Plan for success
Develop an intellectual property strategy

Canadian Intellectual Property Office (CIPO)
Caroline Lefebvre, IP Advisor

October 23, 2020
AGENDA

- Who are we?
- Why IP matters
- What is IP?
- What is an IP strategy?
- CIPO resources and tools
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 CIPO’s highly skilled workforce

Source: CIPO Human Resources, April 2021
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

<table>
<thead>
<tr>
<th>Country</th>
<th>Ratio</th>
</tr>
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<tbody>
<tr>
<td>United States</td>
<td>91%</td>
</tr>
<tr>
<td>Europe</td>
<td>77%</td>
</tr>
<tr>
<td>United Kingdom</td>
<td>77%</td>
</tr>
<tr>
<td>France</td>
<td>77%</td>
</tr>
<tr>
<td>Germany</td>
<td>75%</td>
</tr>
<tr>
<td><strong>Canada (S&amp;P/TSX)</strong></td>
<td><strong>70%</strong></td>
</tr>
<tr>
<td>Japan</td>
<td>55%</td>
</tr>
<tr>
<td>Spain</td>
<td>54%</td>
</tr>
<tr>
<td>Italy</td>
<td>54%</td>
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</tbody>
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Source: A New North Star Canadian Competitiveness In An Intangibles Economy, Public Policy Forum, April 2019

IP-intensive industries contribute $332B to Canada’s GDP and 2 million jobs in Canada.

**Benefits of IP**

- **4 times** more likely to export
- **2 times** more likely to be high-growth
- **27%** more likely to seek financing

**AWARENESS AND USE OF IP**

- **IP Awareness and Use by IP Type**

- Only 10% of companies that innovate have an IP strategy.

WHAT IS IP?

Consider intangible expenses related to your business:

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

<table>
<thead>
<tr>
<th>TRADEMARK</th>
<th>PATENT</th>
<th>COPYRIGHT</th>
<th>INDUSTRIAL DESIGN</th>
<th>TRADE SECRET</th>
</tr>
</thead>
<tbody>
<tr>
<td>A “sign” used to differentiate your products and services from those of other companies</td>
<td>For new, useful inventions that are not obvious</td>
<td>Original work</td>
<td>Unique visual features of shape, configuration, pattern or ornament as applied to a finished article</td>
<td>Confidential and valuable business information</td>
</tr>
</tbody>
</table>
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

SELL PRODUCTS/ SERVICES
BUILD ASSETS AND LICENSE
ATTRACT FINANCING

NEEDS

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**
1. Take stock of your IP
2. IP Landscape
3. Analyse
4. Create your plan
5. Implement
6. Reassess and realign
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

WHAT IS AN IP STRATEGY?
IP STRATEGY

STEP 2: DEFINE THE IP LANDSCAPE

Understand the innovation landscape

- 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!

Knowing the IP landscape is crucial. Don’t re-invent the wheel!
Identify the gaps

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

IP STRATEGY

STEP 3: ANALYSE

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

Includes:
• R&D policy
• Partnership policy

Includes:
• Disclosure Policy
• Sales and marketing

Determine:
• Onboarding
• Trade secret
• IP ownership
• Document management

ACQUIRE/DEVELOP IP ASSETS
R&D POLICY
DISCLOSURE POLICY
HR POLICY

WHAT IS AN IP STRATEGY?
IP STRATEGY
STEP 5: IMPLEMENT YOUR STRATEGY

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

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

WHAT IS AN IP STRATEGY?
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

Carleton Office for Research Initiatives and Services (CORIS)
Industry and Partnership Services (IPS)
Carleton International
Office of Research Ethics
Research Communications

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)

Contact Dr. Theresa White, Manager- Contracts and Innovation Transfer

theresawhite3@cunet.carleton.ca
# Commercialising Carleton’s innovations

<table>
<thead>
<tr>
<th>Carleton researcher</th>
<th>Department</th>
<th>Issued patent or recent application</th>
<th>Title</th>
<th>Assignee</th>
<th>Other Patents/Applications in Family</th>
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<tbody>
<tr>
<td>Mojtaba Ahmadi</td>
<td>Mechanical &amp; Aerospace Engineering</td>
<td>CA 2867484C</td>
<td>CONTROL SYSTEM AND DEVICE FOR PATIENT ASSIST</td>
<td>Gaittronics Inc</td>
<td>US10251805B2;US9907721B2;</td>
</tr>
<tr>
<td>Tim Haats</td>
<td>School of Industrial Design</td>
<td>US 9,986,798B2</td>
<td>UMBRELLAS WITH INFLATABLE PORTIONS</td>
<td>The Handwerker Umbrella Company</td>
<td>CA2966547A1;CN107105841A;EP3214966A4;JP2017535391A;US10244835B2;US10602816B2</td>
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<tr>
<td>Leonard MacEachern</td>
<td>Electronics</td>
<td>US 9,782,104 B2</td>
<td>SYSTEMS, METHODS AND DEVICES FOR ACQUIRING AND PROCESSING PHYSIOLOGICAL SIGNALS</td>
<td>Gesturelogic Inc</td>
<td></td>
</tr>
<tr>
<td>David McMullin</td>
<td>Chemistry</td>
<td>WO2020/118451A1</td>
<td>PORTABLE SYSTEM FOR ANALYSING MICROBIAL POPULATION IN A FLUID</td>
<td>Luminultra Tech Ltd</td>
<td></td>
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</table>
Federal programs **supporting innovation**

- Innovation Canada ([www.innovationcanada.ca](http://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.

Build your custom 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
Canada