



CONTACT

jmarles@patentable.com
tel 604.669.3432 Ext. 8967

JENNIFER A. MARLES*

Counsel | M.Sc. (Biochemistry)

Jennifer helps clients in the biotechnology, chemical and medical device industries build the value of their companies by securing patent protection in Canada, the United States, and beyond. Jennifer also assists clients with technology licensing, handling investor due diligence and evaluating their freedom to practise their technology. At all times, Jennifer tries to be aware of her clients' commercial goals and budgetary constraints, and she enjoys the rigors of learning about their new technologies.

Jennifer's clients include a broad range of early stage and established companies and universities. She has helped her clients to patent inventions such as safety syringes, natural pesticides, new formulation technologies, and electrical safety equipment on a global basis. Jennifer has filed many provisional and PCT applications, and has assisted clients with optimizing their intellectual property protection strategy globally, including handling IP-related issues in China in conjunction with Chinese counsel.

Jennifer's accolades include being awarded the Law Society Gold Medal for graduating at the top of her law school class in 2006, being awarded the J. Edward Maybee Memorial prize for achieving the highest overall mark on the patent agent examinations in 2009, being named as a Lawyer to Watch by Lexpert in 2019, and being acknowledged by Best Lawyers in 2020 for intellectual property law in Canada.

Jennifer is an advocate for education and continuous improvement in the legal and patent agent professions, serving on the Patent Practice Committee (a joint committee between the CIPO and the patent agent community focussed on practice improvement), on the Patent Agent Examination Board, and as an adjunct professor at the Peter A. Allard School of Law at the University of British Columbia.

TECHNICAL EXPERTISE

Biotechnology
Chemistry
Materials Science
Mechanical

LEGAL SERVICES

Patents
Trademarks
Copyright
Industrial Designs
IP Transactions & Licensing
Strategic IP Counselling & Portfolio Management
Domain Names & Internet Law
Trade Secrets & Unfair Competition

EDUCATION

B.Sc. (Honours Biochemistry), University of British Columbia, 2001
M.Sc. (Biochemistry), University of Toronto, 2003
LLB, University of Victoria, 2006

BAR LOCATIONS

Called to the British Columbia Bar, 2008
Registered Patent Agent (CA & US)
Registered Trademark Agent (CA & US)

REPRESENTATIVE MATTERS

- › IP counsel to a local medical device company throughout both the development of its IP portfolio and the due diligence involved in the offering for sale of that IP portfolio.
- › IP counsel to a local chemical company engaged in the development of environmentally friendly pesticides and agrochemicals.
- › Work with the technology transfer offices of universities and research institutions to protect their inventions.
- › Assisted with evaluation of freedom-to-operate issues for a client in the field of carbon capture.
- › Assisted clients with the filing of protest submissions of prior art and re-examination of patents to help ensure their freedom-to-operate.

EVENTS/SPEAKING

- › How Artificial Intelligence is Changing the Intellectual Property Landscape
April 26, 2023
- › Top 10 Intellectual Property Cases of 2021
February 23, 2022
- › CBA – Intellectual Property & Technology Law Session
February 3, 2021
- › GOVERNMENT USE OF PATENTED INVENTIONS – IMPLICATIONS FOR COVID AND BEYOND
July 7, 2020
- › WEBINAR – Government Use of Patents During COVID – Essential Knowledge
April 28, 2020
- › Taking Your Patent Portfolio Global
April 16, 2019
- › Grow Your Assets – Intellectual Property for the Cannabis Industry: Are you Ready?
February 21, 2019
- › Start Smart with Oyen Wiggs & Small Business BC
September 19, 2018
- › Start Smart with Oyen Wiggs & Small Business BC
June 20, 2018



- Powering Change: Setting Women up for Success in the IP Profession
June 4, 2018
- IP Protection for the Cannabis Industry
May 10, 2018
- Panning for Gold in the Green Rush: IP Protection for the Burgeoning Marijuana Industry
December 8, 2017
- Updating your Toolkit for Fighting Obviousness Issues Post-Sanofi
October 12, 2017
- Meet you at RESI San Diego 2017
June 19, 2017
- Patent Primer for the Life Sciences: Patent Disclosure Requirements
June 8, 2017
- Intellectual Property Workshop with Small Business BC
March 24, 2017
- Update on Canadian Patent Practice
March 21, 2017
- “Purposively Construing the Boundaries of Patentable Subject Matter in Canada: Diagnostic Methods as an Example”, Canadian Bar Association, BC Branch Intellectual Property & Technology Law Section Meeting – (15 June 2016, Vancouver)
- “IP Law for The Non-IP-Lawyer”, Canadian Bar Association, BC Branch and Victoria Bar Association Meeting – (24 September 2014, Victoria)
- “Balancing Disclosure and Monopoly in Canada–The Promise Doctrine”, Inter-Pacific Bar Association Annual Meeting and Conference – (14 April 2014, Vancouver)
- “Primer on Canada’s New Anti-SPAM Law (CASL)”, Canadian Bar Association, BC Branch – (18 February 2014, Webinar)
- “IP Law for The Non-IP-Lawyer”, Canadian Bar Association, BC Branch – (20 November 2013, Webinar)

ASSOCIATIONS

- Law Society of British Columbia
- Canadian Bar Association



- › Intellectual Property Institute of Canada (IPIC)

PUBLICATIONS

- › An Overview of European Unitary Patents and the Unified Patent Court
- › Recent Wins for DABUS – Patenting in an Era of Artificial Intelligence
- › China’s New Patent Law – Updates on Patent Term Adjustment and Patent Term Extension
- › CIPO Tackles Pending Trademark Application Backlog with New Practice Notices
- › U.S. Supreme Court Rules Google’s copying of Oracle’s code of permissible “Fair Use”
- › Choueifaty Patent Application Contains Patentable Subject Matter, Patent Appeal Board Rules
- › An Introduction to Novel mRNA Vaccine IP and Some Canadian Connections
- › CHINA’S NEW PATENT LAW TO STRENGTHEN IP PROTECTION
- › Patenting personalized medicine in Canada: navigating choppy waters
- › U.S. Supreme Court Rules BOOKING.COM Is Not Generic and Imposes No Categorical Rule against Registration of “generic.com” Marks
- › Impact of COVID-19 on Patent Deadlines
- › An Effective IP Strategy? – Patenting Treatment for COVID-19 Infections
- › US-China Phase One Trade Deal: Stronger China IP Regime in the Making
- › Welcome to the New Patent Law in Canada!
- › Parody Cannot be Relied on as a Defence to Copyright Infringement if it Causes Marketplace Confusion
- › Protecting IP in China: The Utility Model Opportunity
- › Building a Defensive Trademark Portfolio to Protect Cannabis Brands
- › Moral Rights in Canada



- › Pharmaceutical Patents and Canada’s Prohibition on Patenting Methods of Medical Treatment: A Predictable Pattern to Follow?
- › Top Reasons to File in Canada
- › FOCUS ON MEDICINAL CANNABIS: IP PROTECTION FOR THERAPEUTIC USES
- › Patent Term Extension: Now Available in Canada
- › Federal Court of Appeal Decision Means Lower Costs for Copyright Owners Seeking the Identity of Alleged Infringers
- › 5 Tips for Protecting your Startup’s Intellectual Property
- › Got a New Plant Variety? There’s an Act for That!
- › Growing Popularity of eSports Raises New Copyright Issues
- › Is a Marijuana IP Gold Rush Coming to Canada?
- › Can You Stream Your Way Around Copyright Infringement in Canada?
- › An Uncertain Prognosis for the Patentability of Diagnostic Methods in Canada
- › Canadian Anti-Spam Legislation is Coming Into Force...Are You Ready?
- › Canadian Federal Courts Consider When “Prior Use” Invalidates a Patent
- › Promises, Promises...An Old Legal Doctrine Poses Difficulty for Canadian Patentees
- › Patent Prosecution 2.0 – Third Party Submissions of Prior Art
- › Supreme Court of Canada Paves the Way for Generic Version of Viagra™
- › Take Advantage of Proposed Changes to Canadian Trade-marks Regulations – Non-Traditional Trade-marks
- › A Big Year for Copyright in Canada
- › Buonassisi, A.D. and Marles, J.A. “Potential Copyright Liability for the Use of ‘Free’ TV Streaming Devices in Canada”, 2017, 33 CIPR 123.
- › Law, G.S., Marles, J.A. “Monsanto v. Schmeiser: patent protection for genetically modified genes and cells in Canada.” Health Law Rev. 2004, 13(1):44-7.



- Marles, J.A., Dahesh, S., Haynes, J., Andrews, B.J., Davidson, A.R. "Protein-protein interaction affinity plays a crucial role in controlling the Sho1p-mediated signal transduction pathway in yeast." *Mol. Cell.* 2004, 14(6):813-23.
- Jahn, M., Chen, H., Mullegger, J., Marles, J., Warren, A.J., Withers, S.G. "Thioglycosynthases: double mutant glycosidases that serve as scaffolds for thioglycoside synthesis." *Chem. Commun.*, 2004, (3):274-5.
- Jahn, M., Marles, J., Warren, R.A., Withers, S.G.. "Thioglycoligases: mutant glycosidases for thioglycoside synthesis." *Angew Chem Int Ed Engl.* 2003, 42(3):352-4

