



Plan for success

Develop an intellectual property strategy

Canadian Intellectual
Property Office (CIPO)

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October 23, 2020



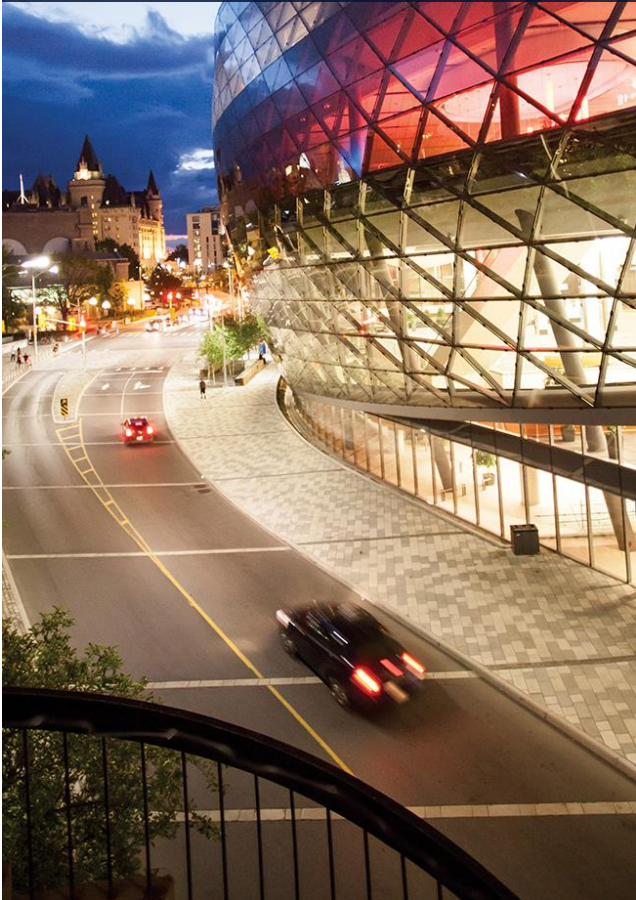


CANADIAN
INTELLECTUAL
PROPERTY
OFFICE

AGENDA

- Who are we?
- Why IP matters
- What is IP?
- What is an IP strategy?
- CIPO resources and tools

CANADIAN INTELLECTUAL PROPERTY OFFICE



WHO WE ARE

SPECIAL OPERATING AGENCY OF INNOVATION, SCIENCE
AND ECONOMIC DEVELOPMENT (ISED) CANADA



Provide
quasi-judicial
functions



Deliver quality
and timely
IP rights



Build
IP awareness
and education



Advance
innovation



Support
businesses
operating
globally



Our ISO certification
positions Canada as
a global leader in
the delivery of
high-quality patents.

1,000+ employees
make up CIPPO's highly skilled workforce

Source: CIPPO Human Resources Plan, March 2017



WHY CARE ABOUT INTELLECTUAL PROPERTY?

What is the value of IP?



Why we should **value IP**

- Research results are tracked
- Tangible assets
- Intangible assets



Your **technology** and your **IP**



Where is the **value?**

INTANGIBLES TO MARKET CAP RATIO IN ADVANCED ECONOMIES

United States (S&P 500)	91%
Europe (Euro Stoxx 50)	77%
United Kingdom (FTSE 100)	77%
France (CAC 40)	77%
Germany (DAX)	75%
CANADA (S&P/TSX)	70%
Japan (Nikkei)	55%
Spain (IBEX 35)	54%
Italy (FTSE MIB)	54%



AWARENESS AND USE OF IP

Benefits of IP

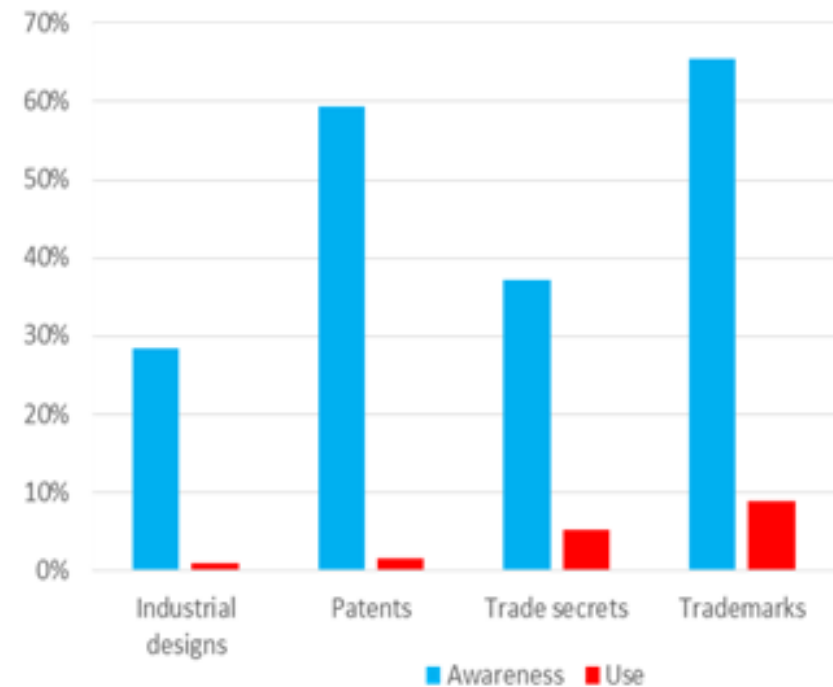
IP-intensive industries contribute **\$332B** to Canada's GDP and **2 million** jobs in Canada

4 times more likely to export

2 times more likely to be high-growth

27% more likely to seek financing

IP Awareness and Use by IP Type



Only 10% of companies that innovate have an **IP strategy**



TYPES OF INTELLECTUAL PROPERTY

What is IP?

Consider intangible expenses related to your business:

- Marketing and advertising
- Research and development
- Website
- Packaging
- Pricing and client lists

TRADEMARK



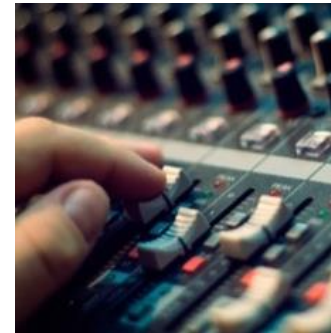
A "sign" used to differentiate your products and services from those of other companies

PATENT



For new, useful inventions that are not obvious

COPYRIGHT



Original work

INDUSTRIAL DESIGN



Unique visual features of shape, configuration, pattern or ornament as applied to a finished article

TRADE SECRET

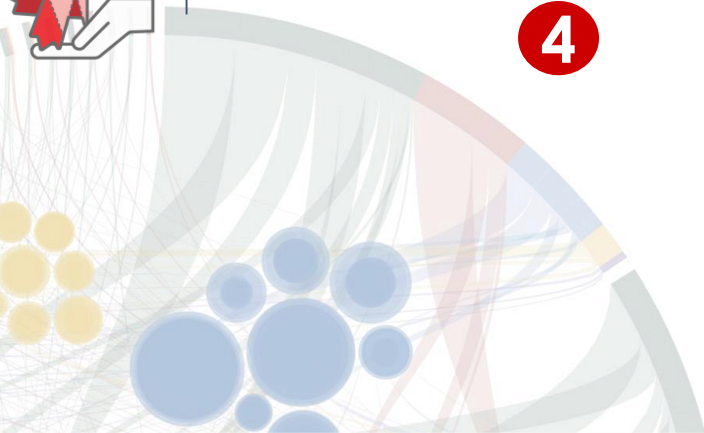


Confidential and valuable business information



Intellectual Property: Best practices in industry/academic collaborations

- 1 Nondisclosure Agreement (NDA)** – execute it immediately *before* you share any enabling information
- 2 Collaboration Agreement** - get it started ASAP as it determines who will own the IP outcomes
- 3 Define Roles** - clearly articulate and define who is bringing what to the table
- 4 Patent *Before* You Publish**

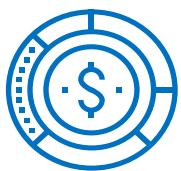




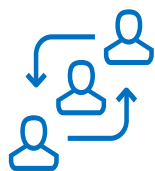
HOW TO MANAGE IP

STRATEGY

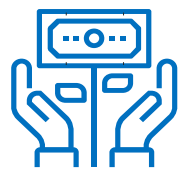
NEEDS



Sell products/
services



Build assets and
license



Attract
financing



Products/
services



Marketplace



Reduce
competition



Business
partners/
contracts



Avoid lawsuits

IP CAN IN-DIRECTLY HELP WITH

- Selling products/services
- Producing your products
- Creating/Identifying business partners

IP CAN DIRECTLY HELP WITH

- Building assets and licensing
- Reducing competition
- Avoiding legal pitfalls

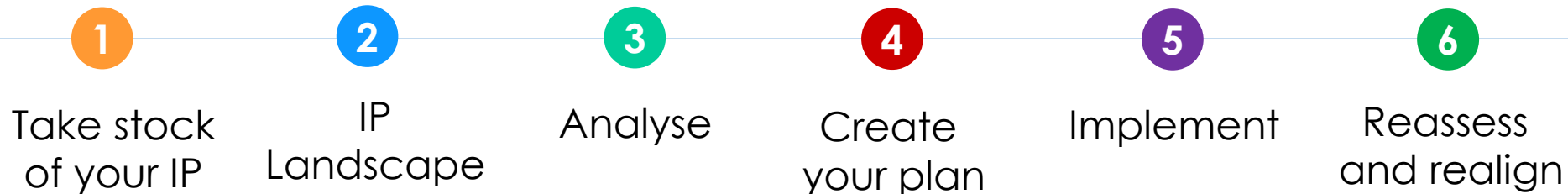


WHAT IS AN IP STRATEGY?

Plans and **actions** designed to maximize the value of IP to **achieving a business' objectives**

- Potential for commercialization
- Spin-offs, licensing, etc...

Steps





IP STRATEGY

STEP 1: TAKE STOCK OF YOUR IP

Take stock of your IP

Start by defining your overall business objectives and relevant IP assets that can help you achieve your goals.

Identify your technologies

Define

- Research teams
- Resources
- technologies
- Funding
- Partnerships
- Commercialisation potential

Understand your IP

- Treat IP as an asset
- IP inventory
 - Consider your informal IP
 - Domain names
- Confirm the details
- IP-related contracts



IP STRATEGY

STEP 2: DEFINE THE IP LANDSCAPE

Understand the innovation landscape

Knowing the IP landscape is crucial. Don't re-invent the wheel!

- Reduce risks of lawsuits
- Gives you an idea of the IP landscape
- Types of searches:
 - Patentability
 - Patent validity
 - Non-infringement (Freedom to operate)
 - Trademark registrability/domain names.
- Practically – not all searches may be complete
- Opinions are used to assess risk – there is no guarantee against being sued!



IP STRATEGY

STEP 3: ANALYSE

Identify the gaps

Using the findings from above, identify the gaps that prevent you from achieving your business objectives. For each gap, formulate actions.

Gaps/Opportunities

- Assess if your IP is attractive for your markets
- Assess if you need to acquire new rights
- Develop them internally/externally
- Assess if you need to remove redundant IP or consolidate different IP rights



IP STRATEGY

STEP 4: CREATE YOUR PLAN



Consider:

- Lifecycle of creation
- Freedom to operate vs. infringement
- Quality vs. Quantity
- Management and maintenance

ACQUIRE/DEVELOP IP ASSETS



Includes:

- R&D policy
- Partnership policy

R&D POLICY



Includes:

- Disclosure Policy
- Sales and marketing

DISCLOSURE POLICY



Determine:

- Onboarding
- Trade secret
- IP ownership
- Document management

HR POLICY



IP STRATEGY

STEP 5: IMPLEMENT YOUR STRATEGY

Execute the IP strategy

Put your plans into actions and commit the required resources to execute the plan.

Train your research teams

- What's confidential/trade secret
- What is IP

Contracts/Agreements

- Assignment/Licensing Agreements
- Confidentiality Agreements

Innovations on the market

- Selecting your licensees
- Licensing and enforcement



IP STRATEGY: licensing or assignment

Licensing

- Both parties able to benefit from the IP monetarily
- Licensor is exposed to new markets with the clients of the licensee
- Minimized competition by turning a possible competitor into a partner
- Licensor does not have to solely rely on own resources to develop and market product/service
- If you're the licensee, its lower cost when compared to owning the IP
- *Licensing does not affect inventors on patent*

Assignment

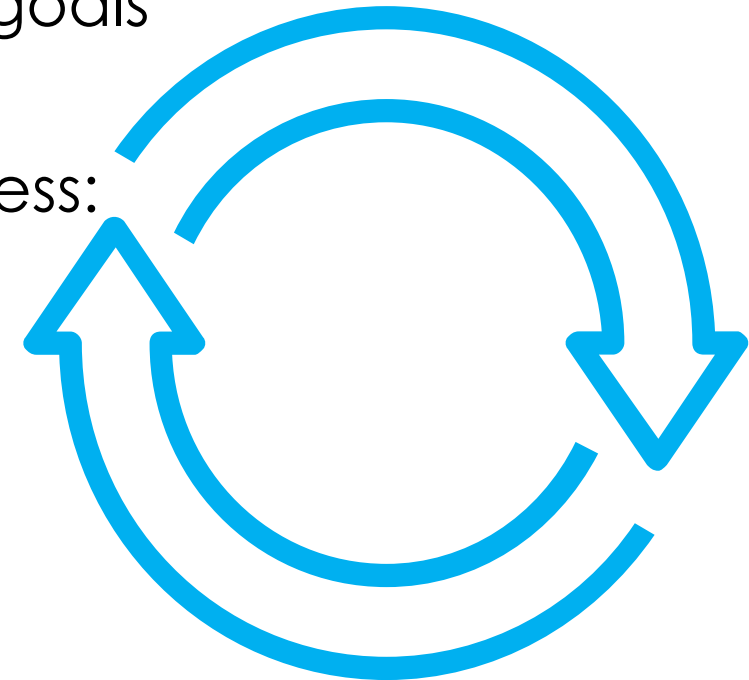
- Ownership of IP is transferred
- Quickest way to gain value (lump sum)
- Seller (assignor) no longer assumes the responsibility of maintaining/enforcing the IP
- Assignee holds full control on the future use of the IP
- *Inventors do not change with change in ownership!*



IP STRATEGY

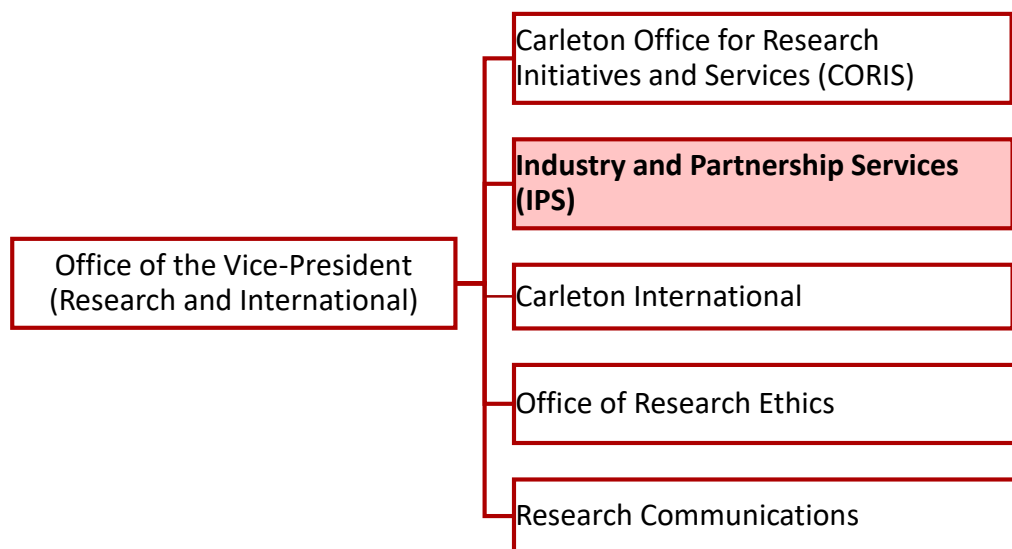
STEP 6: REASSESS AND REALIGN

- In the context of a spin-off
- Make sure your IP strategy remains relevant with your business goals
- Reasons to refine and reassess:
 - Competitors' new IP
 - Your new IP assets
 - Your new business goals





Industry and Partnership Services



IPS supports collaboration between companies and other partners and the University's researchers



Identify and negotiate with potential partners



Leverage public funding with external capital and expertise



Provide advice regarding management of IP (commercialization)



Structure a suitable arrangement

4th Floor, Arise Building, x3570

ips@cunet.carleton.ca

<https://carleton.ca/ips/>

How Industry and Partnership Services can help

- Confidentiality, Research, IP Agreement to protect IP ownership
- Identify and Evaluate Discoveries
 - Identify opportunities for innovation transfer and commercialization.
 - Researcher(s) complete a Disclosure Form and request a meeting.
- Promote innovations on- and off-campus
- Conduct IP assessment and recommend IP strategy (patent, trademark, copyright, etc)
- Conduct Market Assessments and identify potential partners
- Develop a commercialization strategy (licensing or assignment) and ensure your IP strategy is aligned with market assessment
- Analyse commercialisation options (Licensing or assignment)
- Assist with patent prosecution and maintenance (due dates)



Commercialising Carleton's innovations

Carleton researcher	Department	Issued patent or recent application	Title	Assignee	Other Patents/ Applications in Family
Mojtaba Ahmadi	Mechanical & Aerospace Engineering	CA 2867484C	CONTROL SYSTEM AND DEVICE FOR PATIENT ASSIST	Gaittronics Inc	US10251805B2;US9907721B2;
Rafik Goubran	Systems & Computer Engineering	CA 2485728C	DETECTING ACOUSTIC ECHOES USING MICROPHONE ARRAYS	Mitel Networks Corp	EP1526755B1;US7630503B2
Rony Amaya	Electronics	US 10,439,442B2	WIRELESS ENERGY TRANSFER USING ALIGNMENT OF ELECTROMAGNETIC WAVES	Teslonix Inc	CN107078561A;EP3213390A4; JP6629852B2;KR101949963B1;
Tim Haats	School of Industrial Design	US 9,986,798B2	UMBRELLAS WITH INFLATABLE PORTIONS	The Handwerker Umbrella Company	CA2966547A1;CN107105841A; EP3214966A4;JP2017535391A; US10244835B2;US10602816B2
Leonard MacEachern	Electronics	US 9,782,104 B2	SYSTEMS, METHODS AND DEVICES FOR ACQUIRING AND PROCESSING PHYSIOLOGICAL SIGNALS	Gesturelogic Inc	
David McMullin	Chemistry	WO2020/118451A1	PORTABLE SYSTEM FOR ANALYSING MICROBIAL POPULATION IN A FLUID	Luminultra Tech Ltd	
Anatoli Ianoul	Chemistry	US2019/178804A1	LIGHT-ABSORBING OPTICAL FIBER-BASED SYSTEMS AND METHODS	Spartan Bioscience Inc.	



Federal programs **supporting innovation**

- Innovation Canada (www.innovationcanada.ca)
 - Accelerated Growth services
 - Clean Growth Hub
 - COVID-related initiatives
 - Explore IP
 - Innovative Solutions Canada
 - Innovative Super-Clusters Initiative
 - Strategic Innovation Fund

- Industrial Research Assistance Program
 - Innovation Assistance Program (IAP)



ACCESS IP RESOURCES

IP STRATEGY ASSESSMENT TOOL

Plan your IP strategy

Considerations for your intellectual property strategy

Get the most out of everything your business produces! Get started by planning a comprehensive intellectual property (IP) strategy by using the Canadian Intellectual Property Office's (CIPO) online self-assessment tool.

You can integrate your IP strategy into your business plan to help maximize the value of your IP and protect your competitive advantage.

4 reasons to complete the intellectual property self-assessment

1. Learn what information to consider in your IP strategy.
2. Discover what IP is worth protecting, and ways to protect it.
3. It's free, fast and easy, and will take most users no more than five minutes to complete.
4. You get a detailed, printable guide with IP considerations for anytime reference.

[Build your custom IP strategy guide](#)

[Read the plain-text, non-customized IP strategy guide](#)



[Download sample guide \[PDF 238 MB, 4 pages\]](#)



CIPO and Carleton **collaboration**


- Virtual office hours
- Available for meetings
- Webinars on IP-related topics
 - Organised by IPS (or any other groups)
 - Invited guest
- Role of the IP advisor
 - Also, what I will not provide




CONTACT CIPO

 www.cipo.gc.ca or Canada.ca/ip-for-business

 Client Service Centre
Phone: 1-866-997-1936

 In-person meetings by appointment Canadian Intellectual Property Office
Place du Portage I
50 Victoria St., Room C-229
Gatineau, QC K1A 0C9

 IP Advisor
National Capital Region based
Caroline Lefebvre – caroline.lefebvre@canada.ca

 Find more programs and support for Canadian businesses and innovators at
innovation.canada.ca

Other CIPO events: Canada.ca/events

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@Caro_Lefebvre70

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English



<https://form.simplesurvey.com/f/1/IPAE>

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