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Identifying and Protecting Your Intellectual Property

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Overview

1. What is an IP Audit?
2. Benefits of an IP Audit
3. Post-audit IP Management

What is an IP Audit?

1. An inventory of all intellectual property owned, used and created by an organization.
2. An assessment of the protection, maintenance and policies and processes relating to the intellectual property.

What is an IP Audit?

Inventory and assessment of:

1. Intellectual property applications and registrations and intellectual property used by the organization
2. Terms of existing license, distribution, inventors and employment agreements
3. Current policies and procedures

Types of Intellectual Property

1. Patents
2. Trade-marks
3. Copyright
4. Trade Secrets
5. Other – industrial design, integrated circuit topographies, domain names, etc.

Patents

1. Patents provide the exclusive right to make, construct and use an invention, and sell it to others to be used, or stop others from using it
2. Patent rights are granted in exchange for full disclosure of the invention

Patents

1. What is a patent right?
 - The exclusive right, privilege and liberty of making, construction and using the invention, and selling it to others to be used
2. What is patentable?
 - Product, Composition, Apparatus, Process
 - Improvement on any of the above
3. What are the criteria for a patent?
 - Invention must be new, useful and non-obvious

Trade-marks

1. A trade-mark is a word, design, or combination of the two
 - For example, hospital logo is a trade-mark, as well as its name, and tagline
2. Purpose of trade-mark
 - To distinguish your goods or services from the goods or services of others
3. Use – used in association with specific goods or services
 - Prior to registration, there must be use of the mark
 - For goods (products), the mark must appear on the goods at the time of sale
 - For services, the mark must appear on advertisements or promotional materials, and the service must be available to public at that time
4. Protection
 - Common law – within geographical boundaries of use of the mark
 - Registration – Canada wide

Official Marks

1. Available to “public authorities” (e.g. Hospitals)
2. Provides ability to prevent a 3rd party from adopting, registering or using a mark that resembles the official mark without consent, regardless of the associated wares or services
3. Not restricted for use with specific wares or services

Copyright

1. Protects the expression of an idea, not the idea itself
2. Applies to literary, dramatic, musical, artistic and other works
 - For example, business plans, software, marketing materials, artistic elements of logos
3. Provides the owner the sole right to produce or reproduce a work and to prevent others from copying it

Copyright

4. Ownership of copyright

- First owner is the creator/author
- First owner can be contractually designated
- Co-creators have joint ownership
- Employee exception – work produced in the course of employment, copyright vests in employer
 - Does not apply to independent contractors

5. Copyright can be assigned or licensed

- Assignment must be in writing

6. Moral Rights

- Right of integrity and association
- Cannot be assigned, only waived

Trade Secrets

1. What is a trade secret?

- Any confidential information used in a business to give a competitive advantage, and can be kept secret and create value
 - E.g. specific product information like the formula to *Coca-Cola*
 - E.g. business information like customer lists, business plans, pricing

2. Essential element – must remain secret

Other – Industrial Design, Integrated Circuit Topographies, Plant Breeders' Rights

1. Industrial Design

- Protection over the original visual or aesthetic features of a product
 - E.g. perfume bottle
- Must be registered, registration lasts 10 years in Canada

2. Integrated Circuit Topographies

- Protection over the design of a three-dimensional configuration of electronic circuits (e.g. microchips)
- Protection: up to 10 years from the filing of the application

3. Plant Breeders' Rights

- Protection for new plant varieties – gives the right to sell and produce propagating material
- Must be registered
- Protection: 18 years

Benefits of an IP Audit

1. Identifies owned IP.
2. Preserves and enhances value of existing IP.
3. Identifies opportunities to profit from IP.

Benefits of an IP Audit

4. Provides information to improve and / or develop IP protection, maintenance and commercialization strategies.
5. Enables assessment and spotting of IP issues on an ongoing basis to avoid litigation and maximize IP protection and commercialization.

Post-Audit IP Management

1. Protection of IP assets through registration.
2. Protection of IP assets through related agreements.
3. Improve or develop IP policies and procedures.

IP Registration

1. Patents

- Must file for patent with CIPO
- 20 years from time of filing, no renewal
- No public disclosure of patent prior to filing
- One year grace period to file after first public disclosure

IP Registration

2. Trade-marks

- Canada-wide protection – must file with CIPO, otherwise, common-law rights in area of use
- 15 years from grant, can be renewed
- Trade-mark registration provides owner of mark with the right to exclude others from using and registering a confusingly similar mark

IP Registration

3. Official Marks

- Available to public bodies as defined in the *Trade-marks Act*
- Must request public notice be given by CIPO for the use and adoption of the mark by the requesting entity
- No expiration

IP Registration

4. Copyright

- Automatic, no requirement to register, although may do so, international
- In Canada - lasts for life of author + 50 years
- In the case of corporations, lasts for 50 years from time of creation
- Moral Rights – last as long as copyright, unless waived

IP Registration

5. Trade Secrets

- Protected through confidentiality or non-disclosure agreements
- Protection can potentially last forever, as long as the secret is not disclosed (whether disclosure is intentional or unintentional)

IP Agreements

1. License agreements
2. Non-disclosure agreements
3. Employment agreements
4. Inventor / Co-development agreements
5. Assignments of IP rights

IP Policies and Procedures

1. IP ownership policy
2. IP use guidelines
3. Watch services
4. IP maintenance process
5. IP clearance and registration process
6. Recordal of assignments

Questions?

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Thank you!