



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, the Ontario Superior Court and the Court of Queen's Bench of Alberta. 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 founded and publishes the **IPPractice** blog and daily email on developments in intellectual property law in Canada and is a regular columnist for **Slaw** on issues in intellectual property.

Alan works with clients on all aspects of the patent process, from preparing and filing patent applications, strategic advice on developing a patent portfolio, patent landscaping, non-infringement and validity opinions, as well as defending or advancing patent litigation. He is frequently invited to speak on intellectual property topics including issues for emerging technology such as blockchain/cryptocurrencies and AI/machine learning.

Prior to earning his J.D., Alan studied engineering physics and math, as well as worked at several computer and communication engineering firms.

LANGUAGES SPOKEN

- English

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

- Technology
- Financial Services

English

- *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 including in Canada's first virtual patent trial
- *Canadian Energy Services Inc v Secure Energy Services Inc* (2020 ABQB 473) - represented the patentee, CES, in patent infringement proceedings relating to downhole oil and gas technology
- WRNCH Inc. - assisting with patent strategy and patent prosecution on computer vision technology (US10,949,658)
- *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

- *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
- *Data Treasury Corporation v Royal Bank of Canada et al* (T-1472-07) - represented several of the banks in defending patent infringement litigation relating to computerized check processing technology

CREDENTIALS

Admissions

- Ontario, 2006

Recognitions

- *Best Lawyers in Canada* (Intellectual Property Law) 2021-2023
- *Canadian Legal Lexpert® Directory* (Intellectual Property; Litigation: Intellectual Property), 2019-2022
- *Lexpert® ALM 500 Directory* (Intellectual Property), 2022
- *The Legal 500 Canada* (Intellectual Property), 2019-2020, 2022
- IP Star (Patent), *Managing Intellectual Property*, 2018-2022
- *IAM Patents 1000*, (Litigation) 2016-2022

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
- IEEE Member
- Fellow, Intellectual Property Institute of Canada and its Information, Communication & Technology Committee

INSIGHTS

Publications

Canada introduces legislation to regulate artificial intelligence systems

20 June 2022

As part of its re-introduced privacy legislation Bill C-27, the government has proposed a new *Artificial Intelligence and Data Act*. AIDA, if it becomes law, would be the first broad based regulation of artificial intelligence systems in Canada. It would address potential privacy and bias harms of artificial intelligence based systems, particularly for 'high-impact systems', by implementing certain safeguards, and penalties for improper or reckless use. At the same time, it could have unintended application to a broader range of cloud or neural network-based technologies that need to be carefully considered.

Budget 2021 encourages intellectual property in Canada

7 June 2021

In April 2021, the Canadian government released *Budget 2021: A Recovery Plan for Jobs, Growth, and Resilience*, which would encourage innovation in Canada with several new programs relating to intellectual property.

Canadian Intellectual Property Office issues Practice Notice regarding patentable subject matter

10 November 2020

The Canadian Intellectual Property Office has issued updated guidance to its patent examiners on reviewing patent applications for patentable subject matter. This is of particular significance to computer-implemented, medical diagnostic and medical use inventions.

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.

- Contributor, "Patent Litigation 2022," *Chambers Global Practice Guides*
- Canadian Patent Office's approach to computer-implemented inventions rejected by Federal Court, 9 Sep 2020
- Trade Secrets in Canada - now strengthened with criminal remedies, 24 Mar 2020
- Deadlines suspended at the Canadian Intellectual Property Office, 23 Mar 2020
- Canadian patent rules streamlined, 2 Oct 2019
- "Federal Court's Jurisdiction over contractual intellectual property issues", *Slaw*, November 2020
- 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
- Co-author, "Patents", *Intellectual Property Disputes: Resolutions and Remedies* (Toronto: Ontario: Thomson Reuters)
- Co-author, "Computer-Related Disputes", *Intellectual Property Disputes: Resolutions and Remedies* (Toronto: Ontario: Thomson Reuters)

Events

- Panelist, "Are the Robots Taking Over? A Debate that AI Be Considered a Creator/Inventor" Intellectual Property Institute of Canada, Annual General Meeting, September 29, 2022
- Panelist, "IP Blogs: the most efficient tool for sharing IP knowledge worldwide", World IP Forum, April 26 to May 5, 2021
- Panelist, "Patent Litigation by Zoom, Pros and Cons", Ninth Annual University Toronto Patent Colloquium, November 20, 2020
- Speaker, "Dealing with Experts Remotely - the Virtual Trial", Ontario Bar Association, November 18, 2020
- Panelist, "File Wrapper Estoppel in Canada and the United States: What You Say Can and Will Be Used Against You", Intellectual

Property Institute of Canada, Annual General Meeting, October 2, 2020.

- 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 successfully defends Videotron in patent infringement case before Federal Court

23 June 2022

DLA Piper Canada has successfully defended Videotron Ltd. in a patent infringement trial in Federal Court. Videotron is a Quebec-based integrated communications company with well over one million television subscribers.

Eight DLA Piper Canada lawyers named leading lawyers in the 2022 *Lexpert Special Edition on Technology and Health Sciences*

17 June 2022

DLA Piper (Canada) LLP is pleased to announce that eight of our lawyers were recognized as leaders in the technology and health sciences sectors in this year's *Lexpert Special Edition on Technology and Health Sciences*.

DLA Piper Canada successfully represents Canadian Energy Services in patent ownership attack

13 June 2022

DLA Piper (Canada) LLP successfully represented its client, Canadian Energy Services (CES) at the Alberta Court of Appeal, where the attack on CES's ownership of a patent to certain downhole antiaccretion technology was dismissed. In *Secure Energy Services Inc. v Canadian Energy Services Inc.*, 2022 ABCA 200, a majority of the court upheld the findings of the chambers judge that the allegations made by Secure Energy Services regarding ownership of the patent were made outside the time periods permitted by the Alberta Limitations Act as well as foreclosed by a contractual release made between the parties.

DLA Piper Canada practitioners recognized as intellectual property leaders by *Managing IP*

6 June 2022

We are proud to announce DLA Piper Canada Intellectual Property (IP) practitioners have once again been recognized by *Managing Intellectual Property Stars* (MIP Stars) as industry leaders in IP. The firm has been named for its outstanding service in both Patent and Trademark Contentious and Trademark Prosecution categories, and four IP Partners have been recognized as 2022 *MIP Stars*.

Leading Canadian patent lawyers contribute to Chambers Global Practice Guide on Patent Litigation

7 April 2022

Members of DLA Piper (Canada) LLP's team of leading patent lawyers have contributed to the Canada section of the 2022 Chambers Patent Litigation Global Practice Guide.

DLA Piper Canada lawyers recognized in 2022 *Canadian Legal Lexpert Directory*

March 4, 2022

DLA Piper (Canada) LLP is pleased to announce our lawyers have been ranked as leading practitioners in the 2022 edition of the *Canadian Legal Lexpert Directory*.

Four DLA Piper (Canada) LLP partners recognized in the 2022 *Lexpert®/ALM 500 Directory*

7 January 2022

DLA Piper (Canada) LLP is pleased to announce that the 2022 *Lexpert®/American Lawyer Guide to the Leading 500 Lawyers in Canada* has recognized Howard Krupat (Construction), Alan Macek (Intellectual Property), Bruce Stratton (Intellectual Property) and Kevin Wright (Competition) as leaders in their field.

DLA Piper Canada recommended by *Legal 500 Canada 2022*

12 November 2021

DLA Piper (Canada) LLP and its lawyers have been recommended in the latest edition of the *Legal 500 Canada*.

DLA Piper (Canada) LLP recognized in the 2022 *Best Lawyers in Canada* guide

26 August 2021

DLA Piper (Canada) LLP is thrilled to see 84 of our lawyers across 35 practice areas recognized in the 2022 *Best Lawyers in Canada* guide.

Leading global IP ranking guides recognize DLA Piper Canada lawyers as top practitioners

8 July 2021

DLA Piper Canada has once more been recognized for its expertise and depth of experience in the area of intellectual property by leading guides, *Managing Intellectual Property* and *IAM Patent 1000*.

DLA Piper Canada has strong showing in 2021 *Canadian Legal Lexpert Directory*

22 April 2021

DLA Piper (Canada) LLP has increased their rankings in the *Canadian Legal Lexpert Directory* for the third consecutive year.

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