



Jonathan Colombo
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Experience

Jonathan Colombo is a partner with Bereskin & Parr LLP and a co-leader of the firm's Trademarks practice group.

His practice covers all areas of trademark and copyright law including the acquisition, exploitation and enforcement of these rights. He has extensive litigation experience representing many national and international brands, and has represented clients in advertising disputes.

Jonathan, together with associate Amrita V. Singh, currently act for Hilton Worldwide Holdings LLP, the owner of the WALDORF-ASTORIA trademark, and were successful in overturning a decision of the Trademarks Office ordering the cancellation of the registration (which covers "hotel services"), on the basis that there has never been a Waldorf-Astoria hotel in Canada. That decision is now under appeal to the Federal Court of Appeal.

In 2019, Jonathan and Amrita also acted for Glassdoor Inc. in an appeal of a Norwich order requiring Glassdoor to disclose certain personal information of third parties who posted allegedly defamatory employer reviews. Jonathan and Amrita were successful in obtaining a stay of the Norwich Order pending the appeal, and then resolving the dispute, which included vacating the Norwich Order.

In 2017, Jonathan and Amrita successfully represented CarGurus in a copyright proceeding brought by Trader seeking \$98 million in statutory damages relating to 196,740 photos on CarGurus' Canadian website. Trader was seeking the "minimum" of \$500 per photograph, as well as \$1 million for punitive damages, a permanent injunction, and legal fees. In its decision, the Court awarded \$2 per photograph or \$305,064 in total. The Court denied Trader's request for punitive damages and for an injunction. CarGurus and Trader subsequently agreed that legal fees would not be payable. This is the first reported case in Canada dealing with the "information location tool" defence (the search engine defence) and the "making available" right under the *Copyright Act*.

In 2016, Jonathan represented the Association of Chartered Certified

Practice Groups

Copyright & Digital Media
Dispute Resolution
Litigation
Regulatory, Advertising & Marketing
Trademarks

Education

LL.B., McGill University, 1989
M.A., University of Toronto, 1986
B.A., University of Toronto, 1985

Qualifications

Registered Canadian Trademark Agent, 1993
Admitted to the Ontario Bar, 1991

Professional Memberships

Advocates' Society
American Bar Association (ABA)
Intellectual Property Institute of Canada (IPIC),
Fellow
International Bar Association (IBA)
Law Society of Upper Canada (LSUC)
Licensing Executives Society (LES)



Accountants, one of the world's largest international accounting bodies, in litigation against four provincial accounting institutes regarding use of professional designations and "official marks" (the case settled one month prior to trial). Jonathan also represented Canada Goose, a leading Canadian clothing manufacturer, in litigation against Sears Canada in a trade dress dispute.

Jonathan was counsel for Gap in the Gap v. G.A.P. Adventures case, which settled about two months before trial, with the defendant agreeing to re-brand worldwide. Jonathan was also co-counsel for McDonald's in litigation against A&W, resulting in the first reported Canadian decision dealing with "reverse confusion". Jonathan was also co-counsel for Staples in litigation against Office Depot case where a six-year interlocutory injunction was obtained.

Jonathan is a member of the International Trademark Association's (INTA) Advocacy Committee and is a former member of the Enforcement and Parallel Imports Committees. Additionally, he is a past member of the Canadian Trademark Agents Board of Examiners, and taught at the McGill – IPIC Advanced Trademarks Course for more than five years. Jonathan is also a former Managing Partner of Bereskin & Parr.

Recent Articles

- Crashing the Internet: Cars, CarGurus and Copyright in the Digital Age
- It is Our Privilege to Serve – Thoughts on the Law of Privilege in Canada
- Punctual Plumber's Damage Claims Go Down the Drain
- Did Dreams Come True for Trademark Owners in 2017....or Just Owners of Slogans?
- Canadian Trademark Cases 2017: Our Top Picks

Accolades

- 23 Bereskin & Parr Professionals Listed in 2019 Best Lawyers in Canada
- Managing Intellectual Property recognizes Bereskin & Parr and its professionals in the 2019 edition of IP STARS
- 22 Bereskin & Parr Professionals Listed in the Canadian Legal Lexpert Directory 2019
- Bereskin & Parr recognized in Benchmark Litigation 2019
- Bereskin & Parr Ranked Gold for Canada and Eleven Professionals Recognized in World Trademark Review 1000 2019