



Eugene J.A Gierczak

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Biography

Eugene Gierczak a national leader in intellectual property law at Miller Thomson with an additional focus on information technology. He provides advice on all aspects of intellectual property law including litigation, corporate transactions, and patent, copyright, and trademark applications.

In addition to being a lawyer, Eugene is a registered professional engineer for the province of Ontario, as well as a registered patent and trademark agent. He has a long history of drafting original patent applications covering a variety of technologies with a focus on the chemical and mechanical fields, including a particular expertise in fluid processing methods. He assists his clients with patent issuance in Canada and worldwide.

Eugene has extensive expertise in the preparation and prosecution of trademark, copyright, and design applications, as well as trademark opposition and expungement proceedings, in Canada, Brazil, the United States, and Europe.

He represents his clients' interests in technology transfers, joint ventures, licenses, satellite, wireless communications, computer hardware and software transactions, and other intellectual property issues relating to corporate transactions. His skills extend to developing intellectual property strategies including IP audits to define and protect his clients' intellectual assets.

Eugene is an experienced litigator before the Canadian courts in cases dealing with infringement and validity actions concerning patents, trademarks, designs, copyright, and confidential information. He also has experience with injunction applications and search and seizure of intellectual property. He incorporates alternate dispute resolution strategies to bring litigation issues in line with clients' business goals.

Eugene has written numerous papers and is a frequent speaker on intellectual property issues including "Licensing of Patents," "Technology Transfers," and "Intellectual Property Integration with Business Plans" before the legal profession in Canada, the United States, Brazil, and Europe. He is called upon annually to speak on "Joint Ventures and Strategic Alliances in the Context of IP Issues" before the Canadian Institute of Lawyers.

His legal strategy involves understanding a client's business and adding value by defining and protecting intellectual assets using a business-minded approach consistent with the client's goals.

Professional achievements & leadership

- Award for Excellence, Patents and Trademarks lawyer, Canadian-Polish Chamber of Commerce, 2015

Thought leadership

- Presenter, Designing Competitive IP Strategies for North American and Asian Markets, 2015 Chief IP Counsel Exchange, Texas, September 2015
- Moderator, Understanding & Communicating the Value of IP in M&A Transactions, Global IP Exchange, Austin Texas, February 21-23, 2015
- Moderator, The Importance of IP in Transactional Matters: An Initial Consideration or

Afterthought, La Jolla, December 6-8, 2009

- Big Data-Secrets You Must Know From an IP Lawyer, University Ontario Institute of Technology, 2015
- Comparison of Canadian and Brazilian Intellectual Property Law, GTMA, Sao Paulo, Brazil, 2014
- Intellectual Property – Is it Worth Protecting, Markham Convergence Centre, 2013
- Intellectual Property Protection in Canada, Ubifrance, 2013
- Sales From Social Media, Legal Issues, CED Workshop, Toronto, 2011
- An Overview of Bilateral Israel/Canada Intellectual Property, Strategic Alliances and Licensing Strategies, Tel-Aviv, Israel, 2011
- GIS and the Law, Collaborative Issues in GIS, URISA OC, 2011
- Patent Protected, Lexpert 2010 Guide to the Leading US/Canada Cross-Border Litigation in Canada, December, 2010
- Comparison of Canadian and Czech Intellectual Property, Canadian Bar Association, topics in Prague (Czech Republic), 1991
- Technology Transfers, Canadian Bar Association, topics in Warsaw Poland, 1990

Corporate directorships

- Past President, Mississauga Symphony
- Past President, Mississauga Art Gallery
- Past President, Mississauga Chapter of Professional Engineers of Ontario
- Past Councillor for the Association of Professional Engineers of Ontario

Professional memberships

- Member, Law Society of Ontario
- Member, The Canadian Bar Association
- Member, INTA (Intellectual Trade Mark Association)
- Member, MEDEC (Medical Devices Canada)
- Past Member, Association of Professional Engineers of Ontario, Disciplinary Hearing Committee
- Member of Canada Poland Chamber of Commerce
- Director of Greater Toronto Marketing Alliance (GTMA)

Bar admissions & education

- Ontario Bar, 1979
- LL.B., Osgoode Hall Law School, York University
- B.Sc., Chem. Eng., Queen's University