



**LORNE M. LIPKUS**  
**Partner**  
**Kestenberg Siegal Lipkus LLP**



Lorne M. Lipkus is a founding partner in the Toronto, Ontario, law firm of Kestenberg Siegal Lipkus LLP. He is the senior partner responsible for the firm's IP practice. He practices throughout Canada in the area of intellectual property litigation with a principal focus on protecting the intellectual property and the intellectual capital of his clients. His personal engagement with his clients enables him to customize end to end proactive and defensive solutions to combat the piracy, theft, and counterfeiting of his clients property. In addition to strategic defensive work, he actively litigates all manner of anti-counterfeiting cases (copyrights, trademarks, and industrial designs) as well as cases involving theft of confidential information, trade secrets, corporate opportunities and tangible property, by former employees, competitors, or others, as well as computer and other fraud and abuse.

Lorne's success is largely attributable to his extensive experience obtaining and enforcing extraordinary remedies including, Anton Piller Orders, Preservation Orders, injunctions and other declaratory relief. In addition to civil litigation, he has a proven track record working with law enforcement, customs, and other professionals. He regularly assists law enforcement in securing information and evidence necessary to obtain a criminal search warrant. He coordinates and secures the resources necessary to execute criminal search warrants; coordinates multi-country investigations and enforcements; deals with all aspects of anti-counterfeiting border enforcement; consults with respect to comprehensive brand protection programs to be implemented or already existing, both domestic and international; and creates multi-platform training programs designed and utilized by industry, government and law enforcement. Mr. Lipkus has had considerable experience in coordinating all aspects of enforcement issues involving Canadian legislation impacting on counterfeiting/pirating activities including the *Copyright Act*, *Trademarks Act*, *Patent Act*, *Industrial Design Act*, the *Radiocommunication Act* as well as *Criminal Code* offenses and the recently legislated *Combating Counterfeit Products Act*.

In addition to his litigation team, Lorne has also developed an extensive and effective network of professionals, including expert forensic investigators, computer forensic specialists, e-discovery professionals and others, to ensure the appropriate resources can be utilized quickly and cost-effectively for the benefit of his clients.

Mr. Lipkus has attended and presented workshop demonstrations of the firm's proprietary network anti-counterfeiting tracking and enforcement software program (N.A.T.E.) tracking information on the service of over 10,000 Anton Piller Orders, preservation orders, cease and desist letters, separate actions, investigations and law enforcement seizures across Canada. He is also actively involved in computer, domain name and Internet issues relating to anti-piracy/counterfeiting enforcement.

***Ranking and Recognition***

On June 8, 2016 at the 18<sup>th</sup> Annual Global Anti-Counterfeiting Awards in Paris, France, cosponsored by The Global AntiCounterfeiting Group and Managing Intellectual Property, Lorne was awarded an Individual Achievement Award for 2016 stating:

Lorne M. Lipkus of Kestenberg Siegal Lipkus LLP is a founding partner of one of the oldest and most established boutique litigation firms in Toronto and is a founding and currently active member of the Canadian Anti-Counterfeiting Network (CACN). He has worked tirelessly at the forefront of the campaign against the trade in fakes in Canada and



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internationally. His firm specializes in all forms of IP law but is particularly known for effective anti-counterfeiting enforcement and he was pivotal in working with the Canadian government on more effective legislation. Beyond pure IP law enforcement work, Lorne has been increasingly involved in the education and training of law enforcement agencies and in raising the awareness of the public, government and related agencies about the mechanisms and needs for anti-counterfeiting enforcement.

The only person continuously selected by the *World Trademark Review 1000* in their highest category (Gold Band) Canadian Anti-Counterfeiting Lawyer– The Definitive Guide to Trademark Legal Services, from inception of the rankings to date (2011-2018) which identifies the firms and individuals, by country, that are setting the industry benchmark for trademark legal services.

In reference to Mr. Lipkus it has stated, among other things:

“Lorne is known for constantly taking a leadership position in almost all aspects of anti-counterfeiting matters in Canada.”

“Anti-counterfeiting guru Lorne Lipkus is universally regarded as a pioneer in the fight against fakes”. “He is clearly the number one guy – he lives and breathes anti-counterfeiting.” “His overwhelming knowledge makes him a real asset to the industry in terms of both his contribution to legislative developments in Canada and his legal advice to clients.”

“Lorne Lipkus is “an icon among anti-counterfeiting litigators in Canada. He has probably seized more counterfeit goods on behalf of luxury brands than any other lawyer in the country. He is also very well connected with the police, so he is able to offer services on the enforcement front that no other party can. He really has his ear to the ground.”

“Founding partner Lorne Lipkus is “an outstanding advocate for trademark protection and one of the most dedicated, hardworking and knowledgeable professionals you could ever hope to work with.” The mere mention of his name makes infringers quake in their boots.”

Achieved an AV Preeminent Rating from Martindale-Hubbell being the highest possible rating for an attorney for both ethical standards and legal ability from 2013 to date.

Selected by the *World Trademark Review* from 2011 to 2018 to be the contributing author/firm to author the Canadian portion of the global guide on anti-counterfeiting laws, procedures and strategies.

Recipient of an Award in Recognition of Outstanding Contribution to the Toronto Police Service and the Community by the Toronto Police Service (2014)



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***Training Sessions and Lectures***

Mr. Lipkus coordinates and conducts training sessions, workshops and lectures across Canada dealing with anti-piracy\counterfeiting enforcement matters. He has done so on behalf of or in conjunction with:

- the RCMP, Ontario Provincial Police, Toronto Police Service as well as various other regional and municipal police forces
- representatives of Canada Border Services Agency (CBSA and other government agencies)
- Anti-counterfeiting organizations including the International Anti-counterfeiting Coalition (IACC), Canadian Intellectual Property Council (CIPC) and Canadian anti-counterfeiting Network (CACN)
- Canada Revenue Agency (CRA) and
- private investigators.

His training includes educating law enforcement about the impact of piracy\counterfeiting; particularizing ways in which to distinguish between authentic and pirated\counterfeit products; outlining techniques to assist law enforcement in obtaining criminal search warrants; and assisting law enforcement on behalf of brand owners in identifying and prosecuting criminal cases as well as all aspects of civil enforcement, online enforcement, investigation and enforcement on brick and mortar locations as well as the internet.

He has lectured on anti-piracy\counterfeiting matters at various educational meetings and conferences, including:

- ASIS International (American Society for Industrial Security)
- Association of International Automobile Manufacturers of Canada (AIAMC)
- American Bar Association
- American Bearing Manufacturers Association
- 20<sup>th</sup> Anti-Counterfeiting & Brand Protection Conference (IQPC)Brand Protection Packaging Forum
- Blue Line Expo
- BMO Financial Group Anti-Money Laundering
- Canada Border Services Agency (CBSA)
- Canada Revenue Agency (CRA)
- Canadian American Law Enforcement Organization (CALEO)
- Canadian Anticounterfeiting Network (CACN)
- Canadian Association of Importers and Exporters
- Canadian Association of Special Investigation Units (CASIU)
- Canadian Bar Association (CBA)
- Canadian Cosmetic, Toiletry and Fragrance Association (CCTFA)
- Canadian Intellectual Property Council (CIPC)
- Canadian Standards Association (CSA)
- CANASA (Canadian Security Canada)



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- Channel IQ Summit
- C.O. Bick College
- CNAC (Comité National Anti-Contrefaçon/National Anti-Counterfeiting Committee)
- Compass Canada
- Conestoga College, Law and Security Administration Program
- Crime Stoppers International
- Criminal Intelligence Service Canada (CISC)
- Electro Federation Canada (EFC)
- Embassy of France Symposium on Counterfeits
- European Forum of Intellectual Property/Forum Européen de la Propriété Intellectuelle
- Food & Consumer Products Canada
- Franco-Canadian Anti-Counterfeiting Conference (Embassy of France in Ottawa)
- Global Forum on Anti-counterfeiting
- The Guarantee Fall 2018 Insurance Symposium
- Health Canada
- Heating, Refrigeration and Air Conditioning Institute of Canada (HRAI)
- International Association of Women Police (IAWP)
- International Anti-Counterfeiting Coalition (IACC)
- International Authentication Association
- International Federation of Intellectual Property Attorneys (FICPI)
- Intellectual Property Institute of Canada (IPIC)
- International Trademark Association (INTA)
- Imaging Supplies Coalition (ISC)
- IQPC – Anti-Counterfeiting Summit
- Kestenberg Siegal Lipkus LLP Fraud and Anti-Counterfeiting Conferences (over 35 from 1996 to date)
- Luxury Goods and Jewellers Executive Forum
- McGill University/IPIC
- Mohawk College
- National Association of Drug Diversion Investigators (NADDI)
- Niagara Fraud and Counterfeit Workshop
- North West Fraud Investigators Association
- Ontario Association of Crime Stoppers (OACS)
- Ontario Bar Association
- Ontario Ministry of Government Services
- Ontario Provincial Police Anti-Rackets Conference
- Ontario Regional Collection Officers
- Operation Pipeline\Convoy\Jetway
- Osgoode Hall Law School (LLM Program)
- Pharmaceutical Sciences Group (PSG)
- Retail Council of Canada
- Rochester Institute of Technology
- Ryerson University
- Security Canada Association
- Tax Stamp Forum



- The University of Guelph
- Toronto Chinese Business Association
- Toronto Intellectual Property Group (TIPG)
- Visiongain – Anti-Counterfeiting Americas

Mr. Lipkus is the co-author of the following publications, amongst others:

Chapter 8, “Litigation of Counterfeit Goods” in Paul Lomic ed. *Intellectual Property Litigation: Forms and Precedents* (LexisNexis, 2016: Toronto).

- “Anti-counterfeiting 2018, A Global Guide”, ‘Canada’, World Trademark Review “
- “Anti-counterfeiting 2017, A Global Guide”, ‘Canada’, World Trademark Review “
- “Anti-counterfeiting 2016, A Global Guide”, ‘Canada’, World Trademark Review “
- “Anti-counterfeiting 2015, A Global Guide”, ‘Canada’, World Trademark Review”
- “Anti-counterfeiting 2014, A Global Guide”, ‘Canada’, World Trademark Review”
- “Anti-counterfeiting 2013, A Global Guide”, ‘Canada’, World Trademark Review”
- “Anti-counterfeiting 2012, A Global Guide”, ‘Canada’, World Trademark Review”
- “Anti-counterfeiting 2011, A Global Guide”, ‘Canada’, World Trademark Review”
- “Anti-counterfeiting 2010, A Global Guide”, ‘Canada’, World Trademark Review”
- “Taking The Fight To The Counterfeiters: Practitioners From Around The Globe Offer Practical Advice On Creating Effective, Budget-Friendly, Anti-Counterfeiting Strategies” World Trademark Review (Issue 27, October/November 2010).
- Counterfeiting Perspectives: Dealing with Ineffective Canadian Laws”, World Trademark Review (Issue 15, September/October 2008).
- “International Counterfeits: A Practical Primer on Anti-counterfeiting Enforcement in Canada”, Canadian International Lawyer (Issue Vol 6. No. 4, 2006).
- Canadian Forms & Precedents – Debtor/Creditor 2<sup>nd</sup> Edition, LexisNexis Canada

Mr. Lipkus has also authored/co-authored numerous publications/presentations for online training, webinar issues and continuing legal education of lawyers and other professionals. In addition to the lectures, publications and training sessions Mr. Lipkus conducts in the intellectual property area, he is a published author and lecturer on both franchise litigation and the execution of judgments. He has been qualified as an expert in the identification of counterfeit merchandise in several cases before the Federal Court of Canada.

Mr. Lipkus has been counsel in a number of the early Federal Court cases of significance to anti-piracy\counterfeiting enforcements, as well as others, on behalf of rights holders, including:

*Louis Vuitton Malletier S.A. et al v. Zekria Wakilzada et al, 2017 ONSC 2409 (CanLII)* (April 19, 2017 Mr. Justice Cavanagh) The Plaintiffs successfully appealed from an Order striking out paragraphs of Louis Vuitton's Statement of Claim that the Plaintiffs submitted were material facts supporting a novel extension of the theory of vicarious liability to a landlord arising from its tenant's sale of counterfeit merchandise. The Court agreed with the Plaintiffs' submission that the necessary elements for a cause



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LEGAL  
TECHNOLOGY  
INFORMATION

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of action founded upon vicarious liability are unsettled, and may change depending upon the application of this doctrine and the underlying policy considerations to new situations.

*Louis Vuitton Malletier S.A. et al v. Bhatia et al* (May 13, 2015 Mr. Justice Campbell, as yet unreported) in which we acted on behalf of the Plaintiffs in obtaining the largest monetary judgment for 1 Plaintiff group against 1 group of counterfeiters in Canadian history, in the aggregate of over \$3,100,000.00CDN.

*Guccio Gucci S.p.A. et al v. Bhatia et al* (March 23, 2015 Mr. Justice Brown, as yet unreported) in which we acted on behalf of the Plaintiffs in obtaining the largest monetary judgment for 1 Plaintiff against 1 group of counterfeiters in Canadian history, in the aggregate of over \$2,000,000.00CDN.

*Moroccanoil Israel Ltd v Lipton*, 2013 FC 667, Moroccanoil succeeded in its motion for summary judgment relating to the infringement of its registered trade-marks against one of the Defendants, Edward Sivitilli. Sivitilli who filed a Statement of Defence, denying the allegations. The Court evaluated whether the genuine issues for trial, raised by the Defendant, were indeed, 'genuine'. Moroccanoil established the claims through affidavit evidence, including that the product sold in association with its trade-marks was counterfeit, and that harm and damage was caused by the offering for sale of the counterfeit product. In particular, the Court noted that the Defendant was required to put its "best foot forward" and not rely on unsupported statements to argue that there is a genuine issue for trial. Damages were assessed and awarded.

*Guccio Gucci SpA v Mazzei* (2012), 101 CPR (4th) 219 (FCTD). Following a well-orchestrated undercover investigation including, a clandestine meeting at a Toronto gas station, and hidden cameras – disclosing a wholesale counterfeiting operation run from a storage facility, owned by a third party, the Plaintiffs, in a contested summary judgment motion, secured a judgment of trade-mark infringement and an award of \$85,000.00 in damages, injunctive relief, plus costs.

*Harley-Davidson Motor Co et al v Manoukian et al* (2013), 112 CPR (4th) 404 (FCTD). The court granted summary judgment in favour of the Plaintiffs for trademark infringement and awarded damages, including punitive damage, injunctive relief and ordered the delivery up of infringing merchandise. The Court was satisfied the matter could proceed on a motion for summary judgment notwithstanding conflict in some of the evidence. In determining the damage award, the Court noted that where Defendants provide no records to substantiate the manufacture and sale of counterfeit wares, it is difficult to assess damages. In spite of that the Court, in awarding damages, applied a minimum compensatory damage award on a per infringing activity basis.

*Moroccanoil Israel Ltd. V. Shoppers Drug Mart Corporation*, 2010 FC 901. On appeal from a Prothonotary's order, this case clarified that there is no *prima facie* right to security for costs and that such awards are within the discretion of the Court. The court reaffirmed that while security for costs will generally be required if one of the conditions listed under Rule 416(1) is met, the Court retains discretion to deny a request, which it did in this case. The Plaintiff, whom we acted for, being a company incorporated pursuant to the laws of Israel, and ordinarily resident outside Canada, established that security for costs should not issue against it because, in part, it is the owner, in Canada, of a registered trade-mark; it has a distribution network in Canada, and as a result, it is owed significant monthly receivables with a Canadian company.



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It also has a 50% undivided, and unencumbered, title and interest in lands and premises situated in Canada.

*Calvin Klein Trademark Trust v. Beauchamp*, 2010 FC 1107 (CanLII). Successfully stopped defendants from setting aside default judgment and vacating writs. Court clarified that a simple denial of the allegations in a claim, without offering some evidence to show that the defence has some merit, such as an affidavit from the supplier attesting that the goods were manufactured under license, does not meet even the low threshold for showing that a *prima facie* defence is available

*Gianni Versace S.p.A. v. 1154970 Ontario Ltd.*, 2003 F.C. 1015 [clarifying the legal and evidentiary bases to obtain Court Orders preserving infringing merchandise in actions where destruction or disposition of infringing merchandise is an issue]

*Ragdoll Productions (UK) Limited et al v. Doe*, [2003] 2 F.C. 120 (F.C.T.D.) [clarifying and validating awards of minimum compensatory damages for infringement of intellectual property rights in circumstances where the Defendants conduct their business in a manner that renders traditional damage and profit analysis unavailable]

*Tejani v. Nintendo of America Inc.* 2001 FCA [Federal Court of Appeal decision affirming decision that Charter of Rights and Freedoms is not applicable to the issuance and execution of Anton Piller Orders]

*Gianni Versace S.p.A. et al v. V. K. Design Inc. c.o.b. Laco Sac et al*, unreported (Court File No. T-1575-01 - December 10, 2001) [application of principles of minimum compensatory damage awards for conduct pre-dating and post-dating notice of infringing conduct (i.e. 'double damages')]

*Club Monaco Inc. v. Woody World Discounts Ltd.* (1999) 2 C.P.R. (4<sup>th</sup>) 436 [examining the sufficiency of evidence and detailing the requirements to be contained in affidavits filed to obtain Anton Piller Orders]

*Nike Can. Ltd v. Doe* (1999) 174 F.T.R. 131 [reviewing the procedures required for execution of Anton Piller Orders]

*Fila Can. Inc. v. Doe* (1996) 3 F.C. [establishing the procedure to obtain and review the service of a rolling John Doe Anton Piller Order and establishing the first "model" Anton Piller Order]

Since at least the early 1990's Mr. Lipkus has obtained over 8,000 judgments for over 100 Plaintiffs in counterfeiting/pirating cases in Canada. Many have resulted in significant recoveries for rights holders. He has also assisted law enforcement in Canada in several hundred criminal cases involving counterfeiting/pirating.

### **Memberships**

Mr. Lipkus has been a member of the International Anti-Counterfeiting Coalition (IACC) since 1998 and is also a member of the Canadian Bar Association (CBA), the American Bar Association (ABA), International Trademark Association (INTA), Intellectual Property Institute of Canada (IPIC), the Law Society of Ontario, Canadian Intellectual Property Council (CIPC), was a Patron of the International



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Authentication Association, is a founding member of the Canadian Anti-Counterfeiting Network (CACN), and a member of the Toronto Intellectual Property Group (TIPG).

Mr. Lipkus serves as Vice-Chair and Chair for the Education and Training Committee of the Canadian Anti-Counterfeiting Network as well as Chair of the Anticounterfeiting Committee of IPIC and was the Chair of the Security Committee of the American Chamber of Commerce in Canada (AmCham) and Chair of the Education and Training Committee of the Canadian Intellectual Property Council. He also served as Chair for the Counterfeiting and Trade Offenses Committee of the Canadian Bar Association for several years and remains a committee member. He is also a member of the INTA Copyright Enforcement Subcommittee and Chair of the IACC's North America Task Force Canada Subcommittee.

***Education***

Mr. Lipkus received his *Bachelor of Arts (Hons.)* from Concordia University in 1975. He graduated from McGill University with a *Bachelor of Civil Law* in 1978 and a *Bachelor of Laws* in 1979, and was called to the Ontario Bar in 1981.

***Media***

Mr. Lipkus continues to be quoted extensively in most major daily print media in many cities in Canada (including the Toronto Star, Toronto Sun, Globe and Mail, National Post) in addition to being interviewed on all national Canadian television stations, many regional outlets and numerous radio stations. He has also been featured in CBC "Venture", CBC "Doc Zone", CBC "The Lang & O'Leary Exchange", CBC "The Exchange with Dianne Buckner", CTV "Your Morning" with Ben Mulroney, CTV "W5", CTV "Canada AM", CP24, including "Stephen LeDrew Live", City TV's "Breakfast Television", BNN "Business Day", TVO "Museum Diaries", TSN, W5 "Faking It: The Name Game" and RDI "Enquête" television shows. Mr. Lipkus has been the host or guest speaker on numerous intellectual property related webinars and online presentations and interviews, including on "Electrical Business".