

## Finding Your IP Niche in a Crowded Field

*A case study on developing an IP portfolio that is both a sword and a shield.*

**Problem:** The client – a mature medical device company – competed in a crowded field; many of its competitors had filed for or obtained patents covering critical aspects of the technology in this field.

**Solution:** GAI evaluated the client's medical device products and business model to determine that the most lucrative products covered a technological niche that was both patentable and had freedom to operate (i.e. did not infringe) in the international markets of interest to the client. GAI's experts rewrote the claims for existing patent applications and filed new patent applications as necessary to cover this niche, in order to both protect the client's products and to block competitors from entering to this niche. Thus, the client's IP portfolio acted as both a sword (blocking competitors) and a shield (protecting the client's own products).

**Background:** Obtaining a granted patent does not guarantee freedom to operate, as a patent is a "negative right". However, a properly constructed IP portfolio can both protect an invention and potentially block competitors from being able to enter a lucrative niche and hence from being manufacture, sell, import, export etc. The technological niche must be first identified as such in order for this strategy to be implemented.

**Challenge:** The client had a number of already filed patent applications which covered various aspects of the niche technology. GAI's experts evaluated the claims of all such applications to determine their effectiveness in protecting the desired niche. Some claims were added or rewritten in order to block competitors from entering this niche. GAI's experts also determined which new patent applications should be filed to reinforce international protection of the niche and also to cover non-published aspects of the technology that could be of interest to competitors.

**Outcome:** Patents have already been granted in at least some countries with claims that protect the niche; other applications are undergoing prosecution. The client turned to GAI to identify the technological niche and to construct an international IP strategy that acted as both a sword and a shield, instead of only focusing on each product as a separate invention, thereby reducing the risk of having lucrative aspects of the technology being blocked by competitors.