

INTELLECTUAL PROPERTY (IP)

After reading this fact sheet you should:

- Know what Intellectual Property (IP) is.
- Be familiar with the steps involved in filing for IP including the timelines.
- Have links to related resources.

As a medical device innovator, you will want to ensure no one else can manufacture, sell or lay claims on your product being their idea. Developing strong IP around your device is of utmost importance.

What exactly is included in IP?

Patents: A grant of exclusive rights from the government to make, use, sell, or import an invention.

Trademark: A word, phrase, or symbol that is consistently associated with a specific product or medical method and gives the holder exclusive rights to use a word, phrase, brand name, tagline, or logo.

Copyright: The granting of authors and artists of written and graphical materials the right to prevent others from using their original works of expression without permission.

Trade secrets (Know-How): Information, processes, techniques, designs, or other knowledge not generally made public, which provide the holder with a competitive advantage in the marketplace.

Database Rights: Protection for the compilation of critical data for up to 15 years.

Design Patents: Design Patents which cover the design aspects of products to differentiate them from others.

For medical devices, the most important aspect of IP is *Patents*. The patentability requirements mandate that the subject matter of the claimed invention be: (i) patent eligible, (ii) useful, (iii) new, (iv) non-obvious, and (v) described with the particularity required so that people of skill in the relevant technology field or science can understand what the invention is, make the invention, and use the invention without engaging in what the law calls undue experimentation. For further information refer **Knowledge Transfer Ireland**.

Who owns the IP and how much will it cost?

Inventors working in an academic setting must keep in mind that if an invention is conceived and/or developed using significant university resources, the university may assert its rights in taking ownership of the invention. The same applies to an inventor working in a commercial or healthcare setting. The employer may assert its rights in the ownership of the invention depending on the contracts in place between the inventor and the employer.

There are several costs associated with patents. An IP attorney/law firm will be reviewing your patent and filing patent applications across different geographies. The costs include basic filing fees for each country, and maintenance fees upon acceptance. The **Intellectual Property Strategy Offer Grant** offered by Enterprise Ireland will be of help here.

What do I need to do before I apply?

Freedom to operate search: A new device has freedom to operate (FTO) only if the features of the device are free and clear of valid claims from patents that are still in force in the country in question. If there are features in the prior claim that are not part of the new invention, then FTO is preserved.

The Prior Art Search: Understanding prior art landscape for a new invention is one of the most important parts of innovation. If the search reveals troublesome prior art, you shall benefit greatly from finding this information as quickly as possible. Such discoveries can potentially save you huge amounts of wasted time and resources in pursuing the wrong idea. The invention can also be modified into an approach that is patentable.



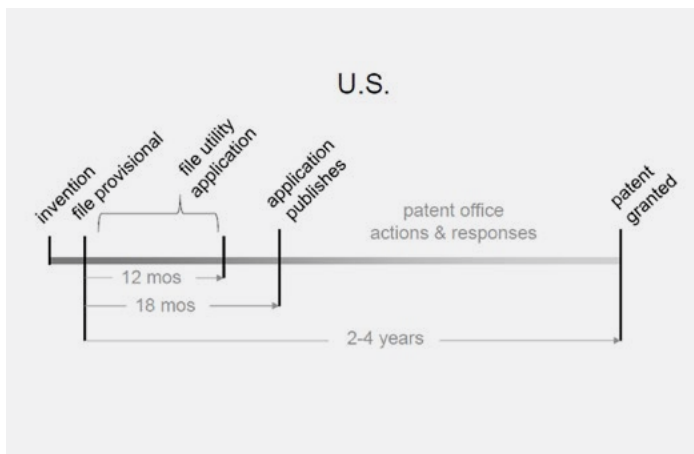
Where to look?

- **PatSnap; Google Patent Search; U.S. Patent and Trademark Office's, Patent Full-Text.**
- International Patents Databases: **WIPO Patent Scope; The European Patent Register Online.**
- Other Databases: **EI Market Research Centre;** PubMed; Google Scholar, and other medical sites.
- **Health Innovation Hub Ireland** can recommend patent attorneys who will help you with the drafting, identifying the IP strategy and filing the patent across different geographies.
- If you are housed in an academic setting, the Technology Transfer Office (TTO) of your institute will be able to assist you. **Mr Joe Doyle**, the Intellectual Property Manager at Enterprise Ireland will be of help.

What are the different routes to file for patents?

Local Patenting: If you are seeking protection in only a few countries, it may be best to apply direct for a patent to each of the national offices. In Ireland, the **Intellectual Property Office of Ireland** is of relevance. Patents must be filed in each country where patent protection is desired, and could be a costly and resource heavy approach.

International Patenting: US: A Provisional Patent can be filed with initial description of an invention that establishes a priority date before filing the utility patent in the US. Upon application of a provisional patent, a non-provisional (utility) patent has to be filed within 12 months. The timing for a US patent filing is shown below. It is important to note that the provisional patent is never published, so after filing it is possible to work on the new invention in complete secrecy. It is only after a US utility patent application is filed claiming priority to the provisional application that the invention will ultimately be published (18 months after the provisional filing date). Find further information and guidance at the **USPTO office website**.



EU, USA, others: The **European Patent Office** accepts applications under the **European Patent Convention (EPC)** and the **Patent Cooperation Treaty (PCT)**. The information regarding applying for patent in the EU is mentioned **HERE**. The attorney or law firm and the EPO will guide you with the application procedure. Under the PCT, a single filing of an international application (called a PCT) is made with a Receiving Office in a single language (the receiving offices are typically the patent offices of the PCT contracting states). There is no collective “international patent” that results from PCT process—patents must be reviewed and granted individually by patent agencies in each of the countries in which coverage is sought. The PCT provides is a way of starting the application process in an efficient and relatively economical way (i.e., a few thousand dollars) and receiving a preliminary opinion on patentability from an expert international agency (International Searching Authority). If you plan on applying for a patent across multiple EU states and the USA, the following timeline will be relevant to you:

Other Countries: Patenting in each country is managed by their respective national patent offices. The details can be found on the **WIPO portal**.

