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Could machines take over the world of patent translations?

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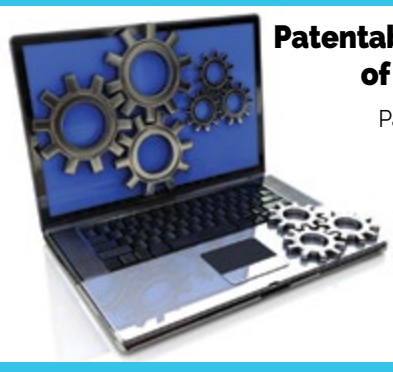
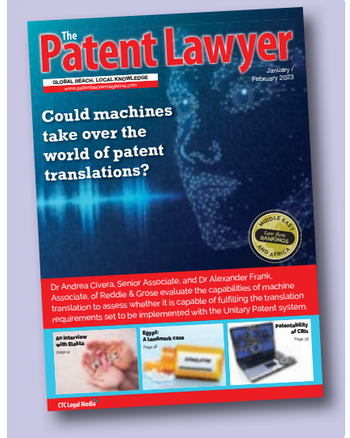
Dr Andrea Civera, Senior Associate, and Dr Alexander Frank, Associate, of Reddie & Grose evaluate the capabilities of machine translation to assess whether it is capable of fulfilling the translation requirements set to be implemented with the Unitary Patent system.



CTC Legal Media



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Editor's welcome

Our cover story this issue, firmly situated amongst the continued discussion of AI capabilities, calls into question the reliability of machine translation and asks whether it can be successfully utilized for fulfilling the translation requirement set to be implemented with the Unitary Patent system. The authors, whose mother tongue is not English, pit their own translations against that of AI to draw an interesting conclusion.

Our guest interview this issue is with Vandita Chandrani, Associate General IP Counsel at Elekta. With very honest advice, Vandita offers key insight into the desirable qualities and working setup for outside counsel and expresses the importance of knowing how practices work on both sides of the fence.

> ***"Calls into question the reliability of machine translation."***

Further, find out how IP management technology is helping firms thrive through task management, simplification, time-saving and more; learn about Apple and Microsoft's Editor's Choice app that is becoming the document analysis tool of choice for Patent professionals; and understand why India is calling for a revision relating to the patentability of computer related inventions.

This issue's *Women in IP Leadership* segment features Susi Fish, Partner at Boult Wade Tennant and Pranita Dharmadhikari, CEO, Innocelf, LLC. Contact us to discuss how you can support this segment.

This and more. Enjoy the issue.

Faye Waterford, Editor

Mission statement

The Patent Lawyer educates and informs professionals working in the industry by disseminating and expanding knowledge globally. It features articles written by people at the top of their fields of expertise, which contain not just the facts but analysis and opinion. Important judgments are examined in case studies and topical issues are reviewed in longer feature articles. All of this and the top news stories are brought to your desk via the printed magazine or the website *www.patentlawyermagazine.com*

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In a career spanning over four decades, Pravin has emerged as an IP trailblazer having strengthened India's IP jurisprudence with a practice encompassing all areas of IP litigation including patents, copyright, design, trademarks, enforcement and dispute resolution.

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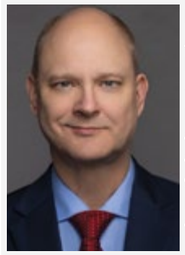
Rafael oversees the Patent, Trademark, Copyright, Plant Breeder's Rights, Internet, and Enforcement Groups. Served in the Mexican Association for the Protection of Intellectual Property AMPPI, AIPPI Mexican group. Current Vice-Chair of AIPPI's Standing Committee on PCT. Appointed INTA's Trademark Office Practices Committee 2022-2023.



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Osamu is a patent attorney specializing in the fields of biotechnology, pharmaceuticals and diagnostics. Osamu is extensively experienced in all aspect of patent issues in these technical fields.

The Patent Lawyer **would like to thank the Editorial Board for their time and support.**

Could machines take over the world of patent translations?

Dr Andrea Civera, Senior Associate, and Dr Alexander Frank, Associate, of Reddie & Grose evaluate the capabilities of machine translation to assess whether it is capable of fulfilling the translation requirements set to be implemented with the Unitary Patent system.

In view of the UPC system entering into force on 1 June 2023, two Reddie & Grose attorneys whose mother tongue is not English have attempted to gauge how good machine translations are compared with their own human translations.

Languages at the EPO

Under EPO practice, an application is most often filed in one of its official languages – English, French and German. If filed in another language of an EPC-contracting state, a translation of the specification into one of the three EPO official languages has to be provided within two months of the date of filing.

The thus selected official language becomes 'the language of the proceedings', and is used during prosecution of the application for all communications between the applicant and the EPO. When the EPO informs the applicant that it intends to grant them a patent, the applicant must file translations of the claims in the other two official languages. For post-grant validation at national level, the EPC-contracting states have the right to require for the specification to be translated into one of their national languages.

Translations in the UPC

Ever since the UP system negotiations began, issues relating to languages have been the subject of some intense debate. Some countries worried that extending the tri-language regime in force at the EPO beyond the limits of its jurisdiction could have been prejudicial to individuals whose mother tongue was not one of the EPO's official languages. For this reason, the EU reverted to the so-called 'enhanced cooperation' process, by which Spain and Italy were excluded from the UP system. Italy subsequently reviewed its position and eventually joined the UP system.

The rules relating to the language requirements for Ups were published in the EU Official Journal as EU Council Regulation No. 1260/2012 on 17 December 2012 and have not been reviewed or updated since. These rules provide for a transitional period, during which a request for unitary effect must be accompanied by a full translation of the specification of the patent into English where the language of the proceedings before the EPO is French or German, or into any official language of the Member States that is an official language of the Union where the language of the proceedings before the EPO is English.

This provision was introduced at the time as a way to ensure that during the transitional period all European patents with unitary effect would be made available in English, which is the language most commonly used in the field of international technological research and for scientific publications. Additionally, this guaranteed that during the transitional period a fraction of all European patents with unitary effect would effectively be made available in other official languages of the participating Member States.

Interestingly enough, the rules published in 2012 also indicated that the transitional period should terminate as soon as high-quality machine translations into all official languages of the Union become available, subject to a regular and objective evaluation of the quality by an independent expert committee established by the participating Member States. Given the state of technological development at the time, the rules also indicated that the duration of the transitional period was not expected to exceed 12 years after entry into force of the UPC Agreement.

At the same time, the rules very clearly established that machine translations should serve for information purposes only, and should not have any legal effect, and further advised that, during the transitional period, the translations to be filed with the request for unitary effect should not be carried out by automated means. This was so the high quality of human-made translations would contribute to the training of translation engines at the EPO.

It is fair to imagine that the legislators who came up with the 12-year transitional period in 2012 assumed that, by now, the UP system would have been up and running. And yet, 10 years later, as we prepare to potentially see the first European patents with unitary effect be granted early in 2023, we wonder if it may not be time to reassess those translation requirements, and reconsider the state of technological development as far as machine translations are concerned.

Machine translations

The research activity in the field of machine translations began at the MIT, the University of Washington, and at the University of California in the early 1950s. Impressed as they were with the potential of machine translation, the US government supported this technology with a view to expanding the capacities for translation of scientific and intelligence data. However, no later than in 1964, a special committee – the Automatic Language Processing Advisory Committee (ALPAC) – formed by the US government to investigate and evaluate the situation with the machine translation researches recommended that further investments in machine translation research be suspended, as there was "no immediate or predictable prospect of useful machine translation". Machine translation was deemed to be slower, less accurate, and twice as expensive as human translation, and so the ALPAC report recommended that focus be placed instead on automatic dictionaries and researches.

As is often the case, technology has progressed much faster than the seven members of ALPAC could have imagined, and in the 1980s the research activity took off again with renewed intensity. New methods and strategies of machine translation emerged in the 1990s. Work on statistical methods inspired researchers because of the increasing power of computers, memory capacity, and lower costs. Translation began to be done by estimating the likelihood that a word in a source sentence language corresponds to a word in the target language sentence, in view of aligned phrases and words in the parallel texts. More recently, the emerging of deep learning models has further boosted this area of research.

Dr Andrea Civera

Dr Alexander Frank

Exemplary translations of claim 1 of G1/21

But how far have machine translations got, as of today? The authors have attempted to gauge this by personally translating claim 1 of EP 1609239 B1 (which was at the center of the recent G1/21 decision) into their respective native languages (German and Italian) and then comparing their

Résumés

Dr Andrea Civera

Dr Andrea Civera joined Reddie & Grose in 2013, having previously worked for an Italian IP firm. Andrea completed his studies in Italy and holds a MEng and a PhD in Chemical Engineering. His doctoral research at Politecnico di Torino focussed on environment-friendly applications of catalysts. He handles patent work in the general mechanical and applied chemical fields (materials processing, automated manufacturing processes, packaging, dispensing systems, tobacco products). As a patent attorney, he has worked extensively for multinational companies with a worldwide commercial presence, and has accordingly filed, prosecuted, and managed patent portfolios in many jurisdictions around the world.

Dr Alexander Frank

Dr Alexander Frank joined Reddie & Grose in 2016 and handles a variety of cases in the life sciences sector, including molecular biology, biotechnology, immunology, biopharma, disease diagnostics, pharmaceuticals and medical devices. Alexander completed his undergraduate degree in Germany and holds a BSci in Biosciences and an MSci in Molecular Biotechnology. He gained extensive technical knowledge and experience through his doctoral research at the University of Cambridge which focussed on circadian rhythms. During his PhD, he was awarded three prizes for the best 1st and 3rd year talks as well as the best 2nd year poster presentation.

own human translations with machine translations obtained from Patent Translate (powered by EPO and Google) and from Google Translate. The results are shown in the following Tables, and differences between each machine translation and the corresponding human translation appear in bold.

GRANTED CLAIM 1 of EP 1609239 B1 (G1/21)

1. An amplifier (20) comprising:
a plurality of amplifier circuits (22, 24) including a first amplifier circuit (22) and at least one second amplifier circuit (24), the amplifier circuits (22, 24) having a reflection coefficient (Γout) at their output, looking into the outputs of the amplifier circuits (22, 24);
at least one hybrid coupler circuit (44) having an output port (28) and an isolation port (29) and coupled to combine output signals (40, 42) of the amplifier circuits at the coupler output port; and
a termination coupled at the isolation port (29) of the coupler circuit (44), characterized in that the termination comprises a length of transmission line (50) that is terminated with an electrical open circuit or an electrical short circuit, the termination having a reflection coefficient (Γγ), looking into the termination, related to the reflection coefficient (Γout) at the outputs of the amplifier circuits (22, 24), according to one of the following relationships:

ang (Γγ) = 180 deg − ang (Γout)

and

ang (Γγ) = − ang (Γout).

Granted Claim 1 of EP 1609239 B1 (G1/21)

ITALIAN HUMAN TRANSLATION

1.Amplificatore (2) comprendente:
una pluralita' di circuiti amplificatori (22, 24) comprendente un primo circuito amplificatore (22) ed almeno un secondo circuito amplificatore (24), i circuiti amplificatori (22, 24) avendo un coefficiente di riflessione (Γout) alla loro uscita, guardando alle uscite dei circuiti amplificatori (22, 24);
almeno un circuito accoppiatore ibrido (44) avente una porta di uscita (28) ed una porta di isolamento (29) ed accoppiato per combinare segnali in uscita (40, 42) dei circuiti amplificatori alla porta di uscita dell'accoppiatore; e
una terminazione accoppiata alla porta di isolamento (29) del circuito accoppiatore (44), caratterizzato dal fatto che la terminazione comprende un tratto di linea di trasmissione (50) che e' terminato con un circuito elettrico aperto o un cortocircuito elettrico, la terminazione avendo un coefficiente di riflessione (Γγ), guardando alla terminazione, correlato con il coefficiente di riflessione (Γout) alle uscite dei circuiti amplificatori (22, 24), secondo una delle seguenti relazioni:

ang (Γγ) = 180 deg − ang (Γout)

e

ang (Γγ) = − ang (Γout).

Italian Human Translation

ITALIAN MACHINE TRANSLATION #1 - Patent Translate (powered by EPO and Google)

Un amplificatore (20) comprendente: una pluralità di circuiti amplificatori (22, 24) comprendenti un primo circuito amplificatore (22) ed almeno un secondo circuito amplificatore (24), i circuiti amplificatori (22, 24) avendo un coefficiente di riflessione (Γ fuori) alla loro uscita, **esaminando le** uscite dei circuiti amplificatori (22, 24);
almeno un circuito accoppiatore ibrido (44) avente una porta di uscita (28) e una porta di isolamento (29) e accoppiato per combinare segnali **di** uscita (40, 42) dei circuiti amplificatori alla porta di uscita dell'accoppiatore; e
una terminazione accoppiata alla porta di isolamento (29) del circuito accoppiatore (44), caratterizzata dal fatto che la terminazione comprende un tratto di linea di trasmissione (50) che **termina** con un circuito elettrico aperto o un cortocircuito elettrico, la terminazione avendo un coefficiente di riflessione (ΓY), guardando alla terminazione, relativo al coefficiente di riflessione (Γfuori) alle uscite dei circuiti amplificatori (22, 24), secondo una delle seguenti relazioni:

ang (Γγ) = 180 deg − ang (Γout)

e

ang (Γγ) = − ang (Γout).

Italian Machine Translation #1 – Patent Translate (powered by EPO and Google)

ITALIAN MACHINE TRANSLATION #2 - Google Translate

Un amplificatore (20) comprendente:

una pluralità di circuiti amplificatori (22, 24) comprendenti un primo circuito amplificatore (22) ed almeno un secondo circuito amplificatore (24), i circuiti amplificatori (22, 24) avendo un coefficiente di riflessione (Γ out) alla loro uscita, guardando nelle uscite dei circuiti amplificatori (22, 24);

almeno un circuito accoppiatore ibrido (44) avente una porta di uscita (28) e una porta di isolamento (29) e accoppiato per combinare segnali di uscita (40, 42) dei circuiti amplificatori alla porta di uscita dell'accoppiatore; e

una terminazione accoppiata alla porta di isolamento (29) del circuito accoppiatore (44), caratterizzata dal fatto che la terminazione comprende un tratto di linea di trasmissione (50) che termina con un circuito elettrico aperto o un cortocircuito elettrico, la terminazione avendo un coefficiente di riflessione (Γ Y), guardando alla terminazione, **relativo al** coefficiente di riflessione (Γ out) alle uscite dei circuiti amplificatori (22, 24), secondo una delle seguenti relazioni:

ang (Γγ) = 180 deg − ang (Γout)

e

ang (Γγ) = − ang (Γout).

Italian Machine Translation #1 – Google Translate

GERMAN HUMAN TRANSLATION

1. Verstärker (20), der Folgendes umfasst:
mehreren Verstärker-Schaltungen (22, 24) einschließlich einer ersten Verstärker-Schaltung (22) und wenigstens einer zweiten Verstärker-Schaltung (24), wobei die Verstärker-Schaltungen (22, 24) einen Reflexionskoeffizienten (Γ out) mit Blick in die Ausgänge der Verstärkerschaltungen (22, 24) an ihrem Ausgang haben;
wenigstens eine Hybridkopplerschaltung (44), die einen Ausgangsport (28) und einem Isolationsport (29) besists und so gekoppelt sind, dass sie Ausgangssignale (40, 42) der Verstärkerschaltungen am Kopplerausgangsport kombiniert; und
einen am Isolationsport (29) der Kopplerschaltung (44) gekoppelten Abschluss, welcher dadurch gekennzeichnet, dass der Abschluss eine Länge der Übertragungsleitung (50) umfasst, die mit einem elektrischen Leerlauf oder einem elektrischen Kurzschluss abgeschlossen ist, wobei der Abschluss einen Reflexionskoeffizienten (Γ Y) mit Blick in den Abschluss hat, der auf den Reflexionskoeffizienten (Γ out) an den Ausgängen der Verstärkerschaltungen (22, 24) gemäß einer der folgenden Beziehungen bezogen ist:

ang Γ Y = 180° - ang Γ out
und
ang Γ Y = - ang Γ out .

German Human Translation

GERMAN MACHINE TRANSLATION #1 - Patent Translate (powered by EPO and Google)

1. Verstärker (20), der Folgendes umfasst:

mehrere Verstärkerschaltungen (22, 24) einschließlich einer ersten Verstärkerschaltung (22) und wenigstens einer zweiten Verstärkerschaltung (24), wobei die Verstärkerschaltungen (22, 24) einen Reflexionskoeffizienten (Γ out) mit Blick in die Ausgänge der Verstärkerschaltungen (22, 24) an ihrem Ausgang haben;

wenigstens eine Hybridkopplerschaltung (44) ~~die einen~~ **mit einem** Ausgangsport (28) und einem Isolationsport (29) ~~besists~~ und so gekoppelt **sind**, dass sie Ausgangssignale (40, 42) der Verstärkerschaltungen am Kopplerausgangsport kombiniert; und

einen am Isolationsport (29) der Kopplerschaltung (44) gekoppelten Abschluss, ~~welcher~~ dadurch gekennzeichnet, dass der Abschluss eine Länge ~~der~~ Übertragungsleitung (50) umfasst, die mit einem elektrischen Leerlauf oder einem elektrischen Kurzschluss abgeschlossen ist, wobei der Abschluss einen Reflexionskoeffizienten (Γ Y) mit Blick in den Abschluss hat, der auf den Reflexionskoeffizienten (Γ out) an den Ausgängen der Verstärkerschaltungen (22, 24) gemäß einer der folgenden Beziehungen bezogen ist:

ang Γ Y = 180° - ang Γ out

und ang Γ Y = - ang Γ out .

German Machine Translation #1 Patent Translate (powered by EPO and Google)

GERMAN MACHINE TRANSLATION #2 - Google Translate

1. **Ein** Verstärker (20), **der Folgendes ~~umfasst~~ bestehend aus:**
~~mehreren Verstärker-Schaltungen~~ eine Vielzahl von Verstärkerschaltungen (22, 24), einschließlich einer ersten Verstärkerschaltung (22) und **wenigstens ~~mindestens~~** einer zweiten Verstärkerschaltung (24), wobei die Verstärkerschaltungen (22, 24) einen Reflexionskoeffizienten (Γ out) **mit Blick in an ihrem Ausgang aufweisen**, wobei die Ausgänge der Verstärkerschaltungen (22, 24) **~~an ihrem Ausgang haben~~ untersucht werden;**
~~wenigstens~~ mindestens eine Hybridkopplerschaltung (44) **~~die einen~~ mit einem** Ausgangsport (28) und einem Isolationsport (29) **~~besists~~** und **~~so~~** gekoppelt **~~sind, dass sie~~ um** Ausgangssignale (40, 42) der Verstärkerschaltungen am **~~kombiniert~~** Kopplerausgang **zu kombinieren;** und
einen **~~am Isolationsport~~ Anschluss, der an der Isolationsöffnung** (29) **~~der Kopplerschaltung~~ des Kopplerstromkreises** (44) **~~gekoppelten Abschluss, welcher~~ gekoppelt ist,** dadurch gekennzeichnet, dass der Abschluss eine Länge der Übertragungsleitung (50) umfasst, die mit einem elektrischen **~~Leerlauf~~ offnen Stromkreis** oder einem elektrischen Kurzschluss abgeschlossen ist, wobei der Abschluss einen Reflexionskoeffizienten (Γ Y)
~~mit Blick~~ aufweist, der in den Abschluss **~~hat, der~~ blickt, bezogen** auf den Reflexionskoeffizienten (Γ out) an den Ausgängen der Verstärkerschaltungen (22, 24) **~~gemäß,~~ nach** einer der folgenden Beziehungen **~~bezogen~~ ist**:

ang Γ Y = 180° **deg -** ang Γ out
und
ang Γ Y = - ang Γ out .

German Machine Translation #2 – Google Translate

Concluding remarks

It is immediately apparent that both Italian and German machine translations match almost *verbatim* the human translation, the only minor discrepancies coming down to essentially formal aspects.

Of course, we don't mean to argue that a single example, i.e. claim 1 of G1/21, can be taken as an indication of a general trend, but we do feel that almost 10 years after their publication the rules of EU Council Regulation No. 1260/2012 should be reviewed; perhaps the duration of that provisional period or even the absolute veto on machine translations for information purposes could be reconsidered.

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An interview with Vandita Chandrani, Associate General IP Counsel at Elekta

Vandita sits down with The Patent Lawyer to discuss her experiences as an in-house patent attorney in the medical industry and at Elekta, the company bringing hope to those dealing with cancer.

Can you describe your pathway into IP?

I'm a big believer in following the wind and that's exactly how I ended up in the world of IP. I first did a degree in Electronic Engineering, really enjoyed the medical portion of that and went on to do a Master's in Medical Electronics and Physics. Off the back of that, I received an offer to work as a Trainee Clinical Scientist carrying out research on ultrasound equipment at a hospital in London.

Around the same time a friend of my brother's, a Patent Attorney working in Private Practice, asked if I had ever considered being a Patent Attorney as firms were crying out for people with a technical background in Electronics. I was six weeks away from starting the research job, with a four week notice period, so I had a very short window of time to consider it and I had very little knowledge at that time of patents and what a patent attorney might do. But I knew that my passion for technology did not lie in lab work and, after some initial research, patents felt like a perfect fit. I would be able to use my science background in a way that focused more on linguistic skills, was not lab-based and, ultimately, paid better. I went to Inside Careers, a booklet that had available positions advertised in alphabetical order, and promptly applied for a couple of positions at patent firms under A and B. Beck Greener offered me a job the following week. I resigned from the job I hadn't started and instead became a Trainee Patent Attorney.

I trained and qualified as a European and UK Patent Attorney at Beck Greener, beginning in 2001, qualifying in 2005, and leaving in 2008. My decision to leave was largely based on the nature of patent private practice firms and my own interests and personality. The largest part of my job was to liaise with international clients/patent firms – typically over email, sometimes by phone and rarely in person – and to draft and prosecute patent applications. For some time, I was the responsible attorney for a clinic that we ran for what I would call "inventors off the street" where we would give 45-minute free advice to people from small outfits or entrepreneurs. I really enjoyed running this clinic and the interaction with these enthusiastic inventors, but I didn't particularly enjoy having to bill and account for all my time carrying out the more traditional work. I'm an incredibly sociable person - for extra context, in the time that I was at Beck Greener I was also Informal's Social Secretary and then the Honorary Secretary - and the law firm set up of working in an office by myself and only interacting with other people when going for coffee or lunch wasn't the right fit for me.

Vandita Chandrani

At this time, one of my best friends had moved from private practice to working in-house at BP which gave me an insight into the life of an in-house patent attorney. It seemed like it may be better suited to me and when, by chance, a recruiter contacted me and asked me to consider a private practice position, I instead suggested they notify me of in-house positions that aligned with my academic background. From there, I applied to both Procter & Gamble and Cannon and took the position at Procter & Gamble.

At the time I was recruited, Procter & Gamble was very much a promote-from-within company, but they had acquired The Gillette Company with offices in the UK and, since the P&G attorneys were all chemists, they needed someone with a mechanical background to handle the work. I was at P&G for 10 years, during which I spent three and a half years in the UK supporting Gillette; four years in Singapore supporting their Beauty & Packaging businesses before landing in Germany to support their Feminine Hygiene business.

How long have you been with Elekta and what attracted you to the company?

I will have been at Elekta for four years in April. At the time I saw the Elekta role advertised, I was thinking of my route home from Germany. Having been abroad for nearly six years, I was ready to come back home. My first thought was to explore options within P&G as I mostly loved working there. But there was a part of me that wanted to return to the world of MedTech - I wanted a job that was good for my soul. It was pure coincidence (or fate!) that I saw the job advert for Elekta at this time and it ticked all of the boxes in spades – I would only leave P&G for the right job and this one had what I was looking for.

What developments have you worked on during your time at Elekta?

An exciting development I've recently worked on just launched – Elekta has a product called Unity[1], an MR Linac that has been on the market for a few years. Innovation that supports the machine has continued to evolve resulting in technology known as Comprehensive Motion Management. This enables the tracking of cancerous tumors in the body in real time and switches the radiation beam off if the tumor moves out of the target region. This focuses radiation treatment on the tumor while minimizing the dose applied to healthy organs. Before launch, we filed multiple patent applications directed towards unique aspects of the technology along with assisting with ancillary IP related matters, including ensuring we have the right contracts in place and that we're not infringing rights belonging to others. Having insight and access to ground-breaking technology like this that can help improve the lives of those dealing with cancer is certainly good for my soul!

> **"This enables the tracking of cancerous tumors in the body in real time and switches the radiation beam off if the tumor moves out of the target region."**

[1] https://www.elekta.com/products/radiation-therapy/unity/

What challenges do you face in your role?

Our main challenge is that we are a very slim-line department with a lot of work to do. We're a global company and, at present, have just three patent attorneys and one formalities officer. We are having to meet the needs of the entire company which has multiple business lines, each with different business models. Additionally, the nature of the business is continually evolving, with a greater focus on software vs traditional hardware based innovation. We are also continually trying to improve IP processes within the organization. This is challenging when we're busy fighting fires left, right, and center but need to carve out time to put the foundations in place so that, one day, we'll have a fire station rather than just a fire engine.

How do you use outside counsel at Elekta?

We use outside counsel for all our drafting and prosecution needs and for litigation. We did not have reliable docketing software up until two years

Often, it's hard for people to see inventions when it's such an integral part of their day-to-day business. So we continually train our inventors and educate them on what may/may not be patentable.

ago, so we were 100% reliant on the records that outside counsel were keeping about our cases. While we still rely heavily on our outside counsel, we're being smarter with our money and placing the focus on value-added work rather than basic admin.

What qualities do you value in outside counsel?

We use our outside counsel as an extension of our department and we really value straight-forward and honest engagement and that goes across the board from work processes, feedback about how best to work, negotiations about price, and fundamentally - our assets.

As an example, if we receive an office action we want our outside counsel to give us an informed opinion about what the examiner has said, rather than just saying "the examiner said that claim four is novel and inventive therefore we'll just amend to that,". We want them to say, "actually, the examiner has missed the point and I think we can fight for claim one." We have routinely organized Elekta IP days where we invite our outside counsel to our offices to show them our machines and our manufacturing facilities and provide them with an insight into the nature and commercial interests of our business. We want them to understand and care about what we do so that they are able to give us the best service possible.

Additionally, we like to know who the team is. We don't want a partner to be the only face that we see to then discover there is an army of trainees or associates that we don't know in the background doing the work. We have asked our outside counsel to align their staff to our technology areas to enable individuals to build up expertise in their respective areas and to ensure consistency for us. In turn, we involve them in our conversations with inventors and give them the background about why we're doing things and I believe this makes them more invested in what we're doing. I also know how much I would have appreciated this kind of engagement when I was working in private practice – then it was very much a case of receiving instructions to do something, carrying out the task and sending it back. There was little discussion about the commercial rationale behind what I was doing and, as such, it was much harder to be fully invested beyond the need to generate revenue.

What strategies do you implement to capture and protect IP?

Trying to forge proper strategies that are effective here is a constant challenge. We use a multilayered approach; our IP savvy inventors will submit ideas via an inventor portal that we established two years ago; but there are many within the organization that are not (yet!) IP savvy. For them, we have to be much more involved and proactive, for example, carrying out "scrubs" of different technology areas to understand what people have been working on and foraging for potential IP. Often, it's hard for people to see inventions when it's such an integral part of their day-to-day business. So we continually train our inventors and educate them on what may/may not be patentable.

What advice would you offer to those considering a change to an in-house role?

Ultimately, there are no two in-house departments that are the same – even at the same company. I held three different roles at Procter & Gamble and my experience was different in each – a lot of which is down to the organization's size, history, and the managers.

If considering an in-house role, make sure to interview the company and learn as much as possible about their ethos, the way the company works, and where people are based because these aspects will significantly affect the experience. The right match will depend on whether a person wants a more diverse role that ranges from, for example, invention capture and filing strategies to review of IP clauses in software licenses and R&D agreements and managing global litigation strategies compared with a more structured, traditional patent role in a larger department.

I believe that the best Patent Attorneys will have experience of life both in-house and in private practice and here at Elekta, we've hosted secondments to provide our outside counsel trainees with an insight into how an in-house department may work. We recently had a secondee join us for a month ahead of their UK finals and I am confident that it's given her some extra context for the nature of our work and, probably, for some of her exam questions! An aspect I enjoy about being in-house is that I see innovation end-to-end – I understand what we're trying to achieve, how and why the innovation, and accompanying IP, is so valuable. I will never get tired of seeing products/innovation that I have worked on out in the world – on a shelf or in a hospital - or of how the IP rights I've helped generate may impact and influence our competition.

I am a massive advocate of working in-house but it does require a willingness to proactively engage with people. It also requires a certain degree of dynamic thought – every day is different and I am frequently faced with questions and issues that I have not previously encountered – sometimes not even always IP related!! But ultimately, it is this slightly uncertain (and sometimes hectic!) nature of the work I do that I thrive on and love and, at least for me, in-house is where I belong!

How IP management technology is helping firms thrive

Tom Parish, Commercial Director at Equinox, explains the depths that an IPMS can offer to law firms by simplifying task management, saving time, reducing complexity, and pleasing clients.

Technology has had a dramatic effect on the intellectual property profession. The lengthy, paper-based processes of the past have given way to advanced software solutions that make managing patents and trademarks quicker and simpler.

Moreover, with the power to better manage the mountain of tasks faced by IP professionals and save them valuable time, IP management software has proven to reduce the complexity of processes to deliver real, tangible advantages. Ultimately, these solutions enhance the capacity of firms and provide a better experience for clients.

IP technology is marketed under lots of different names. IP management systems, docketing software, patent management software – this technology has matured in recent years, and the solutions available today are refining the processes used by legal professionals across the world. There has never been a better time to think about adopting a new system.

But precisely how does IP management software help a firm? Tom Parish is the Commercial Director at Equinox, one of the world's fastest-growing intellectual property management system (IPMS) providers. In this article, he explores the specific features of such technology and demonstrates how it can benefit IP professionals across the world.

Simplify task management

IP professionals face a mountain of tasks, and juggling deadlines, applications, renewals, and finance across a range of clients can be a daunting prospect. Keeping track of dates and activities requires careful planning that can be a burden on organizations and their processes. It is these challenges that IP management software aims to circumvent. Fundamentally, an IPMS will make it easier for you to manage tasks: it tells you what task you need to do and when you need to do it, minimizing the time-consuming planning needed in your processes and drastically reducing the opportunities for human error.

Tom Parish

IP management software can also keep your whole team working together, it is not just for attorneys. Everyone from a managing partner to a paralegal or legal assistant can use the software to manage their individual tasks, plus your finance team can see everything they need to handle with minimal input from those managing cases. With all your team on one platform, you can work more cohesively and deliver more effective services to your clients.

Every firm works a little differently and a one-size fits all approach is not always suitable. At Equinox, we have designed our IP management system to be customizable to make it fit the needs of each firm. This applies to everything from the template emails it generates to the language used in the interface, and by refining your system to fit the way your firm likes to work, you can further enhance the benefits gained from using an IPMS. We get plenty of positive feedback from our subscribers, who consider our system an invaluable tool for managing intellectual property, and the option to refine

Résumé

Tom Parish, Commercial Director of Equinox

Since joining in 2012, Tom Parish has been one of the key figures in developing Equinox into the renowned IP management platform it is today. Working closely with subscribers, Tom employs his extensive knowledge of the IP management process to lead the Equinox team in delivering an intuitive system and unparalleled services to IP professionals across the world.

Equinox to their unique processes improves their experience even further.

Save valuable time

By helping you manage your tasks, an IP management system can also save you a great deal of time.

With integrated document management, invoicing, correspondence, and a variety of templates, an IPMS enhances your existing processes and can provide what you need when you need it. Wrestling with endless files, emails, letters, and notes on a case can add up quickly to occupy precious hours.

IP management systems keep all a case's files in one place: every application, draft document, and official communication handled by your team is stored in a single location to make it as easy as possible to find the information you need. Having a smart system that automatically organizes this for you saves time, freeing you up to focus on the cases themselves.

Correspondence is another task that eats up time. Writing, following up, and filing emails and letters to clients, patent offices, and other attorneys can seem like an endless cycle, but an IP management system offers solutions. In the Equinox system, template emails are automatically generated, it is ready with your case's details so you can fill in the final information. These templates, which can be sent directly from the system or exported to Outlook or Gmail, cut a significant chunk of the work needed to manage communications. They are also automatically organized within the relevant case to further ease the document management process.

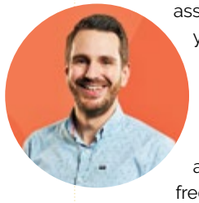
Every member of your team will have different needs that must be provided for. Attorneys tell us that time management and billing solutions are some of the most helpful features of our software. In Equinox IPMS, we have a built-in timing function that allows an attorney to accurately account for the time they take handling a task to allow for precise billing, and our invoice generation feature reduces the time needed to manage a client's administration. Tasks like these can seem small, but they quickly stack up and take resources away from the focus of an attorney's role.

Reduce complexity

Legal professionals rely on a variety of software solutions to manage their cases. With everything from emails to finance software requiring attention, it can be hard to keep track of changes across every service you use. An IP management system can bring all these elements together in one place, allowing you to handle the full life cycle of a case from within the system.

Having a system that integrates with your other services reduces complexity, allowing you to oversee every element of a case's management in one location and automate your activity across platforms. As mentioned already, in Equinox IPMS emails and document management is handled within the system, but we also have built-in integrations with a host of other services such as Microsoft Office, Xero, Sage, and others, so our subscribers do not need to leave the system to manage a case throughout its lifecycle.

Opting for a cloud-based IP management system can prevent headaches for your firm. Mark Richards, Lead Operations Engineer at Equinox, explains the key advantages.



"Having the ability to access your system from anywhere on any device is an invaluable asset for any IP professional. It means you can respond to communications and emergencies without delay, reassuring your clients. Your provider takes care of the storage, backups, and maintenance of your service, leaving you free to spend your time and resources on more important work.

"Adopting an IP management system also allows firms to benefit from the multi-layered security offerings by Microsoft, one of the world's leading cloud providers. The built-in protection against denial of service (DDoS) attacks ensures the physical and technical security of your data. The IP management system provider itself delivers high service availability and disaster recovery protection. Alongside frequent and secure backups of your data, these provide peace of mind for yourself and your clients.

"The performance of your software can be scaled to meet your needs, increasing in line with your business growth when you need it to. When your firm grows, and you take on more clients, your software can grow with you to keep your team delivering great results."

> **At Equinox, we have designed our IP management system to be customizable to make it fit the needs of each firm.**

Subscribers switch to Equinox IPMS from all kinds of setups. Some already use an IP management system that is not catering to their needs, some manage their cases with their own software or Microsoft Office tools, and some are completely paper-based. But whatever organizational system they use at the start, all experience an efficiency boost after adopting a cloud-based system, finding that it is easier to access information, quicker to handle tasks, and simpler to keep the whole team on track.

Keep clients happy

Ensuring a strong communications channel with clients is vital for IP professionals. It is enormously encouraging for clients to have visibility of how their cases are progressing and offering this instills confidence in your services. There are different ways to achieve this, and the traditional channels of regular updates and meetings will always have their place. However, IP management technology can offer an additional opportunity for your clients to keep tabs on your progress.

Some IP management systems offer client access solutions that provide independent visibility on the progress of cases and the status of intellectual property without having to send any updates manually. In Equinox IPMS, our subscribers' clients can view the cases and property under management through a client access portal. This round-the-clock access to case progress information ensures clients are confident in the services being provided for maximum transparency and can reduce the number of meetings and calls needed throughout the lifecycle of a case.

Access to dependable support is always a priority for clients, and your firm should be no different. Adopting a reliable IP management system simplifies processes and makes it easier for a firm to maintain control over the information it handles. On-premises IP management systems can be difficult to manage, and when something goes wrong, it could take a while to get back on track. Equinox subscribers have constant access to a team of system experts: because they know the software so well, they know how to identify, isolate, and respond to a problem as fast as possible.

> **Access to dependable support is always a priority for clients, and your firm should be no different.**

Summary

Ultimately, IP professionals and the firms they work in want to keep their clients confident in their services, and the practice of intellectual property law will always come down to the skill, experience, and expertise of those legal professionals. Adopting a reliable IP management system offers a great deal of support to those skills you have spent your career refining and can be the golden ticket to enhancing your processes for your whole firm.

A good IP management system manages and organizes every one of your tasks to reduce the planning burden and greatly reduce the opportunities for human error. With the whole team using a single system, and with all the information and services you need in one accessible platform, you will likely see a boost in the productivity of your organization. A more reliable, secure, and transparent system will be mirrored in your reputation to clients and support your well-practiced professional ability.

As Equinox has grown internationally, we have seen Intellectual Property firms from the largest to the smallest benefit from our software. The future industry leaders are those that embrace technology and earn the trust of potential clients through incredible results.

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A landmark patent case redefining pharmaceutical patent enforcement in Egypt

Nermien Al-Ali, Esq, Founder and Managing Partner of NAL Law Group, summarizes the case between Merck and Marcyrl over infringing generic pharmaceuticals that changed Egypt's perception of patent protection.

Pharmaceutical patent enforcement was a challenging goal for many multi-national pharmaceutical companies in Egypt for decades since the law only acknowledged pharmaceutical patents in 2000 for the first time. Pharmaceutical patent enforcement was practically impossible, despite it being possible on paper, considering the black letter law. The Economic Misdemeanor Court changed this reality in 2016 with the passing of a landmark judgment in a case of pharmaceutical patent enforcement. This not only instilled trust in the Egyptian legal system but also resulted – for the first time – in an affirmation in the US Special 301 report that pharmaceutical patents can indeed be enforced in Egypt.

Nermien Al-Ali

The facts of the landmark case go back to 2014 when a local pharmaceutical company called Marcyrl decided to produce a diabetes drug using SITAGLIPTIN, which is a new chemical entity protected by an Egyptian Patent in the name of Merck, Sharpe & Dohme Inc. (Merck). Despite legal warnings through court bailiffs, Marcyrl refused to stop producing and selling its infringing products. The then Ministry of Health (now the Egyptian Drug Authority) was also officially requested to cancel the drug registration of the infringing generic but refused to do so. The Ministry of Health at the time stated that according to the law, it is not required to check for patent protection upon issuing marketing authorizations to generics and that it has no system to check or scrutinize patented chemical entities. On that basis, the Ministry of Health opined that it would not cancel any market authorizations except if it was served with a binding court decision, and the patentee should resort to court to enforce patent rights. Our enforcement strategy was multi-faceted; first resorting to the criminal enforcement route under Articles 32 of Intellectual Property Law 82/2002 against the generic producer to stop the infringement, and second resorting to the administrative court to cancel the Ministry of Health's 'negative decision' refusing to cancel the drug/marketing authorization of the generic after being notified of patent rights.

Marcyrl put up a strong fight. After all the generic of SITAGLIPTIN was bringing in large profits given that the active ingredients were imported from India, instead of Europe, for a much lesser price. Competing on a price basis, Marcyrl was also able to bid for, and win, public tenders to supply public hospitals and other state organizations. Marcyrl tried for a while to influence the outcome of the cases by portraying Merck, and NAL as Merck's lawyers, as defenders of the financial rights of multi-national foreign companies against the national companies that serve poor Egyptian patients! Such pleas and statements to move national sentiments worked to a degree in the early 2000s, when the law was first implemented. The media at the time sided by the local generic companies and portrayed the matter as foreign colonial interest against local national interest. This resulted in negative public opinion against pharmaceutical patents, fear of bad publicity on the side of patent owners if they enforce their rights, and general reluctance to prosecute such matters against infringers. The most notable case at the time was the media and public attack on Pfizer for seeking to enforce its patent rights over Lipitor, a cholesterol-lowering medication, against the generic EPITOR produced by a major local company. This however is a matter of the past, and Marcyrl's attempt to repeat history failed and did not intimidate Merck in its determination to enforce its patent rights. To the surprise of Marcyrl, its attempt to exploit national sentiment did not work in 2015, when the market started looking at quality versus price.

Marcyrl, therefore, started looking for other legal arguments to defend its generics instead of stopping its continued patent infringement. Marcyrl first tried to use the limited knowledge about patent law at the enforcement, prosecution, and judicial levels by claiming that SITAGLIPTIN is protected by a United States Patent in the name of an Indian company, which licensed Marcyrl to use SITAGLIPTIN. Indeed, there was a US Patent covering a method to produce the crystalline form of SITAGLIPTIN. However, this was at best a derivative patent requiring a license from Merck before any production. Moreover, Merck also had an Indian Patent covering SITAGLIPTIN and took enforcement action against the Indian company exporting SITAGLIPTIN to Egypt in India. A detailed expert report from the Egyptian Patent Office explained to the court that the US Patent Marcyrl was using as the basis for its defense relates to a method of production and not the chemical entity itself and that in all cases its scope is limited to the geographical territory of the United States only. Thus, rebutting Marcyrl argument and clarifying to the court the territoriality concept of patent protection, as well as the scope of derivative or improvement patents.

> **Marcyrl put up a strong fight. After all the generic of SITAGLIPTIN was bringing in large profits given that the active ingredients were imported from India, instead of Europe, for a much lesser price.**

Marcyrl used another argument, and paid for an expert opinion supporting its argument, that the patent claims covered SITAGLIPTIN with any acceptable salt, but did not specifically mention SITAGLIPTIN phosphate mono-hydrate (the composition of the generic), which should be excluded from the scope of the patent. This required considerable learning on our side as legal counsel, and on the side of the court as legal practitioners, to understand the difference between the active pharmaceutical ingredient (API), and the various generic or non-active salts

Résumé

Nermien Al-Ali, head of NAL LAW Group, and expert Intellectual Property Trainer at NAL LAW Academy, recognized in 2015 by Legal500 as best IP Lawyer in Egypt. Graduated from Sydney University, Australia, and obtained Masters in Intellectual Property from Franklin Pierce Law Center, USA in 2000. She was Research Professor at the Law Center (2001-2003), teaching IP Management and authoring the Comprehensive Intellectual Capital Model, published in New York in 2001. She returned to Egypt to head the IP practice of two major law firms until establishing NAL LAW in 2012. She is the IP Counsel of Apple, Merck, and Egyptian Banks Company among others.

that need to be combined with it in forming the end-product. To explain this to the Economic Court, which had limited exposure to patent enforcement cases, we first had to object to the expert opinion presented by Marcyrl as 'self-made evidence', and requested the appointment of a pharmaceutical expert from the Patent Office. The court-appointed expert's report explained that since the API is SITAGLIPTIN, then any combination of SITAGLIPTIN with any pharmaceutically known salt – and there are thousands thereof – would constitute infringement. In particular, the expert report answered the question of the court, whether SITAGLIPTIN phosphate mono-hydrate infringed Merck's patent or not, in the affirmative.

Marcyrl's last argument was that the Ministry of Health drug registration and market authorization of the generic drug indicates that the generic drug does not infringe the patent rights of Merck. This argument was rebutted using Article 10 of the Intellectual Property Law, which stipulates that one of the exceptions for allowing use of the patented invention is drug registration for the purpose of research and development, provided the holder of the drug registration does not market the infringing product until after the patent expires or is invalidated. The law neglected the fact that no drug can be marketed in Egypt without the Ministry's market authorization of the patch, including the sales price. However, due to the Ministry of Health's stance that it is in no position to decide on patent rights or take any action regarding enforcement against generics, the Ministry issues marketing authorizations to generics regardless of any objection, warning, notice, or any other action short of a court decision, by the patent holder. On presenting this evidence to the court, and the reply of the Ministry to previous legal warnings, the Court was convinced that neither the drug registration nor the marketing authorization issued by the Ministry of Health could be used as evidence, or even as a presumption, of non-infringement. The Tanta Economic Misdemeanours Court issued its decision in 2016, finding that Marcyrl committed patent infringement of the pharmaceutical patent of Merck covering SITAGLIPTIN, and ordered Marcyrl to pay a fine of 100,000 Egyptian Pounds (the maximum allowed by law), and temporary damages of 5,000 Egyptian Pounds to Merck, in addition to publishing the judgment in two daily newspapers. Though the temporary damages are insignificant (around $200), the temporary damages award can be used as the basis for the evaluation of damages by a civil court on the presentation of proof of losses of the patent holder and/or the unlawful revenues of the infringer.

> **"To the surprise of Marcyrl, its attempt to exploit national sentiment did not work in 2015 when the market started looking at quality versus price."**

Both the Appeal Economic Court and the Cassation Court of Egypt affirmed the first-degree judgment in the case of enforcement of the SITAGLIPTIN patent, and by that has set a precedent in pharmaceutical patent criminal enforcement cases, and a much-celebrated legal achievement in the field of Intellectual Property. Following this Landmark Case, many law firms that have never admitted the significance of patents or intellectual property altogether started to change course.

Now, with the government launch of the National Strategy of Intellectual Property, we expect that there will be an added focus and legal reform to develop and improve the enforcement of intellectual property rights in Egypt. At these exciting times – for us as Intellectual Property Lawyers - we look forward to legal developments where the prosecutors, enforcement officers, and the judiciary enforce patents as well as they have enforced trademarks in the past 50 years.

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Women in IP Leadership

Celebrating achievements and continuing the empowerment of women

This segment is dedicated to women working in the IP industry, providing a platform to share real accounts from rising women around the globe. In these interviews we will be discussing experiences, celebrating milestones and achievements, and putting forward ideas for advancing equality and diversity.

By providing a platform to share personal experiences we aim to continue the empowerment of women in the world of IP.

If you would like the opportunity to share your experiences with *Women in IP Leadership*, would like to nominate an individual to be involved, or would like to learn more about sponsorship, please contact our Editor.

Susi Fish: Partner, Boult Wade Tennant

An interview: inspirations, experiences, and ideas for equality.

Susi Fish is a Chartered Patent Attorney and European Patent Attorney working at Boult Wade Tennant LLP in the UK.

Susi works across a range of technologies; including biomedical engineering, medical physics and aerospace related matters. In addition to her patent practice, Susi oversees the firm's European Patent Validations Group, which handles the grant and validation of European Patents.

Susi is an active supporter of IP Inclusive in the UK, and serves as co-chair for the Women in IP group. She also sits on the D&I and Women in IP committees of the Intellectual Property Owners Association (IPO).

Susi Fish

What inspired your career?

I was brought up around engineers and scientists, my dad, granddad, auntie and godmother were engineers and my mum was a biochemist and then a science and math teacher, so pursuing a STEM subject was a perfectly natural fit for me. I did a Mechanical Engineering Master's, and when I reached the end of my studies, I realized that, although I enjoyed the practical aspect, what I really enjoyed was the theoretical side, the in-depth understanding of the subject matter. So, I stayed on to do a PhD in Biomedical Engineering, which enabled me to go deeper into my chosen topic.

I didn't know what I wanted to do after my PhD, but knew I didn't want to stay in academia. I received a couple of engineering job offers, but fancied a change and thought I'd do a law degree. At this point, someone pointed out that I was going to become the eternal student, and, at some point, it would be time to move on! Also around that time, a family friend, a solicitor at a big London law firm, mentioned the prospect of becoming a patent attorney because I could use my engineering background and work whilst I trained. I'd never heard of patents at that point, but once I had I realized that some of my professors had patents and there was a whole tech transfer department at the University of Leeds.

I interviewed at the European Patent Office to become a patent examiner, and at the same time applied for patent attorney jobs. I got offered a couple of in-house and private practice roles and I ended up at Boult Wade Tennant - it seemed to fit what I was looking for location-wise and offered the opportunity of working on medical device patents. So, like many, I fell into a career in IP.

> **"Having learned the hard way, I'm trying to model to others that asking for help is not a sign of weakness."**

How have you found the pathway to your current position? And can you offer advice from your experience?

I'm currently a partner, and was recently described by one of my other partners as having a 'portfolio career', which is quite interesting as that's not usual inside private practice. I've done a lot of different things, I started off on my career climbing frame (rather than a career ladder!) in the normal fashion - I did lots of training, then drafting and patent prosecution at the EPO and the UKIPO, also instructing foreign attorneys. I did the qualifying exams and managed to qualify at the first attempt. I then had children and when returning after maternity leave concentrated on doing mainly prosecution work, with some opposition work, whilst working a part-time schedule.

When my youngest was approaching school age, I decided I wanted more at work, or at least to do something a bit different. Around that time an opportunity enabled me to compliment my prosecution and opposition work with a management and strategy role – leading the validations team at Boult Wade Tennant. That additional role gave me a new lease of life, as I'd never worked in a strategic role before.

After a couple of years I became a partner, which was another twist on the climbing frame and another steep learning curve. I became more involved in client relationships, I find working out how we can best help our clients fascinating.

In another twist, I attended an online conference at the end of 2020 and met a few people who I wanted to stay in touch with. So at the start of 2021 I started my LinkedIn experiment. Through this I have stayed in touch with people: got to know more people, and explored what other people are doing and learning. Building relationships is another part of my life now, and I love it.

The advice I would give from my experience is to be open to opportunities when they arise,

> **Looking at retention, I'd like to see an increased diversity moving up the seniority ranks as we move forward over the next five years.**

not to be rigid in your plans. I've learnt to listen to the little things that bubble up inside of me and, looking back, I think often my achievements have come because I've given myself space and time to think about what I should do with the ideas that are bubbling up. So, in other words, be open to new experiences.

What challenges have you faced? And how have you overcome them?

There have been a number of challenges, let's be honest!

There have been personal challenges at various times, managing my time and how I want my work and life integration to look is an ongoing process. I don't think that will stop and it's something I try to consider regularly.

I have had my own little episodes of burnout, but I don't know that I looked at it that way at the time. These have occurred when I have either driven myself too hard or driven myself in the wrong direction and come to a point where I needed a reboot.

The lesson I learned from those times was not to try and do everything alone. I think we get to a certain point in our career where we feel we should be doing everything ourselves; that we shouldn't need to be asking for help. What I actually learnt after my times of struggle was that it's OK to ask for help, and that other people are happy to help, I just wasn't aware of that. I learnt that my peers, and even those that were further along in their careers than I was, were asking others for second opinions, so why shouldn't I be able to do that?! Having learned the hard way, I'm trying to model to others that asking for help is not a sign of weakness.

The other big challenge is being a woman and a mother in the IP profession. One experience in particular has always stuck with me: I attended a networking event on an evening some years ago, back when my oldest child was relatively young. I was chatting in a small group of four or five people. There was a man talking about how involved he was in his family life, how he was supporting his child's football team. I must have mentioned that my son was at home with my husband. The man's response was that I should have been at home with my child, not at the evening event, that my main role should be as a mother. I was much more junior than I am now, and would like to think that I would now know how to respond, but what I actually did was freeze and say nothing. Nobody else responded either. I took that episode away, internalized it, and, actually started to question was I doing something wrong by working. That experience had quite an impact on me for a long time, and once I realized that it galvanized me to make some changes.

That event was quite a while ago and I'm hopeful that comments like that don't get made anymore. Or, at the very least if they do that they are challenged. My husband is as much a parent as I am, and we work together to make our family work. In fact he's just been to collect the kids from school because I'm here talking to you!

What would you consider to be your greatest achievement in your career so far?

I can't limit it to one! In the technical area of being a patent attorney, there are cases that stick in my mind where people have said that they are hopeless, or somebody said there's no point arguing that one, and I've worked to overcome a particular objection – I love those instances when I've refused to give up and it comes to a positive outcome for my client.

On a completely different level, I've been supported at various times in my career by mentors or sponsors and now, as part of the work I do at Boult Wade Tennant, I enjoy giving back and spending time focusing on diversity and inclusion, this also includes mentoring others. One of my greatest achievements is that somebody came to me relatively recently and asked if we could chat - I always want to be there to support people so I agreed - and they said they looked to me as somebody who shows that it is possible to have a career, to be a parent, to have some semblance of a life outside of work, and to appear happy so they wanted to chat about how I managed. That made me really hopeful - I am nowhere near where I would like to be in an ideal world, but the fact that how I live my life could show it is possible to live the life you want is a real positive for me. I've been very lucky to have people support me moving through my career and so now I really want to be able to give back and support other people as they move through theirs.

What are your future career aspirations? And how will you work to achieve them?

I'm a goal setter, I have long and short-term goals but, if I go back to that second question about my pathway, one of the things that I have learned is that it's okay to change and allow those little sparks to ignite, to allow organic career progression even if that's not necessarily following the path I thought it would. If you had asked me five years ago what my career would look like five years from then, it wouldn't be anything like it is now - so I am goal orientated and yet I have learned overtime to allow those little organic changes and pivots to take place.

So, I'm not sure what my future career will look like, but one area I'm really enjoying at the moment is exploring how to give the best service possible to clients. I'm also enjoying getting involved in some more strategic projects, so I guess I'll see what comes next. I think it's fantastic to be able to work in a firm and have the flexibility to pursue different things, I'm very lucky.

So, I'll stay open to new ideas, I'll continue to work with a coach when I feel I need to, I'll keep reaching out to people, I'll keep listening and I'll remember not to disregard when I notice a spark of interest in something, because I can be quite self-critical when those sparks do appear.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years?

I co-lead the Women in IP group for IP Inclusive, I sit on the D&I committee and the Women in IP committees for the Intellectual Property Owners Association, and the Women in IP committee of the AIPLA, so this is clearly something that I'm very passionate about!

These are all groups that are working towards a similar end. IP Inclusive is very much UK based, and then the IPO and the AIPLA are much more US based, I think it's good that we can learn from each other. I think the more that we can work together, rather than separate little groups in various places, the more traction we can get.

I see some positive changes in diversity at entry level, but looking at retention, I'd like to see an increased diversity moving up the seniority ranks as we move forward over the next five years. When you can see a little change in recruitment, but not see that progressing through to seniority, my opinion is that means that there's a problem with inclusivity and belonging: because people aren't feeling included, they don't feel as though they belong, so they move on or out, potentially from private practice to in-house or they might just leave the IP world completely. I'd like to see change being made at the retention level as well as at the recruitment level.

That said, I think there is still much work to be done within the recruitment area, particularly around social mobility. We need to make sure we aren't just from the same background, including the same socioeconomic background. We need to widen that net and invite more people into the career space of IP. I think that there are more opportunities for this. One of the things we are doing as a firm is supporting a charity called the Sutton Trust, there are many other charities doing this kind of work too, where we are currently doing workshops for A Level students who are from a more socioeconomic and economic deprived background to introduce them to IP. Hopefully some of these children will be inspired to follow a career in IP.

But equally, we can look more widely at bringing people in from more diverse backgrounds, both as a firm and as a profession.

How do you think the empowerment of women can be continued and expanded in the IP sector?

A lot of this goes back to what I've just been talking about: retention and support. But, in addition, I think a key to change is for people to be mindful of how they speak. For example, saying 'parental' leave rather than 'maternity' and 'paternity' leave. The more that can be done to encourage all parents to take part in parental leave, the less it will become a stigma. I still hear of people now saying, "I'd like to take paternity leave, but I won't because it will be perceived in a negative way," – What does this say about how maternity leave is perceived? Until we address matters such as this, there will always be an issue.

Also, assumptions shouldn't be made about what people want - just because a woman has young children doesn't mean she doesn't want to go on a business trip, or take on a more senior role, or move her career forwards. Don't make that assumption, ask.

Likewise, when talking generally, men and women shouldn't be addressed differently when it comes to work and home responsibilities – you can't ask a woman how her kids are going to cope while she's away on business if you wouldn't ask a man the same. I don't get these types of comments much now, but in general, people don't talk about how it is to be a working dad in the same way as they do about being a working mum. I think the use of language and use of assumptions is something that will be key going forwards.

How we speak, and the societal norms, are so important. As a little example, I remember my daughter saying to me when she was five, "I think I'll be a nurse rather than a doctor because I'm a girl." The doctor we take her to is a female, so where did that come from?! It turns out that TV programs and books have quite the impact!

> **The more that can be done to encourage all parents to take part in parental leave, the less it will become a stigma.**

Pranita Dharmadhikari: CEO, Innocelf

An interview: inspirations, experiences, and ideas for equality.

Pranita is the Founder and CEO of Innocelf; with a decade of experience working in the pharmaceutical field, Pranita is well-versed in regulatory and patent aspects of pharmaceuticals and medical devices. Pranita has an undergraduate degree in pharmaceutical sciences and a master's in patent law from Case Western Reserve University, Ohio. She provides patent research and analysis services to pharmaceutical and life sciences companies.

What inspired your career?

I was born and raised in the western part of India in Mumbai. My parents introduced me to innovation and its value early in my life. Being an artist and an engineer, my father was vigilant about monetizing his inventions. I was fascinated by the idea of monetizing creations and making a living out of them. During my undergraduate studies, my team and I created a prototype for a pharmaceutical metal detector device. We received the first prize during the annual tech fest organized by the Indian Pharmaceutical Association. Such events in my early life helped me pursue a passion for pharmaceutical science research and introduced me to what it takes to be an inventor. The urge to support others like my family absorbed me in the captivating concepts of pharmaceutical science and patent law.

How have you found the pathway to your current position? And can you offer advice from your experience?

I was fortunate enough to start a career in Intellectual Property Law right after my master's studies in pharmacology. I worked with the Gov. of India's CSIR - Unit for Research & Development of Information Products (URDIP) as a senior research fellow in patinformatics. My responsibilities were to work on different innovations to guide laboratory scientists on various aspects of patenting, from prior art searching to prosecuting inventions for Indian and the US markets.

After completing one year of a research fellowship, I started working with Ajanta Pharmaceutical Ltd. Mumbai, as intellectual property rights (IPR) officer at the Advent Research Center to advance IP efforts to launch generic drug molecules in India and the US. My experience at Ajanta Pharma helped me understand the complexities of patent law and regulatory processes and its alliance during the successful launch of generic drug molecules. During my work at Ajanta, I had an opportunity to work on more than 10 generics, which resulted in a successful approval by FDA.

After several years of working with pharmaceutical industries as an intellectual property officer, I decided to move to the United States for a master's in patent law studies at Case Western Reserve University School of Law. After graduating in the middle of the COVID pandemic, I decided to start Innocelf. Incorporating Innocelf during a pandemic allowed me to consider the ups and downs of running a business from the get-go.

I navigated my IP journey thanks to generous help and guidance from my fellow IP colleagues and mentors. I recommend others meet and network in the IP field; there is nothing better than learning from actual experiences.

> **"I recommend others meet and network in the IP field; there is nothing better than learning from actual experiences."**

What challenges have you faced? And how have you overcome them?

We at Innocelf strive to incorporate new technologies to improve our search techniques to lower the burden on our team and make it affordable for our clients. Patent searching is a rapidly changing area with the assistance of artificial intelligence tools to get efficient search results. Since the inception of Innocelf, we have been developing a new AI-based tool for our particular client segment. As a non-engineer, developing and implementing a new software method was challenging. But over the years of learning how coding and software engineering works, I was able to guide my team through the process. Today, I can proudly say that we are set to launch our new tool in early 2023.

What would you consider to be your greatest achievement in your career so far?

Running a successful business is an achievement for any business owner, and it's the same for me. In the year 2022, we were able to reach new heights and support hundreds of inventors throughout the year. Apart from being a successful business owner, I also achieved my personal goal of mentoring inventors from the local community which resulted in the successful launch of their products.

What are your future career aspirations? And how will you work to achieve them?

I aspire to adapt to the new era of innovative technologies to serve my clients better. My vision for Innocelf is to make patent searching easy for inventors to use the vast majority of available public data for better decision-making. Innocelf also believes in supporting innovators from underrepresented communities, and we are committed to working with local organizations to promote creations in Michigan.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years?

I would like to see increasing efforts to promote gender diversity and equality within the industry with a continued focus on increasing the representation of women and other underrepresented groups in leadership roles within IP organizations and companies. Additionally, there may likely be an increased emphasis on providing education and training opportunities specifically geared toward women and other underrepresented groups interested in pursuing careers in the IP field. Overall, the IP industry will continue striving for equality and diversity to foster innovation and creativity and ensure that a wide range of perspectives and experiences are represented in the development and protection of intellectual property.

How do you think the empowerment of women can be continued and expanded in the IP sector?

Today we see increasing efforts to bring more women into the IP field. However, we need to support more women to be a part of the proliferating legal tech sector for inclusive legal technology development for an innovative future of IP. The future of IP is creative, having more women in legal technology would change how IP professionals practice law.

> **"The future of IP is creative, having more women in legal technology would change how IP professionals practice law."**

The Patent Lawyer
GLOBAL REACH, LOCAL KNOWLEDGE
www.patentlawyermagazine.com

LAW FIRM RANKINGS 2023

The Middle East and Africa

A comprehensive list of the 10 most well-respected law firms from the Middle East and Africa

The Patent Lawyer Magazine
GLOBAL REACH, LOCAL KNOWLEDGE

Throughout the next few pages, you will view a comprehensive list of the 10 most well-respected law firms from the Middle East and Africa, in alphabetical country and company order. Our focused list is derived from a multifaceted methodology, which uses months of industry research and feedback from our readers, clients, and esteemed connections around the world. All firms are ranked top 10 in their jurisdiction but are displayed alphabetically to avoid bias.

Egypt

Abu-Ghazaleh Intellectual Property | AGIP
Baianat Intellectual Property
Cedar White Bradley
Eldib & Co
Helmy, Hamza & Partners (Baker McKenzie)
Ibrachy & Dermarkar
Maddock & Bright IP Law Office
NAL LAW GROUP
Saba IP
Zaki Hashem & Partners, Attorneys at Law

Israel

Cohn, de Vries, Stadler & Co
Ehrlich Group
Fisher Friedman IP Group
Gilat Bareket & Co.
Liad Whatstein & Co.
Luthi + Co.
Meitar
Pearl Cohen Zedek Latzer Baratz
S. Horowitz & Co.
The Luzzatto Group

Kenya

Bowmans (Coulson Harney LLP)
CFL Advocates
Clay & Associates Advocates
Dentons Hamilton Harrison & Mathews
ENSafrica
Gikera & Vadgama Avocates
Iseme, Kamau & Maema Advocates(IKM) (DLA Piper Africa)
Kaplan & Stratton
Ong'anya Ombo Advocates LLP
Simba & Simba

Lebanon

Abu-Ghazaleh Intellectual Property | AGIP
Alem & Associates
Baianat Intellectual Property
Cedar White Bradley
Nasser & Associates
Obeid & Partners
Raphaël & Associés
Saba IP
Sader & Associates
United Trademark & Patent Services

Morocco

Abu-Ghazaleh Intellectual Property | AGIP
Afrique Advisors
Baianat Intellectual Property
Bakouchi & Habachi - HB Law Firm LLP
Cedar White Bradley
IB for IP
Kettani Law Firm
NJQ & Associates
Saba IP
United Trademark & Patent Services

Nigeria

Abdulai, Taiwo & Co.
ÆLEX
Allan & Ogunkeye
Aluko & Oyebode
Banwo & Ighodalo
F. A. Garrick & Co.
G. Elias & Co.
Jackson, Etti & Edu
Olajide Oyewole LLP (DLA Piper Africa)
Stillwaters Law Firm

South Africa

Adams & Adams
Brian Bacon Inc.
ENSafrica
KISCH IP
Moore Attorneys
Smit & Van Wyk
Spoor & Fisher
Von Seidels
Webber Wentzel
Werksmans Attorneys

Saudi Arabia

Abu-Ghazaleh Intellectual Property | AGIP
AlDhabaan & Partners
Al Ajaleen Law & Intellectual Property
Al Hadaf Marks Services LLC (Saba IP)
Al Tamimi & Company
Al-Otaishan Intellectual Proeprty & Technology (AIP&T)
Baianat Intellectual Property
Cedar White Bradley
Clyde & Co
Kadasa IP

Tunisia

Abu-Ghazaleh Intellectual Property | AGIP
Achour Law Firm
Baianat Intellectual Property
Cabinet d'Avocats Ben Slama
Cedar White Bradley
El Ajeri Lawyers (DLA Piper Africa)
Eversheds Sutherland El Heni
Gide Loyrette Nouel
Kammoun & Kallel
Saba IP

Tanzania

ABC Attorneys
Alin Law Care
Asyla Attorneys
Bowmans
Clyde & Co LLP
ENSafrica
FB Attorneys
LawExchange Associates
IMMMA Advocates (DLA Piper Africa)
NexLaw Advocates

UAE

Al Tamimi & Company
Baianat Intellectual Property
Bird & Bird (MEA)
BSA Ahmad Bin Hezeem & Associates
Cedar White Bradley
Clyde & Co
Deans IP
Galadari Advocate & Legal Consulting
Gowling WLG
Rouse

LiquidText is the document analysis platform of choice for patent professionals worldwide

The winner of Editor's Choice Awards from BOTH Apple and Microsoft, LiquidText lets you do more analytical reading and note-taking with less effort, never lose track of a source document or highlight, and always return to where you left off quickly.

Founded in 2012 and based in New York, LiquidText, Inc., produces and offers its eponymous productivity software to patent attorneys, examiners, and other intellectual property professionals who read, analyze, compare, and collaborate on an assortment of digital documents. Part one of this three-part series on LiquidText, interviews Craig Tashman, founder of LiquidText, to find out what it is and how it benefits patent attorneys and other IP professionals.

Craig Tashman

What is LiquidText?

LiquidText is software to help people read and understand long, complicated, and interconnected bodies of documents. The genesis for the software resulted from my doctoral thesis at Georgia Tech, which studied how attorneys, executives, academicians, students, and others read, take notes, make comparisons, and analyze documents. I had two revelations: paper does not support readers' needs well, and computers traditionally do even worse.

Why did you look at paper when people create and store documents in electronic format?

Everyone we talked to preferred paper for professional reading. You can highlight content, make notes in the margin, and dog-ear page corners for bookmarks. Still, people need to make comparisons and connections between documents, which is extraordinarily difficult on paper, and worse in digital formats.

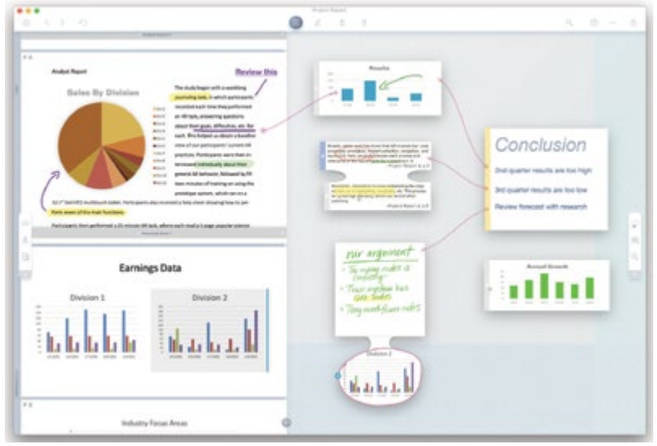
Imagine a crime thriller where detectives use a corkboard to post clippings and notes and make critical connections with twine. Professionals do that when they read critically and analytically but without the corkboard and twine. We looked at that and realized many digital reading solutions were modeled on paper, so they inherited the limitations of paper, and made this kind of discovery and capture of connections difficult -you have to keep it all in your head. So, we took a different approach.

If you did not start with how people use paper, how did you develop LiquidText?

We started with cognitive science and asked what people need when reading. What are their tasks and requirements? This led us down a very different path. We began building prototypes of LiquidText that addressed readers' requirements and embraced critical reading tasks, such as highlighting and annotating text while comparing, contrasting, and making connections among documents. We put the prototypes in front of attorneys, students, and others and got terrific feedback on how professionals read analytically to solve problems. After we released our first product on the Apple iPad in 2015, LiquidText received more than 100,000 downloads in the first two weeks of its availability. From there, we started marketing initiatives for various users and increasingly pressed into the professional space, appealing to attorneys, doctors, and others.

How does LiquidText work?

LiquidText projects begin with your documents. Import from one to thousands, in the most important formats from your file storage, as you need them. Then you read, underline, annotate, excerpt, connect, observe and comment all within the same app and workspace. But beyond that, as you draw the connections between anything that deserves attention and whatever other information, notes, documents, observations, and others that relate, over time you effectively build a "network" of relationships between source materials and your notes, which is invaluable for continuing analysis.



Overview: A screenshot of LiquidText with the document pane and a workspace open, showing notes and connections.

Users can organize a workspace as they like, making notes and connecting them to others. Or they can draw lines between document text, notes, or anything in the app to create a live, visual InkLink between them.

LiquidText works with PDF, Office 365 Word, PowerPoint, and web pages, among other popular content formats. It also supports content management systems like Box, Dropbox, and iCloud Drive, and exports project materials in popular application formats such as DOCX and PDF.

Does LiquidText replace any existing tools, such as a PDF reader?

LiquidText is unique software. We don't see ourselves as PDF readers. We don't compete with Adobe Acrobat, and they aren't competing with us. We consume PDF files and other digital documents. Although we have a large community of readers who use LiquidText for critical reading, the most significant competitor is paper.

Where can I use LiquidText?

The software runs on Apple iPads, Macs, and Microsoft Windows 10/11 PCs and tablet computers. You get LiquidText free from the Apple App Store or the Microsoft Store and make all purchases through the in-app purchase function. We also recently launched an Enterprise Edition which is designed for larger deployments.

The versions you get from the Apple and Microsoft stores use Microsoft Azure for real-time synchronization and backup, allowing you to work on multiple devices. We built the backend on Azure using a .NET architecture. This enables us to deliver LiquidText to law firms, regulatory agencies, and other entities on-premises and in private clouds.

> **When we launched the Windows version, the EPO reached out and informed us they were using iPad versions and were interested in licensing LiquidText for Windows.**

How many active users do you have, and how many are attorneys?

Users have downloaded the software from Apple and Microsoft app stores more than five million times. Based on our customer satisfaction surveys, 10% of our user base identifies as attorneys. Of those, we don't know how many patent lawyers there are, but every patent examiner in the European Patent Office (EPO) uses LiquidText.

How did you discover that patent lawyers were interested in LiquidText?

Anecdotally. Due to Apple and Microsoft privacy agreements, we can't know users' demographics who download from the app stores. Attorneys and patent lawyers contacted us through our support desk and through our periodic customer satisfaction surveys. When we launched the Windows version, the EPO reached out and informed us they were using iPad versions and were interested in licensing LiquidText for Windows. We were also getting a lot of inbound demand from patent attorneys and intellectual property firms. Maiwald contacted us when they heard the EPO was using LiquidText. They did not want their regulators to have better tools than their IP attorneys. We noticed a clear trend of patent professionals using the software when BioNTech SE and Genentech employees contacted our help desk for support.

How does LiquidText help patent professionals?

LiquidText can help legal professionals with any task requiring them to read, compare, and analyze multiple documents. It broadly helps patent professionals with patent litigation and prosecution, freedom to operate analyses within a particular technology area, and opposition proceedings or re-examining patents. As soon as you get into any process dealing with more and more documents, patents, cross-referencing, and reviews, LiquidText is a "competitive advantage," as one attorney put it, especially if the counterparty is using paper.

The LiquidText advantage includes unity, idea capture, and accelerated access to information. LiquidText lets you gather groups of documents

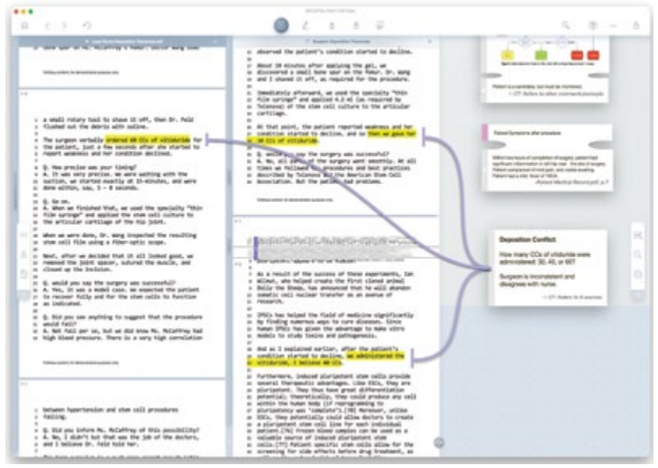
in one unified project so you can replace entire banker boxes of documents. The software helps you preserve the discovery of new connections and relationships among documents. LiquidText lets you take notes in an organized way, linking them in context with source documents, allowing you to return to a project quickly.

LiquidText speeds access to information. You can capture thoughts, link them together, and connect them to text in source documents. In one touch, you can bring conflicting patent claims together in a workspace from multiple documents and draw contradicting statements of witnesses together from several depositions.

As attorneys are always moving between many matters over the course of a day, LiquidText allows them to quickly and easily resume work with all source documents, annotations and previous notes instantly presented exactly where they left off. Attorneys no longer need to pull out document boxes with all the source materials scattered across boxes and pages of paper.

What features excite patent lawyers the most?

The golden feature is creating InkLinks. You can draw lines from a piece of text in one document to another. This can show, for example, how a patent claim conflicts with another. With InkLinks, you can capture all the connections and relationships discovered while reading documents. For example, an attorney can capture inconsistent statements in depositions by drawing lines from the statements to a note in the workspace; they can later retrieve that conflict in court by just tapping the ends of the resulting InkLinks. Interlink anything in documents and workspaces, such as notes, to draw connections – even content outside the project using URL links.

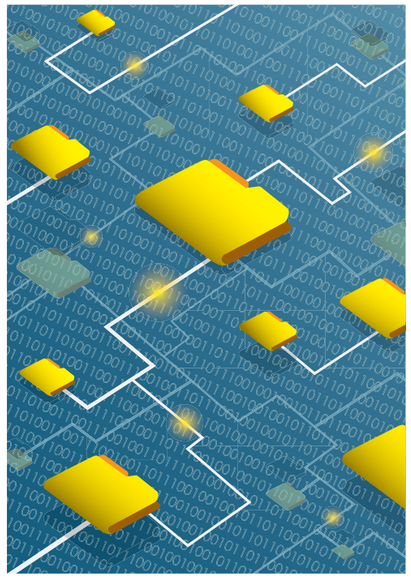


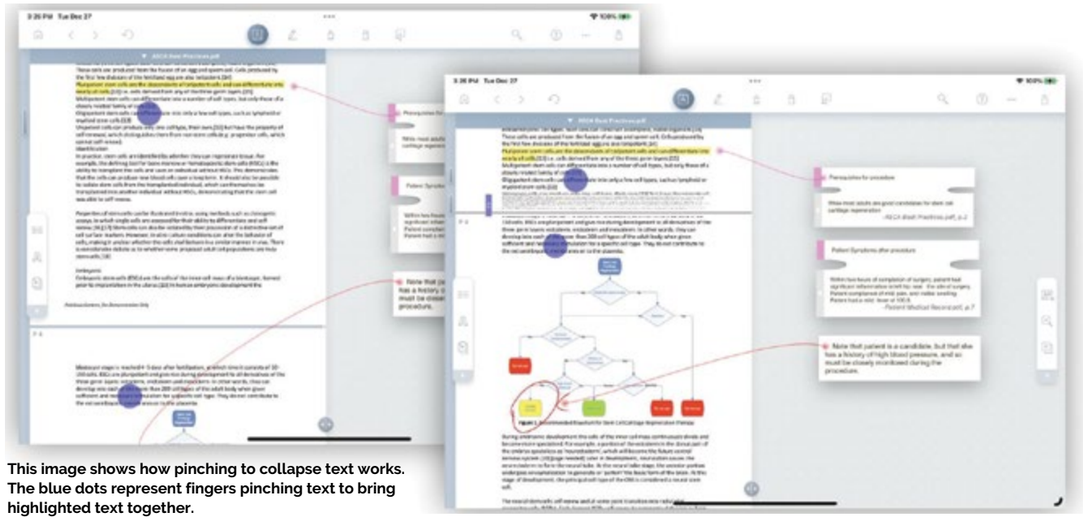
InkLinks, shown here, connect text in one document to text in another relevant document.

The excerpts are the meat and potatoes in LiquidText to bring together information from different patents or claims. Create excerpts by highlighting text or drawing a circle or box around anything in a document and dragging it to the workspace. The excerpt links back to the exact point in the source document it came from. You can bring together critical information from different records, discover connections, and find inconsistencies and workarounds in prior art. Getting the information together makes it easier for your brain to work effectively.

Excerpts allow users to bring together information from different patents or claims.

Everyone gets excited about the gestural UI for touch devices. A 15-second demo video on Google showed how LiquidText users pinch the UI to bring together highlighted texts; it resulted in five million downloads. Few apps take advantage of ink and multi-touch and how it was meant to be exploited to improve the user experience.





This image shows how pinching to collapse text works. The blue dots represent fingers pinching text to bring highlighted text together.

What new features will appeal to patent lawyers?

If there is a new version of a source document in a project that has pages added or removed, you can use it to replace the old version in your project. LiquidText preserves your notes, annotations, links, and markups and carries them forward to the new version. You can create text links across apps, such as with Microsoft Word, and include LiquidText in a cross-app workflow. For example, copy a LiquidText link and paste it into Word; when you click the link in Word, the flow moves to LiquidText.

You recently released a LiquidText Enterprise version. What does that mean for law firms and corporate legal departments?

The Enterprise edition adds manageability, data location controls, and security features typically in enterprise infrastructure and security frameworks. The Enterprise edition will support end-to-end encryption with customer-managed keys (CMK) and include enterprise integrations like iManage. LiquidText supports enterprises with a designated account manager, priority email, Slack channels, and onboarding and training webinars.

Law firms and legal departments face complicated budget planning. Why should they prioritize software tools like LiquidText in a challenging economy?

The only sustainable way for fewer attorneys to do more is with better tools. Acquiring software tools like LiquidText should be a priority. With LiquidText, users can save time and work efficiently to maintain and increase productivity and workloads. It lets users change context easily, take meaningful notes, and find information faster – all core productivity you can't outsource. LiquidText can also improve transparency with multiple attorneys working on projects. And the software is priced as an everyday tool. We also do multi-year deals with organizations to lock in the price over the term of the agreement.

> **"A 15-second demo video on Google showed how LiquidText users pinch the UI to bring together highlighted texts; it resulted in five million downloads."**

How much does LiquidText cost?

We offer a free (Basic) version of LiquidText and a one-time download to run LiquidText on one device without future updates (Pro 2023) for $39.99. The software-as-a-service (SaaS) offerings include feature sets tiered to user intensity and sophistication. The LiquidText Enterprise edition costs $20 per user per month. A certain level of enterprise customizations is free, but some custom work may be a non-recurring expense.

What features are on your product roadmap?

Besides end-to-end encryption and CMKs, we will add real-time collaboration for workspaces. Collaboration features will allow multiple users access to a single project, providing shared and private workspaces. We will add data analysis and visualization tools to projects for users to identify patterns in documents and notes. We plan to integrate with more third-party content management systems and work with public and private patent databases. LiquidText is also in the process of obtaining an ISO 27001 certification.

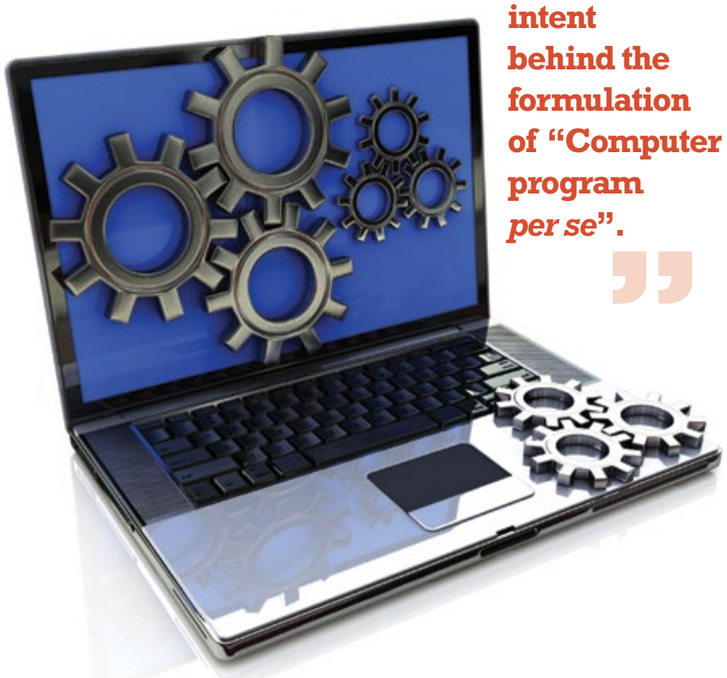
For more information, visit www.liquidtext.net or email info@liquidtext.net.

Patentability of computer related inventions (CRIs) in India: Current practises and a call for revisions

Dr. Joshita Davar Khemani, Mr. Sonal Mishra and Mr. Rahul Sharma of L. S. Davar & Co. **critically examine the current (inconsistent) practices related to CRIs at the Indian Patent Office and offer suggestions on much needed revisions to the extant practices.**

Indian Patent Office (IPO) has often released Computer-related invention (CRI) guidelines in yesteryears. The guidelines aim at showcasing a patent examination procedure as subjected to CRI-based patent applications. Patentability of software/computer-related inventions has been clarified to the extent that every computer program implementing the invention is not un-patentable under Section 3(k) of the Indian Patent Act on the grounds of an exhibition of technical character and effect. Various steps have been taken by the Indian patent office such as the publication of illustrations of technical effects and examples pertaining to patent claims falling under the prohibited category of computer program *per se*.

> **Current practice conflicts with the legislative intent behind the formulation of "Computer program *per se*".**



However, with the innovation spur coupled with artificial intelligence-driven technologies, the clarity offered so far does need further augmentation and revisions with time. For example, inventions that may be completely restricted within the computing machine are often objected/ rejected under Section 3(k) of the Indian Patent Act as a computer program *per se* despite exhibiting technical effects. Such rejection is issued despite sufficient exhibition of a technical effect that otherwise corresponds with a list of examples published by the Indian Patent Office.

Consider a case of a patent claim related to the execution of power management software executed within a "general purpose computing system" that predicts in advance the battery deterioration based on neural network processing. Despite all ingenuity over state of art, such a claim is prone to be often objected to as a computer program *per se* merely on the grounds that the same corresponds to a normal interaction between memory and processor, and lacks a technical character for being no more than a general-purpose computing system operation. Merely absence of other constructional features in a patent claim (barring processor and memory) is often used as grounds by IPO to reject the claim due to lack of technical character. Such rejection attempts to undermine the inventive merit of patent claim elements or steps that otherwise genuinely overcome challenges or disabilities lurking in software platforms of existing power management systems.

Consider another case, wherein a task scheduler of a computing system has been programmed to arbitrate or decide task scheduling based on the current occupancy of the processor in a computing system. The patent claim may be directed to optimize the task scheduling by queuing the most urgent tasks in a manner such that there is no additional overhead, thereby duly corresponding with the definition of technical effect acknowledged by IPO. Yet another case may be a patent claim directed to a computer program for improving a compiler operation of the computing system to save power and memory and enable even less sophisticated computing systems (such as based on Arduino motherboard) to discharge tasks as quickly as higher ordered systems

Despite all technical prowess, still, such claims as referred to in the preceding paragraph may not find favor with IPO based on the same grounds. For example, a task scheduling in a general-purpose computer may be held as a computer program *per se* under Section 3(k) of the Indian Patent Act on the ground the claim does not define structural features barring memory and processor.

> **Inventions that may be completely restricted within the computing machine are often objected/ rejected under Section 3(k).**

In all of the aforesaid scenarios, a patent claim, when restricted to a software platform, is rejected merely due to the absence of construction features, despite offering a far-reaching solution. Such rejection is issued despite enough technical limitations present in the claims such as real-time data of power sources, interfaces, data structures, data conversion elements, and a machine learning logic-driven prediction, to name a few.

As a matter of expediting the processing of the application, while one may resort to limiting the claims further by adding structural limitations such as power sensor, power source, and user input source, one is denied the scope of protection otherwise envisaged by execution of sole method steps through a computer. To put it differently, an unreasonably narrowed claim may be easily worked around to escape direct infringement and allows piggybacking over the invention with no damages to offer.

Considering the jurisprudence, it is evidently clear from an order of Hon'ble IPAB in the matter *ALLANI FERID v. Assistant Controller of Patent (OA/17/2020/PT/DEL)* that technical effect and technical contribution are un-ambiguously associated with the determination of patentability. As has been referred to in Para 33 of the Order, it has been exclaimed that while examining the patentability of the subject matter it is a must to appreciate the technical effect produced by the present invention. Para 33 of the Order explicitly recites that *"the invention must be examined as a whole and the following factors are to be considered while deciding upon the patentability of such inventions – i.e. (i) technical effect achieved by it, and its (ii) technical contribution."*

Résumés

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Joshita has a demonstrated history of working in the legal services industry for 33-plus years. Skilled in client relationships, litigation, management, intellectual property and trademarks.

Joshita, granddaughter of the Founder Partner, the Late Mr. L.S. Davar, is an experienced Legal Professional with a Degree in Law. A keen philanthropist with an interest in education and healthcare for the poor and the underprivileged Joshita can communicate fluently in English, French and many Indian Languages. She has been adjudged not only as one of the Top 100 Powerful Women in Law but also holds a Certificate of Excellence and several Awards from Forbes India for her invaluable services in the field of Innovation & IP.

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With over eight years of experience in the patent industry, Sonal is an engineer turned lawyer having expertise in electrical, electronics, mechanical, ICT, software and other "hi-tech" technologies to patent matters. His practice encompasses myriad aspects of patent laws, with an emphasis on patent analytics, drafting, prosecution, patent litigation, client counseling, and advisory on Intellectual Property protection, structuring and negotiating transactional agreements, commercialization and litigation strategies. He also handles and manages complex litigation patent matters across districts courts, high courts in India. He is also instrumental in assisting with the evolution of patent jurisprudence in India through advocacy in courts, sensitization programs, talks at multiple forums and several writings. He also advises clients on SEP related strategies.

Mr. Rahul Sharma, Principal Patent Attorney
He has more than 15 years of professional experience primarily in drafting and prosecuting patent applications before Indian Offices and overseas. handles patent applications across domains such as electronics, AI, software, electrical, electromechanical, etc. In addition, he is active in counseling the inventors over patentability and protecting innovations. Last but not the least, Mr. Rahul has contributed to various articles and opinions concerning patents for publication online and offline.

It is clear from aforesaid that the Indian Patent office practices Objecting to CRIs (otherwise qualifying the technical effect) based on the absence of structural features stand in conflict with the jurisprudence and the legislative intent behind the formulation of the term "computer program *per se*".

A computing method claim that inventively over-comes challenges of a program such as battery management software can be least referred to merely as a computer program owing to a tangible or well-recognized utility emanating therefrom. A prime example of such challenge overcoming may be the presence of claim elements or a sub-module that interface two otherwise incompatible software modules and thereby inventively address an interfacing problem, which may further result in a time-efficient generation of pre-alert of battery deterioration.

Accordingly, the need of the hour is to motivate IPO at issuing further clarification or revision of guidelines in relation to computer-related invention patentability, wherein there is a *prima facie* presence of technical effect emanating from a computer-related invention. There is a need to put an end to the uncalled requirement of incorporation of structural features in method claims, wherein it is linked to a computing environment and exhibits a well-recognized technical effect, especially wherein a technical problem solution is apparent from the method steps of the claims.

> **"Yet another roadblock is claiming data structures at the Indian Patent Office."**

There is an additional need to provide as a part of updated guidelines, updated examples of computer-related inventions which clearly identify technical effects as emanating from the claims despite the absence of structural features. There is a need to provide such examples with diversity wherein both CRI examples overlap with various domains such as electronics, mechanics, biotech, pure sciences, etc.

Having said so, it is also the duty of the patent applicant to refer, in black and white, in the specification the evidence that there existed a challenge in existing software systems that thwarted the performance of a peripheral such as a power manager. The written description of specification shall flawlessly refer to the mal-functioning or constrained peripherals and extent of underperformance and how the current problem, despite being restricted to a software code, mani-fests hugely to the extent of adversely affecting a business, domestic end user, or even human life.

Yet another roadblock is claiming data structures at the Indian Patent Office. While inventing any wireless communication-based invention based on 3GPP standards, Internet protocols, or image processing-based inventions to name a few, very often command syntaxes or data structures are created during the course of the invention either as a main feature or ancillary feature. For example, almost every 3GPP-based telecom-munication standard is based on packet data structure, reference signaling structure, etc. which warrants an inventor to achieve a restructured scheme of data to aid wireless communication.

Consider an example, wherein a 3GPP standard invention may require the placement of additional data in the header of a packet and wherein data such as a header may be populated with a prototype of the content of the payload to alert a transceiver beforehand about the type of incoming data. The same may be technically advantageous such that a transceiver can selectively receive data and save receiver power.

Consider another example, of mission-critical systems (MCX), wherein alerts are raised by devices as and when human life is endangered due to fire, floods, or any other natural calamity. As the signaling for such systems requires efficiencies in terms of time and energy, the innovations are often found directed to specifications, signaling formats, etc. The same also holds true in scenarios concerning vehicle-to-everything (V2X) communication systems.

As may be obvious from the aforesaid hypothesis, the ingenuity lies solely in the data structure, for example as created for packet data, thereby earnestly requiring a patent claim that shall be restricted exclusively to a data structure. Regard may be had that data structures are held as statutory subject matter by the United States Patent and Trademark Office (USPTO).

However, the same is not the same with the Indian Patent Office as data structure-based claims are rejected as "presentation of information" under Section 3(n) of the Indian Patent Act. Accordingly, one has no other option but to draw a data transmission-based "method claim" incorp-orating such data structures in the quest of seeking a patent grant from IPO. As may be appreciated, a prospective infringer using the same data structure format with minor tweaks but employing a technically different communi-cation method may still be able to easily circumvent direct-infringement.

Accordingly keeping in the mind, the innovation spur, the need of the hour for the IPO is to adjudicate a data structure-based claim at least pertaining to wireless communication or a signal structure at par with a product claim, wherein there is *prima facie* presence of technical effect emanating from a technical appropriation of such a claim. Having said so, it is also the duty of the patent applicant to refer in black and white in the specification the evidence of how the existing data format or signal structures were adversely affecting the performance of a wireless peripheral such as a router or mobile device/user equip-ment. The written description of specification shall refer to how the current format of data structure and signal structure overcomes the aforesaid problem, preferably with case studies.

Likewise, the "graphical user interfaces" (GUIs) based claims are all but rejected as "presentation of information" by the Indian Patent Office. The extent of such rejections is as adverse as a rejection of patent claims directed to a technical problem-solving computer program and claims directed to data structures as referred to in the preceding description. An underlying rationale is that GUIs have started replacing remote controls, joysticks and even measurement devices (inch tapes).

A GUI rendered on a computing device such as a smartphone for operating a TV is technically a remote control in itself. While a remote control may be acceptable to IPO as a means plus function claim subject to other tests of novelty and inventive step, a GUI claim drawn with respect to the same is all but likely to be held as non-statutory as "presentation of information" by Indian Patent Office under Section 3(m) of the Indian Patent Act, despite the mention of technical functionality performed by different graphical controls and interrelation between them.

As an alternate and in quest of securing a grant, an applicant may resort to claiming the GUI functionality through a method claim. Yet, the applicant does happen to incur a substantive loss upon non-acceptance of the GUI claim, given the fact that a prospective infringer may avoid patent infringement by using the same GUI with an altered method of operation. Such loss intensifies especially when a relative arrangement of controls within the GUI is intuitively and technically related to the underlying func-tionality of operation such as a remote control. Accordingly, yet again the need of the hour for the IPO is to adjudicate a GUI-based claim at par with a product claim, wherein there is *prima facie* presence of technical effect emanating from a technical appropriation of such a claim.

In a nutshell, with the innovation spur and changing times, there lies a need for IPO to further revise or update the CRI guidelines for acknowledging allowance of process claims at least when there is a ubiquitous manifestation of technical effect and inventive merit over the state of the art, and for doing away with the requirement of structural features, especially for such process claims. Without gainsaying, a patent claim restricted to a process of a stand-alone, non-networked general-purpose computing system, or a data structure or a user interface is as much patentable as any other engineering or technology marvel on the grounds of ingenuity and merit. In the same vein, the onus shall be on the Examiner of Patents to allow on merits, subject to various tests of patentability and inventiveness, an underlying process claim based on such data structure and GUIs and refrain from rejecting the same as non-statutory subject matter, meaning thereby that the guidelines must be revised to bring even corresponding product claims related to data structures and GUI into the fold of patentable subject matter. An outright rejection of a process claims merely for being based on a data structure is as much unjust as much as non-adherence to principles of natural justice by a judge.

On the other hand, and needless to say, Applicants and Attorneys filing patents based on computer-related inventions need to be categorical about depicting within a drafted patent the challenges as overcome over state of the art. The challenge overcome through any computer software-based patent shall be as much concretized as much as, for example, a newly developed engine designed to achieve 20% power efficiency!


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Terminal disclaimers and common ownership

David McCombs, Eugene Goryunov, Alan Wang & Austin Lorch of Haynes Boone LLP and Tom Kaczmarski of Continental review the conditions of terminal disclaimers and the grounds for common ownership to identify necessary steps for maintaining patent protection when multiple parties are involved.

A terminal disclaimer is a statement filed by a patent owner that disclaims a portion of a patent's term.[1] Terminal disclaimers are often filed in an application to obviate a non-statutory double patenting rejection over a prior commonly-owned patent.[3] The terminal disclaimer, in this case, states that any patent granted on the present application will be enforceable only for and during the period that it and the prior patent are commonly owned.[3] If the application and the prior patent turn out to not be commonly owned but resulted from activities undertaken within the scope of a joint research agreement, the Applicant may still file a terminal disclaimer and state that any patent granted on the present application will be enforceable only for and during the period that it and the prior patent are not separately enforced.[4] Common ownership, for purposes of a terminal disclaimer, generally exists when the claimed invention and the prior patent are wholly owned by, or under an obligation to assign to, the same entities.[5] This article examines what happens when a terminal disclaimer is filed in an application that, after issuance and at the time of assertion in court, is no longer commonly owned with a prior patent.

Hypothetical

A first patent (the "Prior Patent") is commonly owned by Companies A and B and lists inventors from both companies. A continuation (the "Present Patent") of the Prior Patent is filed. The Present Patent is assigned only to Company A and lists only inventors from Company A. During prosecution, the Present Patent receives a non-statutory double patenting rejection over the Prior Patent. Company A files a terminal disclaimer under 37 C.F.R. § 1.321(c) to obviate the double patenting rejection. The Present Patent issues and the terminal disclaimer is recorded.

It appears that, as it stands now, the Present Patent is unenforceable because the Prior and Present Patents are not commonly owned by the same entities, i.e., Companies A and B.[6] To make the Present Patent enforceable, Company A must establish common ownership of the Prior and Present Patents, for example, by way of contract, correcting inventorship, or withdrawing the terminal disclaimer altogether. These potential solutions and their drawbacks are discussed below.

Establish common ownership via contract

Establishing common ownership through contract may be the most promising mechanism Company A can use to render the Present Patent enforceable. There are multiple ways this can be accomplished. Company A could obtain (e.g., purchase) the Prior Patent outright from Company B.[7] Company A could also take out an exclusive license of Company B's interest in the Prior Patent.[8] Or, Company A could assign an undivided interest of the Present Patent to Company B.

Establish common ownership by correcting inventorship

Company A may attempt to render the Present Patent enforceable by correcting inventorship of the Present Patent. One way to do that might be to add inventors from Company B to the Present Patent. Assuming the inventors from Company B are obligated to assign their inventions to Company B, Company B would become an owner of the Present Patent, thereby establishing common ownership (i.e., the Prior and Present Patents would then be commonly owned by both Companies A and B). As a result, the Present Patent would become enforceable under the terminal disclaimer. Certificates of correction and reissue applications are both viable options to correct inventorship.[9] However, each have various criteria and requirements that dictate whether either option can be utilized.[10]

Regarding certificates of correction, if the inventorship mistake was on behalf of Company A, 35 U.S.C. § 255 requires that the mistake be "(1) of a clerical nature, (2) of a typographical nature, or (3) a mistake of minor character."[11] Additionally, "[t]he correction must not involve changes which would: (1) constitute new matter or (2) require reexamination."[12] Further, a certificate of correction of an issued patent requires agreement on behalf of "all parties and assignees" (e.g., in our hypothetical, the originally named inventors from Company A and Company B).[13] If the above criteria are not satisfied, Company A cannot employ a certificate of correction and must turn to the reissue process.[14]

If Company A is the sole assignee of record in a reissue application, which does not enlarge the scope of the claims, Company A "can consent to and sign [a] reissue oath/declaration that adds or deletes the name of an inventor by reissue … without the original inventor's consent."[15] Assuming that inventors from Company B are under an obligation to assign to Company B,

1 37 C.F.R. § 1.321.
2 37 C.F.R. § 1.321(c)-(d).
3 37 C.F.R. § 1.321(c); see also MPEP § 1490(VI).
4 37 C.F.R. § 1.321(d); see also MPEP § 1490(VI).
5 MPEP § 717.02(a)(I).
6 MPEP § 1490(VI).
7 *See STC.UNM v. Intel*, 754 F.3d 940, 946 (Fed. Cir. 2014) (stating "[u]nless STC can … obtain the '998 patent (and '321 patent) outright, or become the exclusive licensee of Sandia's interest, STC cannot enforce the '998 patent in court.").
8 *Id.*
9 35 U.S.C. § 256; 35 U.S.C. § 251.
10 37 C.F.R. § 1.324; 37 C.F.R. § 1.175.
11 MPEP § 1481.
12 *Id.*
13 MPEP § 1481.02(I).
14 *See* MPEP § 1412.04(II).
15 *Id.*

Résumés

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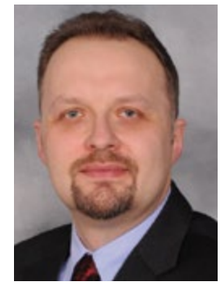
Tom Kaczmarski

then Company B would become an assignee of record as well, thereby establishing common ownership. However, a reissue that broadens the scope of the claims and adds an inventor requires that "the inventor being added [] sign the reissue oath or declaration together with the inventors previously designated on the patent."[16] If the added inventors from Company B do not agree, then Company A may sign a substitute statement under 37 C.F.R. § 1.64 in place of their signature on the reissue oath or declaration.[17] In addition to these requirements, 37 C.F.R. § 1.175 requires that the reissue declaration "state that the applicant believes the original patent to be wholly or partly inoperative or invalid…through error of an inventor incorrectly not named" in the issued patent.[18]

Notably, the MPEP advises that "[w]hile reissue is a vehicle for correcting inventorship in a patent, correction of inventorship should be effected… by filing a certificate of correction if: (A) the only change being made in the patent is to correct the inventorship; and (B) all parties are in agreement and the inventorship is not contested."[19] Therefore, whether Company A uses a certificate of correction or a reissue to correct inventorship and establish common ownership will depend largely on whether the inventors from Company A agree with the change. If any of the inventors from Company A do not agree, then a reissue application will be required.

> **If any of the inventors from Company A do not agree, then a reissue application will be required.**

This article reflects only the present personal considerations, opinions, and/or views of the authors, which should not be attributed to any of the authors' current or prior law firm(s) or former or present clients.

Attempt to withdraw the terminal disclaimer

It is unlikely that Company A can withdraw the terminal disclaimer it filed during prosecution. The MPEP only allows one to withdraw a terminal disclaimer prior to issuance.[20] By filing a terminal disclaimer and allowing the patent to issue, Company A has freely dedicated a portion of the Present Patent's term to the public. To return those rights to the patent owner would go against public policy norms.

Attempt to nullify the terminal disclaimer by correcting the present patent

It is also unlikely that a mechanism of correction can be used to withdraw or otherwise nullify the terminal disclaimer. After issuance, "mechanisms to correct a patent such as a – certificate of correction, reissue, reexamination, *inter partes* review, post grant review, and covered business method review – are not available to withdraw or otherwise nullify the effect of a recorded terminal disclaimer." However, Company A might further explore the following option.

If, when filing the terminal disclaimer, Company A mistakenly believed, in good faith, that the Prior and Present Patents were commonly owned, it is possible that Company A may use a reissue to withdraw or otherwise nullify the effect of the terminal disclaimer to make the Present Patent enforceable. The U.S. Court of Appeals for the Federal Circuit, however, has held that the filing of a terminal disclaimer to obviate a non-statutory double patenting rejection over a prior patent, when the prior patent and the patent sought to be reissued were never commonly owned, is not an error that can be corrected by reissue.[22] In *In re Dinsmore,* the Federal Circuit dealt with such a situation and explained that a reissue was improper because the applicants had not shown a mistaken belief that the two patents at issue were commonly owned, and stated that the applicants were ultimately seeking to revise a choice they made, not to remedy the result of a mistaken belief.[23] This decision limits a viable reissue to a rather narrow set of circumstances.

Implications of establishing common ownership

Company A should be mindful that once Company B has been identified as a common owner of the Present Patent, Company A cannot maintain a suit without Company B joining voluntarily or involuntarily.[24] Furthermore, Company A is unlikely to obtain past damages for the period where common ownership was lacking.[25]

As discussed above, there are some scenarios in which common ownership is established without naming Company B in the Present Patent (e.g., when Company A buys the Prior Patent outright from Company B). When this occurs, Company A need not worry about joining Company B before maintaining a suit because Company A possesses "all rights or all substantial rights" under the patent and can sue in its own name alone.[26] The likely bar on past damages, however, remains a viable consideration.

Conclusion

To recap, if a terminal disclaimer is filed under 37 C.F.R. § 1.321(c) and the two patents are not commonly owned, common ownership must be established to ensure enforceability. Obtaining common ownership through contract is likely the most promising option. Alternatively, a mechanism of correction such as a reissue or a certificate of correction may be available, albeit more uncertain, to correct inventorship, which in turn establishes common ownership. Finally, withdrawing or nullifying a terminal disclaimer of a patent that has already issued is unlikely and may be possible only if the mistake was made by the applicants in good faith.

16 MPEP § 1412.05(I).
17 *Id.*
18 MPEP § 1412.04(II).
19 MPEP § 1412.04(I).
20 MPEP § 1490(VIII).
21 MPEP § 1490(VIII)(B).
22 *In re Dinsmore,* 757 F.3d 1343, 1348-1349 (Fed. Cir. 2014); see also MPEP § 1490(VIII)(B).
23 *Id.*
24 *STC.UNM v. Intel Corp.,* 754 F.3d 940, 946 (Fed. Cir. 2014) (holding that "the right of a patent co-owner to impede an infringement suit brought by another co-owner is a substantive right that trumps the procedural rule for involuntary joinder," and that a co-owner may not bring suit against a third party when another co-owner refuses to join the litigation); *Ethicon, Inc. v. United States Surgical Corp.,* 135 F.3d 1456 (Fed. Cir.1998) (holding "as a matter of substantive patent law, all co-owners must ordinarily consent to join as plaintiffs in an infringement suit"); *Schering Corp. v. Roussel–UCLAF SA,* 104 F.3d 341, 345 (Fed.Cir.1997) ("Ordinarily, one co-owner has the right to impede the co-owner's ability to sue infringers by refusing to voluntarily join in such a suit." (citing *Willingham v. Lawton,* 555 F.2d 1340, 1344 (6th Cir.1977)).
25 *STC.UNM v. Intel Corp.,* 754 F.3d 940, 943 (Fed. Cir. 2014) (recognizing that "STC could not enforce the '998 patent under the terms of the terminal disclaimer, which required identical ownership of both the '321 and '998 patents").
26 *In re Lone Star Silicon Innovations LLC,* No. C 17-03980 WHA, 2018 WL 500258, at *1 (N.D. Cal. Jan. 20, 2018).

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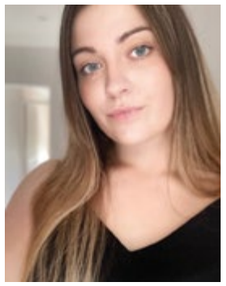
The EPO's Women Inventors report: getting to the roots of women's disproportion in patenting

Faye Waterford, Editor of *The Patent Lawyer Magazine*, evaluates the key findings of the recent EPO Women Inventors report, informed through an interview with Ilja Rudyk, Senior Economist at the EPO and Co-Author of the report, to explore the position of women in patenting and the motives for seeking improvement.

Diversity discussions are not rare and recent decades have seen an uptake in the inclusion of improvement pledges in company goals. If the mere notion of acceptance is not enough to encourage equal opportunities irrespective of gender, sexual orientation, race, or disability, then the overwhelming research that indicates diverse teams are key to success should be. In fact, McKinsey & Company found, based on a study conducted between 2008-2010, that companies with diverse top teams were top financial performers, obtaining a return on equity 53% higher compared to those with less diverse teams.[1] But it's not all about top teams or profit, Deloitte's investigation reported in 2022 found that "research shows that diversity of thinking is a wellspring of creativity, enhancing innovation by about 20%. It also enables groups to spot risks, reducing these by up to 30%. And it smooths the implementation of decisions by creating buy-in and trust".[2] These points scratch the surface of the reasons why we should all be pushing for diversity.

However, STEM sectors are still overwhelmingly lacking when it comes to gender diversity. A recent report published by the European Patent Office [EPO], *Women's Participation in Inventive Activity*[3], investigated the percentage of women inventors in Europe sourced from a total of 4,105,286 applications filed at the EPO between 1976-2021. The intention was to present a picture of gender and patenting today to provide key insights for policymakers and businesses to assist in facilitating a more diverse future in the field. In its opening pages, the report points out the necessity for innovation in the face of the challenges to public health, energy supply, and the environmental and geopolitical stability in Europe, innovation that could be harnessed from the expansion to more diverse teams. It has been suggested that patenting in the United States could be quadrupled if women, minorities, and children from low-income families became innovators at the same rate as men.[4] There are also concerns about the inclusivity of technology due to the lower figures of women inventors, with men's patents tending to focus on men-specific health problems before the health concerns of women.[5]



Faye Waterford

The EPO report confirmed that the gender gap for inventors remains despite a steady increase, with only 13.2% of inventors in Europe being women. Herein find details of further key findings identified by the report.

Women inventors by country

The key findings for women inventors by country, assigned based on the addresses listed on the patent applications, were taken between 2010-2019. Over the nine-year period, it was found that the following countries have the highest proportion of women inventors: Latvia (30.6%), Portugal (26.8%), Croatia (25.8%), Spain (23.2%) and Lithuania (21.4%). Curiously, the countries found at the bottom of the rankings for the proportion of women inventors sit amongst the top 10 patenting countries at the EPO, being Netherlands (11.9%), Germany (10.0%) and Austria (8.0%).

An interesting conclusion relating to jurisdiction was drawn from the research; a key element to reducing the gender gap in patenting in EPO countries is international mobility. Women inventors that reach out to inventors in other countries consequently increase their internationalization which is key for increasing women inventors globally.

Women inventors by technology field

The EPO study also looked at women inventors in each technology field in a bid to better understand the positions of women inventors today. The technology sector with the highest share of women inventors is Chemistry (including biotechnology and pharmaceuticals) with 22.4% of applications coming from women (between 2010-2019). In biotechnology and pharmaceuticals specifically, the share of women inventors exceeded 30%. One hypothesis for this is women's preferences for education based on family role models, another is the working conditions of the sectors and their impact on work-family balance, encouraging women into sectors that offer a more equal balance. Mechanical engineering was found to have the lowest share with just 5.2%.

A positive finding was that the share of women inventors increased over time in all five of the sectors assessed.

An interesting analysis was drawn to suggest that women are over-represented among the less prolific inventors and under-represented among the most productive ones. This is based on the assumption that talent is equally distributed amongst men and women but that the productivity, leadership, and visibility between them differ. Reasons could include barriers to promotion or tenured positions in academia, fewer business connections, or fewer opportunities for women to access IP protection.

It is suggested that sectors with a more acute gender gap should look to the science-based sectors for work practices and a mode of cultural acceptance to encourage more women inventors into the other sectors as the science-based sectors present broader inclusivity.

Leaking pipeline

There are many possible reasons for the low participation of women in patenting, with women in STEM professions often deemed to undergo a more challenging selection process in comparison to their male counterparts. The EPO report explains that the 'leaking pipeline' phenomenon sees the number of women decrease at each stage of career progression due to invisible barriers, for example, women STEM students grossly outweigh the number of women academics or senior R&D staff. Women's under-representation also increases the higher their position, and they are less likely than their male co-authors to be credited as inventors in corresponding patents.

This lack of recognition is reflected financially, with women in R&D earning less than men despite

1 https://www.mckinsey.com/capabilities/people-and-organizational-performance/our-insights/is-there-a-payoff-from-top-team-diversity

2 https://www2.deloitte.com/us/en/insights/deloitte-review/issue-22/diversity-and-inclusion-at-work-eight-powerful-truths.html

3 http://www.epo.org/women-inventors

4 Bell, A. et al., "Do tax cuts produce more Einsteins? The impacts of financial incentives versus exposure to innovation on the supply of inventors, *Journal of the European Economic Association*, 2019.

5 Koning, R., Sampsa, S., Ferguson, J.-P., "Who do we invent for? Patents by women focus more on women's health, but few women get to invent", Science, 372.6548: 1345-1348, 2021.

Madiha Derouazi, European Inventor Award 2022 winner

Image copyright EPO

Résumé

Faye Waterford, Editor-in-Chief

Managing content across CTC Legal Media's channels, including globally renowned intellectual property magazines *The Patent Lawyer* and *The Trademark Lawyer*, Faye implements creative vision and industry research to deliver up-to-date content across print and digital.

With knowledge acquired from attending global IP events, interviewing industry experts, and forging long-term relationships with IP professionals, Faye has implemented new content and brand strategies resulting in significant readership growth.

contributing equally to the development of high-quality inventions. Evidence even suggests that women are less likely to obtain and maintain patent rights, a clear disincentive for women inventors.

Teams are more likely to be led by men than women, and men are more likely to be in positions of authority within teams despite the findings that women are as central to inventions as men. That said, the presence of women inventors is increased in team analysis.

The trends highlighted by the report suggest that the number of women inventors will continue to increase with the support of appropriate policies and human resource management practices, which can be informed by the findings in the EPO report.

Ilja Rudyk, Senior Economist at the EPO and Co-Author of the report, commented:
We had a benchmark for the report as similar studies have been completed in the UK and US, but we were striving to discover where Europe stands. I think it is clear that the share of women inventors is relatively low, which was not a surprise, and far away from being comparative to the positions of their male counterparts. We wanted to produce the study to make people more aware of the current circumstances and encourage thinking, especially within private businesses, about what can be done to encourage women to contribute to innovation. We also encourage this innovation through our awards in which we have recognized many women inventors. Two of the four EPO Young Inventors Prize winners in 2022 were women, Rafaella de Bona Gonçalves and Erin Smith[6]. And we honor many inspiring women inventors through our annual European Inventor Award[7]. Further, we have Women in Leadership programs to assist in women's development in the sector. We want to show women as early as possible that there is a route for them to make a difference, that they can have an impact. And we want to encourage companies to facilitate opportunities.

Closing remarks

The report highlights the increasing contribution women are making to patenting – remarking that the gender gap is due to a different distribution of opportunities between genders and not a reflection of talent – but it remains that women inventors are too few which could harm the development of technologies.

Susi Fish, Partner at Boult Wade Tennant and Co-Chair of the Women in IP Group at IP Inclusive, commented:
The EPO publishing data relating to the position of women in patenting is a really important step.

Erin Smith, joint 1st place winner of the Young Inventors prize, European Inventor Award 2022

Rafaella de Bona Gonçalves, 2nd place winner of the Young Inventors prize, European Inventor Award 2022

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Elena García Armada, European Inventor Award 2022 winner

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Previously data has been provided by the USPTO (Progress and Potential: 2020 update on U.S. women inventor-patentees | USPTO[8]) WIPO (Identifying the gender of PCT inventors (wipo.int)[9]) and the UKIPO (Gender profiles in worldwide patenting: An analysis of female inventorship (2019 edition) (publishing.service.gov.uk)[10]). Having the data from the EPO presented in such a comprehensive report helps to further understand the gender gap in the patent systems. This further understanding will enable the patent offices, corporations, and others involved in the patent systems to identify and develop strategies that work to increase participation by women in innovation. The fact that data is now being gathered and presented in such accessible forms will enable the impact of implemented strategies to be more easily monitored.

The findings of this report must be reviewed to assist in addressing the changes that need to be made to increase the presence of women in patenting.

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