Talking Technology
Protect your intellectual property

By Steve Burns, Capital News contributor

Protecting the intellectual property of your technology company may be one of the most important investments you make.

All too many technology companies seek to obtain financing from third parties only to realize that they have not done their homework to protect the intellectual property of their company.

Although I am by no means an intellectual property expert, it has been my experience that behind every great technology product, there is a very smart intellectual property lawyer.

If you have an idea, even if it is at a conceptual stage, you need to seek the advice of such an intellectual property expert.

One such expert is Tony Edwards, who is a partner in Petraroia Langford Edwards & Rush (www.plerlaw.com). Edwards leads their intellectual property practice and has been invaluable in guiding many technology companies and innovators alike through this important area.

In any patent search work, it is important to work with your advisor to discover what may be protectable versus what is likely not.

Often an initial patent search will do conducted through an organization such as Patscan at the University of British Columbia (www.patscan.com).

This initial search should be properly focused to provide an initial patentability guide.

Once a patent search has been completed, a patent application directed to the specific innovation may be prepared and a potential monopoly sought as widely as possible.

The patent application itself may be filed in the United States and Canada and should be done in both countries within one year of its first public disclosure.

Separate, specific patent applications may be required as well.

Once the patent applications have been filed, the United States Patent Office will usually respond with an "office action" within approximately one year of the filing date.

The Canadian patent application will typically remain pending through this period of time so that the United States Patent Office may be dealt with first.

The United States Patent Office will normally reject the patent application first time round for various reasons most usually based on the opinion that the invention claimed in the pending application is obvious in view of the prior art.

A response then will be prepared and filed to distinguish over the cited prior art.

Once the United States Patent is issued then normally the pending Canadian patent application may be amended.

This will typically result in the Canadian Patent Application being allowed without further argument.

Within one year of filing a first patent application, whether it be for example in the United States or Canada, an International Patent Application may be filed.

This provides patent pending coverage in up to 115 countries.

This would allow for filing of foreign patent applications in any one of the 115 countries designated.

In terms of other intellectual property which may apply to your technology or invention, you need to discuss with your advisor the copyright that may apply.

Depending on the situation it may be desirable to register copyright in the United States and Canada.

Be careful with contract software programmers—independent software programmers will remain as owners of copyright in the code unless a contract specifically states in writing that copyright is to be owned by someone else.

Finally, trademark protection may eventually become important as you commercialize your product.

For example, the name of the product may be a potentially registerable trademark, although a trademark search should be undertaken prior to committing to using any trademark in the marketplace.

In summary, if you seek the ongoing advice and guidance of an intellectual property professional, you will be well on your way to protecting your intellectual property investment.

Steve Burns, CA, CMC, CFP, is the president and CEO of the Burns Innovation Group Inc.

If you would like your company profiled in the column, contact Steve at 763-4716 or e-mail:

steve@burnsinnovation.com