



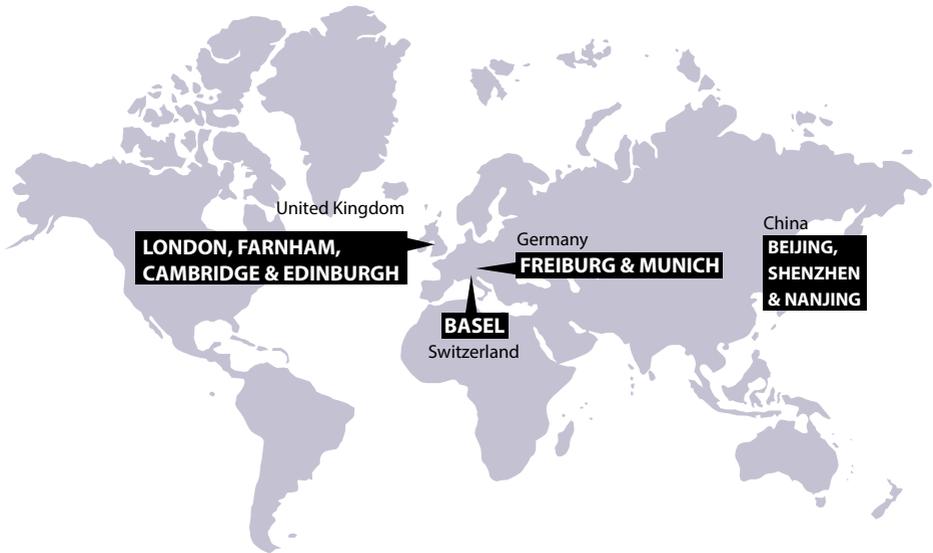
Life Sciences and MedTech  
Intellectual Property Specialists

Patents,  
Trade Marks  
& Designs



# Maucher Jenkins' Offices

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**Maucher Jenkins** is a leading full-service intellectual property firm advising clients on patents, trade marks and designs. We work with a variety of corporate companies, academic and research-based organisations and their spin-out companies, providing a wide range of IP related services. We advise creative people, not only to protect their ideas but also to help their innovative products become a commercial success.

We have offices in the UK located in London, Farnham, Edinburgh and Cambridge and international offices in Munich, Freiburg, Basel, Beijing, Shenzhen and Nanjing

The firm has a strong and flexible attorney team, including some of the most talented and experienced people in our profession. We take pride in all the work that we do and welcome the opportunity to work with innovative and forward thinking individuals and businesses around the world. Our team of attorneys and lawyers act directly before the UKIPO, German PTO, EPO, EUIPO and WIPO on behalf of clients from around the world covering all IP matters.

# Patent protection for Biotech and Medtech

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Our attorneys have significant knowledge and expertise in all life science and healthcare sectors, including biotech, medtech, medical devices (including IVDs), pharmaceuticals, immunology, chemistry, industrial biotechnology, and materials science.

As patent and trade mark attorneys who specialise in life sciences and medical devices sectors, we work with clients of every size from early-stage and start-up companies to established multinationals. We understand the needs of those involved in research, knowledge transfer and the development of exciting new technologies. Our outlook is communicative, client-focused, flexible and above all commercially-minded.

There are many issues that need to be considered and we can assist you as much or as little as you need to turn your innovations into market-ready profitable commercial products. Our team of attorneys are experienced in helping clients to navigate the changing biotech and medtech patent landscapes to ensure the best protection for their technology. With many of our team having backgrounds in research science, we understand the challenges of transforming research and development projects into a commercial product and we seek to strengthen our client's commercial position by giving practical advice that can help to increase value in their business.

Patent law for biotech and medtech products can be a fast paced and shifting environment with new and changing exclusions and restrictions to patentable subject matter

providing greater uncertainty during patent prosecution. Our experienced attorneys can guide you through the patenting process and help you to obtain patent protection for up to 20 years - thus maximising the sales of your product by preventing others from copying, manufacturing or selling a competitive product.

A good biotech and medtech protection strategy however includes far more than just getting patents granted.

For example:

- Do you know your patent landscape and are you free to operate?
- Who are your main competitors or potential licensees?
- Where should you obtain protection?
- Should you use utility models, and if so where and when is it appropriate?
- Your prototypes are made and ready to use but how do you address issues of confidentiality in testing them?

We are skilled in monitoring competitors' patent portfolios and identifying potential strengths and weaknesses. We can give opinions on freedom to operate, perform due diligence when our clients are preparing to expand their business, and pursue those who are infringing our clients' intellectual property rights.

### **Areas of particular expertise in IP protection include:**

Laryngeal masks and endotracheal tubes, laryngoscopes, lithotripsy devices, optics, cardiac and orthopaedic implants, dental devices, x-ray imaging, ultrasonic imaging and MRI, spectrophotometric monitoring, suturing devices, pacemakers and blood pressure monitors, microbiology, recombinant viruses, protein crystallography, flow cytometry, molecular biology and

biochemistry, industrial biotechnology, synthetic biology, in vitro diagnostics, animal health and veterinary technology, and immunology and antibodies.

### **Litigation**

Our firm has a highly respected litigation department and we have experience in pursuing and defending against actions at the UK Intellectual Property Court (IPEC), the UK High Court, and the German Courts as well as representing client in contentious matters before the UK Intellectual Property Office, European Patent Office, and the German Patent and Trademark Office.

### **Unified Patent Court**

The much-publicised and long-awaited Unified Patent Court (UPC) is likely to come into force in the not too distant future. The UPC will be a single court covering 25 countries and most member states of the EU. It will replace the current national courts system that operates under the European Patent Convention and address the issues that arise around decisions on the infringement and validity of European patents, where a patent proprietor wishes to enforce a European patent - or when a third party seeks the revocation of a European patent - in several countries – leading to high costs, risk of diverging decisions and lack of legal certainty.

The UPC seeks to address this with exclusive jurisdiction for litigation relating to European patents and European patents with unitary effect (unitary patents). The London branch will focus on pharmaceutical and chemical cases. Two further courts covering different technologies will be based in Munich and Paris.

## Supplementary Protection Certificates (SPCs)

SPCs are an extension to a patent, which can be applied for in relation to pharmaceutical and plant protected products that have been authorised by regulatory authorities. They are designed to offset the time taken to reach the market due to the compulsory lengthy testing and clinical trials these products require prior to obtaining regulatory marketing approval – which can take many years – significantly reducing the 20-year life of a patent. An SPC can extend a patent right for a maximum of five years. In certain circumstances, a six-month additional extension is also available if the SPC relates to a medicinal product for children – where additional clinical trials and testing are required.

## Worldwide Patent Protection

At the moment, it is not possible to obtain worldwide patent protection as intellectual property rights are limited nationally. You may therefore require specialist advice and help in the various different countries in which you need patent protection. In the jurisdictions where Maucher Jenkins does not have office locations, we have a global network of trusted associate firms with whom we work to obtain the best advice and assistance for our clients.



### Key Patent Contacts:

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# Designs and Medical Devices



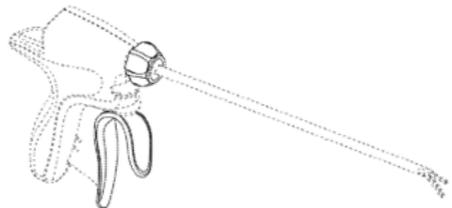
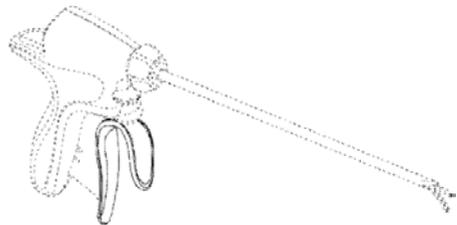
## Why register a medical device design?

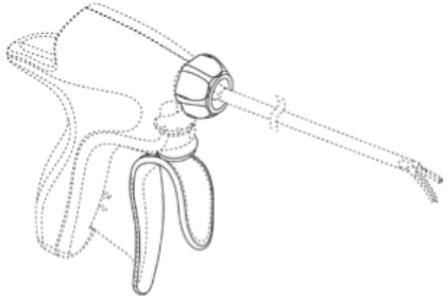
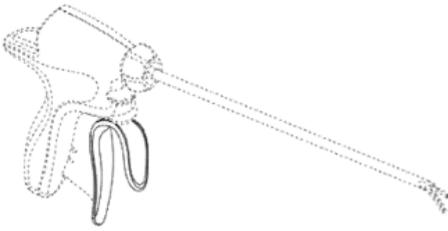
Patents are vitally important to medical device inventors and designers. However, they have their drawbacks. Patents take time to grant, and not every application makes it to the finish line. Even when granted, a patent may not stand up in court. So it is important to have a second line of defence.

In contrast, designs are registered cheaply, rapidly (sometimes within 24 hours), almost never refused, and last for up to 25 years. Yet not every medical device company is aware of the benefits of design protection.

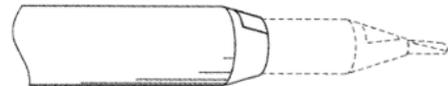
One common misconception is that medical device designs cannot be protected because they are functional. The function may be the most important selling point of a medical product, but that does not rule out protection. Wherever there is choice about the appearance of a product, design protection is possible.

One US case example was *Ethicon v Covidien*, in which on appeal the US Federal Circuit found the designs of aspects of handheld, ultrasonic surgical devices (below) were validly registered.





Another was Medtronic & Warsaw Orthopedic v. NuVasive, concerning a dilator device used to open tissue before surgery. The designs were held to be validly registered by the US Patent Trial and Appeal Board.



In each of these cases, the defendant had in fact done enough to avoid falling within the scope of design rights, which give narrower protection than patents. However, in many situations designs are of value even given this narrow scope.

- First, design protection can keep copycats off the market after launch of a new product, before patent rights are available, allowing a product to establish itself in the market.

- Later, where an established product design which is easy to use and distinctive comes “off patent”, competitors can be deterred from entering with a lookalike, allowing the public and the medical sector to continue to buy the product they are used to without confusion.

And finally, since competitors can always avoid design infringement by making their own products radically different in appearance, the civil litigation sanctions against design infringers are significantly higher than in patent cases. There are also customs and criminal sanctions, which can make design enforcement fast and cost-effective.



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# Brand protection and Trademarks

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Intellectual property protection is important in any business providing products or services to others. If your company invents, designs, manufactures or distributes products in the pharmaceutical or medical technologies industries, you will undoubtedly understand the importance of patent protection but may not be quite so familiar with the importance of trade mark and brand protection.

Trade marks are badges of origin that determine that a specific product or service originates from a particular company or individual. They are the brand names and logos that distinguish your goods and services from those of others. Trade marks allow you to build a brand identity that consumers can rely upon, including a guarantee of the quality and the origin of your goods or services.

In life sciences related industries, trade marks are particularly relevant in taking action against parallel imports (grey market goods) and re-packagers, and, since they are often used by companies when authorising the name of the product by the relevant regulatory body, the goodwill attached to the product can be built up from the very start of the process. In these instances, inventors and subsequent brand owners not only need to comply with trade mark laws (to ensure that they do not infringe any third party's rights) but also with the additional and specific naming conventions issued by the regulatory authorities that apply to pharmaceutical products and/or medical technologies and devices (to ensure patients' health safety).

## Why are trade marks important?

By ensuring that your trade marks are protected in the relevant territory, i.e. where your product is being manufactured and distributed, you will be able to prevent third parties from using your trade mark to represent their own goods or services.

If you have not protected your brand in the required manner, you may not be able to prevent copying. You may also face a situation where you are prevented from entering a certain market because a third party already has registered rights in your mark of interest.

As an example, with the fast growing market of online pharmacies and cross-border information sharing facilitated by the internet, if they see your unprotected product available online, it would be easy for a Chinese manufacturer to protect your trade mark in China without your permission. If you have no registered rights in China, you will not be able to prevent this party from registering or using your trade mark in China, and possibly elsewhere. Furthermore, you may not be able to enter the Chinese market due to the possibility of infringing this third party's rights.

You should also keep in mind that, should you consider selling your business, if your brand is protected, this could add considerably to the overall value of your business.

## How long does trade mark protection last?

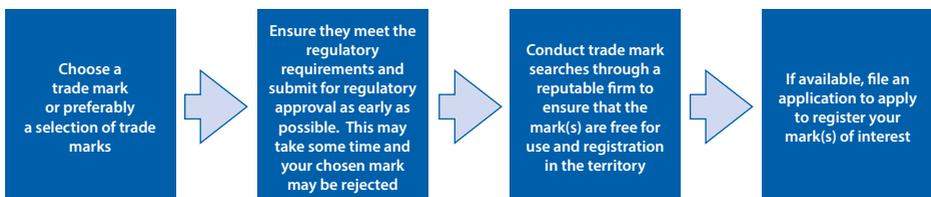
Unlike patent protection that lasts for a maximum of 20 years - and often less in the pharmaceutical industry; with trade mark protection your brands can potentially remain protected forever. The Bass Brewery's logo for example, was registered in the UK in 1876 and remains protected today.

In the case of ASPIRIN®, which was invented in 1899, whilst there was some patent protection in place for a period of time, the trade mark registered brand continues to serve as an indicator of the quality of the originator product and continues to sell well in relation to cheaper versions due to the strength of the 'trusted' brand name.

So the sooner you give your product a brand name, and then protect that brand with trade mark registration, the more money you could potentially make.

## Choosing a brand name

Whilst you'd think this would be the easy bit, choosing a brand name that is acceptable to the various regulatory bodies is easier said than done. Any confusingly similar names may lead to medication error and patient harm will be rejected. Our trade mark attorneys can help anticipate potential issues associated with these clearance processes and provide searching to assist with this.



# Life Sciences and MedTech Team

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## Reuben Jacob

Partner - Head of Life Sciences & MedTech

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Based: Farnham, London, Edinburgh, Munich

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### Chartered Patent Attorney, European Patent Attorney, European Trade Mark & Design Attorney

Since joining the profession Reuben has built up a wealth of experience in advising clients operating in the fields of biotechnology, medical technologies, medical devices and chemistry, including representing industrial clients, universities and research organisations. His special interest is in helping early stage/spin outs and SMEs enhance their businesses by the creation of strategies for the acquisition, organisation and exploitation of their intellectual property rights.

Reuben has gained considerable experience in conducting oppositions and appeals before the European Patent Office, including appearing at oral proceedings before the Examining Division, Opposition Divisions and Appeal Boards. He is experienced in IP litigation, both in a support role in the UK and in the co-ordination of Europe-wide litigation strategies including enforcement and litigation support in Germany.

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## Dr. Kei Enomoto

Partner

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Based: Farnham, London, Munich

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### Chartered Patent Attorney, European Patent Attorney, European Design Attorney

Although Kei's background is in chemistry, specifically in pharmaceuticals and agrochemicals, she has acquired extensive experience in a wide variety of technological fields, in particular in medical devices and packaging, but also in analytical devices, material sciences, polymers, medicinal chemistry, food technology and industrial sciences.

Kei's knowledge of the Japanese language and culture is appreciated by the firm's Japanese clients and Kei travels frequently to Japan and lectures in Japanese. Kei is a member of the Japanese Chambers of Commerce & Industry in the UK (JCCI-UK). Also as a French national, Kei advises, offers training and lectures to French-speaking clients.

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## Dr. Fiona Kellas

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### Chartered Patent Attorney, European Patent Attorney

Fiona is a UK and European Patent Attorney. Fiona graduated from the University of Glasgow with an Honours degree in Biochemistry in 1998 and was awarded a PhD in Biochemistry from the University of Cambridge in 2003. During her PhD, Fiona carried out research in the MRC LMB (MRC Laboratory of Molecular Biology) in Cambridge and in the MRC Mitochondrial Biology Unit in Cambridge.

In addition to working in private practice, Fiona has experience of working in-house in the intellectual property department of an antibody technology company. Fiona has experience of drafting and prosecuting patent applications, preparing and filing design applications, as well as prior art and freedom to operate searching and assessment.

Fiona has worked in a wide range of technologies. In particular, she has experience in the areas of biochemistry, antibody technology, industrial biotechnology, in vitro diagnostics, digital health and medical technologies and devices.

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## Handong Ran

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### Chartered Patent Attorney, European Patent Attorney, European Design Attorney, Chief Representative, China

Handong previously worked as an IT analyst at IBM China and a research assistant in Institute of Cell and Molecular Science at Queen Mary & Westfield College, University of London.

Handong joined Maucher Jenkins in 2006 and qualified as a Chartered Patent Attorney and a European Patent Attorney in 2010. Handong is also a qualified Chinese patent attorney and attorney-at-law.

Handong works in Mandarin, English and has a good understanding of Japanese. diagnostics and medical technologies and devices.

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### **Dr. Manuel Kunst**

Senior Associate

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**Based:** Freiburg

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#### **European Patent Attorney, German Patent Attorney**

As a biochemist, his technical orientation is focused on the fields of pharmaceuticals (e.g. chemical or biotechnological medicaments, formulations, life cycle management), chemicals (e.g. films/foils, adhesives, plastics, silicon compounds), agrochemicals, cosmetics, nutraceuticals, biotechnological products and medical technology products and in neighboring technical fields. In this context he is able to rely on his extensive IP experience derived from his work in industry.

Manuel provides sound advice and support, driven by both experience and curiosity into new developments both regarding IP right and technology.

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### **Dr. Edward Rainsford**

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**Based:** Farnham, London

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#### **Chartered Patent Attorney, European Patent Attorney, European Design Attorney**

Edward graduated from the University of Reading with a degree in Microbiology in 2000 and he was awarded a PhD in virology from the University of Warwick in 2006.

Following his PhD, he moved to the United States where he worked as a Research Associate at the University of Virginia studying negative-strand RNA viruses replication. During his time as a research scientist he presented at a number of international conferences and published several research papers in virology journals.

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### **Dr. Andreas Geißler**

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**Based:** Freiburg

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#### **European Patent Attorney, German Patent Attorney**

Andreas main technical focus is in the fields of biotechnology, pharma, cosmetics, nutraceuticals, medical technology and any neighbouring technical fields. In addition to his background, he has acquired extensive experience in a wide variety of technological fields, in particular in medical devices and mechanical engineering.

Andreas also lectures at the Karlsruhe Institute of Technology (KIT).

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### **Lucy Holt**

Technical Assistant

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**Based:** Farnham

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Lucy graduated from the University of Warwick in the summer of 2016 with a degree in Chemistry. Her final year research project involved the development of an electrochemical boron doped diamond pH sensor suitable for use in harsh environments. She has also carried out research at the University of Oxford in the field of nanoparticle electrochemistry. Lucy completed an internship at Warwick Ventures prior to joining Maucher Jenkins in 2016.

She is currently training and working towards qualifying as a patent attorney – specialising in the life sciences and medical technologies and devices sectors.

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European Patent, Trade Mark & Design Attorneys | UK Chartered Patent & Trade Mark Attorneys  
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