

# INTELLECTUAL PROPERTY

UNDERSTANDING PATENTS COURSE

**JULY 17-21, 2023**



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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 2023

## **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 17, 2023 to Friday, July 21, 2023

Module 1 (3 days) Obtaining and Enforcing a Patent – The Basics and Why They Matter to Your Business (July 17-19)

Module 2 (2 days) Exploiting IP Rights – Strategies re Patent Portfolio Management (July 20-21)



*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 Patent Trial: **Maya Medeiros** Norton Rose Fulbright Canada LLP
- ▶ Prior Art and Freedom to Operate Analysis: **Noel Courage** Bereskin & Parr LLP
- ▶ International Filing Program: **Ilya Kalnish** BCF
- ▶ Simulated Patent License Negotiation: **Maya Medeiros** Norton Rose Fulbright

## MONDAY, JULY 17, 2023

8:30 a.m. – 5:30 p.m. EDT

### MODULE 1

## OBTAINING AND ENFORCING A PATENT

### Course Introduction and Student

**Introductions** 8:30 a.m. to 9:00 a.m.

Course Director:

**Emma Start** Taiga Motors Inc.

Assistant Course Director:

**Maya Medeiros** Norton Rose Fulbright Canada LLP

**Patents: An Overview** 9:00 a.m. to 9:45 a.m. **Amy**

**Dam** Sheertex

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

### Structure of a Patent Specification

10:00 a.m. to 10:45 a.m.

**Justin Freedin** Robic LLP

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

### From Invention to Patent: Preliminary Steps and Timeline

10:45 a.m. to 11:45 a.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

**Designs: An Overview** 12:00 a.m. to 12:30 p.m.

**Christine Genge** Smart & Biggar LLP

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

### Workshop – Invention Mining and Patent

**Claims Drafting** 2:00 p.m. to 3:15 p.m.

**FIRESIDE CHAT** 3:30 p.m. to 4:30 p.m.

### How a Company Captures Innovation and Oversees Patent Preparation

**Emma Start** Taiga Motors Inc

in conversation with

**Erin Pisko** IAC

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

## TUESDAY, JULY 18, 2023

8:30 a.m. – 4:30 p.m. EDT

### MODULE 1 (CONT'D)

### Patent Enforcement: Infringement

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

**Andrew Moeser** Lenczner Slaght

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

**Cease and Desist Letters** 9:45 a.m. to 10:15 a.m.

**Andrew Shaughnessy** Torys LLP

- ▶ What to consider when drafting and sending these letters

**Patent Enforcement: Validity** 10:15 a.m. to 11:00 a.m.

**Andrew Shaughnessy** Torys LLP

- ▶ Obviousness
- ▶ Lack of novelty
- ▶ Other validity challenges

REGISTRATION DEADLINE IS JULY 13, 2023

## BREAKOUT SESSIONS

### Track I: Biotechnology and Pharmaceutical Patents

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

Chantal Saunders Borden Ladner Gervais LLP

- ▶ What is patentable?
- ▶ Claiming biotechnology and pharmaceutical inventions
- ▶ Disclosure requirements
- ▶ Sequence listings, biological deposits
- ▶ Review of the regulatory landscape (Patented Medicines (Notice of Compliance) Regulations, Data Protection, Certificate of Supplementary Protection, Patented Medicines Prices Review Board)

### Track II: Business Method and Software Patents

Natalie Raffoul Brion Raffoul LLP

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

### Mock Trial : Expert Reports and Cross-examination of a witness 1:45 p.m. to 3:15 p.m.

Maya Medeiros Norton Rose Fulbright

Andrew Shaughnessy Torys LLP

Andrew Moeser Lenczner Slaght

**FIRESIDE CHAT** 3:30 p.m. to 4:30 p.m.

### How a Company Manages Litigation and Settlement

Maya Medeiros Norton Rose Fulbright Canada LLP

Brian Daley Norton Rose Fulbright Canada LLP

## WEDNESDAY, JULY 19, 2023

8:30 a.m. – 4:30 p.m. EDT

### MODULE 1 (CONT'D)

#### Trade Secrets: An Overview 8:30 a.m. to 9:00 a.m.

Noel Courage Bereskin & Parr LLP

- ▶ Identification and protection of trade secrets
- ▶ Enforcement

#### IP Ecosystem in Canada

9:00 a.m. to 9:30 a.m.

Mike McLean CEO of the Innovation Asset Collective (IAC)

- ▶ Filing provisional and regular applications
- ▶ Continuation and Continuation-in-part applications
- ▶ Prosecution strategies

#### Comparative Panel on US, European and Chinese Practice

9:45 a.m. to 11:00 a.m.

Tuba Yamac BCF LLP

Carmela De Luca Bereskin & Parr LLP

Stephen Yang IP March

#### Indigenous Knowledge 11:15 a.m. to 12:15 p.m.

Scott Robertson Nahwegahbow Corbiere

**LUNCH & LEARN** 12:15 p.m. to 2:00 p.m.

Keynote Speaker: Kieran Moore Lululemon

#### Workshop - Prior Art and Freedom to Operate Strategies

2:00 p.m. to 3:15 p.m.

**FIRESIDE CHAT** 3:30 p.m. to 4:30 p.m.

#### Patent Searching and Freedom to Operate

Emma Start Taiga Motors Inc.

in conversation with

Daniel Smith Bombardier Recreational Products

## THURSDAY, JULY 20, 2023

8:30 a.m. – 4:30 p.m. EDT

### MODULE 2

#### Patents Worldwide: Value and Cost Management

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

Ilya Kalnish BCF

- ▶ Filing PCT applications
- ▶ Foreign filing strategy and practice
- ▶ Global portfolio management strategies
- ▶ Techniques to maximize value while balancing costs

#### Employment Contracts, Independent Contractors and NDAs

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

Jean-Sébastien Brière BCF

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

#### Workshop - International Patent Filing Program

11:00 a.m. to 12:15 p.m.

#### Settlement and Competition Act Considerations

1:45 p.m. to 2:15 p.m.

Dominic Thérien McCarthy Tétrault LLP

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

#### Panel - Patents Worldwide: Corporate IP Management

2:15 p.m. to 3:15 p.m.

Emma Start Taiga Motors Inc., Olivia Novac McGill,

Marie-Hélène Rochon Lallemand

- ▶ Managing patents as a corporate asset
- ▶ Alignment of IP strategy with corporate and business strategy

#### Panel - Considerations Relating to Funding and Valuation

3:30 p.m. to 4:30 p.m.

Lally Rementilla BDC, Max Yam BDC

Louis Carbonneau Tangible IP

Sandro Zlobec Smart & Biggar LLP

## FRIDAY, JULY 21, 2023

8:30 a.m. – 4:30 p.m. EDT

### MODULE 2 (CONT'D)

#### Anatomy of a License 8:30 a.m. to 9:15 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

#### Exploiting IP Rights 9:15 a.m. to 10:00 a.m.

Justine Gauthier MILA

- ▶ Transferring ownership of inventions: assignments and licensing
- ▶ Due diligence
- ▶ Additional considerations: anti-trust, export controls, working the invention, marking and compulsory licensing

#### Tax considerations surrounding Patents 10:15 a.m. to 11:00 a.m.

Bhuvana Rai Mors & Tribute P.C.

- ▶ SREDS ▶ Patent Boxes

#### Alternative monetizing strategies/licensing trends

11:00 a.m. to 11:30 a.m.

Misha Benjamin Sama

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

#### Workshop - Patent License Negotiation/Purchase and Sale 11:45 a.m. to 12:45 p.m.

#### Panel - Patent Licensing Realities 2:15 p.m. to 3:15 p.m.

Maya Medeiros Norton Rose Fulbright Canada LLP, Michael Crichton Gowling WLG (Canada) LLP, Tracey Stott Sandoz Canada

#### Panel - Alternative Patent Leveraging 3:30 p.m. to 4:30 p.m.

Bhuvana Rai Mors & Tribute

Misha Benjamin Sama

Martin Tremblay Smart & Biggar LLP

Justine Gauthier MILA

## FEES

### Understanding Patents An Introductory Course

July 17 - 21, 2023

IPIC member fee.....\$2295

Regular fee.....\$2495

Full-time student fee .....\$1247.50

### Module 1

July 17 - 19, 2023

IPIC member fee.....\$1560

Regular fee.....\$1760

Full-time student fee .....\$880

### Module 2

July 20 - 21, 2023

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. Can be purchased as a stand alone for the public.

IPIC member / McGill Alumni.....\$75

Regular fee .....\$95

Full-time student fee .....\$50



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

REGISTRATION DEADLINE IS JULY 13, 2023

# 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](mailto:education@ipic.ca)

***Become an IPIC member today at [www.ipic.ca](http://www.ipic.ca)***



## **Professional & Corporate Education (PCE)**

Please visit [www.mcgill.ca/intellectualproperty](http://www.mcgill.ca/intellectualproperty) for details on course accreditation by professional bodies and law societies.

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Program is subject to change.