



Education

McGill University (1999) BCL/LLB
Tufts University (1995) BA

Bar Admissions

Ontario (2001)

Practice Areas

Intellectual Property
Commercial Litigation

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Jordana Sanft

JORDANA SANFT

is a partner at Lenczner Slaght.

"[Jordana] Sanft excels at unravelling the most convoluted life sciences questions and impresses with her keen eye for detail and practical problem-solving approach. " — *IAM Patent 1000*

Jordana co-leads the firm's Intellectual Property group, bringing over 20 years of experience in patent, trademark, and copyright disputes. She is known for developing strategic, creative, and client-focused solutions to achieve success and advance client objectives. Jordana treats her clients as partners, offering practical and strategic advice, and achieving successful results in and out of the courtroom.

Jordana regularly acts in patent impeachment and infringement actions, including proceedings under the *Patented Medicines (Notice of Compliance) Regulations*. Jordana has particular expertise in the pharmaceutical and life sciences industry having worked on some of the most complex cases in Canada. Jordana led the first litigation proceedings in a series of challenges under the amended *PM(NOC) Regulations*. Drawing on deep industry expertise, Jordana also represents clients in judicial review proceedings, regulatory matters, and damages actions. Her IP experience spans a wide range of industries including technology, biotechnology, consumer products, energy, packaged goods, hospitality, and agriculture.

As part of her approach in leading IP litigation matters, Jordana engages with clients to optimize success on a local and global level. She is regularly involved in multi-jurisdictional matters and works to overcome cross border challenges. Jordana also works closely with clients in the pre-litigation context, by providing advice and devising sophisticated early-litigation strategy. Jordana seeks to protect and enforce intellectual property rights.

Jordana has an interest in legal issues at the intersection of IP and artificial intelligence and is a frequent writer and speaker in this space. Jordana is very active in the legal and IP community including as an invited speaker, writer, committee member and Chair, Director, and mentor.

Jordana has appeared as counsel in matters before the Federal Court of Appeal, the Federal Court, the Ontario Superior Court of Justice, and specialized tribunals such as the Trademarks Opposition Board. Jordana is a registered patent and trademark

agent.

RECOGNITION

- Chambers Global (2020-2025)
Intellectual Property – Litigation (Canada)
- Chambers Canada (2020-2025)
Intellectual Property: Litigation (Nationwide – Canada), Life Sciences: IP/Patent Litigation (Nationwide – Canada) (2022)
- Canadian Legal Lexpert® Directory (2018-2025)
Intellectual Property (Most Frequently Recommended), Litigation - Intellectual Property (Consistently Recommended), Life Sciences & Health (Consistently Recommended)
- Lexpert Special Edition: Canada's Leading Technology Lawyers (2021-2025)
- Lexpert Special Edition: Canada's Leading Health Sciences Lawyers (2021-2025)
- Best Lawyers in Canada (2015-2025)
Intellectual Property
- IAM Patent 1000 (2019-2020; 2022-2025)
Patent Litigation: Recommended Individual (Gold)
- Lexology Index: Canada (2018-2025)
IP – Patents (Global Leader), Life Sciences – Patent Litigation (Global Leader), Patents (National Leader), Patent Agents, Life Sciences (National Leader)
- Lexpert Guide to the Leading 500 Cross-Border Lawyers in Canada (2024-2025)
Intellectual Property
- Lexpert Special Edition: Canada's Leading Litigation Lawyers (2022-2024)
- LMG Life Sciences (2016)
Canadian IP Contentious Impact Case of the Year (*Gilead Sciences Inc v Idenix Pharmaceuticals Inc*)
- LMG Life Sciences (2021)
Canadian Patent Impact Case of the Year (*Natco Pharma v Minister of Health and Gilead Sciences*)
- LMG Life Sciences (2023-2024)
Intellectual Property; Shortlisted for Patent Litigator of the Year (Canada) (2023)
- Managing Intellectual Property: IP STARS (2015-2025)
Patent Star – Canada, Trademark Star – Canada, Top 250 Women in IP (2018 and 2020)
- The Legal 500 Canada (2023 - 2025)
Intellectual Property (Leading Partner)

SELECT CASES

- **Gilead Sciences, Inc et al v Apotex Inc** – Counsel to Gilead Sciences, Inc. and Gilead Sciences Canada, Inc. in a NOC action in the Federal Court in respect of Canadian Patent Nos. 2,845,553 and 2,990,210.
- **Gilead Sciences, Inc et al v Apotex Inc** – Counsel to Gilead Sciences, Inc. and Gilead Sciences Canada, Inc. in a NOC action in the Federal Court in respect of Canadian Patent No. 2,845,553.
- **Gilead Sciences Inc, et al v JAMP Pharma Corporation** – Counsel to Gilead Sciences, Inc. and Gilead Sciences Canada, Inc. in a NOC action in the Federal Court in respect of Canadian Patent No. 2,845,553.
- **Gilead Sciences, Inc et al v JAMP Pharma Corporation** – Counsel to

- Gilead Sciences, Inc. and Gilead Sciences Canada, Inc. in a NOC action in the Federal Court in respect of Canadian Patent No. 2,990,210.
- **Gilead Sciences, Inc et al v Natco Pharma (Canada) Inc** – Counsel to Gilead Sciences, Inc. and Gilead Sciences Canada, Inc. in a NOC action in the Federal Court in respect of Canadian Patent No. 2,845,553.
 - **Gilead Sciences, Inc et al v Natco Pharma (Canada) Inc** – Counsel to Gilead Sciences, Inc. and Gilead Sciences Canada, Inc. in a NOC action in the Federal Court in respect of Canadian Patent Nos. 2,845,553 and 2,990,210.
 - **Gilead Sciences, Inc et al v Pharmascience Inc** – Counsel to Gilead Sciences, Inc. and Gilead Sciences Canada, Inc. in a NOC action in the Federal Court in respect of Canadian Patent Nos. 2,845,553 and 2,990,210.
 - **Gilead Sciences, Inc et al v Pharmascience Inc** – Counsel to Gilead Sciences, Inc. and Gilead Sciences Canada, Inc. in a NOC action in the Federal Court in respect of Canadian Patent No. 2,845,553.
 - **Janssen Inc v The Ministry of Health and Attorney General of Canada** – Counsel to the applicant Janssen Inc. in two applications for judicial review to the Federal Court addressing the interpretation and vires requirements for listing patents on the Patent Register under the *Patented Medicines (Notice of Compliance) Regulations*.
 - **Janssen Inc v The Ministry of Health and Attorney General of Canada** – Counsel to Janssen Inc. in appeal of judicial review application to the Federal Court of Appeal addressing the interpretation and vires requirements for listing patents on the Patent Register under the *Patented Medicines (Notice of Compliance) Regulations*.
 - **7912854 Canada Inc v Sunprotection Group Inc et al** – Counsel to leading window coverings designer and manufacturer, Altex, in a trademark infringement, passing off, false advertising, trade libel and unfair competition action in the Federal Court of Canada.
 - **7912854 Canada Inc v Sunprotection Group Inc et al** – Counsel to leading window coverings designer and manufacturer, Altex, in a commercial action in the Superior Court of Canada, related to intentional interference with contractual relations, and misappropriation of confidential and proprietary information.
 - **Akebia Therapeutics, Inc v Fibrogen Inc** – Counsel to FibroGen Inc. and AstraZeneca AB in an impeachment action in the Federal Court in respect of Canadian Patent Nos. 2,468,083, 2,467,689, and 2,526,496. *(Prior to joining Lenczner Slaght.)*
 - **Fresh Baked Goods** – Counsel to Steven Page (formerly of the Barenaked Ladies) in an action in the Ontario Superior Court in regard to a copyright authorship action commenced by Ed Robertson pertaining to the hit theme song from The Big Bang Theory. *(Prior to joining Lenczner Slaght.)*
 - **Merck Canada Inc. v The Minister of Health** – Counsel to Merck Canada Inc. in a judicial review proceeding in the Federal Court in regards to patent listing for KEYTRUDA. *(Prior to joining Lenczner...*
 - **Natco Pharma (Canada) Inc v Canada (Health)** – Counsel to Gilead Sciences Inc. in a judicial review proceeding in the Federal Court, which was the first ever challenge of data protection for anti-HIV combination drug therapies in respect of DESCovy. Successfully upheld data protection. *(Prior to joining Lenczner Slaght.)*

- **Alberta Innovates Technology Futures v Connacher Oil and Gas Limited** – Counsel to Connacher Oil and Gas Limited in a patent infringement action commenced by Alberta Innovates-Technology Futures in regard to Canadian Patents 2 323 029 and 2 391 721. *(Prior to joining Lenczner Slaght.)*
- **Premier Tech** – Counsel to Premier Tech in regard to trademark portfolio strategy, pre-litigation advice and enforcement, opposition proceedings and other trademark prosecution matters, and trademark litigation. *(Prior to joining Lenczner Slaght.)*
- **Genentech Inc. et al v Amgen Canada Inc.** – Counsel to Hoffmann-La Roche Limited and Genentech, Inc. in various Federal Court actions under the new PMNOC Regulations in respect of trastuzumab (HERCEPTIN), which were the first actions under the new regime. *(Prior to joining Lenczner Slaght.)*
- **Genentech Inc. et al v Celltrion Healthcare Co, Ltd.** – Counsel to Hoffmann-La Roche Limited and Genentech, Inc. in various Federal Court actions under the new PMNOC Regulations in respect of trastuzumab (HERCEPTIN), which were the first actions under the new regime. *(Prior to joining Lenczner Slaght.)*
- **Eli Lilly v Various Generic Companies** – Counsel to Eli Lilly and Company in various Federal Court proceedings in respect of teriparatide (FORTEO). *(Prior to joining Lenczner Slaght.)*
- **Hoffmann-La Roche Limited and Genentech, Inc v Various Biosimilar and Generic Companies** – Counsel to Hoffmann-La Roche Limited and Genentech, Inc. in various Federal Court proceedings in respect of bevacizumab (AVASTIN). *(Prior to joining Lenczner Slaght.)*
- **Gilead Sciences Inc v Idenix Pharmaceuticals Inc** – Counsel to Gilead Sciences Inc in the Federal Court and Federal Court of Appeal (leave to SCC denied) proceeding in respect of sofosbuvir, successfully invalidating Idenix's '191 patent and maintaining Gilead's '657 patent. *(Prior to joining Lenczner Slaght.)*
- **Apotex Inc v Pfizer Canada Inc** – Counsel to Pfizer in a summary judgment motion regarding latanoprost (XALATAN), successfully upholding the validity of Pfizer's '132 patent on summary judgment. *(Prior to joining Lenczner Slaght.)*
- **Merck & Co et al v Apotex Inc** – Counsel to Merck & Co., et al in a patent infringement action in the Federal Court and Federal Court of Appeal (leave to SCC denied) relating to lisinopril. *(Prior to joining Lenczner Slaght.)*
- **Merck & Co et al v Apotex Inc** – Counsel to Merck & Co. and AstraZeneca in a damages reference action in the Federal Court regarding lisinopril and prinitiv. *(Prior to joining Lenczner Slaght.)*
- **Glaxosmithkline Inc et al v Pharmascience Inc et al** – Counsel to Glaxosmithkline Inc. in various proceedings in the Federal Court including regarding valacyclovir hydrochloride (VALTREX). *(Prior to joining Lenczner Slaght.)*
- **Glaxosmithkline Inc v Apotex Inc et al** – Counsel to Glaxosmithkline in an action in the Federal Court regarding cefuroxime. (CEFTIN) *(Prior to joining Lenczner Slaght.)*
- **Glaxosmithkline Biologics SA v Novartis** – Counsel to Glaxosmithkline in an impeachment action in the Federal Court regarding adjuvant use in vaccines. *(Prior to joining Lenczner Slaght.)*
- **Pfizer Canada Inc et al v Apotex Inc** – Counsel to Pfizer in a section 8 case in the Federal Court regarding amlodipine (NORVSAC). *(Prior to joining Lenczner Slaght.)*

- **Apotex Inc v Hoffman-La Roche Limited** – Counsel for Roche in a section 8 action in the Federal Court regarding valganciclovir (VALCYTE). *(Prior to joining Lenczner Slaght.)*
- **Bristol-Myers Squibb Canada Co et al v Teva Canada Limited et al** – Counsel to Bristol-Myers and Merck in a *PM(NOC)* application in the Federal Court and Federal Court of Appeal regarding efavirenz (ATRIPLA). *(Prior to joining Lenczner Slaght.)*
- **Bristol-Myers Squibb Canada Co et al v Mylan Pharmaceuticals ULC** – Counsel to Bristol-Myers and Merck in a *PM(NOC)* application in the Federal Court and Federal Court of Appeal regarding efavirenz (SUSTIVA). *(Prior to joining Lenczner Slaght.)*
- **Henry Neugebauer v Anna M Labieniec** – Counsel to Mr. Neugebauer in the Federal Court and Federal Court of Appeal in a copyright dispute relating to joint authorship of book relating to a Memoire recounting Mr Neugebauer's story as a Holocaust survivor. *(Prior to joining Lenczner Slaght.)*
- **Fairmont Hotels Re Trademark Matters** – Counsel to Fairmont Hotels in various trademark prosecution and litigation matters, including litigation matters to protect company trademarks and corporate name in the Federal Court, Opposition Board and pursuant to the *Canada Business Corporations Act*. *(Prior to joining Lenczner Slaght.)*
- **Dr Oetker Re Trademark Matters** – Counsel to Dr. Oetker in various trademark prosecution and litigation matters. *(Prior to joining Lenczner Slaght.)*
- **Fortress Real Developments Inc.** – Counsel to Fortress Real Developments Inc. in an appeal from a decision of the Registrar in respect of FORTRESS REAL CAPITAL & CASTLE DESIGN (see T-317-16) and in various trademark prosecution matters. *(Prior to joining Lenczner Slaght.)*
- **Carol Rosenstein v Queen Productions Limited et al** – Counsel for Carol Rosenstein in a dispute with Queen Productions Limited, Sony Music Entertainment, and Sony Music Entertainment Canada Inc. over the copyright infringement of several Queen music videos directed and produced by Bruce Gowers, including the music video for Bohemian Rhapsody, that are improperly being commercialized on YouTube without authorization.

SELECT PUBLICATIONS AND PRESENTATIONS

- **IP Litigation in the AI Era: Challenges and Strategies** – Jordana Sanft was invited to share her expertise at the Intellectual Property Institute of Canada (IPIC)'s AI & IP Law Webinar Series. Jordana spoke on the panel, *IP Litigation in the AI Era: Challenges and Strategies* where she discussed how artificial intelligence (AI) is reshaping the landscape of intellectual property litigation. The session covered both the opportunities and potential risks associated with using AI in trial preparation and during trial, while also addressing principles, practice directions, and professional obligations relating to its use at trial.
- **Women in IP Panel** – Jordana Sanft was invited to speak at a joint event hosted by the Intellectual Property Society of Osgoode and the Osgoode Women's Network, titled *Women in IP Panel*. Jordana shared her insights on building a successful career in intellectual property law, strategies for professional growth, and navigating the path to senior leadership roles.
- **Patent Agent Training Course: Infringement & Validity** – Jordana Sanft was invited to share her expertise at the Intellectual Property

Institute of Canada's *Patent Agent Training Course: Infringement & Validity*. Jordana served as a lead instructor on the Virtual Lectures and Workshops on "Section 1: Patent Infringement", which took place from February 5-7. The program covered core principles of patent infringement and included hands-on exercises to deepen students' understanding of these key concepts.

- **2024 Snapshot: Through the Lens of Lenczner Slaght** – Lenczner Slaght launches our *2024 Snapshot*, which highlights the most significant developments, decisions, and trends in litigation from the past year across 20 areas of expertise. Reflect on 2024 and look ahead to 2025 through the lens of our expert litigators.
- **Intellectual Property Commercialization** – Jordana Sanft was invited to speak as a guest lecturer at Osgoode Hall Law School on the topic of Intellectual Property Enforcement.
- **IPIC 2024 Conference** – Jordana Sanft was invited to moderate the session, *Inside the IP Chambers – A Federal Court Fireside Chat*, at the IPIC 2024 Conference. Jordana led a discussion on the current challenges and triumphs in case management, trial management, and discoveries. The panel also explored issues and trends impacting IP practitioners and judicial officers in the Federal Court.
- **Is Sharing a Hyperlink Copyright Infringement?** – Jordana Sanft was invited to present at the ALAI Canada program titled, *Is Sharing a Hyperlink Copyright Infringement?* In this session, Jordana provided her expert insights on the implications of the BC Court of Appeal's decision in *Linkletter v Proctorio*. Additionally, she compared the Canadian context to the events in the European Union where hyperlinking had led to major decisions from the EU Court of Justice.
- **2023 Snapshot: Through the Lens of Lenczner Slaght** – Lenczner Slaght launches our *2023 Snapshot*, a look at the most significant developments, decisions, business takeaways, and trends in litigation from the last year, across 15 practice areas. Revisit 2023 and look ahead to 2024 through the lens of our expert litigators.
- **IPIC2023 Conference** – Jordana Sanft was at the IPIC2023 Conference in Winnipeg. Jordana led a panel discussion on "*What I Wish I Knew When I Was a Practitioner – Views from the Bench*".
- **Protecting Confidential Information** – Jordana Sanft shared her expertise at the Intellectual Property Institute of Canada's webinar on Protecting Confidential Information – the Interplay between Implied Undertaking, Protective Orders/Agreements, and the Open Court Principle.
- **Year-in-Review in IP Law 2023** – Jordana Sanft was invited to speak at IPIC's Year-in-Review in IP Law 2023. Jordana presented a year-in-review on patent law and the significant decisions released over the last year.
- **27th Intellectual Property Law: The Year in Review** – Jordana Sanft was invited to share her expertise at the Law Society of Ontario's flagship program titled "27th Intellectual Property Law: The Year in Review". Jordana discussed key patents, trademarks, and copyright cases from 2022, along with opportunities linked to the new European unitary patent system and the Unified Patent Court.
- **11th Annual Patent Colloquium** – Jordana Sanft was invited to share her expertise at the University of Toronto's 11th Annual Patent Colloquium. Jordana spoke on the panel "*AI's Impact on Patent Law – Can AI Be the Inventor?*".
- **IPIC2022 Conference** – Jordana Sanft was Chair of the IPIC2022 Conference in Whistler. Following her opening remarks to kick-off the conference, she led a conversation with the conference's keynote

speaker, Manjit Minhas (CEO, Minhas Breweries, Distilleries and Wineries (Calgary) and Dragon, Dragon's Den).

- **Summer Courses in Intellectual Property** – Jordana Sanft shared her expertise at the Intellectual Property Institute of Canada and McGill University Summer IP Course. Jordana presented on *Patent Enforcement: Infringement* and *Mock Trial: Expert Reports and Cross-Examination of a Witness*.
- **The 15th Annual Harold G. Fox IP Moot** – We were proud to continue our sponsorship of the annual Fox IP Moot! Jordana Sanft and Sana Halwani volunteered their time as judges to the competition.
- **Intellectual Property Strategy for AI Technology in Canada** – Jordana Sanft co-authored the article *Intellectual Property Strategy for AI Technology in Canada*, which was published in "Leading Legal Disruption: Artificial Intelligence and a Toolkit for Lawyers and the Law" by Thomson Reuters. (Prior to joining Lenczner Slaght)
- **Maximizing the Expert Witness in Civil Litigation** – Jordana Sanft shared her expertise at the OBA's Civil Litigation program titled "Maximizing the Expert Witness in Civil Litigation". She presented on the panel *Strengthening Expert Evidence in Court - Compelling Chief/Cross Strategies*. (Prior to joining Lenczner Slaght)
- **8th Annual Patent Colloquium** – Jordana Sanft shared her expertise at the University of Toronto's 8th Annual Patent Colloquium. Jordana spoke on the panel *Recent Trends in Patent Infringement: Indirect Infringement*. (Prior to joining Lenczner Slaght)
- **Artificial Intelligence and Intellectual Property Considerations** – Jordana Sanft co-authored the article *Artificial Intelligence and Intellectual Property Considerations*, which was published in the 2018 issue of *Financier Worldwide*.
- **Mastering Winning Discovery Techniques** – Jordana Sanft presented at The Advocates' Society's "Mastering Winning Discovery Techniques" program. Jordana shared her expert insights on *Conducting a Discovery and Implications for Trial*. (Prior to joining Lenczner Slaght)
- **The Law of Utility in Canada - Where Are We Now and Where Are We Going** – Jordana Sanft led a discussion on *The Law of Utility in Canada - Where Are We Now and Where Are We Going* at the Intellectual Property Institute of Canada's 2017 Annual General Meeting. (Prior to joining Lenczner Slaght)
- **The Dos and Don'ts of Appeals** – Jordana Sanft was invited to speak at the Canadian Bar Association's 2017 IP Day on *The Dos and Don'ts of Appeals*. (Prior to joining Lenczner Slaght)

BLOG POSTS

- **North of Legal or South of Safe? Key Legal and Regulatory Considerations to Substantiate "Made in Canada" Claims** – On the heels of Canada Day and with Canadian patriotism on the rise, many companies doing business in Canada are eager to promote their products as "Canadian". Before wrapping a product in the Canadian flag, and to avoid common pitfalls, the legal and regulatory requirements for "Made in Canada" and "Canadian" claims should be considered.

- **Coming Soon: Changes to Trademark Proceedings in Canada** – On April 1, 2025, various amendments to the *Trademarks Act* and *Trademarks Regulations* will come into force. The overarching theme of the upcoming amendments is to increase efficiency and effectiveness in trademark proceedings before the Trademarks Opposition Board (TMOB) and the Federal Court.
- **Humans are Central to Copyright: Highlights from the U.S. Copyrightability Report and its Potential Implications for Canada** – The U.S. Copyright Office released a comprehensive report titled "Copyright and Artificial Intelligence Part 2: Copyrightability" ("U.S. Copyrightability Report") in January 2025, which delves into the complex issue of copyright protection for AI-generated material.
- **Health Canada's Proposed Regulations Addressing Drug and Medical Device Shortages Now Open for Public Comment** – Following on Health Canada's plan to introduce new regulations aimed at addressing therapeutic product shortages as discussed previously in our Fall Regulatory Roundup, proposed amendments to the *Food and Drug Regulations* and *Medical Device Regulations* were published for public comment on December 28, 2024. The comment period closes on March 8, 2025.
- **Making Your Patent List and Checking It Twice... but Don't Delay in Submitting It!** – Engaging Canada's *Patented Medicines (Notice of Compliance) Regulations* (the "*Regulations*") requires pharmaceutical patentees to first submit a list to Health Canada of patents to be included on the register – Canada's equivalent to the Orange Book. Any delay in submitting that list after an eligible patent has been issued can have severe consequences on the scope of a patentee's protections under the *Regulations*. The recent Federal Court decision in *Serono v Canada (Health)* is illustrative.
- **Close Only Counts in Horseshoes: Federal Court of Appeal Reins in the PMPRB** – The Federal Court of Appeal's decision in *Galderma Canada Inc v Canada (Attorney General)* ("*Galderma FCA*") arose from what seemed like a straightforward production order, but ended up providing clear guidance on the jurisdiction of Canada's Patent Medicine Prices Review Board (PMPRB). The key takeaway: the PMPRB's jurisdiction extends only to *patented* medicines, not *all* medicines.
- **Reasonable Request for Samples Required** – In the recent decision in *Bayer Inc v Amgen Canada Inc*, Case Management Judge Duchesne of the Federal Court dismissed a request for samples on the basis that Bayer failed to demonstrate that the proposed testing could lead to a result that would assist the trial judge in determining an issue in the proceeding.
- **A New Test for the Validity of Subordinate Legislation: Auern't You Glad the Supreme Court Weighed In?** – When we think about the broad direction of government policy, we generally think about the statutes introduced by the legislature. However, the reality is that much of the laws that impact us are subordinate legislation: regulations, rules, and policies that are enacted by Ministers, boards and agencies, or other government actors pursuant to rule-making power provided to them under legislation. For nearly a decade, challenges to subordinate legislation were extremely challenging. The Supreme Court of Canada's 2013 decision in *Katz Group Canada Inc v Ontario (Health and Long-Term Care)* set a high bar for challenging such subordinate legislation. The Court in that case held subordinate legislation "must be 'irrelevant', 'extraneous' or 'completely unrelated' to the statutory purpose to be found to be *ultra vires* on the basis of inconsistency with statutory purpose."
- **Punished for the Sins of the Baby?: Liability of Foreign Parent Companies for Patent Infringement in Canada** –

The recent decision in *Munchkin Inc v Angelcare Canada Inc* presents an example of circumstances in which foreign parent companies can be held liable for patent infringement in Canada.

➤ **Fall Regulatory Round Up – The Shifting Shape of the Canadian Landscape – Fall Regulatory Round Up**

Activity abounds on the regulatory landscape from modernization and transparency initiatives to consultations, collaborations, and even potential implementations. Our Fall Regulatory Round Up highlights significant developments for drug products and patents that are of interest to those in the life sciences and biotech spaces. We will be following these important regulatory initiatives as they continue to unfold and will provide updates of interest.

➤ **AI Artistry on Trial: Can Machines Hold Copyright? – The intersection of artificial intelligence and intellectual property law is once again in the spotlight with the latest legal proceeding, *Samuelson-Glushko Canadian Internet Policy and Public Interest Clinic v Ankit Sahni*.**

➤ **Summary Judgment Still Appropriate for Certain Patent Infringement Claims – A desire to expedite patent disputes may result in a party pursuing summary adjudication. We have previously commented on a number of cases relating to the use of summary proceedings for resolving patent cases in Canada. In particular, in the Federal Court of Appeal's 2022 decision in *Gemak Trust v Jempak Corporation*, the FCA held that summary judgment is not appropriate where there are serious issues with respect to the credibility of witnesses, and the Court observed more generally that "while patent infringement issues are not by definition excluded from the ambit of the summary judgment process, they tend to raise complex issues of fact and law that are usually better left for trial". We noted that in *Gemak*, the FCA was tapping the brakes on a trend towards increased adoption of summary proceedings in patent cases, and that for parties interested in summary adjudication, summary trial may be a more attractive option, particularly where witness credibility, and especially expert credibility, is likely to be an issue.**

➤ **On the Horizon: Legal Complexities Intersecting Generative AI, Class Actions, and IP Law – The multifaceted nature of generative AI is bound to create legal complexities at the intersection of intellectual property law and class actions, as this emerging technology disrupts not only the tech landscape but the legal one too.**

➤ **Exploring the Boundaries of Patent Protection: Federal Court of Appeal Holds That Marketing Is Not "Use" Under the Patent Act – The Federal Court of Appeal's decision in *Steelhead v ARC* upholds Justice Manson's summary trial decision finding no infringement by ARC Resources of Steelhead's 085 Patent. In summary, the FCA held that the marketing of an apparatus that – if built – would infringe the 085 Patent did not constitute "use" (or "exploiter" in the French version) under section 42 of the *Patent Act*, and therefore could not be infringement.**

➤ **AI in the Courtroom: The Quest for Legal Precedents – The current landscape is inundated with narratives surrounding artificial intelligence and its intersection with the law. From the New York Time's lawsuit launched against OpenAI in December 2023, to the BC lawyer reprimanded for citing fake AI-generated cases, to the lying Air Canada chatbot, the legal and mainstream media is full of stories of AI or people using AI running up against traditional legal doctrine and practice. Yet, amidst this surge of AI-related incidents, Canada finds itself grappling with more questions than answers.**

➤ **Policing Scope Creep: Relevance in Canadian Pharma Disputes for Section 8 Damages – In Canada, a generic pharmaceutical company can commence an action for damages under section 8 of the *Patented Medicines (Notice of Compliance) Regulations***

(the “*Regulations*”), if it successfully defends a patentee’s claims in an earlier section 6 prohibition proceeding. Section 8 actions are often complex, requiring a determination of the alleged loss suffered by assessing a “but-for world” where the generic would have received regulatory approval and commenced sales at an earlier date, but for having been blocked by the operation of the *Regulations*. Depending on the drug(s) and patent(s) at issue, there may be several independent section 8 actions against a patentee, each started by a different generic plaintiff (see our previous post). When distinct section 8 actions are commenced pertaining to the same drug(s), patent(s), and patentee(s), issues as to relevance and scope of each action may arise.

- **Swiftly Navigating the Importance of IP** – Few pop icons have navigated the art of protecting their intellectual property as well as Taylor Swift. Not only does Taylor Swift have an outstanding knack for creating number one hits, a keen eye for branding, and an entrepreneurial spirit that is inspiring, she is also business savvy in protecting her trademarks and copyright. On this International Women’s Day 2024 we look to Taylor Swift as an inspiration in IP protection, enforcement, and commercialization, as we celebrate women who “could show you incredible things”.
- **Sniff, Kleenex Is Snuffed Out of Canada** – On August 25, 2023, Canadians were advised that KLEENEX was blowing out of town and would no longer be available in Canada (see *Globe & Mail* article).
- **No Human, No Copyright: U.S. District Court of Columbia Denies Thaler’s Summary Judgment Motion** – The “Creativity Machine”, owned by Stephen Thaler, generated a work of art of its own accord. Thaler applied to register copyright in the artistic work titled ‘A Recent Entrance to Paradise’ with the United States Copyright Office. The application stated the Creativity Machine created the work and it was listed as the author. Thaler sought to transfer the copyright to himself as owner. The registration was denied.
- **Insights on the Independence of Expert Evidence** – In the recently released decision *dTechs EPM Ltd v British Columbia Hydro and Power Authority and Awesense Wireless Inc*, the Federal Court of Appeal (“FCA”) weighed in on the role and independence of experts in patent cases. In particular, the FCA provided guidance on (1) the role counsel may play in preparing expert reports; (2) an expert’s role in claim construction; and (3) the difference in the role of an expert where anticipation is alleged based on prior use versus prior publication.
- **Clarity on the Test for Inducing Infringement in Canadian Patent Law** – Indirect infringement or “inducement” often arises in pharmaceutical patent infringement cases where a defendant generic manufacturer may not ultimately “use” the drug in question (*i.e.*, directly infringe). Since 2011, the Federal Court of Appeal’s (“FCA”) *Corlac Inc v Weatherford Canada Inc* decision has frequently been cited as the leading authority for the tripartite test for inducement. In 2020, the Federal Court suggested that *Corlac* had changed the law of inducement—particularly at the second step determining influence—thereby requiring “a higher threshold for establishing inducement than was applied in the earlier cases”. In the recent decision of *Teva Canada Limited v Janssen Inc* (“*Paliperidone*”), the FCA has rejected that interpretation of *Corlac*. The FCA held that *Corlac* incorporates the same principles of inducing infringement as had been established in cases dating back to 1906. In doing so, it overturned the lower Court’s inducement determination based on a supposed higher standard and found that the defendant was liable for inducement when the *Corlac* test was properly applied.
- **Let’s Chat(GPT)** – The use of generative artificial intelligence (AI) is on

the rise and is receiving significant attention across disciplines and industries. The impact of generative AI spans various fields such as healthcare, gaming, education, marketing, visual arts, literature, music, banking and fashion, to name a few. In the context of intellectual property law, where the focus is on innovation and creativity, generative AI raises countless complex questions. This blog post focuses on ChatGPT and copyright.

- **To Consolidate or Not to Consolidate – This is the Federal Court’s Question** – In a recent decision, *Takeda Canada Inc v Apotex Inc*, the Federal Court dismissed the Plaintiff, Takeda’s, motion for consolidation of two actions against Apotex relating to Takeda’s dextansoprazole (DEXILANT) under section 6 of the *Patented Medicines (Notice of Compliance) Regulations* (the “PM(NOC) Regulations”).
- **Better Together – or Maybe Not** – Some things just go better together and probably always will, as Luke Combs sings in ‘Better Together’. Like a cup of coffee and a sunrise; Sunday drives and time to kill. Multiple section 8 actions however have not made the cut. According to the recent decision of Justice Southcott in *Apotex Inc v Janssen Inc*, multiple actions for section 8 damages should not have common issues heard together.
- **FCA Taps the Brakes on Summary Judgment in Patent Cases** – Over the last several years there has been a trend towards increased adoption of summary proceedings for resolving patent cases in Canada. In particular, we have previously commented on decisions of the Federal Court (e.g., *Kobold* partial SJ motion) and Federal Court of Appeal (e.g., *Canmar* Appeal) that signalled a willingness to move away from the historic reluctance of those courts to approve summary judgment for patent infringement actions. We had also noted that summary proceedings were a trend to watch this year.
- **A Complete Code: Ontario Court of Appeal Denies Remedies Exist Outside the PMNOC Regime** – The Patented Medicines (Notice of Compliance) Regulations (PMNOC Regulations) is a complete code. In *Apotex Inc v Eli Lilly Canada Inc*, the Ontario Court of Appeal weighs in on the drawn-out battle between patent owners and generics on whether monetary relief is available outside the parameters of the PMNOC regime. It is not.
- **Public Disclosure vs. Confidentiality Protection: The FCA Finds the Proper Balance** – In *FibroGen, Inc v Akebia Therapeutics, Inc*, the Federal Court of Appeal set aside an order requiring a party to make certain fact witness statements from a discontinued action public, restoring the proper balance and safeguarding the confidentiality of documents that had been designated as confidential or highly confidential information.
- **Don’t Be the Author of Your Own Dismissal: Chief Justice Dismisses Dueling Motions for Summary Judgment in the Trademark Context** – Summary adjudication can be enticing. In the right circumstances, it saves the parties time and money. Unsurprisingly, there is a growing trend in Canadian intellectual property litigation to use summary adjudication that we have been actively monitoring (see, e.g., our comments [here](#), [here](#), [here](#), [here](#) and [here](#)).

- **Bill C-27 and the Proposed Artificial Intelligence and Data Act: Oversight of AI in Canada is Coming** – On June 16, 2022, Canada's Minister of Innovation, Science and Industry introduced Bill C-27, titled “*An Act to enact the Consumer Privacy Protection Act, the Personal Information and Data Protection Tribunal Act and the Artificial Intelligence and Data Act and to make consequential and related amendments to other Acts*” (short title, the *Digital Charter Implementation Act, 2022*), in the House of Commons.
- **The Suit Against Iron Man's Suit is Not Iron Clad** – Iron Man's suit is at the centre of an intergalactic copyright infringement battle brought by Horizon Comics Productions Inc. (“Horizon”) against Marvel Entertainment, LLC et al. (“Marvel”). The alleged infringement is largely directed to Horizon's Canadian created *Radix* comic book series (the “Works”) and Marvel's Iron Man suit from the movie Iron Man 3.
- **SCC Leave Denied in Alexion Pharmaceuticals Inc v Canada (Attorney General)** – In our blog 2021 Year in Review & 2022 Trends to Watch for Pharmaceutical Patents, we identified *Alexion Pharmaceuticals Inc v Canada (Attorney General)* as an important case to watch in 2022 as leave to the Supreme Court was filed.
- **Data-Protection Déjà Vu All Over Again** – For the second time in less than a year, Justice St. Louis of the Federal Court has set aside the issuance of a Notice of Compliance (“NOC”) to an innovator drug company and remitted the matter to the Minister of Health (“Minister”) for what will be a third determination in *Catalyst Pharmaceuticals, Inc v Médunik Canada* (“*Catalyst 2022*”).
- **Amendments to the Patented Medicines Regulations Lose Some Teeth** – The proposed amendments to the *Patented Medicines Regulations* had the projected effect of lowering drug prices by billions of dollars over the next ten years. But by overreaching its jurisdiction, these amendments have lost some of its bite. The Quebec Court of Appeal determined several provisions to be *ultra vires*.
- **Mirror Mirror on the Wall, Whose IP Will Win It All?** – An intellectual property battle among major athletic brands is brewing in the United States. Lululemon is suing Peloton. Peloton is suing Lululemon. And Nike is suing Lululemon.
- **AI and IP: Who or What Can Be an Author or Inventor in Canada?** – There have been two recent and notable developments with respect to artificial intelligence (“AI”) and intellectual property (“IP”) rights in Canada. A preliminary legal question at the intersection of AI and IP is whether AI can be granted authorship in the case of copyright or inventorship in the case of patents for something that it generated. Jurisdictions around the world are facing the same issues. This blog post discusses Canada's first foray into this new frontier.
- **The Federal Court Clarifies the Burden of Proof in Summary Trial** – In 2022, the use of summary proceedings in patent matters continues at the Federal Court. In *Janssen Inc v Pharmascience Inc*, the Court:

- **2021 Year in Review & 2022 Trends to Watch: Pharmaceutical Patents** – In 2021, the Canadian pharmaceutical and life sciences industries were once again at the forefront of innovation, developing and commercializing new vaccines, drugs, and medical devices. The media continued to shine a light on the advances made to protect the public from COVID-19, including regulatory approvals for new mRNA and adenovirus vector vaccines. In the pharmaceutical patent litigation arena in particular, we saw some new trends develop. There were important developments in proceedings relating to pharmaceutical patents, advances in cases and legislative developments relating to the Patented Medicine Prices Review Board (“PMPRB”) as well as judicial review applications and appeals in patent-related fields.

SELECT NEWS ARTICLES

- **IAM Patent 1000 Highlights Lenczner Slaght’s IP Expertise** – Canada’s leading litigation firm continues to receive worldwide recognition for its exceptional Intellectual Property expertise.
- **2025 Lexpert Directory Highlights Lenczner Slaght’s Excellence in Advocacy** – Peers and senior members of the legal profession across the country continue to recognize the depth and breadth of Canada’s leading litigation firm in the latest *2025 Canadian Legal Lexpert Directory*.
- **Lenczner Slaght Recognized in Chambers Global 2025** – Canada’s leading litigation firm and its expert litigators are recognized for the 23rd consecutive year in world-renowned directory, Chambers Global.
- **Lenczner Slaght’s 24th Year at the Centre of the Lexpert Bull’s Eye** – The 2025 edition of *Lexpert’s Leading 500 Cross-Border Lawyers: A Guide to Doing Business in Canada* continues to recognize Lenczner Slaght as the #1 firm in Toronto for Litigation and Commercial Litigation.
- **Lenczner Slaght Lawyers Recognized as Canada’s Leading Litigators** – Following an in-depth peer review process across the legal profession, 21 Lenczner Slaght lawyers have been recognized in the *2024 Lexpert Special Edition: Canada’s Leading Litigation Lawyers* guide for their extensive courtroom experience and subject-matter expertise.
- **Lenczner Slaght Recognized as a Leading Litigation Firm in Legal 500 Canada** – Canada’s leading litigation firm has reaffirmed its Tier 1 ranking in Dispute Resolution in *Legal 500 Canada*.
- **Chambers Canada Recognizes Lenczner Slaght’s Deep Bench of Expert Litigators** – Canada’s leading litigation firm continues to advance their position in the latest edition of the world-renowned directory.
- **Lenczner Slaght Recognized for Patent Litigation Excellence by LMG Life Sciences** – Lenczner Slaght is pleased to announce its continued recognition for patent litigation expertise in the latest edition of *LMG Life Sciences*, following an in-depth qualitative research process that included peer and client feedback.
- **Lenczner Slaght Litigators Recognized as the Best Lawyers in Canada** – In the 2025 edition of *Best Lawyers in Canada*, Lenczner Slaght is proud to receive 168 total rankings, with 45 of our expert litigators recognized for their expertise across 25 practice areas.

- **Lenczner Slaght Litigators Recognized as Leading Practitioners in IP** – The latest edition of Managing Intellectual Property's 2024 IP STARS handbook, a leading guide to the world's foremost IP firms and practitioners, continues to recognize Sana Halwani and Jordana Sanft.
- **IAM Patent 1000 Recognizes Lenczner Slaght's Expert IP Team** – Lenczner Slaght continues to receive worldwide recognition for its intellectual property expertise and is proud to advance to the Silver Tier in the 2024 edition of IAM Patent 1000: The World's Leading Patent Professionals.
- **Federal Court and Federal Court of Appeal Float Ideas for Reforming Their Rules, Seek Bar's Input** – Interviewed by Law360, Jordana Sanft commented on the Federal Court and Federal Court of Appeal's reform initiative to modernize and improve its existing joint rules, last overhauled in 2012.
- **The 2024 Lexpert Directory Recognizes Lenczner Slaght's Litigation Excellence** – Lenczner Slaght's litigators continue to be recognized by their peers as the foremost practitioners in their fields.
- **Chambers Global Recognizes Lenczner Slaght for the 22nd Consecutive Year** – Canada's leading litigation firm and its expert litigators are increasingly recognized in the latest edition of world-renowned directory, Chambers Global.
- **Lenczner Slaght Remains at the Centre of the Lexpert Bull's Eye** – The 2024 Lexpert®/American Lawyer Guide to the Leading 500 Lawyers in Canada recognizes Lenczner Slaght as the #1 firm in Toronto for Litigation and Commercial Litigation for the 23rd consecutive year.
- **Lexpert Recognizes Lenczner Slaght's Litigation Strength** – An increasing number of our expert litigators continue to be recognized as the foremost lawyers in their fields by peers and senior members of the legal profession.
- **Lenczner Slaght Stands Out as a Top-Tier Litigation Firm in Legal 500 Canada** – Canada's leading litigation firm is once again recognized as a "litigation powerhouse" according to *Legal 500 Canada*.
- **Chambers Canada Recognizes Lenczner Slaght as a Top-Tier Litigation Firm** – Canada's leading litigation firm and its expert litigators continue to be recognized by world-renowned directory, Chambers & Partners.
- **LMG Life Sciences Recognizes Lenczner Slaght's Patent Litigation Expertise** – Following an extensive qualitative research process that included peer and client feedback, Lenczner Slaght is proud to be ranked for its patent litigation expertise in the latest edition of LMG Life Sciences.
- **Song with Deep-faked Vocals of Drake, the Weeknd Not Eligible for Juno Nomination** – In this article, CBC mentions Jordana Sanft and her recent interview, where she shared her expert insights on IP law in the world of generative AI.
- **Lenczner Slaght Litigators Recognized as Best Lawyers in Canada** – In the latest edition of *Best Lawyers in Canada*, 41 of our expert litigators are recognized for their expertise across 24 practice areas. The following lawyers have also been recognized as "Lawyer of the Year" for receiving the highest overall peer-feedback in their practice areas in Toronto.
- **Lenczner Slaght Litigators Recognized Among Leading Practitioners in IP** – Managing Intellectual Property's 2023 IP STARS handbook, a leading guide to the world's foremost IP firms and practitioners, continues to recognize Sana Halwani and Jordana Sanft.

- **Lenczner Slaght Receives Worldwide Recognition in IP Litigation** – Canada's leading litigation firm continues to be recognized year-over-year for its exceptional Intellectual Property expertise.
- **CBC Day 6 Segment: Generative AI** – Jordana Sanft shared her expertise on CBC's Day 6 segment on generative AI, in particular AI-generated vocals of popular artists, in the context of copyright law.
- **International Women's Day Spotlight: Jordana Sanft** – Jordana Sanft was featured in the Intellectual Property Institute of Canada's 2023 International Women's Day spotlight series! Jordana shares how we can all #EmbraceEquity, her advice for aspiring women in IP, and what she believes will be the biggest challenge for the next generation of women leaders in IP.
- **Lenczner Slaght's Litigation Excellence Recognized in 2023 Lexpert Directory** – Following comprehensive peer review surveys and interviews with senior members in the legal profession, the 2023 *Canadian Legal Lexpert Directory* has recognized 31 of the firm's expert litigators for their experience, knowledge, and precision, with 108 rankings spanning 17 practice areas.
- **Chambers Global Recognizes Lenczner Slaght for the 21st Consecutive Year** – Canada's leading litigation firm continues to be recognized for its dispute resolution expertise by world-renowned directory, Chambers Global, alongside notable full-service, national, and international firms.
- **Lenczner Slaght Recognized Among Canada's Leading Litigation Lawyers** – Following an in-depth peer review process, the 2022 Lexpert Special Edition: Canada's Leading Litigation Lawyers guide recognizes 15 Lenczner Slaght lawyers for their extensive courtroom experience and subject-matter expertise. We know courts, and courts know and trust us. That is why clients turn to us to solve their most complex legal problems.
- **Lenczner Slaght Stands Out as a "Litigation Powerhouse" in Legal 500 Canada** – Canada's leading litigation firm is once again ranked in Tier 1 for Dispute Resolution by *Legal 500 Canada*.
- **Lenczner Slaght Ranked Band 1 in Chambers Canada for 5th Consecutive Year** – Canada's leading litigation firm and its expert litigators continue to be recognized in the latest edition of world-renowned directory, Chambers & Partners.
- **Lenczner Slaght Litigators Recognized Among the Best Lawyers in Canada** – In the latest edition of *Best Lawyers in Canada*, 39 of our expert litigators are recognized by their peers for their expertise across 24 practice areas.
- **Lenczner Slaght's Expert IP Team Receives Worldwide Recognition** – Canada's leading litigation firm continues to be recognized for its exceptional Intellectual Property expertise by IAM Patent 1000.
- **Sana Halwani & Jordana Sanft Recognized as Leading Practitioners in IP** – *Managing Intellectual Property's 2022 IP STARS handbook*, a leading guide to the world's foremost IP firms and practitioners, has once again recognized Sana Halwani and Jordana Sanft for their patent and trademark expertise.
- **The 2022 Lexpert Directory Recognizes Lenczner Slaght's Litigation Excellence** – 31 of our expert litigators are recognized by their peers as the foremost practitioners across 18 fields.
- **Lenczner Slaght Ranked for the 20th Consecutive Year in Chambers Global** – Canada's leading litigation firm continues to be recognized for its dispute resolution expertise by world-renowned directory, Chambers Global, alongside notable full-service, national, and international firms.
- **New IP Partner Joins Lenczner Slaght** – Canada's leading litigation

firm is proud to welcome exceptional intellectual property litigator, Jordana Sanft, as a strong new addition to its formidable IP team.

PROFESSIONAL ACTIVITIES

- Intellectual Property Institute of Canada
Director (2022-2024); Conference Committee Chair (2021-2023); Vice Chair (2019-2021); Women in IP Networking Group
- Canadian Bar Association
Intellectual Property Section; Federal Courts Bench and Bar Liaison Committee - Chair (2023-2025) and Member (2022-2023); IP Court Practice Committee - Chair (2017-2020) and Member (2021-present)
- International Association for the Protection of Intellectual Property
- The Toronto Intellectual Property Group
- ChIPs
Non-profit organization advancing women in technology, law and policy
- The York School
Risk Committee of the Board of Directors; Member at Large (2017-2022)
- Youth Rising Above
Board Member (2021-2022)