

Intellectual Property and Patents

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Most Common Intellectual Property Rights

- Patents
- Trade-marks
- Copyrights
- Industrial designs
- Integrated Circuit Topographies
- Trade secrets

Patents

- Exclusive right to manufacture, sell and use an invention
- Must be original, not obvious and have industrial application
- Duration of patent protection: twenty years from the application filing date

Trade-marks

- Used to distinguish the source of products and/or services from one business to another
- TM - “Common law” use of a mark limits its enforceability to the particular locality where the mark is used

Trade-marks (cont'd)

- ® - A registered trade-mark is presumptive evidence of the validity of the mark and the owner's right to use that mark nation-wide
- Duration of trade-mark protection is fifteen years from the registration date with indefinite renewal

Copyrights

- An exclusive right to reproduce an original work of authorship fixed in any tangible medium of expression
- Extends to any original literary, dramatic, musical or artistic work, including computer software
- Does ***not*** extend to any idea, method of operation, concept etc.

Copyrights (cont'd)

- Automatically subsists from the instant of creation
- Registration confers the owner with presumed evidence of the validity and ownership of the protected work
- Protection extends to the life of the author, plus fifty years after the author's death

Integrated Circuit Topographies

- Protects semiconductor integrated circuits or microchips and their topographies
- Duration of protection is ten years from application filing date
- Chip design must be original
- Registration must be effected within two years of commercial sales

Industrial Designs

- Protection relates to the aesthetic appearance of articles
- Design must be original
- Duration of protection is ten years from the registration date

Trade Secrets

- Proprietary information which is not publicly available and confers economic benefit to the owner of such information
- Includes: know-how; technical, commercial, financial information; business and sales techniques; customer and supplier lists

Trade Secrets (cont'd)

- Confidential nature of the information must be communicated from the owner to the recipient
- **Not** afforded under any statutory law, i.e. common-law protection only
- Can be protected for as long as the secrecy nature is maintained

Patenting Requirements: 3 Criteria

- Novelty
- Ingenuity
- Utility

Novelty

- Whole invention being anticipated by a single source
- Prior publication – patents, papers
- Public disclosure – conferences, posters, sales, etc.

Ingenuity

- Not obvious to average person “skilled in the art”

Utility

- Able to work and has industrial usefulness

Subject Matter

- ***Not* patentable (*yet*)** –
- Mere idea, scientific principles, abstract theorems, medical treatments, software programs, etc.
- Internet-related developments
- Business methods
- Genetic engineering and higher life-forms

Patenting Process:

- **Patentability Searches**
- Canada – www.cipo.gc.ca
- US – www.uspto.gov

Patenting Process: (cont'd)

- **Filing Patent Applications**
- Entitlement given to first filing party
- Preparing an application – abstract, description, drawings and claims
- Filing an application – provisional vs. complete

Patenting Process (cont'd)

- **Filing Patent Applications** (cont'd)
- Examination and response
- Amendments
- Patent grant

Patenting Process (cont'd)

- **Foreign Patents**
- Determining where to file
- Paris Convention
- Patent Cooperation Treaty (PCT)

Patenting Issues Pertaining to Academic Institutions

- **Disclosure**
- Publication vs. filing a patent application
- One-Year “grace period”
- Advantage of a provisional application
- Drawbacks of a provisional application
- Non-disclosure agreements

Patenting Issues Pertaining to Academic Institutions (cont'd)

- **Inventorship**
- Definition of inventor
 - A person conceiving the inventive idea
 - **Not** a person presenting a problem to another for solution
 - **Not** a person who critiques an inventive development
 - **Not** a person collecting experimental data

Patenting Issues Pertaining to Academic Institutions (cont'd)

- **Ownership**
- University policy
- Outside contractual obligation
- Sole vs. joint
- Assignment – whole or partial

Patenting Issues Pertaining to Academic Institutions (cont'd)

- **Licensing**
- Retention of ownership rights
- Exclusive vs. non-exclusive
- Improvements – who owns the IP?

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