

Forum Shopping Considerations for IP Litigation in Canada

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When it comes to intellectual property (IP) litigation in Canada, most suits can be brought in either the Federal or provincial courts. Typically, the Federal Court of Canada is the default venue as it can issue nationally enforceable orders, has a specialized chamber of IP judges and offers streamlined procedures tailored for complex IP matters. However, there may be strategic reasons why a litigant may consider provincial superior courts instead. Below are five key considerations that may inform forum choice for IP disputes in Canada.

1. What is the Cause of Action?

The nature of the legal claim is a critical factor in choosing between federal and provincial court. For example, if you want a court to declare a competitor's patent invalid and unenforceable against *anyone* (i.e., bring an impeachment action *in rem*), the Federal Court is your only option as the Federal Court has exclusive jurisdiction over impeachment proceedings. In contrast, if your claim primarily arises from a common law cause of action, such as a trade secret claim or a contractual dispute, the provincial court will be the appropriate jurisdiction.

2. Pace of Litigation

In instances where federal court and provincial courts have concurrent jurisdiction, timing can be a strategic consideration. The Federal Court is known for its efficiency in handling IP disputes. The Court has the intention to bring cases to trial within two years. Further, a case management judge is often assigned at an early stage to keep litigation on track.

In contrast, provincial courts have historically been considered the slower forum, and case management is not always as readily available. Thus, if the commercial and business realities require a slower pace of litigation to allow for settlement discussions or other considerations, the provincial court may be the more attractive forum.

Recently, however, provincial courts across the country have been announcing initiatives to streamline litigation and expedite proceedings. For instance, the Court of King's Bench of Alberta recently [announced](#) that it will require parties to file a case litigation plan with the aim of having the trial scheduled within three years after the first Statement of Defence is filed.¹ Additionally, Ontario has [proposed significant changes](#) to their rules of court to support a quicker litigation process, such as eliminating oral examinations for discovery altogether.

3. What is Your Budget?

Your budget may be another factor, which can be heavily influenced by the scope of discovery. The Federal Court generally tries to limit oral discovery to one day of questioning for each anticipated week of trial. This contrasts with provincial courts where extended questioning can happen.

4. Do you want a Specialized IP Judge?

The Federal Court has recently created a [specialized chambers](#) of IP judges, which includes over 20 judges that have expertise in IP and Competition Law. The Court has also developed specialized guidelines for complex IP matters, such as the [Case and Trial Management Guidelines for Complex Proceedings, Proceedings under the PM\(NOC\) Regulations, and Appeals under Subsection 56\(1\) of the Trademarks Act](#).

If your claim involves particularly complex IP issues, the Federal Court's experience in managing complex IP litigation will likely be helpful.

¹BD&P provides more details on the Alberta Court's plans [here](#).

5. Where is the Infringing Activity?

Geography matters when it comes to enforceability. The Federal Court has national jurisdiction and its orders are enforceable across Canada. This makes the Federal Court the better forum for cases involving infringement in multiple provinces or online activity. Provincial court's orders are enforceable only within the province in which the court sits. If the infringement took place in a single province, a provincial court may be more convenient and lead to cost savings.

While the Federal Court is often the go-to venue for IP litigation in Canada, forum selection is not a one-size-fits-all consideration. The nature of the claim, desired pace, budget, complexity and geographic scope of the dispute play a role in forum selection. Understanding these factors allow for a strategic and cost-effective business decision that aligns with a company's goals and budget. If you require legal assistance or more information about IP litigation, contact [the BD&P team](#).