

Generating Revenue and Reducing Risk: Our IP Survey Results Are In

Technology and Intellectual Property Group Seminar
Wednesday, September 15, 2010



John P. Beardwood
Partner
416 868 3490
jbeardwood@fasken.com



Mark D. Penner
Partner | Patent Agent | Trade-mark Agent
416 868 3501
mpenner@fasken.com

Going Global: How Canadian Companies View Intellectual Property

John Beardwood
Mark D. Penner

September 15th, 2010



Overview: The Fasken Martineau IP Survey

- **GOAL**
 - Capturing the benefits of innovation through IP
- **BARRIERS TO THAT GOAL**
 - Numerous and competing priorities on companies' time, money, and attention
- **HELPING OVERCOME THOSE BARRIERS**
 - We surveyed a number of Canadian companies to get their views on importance, value and role of IP
 - Based on our survey, help develop strategies for:
 - more effective secure IP protection
 - more effectively manage IP
 - reduce the risk posed by third party IP



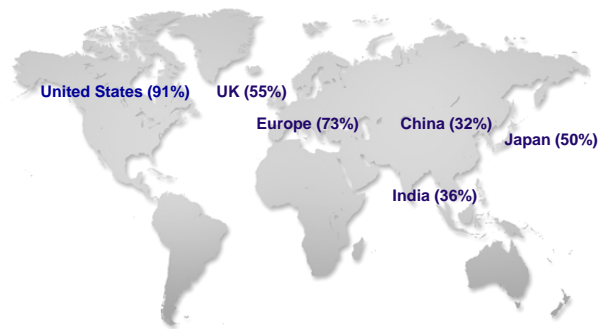
Key Results of Fasken Martineau Survey

- **NEED TO BETTER UNDERSTAND IP ASSETS**
 - Almost three quarters of the respondents had failed to appreciate nature and value of their IP assets
- **NEED TO BETTER MANAGE IP**
 - Over two-thirds of the respondents feel that their company's "IP strategy requires improvement."
- **NEED TO BETTER MANAGE IP RISKS**
 - Survey indicated companies could be better at IP risk management/mitigation



IP Protection is Global

- Two thirds of the respondents report that they sell products or make their services available outside Canada
- 69% sought IP protection outside of Canada – breakdown:



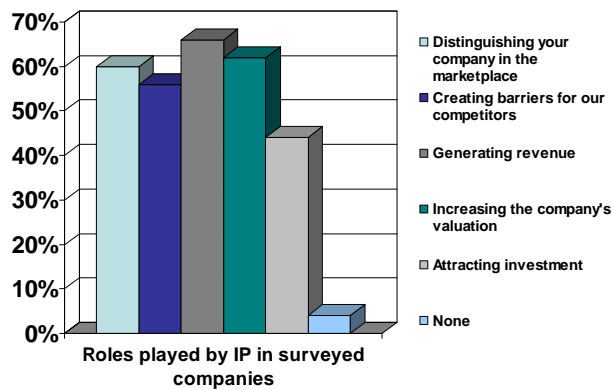
What IP do Canadian Companies Own?

- 60% indicated that they owned patents; BUT
- A significant majority, but not 100%, of the companies surveyed (70%) indicated that they owned trade-marks
- Only just over half of respondents (56%) indicated that they owned copyright
- Only fifty percent (50%) indicated that they owned trade secrets

Need To Better Understand IP Assets

- Trade-marks
 - Every company will have at least one trade-mark
 - 30% underestimated trade-mark ownership
- Copyright
 - Every company will have copyrighted works
 - Almost half underestimated copyright ownership
- Trade Secrets
 - Most companies will have some confidential information
 - Half underestimated trade secret ownership

Roles of Intellectual Property within Canadian Companies



IP Management

- Over 70% indicated that they have a formal policy governing IP issues
- But almost one third have **not** implemented any formal IP policies
- **Over two-thirds (69%) of the respondents agreed that their company's "IP strategy requires improvement."**

Absence Of IP Management Is Problematic

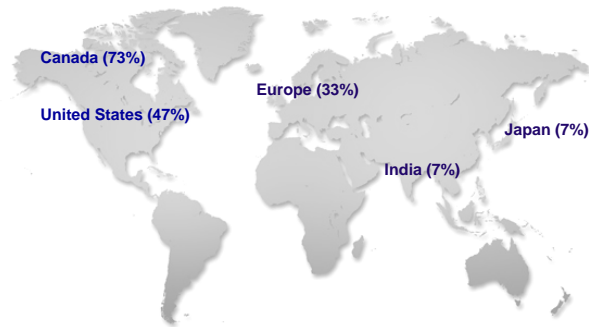
- Issues with IP ownership and/or infringement
 - 55% indicated they license IP yet almost a third were “**somewhat uncomfortable**” with providing the licensee with representations and warranties regarding IP ownership and infringement
 - **Only 17% confirmed ownership** of IP directed to business, product or service before going to market
- Issues with investors
 - 62% of the respondents indicated that one of the key roles of IP within the business was to “**increase the company’s valuation**”
 - Investors will evaluate IP management

Risk of IP Disputes

- 43% indicated that they had been involved in an IP- related dispute
- Over half (54%) of those respondents indicated that the litigation significantly or somewhat altered or impacted their business plan
- 47% indicated that the litigation had no impact!

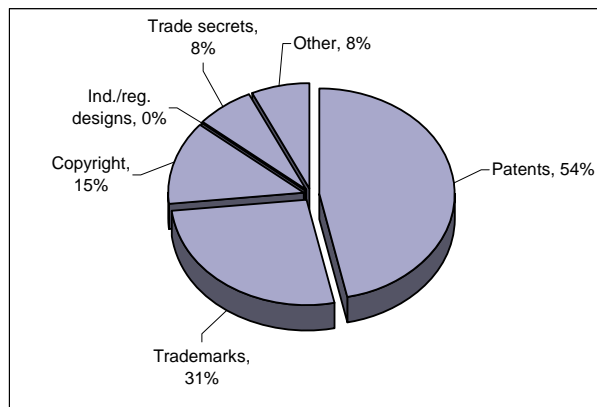
IP Dispute Risks are Global

- Two thirds of the respondents report that they sell products or make their services available outside Canada
- Risks of IP disputes are global
 - 43% indicated that they had been involved in an IP- related dispute – breakdown:



IP Rights Involved In Disputes

IP Right Involved in Dispute



Need to Better Assess IP Risks

- 39% of companies indicated that they would conduct a market analysis of existing businesses, products or services before launching a new business, product or service
 - **Only 20% indicated they would search IP databases**
- Significant IP licensing-in of patents (46%) and copyright (39%)
 - nearly **40% of the companies surveyed claimed that they did not license any IP rights from third parties**
 - Not fully taking into account other types of IP licenses from third parties
 - Possible explanation:
 - failure of the respondents to take into account off-the-shelf software products like MICROSOFT OFFICE
 - strategic decision to develop/market products which are solely proprietary and do not use any third party IP in their products

Need to Better Assess IP Risks

- Majority (more than 67%) indicated they sell products or make services available outside of Canada
 - **25% had taken no steps to identify third-party IP rights in applicable foreign jurisdictions**
- Level of risk mitigation does not correlate well with the global scope of the activities

Managing IP Risks

- Searching IP databases is one of the best steps that can be taken to help avoid particular IP disputes
 - Investment can pay off significantly by identifying IP risks and helping to eliminate the much more significant costs associated with IP litigation
 - Appropriate IP searches may have identified third party patent or trade-mark rights (85% of litigation)

Managing IP Risks

- Internal IP due diligence re: breach of contract and/or indemnity claims by licensees/purchasers
 - each licensee/purchaser will likely require that the respondent provide contractual representations, warranties and/or indemnities regarding ownership and non-infringement
 - 69% indicated that they were either **very or somewhat comfortable** with representations and warranties regarding ownership and non-infringement
 - **BUT 80% failed to complete any IP searching** prior to taking a product or service to market
 - **ONLY 17% confirmed ownership of IP** directed to business, product or service before going to market

Managing IP Risks

- One means to offset the costs of IP litigation is insurance
- In recent years, insurance policies for IP infringement claims have become more commonplace
- **Majority of respondents (72%) have not sought any advice from an insurance provider**



Best Practices for IP Management

- **GOALS**
 - Understand what IP assets you have and the value thereof
 - Adopt appropriate IP management
 - Adopt appropriate IP risk mitigation strategies
- **STEPS TO HELP ACHIEVE GOALS**
 - Maintain current schedule of proprietary IP
 - Maintain current schedule of licensed IP
 - Licensed-in/Licensed-out
 - Address non-disclosure/confidentiality of inventions
 - Address Ownership of IP developments
 - Third Parties/Employees
 - Address IP clearance prior to product/service launch
 - IP Searching
 - Enforce IP Rights





MARK PENNER
Partner

Mark Penner is a partner in the Technology and Intellectual Property Practice Group with expertise in the acquisition, protection and enforcement of intellectual property rights in the chemical, pharmaceutical and biotechnology areas. His practice focuses primarily on the drafting and prosecuting of patent applications in this area of technology.

416.868.3501
mpenner@fasken.com



JOHN BEARDWOOD
Partner

John Beardwood is engaged in a corporate/commercial practice, with an emphasis on outsourcing and procurement, technology and privacy law related matters. John is regularly listed among the world's preeminent internet and e-commerce lawyers in Who's Who Legal - The International Who's Who of Business Lawyers where, in addition to being referred to as "an authority on outsourcing" in the guide to Internet and E-Commerce Lawyers, he is identified as being both one of the two most highly nominated lawyers in the guide.

416.868.3490
jbeardwood@fasken.com

This presentation contains statements of general principles and not legal opinions and should not be acted upon without first consulting a lawyer who will provide analysis and advice on a specific matter. Fasken Martineau DuMoulin LLP is a limited liability partnership.

BIOGRAPHIES



John P. Beardwood

Partner

Toronto

Direct Line: 416 868 3490

Facsimile: 416 364 7813

jbeardwood@fasken.com

www.fasken.com/john-beardwood

Areas of Practice

Technology and Intellectual Property

Privacy and Information Protection

Outsourcing

Information Technology

Health

Corporate / Commercial

Education

BA (Hons), History and Political Science
McMaster University, 1992

MA, Political Science
McMaster University, 1993

LLB,
University of Toronto, 1996

Year of Call

Ontario, 1998

John Beardwood is a partner of the firm, engaged in a corporate/commercial practice, with an emphasis on outsourcing and procurement, technology and privacy law related matters. John is regularly listed among the world's preeminent internet and e-commerce lawyers in *Who's Who Legal - The International Who's Who of Business Lawyers* where, in addition to being referred to as "an authority on outsourcing" in the guide to Internet and E-Commerce Lawyers, he is identified as being both one of the two most highly nominated Canadian lawyers in the guide, and one of the ten "most highly regarded individuals" globally; and is also included as a leading lawyer in the Internet & e-Commerce chapter of *Who's Who Legal: Canada 2010*. He is listed in *Chambers Global - The World's Leading Lawyers for Business 2010*, for Information Technology. He is consistently recognized in *The Best Lawyers in Canada* for information technology law, and highly recommended as an outsourcing practitioner in the *PLC Which Lawyer? Yearbook* and in the *PLC Outsourcing Handbook*. His biography is to be included in the *Canadian Who's Who (2010)*.

John works closely with clients in advising on and negotiating various technology-related transactions, including outsourcing/procurement, licensing, implementation, distribution, technology transfer, strategic alliance and e-commerce related transactions, including in the airline, health care, financial/insurance institution and public sector contexts. John often advises clients on privacy law and access to information matters, and has between developing and implementing privacy compliance programs for almost ten years. He is a frequent speaker and publisher on various IT law and privacy law-related topics and has been interviewed for CBC Metro Morning, The Globe and Mail, ITBusiness.ca, Computing Canada, CBC Marketplace, Canadian Business Magazine and 1010 CFRB, and was featured on the cover of CBA National Magazine for the article "The Outsourcing Lawyers". John is the co-editor and a contributing author of the industry-leading text *Outsourcing Transactions: A Practical Guide*, now in its 3rd Edition.

John is Co-Chair of the National Technology and Intellectual Property Practice Group; Co-Chair of the National Outsourcing Practice Group; and Vice-Chair of the Privacy and Information Protection Practice Group.

Representative Experience

- *MDS completes divestiture of instrument division to Danaher for US\$650 million*
Canadian counsel to MDS Inc.
- *Western Financial Group and Bank West acquire AgriFinancial Canada*
Advised Western Financial Group
- *La Coop fédérée closes deal with Agronomy Company of Canada*
Advised Land O'Lakes
- *MDS sells diagnostics business to Borealis Infrastructure Management in \$1.325 billion transaction*
Advised MDS Inc.

- *Air Canada signs groundbreaking outsourcing agreement with ITA Software for new reservation management system*
Advised Air Canada
- *Bank of Nova Scotia undertakes parallel track negotiations with three vendors regarding outsourcing of certain technology services to India*
Advised Bank of Nova Scotia
- *De-merger of Women's College Hospital and Sunnybrook Health Sciences Centre*
Advised Sunnybrook Health Sciences Centre and Sunnybrook Foundation
- *Ontario Air Ambulance System Consolidated under the Operation of Ornge*
Advised Ornge
- *ING Canada acquires Allianz of Canada*
Advised ING Canada
- *The Independent Order of Foresters enters into outsourcing arrangement with CGI*
Advised The Independent Order of Foresters
- *Desjardins Group acquires Province of Ontario Savings Office, and creates Desjardins Credit Union Inc.*
Advised The Desjardins Group
- *Ontario Ministry of Transportation enters into public-private partnership to deliver driver examination services*
Advised the Ministry of Transportation of Ontario
- *IBM acquires PwC consulting and technology services business in US\$3.5 billion deal*
Advised PricewaterhouseCoopers
- *Atos Origin in complex parallel negotiations with Celestica regarding outsourcing of certain technology services*
Advised Atos Origin
- *TD Bank Financial Group sells its internal and external custody business (transferring \$75 billion of custodial assets under administration) to CIBC Mellon*
Advised TD Bank Financial Group
- *ING Canada acquires insurance business from Zurich North America Canada*
Advised ING Canada
- *PricewaterhouseCoopers in complex three-party \$100 million enterprise effectiveness outsourcing by Bell Canada*
Advised PricewaterhouseCoopers
- *MDS signs IT licensing agreement with Oracle*
Advised MDS Inc.
- *Dupont outsources payroll services*
Advised Dupont
- *TD Bank in transitional outsourcing of systems, procedures, processes and networks used in connection with operation of its custodial business*
Represented The Toronto Dominion Bank
- *St. Joseph's Healthcare Hamilton renegotiates its multi year outsourcing of its technology function*
Counselled St. Joseph's Healthcare Hamilton
- *Counseled international IT services provider in a teaming arrangement with a third-party software provider to deliver information technology outsourcing services to Canadian financial institution*

- *Major Canadian bank affiliate outsources mailing/fulfillment services*
Advised Xerox Canada
- *Ontario Ministries of Attorney General and Solicitor General advised with respect to Integrated Justice Initiative*
Advised Ontario Ministries of the Attorney General and Solicitor General
- *Moneris Solutions outsources maintenance and distribution of POS terminals*
Advised Moneris Solutions Corporation

Presentations

- Navigating Murky Waters: Anatomy of a Privacy Breach, Privacy and Access Rights in the Age of Technology: The State of Canadians' Information Rights in 2010 and Beyond, The Canadian Bar Association, September 19, 2010
- Generating Revenue and Reducing Risk: Our IP Survey Results Are In, Technology and Intellectual Property Group Seminar, September 15, 2010
- Negotiating and Contracting for Outsourcing, COP Master Class, International Association of Outsourcing Professionals, June 23, 2010
- Change Management: How to Build Flexibility into your Contracts, Centre for Outsourcing Research & Education (CORE), June 2010
- Legal Risks of Agile Software, IFCLA Conference, June 9-11, 2010
- One of These Things is Not Like the Others: Special Issues in Collaborative Sourcing, June 2, 2010
- SLA Negotiations, Ontario Institute of the Purchasing Management Association of Canada, February 9, 2010
- Change Management: How to Build Flexibility into your Contracts, Centre for Outsourcing Research & Education (CORE), January 2010
- An Alternative to the Traditional Outsourcing Model, Xchanging Presentation, December 9, 2009
- Emerging Privacy Issues, Ninth Annual Regulatory Affairs Symposium: Current Regulatory Environment for P&C Insurers, October 30, 2009
- Document Retention & E-Discovery: Canadian Legal Issues, Achieving Litigation Readiness while Cutting Costs and Improving Outcomes, September 10, 2009
- Change Management: How to Build Flexibility into your Contracts, Centre for Outsourcing Research & Education, June 2-3, 2009
- Current Legal Issues Affecting Hospitals, May 27, 2009
- CLE Seminars on Key Differences in IT/IP Law in Canada, US Strategy presentation: DLA Piper, Dorsey & Whitney LLP, and Perkins Coie LLP, May 14-15, 2009
- Risk Management in Outsourcing Transactions: Finding the Balance between Certainty & Flexibility - "Air Canada: A Case Study in Outsourcing", *The 2009 Outsourcing World Summit*, International Association of Outsourcing Professionals, February 18-19, 2009
- Change Management: How to Build Flexibility into your Contracts, Centre for Outsourcing Research & Education, January 27-28, 2009
- Outsourcing in Ontario - The Nearshore Alternative: The Legal Issues, Ontario Ministry of International Trade and Investment - *Connect2Canada*, December 10, 2008

- PIPEDA 2.0? An Advance Preview of the New PIPEDA: Breach Notification; Mastering Privacy Issues in Litigation and e-Discovery, *Canadian Corporate Counsel Association Platinum Series CLE – (Privacy Matters)*, November 13, 2008
- Ensuring coverage: Insurance Issues in Outsourcing Arrangements, *ITechLaw 2008 European Conference*, November 6-7, 2008
- Keeping yourself covered: Insurance Issues in Outsourcing Transactions, *Technology and Intellectual Property Videoconference*, October 22, 2008
- Security Fundamentals for Privacy Professionals, *IAPP KnowledgeNet Breakfast/Networking*, August 27, 2008
- Bankruptcy & Insolvency Issues in Outsourcing Arrangements: A Wake-Up Call, *International Federation of Computer Law Associations 2008 Conference*, June 5-6, 2008
- Legal Aspects of Outsourcing, *IAPP Canadian Privacy Summit 2008*, May 21-23, 2008
- Lessons from the 2008 Survey: Connecting your IP Strategy to your Goals, *PricewaterhouseCoopers Fifth Annual Emerging Software Companies Conference: Connecting Vision to Reality 2008*, May 13, 2008
- Outsourcing Strategy and Scoping: Managing Change in Outsourcing Arrangements, Centre for Outsourcing Research and Education, Executive Education Program, May 5, 2008
- Structuring Escrow Agreements, *8th Annual IT Law Spring Training Programme*, May 2, 2008
- Outsourcing Recent Developments and Trends, *2008 World Technology Law Conference and Annual Meeting*, ITechLaw, April 24-25, 2008
- Privacy Laws Update: Proposed Changes to PIPEDA; Can You Be Sued for Breach of Privacy?, Presented at Fasken Martineau *Annual National Labour Seminar*, February 15, 2008
- PIPEDA 2.0? Update on PIPEDA Review & Breach Notification, Presented at Canadian Institute's *Payment Card Compliance*, February 14-15, 2008
- Privacy Issues & Investigations: Key Legal Challenges when fighting Fraud in Financial Institutions, presented at Federated Press *Fraud for Financial Institutions*, January 16-17, 2008
- Federated Press *4th Edition Service Level Agreements Course*, principal lecturer, January 7-8, 2008
- Focis Outsourcing Workshop, presented, December 3, 2007
- IT Security, presented at *Outsourcing Seminar* by Fasken Martineau and International Association of Outsourcing Professionals (IAOP), November 23, 2007
- Outsourcing, Fasken Martineau Business Law CLE, November 13, 2007
- Price as Change Management Tool in Outsourcing Transactions, Centre for Outsourcing Research & Education (CORE), November 7-8, 2007
- Technology Contracting, moderator at *ITechLaw 2007 European Conference*, London U.K., November 1-2, 2007
- International Issues in Privacy Regulation and Global Compliance; Canada's Personal Information Protection and Electronic Documents Act, 3rd Annual Global Privacy and Data Security Conference, October 30, 2007
- Multi-Function Outsourcing - Making the Sum Greater than the Whole of its Parts, presented at CORE - *Case Studies in Outsourcing Seminar*, Montréal, October 24, 2007
- Trends in Outsourcing, presented at *Outsourcing Seminar* by Fasken Martineau and Focis Consulting Inc., October 5, 2007

- International Developments in Privacy & Access Law, presented at Canadian Bar Association's *CBA Canadian Legal Conference & Expo*, Calgary, August 12-14, 2007
- Managing Risk When Outsourcing the Management of E-Documents to Third Parties, presented at *Infonex 3rd Annual E-Discovery Conference*, June 20-21, 2007
- Confidentiality & Privacy Issues in Termination Assistance - Getting out of the Outsourcing Deal, presented at the *7th Annual IT Law Spring Training Program*, May 14, 2007
- New Approaches in Business Critical Transactions, chair, *ITechLaw Annual Meeting & World Conference*, Chicago, April 26-27, 2007
- Legal Aspects of an SLA; Avoiding Common Pitfalls and Traps, presented two papers at Federated Press *3rd Annual Service Level Agreements Course*, April 23-24, 2007
- Privacy Issues & Investigations: Key Legal Challenges When Fighting Fraud in Financial Institutions, presented at Federated Press *Fraud for Financial Institutions Course*, April 18-19, 2007
- Post Papering the Deal, presented at *Outsourcing Seminar* by Fasken Martineau and Focis Consulting Inc., April 3, 2007
- Making the Decision, and Getting to Contract Execution, presented at *Outsourcing Seminar* by Fasken Martineau and Focis Consulting Inc., March 5, 2007
- PIPEDA: Where are we now and where are we going?, presented at Insight Info's *National General Counsel Compliance Congress*, February 28 - March 1, 2007
- PIPEDA and Privacy Update, presented at Canadian Institute's *2nd Annual Payment Card Compliance in Canada Conference*, February 15-16, 2007
- Software and IT Licensing, presented paper at the Canadian Institute's *10th Annual IP License Agreements Conference*, November 27-29, 2006
- Outsourcing to Eastern Europe: Comparative Advantages of Eastern European Countries in IT Product and Service Development, chaired at *ITECHLAW European Conference*, Prague, November 2006
- Canada's Personal Information Protection and Electronic Documents Act, presented at *Brown Raysman Global Privacy and Data Security Conference*, New York, October 25, 2006
- Outsourcing and Trans-Border Data Flows: Privacy and Public Policy in Transition - Defining the Issues, presented at the *IAPP Privacy Academy Conference*, October 18-20, 2006
- Lessons Learned in International Outsourcing, presented at the *Association of Corporate Counsel (ACC America) Greater New York Chapter*, October 10, 2006
- Structuring Pricing to Respond to Change, presented at the Fasken Martineau Technology and Intellectual Property Group videoconference on *Outsourcing Transactions*, June 29, 2006
- At What Price Binary Freedom: The Evolving Challenges of Open Source and Hybrid Software, presented paper at International Federation of Computer Law Association (IFCLA) Conference, *IT Law - The Global Future: Achievement, Plans and Ambitions*, Amsterdam NL, June 2006
- Multi-Function Outsourcing Arrangements: Making the Sum Greater than the Whole of its Parts, presented at the *Sixth Annual IT Law Spring Training Program* (IT.Can-LSUC joint conference), May 29, 2006
- The only constant: Pricing for Change in Outsourcing Arrangements, paper presented at *ITech Law 35th World Computer and Internet Law Congress and Annual Meeting*, San Francisco, May 4-5, 2006

- Extra-Jurisdictional Data Transfer Issues, presented paper at *Joint BC and Alberta Information & Privacy Commissioners' Conference*, Calgary, April 26-27, 2006
- Legal Aspects of a Service Level Agreement; Avoiding Common Pitfalls and Traps, chaired and presented at the Federal Press *Second Annual Service Level Agreements Conference*, April 20-21, 2006
- Key Legal Issues in Electronic Record Retention, presented paper at *ARMA Seminar*, January 2006
- Outsourcing issues: transfers of personal information in outsourcing; Patriot Act and other cross-border issues, presented paper at *Annual Fasken Martineau Privacy Seminar*, Calgary and Vancouver, November 24-24, 2005
- Privacy Issues in Transporting Data Across Various Jurisdictions, presented at Fasken Martineau and the Computer Law Association videoconference, November 9, 2005
- Ensuring Compliance with Privacy and Data Protection Legislation, presented at the Federated Press *Digital Identity Management Course*, November 3-4, 2005
- Only in Canada, eh? Pity: New Data Restrictions in Extra-Jurisdictional Outsourcing, presented at Computer Law Association *European Conference 2005*, Stockholm, Sweden, October 27-28, 2005
- Service Level Agreements, co-chaired and presented at *The Outsourcing Institute RoadShow Series*, October 20, 2005
- Hackers and Websites: Legal Issues in Managing Security Breaches in IT Systems, presented at the OBA seminar *In the Hot Seat: Crisis Management for In-House Counsel*, June 2, 2005
- Privacy Issues and Investigations: Key Legal Challenges When Fighting Fraud in Financial Institutions, presented at the Federated Press *Fraud in Financial Institutions Course*, May 19-20, 2005
- Legal Aspects of a Service Level Agreement; Avoiding Common Pitfalls and Traps, chaired and presented at the Federated Press *Service Level Agreements Conference*, May 16-17, 2005
- Critical Outsourcing Debates, moderated panel discussion at the 2005 World Computer and Internet Law Congress, the Computer Law Association, Washington D.C., May 5-6, 2005
- Privacy Legislation Compliance: How to Harmonize National Policies to Incorporate Different Provincial Standards & Laws, presented at the Infonext *Managing Mutual Funds Conference*, April 6, 2005
- Canadian Privacy Law, presented at The European Union Studies Center of the Graduate Center, CUNY, and the New York State Bar Association International Law and Practice Section, International Privacy Law Committee, New York, March 15, 2005
- 2004 - Revolution in Canadian Copyright Law, presented at the Computer Law Association Conference, Amsterdam NL, November 19, 2004
- 2004 - Revolution in Canadian Copyright Law?, presented at the Computer Law Association Conference, Amsterdam, November 19, 2004
- Accountability and Privacy Issues in Outsourcing Arrangements, presented for the *Legal Showcase* at the OHA Health Achieve 2004, November 15, 2004
- Current Issues from the Perspective of Property and Casualty Insurance Industry with the Implementation of PIPEDA, presented as part of a Privacy Panel at the *Fourth Annual Insurance Bureau of Canada Regulatory Affairs Symposium*, November 4, 2004

- Key Privacy Issues Facing CA IFAs Today, presented at *The 6th Annual Alliance for Excellence in Investigative and Forensic Accounting Conference*, October 19, 2004
- Privacy Legislation: Preparing for PHIPA and PIPEDA Compliance, presented at the Fasken Martineau *Health Law and Privacy Groups seminar*, September 29, 2004
- Privacy Issues in Your Call Centre to Ensure Compliance with Privacy Laws, presented at the *Inaugural Canadian Call Centre Week Conference*, September 16, 2004
- Managing Security and Privacy in Outsourcing Health Information Services: How to Minimize Risk in the New Regime, co-chaired and presented at The Canadian Institute Seminar on *Ontario's New Personal Information Protection Act*, June 17-18, 2004
- Intellectual Property: Due Diligence and Asset Strategies, presented at the Fasken Martineau/PricewaterhouseCoopers seminar *Getting Your Company Ready for the Dance*, June 16, 2004
- Creeping Law: The Canadian Lawful Access Consultation Document, presented at the Barreau du Québec's Annual Meeting, Québec City, June 4, 2004
- Privacy in IT Transactions: Advising Business under the Current Privacy Legal Landscape, presented at *The Fourth Annual IT Law Spring Training Program* (T.Can-LSUC joint conference), May 19-20, 2004
- Health Privacy in Ontario - The Latest Developments, co-chaired and presented at the Insight Seminar on *Privacy Compliance in Healthcare*, May 17-18, 2004
- An e-contract is a contract is a contract: Online Contracting with Consumers, presented at Computer Law Association Conference in Washington D.C.; reported in "With Validity of Online Contracting Settled, Courts Eye Details: Notice, Assent, Fairness" in Bureau of National Affairs bulletin *Electronic Commerce & Law*, May 6-7, 2004
- We Are Considering Buying the Shares of Retail Target Co. What Privacy Due Diligence Should We Do?, presented at the OBA Seminar on *Privacy for Business Lawyers*, April 19, 2004
- Monitoring Employees in the Electronic Age, presented at the OBA Institute Program *The E-Counsel Primer - Going Boldly Where Your Practice Did Not Go Before*, January 30, 2004
- The Personal Information Protection and Electronic Documents Act, presented at the *AIIIM International Toronto Chapter Seminar*, January 29, 2004
- Privacy Legislation: How the Federal Privacy Legislation will Affect Ontario Hospitals, presented for the *Legal Presentation Showcase* at the Ontario Hospital Association Convention & Exhibition, November 3, 2003
- Privacy Issues for IT Business, presented at the Canadian IT Law Association/Canadian Corporate Counsel Association Program, October 22, 2003
- Privacy Matters in the Workplace: An Update for 2003, presented at the 19th Annual Fasken Forum: Employment, Labour and Human Rights, Pensions & Benefits Conference, October 9, 2003
- Provincial Private Sector Privacy Laws, presented at the Insight Seminar *Health Privacy*, September 29, 2003
- Hidden Mines: Personal Information Issues in a Business Transaction, presented at the Toronto Venture Group *Bridging the Gap* seminar, May 23, 2003
- Sale of Business, presented at the Ontario Bar Association conference *The Absolute Very Latest Up to the Minute News, Tips and Strategies in Privacy Law and Compliance*, May 5, 2003
- Developments in Canadian Privacy Law, presented at the Computer Law Association Conference, Washington D.C., May 1-2, 2003

- Privacy Laws Update: New Developments, presented at the Insight *Fourth Annual Internet Law Conference*, April 24, 2003
- Privacy Law Issues for Credit Professionals, presented at Lumbermen's and Mercantile Credit Bureau *Workshop for Credit Professionals*, April 23, 2003
- Privacy of Patient Information, presented at the Insight Seminar *Hospital Liability and Risk Management*, March 25-26, 2003
- The Impact for Business Law, presented at the Ontario Bar Association Institute 2003 Conference, Privacy Law Section seminar *Privacy Law Fundamentals - Are You Ready for 2004?*, March 20-22, 2003
- Canadian Developments in Cyber Security - The Lawful Access Consultation Document, presented at Misc. Miller International Seminars & Conferences on *The State of Cyber Security*, New York, February 19, 2003
- Through a Glass Darkly: A Review of the Key Findings of the Privacy Commissioner Under PIPEDA (2002), presented at The Toronto Board of Trade *Privacy Act Series*, February 18, 2003

Publications

- "Going Global: How Canadian Companies View Intellectual Property", Intellectual Property Bulletin, August 2010
- "Understanding the PPP: The BPS Supply Chain Guideline", Health Law Bulletin, March 2010
- "Understanding the PPP: The BPS Supply Chain Guideline", Health Law in Canada, Volume 30, No. 3, February 2010
- "Canada: "Net Neutrality" Decision - Radio-television and Telecommunications Commission rules on Internet Traffic Management Practices", Computer und Recht International (CRI), December 2009
- "Regulating Social Networking: Lessons from Canada", Computer und Recht International (CRI), December 2009
- "Important Lessons in Exploiting Your IP Portfolio: Revenue Generation and Reducing Risks", Technology and Intellectual Property Bulletin, March 2009
- "Special Issues in Selling Online in Canada", Lexpert, March 2009
- "Ensuring coverage: Insurance Issues in Outsourcing Arrangements", ITechLaw 2008 European Conference, November 2008
- "Complying with Privacy Laws Nationally", CBA National Privacy and Access Law Section – Online CLE, October 7, 2008
- "Counter-revolution in Canadian Copyright Law?", Computer und Recht International, October 2008
- "The 2008 Report on Emerging Canadian Software Companies: The CEO Perspective (by PricewaterhouseCoopers LLP)", Contributors, John P. Beardwood and Mark D. Penner - Intellectual Property, May 2008
- "Outsourcing Transactions: A Practical Guide", Eds. C. Ian Kyer and John Beardwood, Canada Law Book, 2008
- "International Privacy Laws: A Comparative Guide", Co-editor and contributing author, IT Tech Law, 2009

- "Bankruptcy & Insolvency Risks in Outsourcing Transactions: A Wake-Up Call", Author, IFCLA IT Law Newsletter, March 2008
- "Bankruptcy & Insolvency Risks in Outsourcing Transactions: A Wake-Up Call", author, IFCLA IT Law Newsletter, 2008
- "Open Source Hybrids and the Final GPLv3", co-author, Computer und Recht International (CRI), February 2008
- "Canada: PIPEDA - Amendments Towards 2.0?", author, Computer und Recht International (CRI), December 2007
- "PIPEDA - New and Improved? The 4th Report of the PIPEDA Review Committee and the Government Response", author, Canadian Insurance Regulation Reporter, Vol. 1, No. 1, December 2007
- "PIPEDA 2.0? Proposed amendments to the Canadian Personal Information Protection and Electronic Documents Act ", Privacy and Information Protection Bulletin, November 2007
- "Extra-Jurisdictional Data Transfer Issues", paper presented at the Joint BC and Alberta Information & Privacy Commissioners' Conference, Calgary, August 26-27, 2006
- "At What Price Binary Freedom: The Evolving Challenges of Open Source and Hybrid Software", co-author, Computer und Recht International (CRI) Issue 4, August 2006
- "New Canadian Restrictions on Extra-Jurisdictional Data Processing", co-author, Canadian Bar Association National Newsletter , August 2006
- "Bankruptcy & Insolvency In Outsourcing Arrangements: A Wake-Up Call", Technology Law 2006: New Frontiers and Challenge: global, virtual, open and outsourced, June 2006
- "New Canadian restrictions on extra-jurisdictional data processing: foreign service providers take note", co-author, National Privacy and Access Law , Canadian Bar Association, June 2006
- "New Canadian Restrictions on Extra-Jurisdictional Data Processing: Why U.S. Service Providers Should Take Note", author, BNA International Inc., Privacy and Security Law Report , April 2006
- "The OSFI Guidelines: Deciding Whether to Outsource", By Robert E. Elliot, in Outsourcing Transactions: A Practical Guide, by C. Ian Kyer and John P. Beardwood, Canada Law Bank, 2006
- "Extra-Jurisdictional Transfer of Data: What We Can Expect for 2006", co-author, Internet and E-Commerce Law in Canada , LexisNexis, Butterworths, January 2006
- "Towards A 'Do-Not-Call' List in Canada", co-author, Privacy and Information Law Report , Vol. 7, Issue 1, Thomson Legalworks, January 2006
- "Approaches to 'Extra-Jurisdictional' Data Transfers in Canadian and European Outsourcing", co-author, Computer und Recht International (CRI), Issue 6, December 2005
- "A Brief Guide to Outsourcing", author, CICA bulletin - Report on Industry , September 2005
- "A Brief Guide to Outsourcing", author, CICA bulletin - Practice Advantage , September 2005
- "2004 - Revolution in Canadian Copyright Law?", author, Computer und Recht International (CRI), Issue 2, April 15, 2005
- "Current Trends in Outsourcing", co-author, OBA seminar, New Trends in Technology , April 8, 2005
- "Special Issues in Canadian IT Outsourcing", co-author, article for the 2005 Lexpert Guide to the Leading Canada/US Cross-Border Corporate Lawyers in Canada , April 2005

- "Accountability and Privacy Issues in Hospital Outsourcing Arrangements", Health Law and Privacy Alert by Lynne Golding and John P. Beardwood, December 2004
- "Coming Soon to the Health Sector Near You: An Advance Look at the New Ontario Personal Health Information Protection Act (PHIPA)", co-author, Healthcare Quarterly , Part 1 and Part 2, October 2004 and January 2005
- "Anatomy of a Privacy Incident Response: Why Good Planning Matters", co-authored article as a representative of the International Law and Privacy Section of the New York State Bar Association for the International Law Practicum , Autumn 2004
- "Coming Soon to the Health Sector Near You: An Advance Look at Bill 31, the Ontario Personal Health Information Protection Act (PHIPA)", author, OBA Privacy Section Newsletter, Personally Yours , June 2004
- "An Overview of the New Ontario Health Information Protection Act", Health Law and Privacy Alert by John P. Beardwood, June 2004
- "Preventing the Cure from Being Worse than the Disease: Special Issues in Hospital Outsourcing", co-author, Healthcare Quarterly , January 2004
- "The Next Step to Privacy Compliance for Hospitals: Implementing the OHA Guidelines", Health Law and Privacy/Security Alert (with Deloitte & Touche), November 2003
- "New Privacy Issues in Corporate Transactions", author, Corporate Financing , October 2003
- "Taking the Next Step to Privacy Compliance for Hospitals: Implementing the OHA Guidelines", author, Healthcare Quarterly , October 2003
- "Creeping Law? The Canadian Lawful Access - Consultation Document and the Council of Europe's Convention on Cyber-Crime", author, Computer und Recht International (CRI), June 2003
- "Making All Sales Final: Meeting the Requirements for Online Consumer Transactions in Canada", author, Computer und Recht International (CRI), April 2003
- "Made-In-Ontario II: The Draft Ontario Privacy of Personal Information Act ", Privacy and Information Protection Bulletin, March 2002
- "Financial Institutions and Personal Information Protection", Financial Institutions and Services/Privacy and Information Protection Bulletin by Robert E. Elliott and John P. Beardwood, May 2000

Memberships and Affiliations

- Member of the Board of Editors for e-Commerce Law & Strategy
- Member of the Executive Committee and Board of Directors and Program Chair of ITechLaw (formerly Computer Law Association)
- Founder and Past-Chair, Canadian Bar Association National Privacy and Access Law Section
- Co-founder and Past-Executive Committee Member, Ontario Bar Association, Privacy Law Section
- Co-founder, ex-Director and ex-Treasurer Canadian IT Law Association ("IT.Can")
- Co-Chair of the 2005 Computer Law Association Conference in Washington, D.C., May 5-6, 2005
- Member of the organizing committee for the 2004 Computer Law Association Conference in Washington, D.C., May 6-7, 2004
- Macro Area Representative (MAR) for North America (excluding U.S.A.), ITechLaw

- Canadian editor for Computer und Recht International (CRI)

Rankings and Awards

- Canadian Legal Lexpert Directory 2010: repeatedly recommended, Computer & IT Law
- Listed in Who's Who Legal Guide to Internet & e-Commerce Lawyers as being one of the ten "most highly regarded individuals" globally
- Listed as "Highly Recommended" for Outsourcing (Canada) in the PLC Cross-border Outsourcing Handbook 2010, and in Which Lawyer? Yearbook 2008 and 2009
- Listed in the International Who's Who of Internet and e-Commerce Lawyers in 2008 and 2009
- Recognized in the 2008, 2009, 2010 and 2011 edition of The Best Lawyers in Canada in the specialty of Information Technology Law
- Recognized as one of the Best Lawyers in Canada for IT law in the National Post Business magazine annual list of Best lawyers in Canada for 2007-2008



Mark D. Penner

Partner

Toronto

Direct Line: 416 868 3501

Facsimile: 416 364 7813

mpenner@fasken.com

www.fasken.com/mark-penner

Areas of Practice

Technology and Intellectual Property

Intellectual Property

Life Sciences

Litigation and Dispute Resolution

Asia Pacific Practice

Chinese / □□

Japanese / □□

Entertainment & Media

Education

Registered Patent Agent (United States),
2001

Registered Patent Agent (Canada),
2000

Registered Trade-mark Agent (Canada),
1998

LLB,
Queen's University, 1995

MSc, Immunology
University of Toronto, 1994

BSc, Biochemistry
Queen's University, 1989

Mark is a partner in the Technology and Intellectual Property Practice Group with expertise in the acquisition, protection and enforcement of intellectual property rights in the chemical, pharmaceutical and biotechnology areas. Mark's practice focuses primarily on the drafting and prosecuting of patent applications in this area of technology. Examples of this include therapeutic compounds and their uses (e.g. small molecule therapeutics, biopharmaceuticals, stereoisomers); chemical and biotechnological processes (e.g. in food production, heavy oil extraction, protein, gene and life form engineering); and recombinant biomolecules (e.g. antibodies, peptides, cellular recognition/adhesion proteins, angiogenesis and immune response modulators).

In addition to patent prosecution, Mark also has extensive experience with preparing infringement, validity, freedom to operate and patentability opinions in the life sciences. On the enforcement side, Mark has been involved in Federal Court proceedings involving patent infringement and validity as well as Notice of Compliance proceedings under the Patented Medicines (Notice of Compliance) Regulations.

Mark's practice also involves the IP aspects of corporate transactions (e.g. financing, mergers & acquisitions and joint ventures) such as protection of confidential information, trade secrets and know how, conducting due diligence, as well as technology acquisition and licensing.

Mark is registered to practise as a patent and trade-mark agent before the Canadian Intellectual Property Office. He is also registered to represent Canadian applicants before the United States Patent & Trademark Office.

Representative Experience

- *AEA Mezzanine Fund provides mezzanine debt to Kohlberg & Co. to assist in funding its US\$200 million acquisition of Nike's Bauer Hockey subsidiary*
Advised AEA Mezzanine Fund
- *Parker Hannifin Corporation acquires Vansco Electronics*
Advised Parker Hannifin Corporation
- *North Castle Partners acquires World Health Club*
Advised North Castle Partners
- *Liqui-Box sells performance films business to Exopack*
Advised Liqui-Box Canada Inc.
- *MDS sells diagnostics business to Borealis Infrastructure Management in \$1.325 billion transaction*
Advised MDS Inc.

Presentations

- *Generating Revenue and Reducing Risk: Our IP Survey Results Are In, Technology and Intellectual Property Group Seminar, September 15, 2010*

Year of Call
Ontario, 1997

- Top Intellectual Property Cases of 2009, Technology and Intellectual Property Group Seminar, January 26, 2010
- Basics of IP: Patents and Trademarks, MITACS Skills Training & Entrepreneurship Program (MITACS STEP), January 11, 2010
- Tangible Intangibles - The Rising Value of IP: A Strategic Guide to Intellectual Property, Etobicoke Chartered Accountants Association, November 2, 2009
- Future of Life Sciences in Canada, Deloitte & Touche LLP Manufacturing Learning Conference, October 30, 2009
- The Nuts and Bolts of Commercialization, CHBDN 2009 Annual Conference, *Rethinking the Business of Healthcare*, October 7, 2009
- Intellectual Property Considerations in the Design Process, The Design Exchange Business Forum, January 27, 2009
- PricewaterhouseCoopers Fifth Annual Emerging Software Companies Conference: Connecting Vision to Reality 2008 (Ottawa), December 2, 2008
- Convergent Medical Technologies Conference 2008, Innovation to Implementation, November 2008
- Lessons from the 2008 Survey: Connecting your IP Strategy to your Goals, PricewaterhouseCoopers *Fifth Annual Emerging Software Companies Conference: Connecting Vision to Reality 2008*, May 13, 2008
- Perspectives on National Business Developments in the Life Sciences Industry, Panelist, Canadian Institute's Life Sciences Business and Legal Guide to Product Life Cycle Management: Managing Risk and Increasing Business Opportunities, April 10, 2008
- The Design Process and Intellectual Property: A Strategic and Tactical Guide, presenter, DX Business Forum: Integrating the Design Process, March 4, 2008
- Strategic Intellectual Property 301: Effective Branding & Brand Creation, January 24, 2008
- Using Recent Developments in Patents and Data Protection/Data Exclusivity to Bolster Your Organization's Strategic Advantage, presenter, The Canadian Institute's 6th Annual Forum on Pharma Patents, Toronto, Ontario, October 17, 2007
- Why Patents Matter, presenter, International Conference on The Pharmaceutical Life Cycle: Interdisciplinary Perspectives on Diversity and Complexity, Montreal, Quebec, October 15, 2007
- Strategic Patenting 201: Creative Effective Patent Portfolios, September 20, 2007
- The Basics of Intellectual Property, presenter, National Franchise and Business Opportunities Show, Mississauga, Ontario, September 8-9, 2007
- Strategic Intellectual Property 101: Unlocking and Maximizing your IP's Value, Fasken Martineau Intellectual Property Group Seminar, June 8, 2007
- Intellectual Property, Presenter, Seneca College, March 3, 2007
- From the Lab to the Pharmacy: Navigating Your Way Through the Drug Approval Process, co-presenter, Canadian Institute's Pharma Supply Chain Conference 2007, February 19-20, 2007
- Intellectual Property: the Year 2006 in Review, Moderator and Presenter, February 15, 2007
- The Basics of Intellectual Property, Presenter, National Franchise and Business Opportunities Show, Toronto, Ontario, January 13-14, 2007
- Understanding Bill 102 and its Regulations, presenter, Fasken Martineau Seminar, September 26, 2006

- The Basics of Intellectual Property, Presenter, National Franchise and Business Opportunities Show, Mississauga, Ontario, September 9-10, 2006
- Making IT Happen, Presenter, IT/IP Conference for Small Business, Humber College, October 19, 2005
- Tips for Drafting Successful Pharma Patent Applications, Speaker, Canadian Institute's Fundamentals of Pharma Patents, April 18-19, 2005

Publications

- "Going Global: How Canadian Companies View Intellectual Property", Intellectual Property Bulletin, August 2010
- "Fasken Martineau's Life Sciences Newsletter", Life Sciences Newsletter, June 2010
- "Commercializing Intellectual Property for Healthcare Businesses", Health Law in Canada, Volume 30, No.3, February 2010
- "Commercializing Intellectual Property for Businesses", Technology and Intellectual Property Bulletin, November 2009
- "Commercializing Intellectual Property for Healthcare Businesses", Technology and Intellectual Property Bulletin, November 2009
- "Important Lessons in Exploiting Your IP Portfolio: Revenue Generation and Reducing Risks", Technology and Intellectual Property Bulletin, March 2009
- "Intellectual Property: The Year 2008 in Review", By the Intellectual Property Practice Group, February 2009
- "Business method and software patents: US Bilski decision sends ripples across pond", IT Law Today, February, 2009
- "Health Canada Publishes Draft Guidelines Regarding Submission Requirements for Subsequent Entry Biologics", Vol. 3, Issue 3, The Catalyst, November 2008
- "Fasken Martineau's Life Sciences Newsletter", Life Sciences Newsletter, September 2008
- "Your Questions Answered: Intellectual Property", Canadian Business Franchise, July 2008
- "The Impact of Intellectual Property Rights on Health Care in Canada", Health Law in Canada, Volume 28, No 3-4, June 2008
- "Health Law in Canada, Volume 28, No 3-4", June 2008
- "Removing Barriers? An Overview of the Canadian Access to Medicines Regime", June 2008
- "An Intellectual Property Primer", June 2008
- "The 2008 Report on Emerging Canadian Software Companies: The CEO Perspective (by PricewaterhouseCoopers LLP)", Contributors, John P. Beardwood and Mark D. Penner - Intellectual Property, May 2008
- "The Very First Newsletter of the Life Sciences Practice Group!", Life Sciences Newsletter, April 2008
- "Antitrust/Competition & Marketing 2007 Year in Review", Antitrust/Competition & Marketing Bulletin, March 2008
- "Intellectual Property: The Year 2007 in Review", February 2008
- "Supporting Your Selection", author, Bio Business, October/November 2007

- "Intellectual Property and the Pizza Franchise", Author, Canadian Business Franchise, Volume 13, No. 4, September-October 2007
- "Canadian Patent Developments in 2006", Submission Editor, The In-House Lawyer, March 2007
- "Protecting Your Green Thumb; Intellectual Property Basics", Author, Canadian Business Franchise L'Entreprise, Volume 12, No. 6, January-February 2007
- "Intellectual Property Year in Review 2006", By the Intellectual Property Practice Group, January 2007
- "Stemming the Tide: Canada Attempts to Stop the Patenting of Inventions Directed to Stem Cells, Organs and Tissues", Author, Biotechnology Focus, Volume 9, No. 10, 2006
- "Asset Deals in IP: Buying What You Can't See", Co-author, 44th Association Internationale Des Jeunes Avocats (International Association of Young Lawyers) Annual Congress, August 2006
- "Amendments to the Canadian Patent Act to Address Drug Access: Is Help on the Way?", co-author, Food & Drug Law Journal, Vol. 60, No. 3, 2005
- "Another Canadian First! Amendments to the Patent Act to Address Drug Access - Is Help on the Way?", co-author, Intellectual Property, Volume XI, No. 4, 2005

Memberships and Affiliations

- Professional Associations
- Member, Canadian Bar Association
- Member, Intellectual Property Institute of Canada
- Foreign Affiliate Member, American Intellectual Property Law Association

FASKEN MARTINEAU INSTITUTE SEMINARS FALL 2010



TORONTO

Fasken Martineau Institute Seminars Fall 2010



Fasken Martineau Institute Seminars

Fall 2010

Welcome to Fasken Martineau Institute! We are excited to announce the fall 2010 program of educational seminars designed to keep you abreast of the key legal issues facing senior business leaders in the GTA.

The course calendar in this brochure provides an overview of the current seminars planned for the fall of 2010. We hope this makes it easier for you to plan which seminars you would like to attend. Save the date for any topics of interest and then keep an eye out for the e-invitations coming to you shortly with further details about each seminar.

Please also visit us online at www.fasken.com to see a list of our upcoming seminars and to register. You will also find more details about each seminar as well as additional seminars added to the program.

We hope you can attend these informative seminars with Fasken Martineau Institute.

Area	Seminar Dates
Antitrust, Competition & Marketing	November 18
Financial Institutions & Services	October 13
Investment Products and Wealth Management	September 17, October 15
Labour, Employment & Human Rights	September 22, October 20, November 24
Pensions and Benefits	November 16
Product Liability	September 29
Securities and Mergers & Acquisitions	October 5, November 4, November 18
Technology & Intellectual Property	September 15

SEPTEMBER 2010

Sunday	Monday	Tuesday	Wednesday	Thursday	Friday	Saturday
			1	2	3	4
5	6	7	8	9	10	11
12	13	14	15 Generating Revenue and Reducing Risk: Our IP Survey Results Are In 8:00 am - 10:00 am	16	17 Regulatory Update - NI 31-103 Registration Reform and Other Matters 12:00 pm - 2:00 pm	18
19	20	21	22 Tips for Accommodating Disability 8:00 am - 10:00 am	23	24	25
26	27	28	29 The Canada Consumer Product Safety Act - Let the Seller Beware! 8:00 am - 10:00 am	30		

OCTOBER 2010

Sunday	Monday	Tuesday	Wednesday	Thursday	Friday	Saturday
					1	2
3	4	5 What to Do When You Have Allegations of Wrongdoing 8:00 am - 10:00 am	6	7	8	9
10	11	12	13 Legal and Regulatory Developments Affecting Financial Institutions 4:30 pm - 7:30 pm	14	15 CLS Training Seminar 8:00 am - 10:00 am	16
17	18	19	20 Workplace Violence and Harassment Laws - Are You in Compliance? 8:00 am - 10:00 am	21	22	23
24	25	26	27	28	29	30
31						

NOVEMBER 2010

Sunday	Monday	Tuesday	Wednesday	Thursday	Friday	Saturday
	1	2	3	4 Public Company - Strategies to Handle Aggressive Minority Shareholders 8:00 am - 10:00 am	5	6
7	8	9	10	11	12	13
14	15	16 Pension Reforms - Part II 8:00 am - 10:00 am	17	18 Strategic Considerations in Acquisitions by State Owned Enterprises 8:00 am - 10:00 am	19	20
21	22	23	24 Wrongful Dismissal - New Issues and Recent Cases 8:00 am - 10:00 am	25	26	27
28	29	30				

