

An Intellectual Property Quiz: IP Considerations During Product Development

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At BIOMEDevice in San Jose, Andrew Kimmel [2], a partner at Knobbe Martens delivered a talk titled "IP Considerations During Product Development." Kimmel has a unique perspective on intellectual property (IP) in medtech because he is originally an engineer by training and worked for about ten years in a medical device company, where he was an inventor and worked on a number of that company's patents. After working there, Kimmel went to law school and later became an attorney focused on IP.



He opened his presentation with a true/false IP quiz, which is presented here:

True or false? A patent grants the inventor the right to make, use, sell, and import his or her invention. In other words, does a patent grant the inventor the right to practice the invention—meaning, the right to make, use, sell, and import the invention.

False. "This is actually the most misunderstood aspect of patent law," Kimmel says. "It's very counter-intuitive but having the patent doesn't necessarily mean that you are free to go around and practice your invention."

T or F? The person who pays for the inventing owns the patents.

False. "Under U.S. law, the rights in the patent do not vest in the person who pays for the patent—instead the rights vest in the inventor," Kimmel says. "That's why it's critical to have some sort of contractual agreement with the company you hire to do inventing work for you," he adds. It could be an employment agreement, it could be a confidentiality agreement that has some sort of assignment provisions. "But it's very important that you are protecting yourself by making sure that the rights in the patent get assigned to you if you are the one paying."

T or F? A method of performing a medical procedure may be patented.

True. "This is a unique aspect of the U.S. patent law system." We are one of the only countries that in the world allow a company, a doctor, or an individual to get a patent on performing a medical procedure." You can get a patent on inserting a catheter, advancing it to its destination, deploying the stent, removing the catheter. "That's perfectly acceptable

subject matter for a patent in the United States. The rest of the world says that that is against public policy."

T or F? Improvements to old technologies may be patented.

True. "You actually can get a patent on an improvement to an old technology as long as the improvement is something new and it's not just an obvious improvement—that's the key," Kimmel says. In fact, most technologies are just improvements to things that have come before.

T or F? A patent application has been updated after it has been filed to incorporate new features.

False. You cannot update the patent application once it's filed. "It's pretty much locked in once it is filed," Kimmel says. You can modify the claims but you can't add new ideas, figures, or details. "That's why it's important to continually file additional patent applications to keep the R&D activity calibrated to the patent activity."

T or F? Liability for infringement can be avoided as long as you don't intend to infringe.

"No intent requirement at all," Kimmel explains. "In fact, you don't even have to know about the existence of the patent. Someone can knock on your door and say 'congratulations, you are infringing on my patent.'"

—[Brian Buntz](#) ^[3]

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