

Intellectual Property: Case Studies and Horror Stories

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Overview

1. What **types** of IP protection should you consider in healthcare innovation?

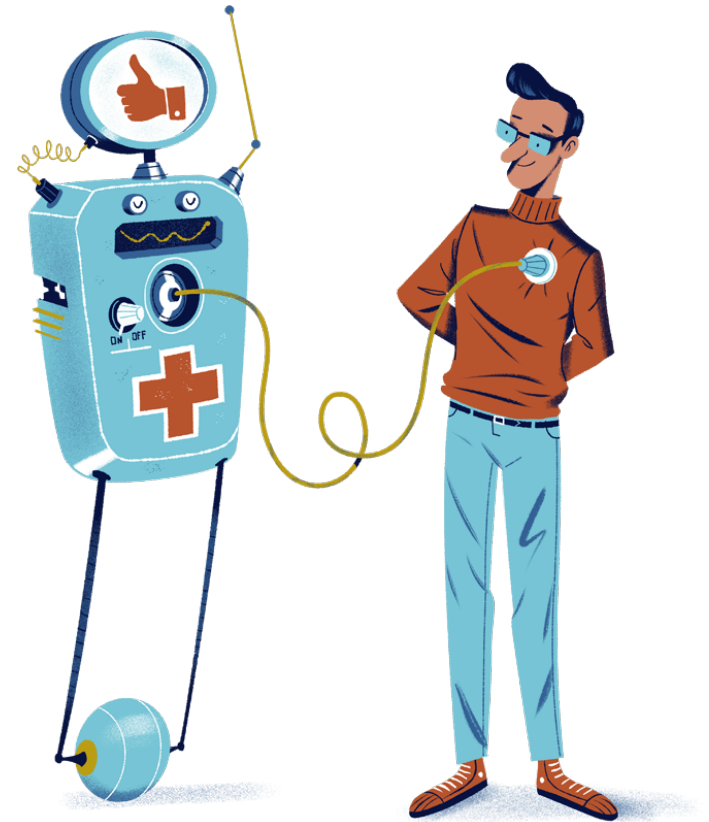


2. What are investors looking for?



4 different types of IP

1. Copyright
2. Trade Marks
3. Designs
4. Patents



Copyright

Protects the **expression** of an idea – not the idea itself

- Artistic works
- Literature
- Music
- Film
- Sound recordings
- In healthcare, © is likely to be in your drawings, text, website



Copyright

- The work must be **original**
- Protection arises **automatically**
- Expires.....eventually
- Gives the right to **prevent copying**
- Belongs to the creator (unless an employee)
- Assignments must be in **writing**

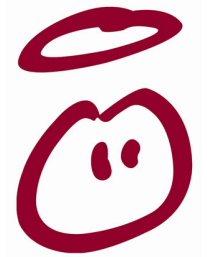


Top tips for ©

1. Clearly mark all of your original materials (text, designs, drawings, web pages, etc.) with your company name, the date, and the copyright symbol, e.g.:

© 2019 MedTech NewCo. Ltd

2. Ensure any important documents are **dated** and stored in a safe place
3. Ensure that you have clear ownership of any **commissioned** copyrighted works by a **written** assignment



Trade Marks

“If this business were to be split up, I would be glad to take the brands, trademarks and goodwill and you could have all the bricks and mortar - and I would fare better than you.” – John Stuart, former Quaker Oats chairman

Trade Marks

- A sign or symbol, which distinguishes the goods and/or services of one trader from those of another
- Can be (virtually) anything:-
 - words (e.g. Nike)
 - logos (e.g. adidas stripes)
 - phrases or slogans (e.g. I can't believe it's not butter!)
 - pictures
 - sounds (e.g. "Intel inside" jingle)
 - shapes (e.g. Toblerone bar)
 - combinations of these



Trade Marks

- Very strong trade marks
 - made up words e.g. Kodak® or Haribo®; or
 - words unrelated to product/service provided: e.g. Apple®
- Moderately strong trade marks
 - Marks that elude to qualities of your product or service, e.g. Jaguar
- Weak trade marks
 - Marks which are descriptive of the product or service, e.g. Baby-Dry or Eat



Trade Marks

- Some businesses mistakenly believe that registering their company name as a domain name or at Companies House gives them rights to use the name and prevent third parties from doing so.

WRONG!

- Until a name, brand or sign has been **registered** as a trade mark, there is **no certainty** it belongs exclusively to one only business and even then there are situations where identical brands do co-exist.
- The potential costs of trade mark infringement litigation, re-designing a brand and packaging and marketing brochures can be considerable, and it may also damage the **goodwill** established in a brand.
- **Register** your trade marks early

Trade Marks



- Rights arise through **use** BUT stronger rights are granted by **registration**
- Registration is territorial and “in relation to” goods and/or services
- Gives the right to prevent use of the same (or similar) mark in relation to the same (or similar) goods or services
- Registration can last **forever** (provided renewal fees are paid and – sometimes – use shown)
- If trade mark is not used, registration can be **attacked**

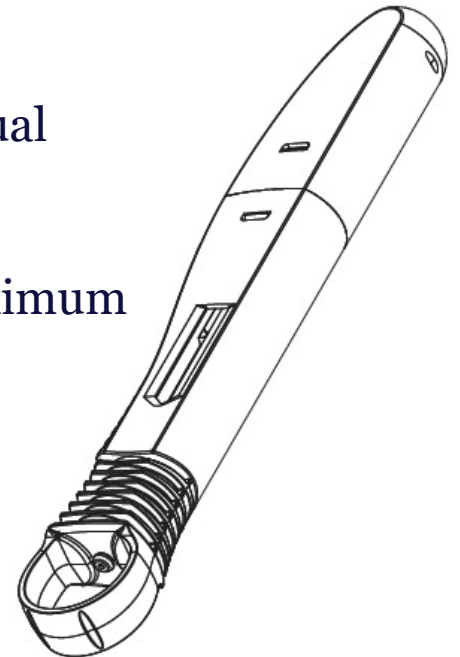
Top tips for TM

1. Conduct a trade mark **clearance search** before adopting **any** trade mark – this will reduce the risk of TM infringement and helps determine registrability
2. **Register** your trade marks **early** to avoid disappointment
3. Always use the TM and ® symbols **correctly**
4. For **unregistered** marks, keep detailed records of the extent of their use in case you need to rely on unregistered passing off rights (goodwill)
5. If your logos change with time, ensure that they are still covered by your registration



Registered Designs

- “Design” means the outward physical appearance of the **whole** or **part** of a product
- Registerable design includes **2D** surface decoration & ornamentation, and **3D** shape and configuration of the product - 2D & 3D designs may be simultaneously protected
- To be registerable, design must be new and have “individual character”, and be **visible** during its normal use
- Initial registration period is 5 years, extendable up to maximum term of **25 years**



Unregistered Design Right

- Arises automatically and is **free**
- **Copying** must be shown
- European UDR:
 - Same as registered designs
 - Lasts for three years
- British UDR:
 - 3D shape and configuration of a product
 - Protection lasts the shorter of 15 years from end of year in which design created, or 10 years from end of year of first sale



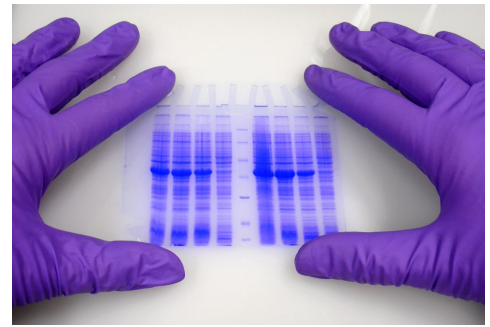
Top tips for designs

1. **Register** your new, important designs (2D & 3D)
2. Understand that some features of your designs could also be **automatically** protected by **UDR**
3. Ensure any important documents are **dated** and stored in a safe place – particularly important for UDR
4. Ensure that you have clear **ownership** of any commissioned designs by a written assignment



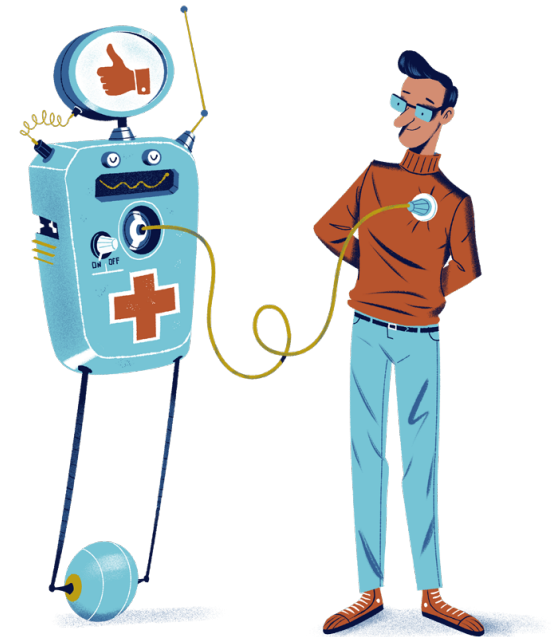
Patents

- Protect **technical** inventions, i.e. medical/healthcare
- A patent is an exclusive right allowing the owner to **prevent** third parties from doing certain activities relating to the patented invention:-
 - making
 - using
 - selling (offering to sell)
 - importing
 - keeping
- Patents last for **20 years** from filing
- Patents are **territorial**



Many uses of patents

1. **Protecting** your invention
2. Creating a **defence** for your product
3. **Deterring** your competitors & chasing infringers
4. Attracting **investment**
5. **License** or **sell**
6. Attracting **collaborators**
7. Patent Box



Patent Claims

The patent monopoly is defined in the **claims** of which there are two categories:-

1. Physical **entity** (products, articles, compositions etc.)
2. **Activity** (processes, methods, uses etc.)

1) Novelty

- Invention must be **novel** when the patent application is filed
- Invention must not be “made available to the public”:-
 - in any way
 - in any language
 - at any time
 - anywhere
 - by anyone
- Examples:-
 - Academic paper
 - PhD Thesis (if no embargo)
 - Discussion with contemporaries
 - Presentation or poster at a conference
 - Publication of abstract on internet
 - Sale of a product
 - Non-confidential use of a product



2) Inventive step

- Invention must not be **obvious** over the ‘prior art’
- ‘Prior art’ is everything that was in the public domain **before** the patent application was filed
- Inventive step is **arguable**:-
 - Has an advantage?
 - Solves a technical problem?
 - Unexpected or surprising result?
 - Not obvious to try?
 - Overcoming a technical prejudice?

Other requirements

3) Industrial Applicability

- Invention must be capable of being applied in industry/agriculture
- Mention a utility in the patent application

4) Sufficiency

- The patent needs to be sufficiently detailed so that a person skilled in the art can repeat the invention unhindered
- Include full details of all non-routine techniques used

5) Support

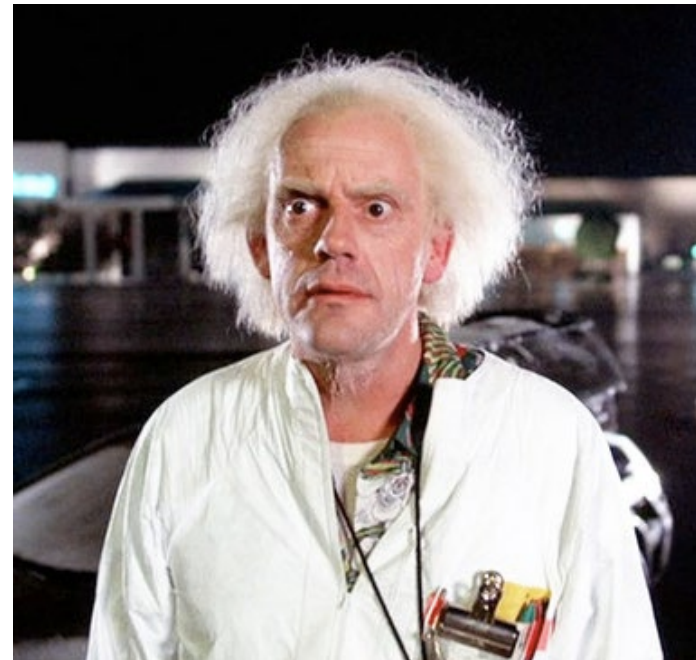
- Include examples to show the invention works



Inventorship

The inventor is the “**actual deviser**” of the invention, such as:-

- Employees
- Company directors
- Academics
- Consultants
- External contractors



Ownership

- The owner depends on the **relationship** between the inventor(s) and any other parties involved
- Default position under UK patent law – the **employer** automatically owns an invention made by an employee if:
 - Invention was made in the course of the normal duties of the employee, or other duties specifically assigned to him/her; OR
 - Employee had special obligation to further the employer's interests (e.g. if employee held a senior position in the company)
- BUT, ownership can be varied by contract



Typical patent filing strategy



(11) **EP 2 869 884 B1**(12) **EUROPEAN PATENT SPECIFICATION**

(45) Date of publication and mention
of the grant of the patent:
23.01.2019 Bulletin 2019/04

(21) Application number: **13735376.9**

(22) Date of filing: **03.07.2013**

(51) Int Cl:
A61M 25/06 (2006.01) A61M 25/00 (2006.01)

(86) International application number:
PCT/GB2013/051763

(87) International publication number:
WO 2014/006403 (09.01.2014 Gazette 2014/02)

(54) **DELIVERY APPARATUS**

**FREISETZUNGSVORRICHTUNG
APPAREIL DE POSE**

(84) Designated Contracting States:
**AL AT BE BG CH CY CZ DE DK EE ES FI FR GB
GR HR HU IE IS IT LI LT LU LV MC MK MT NL NO
PL PT RO RS SE SI SK SM TR**

(30) Priority: **03.07.2012 GB 201211745**

(43) Date of publication of application:
13.05.2015 Bulletin 2015/20

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(56) References cited:
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WO-A1-2007/005386 WO-A1-2009/049823
US-A- 5 312 345 US-A- 5 578 053
US-A1- 2002 095 123 US-A1- 2004 116 864
US-B1- 7 729 735

Note: Within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin, any person may give notice to the European Patent Office of opposition to that patent, in accordance with the Implementing Regulations. Notice of opposition shall not be deemed to have been filed until the opposition fee has been paid. (Art. 99(1) European Patent Convention).

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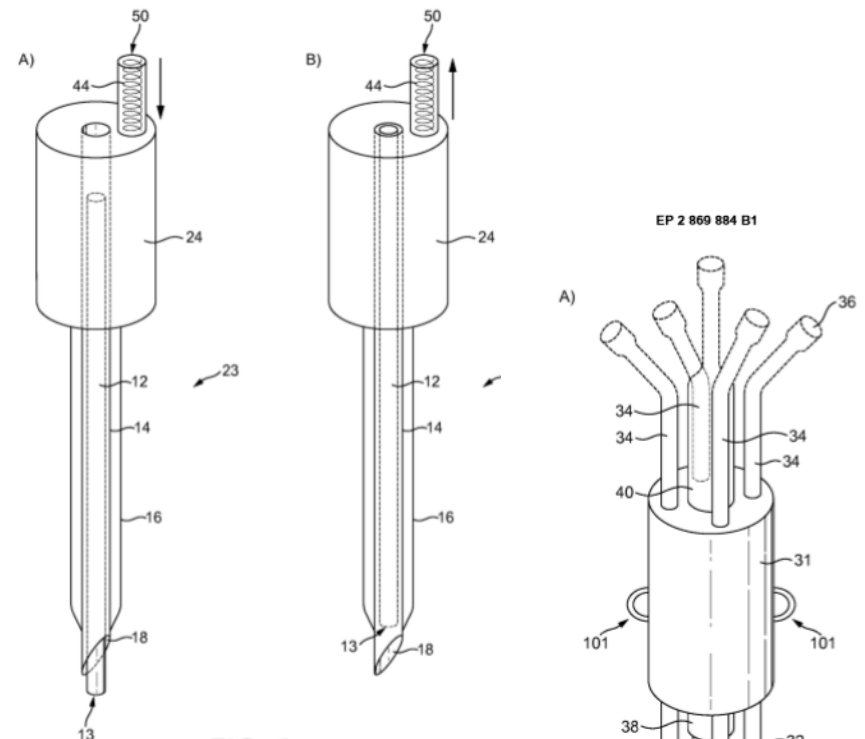


FIG. 6

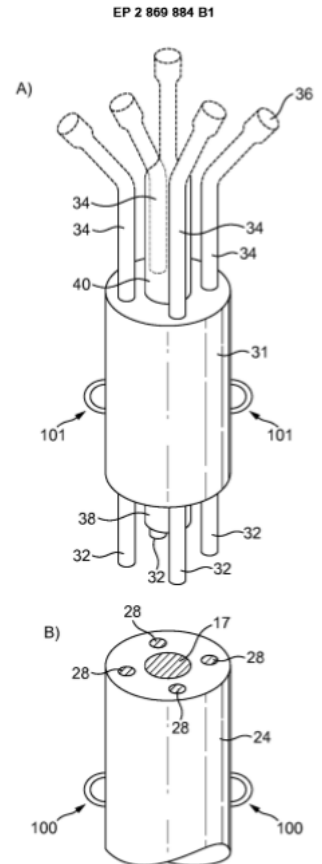


FIG. 5

EP 2,869,884 B1 - granted

*“1. A **delivery apparatus** (1) for introducing a catheter or cannula (23) into a subject’s vessel or body cavity.... comprising:-*

*(i) a **catheter** or cannula (23) comprising at least one channel (17) extending therethrough and through which access to a subject’s vessel or body cavity is achieved;*

*(ii) a removable **needle** (14) extending through the catheter or cannula (23), wherein a distal end (18) of the needle (12) is sharp and bevelled, and the needle (14) comprising a stellate (12).....;*

*(iii) an **adapter** (31) comprising at least one channel (17) extending therethrough.....;*

*(iv) **biasing means** (44) for biasing the stellate (12) into the first, retracted position; and*

*(v) **actuation means** (50) comprising a trigger (50)...., characterised in that when the stellate (12) is in the first, retracted position, depressing the actuation means (50) causes the stellate (12) to be pushed through the needle (14) against the biasing force of the biasing means (44) so as to cause the stellate (12) to move into the second, extended position, and when the stellate (12) is in the second, extended position depressing the actuation means (50) causes the stellate (12) to be retracted in to the needle (14), and thereby move into the first retracted position, thereby allowing a clinician to choose when the sharp, bevelled end (18) of the needle (14) is presented to the subject, or when it is blunt-ended.”*

Top tips for patents

1. Check you have **entitlement** to invention/patent
2. Check that the **inventors** are correctly named
3. Assess the **patentability** with respect to the prior art (novelty & inventive step)
4. Assess the **validity** with respect to sufficiency & support



Top tips for patents

5. Build a strong **patent portfolio** offering good protection for the invention(s)
6. Have several numbers of patent families offering different **breadths** of protection
7. Check **geographical** coverage of protection
8. Check remaining **term** of patent protection
9. Check that you have **freedom-to-operate**



Summary

- Continually think about which aspects of your idea should be protected by:
 - **copyright** (automatic)
 - **trade mark** (register)
 - **design** (register)
 - **patent** (register)
- File patent applications where **commercial opportunities** are good
- Important to get **inventorship** & **ownership** issues right at outset
- **Due diligence** may be carried out on your IP portfolio so be prepared!

Thank you for your attention!

Any questions?

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