



Shohini Bagchee, P.Eng., Patent Agent

in

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Overview

Shohini Bagchee, P.Eng., M.Eng. (Chemical), is a patent agent based in Field Law's Edmonton office. Shohini's primary focus is providing clients with counsel in the area of patent procurement.

Shohini's previous career as an engineer allows her to deliver counsel to her clients that is supported by solid academic and industry credentials, and takes into account the legal and business aspects of their patent protection. Many of Shohini's clients are based in the oil and gas industry, and range from downhole equipment and service companies, and clients in the areas of petrochemicals, bio-fuels, food science, fine chemicals, nanotechnology, agriculture, mining, environmental, biotech, materials and metallurgy.

Shohini's role as a patent agent provides her with the opportunity to support her clients' business goals in a number of ways, including:

- Filing for and prosecuting patents before the Canadian, US and PCT patent offices
- Conducting searches for patentability, infringement and freedom to operate
- Providing clients with industrial design patent services
- Supporting clients throughout the IP due diligence process, including the assessment of patents for purchase or sale
- Conducting IP portfolio management for clients and developing IP prosecution strategies to further international IP protection and enforcement, and
- Consulting with clients on the development of company IP policies.

Shohini's sophisticated, broad technical knowledge is complimented by solid writing and oral advocacy skills, which enables her to help clients across a broad spectrum of technology sectors. Clients with intellectual property interests that span the Canada-US border receive seamless patent support from Shohini, who is registered to practice before the Canadian Patent Office and the United States Patent Office.

Value to Clients

"I place a great importance on openness with my clients and build my relationships with them by providing two-way counsel that actively considers their patent needs and understands their business goals. By being

Industries

Energy + Environment
Technology

Services

Intellectual Property + Technology

Education

University of Ottawa, 2001, Master of Engineering
University of Alberta, 1996, Bachelor of Science, Engineering

Languages

Bengali

approachable and eager to understand exactly what brought my clients to me, I can provide counsel that is customized and goal oriented.”

Outside the Office

Shohini’s time outside of the office is spent engaging with her community. Whether she’s catching live, local music or volunteering her time, Shohini enjoys connecting with others. When she isn’t out and about, she’s indulges in her love of reading.

Experience

IP solutions to meet business goals

IP Strategy

To patent or not to patent?

Professional

Intellectual Property Institute of Canada (IPIC)

Fellow

2001 - Present

APPEGA

Member/P. Eng

1996 - Present

Community

Board of Directors, Events Edmonton, producers of the Taste of Edmonton Festival, 2012-Present

Sole and Small Practice Committee - Member, IPIC, 2009-Present

Client Stories

IP solutions to meet business goals

Shohini’s client, an oil and gas equipment and service provider based in Western Canada, successfully resolved a patent infringement suit. During the process, they took stock of their own IP portfolio and quickly realized that the patent protection of their own technology was sorely lacking. They approached Field Law, looking for ways to have patentability and freedom to operate play a more prominent role in their product development process.

Shohini reviewed their technology, prioritized devices and methods for patent review, prepared and filed patent applications and provided an overview of the current patent landscape. This overview identified opportunities for her client. As the relationship evolved, Shohini started to provide patent strategy, proactively advising when and where to file for protection to best meet their business goals.

As a result, the client now has a robust portfolio of patent protection with patents granted or pending in all key markets. They have also been able to work on developing tools and systems with patentability in mind, giving them the edge in a very competitive market.

The importance of an IP strategy

Having worked with an international medical equipment manufacturer to obtain a couple of patents, Shohini was the first to receive a call when they received a cease and desist letter from a competitor. Her client needed confirmation of freedom to operate and they needed to reconsider the role IP played in their industry.

Shohini reviewed the competitor’s patents and determined that the patents were most likely invalid for obviousness reasons. She responded as much to the competitor and the client was not bothered again.

This shifted their focus. With the client now understanding the value of a robust patent strategy, Shohini helped them decide what they could patent and prepared and filed for patent protection in key technology areas. The client now has a patent portfolio that covers their target products and product areas and meets regularly with Shohini to review their overall IP portfolio.

To patent or not to patent?

We worked with an Alberta oil and gas tools and services provider who was very aware of the value of patent protection and had many patents and applications in their portfolio. However, in mid-2010s, as oil prices fell, contracts became scarce and their customers were asking for steep discounts. As a result, our client needed to take a good look at their IP portfolio and decide which patents to keep and which to delay. They also needed to develop a more stringent test for deciding to patent or not.

We sat down with our client to review their tools and determine if they were still selling those tool and if so where? Could prosecution on any applications be delayed and if so what were the risks? Were there alternative ways to keep their competitors at bay without filing for patent protection immediately?

Working with the client, we tailored their patent portfolio to accommodate their budget, while still protecting their key technology areas. We've developed patent strategies to delay prosecution and allow the client to hold off filing for patents until the energy sector picks up. We also helped our client develop better criteria for making the decision to patent or not.

News + Views + Events**September 2016**[Post-Grant Patent Amendment - Canadian and US Options](#)**May 2014**[Whose Invention Is It Anyway? Some Thoughts on Patent Inventorship and Ownership](#)**February 2014**[Intellectual Property Considerations in Business Transactions](#)**November 2013**[Getting Your Application Through the USPTO - Expedited Examination Options](#)**March 2013**[The Heart of The Patent Bargain: Viagra Patent Invalidated In Canada](#)