



## Tai Nahm

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### SERVICES CONNEXES

Propriété intellectuelle  
Technologies de l'information

### SECTEURS INDUSTRIELS CONNEXES

Énergie et ressources naturelles

### SECTEURS PARTICULIERS CONNEXES

Intelligence artificielle  
MTech<sup>MC</sup>

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## Biographie

( Disponible en anglais seulement )

Tai Nahm is a professional engineer in addition to his law credentials. With 20 years of experience in the field, his practice focuses on the acquisition, exploitation, and management of intellectual property (IP) rights, including patent drafting and prosecution, patent opinions, procurement of trademark and industrial design (design patent) registrations, copyright, licensing, due diligence, IP portfolio management, IT agreements, SaaS agreements, website terms and conditions, and related matters.

Tai works with large corporate clients, leading academic institutions, SMEs and fast growing startups in diverse technology areas including information technology, artificial intelligence (AI), blockchain, robotics, software, Internet, telecommunications, wireless, scientific instruments, and general manufacturing, seeking protection for physical and logical systems, software, user interfaces, mechanical and electro-mechanical devices, and manufacturing methods and processes. Tai enjoys working with clients to identify and cost effectively protect and secure their IP rights in order to establish a competitive IP strategy.

Tai has a degree in systems design engineering, and previously worked for a major multinational computer company providing systems engineering support. He also has experience in computer operations and manufacturing. He is a Registered Patent and Trademark Agent in Canada, and is qualified to represent Canadian applicants before the United States Patent and Trademark Office and the international Patent Cooperation Treaty (PCT) Office. Tai also represents Canadian applicants around the world through a network of foreign IP associates.

Tai's practice involves:

- Patent drafting and prosecution covering diverse technology areas
- Trademark and industrial design / design patent procurement
- IP licensing and technology transfer
- IP infringement, validity, and registration opinions
- IP due diligence in corporate transactions
- IP portfolio review and management
- Competitive analysis and development of IP strategies
- IP & IT agreements, website terms and conditions, and privacy compliance

## Réalisations professionnelles et leadership

- Registered Trademark Agent, 2013
- Registered Patent Agent (United States), 2003
- Registered Patent Agent (Canada), 2002
- Professional Engineer, Ontario, 1992

## Faculty Experience

- Guest Lecturer, Osgoode Hall Law School, York University, Presentation on Criteria for Patentability, Prof. Ikechi Mgbeoji's Patent Law Classes 2007-present

## **Leadership éclairé**

- Member of Miller Thomson's National Artificial Intelligence Task Force
- Contributor to Lexis Nexis online reference guide for computer-implemented inventions, 2014-present
- "Bilski Decision Alters Test for Patentability of Software and Business Method Inventions in the U.S.," *Ontario Bar Association Information Technology and E-Commerce Section Newsletter*, Volume 10, No. 2, 2009
- "In Re Bernard L. Bilski and Rand A. Warsaw: Will Bilski Stop 'Business Method' Patents in the U.S.?" 2008

## **Engagement communautaire**

- University of Waterloo English Department Chair's Advisory Council, 2009-2017
- Pro Bono work advising startups at Communitech and Accelerator Centre

## **Postes d'administrateur**

- Past Director, Federation of Asian Canadian Lawyers

## **Associations professionnelles**

- Member, Communitech
- Member, Canadian Bar Association
- Member, Intellectual Property Institute of Canada
- Foreign Affiliate Member, American Intellectual Property Law Association
- Past Executive Member, Korean Canadian Lawyers Association
- Member, Professional Engineers Ontario
- Member, Ontario Society of Professional Engineers

## **Formation et admission au barreau**

- Ontario, 1998
- LL.B., Osgoode Hall Law School, York University, 1996
- B.A.Sc. (systems design engineering), University of Waterloo, 1990