



Karen Durell

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Biography

Karen Durell is National Co-Lead, Technology at Miller Thomson. She has practised intellectual property (IP) law for many years as an IP lawyer, Canadian patent agent, and U.S. and Canadian trademark agent. She assists organizations ranging from emerging businesses through to established corporations with respect to their IP rights and related transactions. Karen tailors legal strategies for public and private innovators, drawing on her background in technology and law.

Karen provides advice and counsel in a number of areas:

IP procurement: As a registered patent agent, Karen is involved in drafting and prosecuting original patents with particular focus in the areas of software, information technology, and mechanical innovation. As a registered trademark agent, Karen assists with drafting and prosecuting trademark applications, brand development and protection, and protection of trademarks. She also works in the areas of industrial design and copyright, and on the unique issues relating to IP procurement.

Technology transactions: Karen assists companies with a wide range of technology-related transactions and agreements, along with general corporate matters. She has been involved in corporate transactions ranging from public offerings to corporate maintenance, as well as IP transactions.

IP audits & due diligence: Karen undertakes IP portfolio work, including IP audits and IP due diligence, to support various types of corporate transactions and other client initiatives. She is involved in both reviewing existing IP portfolios and providing advice and strategies relating to an organization's future use and development of its IP portfolio.

Technology transfer deals & licenses: Karen helps organizations to negotiate deals and draft agreements to transfer, license, and develop IP rights and portfolios. She undertakes this type of work for a variety of organizations, and she is active in initiatives to maximize the impact of university-based and emerging-business research and innovation.

RELATED SERVICES

Artificial Intelligence
Corporate
Intellectual Property
Marketing, Advertising & Product Compliance
Patents and Industrial Designs
Startup, Emerging Companies and Venture Capital
Technology
Technology, IP and Privacy

RELATED FOCUS AREAS

Privacy and Data Protection

Karen speaks on various IP issues. She has delivered presentations and seminars on IP, ethics, and intellectual-asset management to a variety of audiences including academics, students, policy makers, government bodies, scientists, and public forums. Karen is widely published on IP, IP transactions, intellectual-asset management and patent law. She has also taught and tutored courses in IP and ethics at the Faculties of Law and Medicine at McGill University and the Faculté de droit, Université de Sherbrooke.

Karen was awarded a doctoral degree (D.C.L.) by the Faculty of Law, McGill University. Her thesis examined the intersection of contract legal principles and IP assets in IP transactions.

Prior to entering law school Karen had several years of experience as an information technology developer. In particular, she worked as a database designer and software developer in industries ranging from home décor to insurance.

Karen is engaged with her community through involvement with national IP societies, in board positions with an IP institute, in hospital research ethics reviews, and as a participant in pro bono legal clinics, as well as other local groups.

Professional achievements & leadership

- Registered Patent Agent, Canada, 2004
- Registered Trademark Agent, Canada, 2009
- Registered Trademark Agent, U.S., 2010

Thought leadership

- Sessional Lecturer, Patent Agency & Legal Practice Course, McGill University, Faculty of Law
- Tutorial Leader, Medical Ethics and Health Law Course, McGill University, Faculty of Medicine
- Presenter, "IP Issues in Canada and Canada's Anti-Spam Laws," hosted by Clear Law, June 2016
- Chapter author, "Vaccines and IP Rights: A Multifaceted Relationship," in Sunil Thomas, ed., *Vaccine Designs—Methods and Protocols* (New York: Springer, 2016)
- Presenter, "IP Issues in Canada and Canada's Anti-Spam Laws," hosted by Lawline, June 2015
- Co-presenter with Andrew Sprague
- Presenter, "Operating as a Canadian Business Under the New 'User-Focused' Copyright Act—MaRS Best Practices" MaRS Best Practices, May, 2013
- Co-presenter with Stacey Ivanchuk, "Improving Access to Medicines with a Pharmaceutical Patent Pool: Legal/Business & Antitrust Considerations," Drug Patents in Canada Conference, hosted by Insight at St. Andrews Club & Conference Centre, 7 May 2010
- Editor, "Intellectual Property and Business in Canada," *Business Laws of Canada* (Eagan: West (a Thomson Reuters business), 2009-2016).
- "Who can Tell the Value of IP?" *Recent Developments—Business Law in Canada*, Spring/Summer 2009
- Co-author with Richard Gold, "Looking Beyond the Firm: Intellectual Asset Management and Biotechnology," in David Castle, ed., *The Role of Intellectual Property Rights in Biotechnology Innovation*, (Northampton: Edward Elgar Publishing, 2009).
- "IAM & Stakeholder Rights: Can we Tame the 'Wild West'?" and co-

- author with Louise Bernier, "Are Gene Patents Really a Threat? Vulnerable Populations and Access to Genetics," in E. Richard Gold & Bartha Maria Knoppers, eds., *Biotechnology IP & Ethics*, (Markham: LexisNexis, 2009).
- Co-author with Richard Gold, "An All-Asset Approach to Canadian Technology Transfer," Commissioned Report to Industry Canada, March 2008
 - Presenter, "BRCA Testing in Canada: The Myth and the Business Model," Visions National Health Law Conference, hosted by the Health Law Institute, Banff Centre, Banff, Alberta, 9 November 2007
 - Co-author with Tania Bubela, "Intellectual Property and Biotechnology" in Gad, S.C. ed., *Handbook of Pharmaceutical Biotechnology* (Cary NC: John Wiley & Sons, 2007)
 - Presenter, "Open Source Intellectual Property Models: A Forecast," National Focal Point, Access and Benefit Sharing, Environment Canada at the National Meeting on ABS and Certificates, Gatineau, Quebec, 16 November 2006
 - "Intellectual property protection for plant derived vaccine technology: here they come are we ready or not?" 10(3) *Lex Electronica*, 2005
 - Co-author with E. Richard Gold, "Innovating the Skilled Reader: Tailoring Patents to New Technologies," 19(1) *Intellectual Property Journal* 189, 2005
 - Co-presenter with Richard Gold, "Patent Scope in Genes: A Comparative Analysis of Scope," Queen Mary Patenting Lives Conference, London, England, 2 December 2005
 - Co-presenter with Martin Phillipson, "Intellectual Property Rights in agriculture: overview and identification of opportunities for innovation," Canadian Biotechnology Secretariat, Environment Canada, Genetic Resources in Agriculture: Their role, their governance—implications for Access & Benefit Sharing Conference, Saskatoon, Saskatchewan, 9 November 2005
 - Co-author with Louise Bernier and E. Richard Gold, "WHO Literature Review on the Impact of Gene Patents on Access to Genetic Technologies and Services: View from Developing Countries," Background Paper for "Genetics, Genomics and the Patenting of DNA" (2005) LC/NLM QU 33.1, World Health Organization, Geneva, 2004
 - "Intellectual Property Protection for Computer Software: How Much and What Form is Effective?" 8 *International Journal of Law and Information Technology*, Oxford University, Press 231, 2000

Professional memberships

- Member, Intellectual Property Institute of Canada

Bar admissions & education

- Ontario, 2008
- Alberta, 2001
- D.C.L. (Ph.D.), McGill University
- LL.M., McGill University
- LL.B., University of Saskatchewan
- B.A. (Honours), Queen's University