



Prior Art Proficient: Finding an Expert in Medical Device Patents

A medical device patent dispute between two manufacturers of endoscopic clips for the GI tract demanded a seasoned expert witness with in-depth expertise in design patents and prior art searches.

The Case Challenge

IMS worked in support of a multinational manufacturer of medical devices in its patent infringement dispute against a privately held medical device manufacturer. The case survived several years of Patent and Trademark Office (PTO) challenges pursued by the defendant and reached the US District Court.

Our client represented the plaintiff and sought an expert with prior art search experience to opine on what constitutes a reasonable prior art search. They were looking for an excellent researcher who had experience with prior art for medical devices, had preferably been employed at the PTO, and had testified at trial and in depositions.

The Expert Solution

Because every medical device matter is unique, and each client has specified goals, our expert services team performed a custom search to secure the best-aligned patent expert candidates for this complex IP dispute.

An IMS researcher swiftly identified nine potential industry experts who met the plaintiff counsel's criteria. Our recruiting team vetted the six best-qualified candidates and presented the top two to our client, allowing them to engage an expert within three weeks of their initial request.

The chosen expert is the CEO and founder of a premier patent search firm ranked by IAM Strategy 300 as one of the world's top IP strategists, with extensive experience as an expert witness in patent research. He is renowned for his patent search acumen related to prior art estoppel. He served as a senior patent analyst and examiner at the PTO for more than 10 years.

The Outcome

The case was determined entirely in favor of the plaintiff with a nine-figure verdict. The jury found that the infringement was intentional, opening the door for treble damages.

Expertise Is Key in Today's Medical Device IP Disputes

The pace of innovation in medical technology continues its upward trend. Emerging technologies in this industry include medical robots, 3D printing of implants, and minimally invasive devices. The surge in AI advances has led to a substantial increase in patent applications globally. And while AI systems cannot be named inventors on a US (or UK) patent application, there remains potential for AI-generated data to influence innovation in the med-tech industry.

Companies that innovate to improve the delivery of patient care are best served by filing early in the inventive process and protecting and defending their portfolio of patents when necessary. The immediate challenges to doing so will be the lack of AI regulation and the concomitant difficulty in patent enforcement in this rapidly transitioning IP environment.

How IMS Can Help

IMS provides access to the top consulting and testifying experts in the medical device industry. Whether you require an expert to offer pre-market patentability advice, consult on managing risk in your patent portfolio, or testify in your patent dispute, our proven process ensures you find exactly who you are looking for. Contact our team to start your custom expert witness search today: contactus@imslegal.com

IMS knows the subject matter authorities across every industry and discipline. No matter your specific needs, IMS will locate and deliver the [best-aligned expert witness](#).

Let's find your expert: contactus@imslegal.com

IMS Legal Strategies is a professional services firm that partners with the most influential global law firms and corporations to elevate their legal strategies. Through every stage of dispute resolution, IMS provides the full suite of sophisticated advisory services lawyers need to prevail—world-class expert witness placement, specialized litigation consulting, cutting-edge visual advocacy, and flawless presentation delivery using state-of-the-art technology. Whether our consultants are placing independent custom-search or in-house expert witnesses, developing themes and demonstratives, preparing witnesses for depositions and hearings, conducting focus groups and mock trials, or guiding jury selection and voir dire, we work collaboratively with our law firm partners to strengthen their cases. IMS offers a fully integrated international team with decades of practical experience in more than 45,000 cases and 6,500 trials. Our trusted expertise is hard-earned. Together, we win. Visit imslegal.com for more.