

# David Schnurr

## Associé

Région de Waterloo

**BUREAU**

519.593.3287

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## Secteurs et Expertises

**EXPERTISE**

Technologies, propriété intellectuelle et protection de la vie privée | Droit des sociétés | Brevets | Entreprises en démarrage, entreprises émergentes et capital de risque | Marques de commerce | Intelligence artificielle | Protection de la vie privée et cybersécurité | Litige en matière de propriété intellectuelle et de technologies | Propriété intellectuelle | Fusions et acquisitions | Technologies

## Biographie

**ADMISSION AU BARREAU**

Ontario, 2007

**FORMATION**

- LL.B., Western University, 2006
- B.Sc. (Hons), University of Waterloo, 2003

**LANGUES**

Anglais

As a nationally recognized business and technology lawyer, David Schnurr combines his qualifications as a Registered Patent and Trademark Agent with his extensive experience in corporate commercial and technology law to provide a full range of pragmatic and cost-effective intellectual property (IP), information technology (IT), business transactional (including cross-border transactions), contractual agreement and day-to-day commercial advice and solutions. David's experience extends to cutting-edge technologies like AI, making him a go-to advisor for startups and established businesses alike. David is not only focused on delivering top-notch legal services but also excels in client care. With his exceptional skills in contract drafting and research, he ensures deadlines are met and provides strategic advice tailored to each client's goals. His dedication to simplifying complex matters and proactively addressing issues has earned him high praise from clients and peers, solidifying his position as an experienced and trusted legal partner. Given the breadth of David's experience, he provides general counsel services to many of his clients, including high-level advisory and strategic planning services on corporate and related matters, investments and acquisitions.

David is recognized as a go-to lawyer on legal matters requiring sophisticated and strategic attention. David is a voracious reader with a keen legal mind. He is adept at finding support for his arguments, even in apparently weak cases. David's enthusiasm and willingness to jump into complex matters consistently impresses his clients and colleagues and he is repeatedly recommended as a go-to source for managing sophisticated IT and business transactions, mergers and acquisitions, complex patent and trademark prosecutions and contentious client matters involving a serious threat of litigation.

Notably, David has prosecuted hundreds of patent and trademark applications around the world and manages significant IP portfolios for several of the firm's global clients. In addition, David is a nationally recognized leader in the area of technology contracting, including in respect of the preparation and negotiation of license and end user agreements including EULAs and EUSAs, hosting agreements, software as a service (SaaS) and other cloud services agreements, master services agreements (MSAs), IT consulting services agreements and statements of work (SOWs), software application development agreements, joint venture agreements, maintenance and support agreements, consulting and professional services agreements, confidentiality and non-disclosure agreements (NDAs), privacy policies and data processing agreements, and distribution agreements, including OEM and reseller agreements.

In his Information Technology (IT) practice, David has acted as the lead negotiator on a substantial number of significant multi-million dollar IT outsourcing and strategic sourcing projects, including for large multi-national corporations and government bodies. He has brokered complex IT transactions, serving as the main client point of contact and overseeing the responsibilities of client in-house legal counsel, contract specialists and business stakeholders. In this role, he has directly negotiated complicated and contentious IT matters and has positioned himself as one of Canada's leading legal professionals in computer & IT law. David is the author of the Cloud Computing chapter in LexisNexis' legal textbook, Social Media and Internet Law, which is now in its second edition.

David's Intellectual Property (IP) practice includes the provision of legal services in respect of patents, trademarks, copyright, and industrial designs, including the preparation, filing, prosecution, registration and maintenance of such applications before the Canadian Intellectual Property Office (CIPO), the United States

Patent and Trademark Office (USPTO) and internationally, the preparation of patentability and trademark registrability opinions, intellectual property due diligence in corporate transactions, Trademarks Opposition Board and cancellation proceedings, domain name disputes and the enforcement of intellectual property rights generally. David also provides advice on legal matters relating to Canada's Anti-Spam Legislation (CASL) and regulatory issues in the field of Artificial Intelligence (AI).

David is one of Canada's leading startup and emerging technology lawyers and is a key member of Miller Thomson's National MTech® Startup Team. As a regional MTech leader, David leads teams of lawyers in providing high-quality legal advice and mentoring to startups and early-stage businesses using attractive and predictable billing models. In addition, David leads Miller Thomson's ElevateIP and Intellectual Property Ontario (IPON) service teams.

As a leading Canadian IP/IT lawyer, David has assisted a significant number of clients in defending software audit requests and copyright infringement demands advanced by BSA (The Software Alliance), and large software companies. In this role, David has established proven and effective methods for managing client disputes with the BSA, with a view to mitigating both legal and financial consequences for his clients.

In past years, David has been ranked as one of Canada's Leading Lawyers in The Canadian Lexpert Legal Directory (Repeatedly recommended – Intellectual Property). David is consistently ranked as one of Canada's leading trademark practitioners by the prestigious World Trademark Review (WTR 1000). In this regard, David is praised as: [a] "delight to work with – his enthusiasm for trademarks is incomparable"; his varied client list "has benefited from shrewd portfolio management and assurance in opposition"; "an extremely thorough, diligent and knowledgeable attorney"; "[a] key difference between him and many other IP practitioners is the personal attention he gives to clients. He always makes himself available when needed and provides fantastic service, taking the time to thoroughly explain all imperative details with clarity and patience and proactively bringing up potential issues before they become a problem. The level of dedication he shows is rare – he really goes above and beyond at every turn. What's more, he's always transparent about his actions and the costs incurred"; "synonymous with excellent client service"; "instrumental in simplifying processes and putting things into layman's terms to assist clients in protecting the aspects of their products that (are) important"; "prompt, clear and helpful...[b]eing able to rely on someone so knowledgeable has been crucial. He goes out of his way to explain his recommendations" and presents "different options based on [clients'] needs"; "refreshing [to work with] – he understands his clients and how to best support global businesses"; driven by a strong desire to add value to brands by providing affordable services and counsel that is easily actionable; and a lawyer who "devises savvy prosecution strategies to achieve watertight brand protection for his clients". David is pleased to be ranked once again as one of Canada's leading trademark professionals in the 2024 edition of WTR 1000 where he has once again attained a Silver Band ranking, conferred upon only a select few trademark practitioners across Canada.

David is a Registered Canadian Patent Agent and U.S. Patent Agent, having passed the Patent Agent Examinations on his first attempt. In a given year, less than 5% of test-takers achieve passing grades on all four Patent Agent Examinations, placing David in elite company. David is also a Registered Canadian Trademark Agent and U.S. Trademark Agent. David provides legal services to a broad range of clients across

Ontario and Canada, including multinational corporations, universities, startup businesses and entrepreneurs, research hospitals, small business owners, charities, and international IP counsel, among others. As an associate, David was seconded to assist the in-house legal department of a multinational technology company headquartered in Canada with its IP/IT matters. David has presented on various legal topics to in-house counsel, foreign agents and attorneys, universities, startups, professional associations and other Ontario lawyers, including at seminars organized by the Ontario Bar Association (OBA) and the Law Society of Ontario. David has also been interviewed on IP/IT matters by Postmedia and CBC News, including for nationally distributed news articles, radio and television programs, including CBC's The National. Since 2009, David has served as an Adjunct Professor in the Faculty of Law at Western University, where he teaches the Advanced Intellectual Property course and is a five-time recipient of the Faculty's Teaching Award of Excellence. David completed his law degree at Western University, where he was the recipient of the Dean of Law Entrance Scholarship and obtained highest standing in Advanced Patent Law. In his undergraduate career, David was the recipient of two Natural Sciences and Engineering Research Council of Canada (NSERC) Undergraduate Student Research Awards. David is a Fellow of the Intellectual Property Institute of Canada (IPIC).

Beyond his impressive credentials, David's commitment to education, public speaking engagements, and his standout publications underscore his passion for sharing knowledge and helping others navigate the dynamic world of business, intellectual property and technology law. David has presented on various legal topics to in-house counsel, foreign agents and attorneys, universities, startups, professional associations and other Ontario lawyers, including at seminars organized by the Ontario Bar Association (OBA) and the Law Society of Ontario. Since 2009, David has served as an Adjunct Professor in the Faculty of Law at Western University, where he teaches the Advanced Intellectual Property course and is a five-time recipient of the Faculty's Teaching Award of Excellence.

## Engagement

### Reconnaissance

- Ranked as one of Canada's Leading Trademark Professionals – 2024 World Trademark Review, WTR 1000 (2025)
- Ranked as one of Canada's Leading Trademark Professionals – 2024 World Trademark Review, WTR 1000 (2024)
- Ranked as one of Canada's Leading Trademark Professionals – 2023 World Trademark Review, WTR 1000 (2023)
- Ranked as one of Canada's Leading Trademark Professionals – 2022 World Trademark Review, WTR 1000 (2022)
- Ranked as one of Canada's Leading Trademark Professionals – 2021 World Trademark Review, WTR 1000 (2021)
- Canadian Legal Lexpert Directory, Repeatedly recommended – Intellectual Property, 2020

- Ranked as one of Canada's Leading Trademark Professionals – 2020 World Trademark Review, WTR 1000 (2020)
- Ranked as one of Canada's Leading Trademark Professionals – 2019 World Trademark Review, WTR 1000 (2019)
- Ranked as one of Canada's Leading Trademark Professionals – 2018 World Trademark Review, WTR 1000 (2018)
- Recognized by Western University Students' Council (USC) with Teaching Honour Roll Award of Excellence, 2017 Academic Year
- Appointed to the Academic Committee of the International Trademark Association (INTA) (2018 – 2019)
- Ranked as one of Canada's Leading Trademark Professionals – 2017 World Trademark Review, WTR 1000 (2017)
- Registered Patent Agent, Canada (2009)
- Registered Patent Agent, United States (2010)
- Registered Trade-mark Agent, Canada (2008)
- Registered Trade-mark Agent, United States (2009)
- Adjunct Professor, Western University, Faculty of Law (2009-present)
- Recipient, Western University Student's Council (USC) Teaching Award of Excellence, Western University Faculty of Law (2011, 2013, 2014, 2016, 2018)
- Highest Standing, Advanced Patent Law, Western University
- Recipient, Dean of Law Entrance Scholarship, Western University
- Recipient, NSERC Undergraduate Student Research Award (2002, 2003)
- Recipient, Year One Scholarship, University of Waterloo
- Peer Reviewer, Western Law Journal
- Black Duck Certified Legal Specialist

## **Leadership éclairé**

### **Publications**

- "Canadian Intellectual Property Office (CIPO) introduces new trademark examination service standards with a view to reducing prosecution delays", January 31, 2024
- "ElevateIP: Everything you need to know about Canada's newest funding program for Canadian startups," November 29, 2023
- "Intellectual Property Ontario (IPON) now accepting applications to fund Ontario innovators," November 16, 2023
- "Government of Canada launches public consultation on the implications of generative artificial intelligence on copyright," October 25, 2023

- “U.S. Court holds that AI generated works cannot be copyrighted: Implications for AI generated works in Canada,” October 11, 2023
- “Canadian Intellectual Property Office (CIPO) to significantly increase official fees on January 1, 2024,” September 20, 2023
- “What your company needs to know about IP,” David Johnston Research + Technology Park, University of Waterloo, August 22, 2022
- “CIPO announces expedited examination process and other measures to improve Canadian trademark examination timelines,” May 7, 2021
- “The Countdown to June 17, 2019 is On: Act Now to Protect Your Trademark Portfolio and Save Money before Canada’s New Trademark Regime Takes Effect,” May 28, 2019
- “Change on the Horizon: Significant Amendments to Canada’s Trademark Laws Take Effect on June 17, 2019: What Charities and Not-for-Profits Can Do Now to Prepare,” December 13, 2018
- “IT service and infrastructure providers beware: Key guidance released by the CRTC regarding liability of intermediaries for CASL breaches,” December 6, 2018
- “The Date is Set – Canada’s New Trademark Laws Take Effect on June 17, 2019: What You Can Do Now to Prepare,” November 22, 2018
- “Canada’s Proposed New Trademark Regulations Released for Comment,” June 22, 2017
- David Schnurr interviewed on impact of CASL by CBC News, June 4, 2014
- David Schnurr’s chapter on Cloud Computing is published in LexisNexis’ legal text “Social Media and Internet Law,” May 2, 2014
- “A Cause For Concern To Geo-Domain Name Owners? CIRA Orders Transfer Of niagararegion.ca To Municipality,” Information & Technology Law (Carswell), Vol. 11, No. 3, 2009

## **Presentations**

- David Schnurr presents a seminar at the University of Waterloo on the topic of Startup Law 101: Intellectual Property (IP) Basics and Government Funding Opportunities through ElevateIP and IPON, November 27, 2024
- David Schnurr presents an ElevateIP webinar on Intellectual Property (IP) Commercialization and Licensing for Startups, May 15, 2024
- David Schnurr participates as a member of an expert panel on “The Competitive Advantage of Innovative Operations” at the 2024 Manufacturing Summit, May 9, 2024
- David Schnurr assists the Western Law IP Moot Teams in preparation for the Harold G. Fox Canadian Intellectual Property Moot, February 15, 2024
- David Schnurr leads a roundtable discussion on the intersection of Intellectual Property and Artificial Intelligence (AI) at the Velocity Incubator at the University of Waterloo, February 29, 2024
- Presenter, “Advanced Intellectual Property”, Western University Faculty of Law, January 9, 2023

- Presenter, “Intellectual Property Law Masterclass,” University of Waterloo Faculty of Engineering, November 22, 2023
- Presenter, “Startup Law 101,” Wilfrid Laurier University (Lazaridis School of Business and Economics), October 31, 2023
- Presenter, “Startup Law 101,” Wilfrid Laurier University, October 28, 2021
- Presenter, “IP Protection Strategies for Municipalities,” October 26, 2021
- Presenter, “Trademark Enforcement,” University of Western Ontario, November 24, 2020
- Presenter, “Startup Law 101,” University of Waterloo, November 18, 2020
- Presenter, “Startup Law 101: Intellectual Property Considerations for Entrepreneurs,” Innovation Guelph, September 30, 2020
- Panel moderator, “Trademark Squatting: Protecting Trademarks Across Borders,” International Intellectual Property Law Association (IIPLA) Annual meeting in Palo Alto, California, September 24-25, 2019
- Presenter, “Startup Law 101: Essentials of Intellectual Property for Entrepreneurs,” University of Guelph, The Hub Incubator Program, July 24, 2019
- Co-presenter, “The Countdown to June 17, 2019 is On: Act Now to Protect Your Trademark Portfolio and Save Money Before Canada’s New Trademark Regime Takes Effect,” Toronto, May 28, 2019
- Presenter, “Legal Perspectives on the Intersection of Copyright Law and Open Date”, Inform Ontario 44th Annual Education and Networking Symposium & 2019 Annual General Meeting, May 23, 2019
- Presenter, “Everything You Need to Know to Prepare for June 17, 2019 – The In-Force Date of Canada’s New Trademark Regime,” Trademark Law Seminar, Waterloo, April 25, 2019
- Teaches the Advanced Intellectual Property course at the Western University Faculty of Law commencing January 8, 2019
- Presents a “SaaS Agreement Bootcamp: Risk Management and Best Practices”, in Waterloo, December 6, 2018
- Presents privacy seminar entitled “Canada’s Mandatory Privacy Breach Notification Law: What You Need to Know”, to members of the Ontario Mutual Insurance Association, November 28, 2018
- Presents seminar entitled “Startup Law 101: Basics of Intellectual Property (IP) Law”, at the University of Waterloo, November 2018
- Presented a seminar entitled “Essential Legal Considerations in Cloud Computing” at the Social Media and Internet Law: Your Comprehensive Guide program in Toronto, October 2018
- Participates in an intellectual property law career panel organized by the Western Intellectual Property Association, at the Western University Faculty of Law, February 6, 2018.
- Presented seminar entitled “So You Want to Build a Startup? Intellectual Property Considerations for Entrepreneurs” at the University of Waterloo, November 2017.
- Presented a seminar on the new CASL legislation and the effect it will have on the business landscape in Niagara on the Lake, June, 2017.

- Presented a seminar on the new CASL legislation and the effect it will have on the business landscape in the Waterloo Office, May, 2017.
- Presented a Trademark and Advertising Law Bootcamp to members of the Guelph Chamber of Commerce at Cutten Fields, April, 2017.
- Presented a seminar entitled “So You Want To Build A Startup? Intellectual Property Considerations For Entrepreneurs” at the Lazaridis School of Business and Economics at Wilfrid Laurier University, February, 2017.
- Presented a seminar on new developments in trademark and advertising law at the Greater Kitchener Waterloo Chamber of Commerce, January, 2017.
- Taught the 2017 Advanced Intellectual Property course at Western University Faculty of Law, 2017
- Presented at the Guelph Chamber of Commerce’s Lunch and Learn Series “Creations of the Mind: How Intellectual Property will make your Business Great”, April 13, 2016
- Conducted a patent seminar within the Cancer Research and Technology Transfer (CaRTT) Program at the Schulich School of Medicine & Dentistry at Western University, March 28, 2016
- Presented on the topic of Intellectual Property Protection to BBA and MBA students in the Entrepreneurial Finance class at Wilfrid Laurier University, February 10, 2016
- “Managing SaaS Agreements: Risk Management and Best Practices” Webinar, held January 2016
- Presented an Intellectual Property Seminar to University of Waterloo students at the Quantum-Nano Centre, Waterloo, November 11, 2015

## **Mandats importants**

- Lead external counsel to one of Canada’s largest e-commerce retailers.
- IP Counsel to one of Canada’s most famous authors.
- Patent counsel to a global consumer goods manufacturer and retailer.
- Trademark counsel to one of Canada’s largest food manufacturers.
- Counsel to large and small businesses in disputes with the Business Software Alliance (BSA).
- Lead external counsel to a number of Canadian universities and colleges on a range of IP and technology law matters.
- Lead external counsel to a number of large public and private Canadian organizations in the negotiation of contracts for ERP software, integration and implementation.
- Lead external IT counsel to a number of large Ontario municipalities.
- Lead external IT counsel to a number of large Ontario-based and inter-provincial utility companies.
- Lead external IT counsel to a number of large Ontario municipalities.
- Lead external IT counsel to Crown corporations, SMEs and non-profit organizations.
- Lead external to one of Canada’s largest school boards regarding the implementation of a board-wide student information system solution.



- Providing assistance to a large American multinational conglomerate operating in the fields of industry, worker safety, US health care, and consumer goods on Canadian IT and privacy law matters.
- Lead external counsel to a multinational wireless communications company and Canada's largest technology company, on hundreds of technology contract matters, including multi-million dollar IT outsourcing transactions and oversight of client in-house legal counsel, contract specialists and business stakeholders.
- Lead external counsel to a large government organization in a multi-million dollar upgrade of its CRM platform, including contract negotiation vis-à-vis one of the world's largest information technology consulting firms.
- Lead external counsel to a large IoT analytics software startup on a variety of IT matters, including preparation of a variety of contract templates and negotiation of key transactions.
- Lead external counsel to one of Canada's leading wearable technology companies, including providing assistance on key IT matters during development and pre-launch phase.
- Lead external counsel to one of North America's leading companies for customer experience and process automation software for auto manufacturers and dealerships.
- Lead external counsel to Ontario's leading education sector human resources, payroll, and finance solutions providers.
- Lead external counsel to some of Canada's largest municipalities on a number of complex multi-million dollar IT outsourcing transactions.
- Lead external counsel to some of Ontario's largest utility companies on a number of IT services, cloud services and other technology transactions.
- Lead legal negotiator on hundreds of IT-related transactions, including negotiation vis-a-vis some of the world's largest IT service/SaaS providers, IT consultants, and hardware and software vendors including SAP, Oracle, IBM, Microsoft, Accenture, AT&T, NCR, HP, Capgemini, TCS and Salesforce.
- Technology outsourcing and procurement and day-to-day commercial matters
- Patent, trademark, copyright and industrial design application drafting and prosecution
- IP, technology, data and privacy law due diligence in M&A and corporate financing transactions
- Cloud computing services agreements (SaaS, IaaS, PaaS), master services agreements (MSAs), IT consulting and professional services agreements, and statements of work (SOWs)
- Commercial technology agreements, including app development agreements, hosting agreements, software end user terms and conditions, requests for proposal (RFPs), and joint venture and partnership agreements
- Intellectual property enforcement, including patent and trademark infringement, trademark opposition and expungement proceedings and domain name disputes
- Software audit requests and copyright infringement demands, including those advanced by software publishers and copyright management organizations
- Privacy, security, data protection and data management

- Anti-spam (CASL) compliance
- Marketing and advertising law
- Social media and internet law
- IP audits and IP portfolio monetization, licensing and royalty agreements
- IP benchmarking and patent landscaping
- IP services to startups and emerging companies, including under the ElevateIP and Intellectual Property Ontario (IPON) funding programs
- Mergers and acquisitions, private equity and venture capital financings, and cross-border transactions

### **Associations et affiliations professionnelles**

- Member, ABA Business Law Section
- Member, ABA Mergers and Acquisitions Committee
- Member, ABA Cyber & Technology Law Committee
- Member, ABA Intellectual Property Section
- Fellow, Intellectual Property Institute of Canada (IPIC)
- Approved Service Provider, ElevateIP
- Approved Service Provider, IPON (Intellectual Property Ontario)
- International Associate, American Bar Association (Business Law Section)
- Registered Foreign Patent/Trademark Attorney Affiliate, AIPLA (American Intellectual Property Law Association)
- Member, INTA (International Trademark Association)
- Member, Toronto Computer Lawyers' Group (TCLG)
- Member, Communitech
- Member, Greater Kitchener Waterloo Chamber of Commerce
- Member, Cambridge Chamber of Commerce
- Member, Guelph Chamber of Commerce
- Member, Ontario Agri Business Association
- Member, Canadian and Ontario Bar Associations
- Member, Waterloo Law Association
- Member, Law Society of Ontario
- Member, Canadian Technology Law Association (CAN-TECH)
- Member, Toronto Intellectual Property Group (TIPG)
- Member, International Federation of Computer Law Associations (IFCLA)