

## Senior Counsel, Intellectual Property

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**Company:** pharmaceutical industry

**Location:** Montreal

### SUMMARY

The Senior Counsel, Intellectual Property, will be responsible for IP counseling and activities designed to enhance patent protection and clearance of the company's licensed and developed products, including securing IP relating to new technologies, indications, combinations, formulations, manufacturing, and other innovations and providing a global perspective on IP matters and policy to country and regional operations; advising on data protection and other forms of exclusivity; ensuring freedom to operate guidance is timely provided; providing due diligence and transactional support; and supporting court and administrative litigation efforts.

### ROLES AND RESPONSIBILITIES

Advise and counsel clients on various IP matters involving patents, trademarks, trade secrets and copyrights, including:

- Managing the in-house IP team
- Managing the company's IP portfolio, including preparation and prosecution of U.S. and foreign patent and trademark filings
- Supporting internal litigation on IP-related proceedings, challenges, disputes and litigation
- Leading prior art and white space research including web, patent, and literature searches, and providing legal opinions regarding patentability, validity, and freedom-to-operate
- Leading intellectual property due diligence to support business development transactions
- Drafting, negotiating, interpreting and advising clients on intellectual property provisions in various agreement such as non-disclosure agreements, license agreements, manufacturing agreements, and supply agreements
- Conducting and enhancing IP-related processes and protections, including portfolio reviews and long-range planning, patent review committee, invention disclosures and pre-publication review
- Identifying and navigating patent and trademark opportunities and risks worldwide for business, programs and operations
- Counseling key stakeholders in the management of the IP portfolio for lead asset as well as generic and innovative research and development programs
- Proactively counseling all levels of the organization on IP matters, ranging from broad strategic objectives to day-to-day collaboration with and input to research and development groups and teams
- Educating staff about the invention and commercialization process, supporting IP commercialization process and driving interest and engagement in innovation across the organization and implementing processes to respect the IP rights of others
- Staying current with relevant legal developments

### QUALIFICATIONS

- Law degree from a Canadian approved law school required with excellent academic credentials preferred

- Admission (or ability to be admitted) to practice law in Quebec, Ontario preferably but other provinces or US states will be considered
- Must be registered to practice before the USPTO
- 10 or more years of patent attorney experience in the pharmaceutical industry or closely related patent areas, including some in-house experience, as well as an advanced degree and/or strong academic credentials in the sciences
- Experience in preparation and prosecution of patent applications
- Demonstrates knowledge and understanding of relevant IP and legal principles
- Sees the “big picture”; analyzes problems thoroughly and capably; interprets jurisprudence and legislation to look at issues in a novel way and applies these skills to provide solutions and advice
- Acts as a strategic advisor by asking questions and diligently approaching clients’ matters to understand their business needs, including to help solve unexpressed needs
- Delivers superior client service and is responsive to client and stakeholder needs and expectations
- Has ability to make complex or abstract ideas or situations clear and understandable
- Stimulates an environment that fosters creative thinking and solutions
- Draws on resources from across the firm, where possible, to provide the highest level of service to clients
- Brings positive energy to work teams and the office
- Acts as a self-starter, energetic, positive, analytical, able to drive results, and has a proven ability to work as part of a cross-functional team
- Maintains integrity, professionalism and high ethical and personal standards
- Exhibit initiative and assertiveness including the ability to work with minimal supervision
- Proficiency in Microsoft Office, especially Word and Excel

***Please note that only candidates selected for interviews will be contacted.***

## **CONTACT INFORMATION**

Please forward your CV/résumé, in confidence, to SHORE & Associates:

Michel Ohayon: [mohayon@shoreassoc.com](mailto:mohayon@shoreassoc.com) – 514-878-4777