



AA THORNTON

INTELLECTUAL PROPERTY LAW

# Medical Devices

It's our people that make the difference

## About us

We are a leading Intellectual Property firm based in London and Munich. Our team of committed and passionate individuals includes patent, trade mark and design attorneys, as well as litigation solicitors, working with clients across a huge range of technologies and commercial fields. We provide the full range of IP services to clients around the world, from prosecution to litigation, in patent law, trade mark, design and copyright law.

Having an excellent understanding of our clients' industries and the challenges they face is key to us delivering commercial, insightful legal advice. Our highly qualified industry teams are made of attorneys and solicitors who work together to share knowledge and experience. We firmly believe *it's our people that make the difference* and that this sets us apart from others. Simply stated, we speak our clients' technical language!

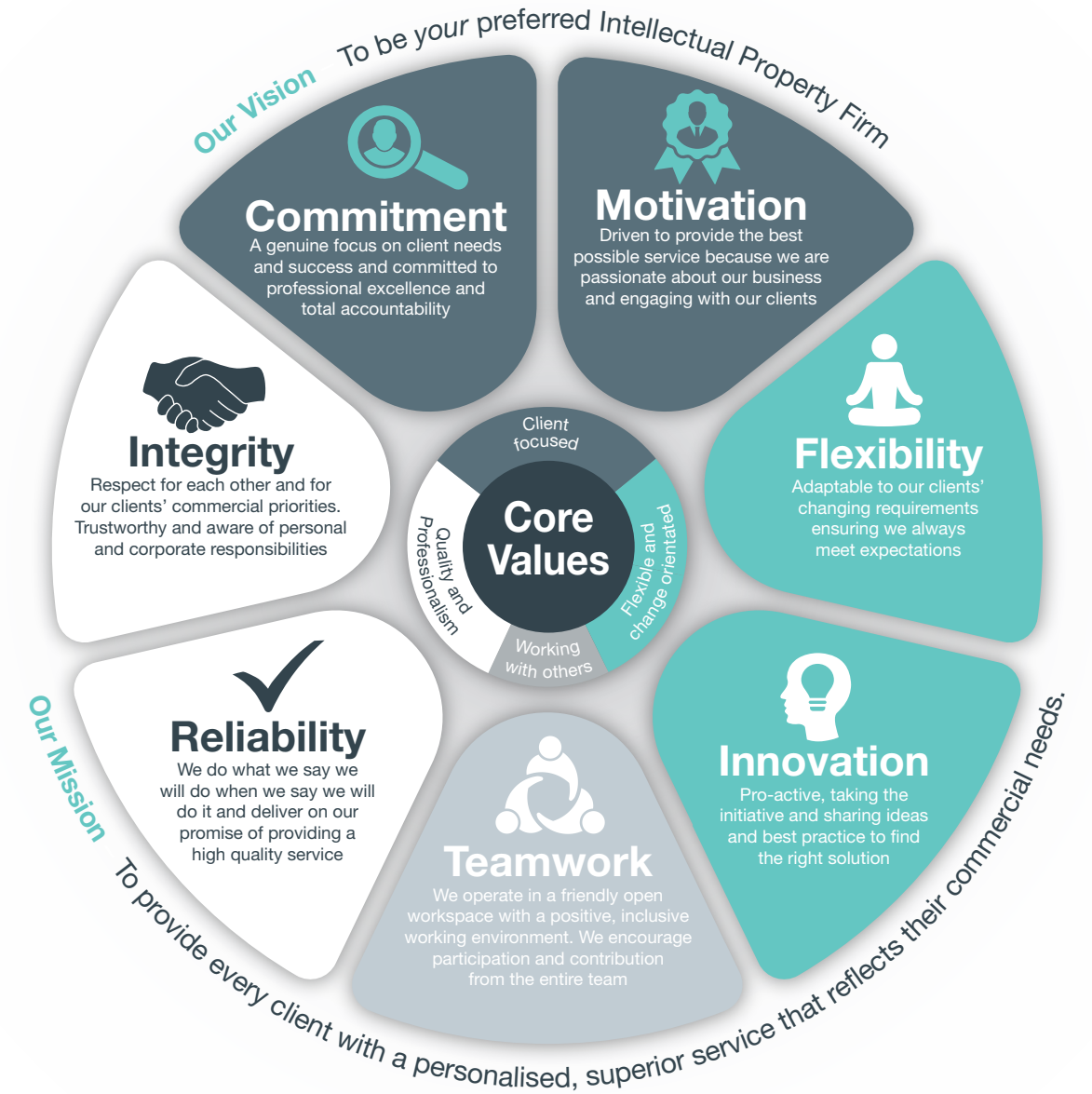
We offer a completely bespoke service at a competitive price. We pride ourselves on our genuine desire to understand the way clients want to work with us, and provide every client with a personalised, superior service that reflects their commercial needs. Our advice is always in-depth, commercial and accessible. We ensure that your inventions, brands and designs are expertly protected and your risks are minimised.

We have a wealth of experience in all aspects of patent law and can advise across a wide and diverse range of *innovations* and technical areas. Whether you are a sole inventor or large corporation, protecting your ideas is vital and we have the leading knowledge to help you. We work seamlessly with legal counsel, R&D, Business Development, Regulatory and Commercial Affairs departments to become an integral part of your team.

Our attorneys and lawyers regularly speak at conferences, and publish articles in leading magazines. We are passionate about innovation and enjoy nothing more than working on new or complex technologies.

Our vision is *"to be your preferred intellectual property firm"*, and we are committed to providing every client with a personalised, superior service that reflects their commercial needs.

## Our values

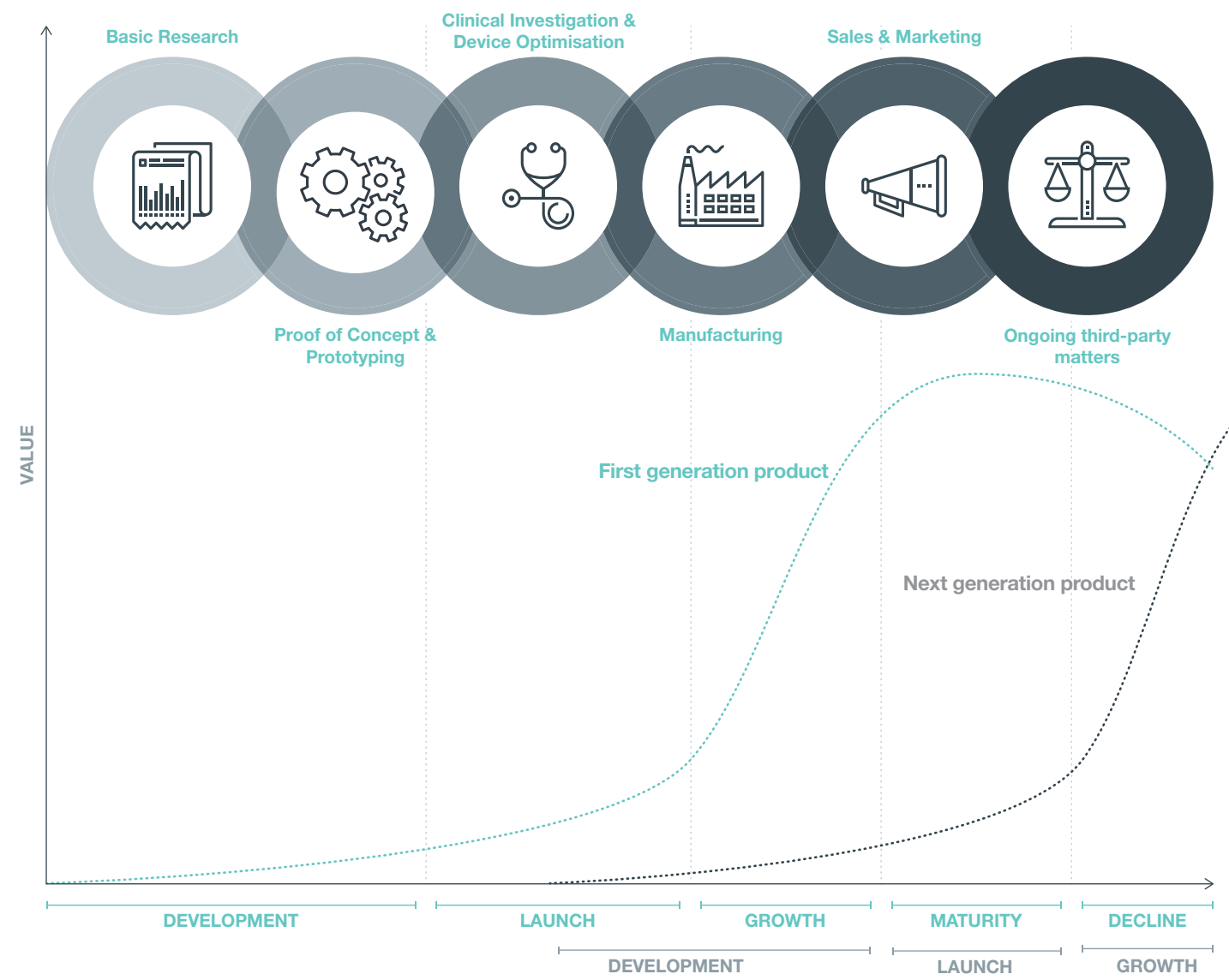


**IPINCLUSIVE**  
Working for diversity and inclusion in IP

We are delighted to be involved with IP Inclusive, which is an organisation that promotes diversity and inclusion within the various IP professions. AA Thornton were among the first signatories to the IP Inclusive charter, which is part of our ongoing commitment to improving diversity and inclusion. We take an active lead in IP Inclusive, such as the project to promote careers in IP to schools and universities through the "Careers in Ideas" initiative.



Our support to you at each stage of your product life cycle



## Our expertise

The firm's medical devices team enjoys an international reputation, and benefits from attorneys and solicitors from a wide range of professional and academic backgrounds. A number of our professionals have previously held in-house positions within the pharmaceutical industry and we actively leverage this experience across the team.

The diverse professional skill set of our team members means that we are well placed to provide advice on both contentious and non-contentious issues across the full spectrum of patent matters.

Collectively, we are proud to have represented a wide range of companies within the medical device industry, from universities and SMEs to large multi-national corporations.

We are a friendly and approachable team with an open and collaborative working style. Clients tell us that they value our understanding of their businesses, and the holistic approach that we take to the assessment of the legal, commercial and regulatory issues which affect them. We work regularly alongside in-house legal counsel, but are equally comfortable liaising directly, for example with colleagues in R&D, Business Development, Regulatory and Commercial affairs. Quite simply, our aim is to integrate seamlessly as a trusted adviser upon whom anyone can call.

“This is most certainly a unique practice. Their key strengths and capabilities are the uniformly very high standard of patent and trade mark work across the entire firm; very good communication skills; ability to obtain excellent results; and the exceptionally high level of honesty and trust.”

**- Legal 500**



# Our key team members



**Craig Turner**  
Partner,  
Patent Attorney

Craig heads our Chemistry, Biotechnology and Pharmaceuticals patents department.

Craig has assisted Cipla Ltd in obtaining and defending patents to cover their inhaler devices by drafting patent applications, prosecuting those applications and defending them in opposition proceedings. Craig also has experience in prosecuting patent applications covering a wide range of medical devices and surgical instrumentation including balloon catheters, cardiac devices such as valve supports, ventricular function assisting devices, perforation devices and vertebral supports.

Craig’s experience also covers patent litigation, preparing Freedom to Operate opinions and representing clients in oral proceedings. His clients include large corporations in the pharmaceuticals, biotechnology, and oil and gas industry sectors, as well as smaller organisations and private individuals working in these sectors.

**“Craig is ‘very persuasive in getting examiners to allow patents in difficult cases’”**  
– Legal 500



**Adrian Bennett**  
Partner,  
Patent Attorney

Adrian heads our Engineering, Physics and Mechanical devices patents department.

Adrian has considerable experience in the original drafting of patent applications and their strategic prosecution around the world for medical device companies such as Cipla Ltd and SSL International plc. Other medical device companies represented by Adrian include Smiths Medical ASD, Inc. (part of Smiths Group plc).

Adrian also has many years of experience in advising clients in infringement matters, for example by way of Freedom to Operate opinions, and in registering Designs. Further principal areas of work include handling oral proceedings before the EPO’s Examining Divisions and particularly before the Opposition Divisions and Boards of Appeal.

Adrian is a member of the International Liaison Committee of the Chartered Institute of Patent Attorneys, and represents the Institute and UK patent profession internationally.



**Ian Gill**  
Partner,  
Trade Mark Attorney

Ian is a Partner in the Trade Marks department and he is also a patent attorney.

Ian has extensive experience in dealing with both contentious and non-contentious intellectual property matters. He advises the Merck Group on trade mark, copyright and design issues in the UK and abroad, and also prosecutes their trade mark applications, defending them against oppositions, opposing competitors’ trade mark applications and advising them on counterfeiting matters.

Ian’s experience also includes managing the worldwide intellectual property portfolios of major companies and assisting clients in domain name dispute resolution proceedings. He works across a range of sectors including Fashion, Agriculture, IT & communications, Mechanical Devices, Food & Drink, and Finance. Ian is an active member of FICPI (the international federation of intellectual property attorneys) and has presented at the FICPI Open Forum on “Foreign words as Trade Marks”.

**“Ian Gill is a true expert and always offers sensible and commercial advice”**  
– Legal 500



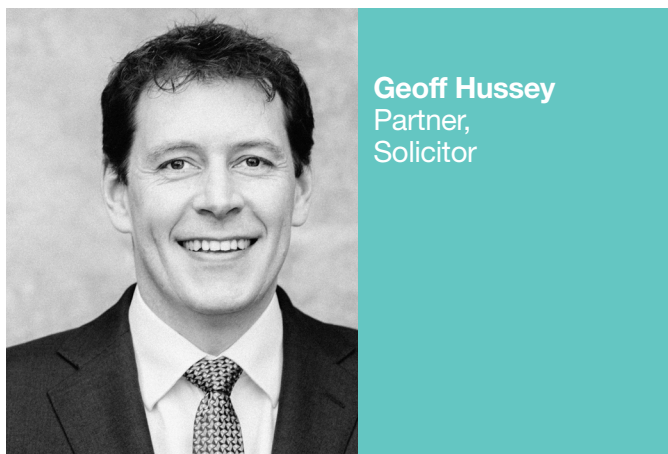
**Rachel Havard**  
Partner,  
Trade Mark Attorney

Rachel Havard is a Partner in the Trade Marks department.

Rachel assists clients in the areas of healthcare, pharmaceuticals and medical devices to secure trade mark protection for their products and services. She has advised clients in protection of trade marks for medical, surgical, veterinary and dental apparatus and instrumentation, intracardiac devices, surgical dressings, incontinence care items, magnetic therapy devices, surgical gloves, inhaler devices and contact lenses.

Rachel regularly handles a wide range of UK and international trade mark cases. She has significant experience of clearing trade marks for use and registration, and in negotiating and drafting trade mark co-existence agreements. Her clients cover a variety of sectors, including clothing, food & drink, oil & gas, and automotive, as well as healthcare, pharmaceuticals and medical devices.

**“Rachel is ‘very thorough’”**  
– Legal 500



Geoff Hussey is a Partner and Solicitor who heads our IP litigation department.

Geoff has extensive experience in patent litigation before the UK Patents Court, Court of Appeal, and in EPO oppositions particularly relating to pharmaceuticals and medical devices. His cases have often included the coordination of parallel proceedings across many jurisdictions in Europe and the US. Geoff's contentious IP experience also covers medical device design rights as well as trade marks, passing off, copyright, and breach of contract disputes involving IP.

One of Geoff's medical device cases is the leading authority in the UK on the scope of numbers in patent claims. In this case Geoff acted for ConvaTec against Smith & Nephew in relation to patent validity, infringement, damages and EPO opposition cases involving a gel-forming silverised wound dressing. ConvaTec successfully maintained a crucial patent in the UK courts and successfully argued infringement of it in separate proceedings.

Geoff has a degree in Genetics from the University of Nottingham.



Nick is a Partner in the Electrical Engineering, Electronics, Telecoms & IT patents department.

Nick advises a wide range of clients in patent and design matters and his practice covers a variety of electrical technologies including medical technologies such as focussing intra-ocular lens implants, drug vial adapters for needleless drug reconstitution and administration, cryocatheters and laryngoscopes.

Before joining the profession, Nick followed his Engineering degree by obtaining a post-graduate certificate in Design, Manufacture and Management. As a part of his course, he visited over 100 companies and carried out projects across a range of manufacturing industries, to gain an insight into different manufacturing practices and commercial issues.

Nick has long been involved with the Chartered Institute of Patent Attorneys as a lecturer on their training course for the profession's patent administrators.



Alex is a Partner in the Engineering, Physics and Mechanical devices patents department.

Alex joined AA Thornton after working in-house at Novartis Pharmaceuticals Ltd where he was responsible for IP support relating to medical delivery devices (particularly inhalation devices and auto injectors) and packaging projects across the Pharma division, as well as for a post-launch respiratory therapeutic product. During his time at Novartis he was responsible for developing and implementing an IP strategy for device IP, and was involved in the due diligence process and subsequent IP integration for a number of acquisitions, including the pulmonary division of Nektar Therapeutics and the UK diagnostics device company Vivacta Limited.

Since joining AA Thornton, Alex has been involved with assisting Cipla Ltd in the identification of potentially patentable subject matter in their device developments, conducting Freedom to Operate searches, and the preparation and prosecution of patent applications directed to some of those developments.



Marianne is a Partner in the Chemistry, Biotechnology and Pharmaceuticals patents department.

Whilst working in private practice, Marianne has assisted clients across a range of medical device technologies including laryngeal mask devices, glottiscopes, laryngoscopes, inhaler devices, kidney stone treatment devices, chemotherapy fluid devices and operating theatre equipment. She also has experience of working in-house for a large speciality chemicals company.

Marianne's experience ranges from the original drafting of patent applications, through patent prosecution around the world, to conducting oral proceedings at the EPO and providing Freedom to Operate opinions. She is also a member of the European Qualifying Examination Committee with responsibility for marking the opposition paper.

**"Marianne is 'very knowledgeable both in Chemistry and in IP law'"**  
– Legal 500



**Dan Byrne**  
Partner,  
Barrister

Dan Byrne is a Partner and Barrister in our IP litigation department with a first class degree in molecular biology and biochemistry from the University of Durham.

Dan is an experienced litigator in the IP courts and has been involved in a number of pharmaceutical cases, many with pan-European aspects. He recently practised for two years in Paris and, while there, dealt with a number of pharmaceutical and medical device cases.

One of his medical devices cases involved a patent which covered an insulin injection pen to deliver a biosimilar insulin glargine. Acting for Sanofi, Dan was part of the team which obtained orders for five searches and seizures in France and which – following an appeal – provided the first case law to explicitly acknowledge that evidence gained in this way could be used in proceedings abroad.



**Varuni Paranavitane**  
Senior Associate,  
Solicitor

Varuni is an Senior Associate and Solicitor whose practice areas are IP litigation and commercial IP.

She has advised digital health clients and pharmaceutical clients on the classification of their medical devices and advised clients on how they could obtain the relevant regulatory authorisations prior to entry of their devices on the EU markets. She has experience in UK high court actions and helped co-ordinate global patent litigation for Novartis. She has also advised on life sciences corporate transactions from an IP perspective and has published articles on various aspects of IP law in the pharmaceuticals sector, such as on patentability of DNA.

She sits on the Intellectual Property Advisory Committee of the UK BioIndustry Association.

Varuni began her career studying Biochemistry at Imperial College, then pursued a PhD and research career studying cell signalling pathways at Cambridge University.



**Stuart Greenwood**  
Senior Associate,  
Patent Attorney

Stuart is an Associate in the Engineering, Physics and Mechanical devices patents department.

Stuart has extensive experience in prosecuting UK, European and overseas patent applications and has drafted and prosecuted applications in the field of medical engineering, including laparoscopic uterine manipulators and medicament dispensing devices. He also has experience of conducting Freedom to Operate searches and representing clients in oral proceedings at the EPO.

Before joining the profession, Stuart worked as an engineer in the automotive industry and for multinational consumer goods company Reckitt Benckiser.

Stuart has particular experience in the complexities of drafting patent applications through his role as an examiner for the UK Final Diploma examination paper – Drafting of Patent Specifications.

“The ‘excellent’  
A.A. Thornton & Co. ‘goes  
the extra mile to provide  
outstanding customer  
service’ and has expertise in  
both contentious and non-  
contentious matters.”

**- Legal 500**



## Case study

### ImmutriX patent prosecution

**Teams involved** - Chemistry, Biotechnology & Pharmaceuticals Patent Department

#### The case

ImmutriX Therapeutics, Inc. is a medical technology company located in Rapid City, South Dakota. They have developed an innovative medical device for cleansing whole blood, in order to modulate and sequester molecules from circulation known to be contrary to health. ImmutriX's medical device was subject to many patent applications to protect the technology within. However, due to differences in regime in the United States and in Europe (e.g. methods of treating the human and animal body can be protected in the US, but not in Europe), complications arose. Patent prosecution was therefore struggling in Europe, and one of the key patent applications was on the verge of being refused, and key patent protection could have been lost.

#### Our input

We took over the handling of the application from the previous attorneys, and were able to maintain Immutrix's rights by filing a so-called divisional application. Using our in-house expertise not only of the law relating to medical devices, but also to the technology that underpins the device, we switched the focus of the patent from the method of its use to the technology itself. As a result, we were able to get a granted patent covering the invention, and thus ensure that ImmutriX could enjoy protection for their invention. The US attorney who instructed us on this case, Jerry Harris of Wick Phillips, said the following: "AA Thornton's unique combination of skilled technical know-how and unquestioned legal expertise have made them my go-to European firm for over a decade."

## Case study

### Medical device design freedom to operate

**Teams involved** - Engineering, Physics and Mechanical Devices Department

#### The case

Our client, a global generic pharmaceutical company, had developed their own version of a competitor's out-of-patent pharmaceutical which required administration to a patient using a specific variable dose injector pen. Our client did not have permission to make and sell this particular injector pen so they included a different injector pen for use with their own version of the product. Our client's in-house patent team had carried out an assessment of the Freedom to Operate risk in respect of any patent rights that might cover the competitor's pen, but it was identified that there may also be risks associated with design registrations. This meant that the business were facing an unknown level of risk for the forthcoming product launch.

#### Our input

We were asked to carry out an assessment of the risks of design right infringement prior to the launch of our client's product and injector pen in Europe. The most serious potential risk for the launch was considered to be the potential infringement of design registrations owned by the competitor. We therefore carried out an initial search for such designs and, although several registrations were identified, we were able to determine that the risks they posed were minimal. Following this initial report we were asked to conduct a more wide-ranging assessment of prior design registrations, not just those in the name of the competitor. Although numerous registrations were identified, we were still able to provide a pragmatic and cost effective analysis of the likely risks within the required timescale. Our full report concluded that there was no significant risk of infringing existing design rights, which gave our client the confidence required to proceed with the product launch. Following delivery of the final report we were thanked for our "great support".

## More about our services and expertise



### Patents

Our patent attorneys have a wealth of experience in all aspects of patent law, and can advise across a wide and diverse range of technical areas.

- Chemistry, Biotechnology & Pharmaceuticals
- Electrical Engineering, Electronics, Telecoms & IT
- Engineering, Physics & Mechanical Devices

Whether you are a sole inventor or large corporation, protecting your ideas is vital. Our European and UK Patent Attorneys can act on your behalf, presenting your case to the UK Intellectual Property Office (UK IPO), the European Patent Office (EPO) and the World Intellectual Property Office (WIPO). Thanks to our network of associates overseas, we can advise on different patent laws and protect or defend you anywhere in the world.



### IP Transactions, Ownership & Licensing

We regularly advise clients in relation to commercialising their IP. When entering into negotiations for contracts involving IP it is important that clients' interests are protected and that the appropriate rights are secured in the transaction.

We have the experience and focus to help guide you through what is a technical legal area to achieve a result that meets your commercial aims for all of your non-contentious IP requirements.

#### Our services include:

- Drafting assignments and licences
- IP contract reviews
- IP due diligence
- IP audits
- Developing IP ownership and licensing structures
- Dispute settlement agreements
- Recording transactions at Intellectual Property Offices



### IP Strategy & Audits

We will work with you to put in place effective strategies for the protection and commercialisation of your IP.

#### Our services include:

- IP audits
- IP due diligence
- IP portfolio management and maintenance advice
- Project reviews to identify potential IP
- Strategy reviews
- IP litigation strategic advice
- Marketplace and competitor surveillance
- Advice on upcoming Unified Patent Court opt-outs
- Parallel imports – advice, reviews, procedures



### IP Litigation

Our IP litigation and legal department advises on all aspects of IP law. Our experience and expertise ranges from dealing with small IP disputes (often resolved in negotiation), to hard-fought high-value IP litigation and coordinating parallel actions in other jurisdictions.

Our litigation approach is, where appropriate, for IP solicitors to work closely with our patent or trade mark attorneys to provide a coordinated approach to both enforcement and protection – ensuring the best possible resolution of IP disputes. The strength of our collective technical expertise also ensures that we can understand the necessary complexities involved in each case.

#### Our services include:

- IP portfolio and litigation strategies
- Patent litigation
- Trade mark, copyright and design right litigation
- Arbitration and mediation
- Licensing disputes
- Coordinating with local counsel in parallel actions around the world
- Settlement advice





## Trade Mark, Design and Copyright Portfolio Management

Our patent and trade mark attorneys regularly advise on IP portfolio management, with a focus on alignment with each client's overall corporate objectives and strategy.

We understand the need to review expenditure, IP asset value and portfolio management decisions on a regular basis, and to check alignment with the current business objectives and market conditions. We approach this with a desire to understand your business needs and to provide a solution that achieves your objectives efficiently and cost-effectively.



## IP Due Diligence & Freedom to Operate or Freedom to Use

We have considerable experience advising clients in relation to commercial due diligence activities across the full spectrum of IP rights. Clients value our commercial focus and attention to detail in helping them to evaluate and realise new business opportunities.

### **Our services include:**

- IP due diligence for clients seeking to commercialise their own IP
- IP due diligence for clients seeking to acquire third party IP
- Freedom to Operate or Freedom to Use assessments





Because of our people we are consistently ranked as ‘top tier’ and ‘leading’  
by our peers and clients:

The Legal 500 | Chambers & Partners | WTR 1000 |  
Managing IP Stars | The Financial Times

### Contact us

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Working for diversity and inclusion in IP

The information in this booklet is general information only and is not intended to constitute legal advice. If you wish to explore protection and associated costs for any of the types of intellectual property discussed, please contact one of our patent, trade mark or design attorneys. October 2020.