



# Intellectual Property: Protecting What's Yours

February 16th, 2011

**gowlings**

Lawyers • Patent and Trade-mark Agents

# IP RECOGNITIONS

Canadian Patent Prosecution Firm of the Year - 2008, 2009, 2010...

- *Managing Intellectual Property Magazine (UK)*

“Top IP Firm in Ontario” and “Most frequently recommended”

- *Lexpert*

#1 ranking as an IP Firm in Canada

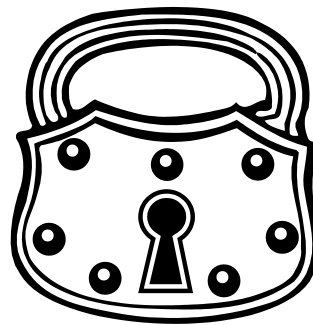
- *Chambers Global Guide*

# OVERVIEW

- **What does IP provide?**
- **Types of IP**
- **What is your Patent Strategy?**

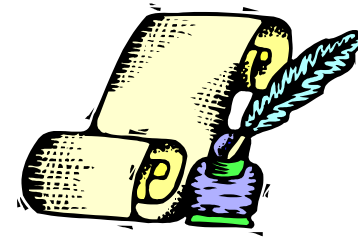
# What does IP provide?

- IP gives the holder the ability to restrict others from practicing what is yours, based on content, territory and time
- Never forget, the holder is transferable!



## Types of IP – Copyright

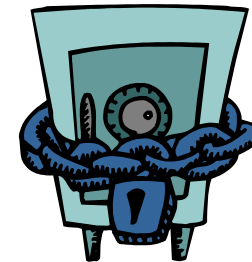
- **Protects original form of expression, *not* underlying idea, for life of author plus 50 years**
  - computer code (kernels)
  - music
  - user manuals



**CCH Canadian Ltd. v. Law Society of Upper Canada, 2004, Gowlings appeared as counsel for the Law Society at the Supreme Court of Canada. This leading copyright case was the first time the Supreme Court dealt with fundamental copyright issues as the standard of originality and fair dealing.**

## Types of IP – Trade Secret

- **Protection for clearly defined information (“know how”) with controlled access, as long the secret is maintained**
  - Google™ algorithms
  - Coke™ formula
  - Caramilk™ secret
- **Only effective if....**
  - no one reveals the trade secret, and
  - reverse engineering not possible
- ***So you tell me someone stole your trade secret....***



## Types of IP – TradeMark

- **Potentially indefinite monopoly for use of mark in association with specified wares or services**
  - sound
  - picture
  - word/phrase
- *So someone attended the same tradeshow as you....*



vs.



gowlings

## Types of IP – Design Patent

- 10 year monopoly for ornamentation, pattern and shape that appeal to the eye
- shape or shape and ornamentation of a finished article
  - computer icons
  - consumer product
  - computer hardware (Tonto)
- not applicable to article function
- *So you have a problem with knockoff batteries....*





## Types of IP – Utility Patent

- **20-year monopoly to restrict others from making, using, selling claimed invention - *nonrenewable***
  - network architecture
  - data manipulation process
  - functionality of product
  - user interface operation
- **Patentee must *fully* disclose the invention including components and their interoperation**
- ***Why should I buy your solution, I'll just make my own....***

## Types of IP – Utility Patent

- 4 related patent families in CA,AU,UK,DE,US
- Valuation = **\$40-50M**

# What is your Patent Strategy?

- **Does one size fit all?**

# What is your Patent Strategy? - Considerations

- **Must take into account three factors**
  - Budget (pre-filing, at filing, post filing)
  - Time (pendancy of applications)
  - Trade-off between Information ↔ Scope
- **Requires that your patent lawyer understand your technology**

# What is your Patent Strategy? – Where?

- **EPO**

- PACE – 1<sup>st</sup> search report in 3-6 mths
- centralised exam for EP member states

- **United States**

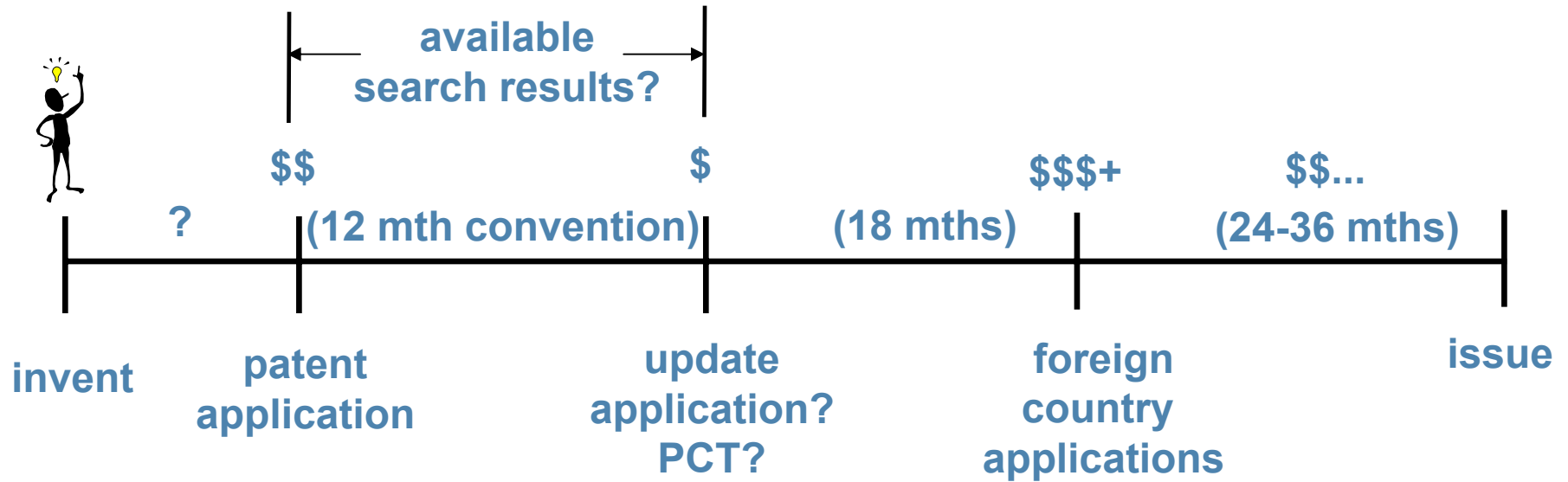
- 1<sup>st</sup> examination report in approximately 15/24 mths
- ability to keep secret until issue
- CIP potential for improvements

- **Canada**

- delay exam for 5 yrs
- Can accelerate examination but must be published first

# What is your Patent Strategy? – Order of filings?

- Budget, timing, Information/Scope





# OPEN DISCUSSION



T: (416) 862-4318  
F: (416) 862-7661

[grant.tisdall@gowlings.com](mailto:grant.tisdall@gowlings.com)

#### **Education**

University of Toronto Institute for  
Aerospace Studies, MAsc. in  
Aerospace Engineering, 1992

University of Waterloo, BAsC.  
in Mechanical Engineering, 1991

## ***Grant W. C. Tisdall, Partner – Waterloo Region and Toronto***

- I am a registered Canadian and United States Patent Agent experienced in building and managing strategic IP portfolios of first/next generation technologies, including hands-on patent prosecution in multiple jurisdictions and infringement analyses
- I practice primarily in the fields of handheld computer products and related systems, enterprise solutions, and GUI configuration for GTA and K-W region based companies
- I draft and prosecute patent applications for network systems leveraging GPS technology, antenna design for rugged handhelds, data visualization/processing for large scale data sets, enterprise systems for transaction management, and intelligent lighting controllers
- My technical background includes Bachelor studies in Mechanical Engineering from the University of Waterloo, and Masters and PhD studies in Aerospace Engineering from the University of Toronto Institute for Aerospace Studies

**gowlings**