

## PETER GIDDENS\*



**Categories:** [People](#), [Lawyers](#)

Peter Giddens is a highly regarded intellectual property (IP) lawyer and registered trademark agent who assists clients on the acquisition, disposition, clearance, use, protection, enforcement and licensing of intellectual property. He has particular expertise in trademark, copyright and domain name issues, and extensive experience advising clients in the technology, franchising, marketing and advertising and media and communications sectors. Peter frequently advises on IP issues in complex acquisitions and divestitures and negotiated commercial transactions.

Active in all aspects of trademark law, Peter prepares and prosecutes applications to register trademarks before the Canadian Intellectual Property Office, co-ordinates international filings, and manages domestic and foreign trademark portfolios. He also negotiates trademark licence agreements and other agreements affecting IP rights, and manages and protects trademark portfolios for international franchise systems.

A significant portion of Peter's practice is dedicated to representing clients in contentious matters such as trademark opposition and expungement proceedings before the Trademarks Opposition Board, and domain name dispute proceedings under the Uniform Domain-Name Dispute-Resolution Policy (UDRP) and the CIRA Domain Name Dispute Resolution Policy (CDRP). He also represents and advises clients in matters of trademark infringement, passing off and copyright infringement.

Peter was recently recognized by *Chambers Canada* and *Best Lawyers in Canada* as a leading lawyer in the area of Intellectual Property. He is also a past chair of the Trademark Office Practices Committee of the International Trademark Association and a leader of the firm's Intellectual Property Group.

**Email:** [peter.giddens@mcmillan.ca](mailto:peter.giddens@mcmillan.ca)

**Expertise:** Franchising & Distribution, Intellectual Property, Marketing & Advertising, Media, Communications & Entertainment, Technology

**LinkedIn:** <https://www.linkedin.com/in/petergiddens/>

**Location:** Toronto

**Phone:** 416.307.4042

**Position/Title:** Partner, Intellectual Property

**Community Involvement:**

- Coaches minor league hockey; fundraises for United Way

**Directorships & Affiliations:**

- Director General's Advisory Committee (CIPO-TIDB)
- International Trademark Association (INTA), Legislation & Regulation - Canada Subcommittee (2020-2021 and 2022-2023)
- International Trademark Association (INTA), Chair of the Trademark Office Practices Committee & Co-Chair of the North American Advisory Council (2018-2019)
- International Trademark Association (INTA), Vice-Chair of the Trademark Office Practices Committee (2016-2017)
- International Trademark Association (INTA), TOPC-Canada Subcommittee Chair (2012-2015)
- Intellectual Property Institute of Canada (IPIC), Trademark Practices Committee

## Publications:

- "[Franchising in Canada: 2022 Year in Review](#)," (January 2023)
- "[A Trademark Primer for Franchising in Canada](#)," Franchising World (May 2019)
- "[Milano Pizzeria Case Study: Hard Lessons Learned by Canadian Licensor](#)" The Licensing Journal (April 2019)
- "[Internet and E-Commerce Law In Canada](#)," Social Media and Website as National Communication Platforms in Canada in Light of French Language Requirements (July 2015)
- "Brand Promotion and Unauthorized Trademark Use in Virtual Worlds," *INTA Bulletin*, Vol. 62, No. 17 (September 2007)
- "Can Copyright Curb Grey Marketing? - The Supreme Court Speaks," *Toronto Law Journal* Vol. 2, No. 8 (September 2007)
- "Don't Get Burned in Effigi: A Warning to Unregistered Trade Mark Users," *Lang Michener Intellectual Property Brief* (Fall 2004)
- "Selection of Registrar: Important Considerations for Domain Name Registrants," *Lang Michener Intellectual Property Brief* (Spring 2004)
- "Trade Dress Protection In Canada," *INTA* (November 2003)
- "Canada Mulls Joining Madrid," *INTA Bulletin* Vol. 58, Issue 14 (August 2003)
- "Domain Name Issues in Commercial Transactions," *Lang Michener Intellectual Property Brief* (July 2001)
- (July 2001) ".biz and .info Implementation Schedule Update," *Lang Michener Intellectual Property Brief*
- "Protecting Trade Mark Owners' Rights Under the New .biz and .info Domain Name Registration Procedures," *Lang Michener Intellectual Property Brief* (June 2001)
- "Changes to .ca Domain Name System," *Lang Michener Intellectual Property Brief* (Summer 2000)
- "Do Your Own Patent Search," *Biotech* (June 1999)

## Education & Admissions:

**Degree:** Called to the Ontario bar

**Year:** 1999

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**Degree:** LLB

**University:** Dalhousie University

**Year:** 1997

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**Degree:** B.Sc. (Hons. Biology)

**University:** University of King's College/Dalhousie University

**Year:** 1994

**Rankings & Recognition:**

- Recognized in the 2023 Canadian Legal Lexpert Directory as a Repeatedly Recommended Lawyer in the area of Intellectual Property
- Recognized by Chambers Global (2023) as a leading lawyer in the area of Intellectual Property
- Listed in World Trademark Review's WTR 1000 (2023) – Silver – Individuals: prosecution in Canada
- Recognized by Chambers Canada (2023) as a leading lawyer in the area of Intellectual Property
- Recognized by *Best Lawyers* in Canada (2023) as a leading lawyer in the area of Intellectual Property Law
- Listed in Who's Who Legal: Global 2022 as a leader in Intellectual Property: Trademarks
- Listed in Who's Who Legal: Canada 2022 as a leader in Trademarks
- Listed in Managing Intellectual Property's 2022 IP STARS Guide as a Trademark Star
- Recognized by Chambers Global (2022) as a Recognized Practitioner in the area of Intellectual Property
- Recognized in the 2022 Canadian Legal Lexpert Directory as a Repeatedly Recommended Lawyer in the area of Intellectual Property
- Recognized by Chambers Canada (2022) as a leading lawyer in the area of Intellectual Property
- Recognized by Best Lawyers in Canada (2022) as a leading lawyer in the area of Intellectual Property Law
- Listed in Who's Who Legal: Global 2021 as a leader in Intellectual Property: Trademarks
- Listed in Who's Who Legal: Canada 2021 as a leader in Trademarks
- Recognized in the 2021 Canadian Legal Lexpert Directory as a Repeatedly Recommended Lawyer in the area of Intellectual Property
- Recognized in the 2021 Lexpert Special Edition on Canada's Leading Technology Lawyers as a Leading Technology Lawyer
- Recognized by Chambers Global (2021) as a Recognized Practitioner in the area of Intellectual Property
- Recognized by the Best Lawyers in Canada (2021) as a leading lawyer in the area of Intellectual Property Law
- Recognized by Chambers Canada (2021) as a leading lawyer in the area of Intellectual Property
- Listed in Who's Who Legal: Canada 2020 as a leader in Trademarks
- Recognized in the 2020 Canadian Legal Lexpert Directory as a Repeatedly Recommended lawyer in the area of Intellectual Property
- Recognized by Chambers Global (2020) as a Recognized Practitioner in the area of Intellectual Property
- Recognized by Chambers Canada (2020) as a leading lawyer in the area of Intellectual Property
- Recognized by Best Lawyers in Canada (2020) as a leading lawyer in the area of Intellectual Property Law

- Listed in Who's Who Legal: Canada 2019 as a leader in Trademarks
- Listed in 2019 Managing Intellectual Property's IP Stars - The Guide to the World's Leading IP Firms and Practitioners
- Recognized by Best Lawyers in Canada (2019) as a leading lawyer in the area of Intellectual Property Law
- Listed in Who's Who Legal Canada: 2018 as a leader in Trademarks
- Listed in Best Lawyers in Canada (2018) as a leading lawyer in the area of Intellectual Property Law
- Repeatedly recommended, Intellectual Property, in the 2017 Canadian Legal Lexpert Directory
- Listed in the Canadian Legal Lexpert Directory 2016 as leading lawyer in the area of Intellectual Property
- Leadership in Mentoring Award (2016)
- Listed in World Trademark Review's WTR 1000 – The World's Leading Trademark Professionals
- Listed in Managing Intellectual Property's IP Stars - The Guide to the World's Leading IP Firms and Practitioners
- Recipient of the International Trademark Association Service Award for the Advancement of Trade Mark Law, 2005

#### **Speaking Engagements:**

- *Protecting the Business's Brand* (Life Cycle of a Business Series), Toronto
- September 17, 2020

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- *Portfolio Management Under Canada's New Trademarks Act*, Toronto
  - February 21, 2019

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- *IP Rights in Bluenose II*, Dalhousie Law School Law Hour, Dalhousie University, Halifax

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- *Official Marks* (5 O'Clock Lecture Series), Toronto
  - March 2003

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- *Domain Names in Corporate Transactions* (5 O'Clock Lecture Series), Toronto
  - 2001

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- *Trademark Registration Process in Canada*, Toronto
  - February 28, 2001

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- *Protecting the Business's Brand* (Life Cycle of a Business Series), Toronto



- August 8, 2018

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- *IP Fundamentals for Business Lawyers*, Toronto

- April 4, 2016

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- *Disruptive Technologies: Mitigating Legal Risks* (Enabling Ideas: Conquering Disruption), Toronto

- May 22, 2015

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- *Navigating Copyright Law: a Risk Management Roadmap*, Toronto

- February 3, 2015

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- *IP Issues for Financing Lawyers: IP as Collateral*, Toronto

- June 21, 2012

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- *Imminent Domain: Domain Name Issues for Brand Owners* (5 O'Clock Lecture Series), Toronto

- November 2007

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- *Trademark Issues on the Internet* (Intellectual Property Institute of Canada 2007 Spring Meeting, Gatineau, Quebec)

- 2007

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- *Current Issues in Intellectual Property* (5 O'Clock Lecture Series), Toronto

- September 2006

### **Representative Matters:**

- Acted as counsel in more than 200 trademark opposition and summary expungement proceedings
- Acted as counsel in more than two dozen domain name dispute resolution arbitration cases
- Advised a professional sports league concerning IP issues in various legal proceedings arising from human rights complaints regarding a team's use of its registered trademark
- Acted as intellectual property counsel to Rogers Media in its acquisition of CityTV from CTVglobemedia
- Acted as intellectual property counsel to AXA Canada in its acquisition of The Citadel General Assurance Company
- Acted as intellectual property counsel to Trader Media Corp. in its acquisition by Yellow Pages Media Group

- Advised Rogers Stadium Limited Partnership, part of Rogers Communications, on intellectual property issues during its purchase of the Toronto SkyDome (now Rogers Centre)
- Acted as intellectual property counsel to Rogers Communications in its acquisition of The Toronto Blue Jays Baseball Club and continues to provide intellectual property advice to the team's ownership, including sponsorship, licensing and marketing activities
- Provides ongoing counsel to world-famous brands in industries including: beverage alcohol, insurance, financial services, furniture retail, professional sports; entertainment; film production; telecommunications; education; cosmetics; food; security; professional services; software; kitchen appliances
- Meets with government officials regarding proposed changes to Canada's trademark legislation and regulations
- Acted as the principal drafter of the submissions by the International Trademark Association (INTA) to the Government of Canada's various consultations concerning Canada's accession to the Madrid Protocol, the Nice Agreement and the Singapore Treaty and the related amendments to the Trademarks Act and the Trademarks Regulations
- Called by the House of Commons Standing Committee on Industry, Science and Technology to testify as an expert witness concerning Bill C-8 (An Act to amend the Copyright Act and the Trade-marks Act and to make consequential amendments to other Acts)

**Industries:** Franchising & Distribution, Marketing & Advertising, Media, Communications & Entertainment, Technology

**Practices:** Intellectual Property