

## Serge Shahinian, Ph.D.

### Partner - Patent Agent - Co-leader of the Intellectual Property Group

Serge Shahinian is a partner and patent agent in Lavery's intellectual property group. He is a registered patent agent in Canada and the United States and has been practicing in the intellectual property field since 2000, following prior doctoral and post-doctoral training in biochemistry, biology, and genetics.

Serge's practice includes the areas of biotechnology, pharmaceutical and chemical, covering a wide range of related technologies in the health, agricultural, food, environmental and industrial sciences. He works with a full range of clients including universities and public research institutions, small and medium sized companies, and large multinational corporations, helping them develop and execute intellectual property strategies oriented towards their business goals. His practice includes the procurement of patent rights in domestic and foreign jurisdictions, as well as opinions and counselling in patentability, validity and infringement matters. He also works closely with our litigation group providing support on patent matters. He further has experience in due diligence in the context of transactions and financing in the biotechnology and pharmaceutical sectors.

Serge is recognized as one of the World's Leading Patent Professionals, **IAM Patent 1000**, 2019 - 2023.



## Publications

- Shahinian, S. and Carpentier, M., *Jurisclasseur Québec – Propriété Intellectuelle – Fascicule 22 – “Formalités et processus administratif du dépôt”*, 2013-present, Lexis Nexis
- Shahinian, S. and Dumont, A., *Jurisclasseur Québec – Propriété Intellectuelle – Fascicule 23 – “Brevetabilité et définition de l’invention”*, 2013-present, Lexis Nexis
- Shahinian, S., Leclerc, A. and Gauvreau, J. “Changes to the Canadian Patent Rules coming into force on October 30th 2019”, *Lavery Newsletter*, October 25, 2019
- Shahinian, S. and Leclerc, A., “Ready, set go! Changes to Canadian patent practice coming into force later this year”, *Lavery Newsletter*, July 10, 2019
- Duffy, J., Jomphe, I., and Shahinian, S. “The United States–Mexico–Canada Agreement (USMCA): What this means for Canadian IP law”, *Lavery Newsletter*, November 1, 2018
- Shahinian, S. “Use it and (maybe) lose it: Prior use and patentability”, *Lavery Newsletter*, October 5, 2018

Dumont, A. and Shahinian, S. "Medical use claims not involving the professional skill of a physician are patent-eligible in Canada", GGDData Newsletter, August 1, 2017

Shahinian, S. and Lavin, G. "Getting on the fast track: Accelerating patent examination in Canada", GGDData Newsletter, May 10, 2017

Shahinian, S. and Duffy, J. "Exemptions to infringement for research under Canadian law", GGDData Newsletter, January 23, 2017

Shahinian, S. and Dumont, A., "Double Patenting Under Canadian Patent Law", GGDData Newsletter, December 7, 2016

Leclerc, A. and Shahinian, S. "Tax relief to stimulate commercialization of intellectual property made in Québec", GGDData Newsletter, March 23, 2016

Shahinian, S. "Canadian national phase still possible for last-minute pre-AIA cases!", GGDData Newsletter, September 30, 2015

Shahinian, S. and Dumont, A., "Recent developments on patent-eligibility of medical use claims in Canada", GGDData Newsletter, April 7, 2015

Mansfield, H., Shahinian, S., "Amazon.com patent application: Still 'clicking' its way through the Canadian authorities", GGDData Newsletter, November 2011, Vol. 11, No. 3

Leclerc, A., Shahinian, S., "Canada fast-tracks 'greentech' patent applications", GGDData Newsletter, March 2011, Vol. 11, No. 1

Lavin, G., Shahinian, S., "Business method patents are just 'one-click' away in Canada", GGDData Newsletter, October 2010, Vol. 10, No. 1

Shahinian, S., Silviu, J.R., "High-yield coupling of antibody fab' fragments to liposomes containing maleimide-functionalized lipids", Methods in enzymology Journal, Vol. 387, p. 3-15, 2004

"L'importance de la demande provisoire", Trans Script, Vol. 2, No. 4, Winter 2004

Levinson, J.N., Shahinian, S., Sdicu, A.-M., Tessier, D.C., and Bussey, H. (2002), "Functional, comparative and cell biological analysis of *Saccharomyces cerevisiae* Kre5p", Yeast 19: 1243-59

Roopchand, D.E., Lee, J.M., Shahinian, S., Paquette, D., Bussey, H., Branton, P.E. (2001), "Toxicity of human adenovirus E4orf4 protein in *Saccharomyces cerevisiae* results from interactions with the Cdc55 regulatory B subunit of PP2A", Oncogene 20: 5279-90

Shahinian, S., and Bussey, H. (2000), " $\beta$ -1,6-glucan synthesis in *Saccharomyces cerevisiae*", Mol. Microbiol. 35: 477-89

Shahinian, S., Dijkgraaf, G.J.P., Sdicu, A.-M., Thomas, D.Y., Jakob, C., Aebi, M. and Bussey, H. (1998), "Involvement of protein N-glycosyl chain glucosylation and processing in the biosynthesis of cell wall beta-1,6-glucan of *Saccharomyces cerevisiae*", Genetics 149: 843-856

Shahinian, S. and Silviu, J.R. (1995), "A novel strategy affords high-yield coupling of antibody Fab' fragments to liposomes", Biochim. Biophys. Acta 1239: 157-67

Shahinian, S. and Silvius, J.R. (1995), “Doubly lipid-modified protein sequence motifs exhibit long-lived anchorage to lipid bilayers”, *Biochemistry* 34: 3813-22

## Conferences

“From Canola to Cannabis: A Growing Interest in Plant Protection”, Licensing Executives Society, November 15, 2018

“(Show Me the Money!) Monetizing Intellectual Capital and Intangible Assets”, 93<sup>rd</sup> IPIC Annual Conference, September 2019

“Opposing Patents on Opposite Sides of the World”, 92<sup>nd</sup> IPIC Annual Conference, October 2018

“CA Update: Life Sciences”, FICPI ABC 2017 Conference, Miami, March 2017

“Patentability: Dealing with Challenges in IT and Life Sciences”, 90th IPIC Annual Meeting, September 2016

“What is Considered Patent Prior Art in the ABC Countries: A Comparative Review”, FICPI ABC 2016 Conference, Wales, June 2016

“Patent Agent Exam Prep: Paper B & Paper D”, IPIC, March 22, 2017, and March 11, 2016 (webinar)

“Strategies for Securing Patent Protection in Europe”, IPIC, October 16, 2013 (webinar)

“Too much? Too little? Just right? Increased Scrutiny of the description and the goldilocks syndrome”, 87th IPIC Annual Meeting, September 2013

“US Supreme Court Decision– Association for Molecular Pathology c. Myriad Genetics, Inc.” IPIC, July 9, 2013 (webinar)

“The promise in Canadian patents, a recipe for disaster?”, joint presentation by Shahinian, S. and Gravelle, L.-P., at the FICPI ABC 2013 Conference, New Orleans, May 2013

“Myriad Genetics and Patenting Human Genes”, Shahinian S. and Gold, R., Conference on McGill Podcasts, McGill University, Montreal, June 2013

“The evolution of patenting in the life sciences: Where have we come from and where are we going?”, Centre for Intellectual Property Policy, Faculty of Law, McGill University, Montreal, January 2013

“Ownership and Transfer of IP Rights in Technology Transfer”, IPIC, October 6, 2011 (webinar)

“Managing Your Client Relationships”, IPIC, June 9, 2011 (webinar)

“Patenting diagnostic inventions: An international perspective”, with Julie Gauvreau, AUTM 2011 Annual Meeting, February 27-March 2, 2011, Las Vegas, NV (poster presentation)

“Workshop on career development”, ENU-CTG, McGill University, December 10, 2010 (panel presentation)

“The art of protecting life science inventions”, AUTM 2010 Annual Meeting, March 18-20, 2010, New Orleans, LA (panel presentation)

■ “Digging deeper into patent grace periods”, with Julie Gauvreau, AUTM 2009 Annual Meeting, February 12-14, 2009, Orlando, FL (panel presentation)

■ “*Le monde des brevets*”, *BioConnexion*, Université Laval, 2004 and 2005

■ “*Les brevets dans le domaine de la biotechnologie*”, *Parc Technologique du Québec Métropolitain*, 2003

## Professional and community activities

■ IRCM, Dragon Boat Race, September 2016

## Distinctions

Recognition in the IAM Patent 1000: The World’s Leading Patent Professionals, 2019-2023

## Education

■ Post-Doctoral Fellowship, Biology, McGill University, 1999

■ Ph.D., Biochemistry, McGill University, 1996

■ B.Sc., Biochemistry, University of Toronto, 1988

## Boards and Professional Affiliations

■ Member of the Executive Committee of the firm (Lavery Lawyers)

■ Intellectual Property Institute of Canada (IPIC)

■ Member, Forums and Seminars Committee, 2011-2013, 2015-2019

■ Member, Biotechnology Patents Committee, 2011-2013

■ Chair, Technology Transfer Committee, 2011-2013

■ Vice-chair, Technology Transfer Committee, 2009-2011

■ Member, Technology Transfer Committee, 2005-2009

■ Member, Biotechnology Legislation Committee, 2001-2002

■ *Fédération Internationale des Conseils en Propriété Intellectuelle*(FICPI)

■ Secretary, FICPI Canada, 2018-2021

■ American Intellectual Property Law Association (AIPLA)

■ Licensing Executives Society

■ The Association of University Technology Managers (AUTM)

■ College of Patent Agents and Trademark Agents (CPATA)