



Education

University of Toronto Faculty of Law
(2009) JD
McGill University (2005) MSc
(Biology)
McGill University (2001) BSc
(Biology)

Bar Admissions

Ontario (2010)

Practice Areas

Intellectual Property
Commercial Litigation
Public Law
Appeals
Injunctions

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Andrew Moeser

ANDREW MOESER

is a partner at Lenczner Slaght.

"Andrew has honed his advocacy skills to a fine point and is a creative strategist with an ability to understand the industry at hand." — *IAM Patent 1000*

Andrew's practice is primarily focused on intellectual property litigation. In patent matters, Andrew has experience with industries such as pharmaceutical and biologics, information technology, and oil and gas. In trademark, copyright, and trade secret matters, Andrew has represented clients in disputes relating to software, gaming, and beauty products. Andrew also has experience in commercial litigation relating to environmental contamination, and in judicial reviews in regulated industries such as pharmaceuticals and renewable energy.

Andrew has represented clients before all levels of court in Ontario, the Federal Court and Federal Court of Appeal, and the Alberta Court of Appeal.

He has also acted *pro hac vice* in proceedings in the United States and has extensive experience as part of international teams litigating large cross-border disputes.

Andrew is also an Adjunct Professor at the University of Toronto Faculty of Law, where he supervises a legal clinic providing assistance to the Structural Genomics Consortium, a not-for-profit public-private partnership that engages in precompetitive basic science research to facilitate and enable the discovery of new medicines.

RECOGNITION

- IAM Patent 1000 (2022-2023)
Patent Litigation: Recommended Individual (Bronze)
- The Legal 500 Canada (2022-2024)
Intellectual Property (Recommended Lawyer)

SELECT CASES

- **Society of Composers, Authors and Music Publishers of Canada, et al v Entertainment Software Association, et al** – Counsel to the intervener Professor Ariel Katz in an appeal to the Supreme Court of Canada addressing the interpretation of the "making available" provision

of the Copyright Act, the role of the Copyright Board of Canada in determining legal questions, and the question of when copyrights trigger entitlements to royalties.

- **Rovi Guides v Videotron** – Counsel to Rovi Guides (a subsidiary of Xperi Holding Corporation) in a patent infringement action involving four patents related to digital entertainment technologies.
- **Merck Sharp & Dohme Corp et al v JAMP Pharma Corporation** – Counsel to JAMP in a NOC action relating to JANUVIA (sitagliptin), a medication used to control high blood sugar in people with type 2 diabetes.
- **Sakab Saudi Holding Company v Al Jabri et al** – Counsel to Canadian cybersecurity suppliers in dispute between Saudi companies and former Minister of Saudi government. Successfully set aside *Norwich Orders* affecting the Canadian suppliers that had been obtained on an *ex parte* basis.
- **Eli Lilly Canada Inc v Mylan Pharmaceuticals ULC** – Counsel to Mylan in multiple related NOC proceedings and appeals relating to patents over CIALIS® (tadalafil); first generic challenge to CIALIS®...
- **Teva Pharmaceutical Industries Ltd v Mylan Pharmaceuticals ULC** – Counsel to Mylan in a NOC proceeding relating to a composition of matter patent over COPAXONE® (glatiramer acetate – a random polypeptide); this...
- **Halliburton Energy Services Inc v BJ Services Company** – Counsel to Halliburton Energy Services in patent infringement litigation regarding wellbore completion patented methods used in North American shale...
- **Bayer Inc v Fresenius Kabi Canada Ltd** – Counsel to Fresenius in a NOC proceeding relating to patents over AVELOX I.V.TM (moxifloxacin hydrochloride). On a preliminary motion, Fresenius successfully struck the portion of the proceeding relating to a formulation patent. (*Prior to joining Lenczner Slaght*)
- **Skypower CL 1 LP v Minister of Energy** – Counsel to Skypower, a renewable energy developer, in a judicial review relating to an Ontario government program for renewable energy projects. (*Prior to joining Lenczner Slaght*)
- **Microsoft Corporation v Liu** – Counsel to Microsoft in copyright infringement litigation relating to unlicensed software. Microsoft was awarded statutory and exemplary and punitive damages. (*Prior to joining Lenczner Slaght*)
- **AmTote International v Exacta Systems** – Counsel to AmTote, a subsidiary of The Stronach Group, in trade secret and false advertising litigation relating to historical horse racing gaming technology. (*Prior to joining Lenczner Slaght*)
- **Comweb Toronto Realty Inc v Transmetro Limited and the City of Toronto** – Counsel to landowner (Comweb) in civil actions and municipal prosecutions relating to environmental contamination and groundwater contaminant migration. (*Prior to joining Lenczner Slaght*)
- **Fresenius Kabi Canada Ltd v Minister of Health** – Counsel to Fresenius in a successful judicial review relating to IDACIOTM (adalimumab). The Federal Court ordered the Minister to immediately approve Fresenius' product. (*Prior to joining Lenczner Slaght*)
- **Swist v MEG Energy** – Counsel to Swist in patent infringement action relating to a method of heavy oil recovery. (*Prior to joining Lenczner Slaght*)
- **ViiV Healthcare Company v Gilead Sciences Canada** – Counsel to Gilead in a patent infringement action relating to BIKTARVY®. Gilead successfully established non-infringement. First use of Federal Court

summary trial to resolve a patent matter despite responding party contesting summary process. (*Prior to joining Lenczner Slaght*)

SELECT PUBLICATIONS AND PRESENTATIONS

- **Patent and Trademark Case Law Review Series** – Andrew Moeser was invited to present at the Intellectual Property Institute of Canada's *Patent and Trademark Case Law Review Series*. Andrew discussed leading court decisions on core trademark issues, related to "Section 45".
- **IPIC2023 Conference** – Andrew Moeser was at the IPIC2023 Conference in Winnipeg. Andrew led a panel discussion on "*Natural Selection and the Origin of the Species Patent: Are Selection Patents Evolving or Dying Out?*".
- **A 360 Review of the Amended PMNOC Regulations** – Andrew Moeser shared his expertise at the Intellectual Property Institute of Canada's program on "*A 360 Review of the Amended PMNOC Regulations*".
- **IPIC2021 Virtual** – Our expert IP litigators, Sana Halwani and Andrew Moeser, were invited to speak at IPIC's Annual Conference.
- **IP Culture Shift: The Rise of Summary Disposition** – Andrew Moeser authored the Lexpert article "*IP Culture Shift: The Rise of Summary Disposition*". In this article, Andrew comments on the shift towards summary disposition in Canadian IP litigation.
- **The value of a fully integrated IP strategy: strategies to integrate and exploit intellectual property for idea-based enterprises** – Commissioned by the Federal Government (Innovation, Science and Economic Development Canada), Andrew Moeser prepared a report on strategies to integrate and exploit intellectual property for idea-based enterprises.
- **A trust approach for sharing research reagents** – Andrew Moeser co-authored the article "*A trust approach for sharing research reagents*", which was published in *Science Translational Medicine: Volume 9, Issue 392*.
- **Patents and Pills: Linkage, Litigation and Generic Drug Approval** – Andrew Moeser lectured at the Faculty of Law, University of Toronto, Pharmaceutical Governance Course.
- **Canada: Modernisation and Flux** – Andrew Moeser co-authored the article *Canada: Modernisation and Flux*, which was published in *IAM Magazine – IP Value: 2013*. The article provided a review of Canada's IP regime, with discussions of the 2012 Copyright legislative reform and Supreme Court decisions, nontraditional Trademarks updates, Canada's unique sound prediction disclosure requirement, and the role of IP in Canada's trade talks.
- **A shift in the Canadian law of obviousness: a comment on Sanofi-Synthelabo Canada Inc. v. Apotex Inc.** – Andrew Moeser's article *A shift in the Canadian law of obviousness: a comment on Sanofi-Synthelabo Canada Inc. v. Apotex Inc.*, was published in the *University of Toronto Faculty of Law Review: Volume 67*.

BLOG POSTS

- **Policing Scope Creep: Relevance in Canadian Pharma Disputes for Section 8 Damages** – In Canada, a generic pharmaceutical company can commence an action for damages under section 8 of the *Patented Medicines (Notice of Compliance) Regulations* (the "*Regulations*")

), if it successfully defends a patentee's claims in an earlier section 6 prohibition proceeding. Section 8 actions are often complex, requiring a determination of the alleged loss suffered by assessing a "but-for world" where the generic would have received regulatory approval and commenced sales at an earlier date, but for having been blocked by the operation of the *Regulations*. Depending on the drug(s) and patent(s) at issue, there may be several independent section 8 actions against a patentee, each started by a different generic plaintiff (see our previous post). When distinct section 8 actions are commenced pertaining to the same drug(s), patent(s), and patentee(s), issues as to relevance and scope of each action may arise.

- **Pharma Patent Case Round-Up** – If your 2024 has been too busy to keep up with caselaw, below we summarize and provide the key takeaways from pharmaceutical patent decisions that have been issued from the Federal Court and Federal Court of Appeal in the last two months.
- **Understanding Patents** – Andrew Moeser will be sharing his expertise on patent enforcement at the joint Intellectual Property Institute of Canada and McGill University Summer IP Course. Andrew will lead a discussion on Patent Enforcement: Infringement, as well as participate on a Mock Trial focused on Expert Reports and Cross-Examination of a Witness.
- **Insights on the Independence of Expert Evidence** – In the recently released decision *dTechs EPM Ltd v British Columbia Hydro and Power Authority and Awesense Wireless Inc*, the Federal Court of Appeal ("FCA") weighed in on the role and independence of experts in patent cases. In particular, the FCA provided guidance on (1) the role counsel may play in preparing expert reports; (2) an expert's role in claim construction; and (3) the difference in the role of an expert where anticipation is alleged based on prior use versus prior publication.
- **Shocking Result? Summary Trial on Battery Jump Starter Patent Fails to Get Going** – Patent infringement cases are complex and technical, and historically Canadian courts were reluctant to endorse summary disposition in the patent context. However, in recent years there has been an increased trend towards the application of summary proceedings in this area. In particular, we have previously commented on decisions of the Federal Court ("FC") (*Canmar, Kobold, and Janssen*) and Federal Court of Appeal ("FCA") (*Canmar and ViiV*) that demonstrate the Court's willingness to approve summary proceedings in patent cases under the appropriate circumstances. Last fall, the FCA decision in *Gemak* was interpreted by some commentators as a return to the historical position, but in our view, *Gemak* can be viewed as tapping the brakes on summary judgment rather than signalling a more sweeping reversal of the trend towards summary adjudication.
- **Clarity on the Test for Inducing Infringement in Canadian Patent Law** – Indirect infringement or "inducement" often arises in pharmaceutical patent infringement cases where a defendant generic manufacturer may not ultimately "use" the drug in question (*i.e.*, directly infringe). Since 2011, the Federal Court of Appeal's ("FCA") *Corlac Inc v Weatherford Canada Inc* decision has frequently been cited as the leading authority for the tripartate test for inducement. In 2020, the Federal Court suggested that *Corlac* had changed the law of inducement—particularly at the second step determining influence—thereby requiring "a higher threshold for establishing inducement than was applied in the earlier cases". In the recent decision of *Teva Canada Limited v Janssen Inc ("Paliperidone")*, the FCA has rejected that interpretation of *Corlac*. The FCA held that *Corlac*

incorporates the same principles of inducing infringement as had been established in cases dating back to 1906. In doing so, it overturned the lower Court's inducement determination based on a supposed higher standard and found that the defendant was liable for inducement when the *Corlac* test was properly applied.

- **To Consolidate or Not to Consolidate – This is the Federal Court's Question** – In a recent decision, *Takeda Canada Inc v Apotex Inc*, the Federal Court dismissed the Plaintiff, Takeda's, motion for consolidation of two actions against Apotex relating to Takeda's dextansoprazole (DEXILANT) under section 6 of the *Patented Medicines (Notice of Compliance) Regulations* (the "PM(NOC) Regulations").
- **Better Together – or Maybe Not** – Some things just go better together and probably always will, as Luke Combs sings in 'Better Together'. Like a cup of coffee and a sunrise; Sunday drives and time to kill. Multiple section 8 actions however have not made the cut. According to the recent decision of Justice Southcott in *Apotex Inc v Janssen Inc*, multiple actions for section 8 damages should not have common issues heard together.
- **FCA Taps the Brakes on Summary Judgment in Patent Cases** – Over the last several years there has been a trend towards increased adoption of summary proceedings for resolving patent cases in Canada. In particular, we have previously commented on decisions of the Federal Court (e.g., *Kobold* partial SJ motion) and Federal Court of Appeal (e.g., *Canmar* Appeal) that signalled a willingness to move away from the historic reluctance of those courts to approve summary judgment for patent infringement actions. We had also noted that summary proceedings were a trend to watch this year.
- **Do I pay the same? Am I only streaming? Or is "making available" a separate, compensable claim?** – Last week, the Supreme Court of Canada released its decision in *SOCAN and Music Publishers of Canada v ESA*, the latest instalment in a decade long battle about whether and how copyright owners should be compensated for making works available online (even if those works are not subsequently downloaded or streamed by a user).
- **The Federal Court Clarifies the Burden of Proof in Summary Trial** – In 2022, the use of summary proceedings in patent matters continues at the Federal Court. In *Janssen Inc v Pharmascience Inc*, the Court:
- **First Application of the New Prior Use Defence** – On January 7, 2022, the Federal Court released the public reasons in *Kobold Corporation v NCS Multistage Inc*. This summary judgment motion is the first judicial consideration of the prior use defence since the substantial amendments to section 56 of the *Patent Act* in 2018. Our comments on the procedural aspects of this summary judgment motion are available in a companion post here.
- **Partial Summary Judgment Narrows Patent Infringement Case** – The recent patent infringement case of *Kobold Corporation v NCS Multistage Inc* is interesting for two reasons: (1) it shows how a summary judgment motion can advance a case even if certain issues require a full trial; and (2) it is the first time a court has interpreted the defence of prior use since the 2018 amendments to section 56 of the *Patent Act*. This post considers the use of summary adjudication. Click here to read our companion post which considers the substance of the prior use defence.
- **You can call my lawyer(s)?** – For the first time, the Federal Court has dealt with the issue of whether a party is permitted to appoint co-solicitors of record. The Court held that a party may not appoint co-solicitors as of right, but it provided guidance on the circumstances in which co-solicitors may be permitted. It remains to be seen how "special" such circumstances must be, especially since such arrangements are

not uncommon in modern practice.

- **The Train Has Left the Station: The Federal Court of Appeal Confirms That Opposition Won't Derail a Summary Trial** – As part of our series on summary adjudication, we previously commented on the Federal Court's recent use of a summary trial to resolve a patent infringement dispute. The abbreviated procedure of a summary trial addresses many of the Federal Court's traditional concerns with summary judgment (e.g., lacking live evidence).
- **In PM(NOC) Litigation, the Pleadings Rule** – Since the amendments to the *PM(NOC) Regulations* in 2017, both generic and brand side litigants have struggled with the question of whether the second person's Notice of Allegation governs the issues in the proceeding, or the Statement of Defence. The Federal Court of Appeal has answered in this week's decision in *Sunovion Pharmaceuticals Canada Inc v Taro Pharmaceuticals Inc*: it is the Statement of Defence.
- **Don't Sit Back During Summary Judgment: Federal Court of Appeal Weighs in on Summary Judgment for Patent Infringement Actions** – The Federal Court of Appeal has historically held that summary judgment is usually not the preferred means of resolving patent infringement actions. These cases are inherently complex and technical, and usually involve expert evidence. In the Federal Court of Appeal's view, a trial judge who has had the opportunity to hear all of the evidence live is best suited to resolve these disputes (see *Suntec Environmental Inc v Trojan Technologies Inc*).
- **Door Left Open for Use of Foreign Patent Prosecution History** – Since its enactment in 2018, section 53.1 of the *Patent Act* has been the subject of much discussion. This provision allows courts tasked with construing the claims of a patent to consider communications previously made by the patentee to the Canadian Patent Office in the course of patent prosecution (known as the "prosecution history" or the "patent file wrapper"). Recently, the Federal Court has provided differing interpretations regarding the limitations of this section.

SELECT NEWS ARTICLES

- **Lenczner Slaght Stands Out as a Top-Tier Litigation Firm in Legal 500 Canada** – Canada's leading litigation firm is once again recognized as a "litigation powerhouse" according to *Legal 500 Canada*.
- **Lenczner Slaght Receives Worldwide Recognition in IP Litigation** – Canada's leading litigation firm continues to be recognized year-over-year for its exceptional Intellectual Property expertise.
- **Lexpert's Top 10 Business Decisions of 2021/2022** – In Lexpert's Top 10 Business Decisions of 2021/2022, Lenczner Slaght is featured for its involvement in *Li v Barber* and *Society of Composers, Authors and Music Publishers of Canada v Entertainment Software Association*. Monique Jilesen was further interviewed on our involvement in *Li v Barber*, where our team successfully obtained a precedent-setting Mareva order.
- **Lenczner Slaght Stands Out as a "Litigation Powerhouse" in Legal 500 Canada** – Canada's leading litigation firm is once again ranked in Tier 1 for Dispute Resolution by *Legal 500 Canada*.
- **Lenczner Slaght's Expert IP Team Receives Worldwide Recognition** – Canada's leading litigation firm continues to be recognized for its exceptional Intellectual Property expertise by IAM Patent 1000.

- **Legal 500 Highlights Lenczner Slaght's Litigation Dominance** – Legal 500 recognizes Canada's leading litigation firm as "a regular fixture in the country's ground-breaking contentious cases".
- **Lenczner Slaght Welcomes New IP Partner** – Canada's leading litigation firm adds Andrew Moeser to its formidable Intellectual Property team.

PROFESSIONAL ACTIVITIES

- University of Toronto Faculty of Law
Adjunct Professor, Clinical Legal Education: Externship - Structural Genomics Consortium (2016 - present)
- Intellectual Property Institute of Canada
Conference Committee (2021-present); CPD Committee (2021-present)
- The Advocates' Society
- Canadian Bar Association
- Ontario Bar Association