



Innovation, Science and  
Economic Development Canada  
Canadian Intellectual Property Office

Innovation, Sciences et  
Développement économique Canada  
Office de la propriété intellectuelle du Canada

Canada

Canadian Intellectual Property Office

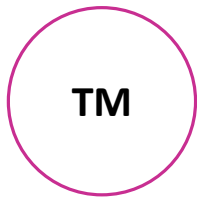
# Intellectual property (IP) in R&D

Presenters: Caroline Lefebvre, Lisa Desjardins

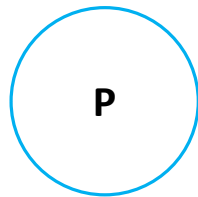
Date: February 28, 2023

# What does CIPO do?

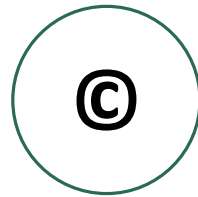
We are responsible for administering and processing IP rights in Canada.



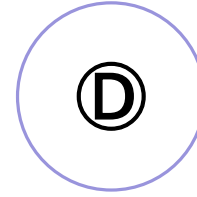
**Trademarks**



**Patents**



**Copyrights**

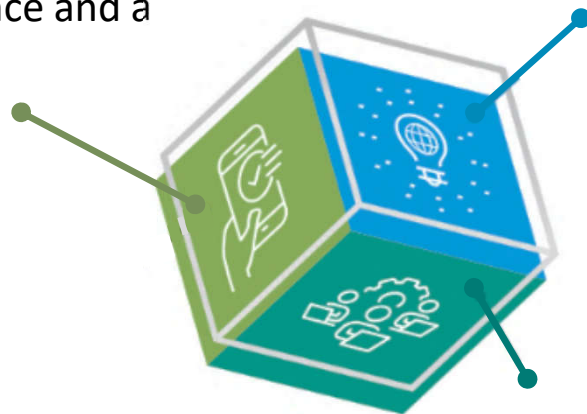


**Industrial  
designs**

# CIPO's strategic priorities

## Priority 1

Deliver timely and quality IP services through operational excellence and a modern client experience



## Priority 2

Foster innovation and competitiveness through leadership and education

## Priority 3

Be a high-performing organization that is built for the future

# IP Awareness and Education services to help you understand:

- What IP is
- How to identify your IP
- How to protect IP
- How to manage IP
- Where to find help



Resources at  
[canada.ca/ip-for-business](https://canada.ca/ip-for-business)



Webinars, seminars

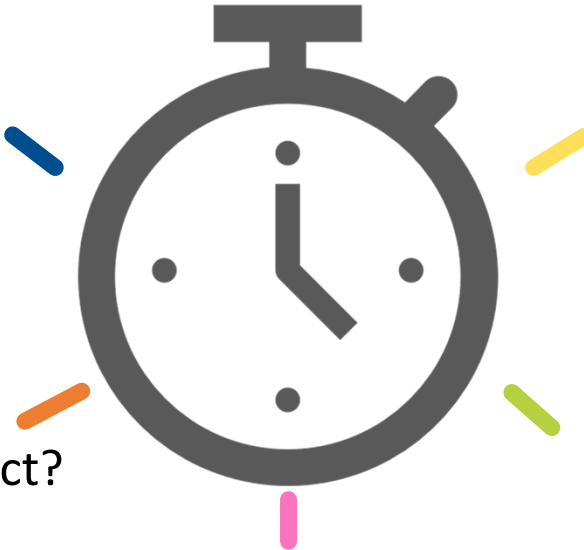


Meeting with an IP advisor

# What we will talk about today

Who can help me?

What is a good IP framework for the project?



What to consider when creating new IP in a R&D project?

What kind of IP can be created in R&D?

How do I know who owns the IP?

# R&D, tech transfer & TRL simplified

- 1, 2, 3 Confirm there is a technical / knowledge gap, POC
- 4, 5, 6 Demonstrate you solved the problem
- 7, 8, 9 Prove & integrate into product/service
- >9 Transfer the knowledge/tech

The success depends on the efforts of

Researcher



Finance /  
Accounting



BD/TTO



IP Counsel



Competitors



# Don't waste your time. Confirm there is a technical problem / knowledge gap

**Researcher**



Literature review  
Critical review  
Research, POC

**Finance /  
Accounting**



SR&ED  
Budget  
ROI

**BD/TTO**



Market research  
Unmet need  
CAGR  
Market share

**IP Counsel**



IP Landscape  
Defensive strategy  
PI NDA/CDA

**Competitors**



Market intel  
IP landscape  
Offensive IP strategy

# Give credit to whom credit is due. Figure out how to show & claim your solution

Researcher



Scientific article  
Conference

Finance /  
Accounting



Budget

BD/TTO



Disclosure  
Ownership

IP Counsel



Disclosure  
Patentability  
Prior art  
IP rights

Competitors



Prior art  
Invalidity  
Publish before you



# Work with others. Prove that your innovation works.

Researcher



R&D collaboration

Finance /  
Accounting



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BD/TTO



Foreground IP  
Background IP  
NDA, CDA, MTA,  
Prior art, IP landscape  
Cross-licensing

IP Counsel



Competitors



Prior art  
Invalidity

# Give your innovation wings. Transfer the knowledge / technology.

**Researcher**



Hand-over

**Finance /  
Accounting**



Revenue  
Expenses

**BD/TTO**



Find partner  
Term sheet

**IP Counsel**



IP assignment  
licensing agreement

**Competitors**



Evidence of Use  
Infringement

# What kind of IP will we create?

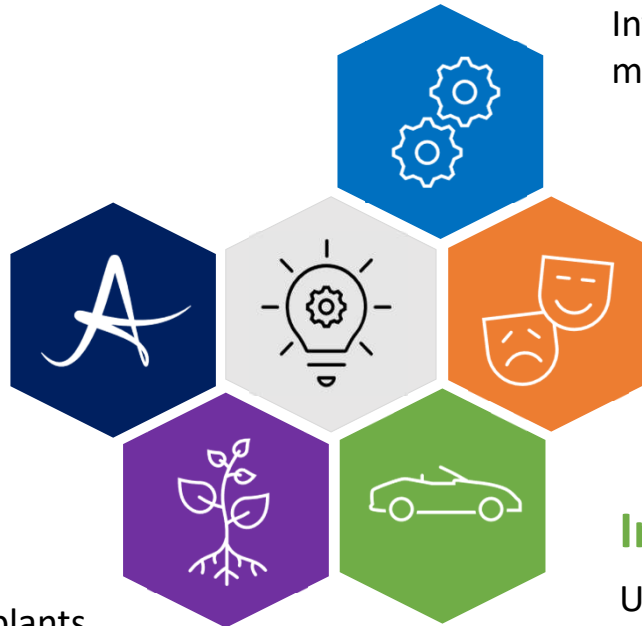
Registered IP rights such as:

## Trademarks

Brand: Words, logos, geographical indications, certification marks

## Plant breeders' rights

Varieties and denominations of plants



## Patents

Inventions: New or improved products, machines, processes and compositions

## Copyright

Creative works: Literary, artistic and musical

## Industrial designs

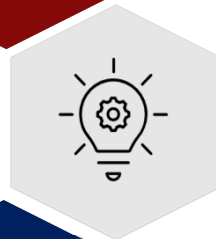
Unique visual features: Shape, patterns, lines or colours of finished articles

# What kind of IP will we create?

And IP such as:

## Trade secrets and confidential information

Data, lists, formulas, know-how



Websites and domain names, trade names, social media accounts, customer lists, territory rights, publicity rights, traditional knowledge

# What kind of rights are they?

Right to **exclude** others from...

## Trademarks

...using a “mark” in relation to goods or services in a manner that is likely to cause confusion as to its source.

## Plant breeders' rights

...producing, conditioning, selling, exporting, importing, using and propagating stock material.



## Patents

...making, using, selling or importing an invention.

## Copyright

...producing or reproducing in any material form, performing, or publishing a work or any substantial part of the work.

## Industrial designs

...making, selling, or renting any article to which the design is applied.

# Right to seek relief...

## Trade secrets and confidential information

...from the misappropriation of confidential information that has business value.



# Creators vs. owners of IP

## CREATORS

- Employees
- Service providers
- Partners:
  - Educational
  - Corporate
  - Government
  - Others

## OWNERS

- Dependent on the **IP terms** of the respective **contracts**
- If the contracts are not clear, IP ownership will be determined by the **laws of the jurisdiction**.



Don't assume that you own the IP – Always have contractual IP terms that clearly articulate ownership.

# How do I build a framework for IP?

- Establish an **IP policy**
- Manage **internal IP disclosures**
- Understand impact of **public self-disclosures**
- Conduct routine **IP searches**
- Control IP ownership in contracts**



Understand why IP is important as a whole – You don't want to lose your IP rights.



# Establish an IP policy

## Why do we need an IP policy?

An IP policy manages expectations by clarifying:

- How IP will be **identified, disclosed, evaluated, and managed**
- How the organization determines **IP ownership**
- Provides a **transparent framework** for cooperating with third parties



Ask yourself : What is the default position of the organization when it comes to IP ownership?

# Manage internal IP disclosures

## Internal IP disclosures

- Provide a **written record of the innovations**
- Clarify who might have a **claim to ownership**
- Are **usually mandatory** under contract or IP policy



You need to know when IP is created and have a management system in place to ensure rights are not inadvertently lost.

# Impact of public self-disclosures

## What is public self-disclosure:

- **Anything** that discloses your technology to the public, in whole or in part, **anywhere** in the world

## Risks:

- Loss of IP rights (patents, industrial designs)
- Loss of trade secrets / tech know-how
- Lost commercial value



Establish a process for appropriate approvals prior to any public self-disclosure.

# Impact of public self-disclosures



12-month grace period

**Canada and the United States allow grace periods to still file for patent and industrial design protection after a public self-disclosure.**



It is best to NOT rely on grace periods as many countries do not have them, so file for protection before you disclose.

# Conduct routine IP searches

## Search IP early and often

- A cornerstone for **return on your R&D investment**
- Informs your IP strategy – **business intelligence**



IP searches help ensure that you aren't investing in work that has already been done.

# Conduct routine IP searches

## Limitations

- Patent applications are only made public **18 months** after the filing date
- Only issued industrial designs are published
- Copyright is only searchable by title

## Free databases with wide international coverage:

- [www.wipo.int/reference](http://www.wipo.int/reference) (World Intellectual Property Organization)
- [www.espacenet.com](http://www.espacenet.com) (European Patent Office)
- [www.euipo.europa.eu](http://www.euipo.europa.eu) (European Union IP Office)
- ...plus a range of free, third-party search engines



You may never be able to get the complete picture of others' IP rights.

# Control IP ownership in contracts

## Initial engagement

- Non-disclosure/Confidentiality agreement (**NDA/CDA**)
- Material transfer agreements (**MTA**)
- **Evaluation** agreement



IP ownership is actively negotiated in almost every contract.

# Control IP ownership in contracts

## Contracts governing commercial relationships

- **Workforce:** employees, services
- **Collaboration/Partnership:** sponsorships, joint ventures, etc.
- **Commercialization:** licenses, assignments
- **Grants and contributions:** Government of Canada, others
- **Procurements:** Government of Canada, others



IP terms can extend beyond the termination of a contract.



# Types of contractual IP

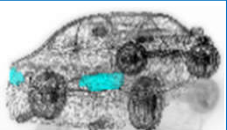
## Background IP (BIP):

- Pre-existing IP
- No ownership changes
- Any allowed use of a party's BIP is spelled out in the contract

Company A  
Background IP



Company B  
Background IP



## Foreground IP (FIP)

- New IP developed by one or more parties under the terms of the contract
- Ownership is negotiated



Parties can enter commercialization contracts after the R&D is complete.

CIPO does not provide contract templates or drafting advice. These examples are for educational purposes. Get legal advice to ensure your contracts properly protect your IP.

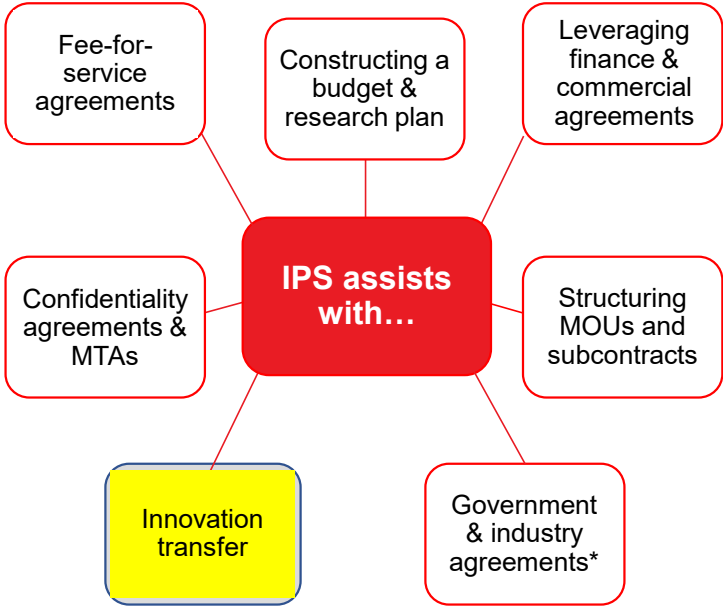
# Canada's experimental use exception

Relates to **patents** and background IP:

- Allows use of patented technologies and processes for experimental purposes
- Permission not required from the patent owner
- Beyond the experimental phase, researcher must obtain permission (i.e. a license) for use

# CITO and Industry & Partnership Services (part of OVPRI)

- IPS supports research collaboration between university investigators, companies, and other partners.
- CITO supports IP protection and Innovation Transfer



\* Inclusive of NSERC Alliance, MITACS (except Globalink) & OCI.

# Contact CITO/IPS to get started

- Complete IP Disclosure Form (<https://carleton.ca/ips/disclosure-forms/>) and submit to CITO
  - All disclosures are kept confidential
  - CITO performs preliminary IP and commercial assessments.
- CITO support beyond this point is voluntary and subject to completion of a Revenue Share Agreement between Inventor(s) and Carleton.
- CITO support includes:
  - Identify and work with outside counsel on strategy, applications and prosecution..
  - Pay government and legal fees.
  - Market Assessments—identify and contact potential partners/licensees
  - Draft and negotiate licensing/transfer agreements
  - Promotion of innovations
  - Support for NSERC Idea to Innovation (I2I) and Lab2Market (L2M) applications

# Carleton IPS/CITO Contacts

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### Manager, Innovation Transfer and Agreements

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- Internal phone: x4024

# Summary of IP management best practices

- Establish an IP policy
- Document and manage internal innovation and public self-disclosures
  - Assess commercial value for the product resulting from R&D
  - Determine what IP has been created, what your rights are, and how to protect them
- Conduct routine IP searches
- Manage contracts to establish IP ownership and other IP-related issues

# Where to find help

Where in the world and how should I secure my IP rights?

Can I protect my (x,y,z) with a patent, a trademark, an industrial design or a copyright?

How much will it cost to secure IP protection?

Who else is in this space and what's their IP?

What should I do if someone else has copied my idea?



Locate a licensed IP agent near you



Find an IP professional



Find a lawyer

# IP Awareness and Education services

We can help you understand

- What IP is
- How to identify your IP
- How to protect IP
- How to manage IP
- Where to find help



[Canada.ca/IP-for-business](https://Canada.ca/IP-for-business)



Contact an IP advisor



Client Service Centre: 1-866-997-1936



LinkedIn



Canada 