial Services

LANGUAGES SPOKEN

English

CREDENTIALS

Admissions

- Ontario, 2006

Recognitions

- *Best Lawyers in Canada* (Intellectual Property) 2021
- *Canadian Legal Lexpert® Directory* (Intellectual Property; Litigation: Intellectual Property), 2019-2020
- *The Legal 500 Canada* (Intellectual Property), 2019-2020
- IP Star (Patent), *Managing Intellectual Property*, 2018-2020
- *IAM Patents 1000*, (Litigation) 2016-2019

Education

- J.D., University of Toronto , 2005
- B.A.Sc. (Computer Science Option, Math Honours with Distinction), University of British Columbia, 2002

Memberships

- Chair, Canadian Bar Association Patents Committee
- Member, Canadian Bar Association
- Member, Toronto Intellectual Property Group
- Member, American Intellectual Property Law Association
- Fellow, Intellectual Property Institute of Canada and its Information, Communication & Technology Committee

INSIGHTS

Publications

Canadian Patent Office's approach to computer-implemented inventions rejected by Federal Court

9 SEP 2020

The Federal Court has criticized the Canadian Patent Office's approach to patentable subject matter and ordered the subject patent application re-assessed under a different test.

Cost deferral and other strategies for your patent portfolio during COVID-19

4 JUN 2020

While COVID-19 has changed the way the world works in a matter of months, it is clear that the importance and value of innovation has not been affected by the crisis. It is the businesses that best position themselves and protect their innovations during this time that are likely to emerge stronger than ever. This article outlines a variety of cost-effective solutions for protecting inventions even when finances are limited.

Trade Secrets in Canada - now strengthened with criminal remedies

24 MAR 2020

Trade secrets are often considered the forgotten intellectual property when it comes to litigation and enforcement. With work forces at home these days, connecting into corporate computer systems using their personal devices, the risk of trade secrets being misappropriated or stolen is higher than ever. Fortunately, Canada recently implemented criminal enforcement provisions for trade secrets. On March 13, 2020, Bill C-4, the United States-Mexico-Canada (USMCA) trade agreement implementation legislation received royal assent, providing greater protection and offering additional remedies for parties that have suffered losses related to trade secrets being exposed through theft, misappropriation or other fraudulent means.

Deadlines suspended at the Canadian Intellectual Property Office

23 MAR 2020

Reflecting the uncertainty around the COVID-19 pandemic, the Canadian Intellectual Property Office has suspended certain deadlines for patents, trademarks and industrial designs.

Canadian patent rules streamlined

2 OCT 2019

New Patent Rules and associated amendments to the Patent Act will come into force on October 30, 2019. These new rules are intended to modernize and standardize the patent prosecution process in Canada, including by implementing the Patent Law Treaty.

Patents on the blockchain - Bitcoin and beyond

29 MAY 2017

Disruptive technologies have transformed the global economy, and will continue to do so at exponential rates. Innovators at the cutting edge of these technologies should carefully review their patenting strategy, or risk being pushed out of emerging market opportunities.

- Co-author, "Risks and Benefits of Blockchain Patents", *Electronic Commerce & Law Report*, July 5, 2017
- "Protecting FinTech Innovation," *Slaw*, January 2017
- Co-author, Intellectual Property chapter, *Canadian Commercial Law Guide*, CCH
- "Jail time used in trademark enforcement," *The Lawyers Weekly*, November 25, 2016
- "Is File History Estoppel Coming to Canada?," *Slaw*, September 2016
- Co-author, "Protecting websites in the copycat age," *The Lawyers Weekly*, June 2015
- "Overhaul of Intellectual Property Legislation," *Slaw*, January 2015
- Co-author, "Patents", *Intellectual Property Disputes: Resolutions and Remedies* (Toronto: Ontario: Thomson Reuters)

Events

Previous

3D Printing in the Intellectual Property Landscape

25 Apr 2019

- Panelist, "The Virtual IP Court Hearing: What You Should Know Before You 'Zoom' into Court", Intellectual Property Institute of Canada, July 10, 2020
- Speaker, "Ethical Dilemmas in IP," 23rd Intellectual Property Law: The Year in Review, Law Society of Ontario, January 17, 2019
- Speaker, "Your Comprehensive Guide to Blockchain", Ontario Bar Association, June 18, 2018
- Speaker, "Bitcoin, Blockchain, and IP Law", *CBA Intellectual Property Section*, The Canadian Bar Association, May 31, 2018
- Speaker, "Blockchain, Smart Contracts & AI: Legal Challenges and Opportunities in Emerging Technologies", Ontario Bar Association, February 7, 2018
- Speaker, "Updating Your Toolkit for Fighting Obviousness Issues Post-Sanofi", Intellectual Property Institute of Canada Annual Meeting, October 12, 2017
- Co-presenter, "Are you protecting your intellectual property?", Toronto Public Library - Small Business Network, March 29, 2017
- Co-presenter, "Decoding the Framework of Double Patenting: Legal Issues and Insights Uncovered!", The Knowledge Group, October 24, 2016

NEWS

DLA Piper Canada increases rankings in 2021 edition of *Best Lawyers in Canada*

28 AUG 2020

DLA Piper (Canada) LLP is pleased to see 79 of our lawyers across 35 practice areas recognized in the 2021 *Best Lawyers in Canada* guide, resulting in our best showing with the guide since its inception.

DLA Piper (Canada) LLP recognized for expertise in intellectual property law by *Managing IP 2020*

10 JULY 2020

Four DLA Piper (Canada) LLP lawyers have been recognized as IP STARS and our Intellectual Property and Technology (IPT) Group has been recognized for its expertise in intellectual property law in *Managing Intellectual Property IP STARS' 2020* global rankings.

DLA Piper patent litigators conduct Federal Court's first virtual trial

22 JUN 2020

DLA Piper's team of patent litigators made history this month by representing their client, Videotron Ltd, in the Federal Court's first virtual trial (*Rovi Guides Inc. v. Videotron Ltd.*, T-921-17). The patent infringement proceeding involved multiple patents on interactive television program guides.

IAM Patent 1000 recognizes Bruce Stratton and Alan Macek for their expertise in patent litigation

16 JUN 2020

The 2020 edition of *IAM Patent 1000 - The World's Leading Patent Practitioners* has recognized Bruce Stratton and Alan Macek for their depth of expertise and market-leading legal advice in the area of patent litigation.

DLA Piper (Canada) LLP increases rankings in the 2020 *Canadian Legal Lexpert Directory*

24 APR 2020

DLA Piper (Canada) LLP is pleased to announce that we have significantly increased the number of lawyers ranked as leading practitioners in the 2020 edition of the *Canadian Legal Lexpert Directory*.

DLA Piper (Canada) LLP recommended in the 2020 edition of the *Legal 500 Canada*

14 NOV 2019

DLA Piper (Canada) LLP has been recommended across a broad range of practice areas in the latest edition of the *Legal 500 Canada*.

DLA Piper (Canada) LLP recognized as a leader in patent laws by *IAM Patent 1000*

12 JUN 2019

The 2019 edition of *IAM Patent 1000 - The World's Leading Patent Practitioners* has recognized DLA Piper (Canada) LLP and four members of its Intellectual Property and Technology (IPT) Group as leaders in the Canadian patent market.

***Managing IP 2019* recognizes DLA Piper (Canada) LLP as a leader in Intellectual Property law**

21 MAY 2019

DLA Piper (Canada) LLP is pleased to see four of our lawyers recognized as IP STARS and our Intellectual Property and Technology (IPT) Group recognized as a leading firm in *Managing Intellectual Property* IP STARS' 2019 global rankings.

DLA Piper (Canada) LLP ranked in 2019 *Canadian Legal Lexpert Directory*

3 MAY 2019

DLA Piper (Canada) LLP is pleased to announce that thirty-eight of the firm's lawyers have been recognized as leading practitioners in the 2019 edition of the *Canadian Legal Lexpert Directory*.

DLA Piper advises Seequent Limited on its acquisition of Canadian software company Geosoft

19 FEB 2019

DLA Piper has advised Accel-KKR and its portfolio company, Seequent Limited ("Seequent"), in connection with Seequent's acquisition of Geosoft, a Canadian-based software company.

DLA Piper (Canada) LLP recognized in 2019 *Legal 500 Canada guide*

7 DEC 2018

DLA Piper (Canada) LLP is pleased to announce that 42 firm lawyers across 17 practice areas have been recommended in the

latest edition of the *Legal 500 Canada*.

MEDIA MENTION

- Quoted, "Virtual patent trials: what we can learn from Canada", *Managing Intellectual Property*, July 2020
- Quoted, "Proceedings in first-ever Zoom trial at Federal Court met with praise by judge, counsel", *The Lawyer's Daily*, June 26, 2020
- Quoted, "Free Trade deal impacts IP", *Law Times*, December 10, 2018
- Quoted, "Canada's Patent Agreement with Europe Extended until 2021", *The Lawyers Daily*, February 16, 2018
- Quoted, "Cases to look out for in 2017 – Canada", *Managing Intellectual Property*, January 2017
- Quoted, "IP law changes coming after Europe deal", *Law Times*, December 5, 2016