

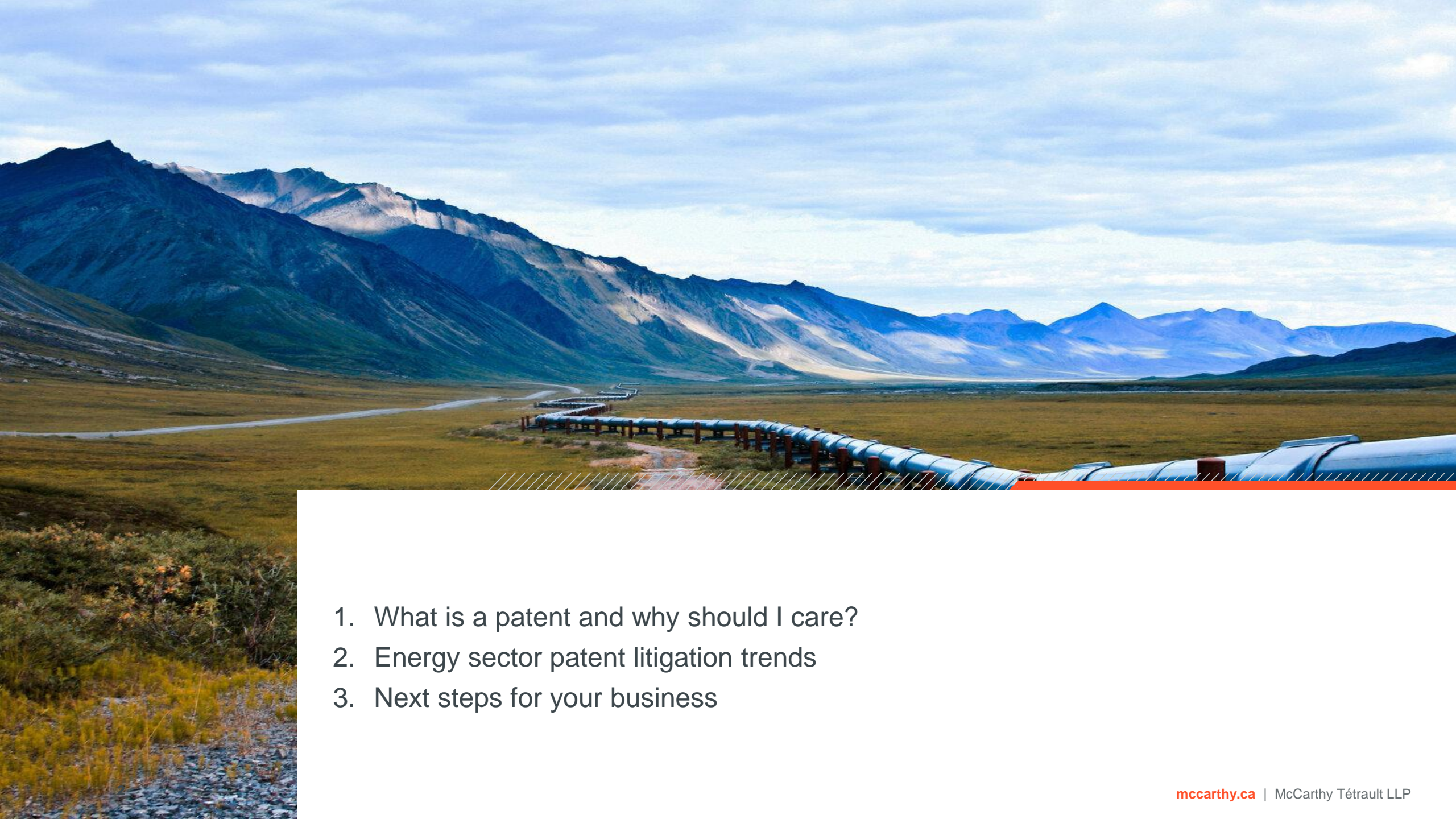


Patent Litigation in the Energy Sector: Insights and Strategies from the Last Decade

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1. What is a patent and why should I care?
2. Energy sector patent litigation trends
3. Next steps for your business

What is a patent and why should I care?

- Patents claim an invention.
- Claims must be new, useful and non-obvious.
- Almost any technical advancement can be claimed and therefore the subject of patent protection.
- Patents provide a time-limited right to exclude others from doing what the patent claims.
- All business should care because:
 - Patents can prevent or remove competition from the market.
 - Patents can generate significant financial compensation.

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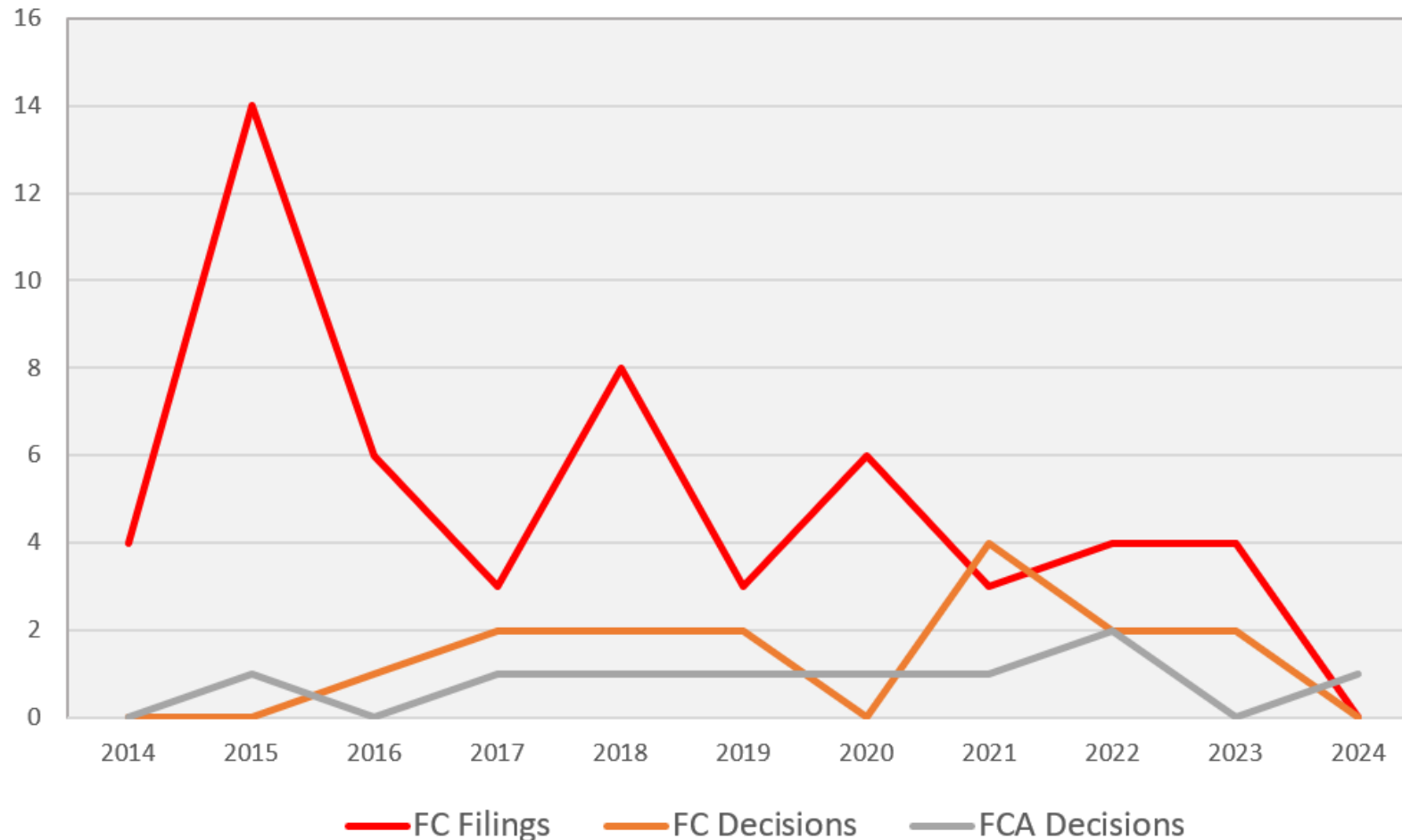
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(54) Titre : SYSTÈME DE GÉNÉRATION D'ALIMENTATION HYBRIDE À PILE À COMBUSTIBLE ET PROCÉDÉ POUR SYSTÈMES DE DISTRIBUTION DE GAZ
(54) Title: FUEL CELL HYBRID POWER GENERATION SYSTEM AND METHOD FOR GAS DISTRIBUTION SYSTEMS

(57) Abrégé/Abstract:
A fuel cell hybrid power generation system and method used in a gas distribution system in which a higher pressure gas is transported/distributed and reduced to a lower pressure gas for a gas distribution or transmission line and a pre-heater is used to heat the higher pressure gas before it is reduced in pressure. The fuel cell hybrid power generation system has an energy recovery generator responsive to the pre-heated higher pressure gas and adapted to reduce the pressure of the pre-heated higher pressure

Oil & Gas Patent Federal Court Filings and Decisions (2014-2024)



Based on our 10-year review, what can your business do to reduce patent infringement risk?

Ownership Agreements

—Focus on **broad assignments** of the **right and title** of discoveries, **inventions**, patent applications and patents developed **during and beyond** the period of employment or contractual engagement.

—**Example clauses:** obligation to disclose patents; covenant not to incorporate inventions created outside of work into work product; obligation to assist with documenting assignment to the employer.

—**Sample IP assignment clause that did not transfer ownership:**

“[a]ny intellectual property developed by the Employee in the course of the discharge of the Employee’s employment duties is the property of the Corporation”

“Working on” the subject matter of the patents was not equivalent to “developing of an invention in the course of the discharge of his employment duties”.

Detailed Record-Keeping

— Why keep records?

- To help establish ownership of the invention.
- To help demonstrate an invention was not obvious by establishing the time, effort and expense required for its development.
- Defensively, to show that a company was already doing what the patent claims prior to the patent.

— Records to keep in mind:

- Reports and summaries.
- Timesheets and logs showing time spent and materials used.
- Financial documents showing costs incurred.

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Relevant time period:

- The limitation period that usually applies to patent litigation is 6 years.
- Documents created pre-filing and throughout the 20-year patent term may be relevant.
- An extended document retention policy may be useful.



Due Diligence

— **Ongoing due diligence can include:**

- Monitoring patent applications being published.
- Monitoring patents being granted.

— **Due diligence during transactions can help determine:**

- Patent portfolio value.
- Patent and patent application ownership and file history.
- Freedom-to-operate and whether patents are being asserted by others against the newly acquired company.

Settlement Considerations

— Settlement may be beneficial where:

1. Litigation risks a negative result that impairs the business, e.g., an injunction.
2. The company wishes to devote resources to other projects. Patent disputes can be time consuming.
3. The settlement offer is too good to pass up.

— Settlement may be counterproductive where:

1. It encourages new patent lawsuits.
2. Settlement terms will be shared despite confidentiality provisions.
3. The case is strong.

Cooperation May Assist Companies

- Companies facing a common opponent may benefit from a coordinated response even if only one company has been sued.
- Consider joint defence agreement or less formal cooperation.
- Cooperation may include:
 1. Providing access to employees who may be fact witnesses / experts.
 2. Providing helpful documents, e.g. prior art that could invalidate an opponent's patent.
 3. Financial assistance to ensure a robust defence.

Thank you.



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