

WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Robert A. FASHLER
Vanguard Intellectual Property LLP
Vancouver, BC
Canada



Nationality: Canadian

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

Fellow, Chartered Institute of Arbitrators, 2007;
Trademark Agent, Canadian Intellectual Property Office, 1984;
Barrister and Solicitor, Law Society of British Columbia, 1981;
LL.B., (Dean's List), University of British Columbia, 1980;
B.A., (1st Class Hons.), McGill University, 1976.

LANGUAGES

English

PRESENT POSITION

Partner, Vanguard IP LLP, 2018.

November 18, 2019

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EXPERIENCE BEFORE PRESENT POSITION

Counsel, Gowling Lafleur Henderson LLP, Vancouver, BC Canada since November 2006-2018;
Lawyer and Trade-Mark Agent, Farris, Vaughan, Wills & Murphy, Vancouver, Canada.
Lawyer and Trade-Mark Agent, Partner and Head of Intellectual Property and Technology Group at
Ladner Downs (now Borden Ladner Gervais), Vancouver, Canada.
Lawyer and Trade-mark Agent, Partner and Head of Intellectual Property and Technology Department
at Davis & Company LLP (now Davis LLP), Vancouver, Canada.

MEMBERSHIP IN PROFESSIONAL BODIES

Law Society of British Columbia.
Fellow, Patent and Trademark Institute of Canada.
Patent and Trademark Association of British Columbia.
Licensing Executives Society.
Fellow, Chartered Institute of Arbitrators.
Panel of Neutrals, International Trademark Association.
Panelist, National Arbitration Forum.
Panelist, Resolution Canada.

AREAS OF SPECIALIZATION

Intellectual property and technology: trademarks, copyright, patents, trade secrets, geographical indications, technology, software.

Establishment of rights (excluding patents), licensing and other forms of commercialization, disputes, transactions, planning and structuring.

EXPERIENCE IN INTELLECTUAL PROPERTY

Extensive experience in a wide range of intellectual property and technology matters since 1983:

- Registering and establishing intellectual property rights (except for patents).
 - Strategic advice and portfolio management;
 - Represent Academy of Motion Picture Arts and Sciences in Canada in numerous infringement and counterfeiting cases involving the mark OSCAR and the appearance of the OSCAR statuette.
 - Representing Government of the Province of British Columbia with respect to Provincial programs to promote local food (BUY BC Program), to certify organic food (Certified Organic Program), and to regulate and certify premium wines grown in the Province (VINTNERS QUALITY ASSURANCE Program), including strategic advice, registration of trade-marks, certification marks, and geographical indications, and preparation of license agreements.
 - Drafting and negotiating license, transfer and other agreements for the development, commercialization or transfer of intellectual property and technology, including those related to electronic commerce and the Internet.
 - Representation of various parties in disputes relating to intellectual property, technology and software in Canadian courts and administrative tribunals.
 - Significant experience with international disputes and transactions, including those involving Asia and Europe.
 - Arbitrator, mediator and panelist in numerous disputes involving, trade-marks, domain names, software, copyrights, technology, ownership and use disputes.
 - IP and technology due diligence in various business and finance transactions.
 - IP and technology counsel in various transactions for the sale or financing of businesses.
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EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Served on numerous UDRP, STOP (.biz) , and CIRA (.ca) Panels on behalf of WIPO, NAF and Resolution Canada.

Represented Disputants as counsel in UDRP proceedings.

Numerous registrations and transfers of domain names in various TLDs around the world.

Drafting numerous license agreements covering domain names and trademarks.

Represented owner of valuable .ca domain name in sale of domain name to foreign owner, including advising on satisfying Canadian presence requirements, drafting sale agreement, and performing escrow function.

Represented international cosmetics manufacturer and distributor in settling infringement claims made against it, including acquisition of trade-marks and domain names from complainant.

Structured and implemented all procedures required to register several .eu domain names for Canadian corporations during the .EU "sunrise" period, including EU trademark registrations, establishing European presence, and putting license agreements in place.

Represented a national organization with significant brand recognition, and its British Columbia affiliate, to enforce rights regarding a "copycat" union strike website in litigation asserting domain name misappropriation, trade-mark infringement, passing off, and copyright infringement.

General representation to Internet service providers regarding trademarks and domain names.

Conducting international clearances and registrations for Vancouver-based multinational corporations establishing or changing their corporate identities, including international clearance and protection of domain names and trade-marks.

Representing a major British Columbia resort in litigation against former employees who registered a domain name using the resort's main trade-mark and operated a website under that name.

Advising an Internet service company regarding claims by a television company with respect to the use of a domain name.

Represented the operator of a tourism website accused of violating the domain name of a municipal tourism organization.

Represented a corporate trust company in British Columbia against Canadian parties regarding the use of a domain name (case was settled);

Served as Regional Director (British Columbia) and Lecturer on behalf of Osgoode Hall Law School's Masters of Law program in E-Business, which included presenting lectures on cybersquatting;

Several lectures and articles on domain names and cybersquatting.

MAJOR PUBLICATIONS

"Royalty and Payment Terms in License Agreements" (with Sarah Dale-Harris). The Intensive Course in Intellectual Property License Agreements. Osgoode Hall Law School, York University. April 18 and 19, 2007 and May 25 and 26, 2006.

"Protecting Confidential Information in Commercial Transactions". Keeping Secrets Secret – Battling Industrial Espionage. 2006 Institute, Ontario Bar Association. Toronto, Canada. January 24, 2006.

"Legal Branding Strategies for the Global Economy". Keeping Secrets Secret – Battling Industrial Espionage. 2006 Institute, Ontario Bar Association. Toronto Canada. January 24, 2006.

"Structuring Technology Supply Transactions to Prevent, Manage and Resolve Disputes". Continuing Legal Education Society of British Columbia. Vancouver. June 4, 2004.

"Legal Tools and Techniques for Creating Value With Intellectual Capital". Managing the Intellectual Property Portfolio. Intellectual Property Institute of Canada. Vancouver, Canada. February 2004.

"Drafting International Intellectual Property License Agreements to Prevent, Manage and Resolve Disputes." Canadian Intellectual Property Review. Intellectual Property Institute of Canada. Vol. 19, No. 1, July 2003.

"Establishing, Managing and Enforcing Trade-Marks and Business Identities on the Internet" (with

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- Christopher Bennett). First Annual Western IT Law Spring Training Conference. Canadian IT Law Association. Vancouver, Canada. May 15 – 17, 2002.
- “Managing E-Commerce Risk, Part 1: Identifying the Risks” (with David Spratley). Commercial Litigation - The Latest Issues in Insurance Litigation and Corporate Level Disputes. Insight Information Inc., Vancouver, Canada. September 17, 2002.
- “Drafting IP License Agreements to Prevent, Manage and Resolve Disputes”. Continuing Legal Education Society of British Columbia. Vancouver, Canada. April 12, 2002.
- “National and International Developments in Electronic Commerce, Part 2 – Facilitating Transactions and Protecting Rights” for NetLaw ‘99, held by The Canadian Institute, November 30, 1999.
- “Ownership and Licensing Issues: Employers, Employees and Consultants” (with David Fewer). The Complete Course on Negotiating License Agreements. Insight Information Co. Vancouver, Canada. November 1998.
- “The International Address and Domain Name System,” The Canadian Institute, Calgary, 1997;
- “Acquiring Intellectual Property and Related Assets,” Continuing Legal Education Society of British Columbia, Vancouver, 1997;
- “Product Distribution and Licensing: Intellectual Property and Contract Issues,” 4th Annual Chinese Entrepreneurs Association Meeting, Vancouver, 1997.
- “Adding Value to your Business through the Effective Use of Intellectual Property,” paper presented at seminar held in Guangzhou, China, 1995;
- “Taking Security in Intellectual Property,” Pacific Business and Law Institute, Vancouver, 1995;
- “Intellectual Property Strategies for Event Organizers,” Continuing Legal Education Society of British Columbia, Vancouver, 1995;
- “New Plant Breeders’ Rights Act,” Continuing Legal Education Society of British Columbia, Vancouver, 1992;
- “The Acquisition of Intellectual Property and Related Assets,” co-authored by Jacqueline A. Kelly, The Canadian Institute, Vancouver, 1993;
- Numerous other publications relating to intellectual property and other areas of specialization.
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EXPERIENCE IN COURT LITIGATION

Directing and structuring international cases between two water treatment technology companies, including patent invalidation, patent infringement, trade secret misuse, breach of contract, and breach of fiduciary obligations;

Acted as instructing solicitor on major Canadian trade secret case involving geological data and foreign mining claims;

Acting as instructing solicitor on Canadian patent infringement case on behalf of supplier of aviation technology suing an aircraft manufacturer;

Acted as instructing solicitor or co-counsel on several international passing off cases involving trademarks well-known in Hong Kong that were misappropriated in Canada;

Acted in numerous other cases involving passing off, trademark infringement, patent infringement, violation of confidential information and disputes relating to ownership and misuse of domain names;

Most intellectual property cases settled;

Acted as lead counsel in numerous trade-mark oppositions in Canadian Intellectual Property Office.

PROFESSIONAL TRAINING IN MEDIATION

Advanced Mediation Training Course, International Trademark Association, April 28, 2007.
Advanced Mediation Training: Turning Points in Business Mediation, The Center for Mediation in Law, Mill Valley, California, October 11 – 14, 2001.
Advanced Commercial Mediation Training Program, The Center for Mediation in Law, Mill Valley, California, 1999.
WIPO Workshop for Mediators in Intellectual Property Disputes, 1997.

EXPERIENCE IN MEDIATION

As mediator, helped resolve dispute between a large commercial enterprise and a software supplier over ownership and use of software developed by supplier under contract with corporation;
As mediator, assisted two charitable organizations in dispute over trade-mark and business name;
As counsel, represented a large natural resources company accused by employee of misusing trade secrets and breaching confidentiality agreement;
As counsel represented a small Canadian business in a trademark dispute with Intel Corporation regarding the trademark INTEL used for financial services;
As mediator, assisted two business partners dividing a national food importation and distribution business, which included division of the ownership and right to use brands;
As mediator, helped resolve dispute between a Canadian software and hardware development company and a U.S. company expert in air traffic control systems, regarding co-development and licensing of air traffic control hardware and software.

PROFESSIONAL TRAINING IN ARBITRATION

The Chartered Institute of Arbitrators Fast Track to Fellowship Programme Assessment Workshop, Chicago, May 30 – June 1, 2002.
WIPO Domain Name Panelist Meeting, Geneva, September 18, 2001.
WIPO International Conference on Dispute Resolution in Electronic Commerce, Geneva, November 6 and 7, 2000.
WIPO Training Program on Domain Name Dispute Resolution Procedures, Geneva, April 6, 7, and 8.

EXPERIENCE IN ARBITRATION

Served as Panelist on numerous UDRP, STOP and CDRP domain name proceedings between March 2000 to June 8, 2007, and beyond.

Acted as co-counsel in an international arbitration involving a dispute between a Swedish manufacturer of baby diapers and its US distributor. UNCITRAL Rules. British Columbia International Commercial Arbitration Centre, Vancouver, Canada.

Acted as co-counsel in an international arbitration involving a dispute.
Between a Korean manufacturer of pianos and its Canadian distributor. UNCITRAL Rules. British Columbia International Commercial Arbitration Centre, Vancouver, Canada.

ARBITRATION EXPERIENCE

SUMMARY TABLE

| Type | Administering Institution | | Role | | | |
|----------------------------|---------------------------|------------------------|----------------------|-----------------|---------------|----------|
| | Name | Number of Arbitrations | Presiding Arbitrator | Sole Arbitrator | Co-arbitrator | Counsel |
| International Arbitrations | AAA | | | | | |
| | ICC | | | | | |
| | LCIA | | | | | |
| | Ad Hoc | | | | | |
| | UNCITRAL | 2 | | | | 2 |
| Number of cases: sub-total | | 2 | | | | 2 |
| Domestic Arbitrations | | | | | | |
| | | | | | | |
| | | | | | | |
| Number of cases: sub-total | | | | | | |
| TOTAL | | 2 | | | | 2 |

MEDIATION EXPERIENCE**SUMMARY TABLE**

| Type | Administering Institution | | Role | |
|----------------------------|---------------------------|----------------------|----------|----------|
| | Name | Number of Mediations | Mediator | Counsel |
| International Mediations | | | | |
| | | | | |
| | | | | |
| | Ad Hoc | 2 | 1 | 1 |
| | Others: | | | |
| Number of cases: sub-total | | 2 | 1 | 1 |
| Domestic Mediations | Ad Hoc | 5 | 4 | 1 |
| | | | | |
| | | | | |
| Number of cases: sub-total | | 5 | 4 | 1 |
| TOTAL | | 7 | 5 | 2 |