

# IP Strategy & Medical Devices

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29 April 2009

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- 6 people, so far, AU, IN – CN, US...
- Global IP Strategy
  - ~50 countries in past 3 years
  - Local law & patent attorney firms
  - Clients – EU, Nth America, India, Asia
- Blog – Justia.com all time most popular
  - Global Week in Review
- Podcasts, etc



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# Copy of this presentation?

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<http://duncanbucknell.com/articles>



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# The key take home message

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- IP can be used in so many different ways to add value
- Thanks for coming...
- If you stay:
  - Then
  - Please
  - Heckle

*(Photo credit: ZenatEl3ain:*

*[http://www.flickr.com/photos/zenat\\_el3ain/](http://www.flickr.com/photos/zenat_el3ain/)*



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# Medical Device Patent Wars

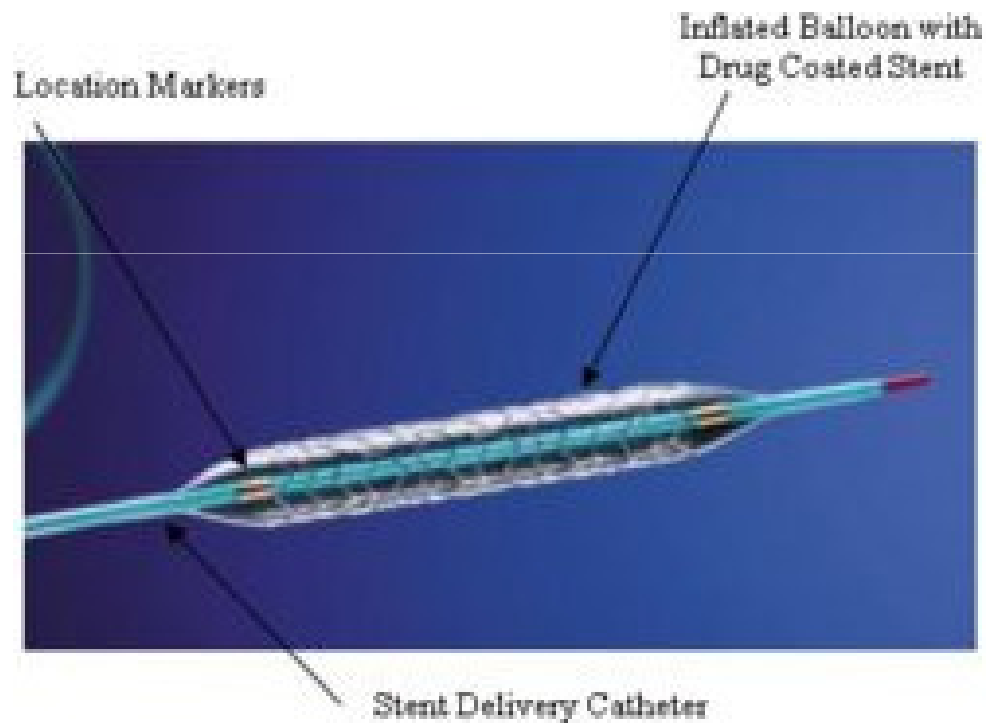
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- Medical Devices – are a bit like Pharma
  - Barriers to competition
    - Regulatory Approval
    - Reimbursement – Govt / Insurance
    - Large R&D expense
  - Patent-heavy
    - Maintains monopoly
    - Lifecycle management
    - Litigation required



# StentWars as an eg.

[www.duncanbucknell.com/scorecards](http://www.duncanbucknell.com/scorecards)



Picture: [http://en.wikipedia.org/wiki/Drug-eluting\\_stent](http://en.wikipedia.org/wiki/Drug-eluting_stent)



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# The big lesson from the stent wars?

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- More of a reminder
- Medical Devices are more like Tech than Pharma
  - Owning the molecule
  - Components and patent coverage
  - Freedom to Operate



(Photo credit: ChrisL\_AK:  
<http://www.flickr.com/photos/fncill/>)



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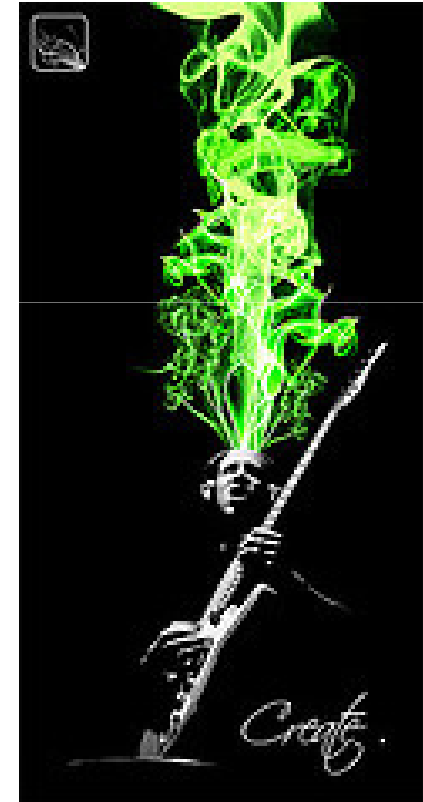
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# Tech? Pharma? Who cares?

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- Don't limit your thinking
- 'Patents as competitive weapons'
  - Too simplistic
    - Patents only
    - Contentious only
  - Lost opportunities

(Photo credit: darkpatator:  
<http://www.flickr.com/photos/darkpatator/>)



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# Contentious IP Strategy (in brief)

- If you must litigate...
- Art of War article 2006
  - Top law firms
- Follow up Article next edition of IAM
  - In House Counsel



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Feature Management Report

## Global litigation strategy and the art of war

By Duncan Bucknell, IP strategy consultant, Melbourne

The ultimate goal in a global IP dispute is rarely to fight and win every case in every country in the world. This is usually a waste of time and money. Instead, the goal is to use the situation to obtain the best commercial result – better than before the dispute arose. As Sun Tzu said in *The Art of War*: “For, to win one hundred victories in one hundred battles is not the acme of skill. To subdue the enemy without fighting is the supreme excellence.”

All manner of opportunities arise in the context of a potential IP dispute. The following five step approach is designed to put you in the best possible position to identify and seize these opportunities and, if necessary, to go out there and win the litigation as well.

In a global IP dispute, two critical factors will play a large part in determining your fate: choosing and coordinating the jurisdiction(s) in which you litigate and the outside counsel you use in each country.

Assuming that your strategy dictates litigation in a particular country, and you have chosen your advocate, then the next three steps to checkmate are: relentlessly seeking and analysing the facts; devising and implementing a consistent strategy; and making sure the team runs smoothly.

To make this article more interesting for you, I asked IP litigators from nine jurisdictions the following question: “In your experience, what is the single most important thing for your clients to focus on to maximise their chances of winning a major IP case?”

The answers reinforce the suggested approach and provide some interesting additional insights.

**Where and when to litigate**  
If you have the choice, then clearly you should litigate where you will obtain the greatest strategic advantage. Where is that? Well, it depends on your situation. The take-home message here is that the better you understand the options available in various jurisdictions, then the better you can make the most of them.

Here are some examples of factors to consider in designing your strategy – as you can see, they must be combined into a single, coherent strategy based on your particular circumstances.

Local procedural rules may act in your favour. For example, for years IP owners had been commencing proceedings in the courts of the Netherlands because of the courts’ willingness to grant cross-border injunctions across Europe (this practice is now in serious doubt, although it has not been specifically ruled invalid under the present Brussels regime by the European Court of Justice).

Similarly, if you are seeking to enforce a patent, you may wish to take advantage of the split systems in China or Germany which (usually) require separate courts to hear cases relating to infringement and validity. Such a system removes invalidity of the IP right as a defence in the infringement proceedings. So you can usually obtain a fast result on infringement, and subsequent remedies, such as injunctions. Of course, the defendant is still able to challenge validity and, if successful, have a finding of infringement become useless at a later date. This does not detract from many of the strategic advantages of having a fast infringement result, however.

You may want to make the biggest impact where the greatest commercial effect will be evident (either to seek an injunction against an infringer or to get the attention of the IP right owner). Clearly, this is dictated by standard commercial factors such as the market size in various countries.

If you are a relatively small player, you may first wish to seek the most cost effective litigation result. Consequently, you may elicit

www.ip-magazine.com

Litigation October/November 2006 81

# Art of War (I) – External Lawyers

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- Where & when to litigate
- Selecting outside counsel
  - Expertise
- Exhaustive preparation – the facts
- Expert testimony
- Global consistency
- It's a team effort



# Art of War (II) – In House teams

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- Nestle, Syngenta, Google, (Lge Pharma)
- Where & when to litigate
- Selecting outside counsel
  - Cultural fit
- It's a team effort
- Think about it soberly
  - Resource intensive



# Contentious IP Strategy - AU

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- Patents in Australia as an Eg.
  - Obviousness
  - Declarations of Non-infringement
  - Costs – comparative article on this
- Germany / China / USA / Europe / Japan...



*(Photo credit: Amy.mil:*

<http://www.flickr.com/photos/soldiersmediacenter/> )



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# Adding Value

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- Patent war / monopoly
- Cash
  - famed IBM licensing program
- Relationships
  - Microsoft?
- Other
  - Capital raising?
  - Access to markets?



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# IP and everything you do

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- External
  - Surveillance for opport & FTO
  - Marketing & Relationships
  - Making the most of these
    - Litigation
    - Licensing
    - Collaboration
    - Innovation
  - etc



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# IP and everything you do

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- Internal
  - Systems & processes
  - Capture, Manage, Value(...)
  - External processes
  - HR
    - Incentives / Team Composition etc.
  - Structure
    - Business / corporate
  - Marketing



*(Photo credit: Alex Osterwalder  
<http://www.flickr.com/photos/osterwalder/>)*



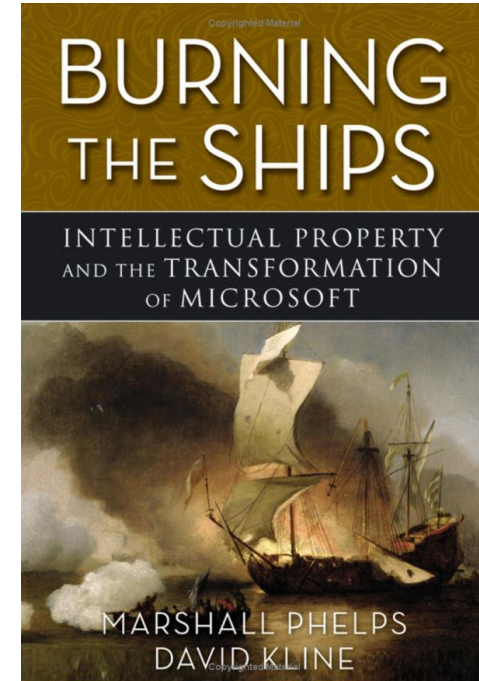
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# Cross licensing as an eg.

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- Burning the ships
  - If Microsoft can do it...
  - Podcast



# Why Cross license?

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- Revenue(?)
- Relationships
  - Access to technology
  - Access to markets
  - Resolve (avoid?) disputes
- Greater innovation in industry
  - Out sourced incubation
  - Open innovation
- ‘Orphan’ technology (?)



# Am I saying not to patent?

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*(Photo credit:  
Sukanto Debnath  
<http://www.flickr.com/photos/debnath/>)*

- No
- More critical than ever to capture & manage IP
- Not only patents
  - Know How / Trade Secrets
  - Brands / Trade Marks
  - Registered Designs, etc
- Use wisely



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# Final slide...

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Use IP tools to *inform* and *leverage*  
business goals

Thank you



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