



R. Scott MacKendrick
B.A.Sc. (Chem. Eng.), LL.B.

Partner | Toronto
416.957.1675
smackendrick@bereskinparr.com

Experience

Scott MacKendrick is a partner with Bereskin & Parr LLP, chair of the firm's Diversity & Inclusion Committee, and a member of the firm's Executive Committee.

Scott practices crosses all areas of intellectual property law, but with a particular focus on litigation. He has represented domestic and multinational clients in patent litigation in pharmaceutical, medical device, chemical, mechanical and software technologies, and has considerable experience in trademark, copyright, industrial design and trade secret litigation, and in domain name dispute resolution proceedings. Much of his litigation experience has been as part of international teams fighting large multinational IP disputes. He also has an active practice before the Canadian Trademarks Opposition Board, and advises clients on trademark portfolio and dispute strategies.

Scott is one of a handful of Canadian lawyers recognized for his notable skills in both patent and trademark matters. He creatively brings those skills to bear in complex and challenging disputes; and he focuses on developing effective, client-oriented strategies to get to a successful resolution as efficiently as possible. He has been described by clients, colleagues and adversaries in various independent ranking publications as: "one of the top practitioners in Canada" (*Who's Who Legal: Canada*); "a leading light in the Canadian IP space" (*WTR 1000*); "top-notch" (*Who's Who Legal: Patents*); "a super-smart litigator with a remarkable ability to anticipate adversaries' moves" (*AM Patent 1000*); "[his] foresight and level-headed approach make him a superb choice for challenging enforcement mandates" (*WTR 1000*); "knows the case law back to front" (*IAM Patent 1000*); a "formidable, tenacious and classy courtroom sharpshooter" (*WTR 1000*); "a clear, attentive communicator who provides business-minded advice" (*IAM Patent 1000*); "goes above and beyond the call of duty to get the job done" (*WTR 1000*); "provides outstanding service and practical, budget-conscious advice" (*IAM Patent 1000*); a "tremendous, smart lawyer who is good at finding practical solutions that benefit all parties" (*WTR 1000*); "a very pure and balanced advocate and brilliant to work with, whether on the same side or against" (*WTR*

Practice Groups

Artificial Intelligence (AI)
Chemical
Copyright & Digital Media
Dispute Resolution
Industrial Designs
Litigation
Mechanical & Industrial Processes
Medical Devices
Patents
Privacy, Cybersecurity & Data Protection
Regulatory, Advertising & Marketing
Trademarks

Education

LL.B., Queen's University, 1985
B.A.Sc. (Chem. Eng.), University of Toronto, 1982

Qualifications

Admitted to the Ontario Bar, 1987
Registered Canadian Trademark Agent, 1987

Professional Memberships

American Bar Association (ABA)
American Intellectual Property Law Association (AIPLA)
Canadian Bar Association (CBA)
Intellectual Property Institute of Canada (IPIC), Fellow
International Trademark Association (INTA)
Law Society of Ontario (LSO)
Toronto Intellectual Property Group (TIPG)



1000); “boasts an impressive understanding of disputes in the pharmaceuticals, mechanical and chemical spheres” (*IAM Patent 1000*); and “expertly represents clients in complex trademark oppositions, enforcement, and brand protection” (*Who’s Who Legal: Trademarks*).

Scott is dedicated to the advancement of the IP profession. He is a member of the International Trademark Association (INTA) Board of Directors. He is the Chair of the INTA Board’s Compensation and Benefits Committee, a member of INTA’s North America Global Advisory Council, and was, amongst other committee assignments, the co-Chair of the INTA Course on International Trademark Law and Practice. Scott is and has also been an active committee member for a number of IP organizations, including the Intellectual Property Institute of Canada (IPIC) – serving at present on its Conference Committee and its Indigenous IP Advisory Group, and having chaired other IPIC committees over a period of more than a dozen years – as well as serving on committees of the Canadian Bar Association, the American Bar Association’s Section of Intellectual Property Law, and the American Intellectual Property Law Association.

Scott is a passionate supporter of the University of Toronto. He is, and has been for the past 20 years, an Adjunct Professor of Patent and Trade Secret law at the University’s law school. He is the immediate past President of the University of Toronto Alumni Association, the past Chair of the University’s College of Electors, a past board member of the University of Toronto Engineering Alumni Association Executive, and has chaired and remains a member of other University committees and award panels. Scott is also a recipient of the University of Toronto Arbor Award in recognition of his many contributions to the University.

Scott speaks frequently on a wide variety of intellectual property topics. He has also taught at Osgoode Hall Law School at York University and at the University of Victoria, and was repeatedly an instructor at the McGill University-IPIC Trademark Practitioner Advanced Course. Additionally, Scott is an author of numerous intellectual property publications, including co-authoring chapters on the conduct of an IP trial in *Intellectual Property Disputes, Resolutions and Remedies*, on trademark opposition proceedings in the *Canadian Trademark Law Benchbook*, and on patent law essentials for IT in *Electronic Commerce: A Practitioner’s Guide*.

Recent Articles

- Access Copyright v York University – School’s Out! No mandatory tariff; no declaratory relief of fair dealing; and “public access to and dissemination” of works is a primary goal of copyright in Canada.
- Exhaustion Doesn’t Apply: Repurposing of Original Branded Parts Leads to Findings of Infringement, Passing Off and Depreciation of Goodwill
- Inducing Infringement by Product Monographs & Skill and



Judgment in Medical Use Claims: Key Takeaways from the Federal Court's decision in Hoffman-La Roche Limited v Sandoz Canada Inc.

- “Comprising” in Claim Construction & Application of the “Obvious to Try” Test: Key Takeaways from the Federal Court's decision in Merck et al. v Wyeth LLC
- Encouraging Trends in 2020/2021 for IP Rights Holders Enrolled in Canada's Border Protection Program

Accolades

- 25 Bereskin & Parr Lawyers Listed in 2022 Best Lawyers in Canada
- Bereskin & Parr Recognized in IAM Patent 1000 2021
- Managing Intellectual Property recognizes Bereskin & Parr and its professionals in the 2021 edition of IP STARS
- Bereskin & Parr recognized in Benchmark Litigation 2021
- 22 Bereskin & Parr Professionals Listed in the 2021 Canadian Legal Lexpert Directory