

IP Portfolio Strategies

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My Background

- Academic and Professional Qualifications:
 - B.Sc. Biochemistry and B.A.Sc. Chemical Engineering
 - P.Eng – Ontario
 - Registered to practice before Canadian Intellectual Property Office and U.S. Patent & Trademark Office
- Practice comprises preparation and prosecution of patent and industrial design application and advising on IP portfolio management
- Professional career spans over 30 years including partnerships in boutique and full-service firms
- Clients include SMEs, universities, government agencies, and multinational organizations
- Rankings: IAM Patent 1000, Who's Who Legal: Patents; Who's Who Legal: Canada; Managing Intellectual Property IP Stars; LMG Life Sciences: Life Sciences Star

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Topics

IP 101

Importance of IP Protection

Hurdles in securing IP

Strategies

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IP 101

- Components of an IP portfolio include:
 - Patents
 - Product, apparatus, process, formulation, etc.
 - 20-year term
 - Industrial designs
 - Unique appearance
 - 3D or 2D (e.g., icons, GUIs)
 - Terms vary from 10-25 years
 - Trademarks
 - Copyrights
 - Trade secrets

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Importance of IP Protection

Put simply, intellectual property is now the chief engine of wealth creation and economic growth in the world. (Gary Michelson; *The Intangible Advantage*)

- IP is an extremely valuable business tool!
- Used for:
 - Maintaining monopoly (competitive advantage)
 - Attracting financing/investors/partners
 - Cross-licensing (potential foil to infringement claim)
- Firms that patent are more likely to increase profits and experience growth (IP Canada 2020; ISED Canada)
- Characteristics of SMEs with IP rights: 2x more innovative; 3x more likely to expand domestically; and over 4x more likely to expand internationally (IP Canada 2019; ISED Canada)

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Hurdles in securing IP

- Most forms of IP are limited by jurisdiction
 - Need to decide very early which countries are of interest (need that crystal ball!)
- Filing in multiple regions can be expensive
 - Must balance with budget constraints
- For patents, often need to protect multiple inventions
 - Patenting costs can be significant (but necessary!)
- Decisions on IP protection must be made early on – difficult for startups
- All of these factors mean: “It’s all about the money”!

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IP Strategies

1. IP awareness is critical for SMEs

- Firms aware of IP and take steps to secure protection are more likely to succeed
- Establish clear IP policies
- Consider creating IP committee to steer IP generation, capture, protection, and management

2. Maintain confidentiality

- Keep inventions secret until ready to file
- Restrict access to R&D facilities and use NDAs
- Include IP ownership clauses in employment agreements

3. Vigilance is important

- Conduct regular patent searches: consider both defence and offence positions.
- Appoint dedicated person so searching skills are honed (searching is an art!) and consider available searching platforms/services

IP Strategies

4. Focus protection on core technologies

- Tailor to business plan; may not be able to protect everything!
- Patent vs. trade secret vs. publish

5. Establish tiers of countries for protection

- “Must have” vs. “nice to have”
- Will be based on business plan
- Will be based on invention (consider subject matter restrictions)
- Filing strategy may vary by country (e.g., Canada has no Continuation practice and Divisional filing has double-patenting risk)

6. Take advantage of available filing options (e.g. PCT) to defer decision/cost

7. Continually revisit IP strategy

- IP portfolio may need to vary with change in R&D direction
- Drop some / add some
- Role could be assigned to IP committee

Thank you!

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