

# IP Strategy Workshop for Project Applicants

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# Canada is an Advanced Manufacturing Nation

- NGen is the industry-led, not-for-profit organization that connects Canada's strengths.
  - Manufacturers
  - Technology providers
  - Government organizations
  - Research organizations
  - Academia



**Our Mission is to build world leading advanced manufacturing capabilities in Canada.**

NGen measures success by the benefits it delivers to Canadians.

## NGen aims to:

Develop world-leading technological capabilities in advanced manufacturing

Increase industry investment in innovation

Enhance value creation and economic growth

Connect and actively engage members of Canada's advanced manufacturing ecosystem

Contribute to the development of a skilled advanced manufacturing workforce; and

Improve the social well-being of Canadians

**NGen's goal is to add at least \$13.5 billion and 13,500 new jobs to Canada's economy by 2030**

## Expected Outcomes:

New domestic and international sales

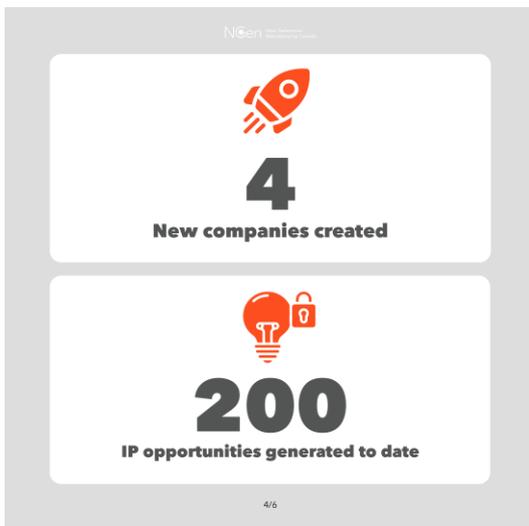
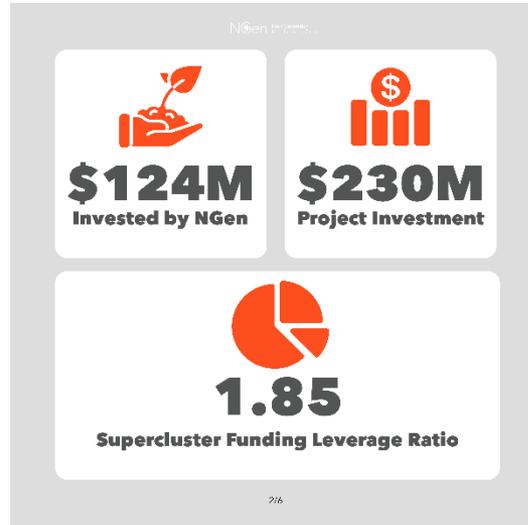
Jobs created

Companies created

New products, processes, and services

Intellectual property created

# 2019-2020 Year in Review



# NGen and Intellectual Property

- Keep IP in Canada - Make Canada a Global Leader in Innovation
- Strengthen Collaboration
  - Shared Competitive Advantage
- Growth of Canadian companies
  - Accelerate Innovation
- Education/Awareness
  
- Polling questions 1 and 2

# NGen and Intellectual Property

- All projects must have an IP Strategy
- Sets how you and your partners intend to manage, protect, and exploit the Intellectual Property from the project.
- IP Manager
  - Support applicants to develop good IP Strategies
  - Provide Education/Guidance
  - IP Registry
- The IP Strategy is a critical component of the project and requires negotiations. Clear alignment up front will make for a strong Collaborative project.
- All approved projects will need a Collaboration Agreement

# Protecting IP and Preserving Patentability

Prior to discussions which may involve the sharing of IP make sure that you are protected.

## Background IP

- file a patent application if you haven't already
- put a non-disclosure agreement in place
- trade secrets should not be shared unless necessary

## Foreground IP

- inventorship determines ownership, unless defined differently in a contract. (Collaboration Agreement)

# Patent/Prior Art Search

How do you know what parts of the project will likely produce new foreground IP or if the project really advances the state-of-the-art?

- conduct a prior art search
  - patents
  - literature
  - competitor/similar products
- benefits
  - avoid reinventing the wheel
  - identify freedom to operate issues early
  - find other partners
- Free patent searching tools
  - Espacenet- <https://worldwide.espacenet.com/>
  - Patent Lens - <https://www.lens.org/>

# What is Intellectual Property

- Know how
- Trade Secrets
- Ideas
- Drawings
- Data
- Copyright
- Trademarks
- Industrial Designs
- Patents

# What needs to be in your IP Strategy

- high level description of how each company handles IP
- has a freedom to operate analysis be completed
- a list of the Background IP each company is bringing to the project, and who in the consortium will need access to complete their part of the project
- a list of the Foreground IP you expect from the project, who will own it, and how you intend to protect it.
- how you will share or license the Foreground IP
- how each company will exploit/commercialize the IP

# Step One- Ensure Project Alignment and Focus

- Market Opportunity
  - Customers
  - Competitors
  - Geographic scope
- Outline the solution/ approach
  - overall
  - by each portion/component
  - discuss and identify where you think the innovations, technical or performance advances are going to occur
- outline each consortium members role in the project
- what benefits do each of the members expect from the project
  - strategic business intentions
  - technical advances and how they intend to use going forward

## Step Two-Identify IP, Ownership, and Licensing

- make a list of the Background IP relevant to the project
- Background IP ONLY needs to be shared with other project members IF it is required by another team member:
  - to carry out their role in the project, and / or
  - to exploit their foreground IP after the project

Background IP	Part of the solution it relates to	Owner	How is it protected, type of IP (know-how, trade secret, patent pending or granted, copyright, industrial design, trademarks, etc.)	Who needs access during the project, what kind of access, licenses	Who needs post project access, for commercialization or research purposes, licenses

## Step Two-Identify IP, Ownership, and Licensing

- Using the solution/approach outline from step one you now can make a list expected foreground IP
- New IP falls out naturally in the parts which are challenging or unknown
- This table is your best guess

Expected Foreground IP	Part of the solution it relates to	Owner	How is it protected, type of IP (know-how, trade secret, patent pending or granted, copyright, industrial design, trademarks, etc.)	Is it an improvement of background IP, which one, is a license required to practice?	Who needs access during the project, what kind of access, licenses	Who needs post project access, for commercialization or research purposes, licenses

## Step Three – Commercialization and Ecosystem Leverage

- define your ideal partners;
  - market development - new customers, applications, markets, geographies
  - potential suppliers and other technology partners
  - researcher development – continue to develop the technology further with other research partners
- using your ideal partner definitions and the market work from step one define types of organizations and markets which you intend to pursue and ones you do not.
- review NGen members to create a list of potential companies that foreground IP owners may be interested in negotiating licenses with and a list of excluded companies with justification. (IP Manager can help with this)

Expected Foreground IP (from above table)	Competitive key markets	Competitive jurisdictions in key markets	Non-competitive jurisdictions in key markets	Non-competitive markets	Other types of NGen members which would be considered for a license negotiation	Other types of NGen members which would not be considered for a license negotiation

## Draft the Strategy

- combine all the information and summarize the discussions from all three steps together into a document
- at the application stage the IP strategy does not require that all license terms and details have been decided, but should include a high-level understanding and a list of items requiring resolution that will be addressed in the final IP strategy should the application be approved
- the IP strategy will form a basis for the collaboration agreement between consortium members

# NGen IP Strategy Myth – Share all IP with Project Consortium

- In order to have a truly collaborative project everyone needs to participate and achieve something at the end. It is expected that each party will have access to what they need to commercialize their new product, process, or development after the end of the project, and to continue to improve their technology beyond.
- License/access beyond the project is not expected to be royalty free.
- Collaboration agreement must have licensing terms both during and after the project.
  - *Recognition of the right of each participant access to, on fair, reasonable and non-discriminatory terms and subject to relevant competitive issues, all Foreground IP arising from the project, at least for internal R&D purposes; and,*
  - *If Background IP is required for exploitation of the results of the projects Foreground IP access, Background IP for participants must be negotiated in a fair, reasonable, and non discriminatory terms.*

# NGen IP Strategy Myth – You have to share all your IP with the supercluster ecosystem

- Help project participants realize potential opportunities and advantages that can be created by sharing their IP, but only when it makes sense.
- Companies will not be forced to disclose sensitive information or to license to their competitors, instead the goal is to help companies find other non-competitive applications and companies to license to.
- By licensing IP you can potentially strengthen your IP by:
  - adoption of your technology across more applications and markets
  - additional revenue that can be re-invested back into your organization
  - creating partners rather than advisories which may wish to weaken or design around your patents
  - developing relationships with companies which can lead to further joint development activities

# Tips

- a [Project IP Strategy Guide for Applicants](#) and a template for the [tables](#) are both available on our website in the project info and guide section
- Before getting started please read the [NGen Intellectual Property Strategy](#) (also available in the project info and guide section)
- work with your partners to develop the Project IP Strategy
- earlier the better

3<sup>rd</sup> polling question

# Help/Support

- NGen provides funding for patent costs for SME's to protect the foreground IP generated by the project. See relevant **financial guide** for your project stream for details.
- Workshops- individual
- Access the IP Expert Series- you can find a recording of our first session in the events section on our website under archived.  
<https://www.ngen.ca/events>
  - [project@ngen.ca](mailto:project@ngen.ca)
  - [rhonda.okeefe@ngen.ca](mailto:rhonda.okeefe@ngen.ca)

Canadian Intellectual Property Office- Education, tools, and resources  
[http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h\\_wr04234.html](http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr04234.html)

3rd polling question

# Upcoming Events

- “What's Next Webinar Series - Cyber Security 101 for Manufacturers”  
November 26th at 11:00 am. Wendy Young is presenting

# Thank You!

**NGen** Next Generation  
Manufacturing Canada

Canada's Advanced Manufacturing Supercluster

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