

INTELLECTUAL PROPERTY

UNDERSTANDING PATENTS COURSE

JULY 15-19, 2024



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Intellectual Property Institute of Canada
Institut de la propriété intellectuelle du Canada



McGill

School of
Continuing Studies



IPIC-McGill Intellectual Property Understanding Patents Course 2024

Join Professionals from Across the Country to Learn from Leading Practitioners in the Field of IP

Since 1994, the Intellectual Property Institute of Canada and McGill University have gathered some of the top practitioners in the field of intellectual property to conduct a series of intensive, practical summer courses in intellectual property. More than 2,500 professionals from the business, legal, and public sectors have gained valuable insight and hands-on experience by participating in our unique summer program. Our courses are also an excellent opportunity to network with individuals from diverse backgrounds who have an interest in Canadian intellectual property.

Each year, the program offers a comprehensive suite of pragmatic courses to help practitioners in the legal, business, and government sectors keep up to date on the latest in intellectual property. Taught by seasoned IP professionals, the program is made up of three specialized courses in the areas of patents, trademarks, and copyright. Participants can sign up for individual modules, full courses, or enrol in the entire program to gain knowledge of a specific aspect of IP, acquire the insights needed to protect a portfolio of intellectual property, or advance their careers in the area of IP law.

Understanding Patents

An Introductory Course: Monday, July 15, 2024 to Friday, July 19, 2024

Module 1 (3 days) Obtaining and Enforcing a Patent – The Basics and Why They Matter to Your Business (July 15-17)

Module 2 (2 days) Exploiting IP Rights – Strategies re Patent Portfolio Management (July 18-19)



By the end of the week, the challenge and excitement of establishing a patenting strategy became clear, and I recommend the course to others. Being relatively new to the world of patenting, I found the course tremendously informative and well organized. The format—morning seminars and afternoon small-group workshops—provided ample opportunities for learning, questioning, and reflecting. The speakers and program directors were congenial, knowledgeable, and open to feedback. From a technology commercialization perspective, various relevant concepts are addressed, from patent structure, claim drafting, and office actions, to license negotiation, international filing, and intellectual property enforcement. Thanks to all for a valuable experience!

Heather A. Phillips

Technology Analyst
Medical & Life Sciences
(AHFMR ForeFront Intern)
University Technologies International
Calgary, Alberta

GET INTO THE GAME – IMPROVE YOUR CAREER

A five-day intensive, practical course divided into two modules. The first module provides an overview of patents and related IP rights, as well as enforcing or attacking a patent. These fundamentals are then connected to the business of owning IP including strategizing an IP portfolio. The second module completes the week, building on the fundamentals and offers insights into managing a patent portfolio in conjunction with your business needs.

KEY BENEFITS

Lectures and workshops deal with the protection of inventions and using the patent system, including the processes for obtaining and maintaining patents in Canada and abroad.

WHO SHOULD ATTEND

Understanding Patents is a must **for anyone involved in patents and patenting, patent agents in training, lawyers (in-house or external counsel), university technology transfer officers, licensing executives and contract managers** – anybody who encounters patents in their work and needs to have a better understanding of the nature and scope of the patent system, how patents are obtained, and how to manage a patent portfolio.

THIS YEAR'S COURSE WILL COVER:

MODULE 1:

- ▶ Patents as an intellectual property right
- ▶ The nature of the patent right
- ▶ The Canadian patent system, EU, China and US compared
- ▶ What can be patented (from life science to software and beyond)

- ▶ Understanding the patent document
- ▶ Drafting patent applications and claims
- ▶ Enforcing patents
- ▶ Trade secrets, designs, and Indigenous knowledge

This year will once again include engaging Fireside Chats with people from industry to provide practical advice regarding how their business works in connection with patents.

MODULE 2:

- ▶ Managing an international patent portfolio
- ▶ Extracting value from patents in business
- ▶ Corporate IP management
- ▶ Patent valuation
- ▶ Patent licensing
- ▶ Tax considerations
- ▶ Competition and settlement considerations

WORKSHOP LEADERS

- ▶ Patent Claim Drafting: **Emma Start** Taiga Motors Inc.
- ▶ Mock Settlement: **Andrew Shaughnessy** Torys LLP
- ▶ Prior Art and Freedom to Operate Analysis: **Noel Courage** Bereskin & Parr LLP
- ▶ International Filing Program: **Ilya Kalnish** BCF, LLP
- ▶ Simulated AI/data License Negotiation: **Maya Medeiros** Norton Rose Fulbright LLP

MONDAY, JULY 15, 2024

9:00 a.m. – 5:30 p.m. EDT

MODULE 1

OBTAINING AND ENFORCING A PATENT

Course Introduction and Student Introductions

8:45 a.m. to 9:30 a.m.

Course Director:

Maya Medeiros Norton Rose Fulbright Canada LLP

Assistant Course Director:

Amy Dam Vice President Legal Affairs, MoCA Cognition

Patents: An Introduction 9:30 a.m. to 10:15 a.m.

Amy Dam MoCA Cognition

- ▶ Commercial advantages of patenting
- ▶ What can be patented?
- ▶ Novelty, non-obviousness and subject-matter
- ▶ Inventors and owners

Structure of a Patent 10:30 a.m. to 11:15 a.m.

Justin Freedin Robic LLP

- ▶ What is prior art?
- ▶ Need for clarity, enablement
- ▶ Patent claims

From Invention to Patent:

Preliminary Steps and Timeline

11:15 a.m. to 12:15 p.m.

Sasha Mandy Carbon Engineering Ltd.

- ▶ Patentability searching
- ▶ Patenting timeline
- ▶ Negotiating with the Patent Office (official actions)
- ▶ Amending applications and patents
- ▶ Re-examination and reissue

Workshop – Patent Claims Drafting

1:45 p.m. to 3:00 p.m.

FIRESIDE CHAT 3:15 p.m. to 4:15 p.m.

Capturing Innovation and Patent Drafting: Practical tools for identifying inventions and preparing applications

Emma Start Taiga Motors Inc

in conversation with **Erin Pisko** IAC

Cocktail Reception 4:30 p.m. to 5:30 p.m.

TUESDAY, JULY 16, 2024

9:00 a.m. – 4:15 p.m. EDT

MODULE 1 (CONT'D)

Trade Secrets: An overview 9:00 a.m. to 9:30 a.m.

Noel Courage Bereskin & Parr LLP

- ▶ Identification and protection of trade secrets
- ▶ Enforcement

Designs: An Overview 9:30 a.m. to 10:15 a.m.

Christine Genge Smart & Biggar LLP

Jean Lee Norton Rose Fulbright Canada LLP

- ▶ Registrable design types
- ▶ Interface with patents and copyrights
- ▶ Originality
- ▶ Prosecution in Canada and internationally

Comparative Overview of US, EP and CN Practice

10:30 a.m. to 11:30 a.m.

Tuba Yamac BCF LLP

Stephen Yang IP March LLP

Carmela DeLuca Bereskin & Parr LLP

BREAKOUT SESSIONS

Software & Bio

11:30 a.m. to 12:15 p.m.

Chantal Saunders Borden Ladner Gervais LLP

Natalie Raffoul Brion Raffoul LLP

- ▶ What is patentable?
- ▶ Review of the legal landscape & recent court decisions
- ▶ Patent drafting strategies
- ▶ Strategic considerations

Workshop - IP Strategy & Freedom to Operate : How to assess risk of infringing other patents

1:45 p.m. to 3:00 p.m.

FIRESIDE CHAT 3:00 p.m. to 4:15 p.m.

Patent Searching & Freedom to Operate : Practical tips to navigate the patent landscape

Emma Start Taiga Motors

Daniel Smith Bombardier Recreational Products

WEDNESDAY, JULY 17, 2024

9:00 a.m. – 4:15 p.m. EDT

MODULE 1 (CONT'D)

Patent Enforcement 9:00 a.m. to 9:45 a.m.

Andrew Moeser Lenczner Slaght LLP

- ▶ Infringing acts
- ▶ Contributory infringement
- ▶ Exceptions to infringement
- ▶ Awards: damages and lost profits; reasonable royalty
- ▶ Injunction: permanent and temporary

Settlement and Competition Act Considerations

9:45 a.m. to 10:15 a.m.

Dominic Thérien McCarthy Tétrault LLP

- ▶ Settling a patent case
- ▶ What to consider about the Competition Act during settlement

Cease and Desist Letters and Other Infringement

Related Communications : What to consider when drafting and sending these letters

10:30 a.m. to 11:15 a.m.

Andrew Shaughnessy Torys LLP

Nicole Mantini Torys LLP

LUNCH & LEARN 11:30 a.m. to 1:30 p.m.

IP Strategy - overlapping patents with other forms of IP protection

Keynote Speaker: Karima Bawa Chair, IPON
(Intellectual Property Ontario)

Workshop - Mock Settlement

2:00 p.m. to 3:00 p.m.

- ▶ Non-infringement
- ▶ Obviousness
- ▶ Lack of novelty
- ▶ Dispute resolution

FIRESIDE CHAT 3:15 p.m. to 4:15 p.m.

Managing Settlement - Guidance on managing complex patent litigation

Brian Daley Norton Rose Fulbright Canada LLP

Nicole Mantini Torys LLP

Andrew Shaughnessy Torys LLP

THURSDAY, JULY 18, 2024

9:00 a.m. – 3:45 p.m. EDT

MODULE 2

Employment Contracts, Independent Contractors and NDAs 9:00 a.m. to 9:45 a.m.

Jean-Sébastien Brière KRB Lawyers

- ▶ Ensuring your company owns the IP it creates
- ▶ Confidentiality considerations

Indigenous Knowledge 9:45 a.m. to 10:15 a.m.

Matthew Foss Canadian Council for Aboriginal Business

Global Patent Management Panel 10:30 a.m. to 11:30 a.m.

Olivia Novac McGill University

Marie-Hélène Rochon Lallemand

Ilya Kalnish BCF, LLP

- ▶ Managing patents as a corporate asset
- ▶ Alignment of IP strategy with corporate and business strategy
- ▶ Managing an international patent portfolio

Workshop - International Patent Filing Program

11:30 a.m. to 12:30 p.m.

Funding & Valuation Panel + Workshop

1:45 p.m. to 3:45 p.m.

Lally Rementilla BDC

Louis Carbonneau Tangible IP

Martin Tremblay Smart & Biggar LLP

Max Yam BDC

- ▶ Patent valuation
- ▶ IP backed financing
- ▶ Extracting business value from IP assets

FRIDAY, JULY 19, 2024

9:00 a.m. – 3:45 p.m. EDT

MODULE 2 (CONT'D)

Anatomy of a License 9:00 a.m. to 9:45 a.m.

Michael Crichton Gowling WLG (Canada) LLP

- ▶ Overview of the anatomy of a typical license agreement
- ▶ Practical licensing considerations and challenges to license out patented technology to commercial entities
- ▶ Discussion of exemplary terms and conditions of a license agreement and negotiation items

AI/Data Licensing Best Practice 9:45 a.m. to 10:15 a.m.

Harshita Bhatnagar Microsoft

- ▶ Key provisions
- ▶ Managing inventions and works
- ▶ Assignments and licensing
- ▶ Due diligence

Alternative Patent Leveraging Panel 10:30 a.m. to 11:30 a.m.

Misha Benjamin Sama

Bhuvana Rai Mors & Tibute P.C.

Harshita Bhatnagar Microsoft

- ▶ Overview of monetization strategies
- ▶ Intellectual property and antitrust issues relating to standards and patent pools
- ▶ Other licensing trends

Tax considerations surrounding Patents 11:30 a.m. to 12:00 p.m.

Bhuvana Rai Mors & Tribute P.C.

- ▶ SREDS
- ▶ Patent Boxes

Workshop - AI/Data License Negotiation : IP licensing strategies 1:30 p.m. to 2:30 p.m.

Panel - Patent Licensing Realities 2:45 p.m. to 3:45 p.m.

Maya Medeiros Norton Rose Fulbright Canada LLP

Michael Crichton Gowling WLG (Canada) LLP

Tracey Stott Irving Shipbuilding

FEES

Understanding Patents An Introductory Course

July 15-19, 2024

IPIC member fee.....\$2295

Regular fee.....\$2495

Full-time student fee\$1247.50

Module 1

July 15-17, 2024

IPIC member fee.....\$1560

Regular fee.....\$1760

Full-time student fee\$880

Module 2

July 18-19, 2024

IPIC member fee.....\$1140

Regular fee\$1340

Full-time student fee\$670

Lunch & Learn - Fireside Chat

Included with the purchase of the full course or Module 1.

Workshop Leaders:

Emma Start Taiga Motors

Erin Pisko IAC

Carole Diop Norton Rose Fulbright LLP

Sasha Mandy Carbon Engineering, Ltd.

Noel Courage Bereskin & Parr LLP

Christine Genge Smart & Biggar LLP

Jean Lee Norton Rose Fulbright Canada LLP

Daniel Smith Bombarier Recreational Products

Nicole Mantini Torys LLP

Andrew Shaughnessy Torys LLP

Brian Daley Norton Rose Fulbright Canada LLP

Andrew Moeser Lenczner Slaght LLP

Ilya Kalnish BCF LLP

Maya Medeiros Norton Rose Fulbright LLP

Harshita Bhatnagar Microsoft

Misha Benjamin Sama

Tracey Stott Irving Shipbuilding



The program covered all the basics of the various intellectual property domains and the afternoon workshops enabled the attendees to select their topics of interest for which they could dwell deeper into the subject under the guidance of trained and experienced coaches. The course is well balanced to ensure that every student acquires the most knowledge and understanding of IP within a week. This course is a "must" to grasp the big picture of the IP world.

James M. Jessop, ing., M.Sc., CLP

Commercial Relations, Storage and
Conversion of Energy, IREQ

INTELLECTUAL PROPERTY INSTITUTE OF CANADA



IPIC is the only intellectual property association in Canada to which nearly all patent agents, trademark agents and lawyers specializing in intellectual property belong.

IPIC members receive a preferential rate on registration fees for the Summer Courses in Intellectual Property.

IPIC offers additional courses in patents, trademarks and copyright. Inquire at education@ipic.ca

Become an IPIC member today at www.ipic.ca



Professional & Corporate Education (PCE)

Please visit www.mcgill.ca/intellectualproperty for details on course accreditation by professional bodies and law societies.

Since 1994, the Intellectual Property Institute of Canada and McGill University have gathered some of the best practitioners in the field to conduct a series of intensive, practical summer courses in intellectual property. More than 2,500 professionals from the business, legal and public sectors have gained valuable insight and hands-on experience by participating in our unique summer program. Our courses are an excellent opportunity to network with individuals from diverse backgrounds who, like you, have an interest in Canadian intellectual property.



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Program is subject to change.