



Intellectual Property Officer

Bio-economy Skills Profile Summary

Intellectual Property Officers are responsible for registering trademarks, applying for patents, registering copyrights, defending intellectual property, guarding trade secrets and deciding to patent inventions and technology. They use their legal and scientific knowledge or work with legal and business development departments to negotiate and draft agreements as well as to ensure that contractual obligations are met.

Learn more about the role of Intellectual Property Officer by downloading the full skills profile for free at www.biotalent.ca/profiles.



Building skills for Canada's bio-economy

Intellectual Property Officer



BioTalent Canada's Bio-economy Skills Profiles

Biotechnology's fusion of science and business creates unique requirements for jobs in the sector. Candidates often need skills suited both to the lab and the boardroom. As a result, occupational descriptions from other sources or sectors don't always fit the bio-economy exactly. That's why, in partnership with industry stakeholders, BioTalent Canada has developed skills profiles specific to the bio-economy—a project that will continue with the ongoing addition of other functions over time.

Each profile includes a definition of the occupation, a list of competencies and associated tasks, a summary situational analysis, language benchmarks, and essential skills.

Who can use these profiles?

Easy to use and interpret, our *Bio-economy Skills Profiles* were created to meet the needs of a wide range of audiences. Here's how you might use them if you're an:

Employer: Develop job descriptions, performance evaluation criteria, professional development programs, succession plans, team building initiatives and recruitment plans.

Job seeker: Identify your professional development needs, tailor your resume for a specific position, prepare for interviews and interpret job descriptions.

Educator: Build industry-oriented curricula to help produce job-ready graduates.

Student: Grow your understanding of employers' expectations and choose the right educational programs to equip yourself with the skills for success.

Validated by industry

BioTalent Canada created its *Bio-economy Skills Profiles* in consultation with industry to accurately capture the needs of biotechnology companies and produce truly practical, relevant resources. These profiles summarize the high-level skills required for each occupational profile and itemize in detail the common tasks associated with each function. Because the profiles are comprehensive, not every skill may be required for a single position: instead, the profiles present the full sets of skills that could be expected of a person in a given role within companies at various stages of development.

Information you can trust

BioTalent Canada is the country's source for reliable, objective and accurate information on skills development and human resources in the bio-economy. Our aim as Canada's biotechnology sector council is to deliver the human resources tools, information and skills development resources industry needs to ensure an adequate supply of job-ready people.

Understanding the bio-economy

Canada's bio-economy is engaged in the research, development, commercialization and manufacturing of biotechnology products. The bio-economy is constantly expanding as new technologies and techniques are applied to an ever-broader range of industries and sectors including:

| | |
|-----------------|-------------------|
| Agriculture | Genomics |
| Aquaculture | Human Health |
| Bioenergy | Industrial |
| Bioinformatics | Life Sciences |
| Bioproducts | Medical Devices |
| Biosciences | Nanotechnology |
| Environment | Natural Resources |
| Food Processing | Nutraceuticals |
| Forestry | Pharmaceuticals |

Get started today

Even before you download the full Intellectual Property Officer Skills Profile, get a sense of the information it contains and how you might use it in your work. Attached here is a quick-reference checklist that summarizes the core skills required for the position and the common tasks associated.



Go to www.biotalent.ca/profiles and download the complete skills profile.

Job incumbents should possess an undergraduate and graduate or higher-level degree in an applicable scientific field to work effectively in the bio-economy. A law degree and/or a degree in Business Administration are not always required, but are highly complementary to the function.

An Intellectual Property Officer must be able to:

A. Develop intellectual property strategy

- 1. Align intellectual property strategy with business strategy or align business strategy with intellectual property strategy, as required
- 2. Maximize the period of exclusivity for products
- 3. Align intellectual property protection with marketing strategy
- 4. Align intellectual property protection with manufacturing strategy
- 5. Align intellectual property strategy with clinical and regulatory strategy
- 6. Decide what intellectual property to develop versus in-license, as required
- 7. Capture and support intellectual property from research and development activities
- 8. Guide or inform research and development activities
- 9. Advise on research and development efforts to maximize return on investment, as required
- 10. Identify defensive publication opportunities
- 11. Identify trade secret information
- 12. Identify opportunities for improvement patents
- 13. Identify opportunities for defensive patents
- 14. Identify intellectual property risks and opportunities
- 15. Keep abreast of changes to patent laws and case law

B. Identify all intellectual property assets

- 1. Review company research for inventions, as required
- 2. Identify commercial applications of research findings
- 3. Evaluate internal invention disclosures
- 4. Identify industrial designs, as required
- 5. Identify trademark strategy
- 6. Identify possible copyrights
- 7. Review marketing materials for trademarks, copyrights and design patents, as required
- 8. Identify domain name registration for the internet

C. Evaluate intellectual property

- 1. Conduct freedom to operate assessment
- 2. Review prior art
- 3. Conduct patentability analysis
- 4. Conduct infringement analysis
- 5. Conduct competitive analysis, as required
- 6. Perform valuation on own and external intellectual property, as required
- 7. Assist in review of licensing deals as they relate to intellectual property terms/provisions

- 8. Assist in review of financing deals as they relate to intellectual property terms/provisions
- 9. Conduct trademark search
- 10. Review and maintain domain names
- 11. Conduct periodic review of intellectual property portfolio for non-interest
- 12. Carry out periodic review of portfolio for management to advise on intellectual property for out-licensing

D. Draft and file intellectual property

- 1. Assess nature and type of intellectual property
- 2. Identify countries where intellectual property protection is desired, as required
- 3. Estimate the costs of intellectual property protection options
- 4. Determine filing strategy
- 5. Draft patent applications
- 6. Draft industrial design applications
- 7. Draft trademark applications
- 8. File patent applications, as required
- 9. File industrial design applications, as required
- 10. File trademark applications, as required

E. Co-ordinate intellectual property registrations and applications

- 1. Perform cost-benefit analysis regarding the use of external counsel
- 2. Monitor costs and review invoices
- 3. Enter countries where intellectual property protection is desired
- 4. Ensure consistency among foreign applications
- 5. Provide instructions to counsel
- 6. Consult with inventors during prosecution
- 7. Provide documentation required to complete intellectual property applications
- 8. Monitor and prosecute filed applications

F. Establish company intellectual property policies

- 1. Review employment contracts, if required
- 2. Establish and ensure compliance with research documentation standards
- 3. Review proposed company publications
- 4. Implement invention disclosure procedures
- 5. Develop basic intellectual property education system for all employees
- 6. Assist development of appropriate reward system for new intellectual property, as required

G. Enforce intellectual property and defend against third party intellectual property actions

- 1. Review patents and applications filed by other companies
- 2. Monitor competitors' activities
- 3. Draft, cease and desist letters

- 4. Respond to cease and desist letters, as required
- 5. Engage litigation counsel
- 6. Co-ordinate litigation proceedings, as required
- 7. Interfere in prosecution of third-party patents
- 8. Impeach/Revoke patents
- 9. Respond to and send notices of allegation, as required
- 10. Negotiate settlement agreements, as required
- 11. Advise on design around third-party patent claims
- 12. Ensure patents are listed on the appropriate regulatory register, if applicable

H. Leverage intellectual property

- 1. Support identification of strategic alliances
- 2. Negotiate and draft research and development agreements
- 3. Negotiate and draft material transfer agreements
- 4. Negotiate and draft license agreements, as required
- 5. Ensure compliance with intellectual property terms in license agreements
- 6. Support negotiation of sale or purchase of intellectual property

I. Demonstrate personal competencies

- 1. Manage multiple tasks
- 2. Demonstrate attention to detail
- 3. Manage sensitive information
- 4. Set priorities
- 5. Make informed decisions
- 6. Seek help when needed
- 7. Demonstrate teamwork
- 8. Demonstrate strategic planning
- 9. Participate in continuous learning
- 10. Display interpersonal skills
- 11. Solve problems
- 12. Build strategic inter- and intra- company relationships
- 13. Demonstrate sensitivity to individual and group dynamics
- 14. Take responsibility
- 15. Demonstrate commitment
- 16. Maintain professional integrity

J. Communicate

- 1. Communicate with diverse audiences
- 2. Develop networks
- 3. Negotiate
- 4. Motivate colleagues to meet deadlines
- 5. Make presentations
- 6. Apply industry terminology