



## Jeffrey Vicq

Partner

Intellectual Property  
Information Technology  
Higher Learning  
Technology Transactions and Emerging Company Services

604 643 3178  
[jvicq@cwilson.com](mailto:jvicq@cwilson.com)

### Profile

Jeffrey Vicq is a partner of the firm and Chair of the Intellectual Property and Information Technology Groups.

He has extensive experience with intellectual property law matters and with complex commercial law issues that typically arise in the development, implementation, exploitation and transfer of information technology-related products and services.

"Jeff responds with substantive answers to client questions rapidly and with advice that reflects a level of understanding of trademark strategy that is second to none. For an in-house counsel, he's a dream - you won't find a better or more practical law firm partner."

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### Work Highlights

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**Lead trademark counsel for world's leading online retailer**

- > Lead all aspects of Canadian trademark clearance, filing, registration, maintenance, and enforcement of trademark rights for the world's leading online retailer. Additionally provide strategic international portfolio advice, copyright advice, and domain-name related services

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### **Co-lead trademark counsel to world's leading search engine services provider**

- > Conduct all aspects of Canadian trademark clearance, filing, registration, maintenance and enforcement of trademark rights for the world's leading search engine services provider.

*Additional work highlights below*

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### **Intellectual Property Services**

- > Trademark registration, enforcement, licensing and portfolio counseling
- > Copyright registration, enforcement, licensing and counseling
- > Domain name registration, acquisition and disputes
- > Intellectual property audits and due diligence
- > Social media advice and counseling
- > The transfer and commercialization of IP rights
- > Intellectual property aspects of employment and contractor agreements

### **Technology Law Services**

- > Master agreements for the procurement of hardware, software and professional services
- > Hardware and software design and development agreements
- > Software licensing and support agreements, including for SaaS, IaaS, and PaaS services
- > Open source software licenses and related issues
- > Hosting and co-location agreements
- > Outsourcing agreements
- > Licensing, bundling and distribution agreements
- > Marketing and promotional agreements
- > Manufacturing, supply, distribution and sales representative agreements
- > Website terms of use and privacy policies
- > Internal and external technology use policies
- > Personal information protection, privacy policies and guidelines

Jeffrey is a frequent speaker and lecturer in both Canada and the United States on intellectual property and technology matters. He routinely authors articles outlining developments impacting businesses and organizations in the technology, information technology and education sectors.

Jeffrey has been repeatedly recognized as one of the Best Lawyers in Canada in the areas

of technology law and information technology law. He is also recognized as a Leading Trademark Practitioner by World Trademark Review 1000:

Jeffrey is "a revolutionary outside-the-box thinker and a strong partner. His combination of trademark knowledge, business acumen, efficiency, effectiveness and personality are unmatched - a phenomenal trademark attorney."

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With precise, business-practical and responsive service, Jeffrey supports his client's efforts to advance their business goals.

## Credentials

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### Awards & Distinctions

- > World Trademark Review 1000, Leading Trademark Practitioner - Prosecution and Strategy
- > Listed in Who's Who as one of the leading trademark lawyers in Canada
- > Best Lawyers in Canada, Information Technology Law, Intellectual Property Law, Technology Law, 2014-2022

### Industry Involvement

- > International Trademark Association, Trademark Legislation and Regulation Committee (Canada Subcommittee)
- > Intellectual Property Institute of Canada, Trademark Practice Committee

### Education & Call to Bar

- > Master of Laws (Concentration in Law and Technology), University of Ottawa, 2007
- > Registered Canadian Trademark Agent
- > Calls to Bar: Saskatchewan, 1999; British Columbia, 2002
- > Bachelor of Laws, University of Saskatchewan, 1998

### External Publications & Presentations

- > Quoted in "A long-time coming' - experts praise Canadian government's creation of independent regulator for IP agents", World Trademark Review - Daily (30 June 2021)
- > "The burdens of popularity - Canadian examination times and new office practices" World Trademark Review (3 June 2021), co-publication (Co-author, with N. Melliship)
- > Quoted in "CIPO takes concrete steps to address examination delays, but applicant frustrations look set to continue for some time", World Trademark Review - Daily (6 May 2021)
- > "Use of Marks on the Internet", Intellectual Property Institute of Canada, (March 9, 2021), Co-author and Speaker, with K. MacDonald
- > "Call Me! CIPO rings up an enhanced telephone amendment practice for trademarks" World Trademark Review (4 June 2020), co-publication (Co-author, with N. Melliship)
- > "Looking high and searching low - where did my Canadian filing go?" World Trademark Review (9 April 2020), co-publication

- > "Trade-mark Use and the Internet", Intellectual Property Institute of Canada, (March 31, 2020), Co-author and Speaker, with K. MacDonald
- > CIPO's practice notice alters extension period to respond to an examiner's report" World Trademark Review (26 March 2020), co-publication (Co-author, with A. Malik and C. Camp)
- > "Canadian official marks can infringe the rights of prior trademark owners" World Trademark Review (12 March 2020), co-publication (Co-author, with A. Malik)
- > "Trade-mark Use and the Internet", Intellectual Property Institute of Canada, May 9, 2019 (Speaker)
- > "Canadian Trademark Reform", International Trademark Association (Portland), April 11, 2019 (Speaker)
- > "Canadian Update on Trademark Law for U.S. Practitioners", International Trademark Association (San Francisco), September 24, 2018 (Speaker)
- > Quoted in "Collaborative Branding: Trademark Lawyers and Marketers", World Intellectual Property Review, (25 May 2018)
- > "What Can Trademark Practitioners Learn from Advertising and Marketing Professionals?", delivered at the Annual Meeting of the International Trademark Association, May 23, 2018 (Moderator)
- > "Delays Nourish Desires: Canada's Trade-Marks Act" The Trademark Lawyer Issue 3 2018 (May 2018) 95 (Co-author, with N. Melliship)
- > "Intellectual Property Law - Copyright Chapter" Annual Review of Law & Practice, The Continuing Legal Education Society of British Columbia, 2018 (Co-author, with A. Malik)
- > "Intellectual Property Law - Copyright Chapter" Annual Review of Law & Practice, The Continuing Legal Education Society of British Columbia, 2017 (Author)
- > Quoted in N. Bennett, Fast changing technology sector keeps lawyers and law firms on their toes, Business in Vancouver Issue 1388 (June 7, 2016) 19
- > Canadian Trade-mark Practice for U.S. Trademark Practitioners, Seattle University School of Law, INTP 316: Trademark Administration, 2009-2016 (Guest Lecturer)
- > Intellectual Property Law - Copyright Chapter Annual Review of Law & Practice, The Continuing Legal Education Society of British Columbia, 2016 (Author)
- > Mission: Transition The Trademark Lawyer Issue 1 2015 (February 2015) 30 (Co-author, with N. Melliship)
- > Intellectual Property Law - Copyright Chapter Annual Review of Law & Practice, The Continuing Legal Education Society of British Columbia, 2015 (Author)
- > Use Madrid Nice[ly] - A Roundtable Discussion on the Omnibus Budget Bill Amendments to the Trademarks Act, Canadian Bar Association, 2014 (Co-author and Speaker, with K. MacDonald)
- > Intellectual Property Law - Copyright Chapter Annual Review of Law & Practice, The Continuing Legal Education Society of British Columbia, 2014 (Author)
- > Canadian Trade-mark Law: Old Eccentricities and New Developments, Oregon State Bar Association - Intellectual Property Section, 2014 (Author and Speaker)
- > Quoted in I. Daro, Royal Canadian Legion tells Reddit to remove poppy symbol over trademark concerns, Canada.com/Postmedia, (29 October 2013)

- > The New Copyright Modernization Act (Bill C-11), Canadian Bar Association, 2013 (Co-author and Speaker, with C. Wilson)
- > Protecting Your Intellectual Property, Business Beyond Borders-Central Okanagan Economic Development Commission, 2011 (Author and Speaker)
- > Quirky Canucks: Eccentricities of the Canadian Trade-mark System, WebIPHour - Association of Intellectual Property Firms, 2011 (Author and Speaker, with M. Roman).
- > Intellectual Property Law - Copyright Annual Review of Law & Practice, The Continuing Legal Education Society of British Columbia, 2011 (Author)
- > Electronic Commerce in Canada: The Enforceability of Online Agreements and Consumer Protection Considerations, 5th Annual Internet Law Conference, Calgary, Federated Press, 2011 (Author and Speaker)
- > Canada considering big changes to trade-mark practice International Lawyers Network The Bulletin Newsletter Volume 9:2, 2010 (Author)
- > E-Exporting: Legal Considerations for Exporting Technology, Foreign Affairs and International Trade Canada, 2010 (Author and Speaker)
- > Report from Canada: Significant Prosecution Changes Coming?, ITMA Review - The Journal of the Institute of Trade Mark Attorneys 379 (October 2010) 26, The Institute of Trade Mark Attorneys (UK)
- > Canada's faithful: avoiding fraud claims at the IPO World Trademark Review Issue 27 (October / November 2010) 59
- > Legal Issues for Digital Media, Centre for Digital Media, Masters of Digital Media Program, 2008-2010 (Guest Lecturer)
- > Quoted in A. Smith, Canada's police force sounds ready to give up on IP enforcement World Trademark Review - Daily (22 September 2010)
- > Quoted in A. Smith, Is Canada finally preparing to join the 21st Century? World Trademark Review - Daily (2 June 2010)
- > Quoted in A. Smith, As INTA kicks off, it's clear that trademarks are back World Trademark Review - Daily (24 May 2010)
- > 'Bad faith' decisions bad news for trade-mark applicants?, IP Osgoode IPilogue (10 May 2010)
- > Intellectual Property Law - Copyright Chapter Annual Review of Law & Practice, The Continuing Legal Education Society of British Columbia, 2010 (Author)
- > How defamation defences benefit the Twitiverse The Lawyers Weekly (12 February 2010) (Author)
- > Quoted in T. Little, Political pressure results in Canadian consultation on Madrid adoption World Trademark Review - Daily (12 January 2010)
- > Quirky Canadians: Canadian Trade-mark Eccentricities for U.S. Practitioners, Oregon State Bar Association - Intellectual Property Section, 2009 (Author and Speaker)
- > Canadian Intellectual Property Office Tosses IP Applicants a Change-Up, International Lawyers Network The Bulletin Newsletter, Volume 8:2, 2009 (Author)
- > Quoted in A. Smith, Psion surrenders NETBOOK trademarks World Trademark Review - Daily (2 June 2009)
- > Report from Canada: More Changes to Opposition Practice, ITMA Review - The Journal of the Institute of Trade Mark Attorneys 364 (April 2009) 32, The Institute of Trade Mark

Attorneys (UK)

- > Understanding Electronic Commerce in Canada: An Update, 2nd Annual Internet Law Conference - Vancouver, Federated Press, 2009 (Author and Speaker)
- > Quoted in A. Smith, Intel rejects Psion's rights in latest NETBOOK clash World Trademark Review - Daily (24 March 2009)
- > Quoted in A. Smith, Spare parts and cybersquatting: the fight for NETBOOK World Trademark Review - Daily (10 March 2009)
- > Quoted in C. Crosby, Social Networking For Lawyers The Lawyers Weekly (27 February 2009)
- > Interviewed by R. Daya, 2010 Motto Global National, Global Television, Vancouver (26 September 2008)
- > Interviewed by M. Blanchard, With Glowing Hearts Calgary Today, 770 CHQR Radio, Calgary (26 September 2008)
- > Bouquets and Brickbats: The Informational Privacy of Canadians, On The Identity Trail, 2006 (Author)
- > Northern Exposure: Lessons from Canada's National Privacy Law Regime, Life, Liberty and Digital Rights, Association for Computing Machinery, 2006 (Author and Speaker)
- > On the Data Trail: A Report on the Canadian Data Brokerage Industry, Canadian Internet Policy and Public Interest Clinic, 2006 (Co-author, with P. Lawson)
- > Intellectual Property, British Columbia Institute of Technology, Elex 8290: Engineering Law, 2005 (Speaker)
- > An Intellectual Property Primer, University of Victoria Business Law Clinic, 2001-2005 (Author and Speaker)
- > Exempting BC and Alberta: Stitching the Seamless Continuum, Canadian Privacy Law Review, 1:9, 2004 (Co-author, with C. Wilson)
- > Living With BC's Privacy Legislation - What Charities Need To Know, Pacific Business & Law Institute, 2004 (Author and Speaker)
- > Securing Your Assets: Intellectual Property Protection, Architectural Institute of British Columbia, 2004 (Author and Speaker)
- > BC's New Privacy Legislation - A Workshop, The Alliance for Arts and Culture, 2004 (Author and Speaker)
- > Intellectual Property for Software Engineers, Association of Professional Engineers and Geoscientists of British Columbia, 2004 (Speaker)
- > Quoted in J. Heath-Rawlings, Canadian, U.S. IP Law Gap Grows The Globe and Mail (14 July 2003)
- > Managing The Relationship: Private Sector Privacy in British Columbia, The Association for Healthcare Philanthropy, 2003 (Author and Speaker)
- > Important Decision Disallows Patenting of Higher Life Forms in Canada, The Continuing Legal Education Society of British Columbia, 2002 (Author)
- > Planning for Privacy, Canadian Association of Gift Planners, 2002 (Author and Speaker)
- > The Library of Babel: Advanced Legal Research Techniques, Saskatchewan Legal Education Society, 2001 (Author and Speaker)
- > The Progression of our 'Consensual Hallucinations:' Advanced Uses of the Internet and the Future of Legal Technology, Saskatchewan Legal Education Society, 2001 (Author

and Speaker)

- > An Agricultural Biotechnology Primer for Lawyers, Canadian Bar Association Bar Notes, 2001 (Co-author, with D. Konkin)

## **Additional Work Highlights**

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### **Legal leadership for enterprise software procurement**

- > Lead several multi-year projects supporting the procurement and implementation of enterprise software solutions for preeminent Canadian post-secondary institution

### **Guidance to governmental agencies**

- > Provide legal support to various governmental agencies in the procurement and implementation of various complex hardware, software and service solutions.

### **Representation of leading restaurant brands**

- > Canadian lead working for one of the world's largest quick service restaurant companies, providing trademark clearance and filing services, as well as marketing-related advice, in support of several well-known brands

### **Trademark counsel to prominent content producer and provider**

- > Provide trademark-related advice to the world's best-known streaming media subscription service provider

### **Outside counsel to leading technology administrative services organization**

- > Provide legal advice relating to the procurement, implementation and support of enterprise cloud solutions for a leading technology administrative services organization

### **Primary Canadian trademark advisor to luxury retailer**

- > Lead a team supporting a leading North American luxury retailer, advising on trademark and marketing-related issues.

### **Canadian portfolio management for world's largest aerospace company**

- > Provide trademark filing, registration, maintenance, and enforcement services for one of the world's largest aerospace manufacturers

### **External legal counsel to leading health care services providers**

- > Serve as legal advisor on numerous projects relating to the procurement of enterprise software and hardware solutions for some of the largest health care service providers in Canada

### **Advisor to high-profile mobile handset manufacturer**

- > Conduct Canadian trademark clearance, filing, registration, maintenance, and enforcement for leading manufacturer of mobile handsets and virtual reality displays

### **Lead counsel for complex automated passport control solution project**

- > External legal team lead on a multi-year project relating to the development and distribution of an automated passport control solution, addressing a wide range of procurement, technology, security, commercial, and intellectual property issues in various countries

### **Worldwide portfolio management for internationally beloved toy maker**

- > Manage and coordinate enforcement of a global trademark portfolio covering stuffed animals, children's toys, and gifts in Canada, the U.S., Europe, Australia, China, other parts of Asia, and Africa, and advise on acquisitions relating to that portfolio. Additionally, provide guidance on copyright and domain name issues

### **Primary legal advisor to educational publisher**

- > Lead a team supporting the leading publisher of online high school career & elective courses, advising on a broad range of technology, commercial, employment and intellectual property issues