

## Planting the Seeds of a Great IP Portfolio

*A case study on international planning - even before the first patent application is filed.*

**Problem:** The client – a newly formed medical device start-up company – wished to file its first patent application but had not yet decided in which country or countries to market its first product.

**Solution:** GAI evaluated the client's medical device invention in terms of patentability but also in terms of the client's business model. The most suitable markets were determined to include countries outside of the client's own home market. GAI's experts constructed the initial patent application to support a long term international sales strategy for the client, for both the currently envisioned medical device product and future products.

**Background:** Filing an initial patent application determines the level of protection provided to an invention on the "priority date", which is the date of filing of the initial patent application. As the vast majority of countries (with the exception of the US) determine patentability with regard to "first to file", the date of filing – and the exact content of the application that is filed – are definitive in situations where competitors file for the same or similar inventions. The content of the initial patent application is therefore critical in order for the priority date to protect the invention in all of its variations internationally.

**Challenge:** Patent laws and requirements vary tremendously between countries, such that a patent application drafted exclusively according to US requirements, for example, may fail to adequately protect an invention internationally, outside of the US. The client turned to GAI for preparing and filing the initial patent application due to our international experience, and also for assistance in constructing an initial international marketing strategy. The client felt that GAI's international experience was particularly crucial once it was determined that the client needed to rapidly develop a sales strategy for countries outside of its home market.

**Outcome:** The initial patent application was drafted in terms of the patent laws and requirements for the US, Europe, China and Brazil, and covered both present and future aspects of the medical device invention. Such strong coverage for the initial filing, in conjunction with the initial international marketing strategy, was not only helpful to the client for future marketing of the product, but was also viewed favorably by investors during due diligence reviews.