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September / October 2024

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Celebrating AIPPI World Congress 2024 with our special bumper edition!

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CTC Legal Media

THE PATENT LAWYER
Issue 74

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CTC Legal Media

Editor's welcome

Welcome to our AIPPI World Congress 2024 Special Edition, and for those attending, welcome to Hangzhou! In this edition prepared especially for the Congress, we present a diverse range of topics and insights that delve into the dynamic world of intellectual property and patent law.

Our guest interview this issue is with Michael Arciero, VP of IP and Commercial Development at ERS Genomics, in which he discusses the protection of rapidly evolving technologies like CRISPR/Cas9 and the importance of having the correct protection in place for product development.

> *Welcome to our AIPPI World Congress 2024 Special Edition.*

Also in this issue, discover the latest IP trends with a study from UnitedLex; enter the patent vs. trade secret debate in review of the recent Tesla case; take a comparative view of European filing strategy considering the UPC and EPO systems; learn top tips for harvesting valuable inventions to strengthen a digital technology portfolio; receive best practice advice for public accessibility; understand the WIPO Standard ST.26 changes affecting Mexican Patent Law; explore the concept of fault-based liability; and much more.

This issue's *Women in IP Leadership* segment features Xiyin Tang, Professor of Law at UCLA, and Kisha Iles, Senior Manager of IP Information Management at Johnson & Johnson. Special thanks to the segment's sponsor, Clarivate, for providing a platform for sharing experiences.

Don't forget, our current issue is always free to read via our website.

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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We pride ourselves on using a sustainable printer for our hard-copy magazines. Halcyon is committed to using only FSC-certified papers, the world's most trusted mark for sustainable forestry. FSC paper ensures responsible management of forests, and, verifying the use of recycled materials, the FSC system can help secure a long-term source of sustainable paper.

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MEET THE EDITORIAL BOARD

Pravin Anand: Managing Partner, Anand & Anand. India

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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Dr. Claudia Tapia: Director IPR Policy and Legal Academic Research at Ericsson. Germany

Claudia's main responsibilities relate to strategy, policy and research in the IP field. Prior to joining Ericsson, Claudia was the Director of IP Policy in the department Patent & Standards Strategy at BlackBerry where she focused on IPR policies in standards, global patent policies, as well as licensing and litigation.

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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.**

2024 IP impact study: trends in benchmarking value

UnitedLex presents its report on how private practice and in-house IP professionals measure IP impact, revealing insights for the future of the industry.

With the speed of innovation pacing faster than ever, IP teams play a starring role in protecting their companies' intangible assets while demonstrating operational rigor and fiscal accountability. This is resulting in increased reliance on metric-driven decisions to measure the impact of IP strategies and resource management, including technology, data tools, headcount, and external partners.

In Q1 of 2024, we at UnitedLex commissioned a third party to survey 200 senior IP professionals to benchmark how in-house and private practice IP professionals measure impact. The study explores how both law firms and corporations measure the efficacy of their IP processes and the impact of the IP assets they secure and enforce. You can access the complete IP Impact Study at unitedlex.com[1].

This article explores measuring IP impact from all angles based on the study's results. Here is a snapshot of the findings:

- **IP prosecution work is increasing**
  A majority of in-house and law firm respondents expect IP filing activity to increase in 2024, with only 1% of in-house teams and 5% of law firms anticipating a slowdown. IP professionals say this anticipated rise is being driven by the growth in emerging tech and AI, with organizations eager to protect their inventions. This backdrop is also raising expectations of greater IP spend over the coming year despite financial pressures impacting in-house resourcing.

> **Almost half of in-house teams are, therefore, still potentially bound by a mindset where the department is viewed as a cost center for the business rather than a revenue-generating partner.**

- **Tackling IP bottlenecks**
  Common challenges cited across law firms and in-house teams are regulatory changes (62% for in-house and 48% for law firms, which IP practitioners say is being driven by evolving AI and data privacy rules) and resource constraints (45% for in-house and 57% for law firms). Those resource constraints are resulting in bottlenecks, with in-house teams citing trademark clearance as the IP prosecution task that takes up the most time and resources (likely driven by a backlog at the USPTO that has extended review times). This backdrop means in-house teams and law firms need to get smarter at allocating resources—certain IP prosecution activities don't need to be completed by a senior IP attorney (let them focus on higher-value work instead).

- **Showing value is essential**
  Given these resource constraints, being able to show value to senior executives is critical, particularly for in-house teams. More than half of respondents (55%) said they use product revenue as an essential KPI for demonstrating value, followed by IP portfolio growth (51%) and litigation outcomes (46%). While 55% are focusing on revenue, almost half of in-house teams are, therefore, still potentially bound by a mindset where the department is viewed as a cost center for the business rather than a revenue-generating partner.

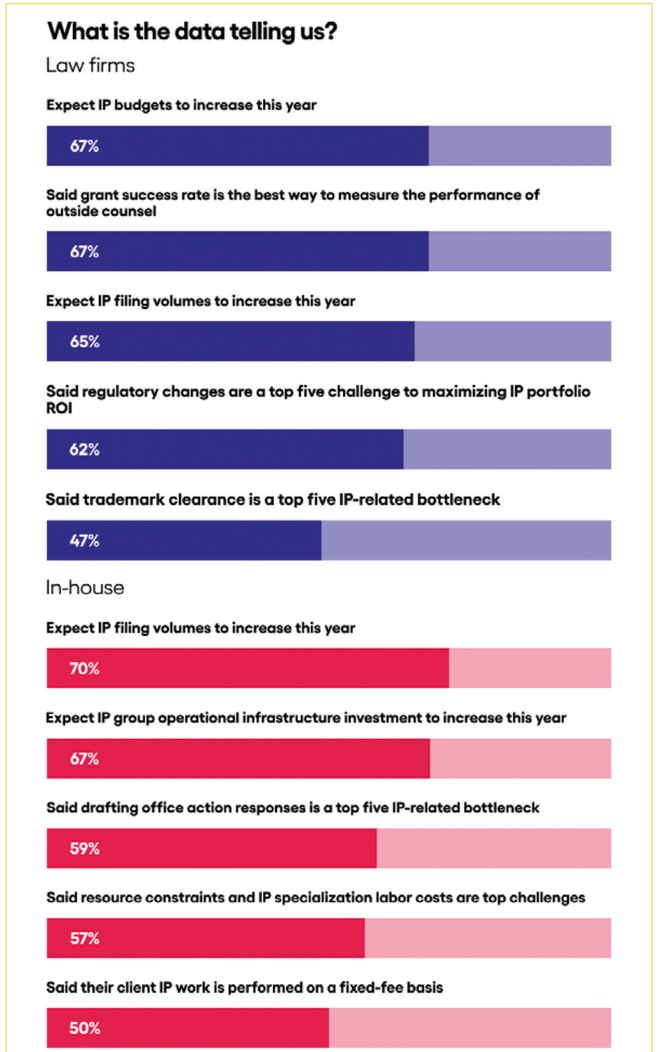


Figure 1

- **IP teams need smarter data insights**
  Amid all these challenges, there is a greater need than ever before to use data tools to manage IP prosecution activities and work more efficiently. Most organizations already understand that – roughly eight in 10 in-house IP departments and law firm practices are using data tools including AI and predictive analytics. The emergence of generative AI is likely to support those efficiency efforts, though most IP professionals we interviewed are cautious about adopting advanced AI tools for now. *See Figure 1.*

IP prosecution work is booming

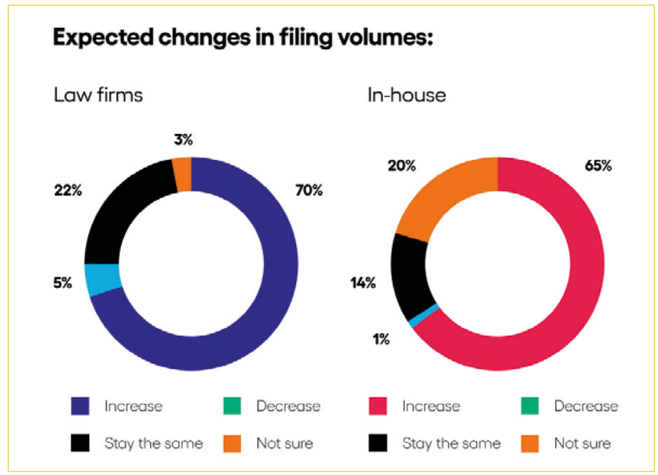
As economies around the world digitize and tech innovation accelerates at a rapid clip, intellectual property lawyers are busier than ever as companies increasingly recognize the value of their IP and the need to protect and monetize their IP assets. This backdrop is expected to push IP filing activity higher over the coming 12 months, maintaining the broad upward trend seen in recent years. *See Figure 2.*

US patent applications hit 418,262 in 2023, a small increase on the 418,116 filings in 2022, according to the US Patent and Trademark Office (USPTO). In the meantime, US trademark applications clocked in at 737,018 in 2023, albeit a slight cooling from 2022's levels when filings reached 787,795.

"A lot of these patent filings have to do with the tremendous growth that we've seen in technology, especially since the pandemic," says Lisa Ferri, global co-chair of Mayer Brown's intellectual property practice. "There's been so much development in the high-tech space and so much in the biotech space, there's just a lot of

> **There is now a longer period of uncertainty about whether their trademark will be refused or subject to an office action.**

Figure 2



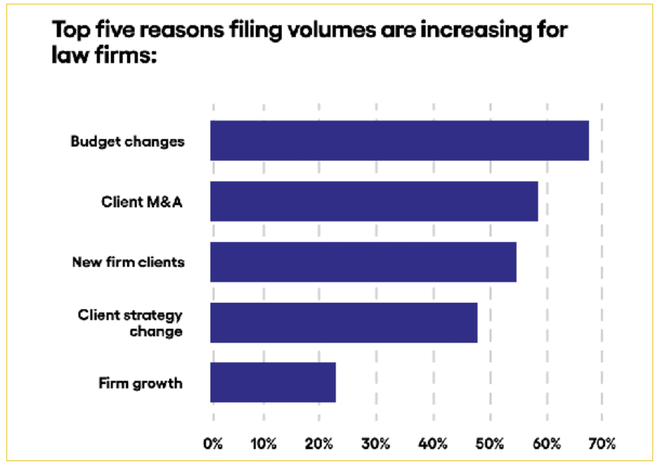


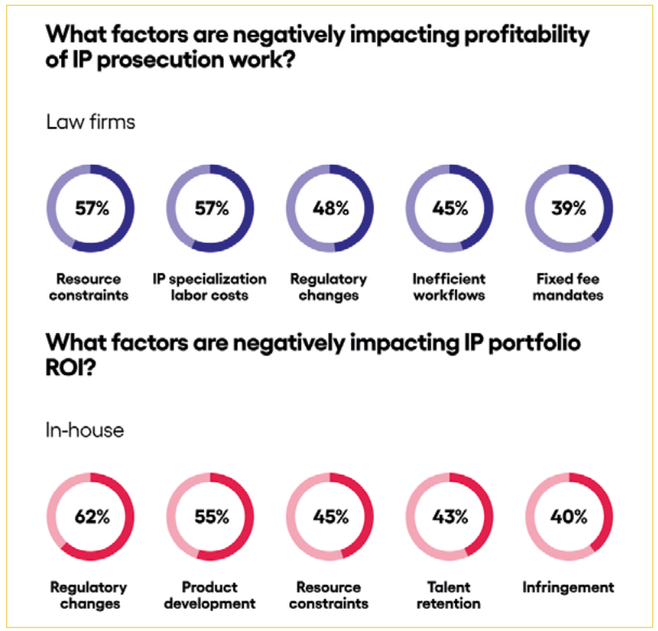
Figure 3

companies interested in protecting their inventions and therefore we are seeing more filings."

Likewise with trademarks, the explosion in artificial intelligence (AI) technology is leading to a surge in applications with the USPTO to ensure AI is included in the description of a company's goods and services. Trademark filings were roughly 3% higher in the first quarter of 2024 compared to a year ago, USPTO data shows.

While the survey indicated that budget changes are the main reason for this anticipated filing increase, strategy is also likely to play a part in those decisions. *See Figure 3.*

Figure 4



Simone Frattasi, Head of Global IP at Danish logistics giant Maesrk, expects his organization's IP filings to increase this year and that expansion "could result from increased outreach and awareness initiatives led by the IP department, an intensified focus on strengthening our tech capabilities company-wide, or strategic acquisitions".

While only 1% of in-house respondents said they expect IP filing volumes to fall this year, a fifth said they were unsure how filing activity will pan out, while another 14% said filing volumes will stay the same. However, filing fewer IP trademark or patent applications also doesn't mean organizations are taking their foot off the gas when it comes to protecting their IP rights.

"The number of IP rights isn't always the most important data point. It is critical to have the right strategy, aligned with your business' strategy," says Sophie Bodet, former head of intellectual property at British consumer health business Haleon. "So you might have more or less filings than your competitors but you're doing what will be very impactful for your business."

Navigating IP challenges

While IP teams are gearing up for increased workloads in the year ahead, they are also having to contend with an unsettled operating environment – both external (geopolitical tensions, economic uncertainty and a continuously evolving regulatory backdrop) and internal (constantly being expected to do more with less). It was little surprise, then, that common challenges impacting law firms and in-house teams revolved around regulation and resource constraints.

When asked to select the five biggest issues that prevent their organizations from maximizing the return on investment of their IP portfolios, the most common answer was regulatory changes (62%), followed by product development (55%) and resource constraints (45%).

For law firms, when asked to select the five biggest issues that impact the profitability of their IP prosecution work, the most common response was resource constraints and IP specialization labor costs (both 57%) and regulatory changes (48%).

Take the regulatory backdrop, for example. Given that so much regulation around emerging technology is still in flux, keeping pace with changes can be tough when IP lawyers are already bogged down with greater volumes of IP prosecution work. *See Figure 4.*

"AI is a particular case in point. While it has been driving increased filing activity, a wave of proposed AI legislation and regulation around the world is also creating regulatory uncertainty," says Eugene Goryunov, a partner and co-chair of the AI and deep learning practice group at Haynes and Boone.

"The EU has passed a law regulating the use of artificial intelligence, and I fully expect that something similar will be coming to the US," he says. "A lot of clients right now are starting to think about what they have to do in order to comply with all of these various regulations and whether they need to change all of their operations or just their European components."

A draft of new data privacy rules is also causing headaches for IP practitioners, from GDPR in Europe to CCPA in California and multiple jurisdictions in between.

"On top of this, there are also industry-specific regulatory challenges, such as patent subject matter eligibility in the US and how that differs from standards in other industrialized nations," says Jeffrey Wolfson, a partner and chair of the patent prosecution practice group at Haynes and Boone.

"Certain industries are greatly affected by that in the United States, including medical diagnostic companies and companies in the business analytics space – they're all impacted by these 35 U.S.C. Section 101 subject matter eligibility issues, and Congress not regulating to bring some certainty is problematic for some of our clients," he says.

The squeeze on resources has been a persistent theme for law firms and in-house teams amid cost-cutting efforts, despite the fact work volumes have tended to increase. Even the richest companies in the world have been trimming headcount lately, underscoring that nobody is immune to these resourcing challenges.

In-house teams are doing this by farming out more administrative work to their law firms or other service providers. For in-house teams, the survey showed that the IP prosecution tasks that are causing the biggest logjams were trademark clearance (46%), preparing invention disclosure statements (44%), and trademark filings (43%). In-house teams said that trademark filings (48%) and trademark clearance (45%) were also the biggest costs they incur when managing IP program filing and prosecution activities. See *Figure 5.*

"The trademark clearance bottleneck in particular is likely caused by the fact there was a big filing push at the beginning of the Covid-19 pandemic, which has created a large backlog at the USPTO," says Michael McArthur, a partner and trademark law specialist at Haynes and Boone.

"We've seen review times double – it used to be about four months before our first action, now it's eight and a half months," he says. "If it sailed through in the past, on average, you could get a registration in nine months; now it's 14 and a half months."

Given the pace of innovation and the need for companies to keep pace with their competitors, if they have a new product or service they want to seek protection for, there is now a longer period of uncertainty about whether their trademark will be refused or subject to an office action.

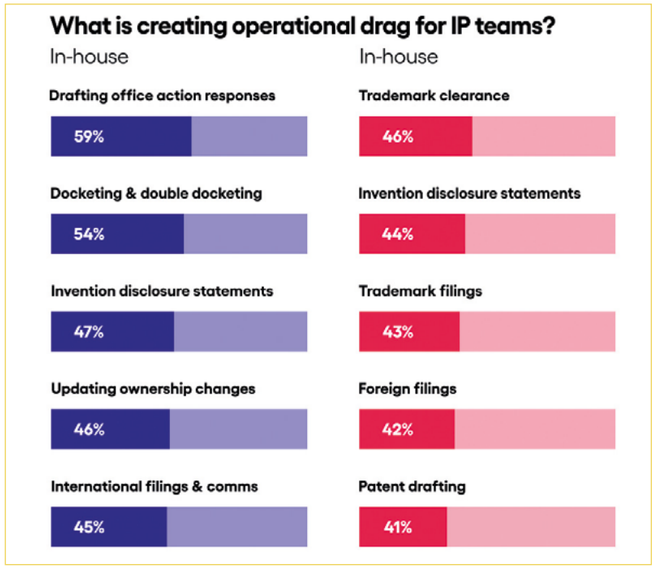
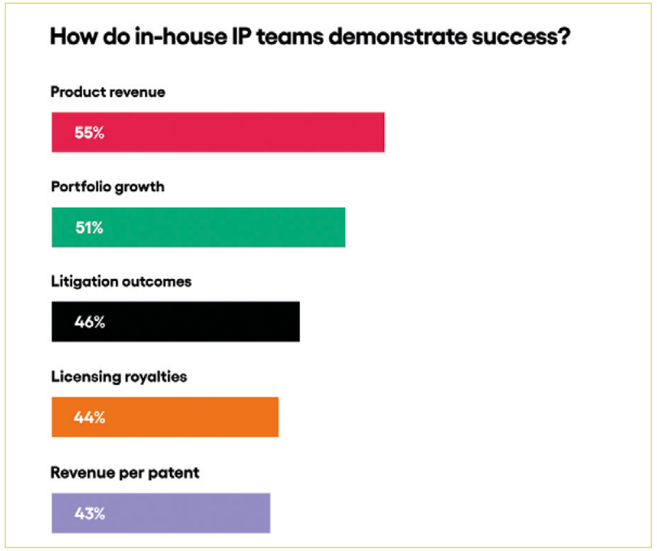


Figure 5

Broader bottlenecks within in-house legal departments are usually a question of bandwidth, underscoring the need for teams to better manage resource allocation and ensure the right people are performing tasks appropriate to their skill level.

It is a similar story for law firms. The IP prosecution tasks that are causing the most practice bottlenecks were drafting office action responses (59%), docketing and double docketing (54%), and preparing invention disclosure statements (47%). *See Figure 6.*

Figure 6



Measuring IP value

Against a backdrop of resource constraints and technological change, the need for IP teams to prove their value has never been more important. When demonstrating the performance of their IP department to executive leadership, 55% of in-house respondents listed product revenue as the main KPI (key performance indicator), followed by IP portfolio growth (51%) and litigation outcomes (46%).

While that suggests some IP teams recognize the importance of demonstrating their contribution to the company's bottom line, there is still a sizeable portion of in-house teams that need to shift boardroom perceptions from the IP department being a drain on resources and instead presenting themselves as a business partner that can drive growth.

There is also a growing focus on monetizing IP as part of the strategy to drive revenue for the business rather than as a defensive play to deter would-be infringers and protect the company's assets. Some 42% of in-house respondents listed revenue-per-patent as a KPI to demonstrate value to executive leadership, with 21% selecting revenue-per-trademark.

"We are seeing more and more out-licensing of IP that's no longer internally valuable," says K&L Gates' Barrett. "We see entities out-licensing patents because they don't care about the technology anymore and the patents could be utilized in a different industry or even by a competitor. And with trademarks, we sometimes see global firms license their marks internally to their different subsidiaries and affiliates for tax benefits."

As the survey data shows, litigation is another way for IP teams to prove value by enforcing their IP rights.

"This can demonstrate a return on investment because the competitor is forced out of the marketplace, in which case the business unit now has greater sales or there are some damages to collect," Barrett says.

Many in-house teams are also aligning their IP strategies with their company's broader corporate agenda to demonstrate the department's value to the business.

Amadeus' Derham says her IP team demonstrates its contribution to the business by focusing on three key responsibilities:

- Using IP rights to protect the company's R&D investments;
- Mitigating risk through IP, contracts, and other rights;
- Showcasing value creation.

"We have to tell stories that feed each of these three things," she says. "For value, it might be how many successful tenders we had where our IP portfolio helped influence it, or how many partnership agreements might have been influenced by our list of IP." *See Figure 7.*

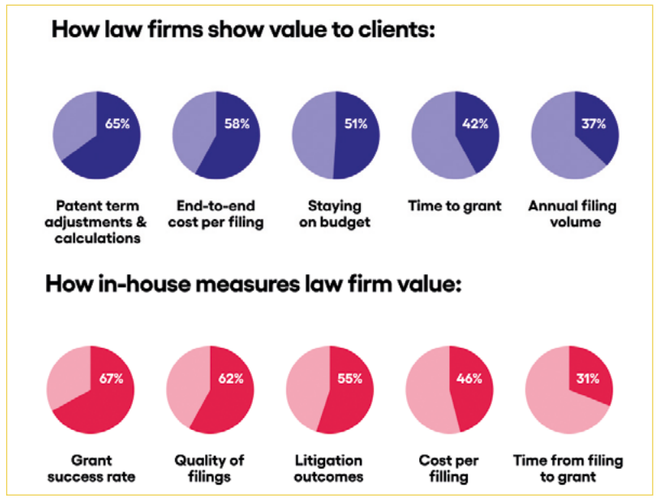
For instance, Mark Rawls, a patent attorney at Rothwell Figg, says his patent team shows value to clients by tracking the number of applications filed and the number that have gone on to be issued.

When law firms are measuring the success of their own work, practice revenue comes out on top (56%), followed by profit-per-partner (45%) and impact on other practice areas, such as cross-selling other services to IP clients (43%).

"We look at client successes, and if clients are happy with the work that we're providing and they're returning for additional work, then that's a key measure of success," says Mayer Brown's Ferri. *See Figure 8.*

> **There is also a growing focus on monetizing IP as part of the strategy to drive revenue for the business rather than as a defensive play to deter would-be infringers and protect the company's assets.**

Figure 7



Data, AI, and the future of IP work

Given all the challenges outlined – increased volumes, resource constraints, prosecution bottlenecks, and the pressure to prove value - the use of data tools such as predictive analytics and AI to help IP teams work more efficiently is critical. Roughly eight in 10 law firms and in-house departments are already using data tools to support their IP work, with trademark search and analysis topping the list of in-house and law firm use cases (60% and 64%), followed by IP strategy decision-making (54% and 63%) and trademark applications (52% and 54%).

For the in-house teams not yet using data tools, 69% said they were planning to implement data tools in the next 12 months, with another 23% saying they plan to implement within the next two years.

The emergence of AI tools is also helping stream-line workflows by automating tasks and performing faster, actionable data analysis.

AI is also likely to be applied to areas where IP teams are experiencing bottlenecks. For instance, some IP tech providers have been developing tools incorporating AI in an effort to speed up the trademark clearance process, says Haynes and Boone's McArthur.

"However, even as the algorithms improve, you're always going to need that human judgment," he says.

Despite all the hype about what AI can do and the potential for it to reshape how lawyers work, IP professionals remain cautious about its application in an IP setting, particularly when it comes to more advanced tools such as generative AI.

The uncertainty of those results and the risk of so-called hallucinations - where the AI spits out invented information - are not the only concerns. Client confidentiality is also a potential issue given the fact AI providers often rely on user data to refine their models.

Key Takeaways

Practice growth

Resource constraints and specialist IP labor costs are having the biggest impact on IP practice profitability. Still, most firms are planning to increase spending on operational infrastructure this year (possibly because most expect an increase in IP filing volumes fueled by client budget changes).

Resource management

Both in-house teams and law firm IP practices increasingly recognize the importance of investing in IP management tech and external IP specialists to help manage workloads, reduce bottlenecks, and ensure IP attorneys are focused on high-value IP matters.

Demonstrate IP value

With resource constraints forcing in-house lawyers to do more with less, IP teams need to show their value to senior executives to shift the narrative away from IP departments being a cost center and present themselves as business partners who can make a significant contribution to the company's bottom line.

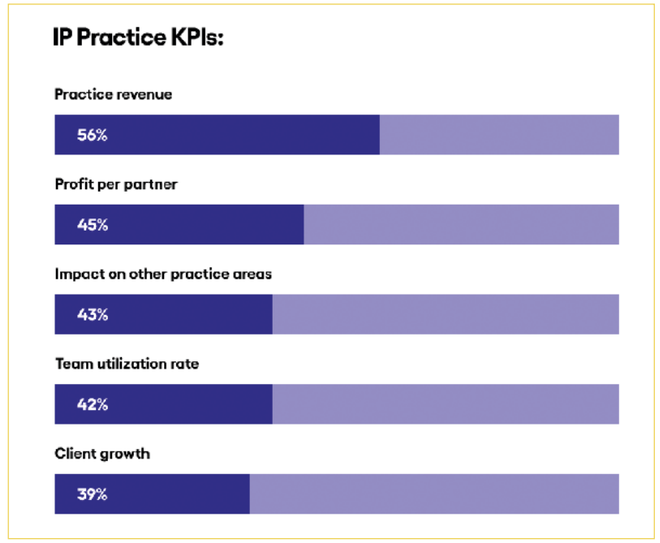


Figure 8

> **Many in-house teams are also aligning their IP strategies with their company's broader corporate agenda to demonstrate the department's value to the business.**

Review all the findings and the complete report, *2024 IP Impact Study: Trends in Benchmarking Value*, at unitedlex.com[1].

[1] https://unitedlex.com/insights/2024-ip-impact-study-trends-in-benchmarking-value/

Methodology

UnitedLex partnered with Pensar Media to survey 200 senior IP professionals at Am Law 200 law firms and companies with active IP filing strategies (and an IP portfolio of at least 500 patents and 1,000 trademarks), with respondents including practice group heads, general counsel, chief IP officers and other senior decision-makers. The fieldwork was conducted in February 2024.

Contact

https://unitedlex.com/

An interview with ERS Genomics' Vice-President of Intellectual Property and Commercial Development, Michael Arciero

Michael sits down with *The Patent Lawyer* to discuss the importance of developing a robust intellectual property portfolio in rapidly evolving technologies like CRISPR/Cas9, the considerations for maintaining a global patent portfolio, and the importance of having the correct IP in place to protect product development timelines and ensure the ability to commercialize.

Can you start by introducing yourself, your background in IP, and your role at ERS Genomics?

I am General Counsel and Head of Intellectual Property at ERS Genomics. I have over 20 years of experience in corporate and academic IP management and licensing transactions. I also hold a bachelor's degree in biology from the University of California, San Diego, and a Juris Doctorate from the University of San Diego School of Law.

Before joining ERS, I was Director of Technology Commercialization and New Ventures at the Stevens Center for Innovation, University of Southern California, where I led technology transfer and corporate alliance teams, supporting innovation across all disciplines stemming from over $900 million in annual research expenditures. Prior to that, I worked as a licensing attorney for Diversa Corporation (now BASF), negotiating and drafting complex agreements to support business and research development.

At ERS Genomics, I oversee all legal and intellectual property matters including managing the Company's foundational CRISPR/Cas9 patent portfolio, negotiating and drafting licensing agreements, and ensuring compliance with IP laws and regulations. A key focus of my

role is to protect and leverage our CRISPR technology assets, facilitating collaborations, and supporting the Company's strategic business initiatives through IP management.

What are the key considerations for developing a robust intellectual property portfolio in the era of rapidly evolving technologies like CRISPR/Cas9?

With rapidly evolving technology such as CRISPR/Cas9, pursuing patent protection presents significant opportunities, as well as a certain amount of risk. One key challenge is balancing the need for broad, enforceable claims with the associated budgetary constraints. While securing wide-ranging protection is crucial, it's also important to manage costs effectively. Equally, failing to adequately protect core innovations can lead to a loss of value and potential revenue in the longer term.

A successful IP strategy should maintain a strong focus on protecting the core competitive advantages of the technology, considering relevant prior art to ensure that the most valuable innovations are well-guarded against competitors. Understanding how early adopters will commercialize the technology also plays a crucial role in shaping patent claims. This insight helps prioritize which claims to focus on during prosecution.

Additionally, maintaining pending applications, where possible, can be a valuable strategic move. This approach allows for the filing of divisional applications, allowing companies to capitalize on new developments enabled by earlier priority filings. In turn, IP protection can be refined and expanded as the technology and its applications evolve.

How does having a global patent portfolio affect your IP strategy?

The global nature of CRISPR/Cas9 technology means that our innovations have far-reaching implications across various industries and regions, so maintaining patent protection worldwide is a key priority in our IP strategy, particularly in supporting our licensing efforts.

Managing a global portfolio involves collaborating closely with patent counsel in different countries, as positions taken in one jurisdiction can be leveraged by opponents in another, even if patent laws differ. Understanding how materials and arguments in various jurisdictions can be used out of context by competitors informs our ongoing global patent strategy. This collaborative and strategic approach helps us navigate diverse patent laws effectively, balance costs, and maximize protection. Ultimately, it offers our licensees confidence in the strength of our IP protection – an approach that optimizes licensing potential.

Michael Arciero

> **One key challenge is balancing the need for broad, enforceable claims with the associated budgetary constraints.**

What role does ERS Genomics play in providing access to CRISPR/Cas9 technology?

ERS Genomics is empowering widespread commercialization of CRISPR/Cas9 by offering licenses to the foundational intellectual property of our Co-Founder and Scientific Advisor, Emmanuelle Charpentier who, together with Jennifer Doudna, was awarded the Nobel Prize in 2020 for deciphering the CRISPR/Cas9 system and developing a method of genome editing. By making non-exclusive licenses available, we are enabling companies across various industries to develop and commercialize CRISPR/Cas9-based products and services.

Why is it important to have the correct intellectual property in place when working with fundamental technology like CRISPR/Cas9?

Having the correct intellectual property in place is essential for protecting product development timelines and ensuring the ability to commercialize. Legal access to CRISPR/Cas9 through IP rights prevents potential delays that could disrupt bringing new products to market. Without this access, companies could face significant setbacks, impacting both competitive position and market opportunities.

Strong IP protection also facilitates commercialization by allowing companies to develop and launch products with confidence. It provides the legal security needed to attract investment and build partnerships – securing the right IP is key to safeguarding the commercial potential of CRISPR/Cas9-based products.

How do you approach the delicate balance between protecting intellectual property and fostering an environment of collaboration and open innovation?

Planning and communication with internal R&D stakeholders is essential when approaching collaboration. The role of the IP team is to make sure the appropriate agreements are in place to govern the collaboration and to ensure the handling of intellectual property is managed fairly. Properly defining specific roles and activities under a collaboration agreement frees researchers for collaboration. Further, comprehensive training of R&D staff plays a critical role in ensuring that innovations are duly reported and protection is sought when appropriate.

What recent successes has ERS Genomics' patent portfolio seen?

Testament to the strength of our patent portfolio is the continual expansion of our licensing agreements across various industries. We've secured new partnerships with companies that

are leveraging CRISPR/Cas9 technology for innovative applications, including agriculture, biotechnology, and synthetic biology. These agreements highlight our commitment to enabling broad access to CRISPR/Cas9 technology.

We recently had success in China when the China National Intellectual Property Administration upheld one of our key patents related to the CRISPR/Cas9 technology. This decision affirmed the validity and reinforced the strength of ERS Genomics' intellectual property in China. The Japanese Patent Office also upheld another key patent for the second time in response to an invalidation challenge.

Although these decisions remain under appeal, successfully defending the validity of our patents, in multiple jurisdictions, reinforces the strength of our patent portfolio and assures our licensees that the underlying IP is robustly protected.

What should organizations in the US know about CRISPR/Cas9 patent licensing, given the ongoing patent disputes between the Broad Institute and CVC?

It's important to fully understand the current patent landscape, whichever jurisdiction you're working in. Despite the ongoing interferences between CVC and competitors, including the Broad institute in the US, the current situation is clear: the ongoing PTAB interferences only affect certain CVC applications specifically related to eukaryotic cells.

Moreover, the CVC group, including ERS, holds over 56 US patents covering CRISPR/Cas9 for all cell types, including eukaryotic cells. In short - to use CRISPR/Cas9, you'll need a license from CVC. If you're working specifically with eukaryotic cells, you may also need a license from the Broad Institute or others, but a CVC license is essential for all CRISPR/Cas9 applications.

> **It's important to fully understand the current patent landscape, whichever jurisdiction you're working in.**

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Tesla sues supplier Matthews International Corporation for misappropriation of trade secrets related to battery manufacturing

Dr Dustin Bauer, Associate at Reddie & Grose LLP, enters the trade secret vs. patents debate, analyzing the recent case between Tesla and its supplier to evaluate the advantages and potential drawbacks of each type of protection.

On 14 June, Tesla filed a lawsuit[1] against one of its suppliers, Matthews International Corporation, for alleged trade secret theft.

The allegedly misappropriated trade secrets relate in particular to Tesla's dry-electrode battery manufacturing technology. Tesla acquired Maxwell Technologies, a developer of ultracapacitors, in 2018, to boost its expertise in dry-electrode manufacturing[2]. Dry-electrode manufacturing has the potential to significantly reduce the environmental impact, costs and time associated with traditional electrode manufacturing, which relies on wet coating methods.

Dr Dustin Bauer

Tesla alleges that Matthews used Tesla's confidential trade secrets in their own patent filings to "claim for itself both ownership and inventorship of Tesla's confidential trade secrets". Tesla also alleges that by filing patent applications containing Tesla's trade secrets, Matthews set in motion events that could lead to the publication of confidential information regarding the dry-electrode manufacturing process.

In addition, Tesla alleges that Matthews disclosed Tesla's confidential trade secrets to Tesla's competitors, including by "selling equipment for dry-electrode battery manufacturing" which "embodied Tesla's confidential trade secrets". Tesla "conservatively estimates" that the damages will exceed $1 billion.

Tesla's IP strategy

Tesla has long pursued a fairly uncommon IP strategy, and in particular CEO Elon Musk has been happy to advocate his views on patents ("Patents are for the weak"; "[Patents] serve merely to stifle progress").

In 2014, Tesla made its patents "available for anyone to use for free[3]", doubling down by promising in 2019 that Tesla would "not initiate patent lawsuits against anyone who, in good faith, wants to use our technology".

Because of its CEO's stance on patents, Tesla generally appears to file fewer patent applications than may be expected for a company of its size and innovation. In fact, since 2018, the number of patent applications being filed by Tesla appears to have declined significantly.

It is generally understood that Tesla relies heavily on trade secrets as an alternative to patents. However, Tesla's recent lawsuit highlights one of the possible pitfalls of such a strategy.

Trade secrets vs. patents

Trade secrets have some advantages over patents, and Elon Musk is not their only fan, with trade secrets being heavily relied on in the EV and battery industry. Indeed, they should form part of a balanced IP strategy for most innovative companies.

As long as trade secrets are kept confidential, they may offer protection **indefinitely**. Trade secrets, by their very nature, also **do not require any public disclosure**, can be maintained at a relatively lower cost, and there is **no formal application process**. Because of the low hurdles, rapid advancements and **incremental improvements** may be protected by trade secrets for which patent protection may not be available.

However, trade secrets are not a monopoly right, and their misappropriation can be difficult to police. If trade secret information becomes publicly known or it is independently discovered, then protection will be lost.

Third parties in supply chains, employees, and trade secrets

In the EV battery field, even a vertically integrated company such as Tesla relies on complex supply chains. However, an IP strategy that is trade secret heavy, and light on patents, may be risky if trade secrets have to be shared with third parties.

Tesla controls many aspects of the production of its vehicles, including for the most valuable part of electric vehicles, the battery, from raw materials to manufacturing. Nevertheless, Tesla still relies on third-party suppliers such as Matthews for machinery. Indeed, Tesla's gigafactories rely on a range of new machinery to run smoothly, not all of which can be developed in-house and without third-party expertise.

Matthews' response to Tesla's allegations

Unsurprisingly, Matthews has refuted[4] Tesla's allegations. Matthews argue that they have been developing dry battery electrode technology for "over 25 years…[since] before Tesla even existed as a company". According to Matthews, the lawsuit is "simply a new tactic in their [Tesla's] ongoing efforts to bully Matthews and improperly take Matthews' valuable intellectual property".

Clearly, views differ on who owns the intellectual property at stake. Matthews has alleged

Résumé

Dr Dustin Bauer is a native German speaker who joined Reddie & Grose as an Associate in September 2018. After an engineering degree in Germany, Dustin received his PhD in Materials Chemistry from UCL, researching the hydrothermal synthesis of nanoparticles for use in a range of energy storage devices, including lithium-ion batteries, sodium-ion batteries, and hybrid capacitors. His area of expertise includes energy storage, nanotechnology, green chemistry, chemical processes, and materials science.

Dustin has experience working on patents in a variety of fields, including medical devices, consumer products, materials, internal combustion engines and electric engines, electric vehicles, and related technologies such as batteries, fuel cells, and electronics. Dustin is keenly interested in renewables (including solar cells) and sustainability (including battery recycling and more sustainable battery manufacturing).

1 https://fingfx.thomsonreuters.com/gfx/legaldocs/xmvjnrorovr/TESLA%20MATTHEWS%20LAWSUIT%20complaint.pdf

2 https://www.lexisnexisip.com/resources/tesla-to-buy-maxwell-technologies-an-important-technological-edge-in-the-battery-market-for-electric-cars/

3 https://www.reddie.co.uk/2014/08/15/tesla-motors-opens-up/

4 https://www.matw.com/investors/news-events/press-releases/detail/249/matthews-international-refutes-tesla-allegations

However, an IP strategy that is trade secret heavy, and light on patents, may be risky if trade secrets have to be shared with third parties.

that Tesla "fails to identify even one trade secret that Tesla purportedly disclosed to Matthews", and that Tesla "came to Matthews seeking… access to our **valuable intellectual property, trade secrets** and our global engineering talent" [emphasis added].

The outcome of the lawsuit will be watched with great interest by many, not only in the Li-ion battery and EV sectors, but also by IP professionals with an interest in trade secrets and patents. It remains to be seen if a settlement will be reached, especially considering that according to Matthews' press release, "Matthews continues to work with Tesla as a trusted supplier."

Not the first high-profile trade secret dispute

Tesla v. Matthews is not the first high-profile trade secret dispute in the EV battery industry. In a global dispute between LG and SK Innovation, which involved allegations of patent infringement in various jurisdictions, trade secrets were also at stake.

Besides relying on suppliers to maintain trade secrets, employees play a crucial role in keeping confidentiality. In a field such as EV batteries, which has frequently seen employees move between competitors, one of the greatest risks to a company's trade secrets may be former employees.

Ensuring that employees are aware of the highly confidential nature of trade secrets, and their duty to maintain confidentiality regarding trade secrets after their employment ends, may prevent unintentional disclosure of trade secrets. However, it is very difficult, even with best practice trade secret management, to prevent intentional misappropriation of trade secrets by former employees.

In the dispute between LG and SK Innovation referenced above, employees left LG to join SK Innovation, in the process allegedly misappropriating LG's trade secrets. The dispute highlighted the risks employees leaving to work for competitors may pose to trade secrets. It also showed the difficulty of distinguishing the skills and expertise of employees, some of which may have been acquired through their employment, from trade secrets of the employer.

While LG and SK Innovation ultimately settled, the settlement came after the US International Trade Commission (ITC) found in 2021 that SK Innovation had misappropriated LG's trade secrets, prohibiting imports of some SK Innovation lithium-ion batteries into the US for 10 years, emphasizing the potential value of trade secrets.

LG Energy Solution launches new license pool with Panasonic and threatens to get tough on infringers

In spite of the specific examples outlined above, for a quickly expanding, highly innovative, and increasingly competitive sector, the EV battery sector has not seen as much patent litigation as one may envisage.

However, there is a string of recent high-profile disputes, such as *Opel and CATL v. MU Ionic* (in 2023, Düsseldorf Regional Court, Germany found that CATL's batteries did not infringe EP1939971[5]) and *ATL v. CosMX* (in 2024, CosMX subsidiaries were found to infringe ATL patents in the US and Germany).

LG has one of the, if not the, largest patent portfolio relevant to current generation EV batteries. LG recently announced[6] that it intends to take a firm stance against an alleged "surge in patent infringement by latecomers in the battery industry". According to LG's analysis, at least 580 of what LG calls "highly strategic patents" are being infringed by other battery manufacturers – showing the potential for a significant increase in patent litigation in the battery sector.

However, one must take into account that LG's announcement also included explicit reference to LG's plan of "establishing a fair patent licensing system", and the launch of a joint patent licensing pool by LG Energy Solution and Panasonic Energy, Tulip Innovation[7]. As such, it remains to be seen if establishment of the licensing pool will reduce LG's enforcement activities, or if LG will expand its IP litigation if licenses are rejected by alleged infringers.

LG also expects the "risk of patent infringement by latecomers" to also extend to "next-generation battery technologies" including "dry coating processes" – the same "next-generation" manufacturing technology in dispute between Tesla and Matthews.

Final thoughts

Patent applications are published and have a finite lifespan, whereas trade secrets can, theoretically, remain secret in perpetuity. Thus, in some sense, trade secrets may be seen to "stifle progress" whereas patents enforce disclosure of innovations, allowing others to build on innovative developments.

It will be interesting to see if Tesla will be successful in its lawsuit, and the effect Matthews' patent applications will have on Tesla's alleged trade secrets and its IP strategy.

In general, trade secrets can be a valuable part of a successful IP strategy, particularly in a fast-moving field like battery manufacturing. However, patents have some significant advantages over trade secrets, and their enforcement is perhaps more straightforward. Most large companies' IP strategies should likely include a combination of patents and trade secrets.

One can't help but wonder whether Tesla's position would have been improved had they filed patent applications to the alleged trade secrets being implemented in equipment and disclosed in patent applications by Matthews.

Most large companies' IP strategies should likely include a combination of patents and trade secrets.

5 https://register.epo.org/application?number=EP06832384
6 https://www.lgcorp.com/media/release/27604
7 https://tulipinnovation.com

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Patent revocation actions under the new European patent system: UPC vs. EPO and why it may be wise to reappraise your European filing strategy

Sophie Ertl and Heike Röder-Hitschke of Maiwald evaluate the first 15 months of the Unitary Patent Court to assess its success in comparison to the EPO system, whilst providing guidance for leveraging the best available protection.

After 15 months into the new European patent and court system, it seems safe to say that both the Unitary Patent (UP) and the Unified Patent Court (UPC) have been very positively received by the patent world. However, the new system could still potentially present major challenges, and not only for European companies. In 2023 alone, for example, 24.2% of applications for European patents (EP) were filed by US applicants.[1] In addition, at 15%, US patent proprietors have the second-largest share of all UPs registered to date.[2]

First important orders and decisions of the UPC, which has exclusive competence for all disputes relating to EPs[3] and UPs, have already been handed down in revocation proceedings. In particular, whether or not the UPC will stay a revocation action where opposition proceedings before the European Patent Office (EPO) are pending may be of considerable strategic importance for patent proprietors (but also for opponents) of an EP or UP and could force patent applicants to rethink their filing strategies, or opponents to consider new ways of challenging granted patents.

Sophie Ertl

Heike Röder-Hitschke

Unitary Patent: the status quo

Facts & figures

Thanks to the daily updated figures that the EPO makes available on its website[4], it is very easy to track the development of the Unitary Patent and its level of acceptance by patent applicants.

The overall picture after 15 months is positive: expectations for the UP and its take-up figures have been met or exceeded for both 2023 (expected 17%, actual 17.5%) and 2024 (expected 20%, currently 24.8%). There is no significant backlog in the processing of applications for unitary effect (4.9%), and only very few applications (0.1%) have been rejected or withdrawn. Most of the applicants are from Germany, followed by the USA, France and China. The most strongly represented technical fields are so far medical technology (12.0%), civil engineering (5.6%), measurement technology (5.5%), transport (5.2%), digital communication (5.2%), pharmaceuticals (3.7%).[5]

2nd generation

Since September 1, 2024, the UP comprising 17 EU Member States (1st generation) has been replaced by the 2nd UP generation comprising 18 EU Member States, now including Romania[6]. *See Fig. 1.*

With each new participating Member State, there will be a next generation of the UP; clarity about the territorial scope of protection of the respective UP will then only be provided by checking the UP register kept at the EPO.

Note that 1st generation UPs granted up to August 31, 2024, continue unchanged; a later extension of the territorial scope is not possible.

Revocation actions[7]: the *status quo*

Patents-in-suit

Of the 41 revocation actions pending, five are in respect of UPs; seven of the EPs concerned were returned to the jurisdiction of the UPC by opt-in. In 15 cases, parallel opposition or appeal proceedings are pending before the EPO. *See Fig 2.*

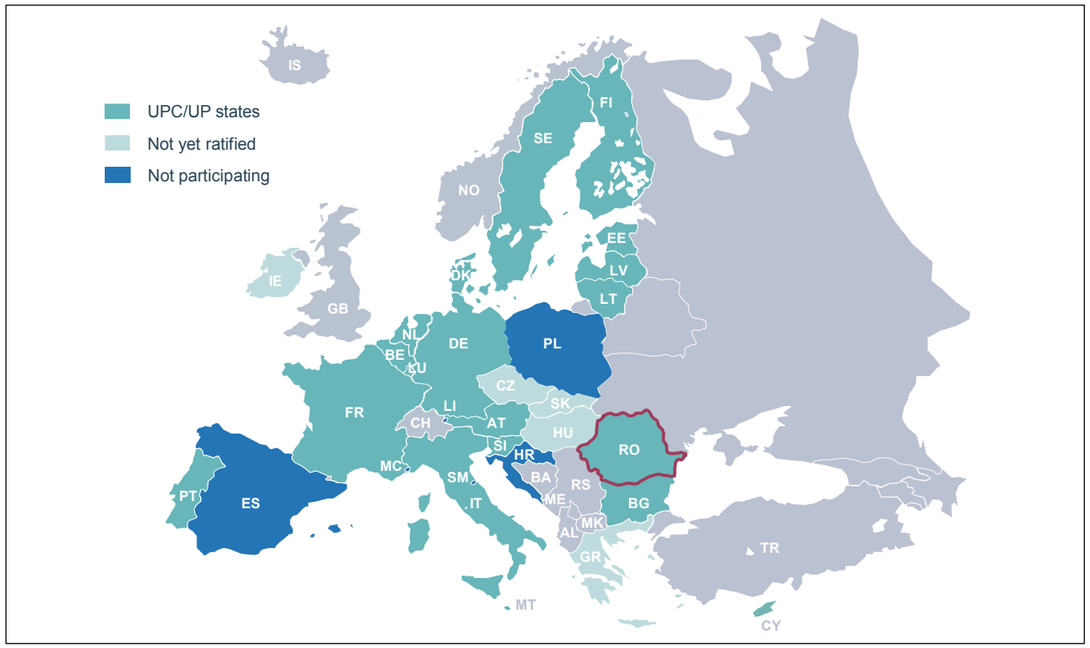


Fig. 1 - UPCA territory as of September 1, 2024.

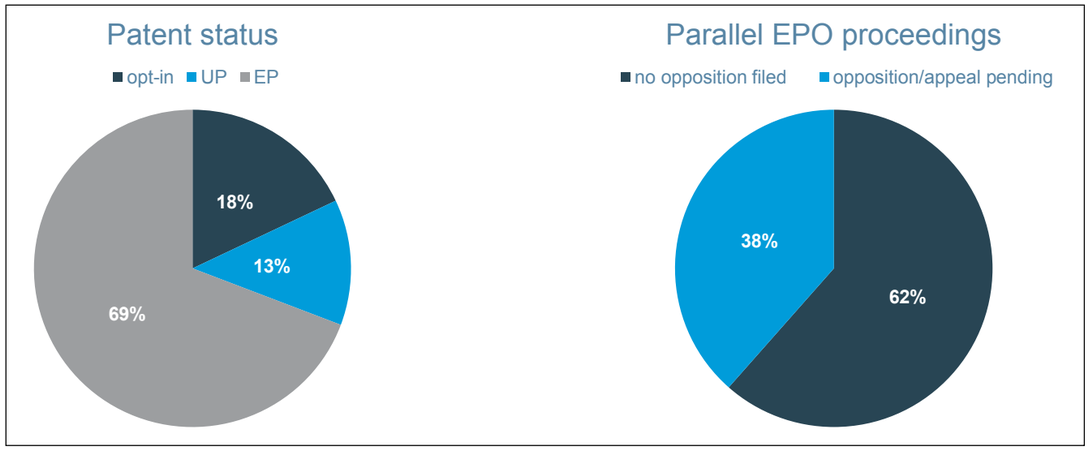
Timeline

The aimed-for duration of first instance revocation proceedings is one year from filing to decision. So far, in many cases oral proceedings are being scheduled for hearing 10-13 months after filing, with a decision being expected within six weeks. The first cases already concluded adhered to this strict timetable.[8]

The Central Division of the Court of First Instance responsible for revocation actions is not only capable of meeting this very ambitious target, but is fully focused on doing so.

1 Cf. Statistics & Trends Center | epo.org [August 12, 2024].
2 Cf. Unitary Patent Dashboard of the EPO | epo.org [September 10, 2024].
3 Apart from an initial seven-year transitional phase, during which the national courts have parallel jurisdiction, or a declared opt-out from this exclusivity.
4 Cf. Unitary Patent Dashboard.
5 As of September 10, 2024.
6 Romania deposited its instrument of ratification for the UPCA on May 31, 2024, and as of September 1, 2024, it is the 18th EU Member State to participate in the new system.
7 Not including a defendant's counterclaim for revocation as a defense in infringement proceedings.
8 CD Munich, UPC_CFI_1/2023: 12.5 months; CD Paris, UPC_CFI_263/2023: 12 months; CD Paris, UPC_CFI_255/2023: 11.5 months.

Fig. 2 - Status of patents in dispute and proportion of patents with pending EPO proceedings.



Résumés

Dr. Sophie Ertl provides expert counsel on patent portfolio strategies and management, addressing a wide range of intellectual property matters. She is skilled in drafting patent applications and representing clients in patent prosecution, opposition, and appeal proceedings. Additionally, she prepares legal opinions on technical and legal issues, including freedom-to-operate, infringement, and validity analyses. With extensive experience in intellectual property disputes, Sophie has successfully managed numerous cases involving patent and utility model infringements, as well as nullity and cancellation proceedings. Her technical expertise spans mechanical engineering, automotive, medical devices, semiconductors, materials engineering, and process technology.

Sophie leads Maiwald's UPC task force and is a frequent speaker on patent law, particularly regarding the UPC.

Heike Röder-Hitschke has been advising national and international businesses from a broad range of industries in all areas of intellectual property as well as competition and IP-related antitrust law for almost 20 years, with a particular focus on patent litigation.

She has extensive experience in accompanying international FTO projects as well as in coordinating national and cross-border infringement proceedings (patents, utility models, SPCs) and participates in parallel validity proceedings.

In addition, she advises on employee invention law and IP-related agreements.

Heike is a member of Maiwald's UPC task force and regularly presents on UPC topics and gives lectures on patent and licensing law.

Validity of an EP or UP: UPC vs. EPO - who decides first?

The UPC-Agreement (UPCA) allows for a revocation action to be filed even if EPO opposition proceedings are pending. Art. 33(10) UPCA states:

"A party shall inform the Court of any pending revocation, limitation or opposition proceedings before the European Patent Office, and of any request for accelerated processing before the European Patent Office. The Court may stay its proceedings when a rapid decision may be expected from the European Patent Office."

In two proceedings to date, the Central Division decided not to make use of this possibility of staying revocation proceedings in favor of parallel opposition proceedings, as a *rapid decision* by the EPO was not to be expected in either case. At the time of the decisions, the oral hearing on the opposition in one case (Munich) was fixed for about four months later[9] and in the other case (Paris) the hearing date was not yet fixed[10]. In the Paris case, the Court of Appeal confirmed the decision, as the date of the oral hearing on the opposition, which had in the meantime been fixed, would not have taken place until more than four months after the oral hearing on the revocation action.[11]

Looking at the usual duration of opposition proceedings before the EPO, one may well wonder whether the UPC will ever wait for the EPO's Opposition Division. This is because, in the normal course of opposition proceedings, it has not been unusual for approx. 20 months to elapse between the grant of the patent and the issuance of a preliminary opinion by the Opposition Division; a decision is usually only expected after approx. 28 months. Even in accelerated proceedings, it was normal for a decision on the opposition to be issued no earlier than approx. 24 months – far too long for the UPC's target of concluding a revocation action at first instance within a year. Even the new acceleration rules recently introduced by the EPO will rarely, if ever, be able to remove this considerable discrepancy.[12] *See Fig. 3*

The Court of Appeal was very clear on this point:

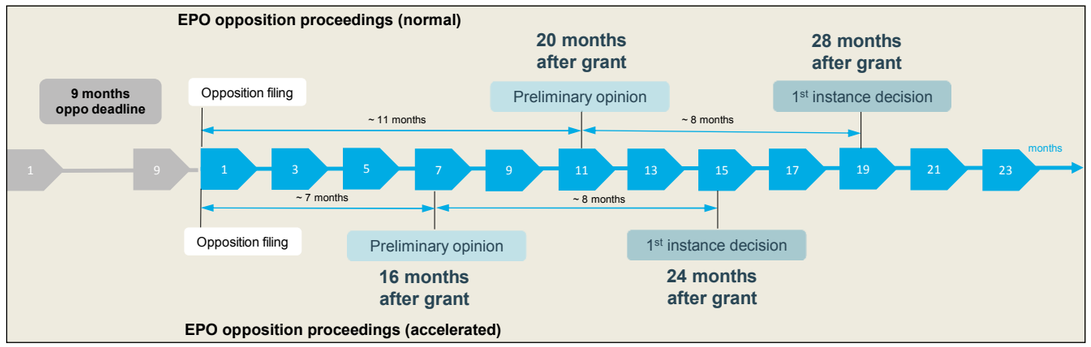
> "[...] proceedings must be conducted in a way which will normally allow the final oral hearing at first instance to take place within one year [...] It follows that, as a general principle, the Court will not stay proceedings.
>
> The mere fact that the revocation proceedings before the UPC relate to a patent which is also the subject of opposition proceedings before the EPO is not sufficient to allow an exception [...].
>
> The mere fact that the EPO has granted a request to accelerate the opposition proceedings is not sufficient to stay revocation proceedings before the UPC."

The Court of Appeal also addressed the question of whether this might lead to conflicting decisions by the UPC and the EPO:

> "The principle of avoiding irreconcilable decisions does not require that the UPC always stay revocation proceedings pending opposition proceedings. Firstly, decisions in which the UPC and EPO issue different rulings on the revocation of a European patent are not irreconcilable. Where one body upholds the patent and the other revokes it, the latter decision will prevail. Secondly, the interests of harmonizing decisions on the validity of a European patent can be promoted by ensuring that the body that decides last can take the decision of the body that decides first into account in its decision. [...]"

It must therefore be assumed that if the UPC has jurisdiction,[13] it will most likely decide first on the validity of a newly granted patent or a patent that is only in the early stages of opposition proceedings. It remains to be seen whether and how the EPO will then consider the UPC's arguments and decision.

Fig. 3 - Timeline of EPO opposition proceedings.



Prosecution strategies

Taking all this into account, patent proprietors may well ask themselves whether they should at all request a UP, leave their EP under the jurisdiction of the UPC, or opt-out. This is quite beside other considerations, such as cost aspects, how to optimize one's patent protection in Europe, and protect one's portfolio against potential invalidity risks.[14]

Unitary Patent

As a rule of thumb, for a patent proprietor seeking protection in more than four UPCA countries, the UP is cheaper than the classic EP. However, it carries the risk of simultaneous patent revocation across all 18 UPCA countries, whilst the competence of the UPC also allows for centralized infringement proceedings and injunctions with the same effect.

National patent

In some cases, national protection alone is already sufficient, cost-effective and has other advantages besides its affordability. German patent law ensures smoother and faster application and examination proceedings. In addition, the German Patent Office generally adopts a notably applicant-friendly stance compared to its European counterpart.

9 CD Munich, UPC_CFI_80/2023 ORD_579547/2023 APP_577540/2023 of November 20, 2023.

10 CD Paris, UPC_CFI_263/2023 ORD_591040/2023 APP_590707/2023 of January 8, 2024.

11 CoA, UPC_CoA_22/2024 APL_3507/2024 of May 28, 2024.

12 EPO notice of November 7, 2023, regarding parallel opposition and national or UPC proceedings and EPO guidance on accelerated proceedings of February 22, 2024.

13 This applies to UPs and EPs for which no opt-out has been declared or for which such a declaration has been withdrawn (opt-in).

14 See also Sophie Ertl, A comparative analysis of the EP patent, the DE patent, the German Utility Model, and the Unitary Patent, in: *Women's IP World Annual*, 2024, p. 70 et seq.

15 Provided that either a UP is applied for or no opt-out is declared for the EP.

16 Austria, Denmark, Finland, Italy, Portugal, Sweden.

17 Utility Model protection is available, *inter alia*, in Germany, Austria, Bulgaria, Denmark, France, Italy, Portugal.

Double protection

With the entry into force of the UPCA, the prohibition of double protection for EP and national patents was lifted in Germany and France.[15] Other countries have extended the double patenting already permitted for EP to UPs.[16] This ensures additional protection of the invention in important markets if the UPC declares the EP or UP invalid.

Utility model

The branching off of a utility model[17] could be a cost-effective alternative to, or a third level of protection in addition to national patent and EP. Indeed, the German utility model is emerging as a surprising and formidable tool that offers unique advantages, including lower costs and a simplified registration process. Registration is fast, often within days of filing, and devoid of substantial examination. This rapid process positions it as a potent and unexpected asset in combating competitors through prompt infringement actions. Validity challenges can be addressed in both infringement and separate cancellation proceedings, allowing for flexible claim amendments during the litigation process. The utility model can be filed separately or seamlessly branched off from a pending DE, EP, or PCT (with Germany as a designated country) application.

New attack strategies

The UPC's case law on the suspension of a pending revocation action opens up new possibilities for third parties wishing to challenge an EP. If a party is interested in a very quick review and, at best, revocation of the patent, at least in the now 18 UPCA Member States, it may be worthwhile filing a stand-alone revocation action with the UPC immediately after the grant of the EP or registration of the UP. A suspension is not to be feared, especially since an opposition, which may additionally be filed in order to have the EP revoked in the non-UPCA territory, will only be processed after the nine-month opposition period has expired. At this point, the revocation action will be already well advanced and an oral hearing on the opposition still a long way off. Although such a "double attack" is costly, it would be a very interesting strategy, either with the aim of destroying the troublesome patent or reaching a settlement with the patent proprietor.

We would be very pleased to formulate strategies tailored to your or your client's specific needs and would greatly welcome an opportunity to discuss these with you.

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Invention harvesting in emerging technologies

Robert Klinski, Founder of Patentship, analyzes how to harvest valuable inventions to develop sustainable IP portfolios in digital technologies.

Technology life cycle and its impact on invention

Every technology undergoes a life cycle starting with an emerging technology stage, moving through growth, and eventually reaching saturation. The emerging technology stage, often sparked by a disruptive event, offers significant opportunities for new inventions with low "IP competition." During this period, valuable IP assets can be secured with broad protection at reasonable costs. Early investment in emerging technologies presents a high risk-to-reward ratio, especially with a clear market vision, but CAPEX risks are also higher.

As technology enters the growth stage, adoption increases, leading to incremental innovations. Patent applications rise, but protection scopes narrow. Although CAPEX risks decrease, so does the risk-to-reward ratio as the technology matures.

In the saturation stage, the focus shifts to monetizing the technology. Innovation slows, and maintaining IP portfolios becomes costly, leading many to abandon less valuable IP or seek monetization.

To justify CAPEX for IP development, a strong business case is needed, ideally maximizing rewards while minimizing risks. The emerging technology stage is often optimal for IP development, but predicting high returns is uncertain, making CAPEX risk mitigation essential.

The inventor's dilemma

Traditionally, technology development has been concentrated in the growth stage, where the focus is on incremental invention to improve existing products, such as the combustion engine, which dates back to 1892. Engineers, familiar with enhancing known technologies like energy-efficient electronic circuits, often generate inventions as by-products of this incremental development.

In contrast, the emerging technology stage involves creating entirely new technology platforms. Engineers are typically not trained to systematically develop intangible IP assets and often struggle to identify what to invent in the absence of an established technology platform. This dilemma is further emphasized by Patent Offices – particularly the European Patent Office – which tend to favor incremental inventions rooted in existing technology platforms when assessing the inventive step.

> **"Once a technology trend becomes profitable, engineers face intense pressure to transition it from niche to mainstream markets."**

Innovation challenges in the emerging technology stage

Emerging technologies can be disruptive, often bypassing established innovation processes due to the lack of an existing technology to build upon. Clayton M. Christensen noted that disruptive technologies are frequently overlooked by established companies in their early stages because they typically originate in less profitable market niches and involve significant technical challenges ("The innovator's dilemma: when new technologies cause great firms to fail", Boston MA, United States: Harvard Business School Press, 1997). Moreover, not all new technology trends lead to profitable outcomes. Once a technology trend becomes profitable, engineers face intense pressure to transition it from niche to mainstream markets.

Case studies on emerging technologies

An example of an emerging technology with vast potential for invention harvesting is 5G network architecture. This advanced system enables the creation of specialized sub-networks, or "slices," each tailored to meet the unique demands of specific applications, such as the ultra-low-latency communication essential for autonomous driving. While the hardware components used to establish these 5G network slices are largely well-known, the true value lies in the innovative slice architectures themselves.

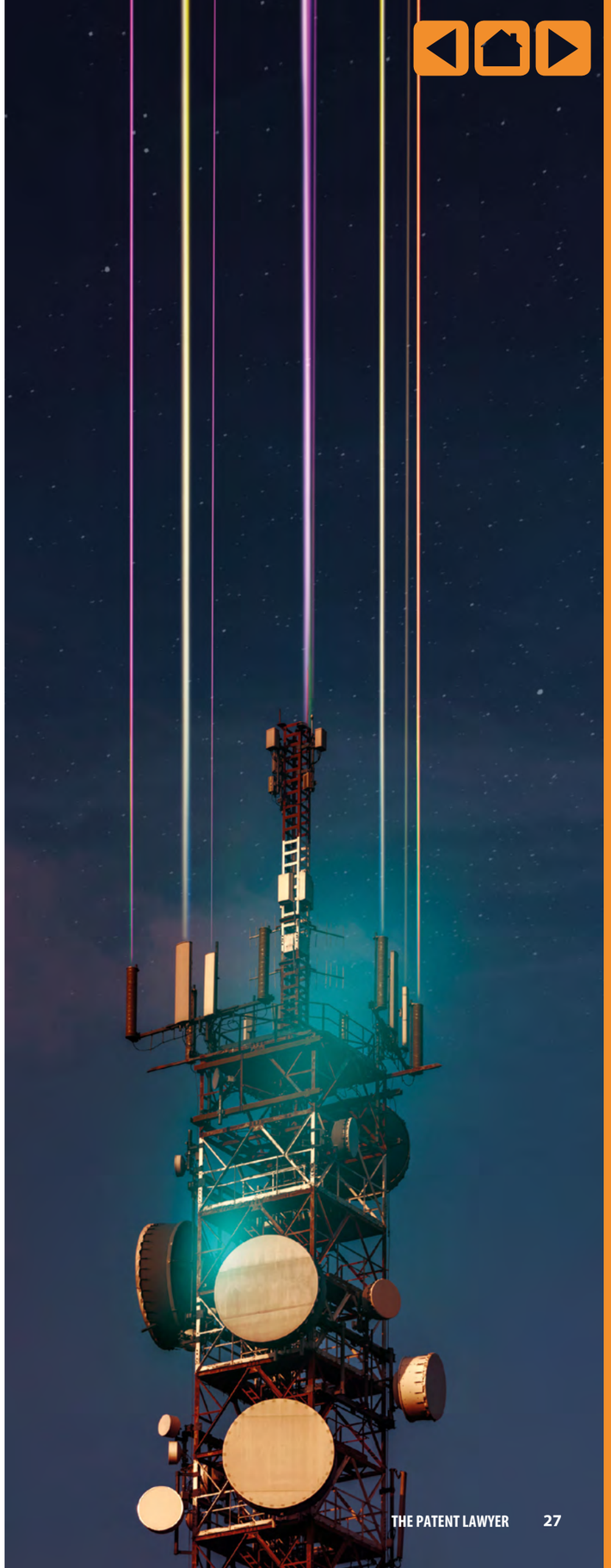
Each 5G slice represents a distinct business opportunity, with its architecture defining the parameters of its use case. By securing patents on these slice architectures, companies can effectively protect their underlying business models through an indirect approach that also covers the associated hardware configurations. In this context, generating valuable inventions demands more than just technical expertise – it requires an entrepreneurial mindset. Engineers must not only possess a deep understanding of the technology but also the vision to identify and capitalize on the business potential inherent in these cutting-edge developments.

Another example is artificial intelligence (AI), a rapidly advancing field with immense potential for invention harvesting, particularly in the development of specialized algorithms and applications. AI technologies, such as machine learning models and neural networks, are already well-established, but the real innovation lies in the novel ways these technologies are applied to solve industry-specific challenges. For instance, in sectors like healthcare or finance, AI can be tailored to enhance predictive analytics, optimize decision-making processes, or automate complex tasks. Patenting these unique AI-driven solutions allows companies to protect their business strategies and market positions by securing exclusive rights to the underlying algorithms and methodologies. In this context, successful invention harvesting requires not only a deep technical understanding of AI architectures but also a strategic business perspective. Engineers and developers must be supported in thinking entrepreneurially, identifying opportunities where AI can create significant value and competitive advantage.

Market need vs. technical problem to be solved

In the emerging technology stage, inventions often arise from satisfying a market need rather than solving a technical problem to improve existing technology. For example, the development of cryptocurrencies was driven by a market need for secure electronic payments rather than a technical problem associated with improving the security of existing banknotes.

An essential patentability criterion employed by Patent Offices, such as the European Patent Office, is the technical solution of a technical problem as claimed in a patent application. The European Patent Office does not require or award solutions that address market needs. However, a valuable invention should ideally address a market need at all stages of technology development. An invention that satisfies a market need is more likely to be implemented in a product or infringed upon by a third party, thereby possessing greater monetary value than an invention that merely improves existing technology. In other words, the CAPEX risk associated with a given invention is reduced if the invention solves a technical problem associated with a



Résumé

Robert Klinski, German and European Patent Attorney and the Founder of Patentship, specializes in harvesting valuable inventions to develop sustainable IP portfolios as well as in prosecuting and litigating patents in digital technologies

He studied electrical engineering and telecommunications at the Technical University Hamburg-Harburg and received his PhD with honors from the Technical University of Munich in the field of statistical signal processing in telecommunications. He was a scientific researcher at the Fraunhofer Institute and an engineer at Siemens AG in the fields of wired and wireless communication systems, and he is mentioned as an inventor in several patents relating to telecommunications.

Robert has worked in the IP field since 2002 and has extensive experience in IP prosecution, IP litigation, IP harvesting, and creating IP on demand in the fields of digital signal processing, 5G, the Internet of Things (IoT), AI, fintech, security, and blockchain. In his recent 5G, SIM, IoT, security, and fintech projects, he supported his clients by harvesting more than 450 inventions. Robert also actively supports international investment firms in IP-backed start-up incubation and IP generation on demand.

Patentship is a medium-sized patent law firm based in Munich, specializing in value-oriented, results-driven patent drafting, prosecution, litigation, and invention harvesting in various jurisdictions and across a wide range of technologies, such as electrical engineering, telecoms, and information systems, software, mechanical engineering, automotive, chemistry, and biotech. Patentship's clients include national and international research institutes, medium-sized companies, and global players listed in the Fortune 500 and Forbes 100 rankings.

Robert Klinski

market need rather than a technical problem related to the technology itself. CAPEX risk can be further reduced by considering patent office practices during the invention harvesting process and focusing on inventions that provide technical solutions to technical problems addressing market needs.

"An example of an emerging technology with vast potential for invention harvesting is 5G network architecture."

Challenges associated with harvesting inventions during the emerging technology stage

One significant challenge in harvesting valuable inventions during the emerging technology stage is that new technologies are often developed in software, which presents numerous challenges in patenting. However, software is just another technology tool that frequently replaces traditional technology tools used to solve technical problems. It should be noted that software implementations, or generally technical inventions that solve technical problems with technical means, can be patented according to the EPO.

Patenting emerging technology stage inventions: AI

AI is currently a leading emerging technology, raising important questions about how to patent AI inventions effectively.

At the European Patent Office (EPO), AI inventions are patentable if they are drafted with precise and sustainable claims. Typically, AI applications involve two phases: training an AI model using data and deploying the trained model for a specific task. These phases are often distinct, as seen with OpenAI's ChatGPT, where the model is trained by OpenAI and then deployed by users.

For valuable AI patents, it is advisable to claim the training and deployment phases separately, unless both are performed by the same entity – such as in cases where an AI model is trained during the operation of a robot. In such cases, both phases should be claimed together.

Patenting the training of AI models with data

To obtain a patent for AI training processes, the characteristics of the data used for training the AI model are crucial. It is important to remember that the EPO does not consider AI models, in and of themselves, to be patentable. However, training an AI model with specific data for a specific technical task – thereby provisioning the AI model for a particular technical purpose – can be considered a technical contribution and thus patentable.

The EPO makes a distinction regarding the sources of data used for training an AI model. AI models can be trained using simulated data, such as data derived from a digital twin simulation of an environment. For example, an AI model designed to control an autonomous industrial truck can be trained using "real-world data" from sensors in the environment or simulated data from digital twin simulations. However, training an AI model with simulated data constitutes a computer simulation of a technical system, and according to EPO decision G 001/19, this alone is not sufficient to meet the EPO's patentability requirements. As a result, AI inventions involving training an AI model based solely on a computer simulation of a physical system may be deemed non-patentable by the EPO.

Conversely, physical interaction with the real world, such as the environment of an autonomous truck during training, may render an invention patentable. For instance, if the training data is directly obtained from physical measurements taken by the truck as it navigates its environment, the corresponding AI invention may be considered patentable.

Patenting specifically adapted AI implementations

Another category of AI inventions that are patentable at the EPO involves AI systems specifically adapted to solve technical problems within a particular application. For example, the use of a neural network in a heart monitoring device to detect irregular heartbeats is a patentable AI application. In this context, AI serves as a tool within a technical application, addressing a specific technical problem.

Summary

Invention harvesting in emerging technologies is a complex, interdisciplinary process. It demands deep technological insight, entrepreneurial foresight to assess future market potential, and a thorough understanding of patent practices. Equally important is fostering inventors' motivation and providing the support needed to pioneer new technology platforms and applications.

PATENTSHIP has mastered this complexity with a market-driven invention harvesting strategy, successfully applied across sectors like security, cryptography, IoT, and 5G. Our approach consistently delivers high-value inventions, and our impressive patent grant rate highlights the effectiveness of our proven methodology.

"For valuable AI patents, it is advisable to claim the training and deployment phases separately, unless both are performed by the same entity."

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The way(back) to public accessibility

David McCombs, Eugene Goryunov, and Eric Horsley of Haynes & Boone review recent cases that have questioned public accessibility to provide best practice advice for indexing and searchability.

Prior art in the form of patents and printed publications is the foundation of any challenge to patent validity in an *inter partes* review ("IPR"). A petition for IPR must show that a publication qualifies as prior art under 35 U.S.C. § 102. Without that showing, an IPR never gets off the ground. In *First Solar, Inc. v. Rovshan Sade ("First Solar")*, the Patent Trial and Appeal Board ("Board") denied institution of IPR as a result of Petitioner First Solar's failure to establish that a reference was publicly accessible before the critical date.[1] A discussion of First Solar, related cases, and a few lessons follows.

David McCombs

Eugene Goryunov

Eric Horsley

Résumés

David McCombs is a partner at Haynes and Boone LLP with 35 years of experience serving as primary counsel for many leading corporations. He is regularly identified as one of the most active attorneys appearing before the Patent Trial and Appeal Board.

Eugene Goryunov is a partner at Haynes and Boone LLP with nearly 15 years of experience representing clients in complex patent litigation matters involving diverse technologies, from consumer goods to high tech, medical devices, and therapeutics.

Eric Horsley is an associate in the Intellectual Property Practice Group. His practice focuses on patent prosecution and counseling. Eric has a Ph.D. in physics and brings his extensive education in physics to assist clients in protecting their technology.

First Solar, Inc. v. Rovshan Sade

The patent at issue in *First Solar* is directed to solar trackers that reorient solar panels to track the sun throughout the day.[2] First Solar ("Petitioner") challenged claims 5-6 based on an installation guide ("Wattsun") and a brochure ("RayTracker") – each related to a solar tracker product.[3] Petitioner alleged that the public accessibility of Wattsun was "evidenced at least by its reference on a webpage verified by the Internet Archive as being publically [sic] available as early as December 2, 2005."[4] For support, the Petitioner cited an affidavit of a Records Request Processor at the Internet Archive that described the Wayback Machine and how it is searched.[5] Similar Wayback Machine-related support was offered for the RayTracker reference. For RayTracker, Petitioner alleged further support for public accessibility from "testimony by persons with personal experience and knowledge of *RayTracker"* and "identification of a later version of *RayTracker* as prior art by the Applicant during the prosecution of US Patent No. 9,917,546, a continuation of the '57546 Patent."[6] However, the RayTracker webpage containing the brochure relied on by Petitioner was not archived in the Wayback Machine before the relevant priority date.[7]

The Board was not convinced of the public accessibility by the relevant priority date. For Wattsun, the Board agreed with Patent Owner that "Petitioner has failed to present sufficient evidence or argument that an interested party exercising reasonable diligence would have located Wattsun."[8] The Board found two deficits. First, a lack of testimonial evidence "that a person interested in solar trackers or solar panel assemblies would be independently aware of the web address for Wattsun or even of the company or its products."[9] Second, the website for Wattsun was not shown to be indexed and thus only "technically accessible."[10] For RayTracker, the Board observed that RayTracker did not match a later version of the webpage cited by Petitioner, and that uncorroborated testimony could not salvage an availability date for RayTracker.[11]

In *First Solar,* the inability to establish public accessibility was sufficient to decide the entire IPR. Irrespective of the reasons for not offering sufficient evidence, the denial of institution tracks with the existing caselaw. That caselaw provides a guide to successfully establishing public accessibility of a reference and avoiding common pitfalls. We now turn to that caselaw.

Establishing Public Accessibility of the Prior Art

The key relevant feature of a printed publication is public accessibility.[12] A reference is publicly accessible if it was "'disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art [(POSA)] exercising reasonable diligence, can locate it.'"[13] Determining public accessibility "involves a case-by-case inquiry into the facts and circumstances surrounding the reference's disclosure to members of the public."[14] However, technical accessibility is not sufficient to show public accessibility.[15] A reference is only technically accessible when there is a lack of both meaningful indexing/cataloging and other evidence of showing a POSA could locate the reference with reasonable diligence.[16] For example, indexing by author and year alone may not be meaningful indexing.[17]

There are many forms of evidence that can be used to support public accessibility. For example, evidence that tends to establish the extent of indexing or cataloging, the quality or functionality of search features, the knowledge of a POSA, etc. No particular form of evidence is required to make a showing of public accessibility. What follows are some illustrative cases of how public accessibility is successfully and unsuccessfully established along with associated lessons.

Indexing & Searchability: *In re Lister, Voter Verified, and Acceleration Bay*

Publicly accessible: In *re Lister* concerns the public accessibility of a manuscript. The manuscript was included in three databases – two commercial databases and the Copyright Office's automated catalog.[18] The Copyright Office's automated catalog could only be searched by author's last name or first word of title of the work.[19] The parties agreed that the indexing of the automated catalog was insufficient to make it publicly accessible.[20] The commercial databases permitted keyword searching of titles, which rendered the manuscript publicly accessible as of the time of its inclusion in those databases.[21]

In *Voter Verified,* an online digest was asserted as prior art. The Federal Circuit noted three important findings of the district court for public accessibility: (1) the online digest where the reference was published was "well known to the community interested in the [relevant art]"; (2) all publications in the online digest were treated as public disclosures and users could freely and easily copy online digest content; and (3) the online digest included search tools that would have retrieved the reference upon keyword searching.[22] On this evidence, the Federal Circuit agreed with the District Court's finding of public accessibility despite the lack of evidence showing the website was indexed by any commercial search engines.[23]

> **The Federal Circuit agreed with the District Court's finding of public accessibility despite the lack of evidence showing the website was indexed by any commercial search engines.**

Only technically accessible: In *Acceleration Bay*, a technical report was only technically accessible through a website. While advanced search features were available, evidence tended to show the search functionality was unreliable.[24] What remained was a list of technical reports indexed by author and year.[25] The Federal Circuit agreed with the Board's finding that there was insufficient indexing and functional search features to show the technical report was publicly accessible.[26]

Lesson One and Two: First, if a potential reference is indexed, ensure you establish meaningful indexing. Second, if relying on search features, ensure they are sufficiently advanced (e.g., keyword searchable) and functional. Like *Acceleration*

1 *First Solar, Inc. v. Rovshan Sade*, IPR2023-00827, Paper 13 (PTAB Nov. 16, 2023).
2 *Id.* at 4–6.
3 *Id.* at 7–8.
4 *First Solar, Inc. v. Rovshan Sade,* IPR2023-00827, Paper 2 at 3 (PTAB April 28, 2023).
5 *Id.; First Solar, Inc. v. Rovshan Sade*, IPR2023-00827, Ex. 1009 (PTAB April 28, 2023).
6 *First Solar, Inc. v. Rovshan Sade,* IPR2023-00827, Paper 2 at 5–7 (PTAB April 28, 2023).
7 *First Solar, Inc. v. Rovshan Sade,* IPR2023-00827, Paper 13 at 24–26 (PTAB Nov. 16, 2023).
8 *Id.* at 17.
9 *Id.* at 18
10 *Id.* The Board highlights the difference between showing the Wayback Machine is searchable and querying a search engine before the critical date.
11 *Id.* at 24–25.
12 *See Jazz Pharms., Inc. v. Amneal Pharms.,* LLC, 895 F.3d 1347, 1355 (Fed. Cir. 2018).
13 *SRI Int'l, Inc. v. Internet Sec. Sys. Inc.*, 511 F.3d 1186, 1194 (Fed.Cir.2008) (quoting *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)).
14 In *re Klopfstein,* 380 F.3d 1345, 1350 (Fed. Cir. 2004).
15 *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019).
16 *See id.* (Describing a situation where there is no meaningful indexing but other evidence tended to show accessibility).
17 See the discussion of *Acceleration Bay* below.
18 *In re Lister* 583 F.3d 1307, 1315 (Fed. Cir. 2009).
19 *Id.*
20 *Id.*
21 *Id.* at 1315–16. Ultimately, the government failed to show the manuscript was included in the commercial databases by the critical date. Id. at 1317.
22 *Voter Verified, Inc. v. Premier Election Sols., Inc.,* 698 F.3d 1374, 1380–1381 (Fed. Cir. 2012).
23 *Id.* at 1381.
24 *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018).
25 *Id.* at 774.
26 *Id.*

Bay, the Petitioner in *First Solar* only established that the Wayback Machine was indexed by a URL, and no further information was alleged as to the search features of the Wayback Machine.[27] As the Board observed, this is mere technical accessibility in the absence of other evidence.[28]

Other Evidence: *Weber*

Corroborated testimony: In *Weber,* indexing was not relied on to establish public accessibility. Weber sought to use their own operating manuals for a commercial slicer as prior art.[29] And "record evidence show[ed] that Weber's operating manuals were accessible to interested members of the relevant public by reasonable diligence."[30] The parties disputed the number of customers who received the operating manuals, and patent owner argued the cost of the commercial slicer's that the operating manuals accompanied prevented the manuals from being sufficiently accessible.[31] The Federal Circuit found neither issue defeated public accessibility.[32] Weber employees testified that the operating manuals could be obtained upon purchase of a slicer or by request to a Weber employer.[33] Weber corroborated this evidence with invoices, delivery notes, customer declarations, and email correspondence.[34] Further, Weber showed operating manuals were available at trade shows and factory showrooms.[35] Reversing the Board, the Federal Circuit held that the operating manuals were publicly accessible.[36]

Lesson Three: If relying on testimony, ensure it is corroborated. In contrast to *Weber*, the Board in First Solar noted that "the record at hand does not provide any suitable corroboration for Mr. Schneider's expressed 'belief and opinion' and 'personal knowledge' as to the public availability of [RayTracker]."[37]

Conclusion

Failing to establish the public accessibility of alleged prior art is a critical misstep in the early stages of an IPR. Missteps in this vein can take several forms, including only establishing technical accessibility and failing to corroborate testimony on public accessibility. However, they also reveal some paths to establish public accessibility, which are captured in the three lessons set out above.

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> **First, if a potential reference is indexed, ensure you establish meaningful indexing.**

[27] *See, e.g., First Solar, Inc. v. Rovshan Sade,* IPR2023-00827, Ex. 1009 (PTAB April 28, 2023).
[28] *First Solar, Inc. v. Rovshan Sade,* IPR2023-00827, Paper 13 at 18 (PTAB Nov. 16, 2023).
[29] *Weber, Inc. v. Provisur Technologies, Inc.*, 2022-1751 at 6 (Fed. Cir. February 8, 2024).
[30] *Id.* at 11.
[31] *Id.*
[32] "No minimum number of occasions of access is dispositive of the public accessibility inquiry in all cases." "Cost alone cannot be dispositive because the printed-publication inquiry is focused on the interested public, not the general public." "Here, the interested public includes commercial entities that can afford high-cost slicers." *Id.*
[33] *Id.*
[34] *Id.* at 12.
[35] *Id.*
[36] *Id.* at 2.
[37] *First Solar, Inc. v. Rovshan Sade,* IPR2023-00827, Paper 13 at 25 (PTAB Nov. 16, 2023).

A study on product claims defined by parameters from laws and judicial precedents

Yingan Gu, patent attorney of Beijing Sanyou IP Agency Ltd., identifies relevant laws and regulations surrounding parameters in patent examination whilst reviewing recent trends with case examples.

In the practice of patent application and right confirmation, there are a lot of product claims defined by parameters. This may be due to limitations on objective conditions, for example one or more technical features in a product claim cannot be clearly characterized by structural features, thus the applicant has to define a product by using parameter features, which settles for second best. On the other hand, the applicant may also adopt parameter features to define a product claim for its subjective intention, for example redefining the existing product in the form of parameter features, so as to achieve a purpose of hiding the essential features of the product. However, for whatever reason, the applicant needs to pay attention to the laws and regulations related to patentability evaluation of parameter features, and tracks examination and trial trends in a timely manner, and on this basis, carries out patent landscaping, invalidation attack and defense, etc.

Yingan Gu

Relevant laws and regulations

The *Guidelines for Patent Examination* provide the grounds for using parameters to define a product claim. However, when using parameter features to define the product claim, it is advised to pay attention to the limitations of relevant legal provisions, such as:

1. Examination of a product claim with parameter features mainly involves the provisions of paragraph 2, Article 22 of the Chinese Patent Law on novelty.

In addition, Section 3.2.5 of Chapter 3 of Part II in the *Guidelines for Patent Examination* specifically stipulates the examination principle "presumption of lacking-novelty" for a product claim with performance or parameter features. Accordingly, regarding the novelty of a product claim characterized by parameter features, it does not depend on whether the parameter is disclosed in prior art in *pro forma* or not, but, starting from the subject "product claim", if a precondition in which persons skilled in the art cannot distinguish a claimed product from a product in the prior art according to said parameter, the claim may then be presumed not to possess novelty. The onus of proof is transferred to the applicant; the applicant needs to prove that a product with the parameter features differs from the product in the prior art in terms of structure and/or composition.

It should be noted that, for persons skilled in the art to distinguish the claimed product from the product in the prior art according to the parameter, it is not only necessary to compare the defined parameters with prior art, but also usually to examine other conditions provided in

Résumé

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the involved patent and the prior art. For example, whether there are differences in other parameters and preparation methods which are for reference. Therefore, the requirement for proving this precondition is strict.

2. On the other hand, a request for invalidation of a product claim with parameter features mainly involves the provisions of paragraph 3, Article 26 of the Chinese Patent Law on "fully disclosed by the Specification" and paragraph 4, Article 26 on "supported by the Specification".

A product claim should be based on the Specification, and the Specification should meet three requirements for full disclosure: "clear," "complete," and "achievable". In a product claim defined by parameter features, "achievable" is a reason that is often questioned. This is because, if the applicant uses unconventional parameters, non-empirical formulas, or formulas obtained through unconventional derivation to present a technical solution, then if an effect produced by this technical solution goes beyond the scope that can be reasonably expected by persons skilled in the art according to their mastered common technical knowledge, persons skilled in the art have sufficient reasons to suspect that this technical solution cannot solve its technical problem and achieve an expected technical effect, that is, does not meet the definition of "achievable" in the *Guidelines for Patent Examination*.

Examination and trial trends

The Letter of the China National Intellectual Property Administration (hereinafter referred to as CNIPA) in reply to advice No. 8842 of the fifth session of the 13th National People's Congress clearly states that "patent applications defined by formula and parameter-type features are to be examined strictly according to law"[1]. Seen as such, the examination of parameter patents by the CNIPA tends to be stricter.

In addition, the Supreme People's Court (hereinafter referred to as "SPC") has also adopted the mode of inversion or transfer of the onus of proof in specific trial practice, requiring a patentee to provide evidence to prove that a claim defined by parameters implies that it differs from a prior art/reference document in terms of structure or composition, otherwise, it is presumed that novelty is not tenable.

Hereinafter descriptions will be made using several cases.

Problem of presumption of lacking-novelty

The patent war between China air conditioner giants Gree and Aux began in December 2018.

> **If a precondition in which persons skilled in the art cannot distinguish a claimed product from a product in the prior art according to said parameter, the claim may then be presumed not to possess novelty.**

[1] https://www.cnipa.gov.cn/art/2022/7/22/art_516_176743.html

At that time, Aux bought a compressor patent from Toshiba Carrier and filed an infringement lawsuit against Gree, which lasted about five years. The SPC made a final judgment on this case on December 7, 2023 ((2023) Zui Gao FA Zhi Xing Zhong No. 37).

A point of dispute in this case (patent number of the involved patent: ZL00811303.3) lies in whether claim 1, defining that a ratio of a total area of slot gap portions to an entire area of the gas passages is 0.3 or more, and thus belonging to a product claim defined by a parameter, possesses novelty or not.

In the trial of this case, the SPC elaborated on the rules for determining whether a claim containing an unconventional parameter feature possesses novelty and in particular, pointed out that:

"If the parameter in this patent claim is an unconventional parameter that has not been used in prior arts, the patent document does not fully disclose the impact of the parameter feature on a product structure or composition, while a reference document has disclosed the same invention idea as the patent, which may make it difficult for persons skilled in the art to distinguish the product claimed by the patent from the prior arts. At this time, in order to prevent the patentee or applicant from hiding the fact of lacking novelty by redefining the existing product features in the form of an unconventional parameter feature, and to protect the interests of the public, the patentee or applicant should prove or adequately demonstrate difference(s) between the two. If the patentee or applicant cannot prove or adequately demonstrate difference(s) between the two, an unfavorable presumption may be made to the patentee or applicant, determining that the patent claims do not possess novelty relative to a reference document."

Seen as such, when the involved patent involves unconventional parameters that do not have much physical significance, the SPC adopts a mode of reversion or transfers the onus of proof. Therefore, if a difference with prior arts only lies in an unconventional parameter, while the applicant cannot explain well how the claimed product is distinguished from a prior art/reference document in terms of structure or composition, then the unconventional parameter cannot substantially play a role in defining a product claim, and there is a considerable risk of failure in the final trial.

Problem of insufficient disclosure

The case involved in Invalidation Request Examination Decision No. 563221 (patent number of the involved patent: ZL200610072849.5) was rated as one of the "top 10 cases of patent reexamination/invalidation in 2023", and the key legal issue of this case involves defining a product by parameter features.

Claim 1 of the involved patent defines N_{min}, the minimum number of single batteries in a battery pack, by using a formula with technical parameters, thereby ensuring that there are enough single batteries as heat absorbers when an individual single battery explodes and burns. However, the collegial panel considered that the calculation formula has many technical parameters and calculation relations, and multiple specific conditions or ideal conditions need to be assumed to derive N_{min}, while in actual working conditions in the field of lithium batteries, these specific conditions or ideal conditions are difficult to achieve, so a technical effect of its solution has lower predictability. Persons skilled in the art have sufficient reasons to suspect that the above calculation formula cannot solve its technical problem and achieve an expected technical effect, and must be verified through experimental data, however, the Specification does not provide any experimental effects to prove, resulting in persons skilled in the art unable to reasonably expect whether the above calculation formula can solve its technical problem and obtain the expected technical effect.

Seen as such, the CNIPA requires full disclosure of a technical solution, and also requires that a technical effect is not just an ideal effect but must be one that is able to be expected according to the contents of the Specification. For a technical field with a technical effect having lower predictability, if a calculation formula with parameters in a technical solution is derived under many specific conditions or ideal conditions, the applicant at least needs to disclose experimental data for verification, otherwise the requirement on full disclosure is not met.

Problem of support

China battery manufacturer giants CATL, GOTION HIGH-TECH, etc., launched an invalidation challenge to a lithium iron phosphate battery patent (patent number: ZL200610002636.5) of Longhua Technology. And before this, Longhua Technology filed a lawsuit against Tesla for patent infringement to the Hefei Intermediate People's Court, and this lawsuit was accepted. Seen as such, the involved patent has caused widespread attention in the industry.

Claim 1 of the involved patent defines that a ratio of the surface area to the thickness of a positive electrode material coating is greater than $1.2*10^6$mm, which belongs to a product claim defined by parameter. In this case, The CNIPA questioned the critical limit value of the parameter range "$1.2*10^6$mm": since the Specification did not provide sufficient explanation to support the rationality of this choice, the CNIPA considered that this ratio parameter was not reasonable, so the claim was not supported by the Specification.

> **A product claim should be based on the Specification, and the Specification should meet three requirements for full disclosure: "clear," "complete," and "achievable".**

Conclusion

As revealed by the examination and trial cases, although it is a feasible and even convenient way to define a product claim by a parameter feature, the applicant needs to re-examine the landscape strategy of a parameter patent to avoid a presumption of no novelty, or from being rejected or invalidated due to problems such as insufficient disclosure, not being supported by the Specification, etc.

Specifically, when considering defining a product claim by a parameter feature, an applicant should consider that when facing a challenge of novelty, the applicant can provide sufficient evidence to show how the parameter feature implies the composition and/or structure of the product, thus distinguished from prior art.

Furthermore, if the parameter feature relies on a specific condition or ideal condition, the applicant further needs to provide evidence, including experimental data, to prove that the condition can be achieved, and the performance/technical effect corresponding to the parameter can be expected.

In addition, when considering defining a product claim by process, performance, use, etc., the applicant may draft and consider the patent landscape by referring to similar laws and regulations as well as examination and trial trends concerned with a product claim defined by parameter.

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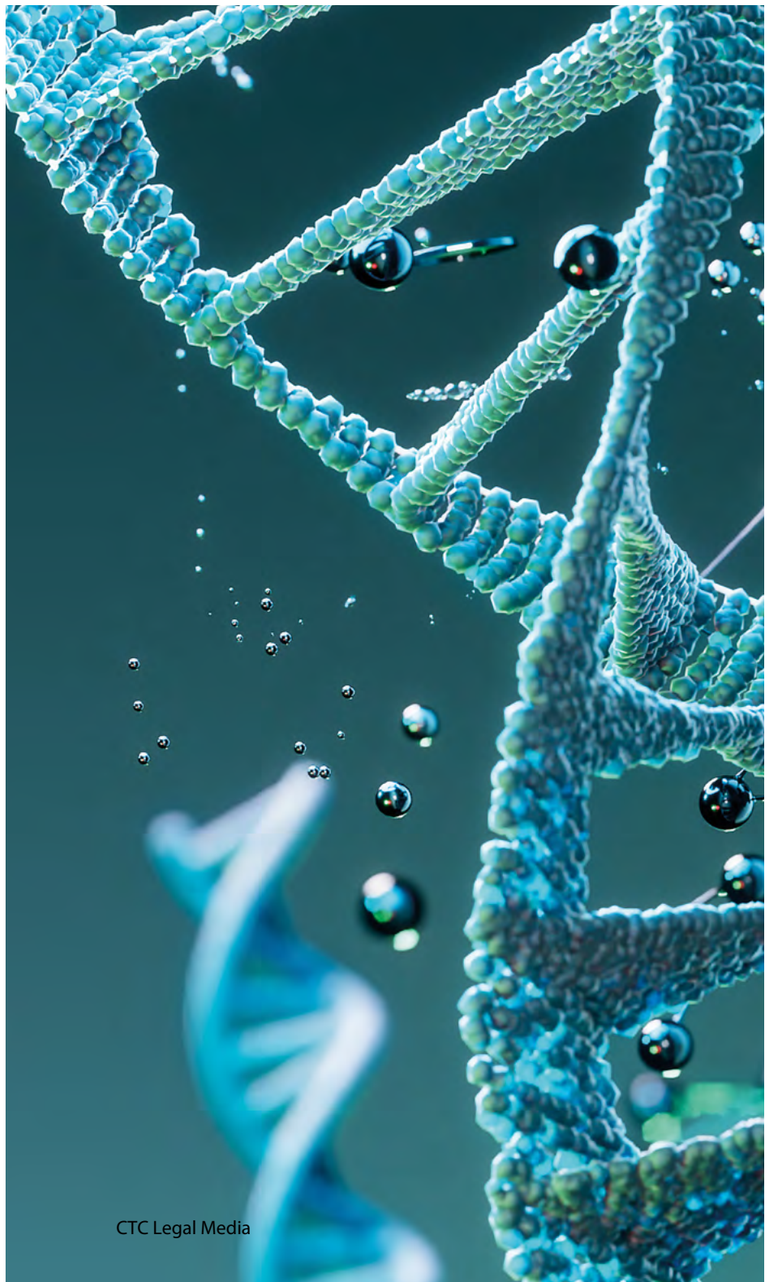
Key factors for WIPO ST.26 adoption at the Mexican Patent Office



CTC Legal Media

Rommy Morales, Sergio Olivares, Daniel Sánchez, and Jorge Juarez of OLIVARES introduce the changes set out in WIPO Standard ST.26, including new rules for representing amino acids and nucleotides and the need for applicants to adjust in preparing and submitting patent applications.

Biotechnology has transformed several fields like medicine, agriculture, and environmental sciences by promoting advancements at the molecular level. Many of these developments rely on DNA, RNA, or amino acid sequences, which are key components of new biotechnological drugs, genetically modified organisms, and diagnostic tools. To protect these biotechnological inventions, sequence listings must be included in patent applications as they are an essential component thereof.

The sequence listings provide a standardized way to disclose biological sequences, which is important for patent examination, public disclosure, and the future development of related technologies.

On July 1, 2022, the World Intellectual Property Organization (WIPO) introduced Standard ST.26, a new standard for sequence listings that replaced the previous ST.25. This new standard brings significant changes to how sequence

Résumés

Rommy Morales boasts over 16 years of experience in intellectual property, with a specialization in patent prosecution, IP litigation, and plant variety protection. She is renowned for accurately identifying clients' needs and subsequently developing and implementing strategies tailored to the protection of their industrial property rights. Rommy provides technical and legal advice to national and international clients in the pharmaceutical, biotechnology, and chemical industries. Her advice covers the preparation, filing, prosecution, granting, and enforcement of patents, including patentability and validity opinions, as well as freedom-to-operate analyses. In her role, Rommy supervises the team responsible for filing and prosecuting patent applications. Owing to her distinguished reputation as a biologist and her extensive experience in the field, she also leads the department dedicated to plant variety protection in Mexico.

Sergio Olivares joined OLIVARES in 1987 and has been practicing IP law for more than three decades. He has been a partner since 1994 and Chairman of the firm's Management Committee since 2009. He is proficient across all areas of IP law, working very closely with the firm's Patent Group. Sergio is highly recommended by leading industry publications and directories as a leader in IP. He has been integral to OLIVARES' expansion into new and innovative practice areas; has been at the helm of cases that are helping to shape the standard for evaluating inventive step and novelty for pharmaceutical patents; and was involved in a landmark Supreme Court case that changed the landscape for unfair competition enforcement in Mexico. Sergio received his J.D. from the Universidad Intercontinental in 1991 and graduated from the Franklin Pierce Center for Intellectual Property in 1993.

Daniel Sanchez joined OLIVARES in 2000, became a partner in 2011, and co-chairs the firm's Litigation and Patent Teams. He is one of the leading intellectual property and administrative litigators in Mexico and is recognized by industry rankings and publications including Chambers Latin America, IAM Patent 1000, and WTR 1000. As one of the few regulatory and administrative litigation experts in Mexico, Daniel guided the development and implementation of a revolutionary and proprietary software system that replicates the drug naming and labeling approval process within COFEPRIS, Mexico's health ministry. This drastically improves the accuracy of advice about whether clients' marketing authorizations can and will be approved. He has also led Olivares' team in obtaining approval for alcoholic beverage advertisements from COFEPRIS, authored various articles on IP and Life Sciences-related matters, and lectured on IP topics in both national and international forums.

Jorge Juárez has been in the IP field since 2006 and works in the patent department of Olivares. His primary area of practice is related to the fields of Industrial Designs, Electronics, Electricity, Software, Mechanical, and Information Technologies (IT), wherein he provides specialized advice related to patent prosecution including technical and legal consultancy in substantive examination matters, patent searching, and patent drafting. He also supports the patent litigation team providing technical options. He co-chairs the Patent Subcommittee of Industrial Designs and Mechanical and Electronic Inventions of the Mexican Association for the Protection of Intellectual Property (AMPPI).

listings are formatted and submitted in patent applications.

The role of sequence listings in biotechnology patents

In biotechnology patent applications, the inclusion of nucleotide or amino acid sequences is often crucial to the invention. These sequences must be clearly disclosed, and sequence listings provide a structured and standardized format for presenting them. This ensures that the invention is disclosed in a sufficiently clear and complete manner, allowing a person skilled in the art to replicate it – an essential requirement of the patent system. Additionally, sequence listings help clarify the scope of the claims in a patent by defining the subject matter for which protection is sought. They also facilitate the search and examination process, enabling patent offices to more efficiently assess the patentability of the invention.

The transition to WIPO Standard ST.26

In accordance with WIPO guidelines, ST.26 applies to all patent applications filed on or after July 1, 2022, regardless of the priority date.

The introduction of WIPO Standard ST.26 on July 1, 2022, marked a significant change in how sequence listings are presented in patent applications. Under ST.26, sequence listings must be filed in Extensible Mark-up Language (XML) format, replacing the text or PDF formats used under ST.25. This change addresses the limitations of the text-based format of ST.25, which was not fully compliant with the requirements of public sequence databases and often resulted in data loss during the transfer of sequence listings. The adoption of the XML format under ST.26 allows for automated validation and improved search features, benefiting both patent offices and applicants.

This transition was motivated by the need to harmonize sequence listing practices across different jurisdictions, reflect advances in biotechnology, and meet the requirements of current public sequence databases.

Key differences between ST.25 and ST.26 standards

WIPO Standard ST.25 has become less effective and is no longer sufficient to include the increasing variety of sequences that have emerged in the field of biotechnology. For example, ST.25 did not properly address the representation of linear portions of branched sequences, D-amino acids, or nucleotide analogs. The adoption of ST.26 solves these problems by introducing these additional sequence types, making ST.26 more complete and better adapted to modern biotechnology developments.

ST.26 also introduces new rules for representing amino acids and nucleotides. For example, amino acids are now represented by a single capital letter rather than the codes used under ST.25, which included three letters. Additionally, RNA sequences are now repre-sented using "t" instead of "u" for uracil, aligning with current standards in public sequence databases.

Likewise, ST.26 excludes sequences with fewer than 10 defined nucleotides or four defined amino acids from the sequence listing.

Consequently, the transition to ST.26 requires applicants and patent offices to make some adjustments in how they prepare, submit, and receive patent applications containing sequence listings, considering these differences.

To support this transition, WIPO developed the WIPO Sequence Validator software, which allows patent offices to verify that sequence listings comply with ST.26.

For applicants, WIPO also developed the WIPO Sequence software, which is compatible with Windows, Mac OS, and Linux operating systems. This software helps applicants generate ST.26-compliant sequence listings and automatically validates them to ensure they meet the new standard. It also facilitates the transformation of ST.25 sequence listings into ST.26 format, although applicants must be careful to avoid introducing new matter during this process, as it could affect the validity of the patent application. While the use of WIPO Sequence is not mandatory, it is recommended to minimize errors in sequence listings.

On the other hand, for applicants, WIPO has also developed software called WIPO Sequence. This software can be used on three operating systems: Windows, Mac OS, and Linux. It helps applicants generate amino acid or nucleotide sequence listings that meet the requirements of Standard ST.26 by checking it and highlighting any issues that need to be addressed through automated validation. Additionally, it allows the transformation of ST.25 sequence listings into ST.26 format if an applicant has previously submitted a sequence listing under ST.25. The transformation process involves converting the listing into XML format and adding any additional information required under ST.26; however, care should be taken to avoid introducing new matter as it could affect the validity of the patent application. WIPO has provided guidelines for applicants on converting sequence listings to ST.26 while preserving the content and scope of the original application.

Filing PCT applications with sequence listings

The introduction of ST.26 also impacts the filing of Patent Cooperation Treaty (PCT) applications with sequence listings. In this regard, the ePCT system now includes real-time validation features that help prevent errors and ensure compliance with ST.26. In addition, it is no longer possible to submit ST.25 sequence listing for a PCT application filed after July 1, 2022. All such applications must comply with the new format. This requirement ensures that sequence listings in PCT applications are consistent with those filed in national patent offices, promoting global harmonization in biotechnological patent applications.

Rommy Morales

Sergio Olivares

Daniel Sanchez

Jorge Juárez

Mexican legislation on sequence listings

In Mexico, the presentation of sequence listings in patent applications is regulated by specific provisions set forth in the Federal Law for the Protection of Industrial Property, Regulations of the IP law, and "Agreement on the Rules for the Filing of Patent Applications in Mexico."

The main consideration regarding sequence listings, as outlined in the Mexican legislation, is that sequence listing must be presented as a separate part of the patent application and titled "Sequence Listing." If a sequence listing is included within the descriptive chapter of the patent application, the Mexican Institute of Industrial Property (IMPI) will require the applicant to amend the specification and present the sequence listing as an independent section of the application. It is important to note that there is no requirement to submit a Spanish translation of the sequence listing presented under the ST.26 format.

According to Mexican Law, to get a filing date for a patent application, the sequence listing must be submitted from the beginning. If a sequence listing is required but not presented, IMPI will recognize the filing date as the date and time when the sequence listing is submitted.

Although WIPO Standard ST.26 should apply to all patent applications filed on or after July 1, 2022, regardless of the priority date, IMPI stipulated that the ST.26 format must be used for non-PCT applications, if the claimed priority under the Paris Convention is on or after July 1, 2022. For national applications (those not processed under the PCT or Paris Convention) filed on or after July 1, 2022, the sequence listing must comply with ST.26.

Currently, the IMPI's patent online filing system, known as PASE (Portal for Access to Electronic Services), still allows the submission of sequence listings in PDF format (ST.25 standard) at the time of filing the application. However, it is anticipated that this option will eventually be disabled to promote compliance with the new standard for applications containing sequence listings.

Sequence listings in divisional applications

WIPO recommends that sequence listings for divisional applications filed from July 1, 2022, are submitted in the ST.26 format even if the parent application includes a sequence listing under ST.25 standard.

WIPO leaves it to the discretion of patent offices whether to allow applicants to use the sequence listing from the parent application and incorporate it into the divisional application. In the case of Mexico, for divisional applications containing sequence listings, the filing date of the initial application will determine whether the sequence listing to be submitted must comply with Standard ST.25 or ST.26, that is to say, they should use the same format as the parent application.

Conclusion

The transition to WIPO Standard ST.26 represents an important step in the development of biotechnology inventions containing sequence listings. By adopting the XML format and including additional sequence types, ST.26 enhances the quality, consistency, and accessibility of sequence data in biotechnology patents.

For applicants, the transition to ST.26 requires the use of specialized tools and resources provided by WIPO, such as the WIPO Sequence software and the ePCT system. As the field of biotechnology continues to evolve, the adoption of ST.26 is essential for the harmonization of sequence listing practices.

With ST.26 now in effect, applicants must adapt to the new requirements and take advantage of the opportunities it presents. By doing so, they can ensure that their inventions are properly protected and that their sequence listings are accessible for the assessment of patentability. This accessibility also contributes to advancing biotechnology and related fields on a global scale.

> **The transition to ST.26 requires applicants and patent offices to make some adjustments in how they prepare, submit, and receive patent applications containing sequence listings.**

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Can obtaining a preliminary injunction for patent infringement be considered abusive if the patent is later annulled? Romania's High Court says no

Alina Tugearu, Partner at Zamfirescu Racoti Vasile & Partners, details the enforcement of provisional measures for patent infringement and the concept of fault-based liability.

Romania's High Court supports the principle of fault-based liability when enforcing provisional measures for patent infringement, contrary to CJEU's preference expressed in the latest decision on the matter in *Myan v. Gilead* (C-473/22) and more in line with the principles laid down in the earlier decision in *Bayer v. Richter* (C-688/17).

CJEU's interpretation of Article 9 (7) of Directive 2004/48 on the enforcement of intellectual property rights in this year's decision in *Mylan v. Gilead* (C-473/22)[1] has led us to revisit an earlier decision of the Romanian High Court of Cassation and Justice, which supports the principle of fault-based liability under Romanian law when enforcing provisional measures for patent infringement.

Although the CJEU has expressed a different preference in its latest decision, it has also clarified that the Member States do have the possibility to opt for a strict (no-fault) liability regime or a fault-based liability regime. As we will further detail, Romania's High Court has confirmed that, under Romanian law, a fault-based liability regime is applicable.

Alina Tugearu

[1] The decision was issued on 11 January 2024

Résumé

Alina Tugearu, partner, leads the Intellectual Property Litigation practice of Romanian law firm Zamfirescu Racoti Vasile & Partners (ZRVP).

She has extensive experience, of more than 18 years, in advising local and international companies on a broad range of IP matters related to the exercise and protection of trademark rights. Her practice focuses on IP litigation with an emphasis on patents, trademarks, copyrights, domains, designs, and unfair competition law, assisting clients in different fields, including the pharmaceutical and biotechnology industries, cosmetics, advertising, food, oil and gas, design and engineering software, music and sports.

Legal context

According to Article 9 (7) of the Directive 2004/48 on enforcement of IP rights:

> "Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures."

Similarly, Article 50 (7) of the TRIPS Agreement provides that:

> "Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures."

CJEU's interpretations

The provisions of Article 9 (7) of Directive 2004/48 have been scrutinized by national courts, which called for the interpretation of the CJEU to clarify the limits of the protection stemming from the enforcement of intellectual property rights.

In 2019, in *Bayer v. Richter* (C-688/17), CJEU had upheld the validity of national legislation that denied automatic compensation for damages caused by the enforcement of provisional measures based on a patent that was later invalidated, i.e., thus seeming to require a liability based on fault, with compensation being due only to the extent that the applicant had committed an abuse of rights or process when filing for the provisional measures. In essence, the Court held that Article 9(7) does not automatically apply where provisional measures are later revoked, or the patent is later held invalid, but the courts must take due account of all the objective circumstances, including the conduct of the parties, in order to determine that the applicant had not abused the provisional measures (see para. 71 of the decision).

Further clarifications followed early this year in *Mylan v. Gilead*, where CJEU confirmed that a mechanism of strict (no fault) liability, based on the risk incurred by the applicant, is not contrary to the EU legislature's objective of ensuring the enforcement of intellectual property rights while comprehensively mitigating the risk that the defendant will suffer loss as a result of provisional measures (see para. 47 of the decision). To support such a conclusion, the CJEU pointed out that there is no mention of fault in Article 9(7) (see para. 31 of the decision), and the wording of Article 9(7) is broad (see para. 35 of the decision).

However, the same decision confirms that Article 9(7), read in light of Article 50 (7) of the TRIPS Agreement, "must be interpreted as laying down a minimum standard" for the enforcement of intellectual property rights, **"leaving the Member States leeway to opt, as the case may be, for a strict liability regime or a fault-based liability regime"** (see para. 36 of the decision).

In light of the above, it is clear that it is for the Member States, through their national legislations, to provide the most appropriate mechanism for compensation for the damages caused by provisional measures, as long as minimum protection is ensured.

> **"Romania's High Court has confirmed that, under Romanian law, a fault-based liability regime is applicable."**

The Romanian perspective

In a landmark decision rendered in 2019, the High Court of Cassation and Justice has held that the obtaining of a preliminary injunction for patent infringement cannot be considered abusive in case the patent is later annulled, which supports the principle of fault-based liability when enforcing provisional measures for patent infringement in Romania.

The facts pertaining to the decision of the High Court are as follows:

A pharma company successfully filed a preliminary injunction against a generic manufacturer based on the *prima facie* rights stemming from a Romanian patent and thus obtained the prohibition of the sale of the generic drug on the Romanian market for a significant period.

The invoked patent was granted in the national phase of a PCT procedure, in relation to which two other foreign patents granted in national phases had already been annulled on the grounds of lack of novelty. Prior to filing the injunction, the generic company had contested the granting of the patent, but its revocation request was rejected by the competent courts, which thus confirmed the validity of the granted patent.

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Immediately after the provisional measures were granted, the generic company filed for annulment of the Romanian patent on the same grounds of lack of novelty, which it eventually obtained nine years later.

After the patent was annulled, the generic company filed a damages claim against the pharma company, alleging that the pharma company was aware that its Romanian patent was not valid (i.e., annullable based on the conclusions of the international search report) and therefore abusively filed and obtained the injunction, thus seriously damaging the generic manufacturer (damages of approx. EUR 4.6 million); moreover, it invoked the retroactive effects of the nullity, which supposedly affected the right invoked when obtaining the injunction.

After initially being rejected in the first court, the damages' claim was admitted in appeal by the Bucharest Court of Appeal, based on the generic manufacturer's arguments.

This decision was, however, later reversed by the High Court of Cassation and Justice through a landmark decision that establishes the principles of reparation under Romanian law when enforcing provisional measures for patent infringement in Romania, i.e., a fault-based liability.

According to Romanian civil law, liability for damages caused by one's own act, i.e., tort liability, requires the cumulative existence of four conditions or constituent elements: the wrongful or illicit act, the damage, the causal link between the wrongful act and the damage, and the guilt.

The High Court held that the filing of a court claim based on the rights stemming from a patent in force can never be considered abusive and an illicit deed under the Romanian liability regime since the applicant's actions represent an exercise of the rights provided by the law which cannot in itself have an illicit nature. Moreover, the reliance on the effects of a final court decision (i.e., the decision rejecting the revocation against the granting of the national patent) cannot represent an illicit act.

Thus, the mere exercise of rights that are provided by the law – such as the right of the patent holder to seek provisional measures based on the effects of a patent in force at that date – can never be illicit. This is in perfect line with the Latin dictum: *Neminem laedit qui jure suo utitur*.

Moreover, the High Court has confirmed on several occasions that the use of the effects of a final court decision cannot constitute an illicit act, irrespective of the fact that such a decision is later reversed following extraordinary means of appeal. What matters is the fact that, at the date when the applicant made use of these effects, the court decision was final and presumed to express the truth. By analogy, the same rationale applies to a patent that is later annulled.

In what concerns the fact that two other foreign patents granted in national phases had already been annulled on the same grounds of lack of novelty, which were later held in Romania, the High Court upheld the principle of independence of patents in various jurisdictions in line with the provisions of Article 4 bis of the Paris Convention for the Protection of Industrial Property. It thus confirmed that the validity conditions for patents in various jurisdictions are to be analyzed separately. Since the Romanian patent had been granted, it benefitted from the presumption of validity, which had rightfully supported the applicant's provisional measures' request.

“The mere exercise of rights that are provided by the law – such as the right of the patent holder to seek provisional measures based on the effects of a patent in force at that date – can never be illicit.”

Finally, in what concerns the retroactive effects of nullity, the High Court pointed out that irrespective of this legal effect, it cannot be held that, at the date when the injunction was filed, the applicant had the subjective representation of the invalidity of their patent which was only years later annulled.

Note that in *Mylan v. Gedeon*, CJEU held that the retroactive invalidation leads to the consequence that the act of the defendant prevented by the provisional measures was fully part of legitimate trade and should not have been hindered (see para. 49 of the decision). The Court further goes on to state that the high level of protection of intellectual property intended by the EU legislature could not be invoked since the intellectual property right, which has been declared invalid retroactively, is deemed never to have existed.

However, in a fault-based regime, such as the one under Romanian law, the legal fiction of retroactivity cannot corrupt/affect the subjective representation existing at the date when the applicant sought the injunction. This is because, at that date, the applicant benefitted from the legal effects of a patent in force that supported its request for provisional measures and that subjective representation cannot be 'retroactively annulled'. As the High Court held, at the date when the injunction was filed, the applicant had legitimately grounded its provisional measures request on the effects of the patent in force.

Conclusion

Irrespective of the type of regime adopted by the Member States, both the *Bayer* and *Mylan* decisions confirm the discretion of the national courts, which cannot automatically and, in any event, order the applicant to provide compensation. What is essential is that the courts consider all circumstances of the case, including the conduct of the parties, in order to determine whether the applicant has abused the provisional measures or not (which, in a strict liability regime such as the one endorsed in *Mylan*, could lead to an adjustment of the amount of compensation).

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Women in IP Leadership

Celebrating achievements and continuing the empowerment of women

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We give special thanks to Clarivate for their dedication and support in continuing the empowerment of women in IP by facilitating this opportunity.

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.

This segment is sponsored by Clarivate, who, like *The Patent Lawyer*, are passionate to continue the empowerment of women. Clarivate's sponsorship enables us to remove the boundaries and offer this opportunity to all women in the sector. We give special thanks to Clarivate for supporting this project and creating the opportunity for women to share their experiences, allowing us to learn from each other, to take inspiration, and for continuing the liberation of women in IP.

"At Clarivate, we connect you to intelligence you can trust to ensure an IP-empowered tomorrow. We know that bringing people together from different cultures and backgrounds, with different life experiences and perspectives, is a key driver of innovation. This is an opportunity to celebrate all talented women around the world of IP and acknowledge their work which has changed the industry to date and look forward to what they and many more women in IP will do for tomorrow."

Gordon Samson, President, IP, Clarivate

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.

Kisha Iles: Senior Manager of IP Information Management, Johnson & Johnson

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

Kisha Iles is a Senior Manager of IP Information Management (IPIM) within the Global Legal Organization at Johnson & Johnson (J&J). She oversees the daily operations of the IPIM team and manages the company's IP systems. Kisha and her incredible team are responsible for overseeing J&J's IP estate, encompassing 100K patents and 90K trademarks, respectively.

After earning her B.A. in Political Science from Farleigh Dickinson University, Kisha earned a Paralegal Certificate and became a Certified Legal Assistant (National Association of Legal Assistants).

As a proactive and inclusive manager, Kisha has earned several leadership awards while at Johnson & Johnson.

What inspired your career?

I have always possessed an interest in the legal field. Early on in my career I held a paralegal role in a law firm assisting with contract review. I was offered the opportunity to fill in for an IP Paralegal who would be away on medical leave. Working with different brands and being immersed in the process of helping inventors and companies protect ideas and innovation fascinated me from the start. I was hooked. During this time, one of the patent attorneys offered my first training in how an IP database is structured and the importance of carefully managing its contents. This opportunity to expand my knowledge and be a part of the innovation cycle gave me the inspiration to focus my career on Intellectual Property.

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

The pathway to my role was long, with consistent themes: being proactive and anticipating the needs of the teams I work with while not being daunted by taking on more responsibility or bigger projects. Working on big projects allowed me to build and demonstrate my skills. Finding my cheerleaders, supporters and mentors was influential in my journey as well. These are the people who recognized my skills, capabilities, and general talent when I was knee-deep in projects and tasks. Additionally, seeking feedback is critical. Good feedback enhanced my performance and motivated me along the way. I feel it is also important to establish and cultivate healthy, professional relationships and rapport with colleagues.

"Seeking feedback is critical. Good feedback enhanced my performance and motivated me along the way."

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

The biggest challenge I have faced is learning how to balance my family life and career. I realized early that I needed to pursue roles and work with teams in which I could grow in my career, but also be a good mom. I struggle with finding that perfect balance all the time. I am blessed, however, to work at J&J, a company that offers flexible work policies and excellent opportunities in the health and well-being space. I recently took a three-day Energy for Performance course which, allowed me to focus on my passion and purpose here at J&J and in my family life. I left feeling reenergized, and equipped with new tools to help me achieve the balance we all strive for.

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

In 2022, I had the opportunity to play a key role in establishing the IP department of a J&J spinoff company. This was a huge project, but working with a focused and diligent team, we got the job done and celebrated our success in the end. Succeeding with a dedicated team was honestly one of my greatest achievements to date.

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

Mentoring and sharing my knowledge and experience as a manager and IP specialist is at the forefront right now. While working in this

field, I still learn new tidbits daily. On the flip side, I think I have a catalog in my brain that I need to download and share with whoever will listen! IP is a great field, and I hope to inspire others to join the fun.

I would not be where I am today without the great mentors (both women and men) I have had throughout my career. Before she retired, my previous manager taught me so much, and I reflect on her teachings every day. Not only was she my boss, but she was my advocate and an inspiration. My aspiration is to pay this forward and be that unwavering advocate and source of inspiration for others.

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

Continuing the equality and diversity work taking place in the IP space currently is crucial. It is important that young people, especially women, know that there are opportunities in IP. If you want to become a paralegal, why not specialize in patents or trademarks? If you aspire to be an engineer, why not take that a step further and become a patent attorney?

The legal organization at J&J constantly works to educate students at all levels and of all backgrounds about careers in IP. The IP team hosts student expos annually in which lawyers and paralegals discuss their career journeys. The students are hosted from communities in which J&J has a presence. This is one example of how equality and diversity in the field is encouraged. Additionally, J&J proactively seeks to work with law firms that demonstrate equality and diversity as a priority.

I view J&J as leading in advancing DEI initiatives based on the 2023 DEI Impact Review. J&J has prioritized diversity in clinical trials to promote the creation of medicines that target affected populations. My company also seeks diversity in Tier 1 suppliers with the goal of creating wealth for diverse groups. Amazing outcomes are achievable when equality and diversity are incorporated in all areas of business.

Data and technology should also be leveraged to steer the industry towards a more dynamic and inclusive future state.

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

When I began my career at J&J, many women showed me how to navigate corporate culture and shared the great resources at J&J. Those same women also supported me on a personal level, going with me to the onsite gym and providing me with a safe space to share and seek guidance. These women got me through tough days at work.

I know that women are empowered when we see other women accomplish remarkable things and be celebrated for it. Most women I know are leaders, but many may not be targeted for leadership development and opportunities. Women, like me, enjoy collaborating with others in the industry. As an industry, we should encourage more opportunities to share best practices and resources in the empowerment space.

> **“I know that women are empowered when we see other women accomplish remarkable things and be celebrated for it.”**

Xiyin Tang: Professor of Law, UCLA

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

Xiyin Tang is a Professor of Law at UCLA. Her scholarly work has been published in the Yale Law Journal, the Columbia Law Review, and the Michigan Law Review, among others. Prior to entering academia, Xiyin served as a Lead Counsel for Meta, where she was part of the team that integrated music into Meta's entire family of apps, including Instagram, Facebook, and WhatsApp. Before Meta, Xiyin was an IP associate at several large law firms, including Skadden Arps and Mayer Brown, where she represented technology companies such as Spotify in high-stakes royalty disputes. Xiyin is a graduate of Columbia University and Yale Law School, and was named to the 2017 Forbes 30 Under 30 list.

What inspired your career?

I've wanted to be an IP attorney since I was in high school. I grew up in the age of Napster, where everyone I knew was either downloading music or being sued for downloading music. I became interested in the laws that governed content creation on the Internet, and saw firsthand how those laws were coming under stress in the new digital age. I wanted to be at the forefront of that change on the ground, helping to shape the development of those laws in real-time.

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

Because the conventional wisdom in academia is that anyone with more than a few years of practice experience can't plausibly land a tenure-track position at a good law school, I wouldn't have even thought of pursuing a career in academia until an email landed in my inbox almost as if by magic, from someone on the search committee at a top 10 law school, asking if I might be interested in pursuing an academic career. This was all based on a Note I wrote in law school! And I was lucky to have a number of strong sponsors – and I call them sponsors rather than mentors because sponsors are vocal about advocating for you – from my time in law school,

who, when I called them up telling them I was thinking of pursuing a career in academia at this late juncture in my career, just asked who they can call on my behalf and what they can do to help. So, you never know, and the conventional wisdom can be wrong. Don't ever count yourself out, and there's no such thing as "too late."

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

The first few years in private practice were some of the toughest I've ever faced (and this is saying a lot, for someone who left China at the age of six with a stuffed animal and not much else). Looking back on them now, you can see that people pass down negative energy to those they believe are in inferior positions of power, creating the perfect conditions for a toxic work environment. It took a lot of years of deep introspection (and, frankly, lots of therapy a nd yoga) to overcome it, but the time you make for yourself amidst all the noise is the most important.

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

Finding time to give birth to two beautiful girls, one right before, and one shortly after, relocating from New York to Los Angeles to start my academic career.

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

Everything in this life is about giving back to the community, and I feel lucky to be in a career where I can give back in the same way that my mentors had so generously done for me. In the grand scheme of things, I haven't been teaching students for that long (I spent several years as an adjunct at Yale, and now almost five years at UCLA), but it's my hope that I can build a community of people who can help one another, who can help grow each other's careers, and who all feel like they can call upon me – and each other – in times of need. And if I can just write one article or book that helps them do that in some way, whether professionally or personally, that would make me very, very happy.

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

In recent years, more and more empirical studies have shown that the number of female and non-white inventors named on US patent applications is dismally low. I would love to see more representation in innovation, inventorship, and at the patent office, and I think calling out the problem is the first step towards greater equality in innovation.

> **I hope more parents encourage their daughters to pursue a career in STEM and get them learning about math and science from an early age.**

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

Interest and representation in the sciences start young! I hope more parents encourage their daughters to pursue a career in STEM and get them learning about math and science from an early age.

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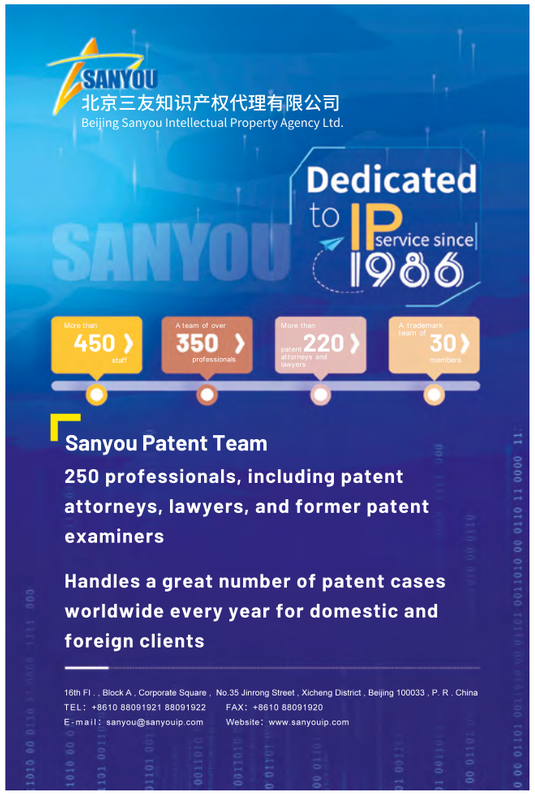
LAW FIRM RANKINGS 2024

Asia Pacific

A comprehensive list of the 10 most well-respected law firms from the Asia-Pacific region.



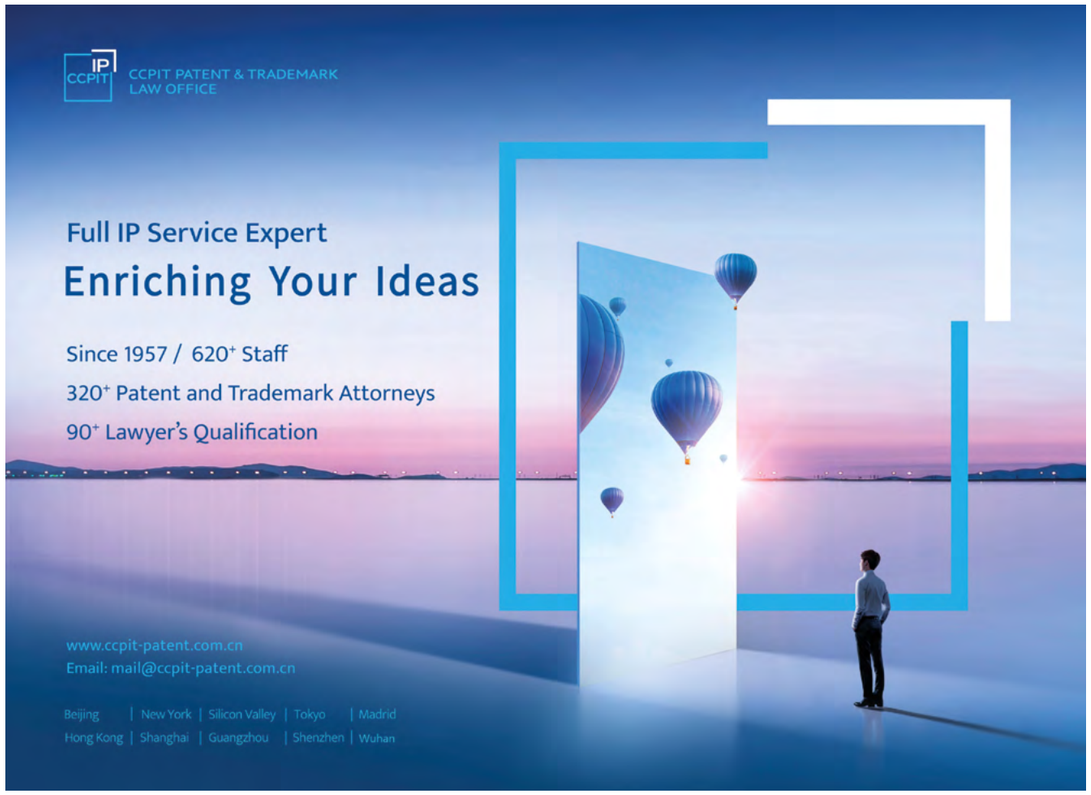
The Patent Lawyer Magazine

GLOBAL REACH, LOCAL KNOWLEDGE

Throughout the next few pages, you will view a comprehensive list of the 10 most well-respected law firms from Asia, 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.

China

Beijing Sanyou Intellectual Property Agency
CCPIT Patent & Trademark Law Office
Chang Tsi & Partners
China Patent Agent (H.K.)
East IP
Hong Fang Law
IP March
Unitalen Attorneys at Law
Wanhuida Intellectual Property
ZY Partners



Australia

Allens
Ashurst
Clayton Utz
Corrs Chambers Westgarth
Davies Collison Cave
Gilbert + Tobin
Griffith Hack
Minter Ellison
Pearce IP
Spruson & Ferguson

Hong Kong

Baker McKenzie
Bird & Bird
Deacons
Eagle IP
East IP
Hogan Lovells
Marks & Clerk
WENPING PATENT & TRADE MARK AGENT LTD.
Wilkinson & Grist
Vivien Chan & Co.

Nepal

Apex Law Chamber
Imperial Law Associates
JANAK BHANDARI & ASSOCIATES
Khurana & Khurana
Neupane Law Associates
Pioneer Law Associates
Pradhan & Associates
Prime Law Associates
Sinha Verma Law Concern
Solar Law Associates

New Zealand

AJ Park
Catalyst IP
Chapman Tripp
Dentons Kensington Swan
ET Intellectual Property
Henry Hughes IP
Hudson Gavin Martin
James & Wells
Russell McVeagh
Simpson Grierson

Indonesia

Am Badar & Am Badar
AMR Partnership
Biro Oktroi Roosseno
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Taiwan

Deep & Far Attorneys-at-Law
Formosan Brothers
Giant Group
Lee and Li Attorneys-at-Law
Li & Cai
Saint Island International Patent & Law Offices
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Top Team International Patent & Trademark Office
Tsai, Lee & Chen
Tsar & Tsai Law Firm

Thailand

- Ananda Intellectual Property
- Domnern Somgiat & Boonma
- ILCT
- LawPlus
- Rouse
- Satyapon & Partners
- SCL Nishimura & Asahi
- Tilleke & Gibbins
- TMP Intellectual Property
- ZICO IP

Vietnam

- Annam IP & Law
- Baker McKenzie
- Elite Law
- Gintasset
- INVESTIP
- Pham & Associates
- Rouse
- Tri Viet & Associates
- Vision & Associates
- WINCO

Solicitation of third-party opinions under the Japanese amicus brief system increases attention to patent practice in the medical field

Koji Sugimura and Takuya Izumi of Sugimura & Partners provide an overview of the questions solicited by third parties around the industrial applicability requirement and the historical development and current status of the patent requirement in the medical field.

The Intellectual Property High Court (IP High Court) solicited third-party opinions on a couple of patent law questions under the Japanese amicus brief system in the proceedings of Case No. 2023 (Ne) 10040 from June 24 to September 6, 2024. The questions concern the industrial applicability requirement under the main paragraph of Article 29(1) and the medicine dispensing exception under Article 69(3) of the Patent Act. These articles have been less frequently discussed in court than issues such as literal/equivalent patent infringement and inventive step. This article will summarize the Tokyo District Court (lower court) decision and the questions solicited to a third party, then provide an overview of the historical development and current status of the patent requirement regarding industrial applicability together with a couple of observations. We hope this article will help readers understand the IP High Court decision that is expected to be issued in the near future.

Tokyo District Court decision

The lower court case (No. 2022 (Wa) 5905) was brought to the Tokyo District Court by the patentee of Japanese Patent No. 5186050 titled "Composition for Promoting Increase in Subcutaneous Tissue

Koji Sugimura

Takuya Izumi

Résumés

Koji Sugimura is a Managing Partner of SUGIMURA & Partners, a full-service IP law firm that expands its legal services into adjacent areas such as personal information protection. His practice encompasses consultation to dispute resolution, in areas of IP laws and adjacent areas, including trade secrets, information technology, privacy act, and media/entertainment. He has also served as a Legislative Affairs Officer at the General Affairs Division of the Japan Patent Office, acting in a primary role in the revision of the Patent Act.

Takuya Izumi is the Director of the Global Operations Department at SUGIMURA & Partners. He brings his extensive experience as a director, patent judge, and examiner at the Japan Patent Office to his work in patent prosecution. He was the first IP attaché to the US West Coast. He also has worked on AI governance guidelines, WTO/TRIPS, etc.

and Subcutaneous Adipose Tissue" (hereinafter also referred to as "the 050 Patent"). The patentee alleged that blood-derived medication for breast augmentation manufactured by the defendant (physician) fell within the technical scope of the patented invention. The case was dismissed because the court found that the defendant's medication did not satisfy the claimed elements.

Claim 1 and claim 4 of the patent read, "a composition for promoting an increase in subcutaneous tissue, comprising (A-1) autologous plasma, (A-2) a basic fibroblast growth factor (b-FGF), and (A-3) lipid emulsion," and "a composition for breast augmentation, comprising the composition for promoting an increase in subcutaneous tissue according to any of claims 1 to 3, used for breast augmentation," respectively. (A-1), (A-2) and (A-3) are added for convenience of explanation.

The Tokyo District Court found that the defendant had administered (a-1) "cell-free plasma gel", which consists of plasma from which cellular components, including platelets, had been completely removed, (a-2) Trafermin, which contains a basic fibroblast growth factor, and (a-3) Intralipos, a type of lipid emulsion. And regarding whether Trafemin and Intralipos had been formulated before the administration of them or Trafemin and Intralipos were administered separately, the court found, based on arguments from both sides, that the plaintiff failed to show that the defendant formulated medication including both Trafemin and Intralipos together with "cell-free plasma gel" and administered the formulated medication containing the three ingredients at the same time, and thus concluded that it was not found that the defendant had manufactured the medication that satisfies the element "[a composition] comprising autologous plasma, a basic fibroblast growth factor (b-FGF) and a lipid emulsion." The plaintiff appealed to the IP High Court.

> **The first question posed to third parties was whether the patent, in this case, should be invalidated because the invention lacks industrial applicability under the main paragraph of Article 29(1) of the Patent Act.**

Questions posed to third parties

The IP High Court solicited third-party opinions on a couple of patent law questions under the Japanese amicus brief system in the proceedings of Case No. 2023 (Ne) 10040 from June 24 to September 6, 2024. The first question posed to third parties was whether the 050 Patent should be invalidated because the invention lacks industrial applicability under the main paragraph of Article 29(1) of the Patent Act. The second question was whether the invention is an invention pertaining to a medicine that is to be manufactured by two or more medicines being mixed together as stipulated under Article 69(3).

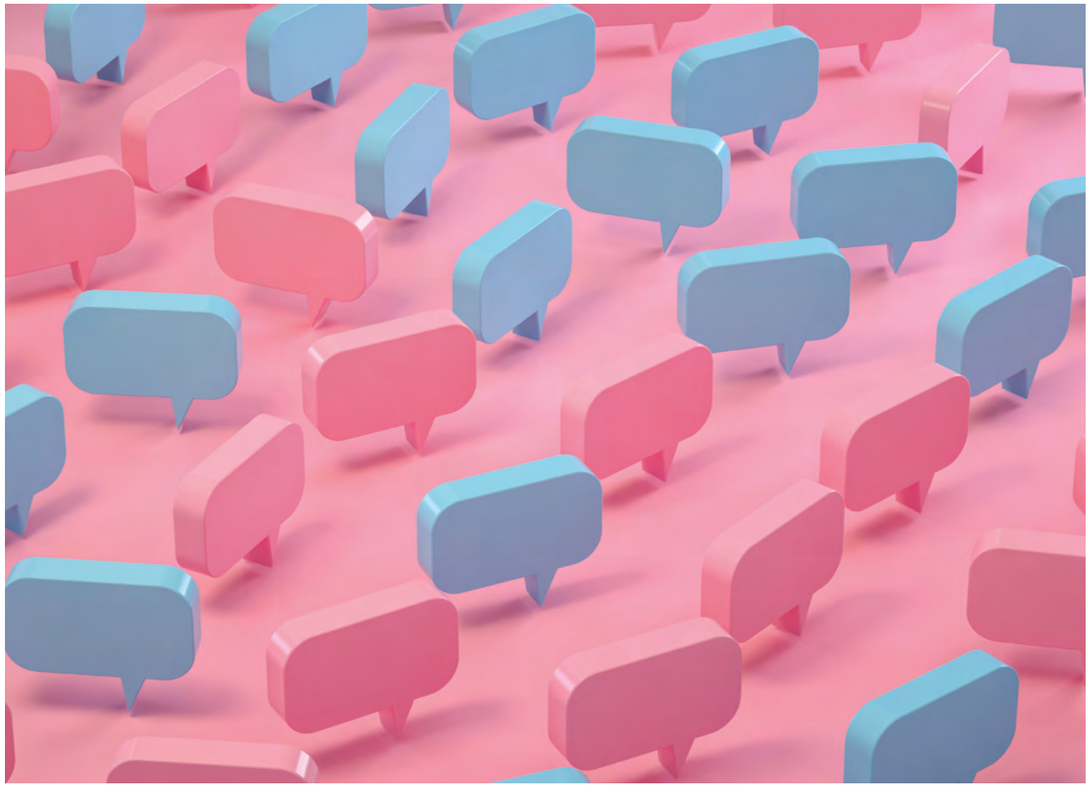
Thirdly, assuming that (a-1) "cell-free plasma gel", (a-2) Trafemin, and (a-3) Intralipos manufactured by the defendant correspond to (A-1) "autologous plasma", (A-2) "a basic fibroblast growth factor (b-FGF)", and (A-3) "a lipid emulsion", respectively, the IP High Court asked the following three sub-questions: (1) whether the act of manufacturing by instructing a nurse or an assistant nurse to prepare medication by mixing "cell-free plasma gel", Trafemin, and Intralipos (hereinafter referred to as the "Mixed Medication") for the surgery at the Appellee's hospital without issuing a prescription constitute "the act of preparation of a medicine as per a physician's or dentist's prescription" under Article 69(3) of the Patent Act; (2) whether the act of manufacturing the Mixed Medication by the Appellee, a physician, is an act against which the 050 Patent is not effective for some reason as the act is closely related to medical activity; (3) whether the surgery by the Appellee constitute "production" of the "composition" claimed in the 050 Patent when the first medication of "cell-free plasma gel" and Trafemin and the second medication of Intralipos are separately administered and the two medications are mixed in the subject's body.

All of these are intriguing issues, but we will focus on the first question. We will review the historical development and current status of the industrial applicability requirement together with some observations.

Industrial applicability requirement: history and current status

The industrial applicability requirement is set forth in Article 29(1) of the Patent Act. It stipulates that "a person that invents an invention with industrial applicability may obtain a patent for that invention" unless the invention lacks novelty and/or inventive step. The industrial applicability requirement is primarily relevant to the medical field in patent procurement practice. The history of this requirement is a series of the Examination Guidelines revisions that have care-fully carved out certain methods that do not directly affect medical practice and have put them outside the scope of the requirement. These revisions were made against the background of progress in research and development of advanced medical technologies such as regenerative medicine technology.

It seems that a 2002 Tokyo High Court ruling (Case No. 2000 (Gyo-ke) 65) sparked discussion on how the Patent Act should protect medical technologies while ensuring that patents do not interfere with medical practice. The 2002 case was an appealed case against the decision by the board of appeals of the Japan Patent Office (JPO) regarding Japanese Patent Application No. S63-504700 (national phase application of WO88/ 009151A1). The claimed invention concerned a process for superimposing position data of a



surgical instrument during surgery on an image of the surgical area captured before the surgery and displaying the superimposed image. The court held that because there is no provision that the patent right does not extend to medical practice, the main paragraph of Article 29(1) of the Patent Act should be interpreted so that patented inventions claiming medical practice are to be refused not to hinder medical practice by physicians, and thus the court affirmed the appeal board decision to refuse this application. The court seemed to reluctantly affirm the patent examination practice at the time.

After the ruling, a couple of expert committees were established in the government to discuss patent protection over medical practice, and the discussions resulted in reform proposals. The JPO addressed the proposals primarily by revising the Examination Guidelines. The 2003 revision of the Examination Guidelines appears to have focused on regenerative medicine-related technologies. The revision carved out methods for treating samples that have been extracted from the human body from "methods of surgery, therapy or diagnosis of humans", a category with no industrial applicability. An example of the carved-out methods is a method for manufacturing cultured skin sheets. However, methods for treating samples that have been extracted from a human body on the presumption that the samples are to be returned to the same body for medical treatment (e.g., a method of dialyzing blood) were not carved out.

> **The 2009 revision carved out, for example, methods of extracting samples and data from the human body, and methods of analyzing.**

In the first few meetings of the expert committee charged with following up on the above discussion for the 2003 revision, whether to abolish the industrial applicability requirement concerning "methods of surgery, therapy or diagnosis of humans" and establish immunity for physicians appears to have been discussed seriously. However, the discussion did not reach a conclusion and resulted in the 2005 revision of the guidelines. For example, the 2005 revision carved out methods for controlling the operation of a medical device from "methods of surgery, therapy or diagnosis of humans." The revision came with a caveat that methods including a step conducted by a physician (e.g., a step where a physician operates a device in order to provide medical treatment in accordance with a symptom) or including a step with an influence on the human body by a device (e.g., incision or excision of a specific site of patient's body by a device) were still considered to be "methods of surgery, therapy or diagnosis of humans."

The 2009 revision carved out, for example, methods of extracting samples and data from the human body, and methods of analyzing,

e.g., comparing such samples and data with standards, by utilizing samples and data extracted from the human body. The 2009 revision also came with a caveat that methods including diagnosis of physical condition of a human body, such as conditions of diseases and physical health or the mental condition of a human body, were still considered to be "methods of surgery, therapy or diagnosis of humans."

Along with the above revisions of the Examination Guidelines, the Examination Handbook, a supplement to the Examination Guidelines, has been revised and additional case examples have been added. In patent prosecution practice, patent attorneys sometimes receive office actions, where JPO examiners suggest referring to certain case examples concerning the industrial applicability requirement instead of providing detailed reasoning.

> **A long-established dichotomy between "product" and "process" might change.**

Practical implications: three perspectives

The IP High Court ruling (Case No. 2023 (Ne) 10040), which is to be issued in the near future, will likely spark the discussion on the industrial applicability requirement under the main paragraph of Article 29(1) and medicine dispensing exception under Article 69(3) of the Patent Act.

Regarding the industrial applicability requirement, the following three perspectives may be useful:

First, a long-established dichotomy between "product" and "process" might change. The JPO Examination Guidelines state that inventions of "methods of surgery, therapy or diagnosis of humans" do not meet the industrial applicability requirement, whereas medical devices or medicines are products and are not considered to be a "method of surgery, therapy or diagnosis of humans." In fact, lack of industrial applicability has not been raised to the composition claims in the patent examination and appeal proceedings concerning the the 505 Patent. A previously well-referenced book for patent practitioners explains that, in the case of an invention of a product, even if the product is used in the medical industry, the production itself is performed in other industries (e.g., machine industry, pharmaceutical industry, etc.), and therefore, the product can be patentable. How should we treat cases of physicians producing a product like this case?

Second, the ruling might lead to a change in the Examination Guidelines, resulting in making examiners' reasoning concerning lack of industrial applicability more understandable. Current examination practice has been criticized in that examiners only discuss whether claims match examples in the Examination Guidelines and case examples in the Examination Handbook, and they do not make a substantive determination as to whether or not claimed inventions constitute medical practice. For example, even if the medical treatment itself is not claimed, if it is found from the specification that the medical treatment is incidental to the working of the claimed method, the JPO examiner will likely refer to some relevant case examples and conclude without detailed reasoning that the application lacks industrial applicability. And then examiners often suggest amending claims to methods for controlling the operation of a medical device. Since the criteria of industrial applicability are unclear in the Examination Guidelines, patent attorneys cannot do anything but follow the examiners' suggestions. The ruling might change such examination practice.

Finally, the ruling might encourage discussion about amending the Patent Act to allow patents for medical practices (i.e., abolishing so-called "upstream regulation"), but to add a new exception to working of patents by physicians (so-called "downstream regulation"). This issue was discussed in the expert committees after the 2002 Tokyo High Court ruling. Some experts appreciated the advantages of the downstream regulation, but no consensus was reached. The IP High Court ruling might give another impetus to the discussion.

This IP High Court case with amicus brief solicited will no doubt revitalize the discussion of medical patent protection. More and more innovations have been occurring in the healthcare industry. It may be high time to revisit the issues concerning the industrial applicability requirement. We strongly encourage readers to keep an eye on the ruling and discussions after it.

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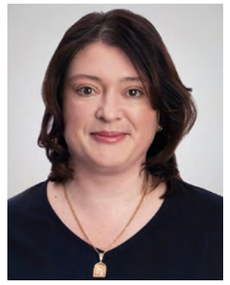
What you need to know about transferring patent ownership in Russia

Olga Dolgikh, Patent Advisor to the Managing Partner at Zuykov and partners, details the procedure for ownership transfer in line with relevant legislation in her jurisdiction.

Patent holders often find themselves in situations where, due to unforeseen circumstances, it becomes necessary to change the name associated with the patent.

First, according to paragraph 1 of Article 1232 of the Civil Code, the patent holder must notify the relevant *federal executive authority for intellectual property* and the *federal executive authority for selection achievements* (Article 1246) about any changes in the information regarding the state registration of the result of intellectual activity: the name or title, location or residence, and address for correspondence. The risk of adverse consequences if such notification is not made or if false information is provided lies with the patent holder. This means that if the name or title of the patent holder has changed, you are legally required to make the corresponding change in the patent and the state register of inventions or utility models.

It should be noted that under the law, the patent holder can be an individual, a legal entity (LE), a group of individuals, a group of legal entities, or jointly, an individual and a legal entity.



Olga Dolgikh

Depending on the composition of rights holders, various changes may be required, for example:

1. One individual must be replaced by another individual;
2. One or more individuals must be excluded from the group of individuals;
3. A new individual must be added to the existing group of individual rights holders;
4. One LE must be replaced by another LE;
5. One or more LEs must be excluded from the group of LEs;
6. A new LE must be added to the existing group of LE rights holders.

When the exclusive right to a result of intellectual activity belongs to several persons jointly, each of the rights holders can use such a result at their own discretion, unless otherwise provided by the Civil Code or an agreement between the rights holders. An agreement between them determines the relationship of persons to whom the exclusive right belongs jointly. The disposal of the exclusive right to the result of intellectual activity is carried out by the rights holders jointly, unless otherwise provided by the Civil Code or an agreement between the rights holders. Income from the joint use of the result of intellectual activity or from the joint disposal of the exclusive right to such a result is distributed among all rights holders in equal shares, unless otherwise provided by agreement between them.

> **It should be noted that a fee is paid for changes to the register and to the patent for each patent.**

Résumé

Olga Dolgikh is a Patent Attorney and Patent Advisor to the Managing Partner at Zuykov and partners. Having a qualification of a mechanics engineer, Olga specializes in conducting patent searches for inventions and utility models, registration, preparation, and filing of applications for inventions, utility models, software, and databases to the Rospatent and the EAPO.

Additionally, if changes are planned to be made to a group of rights holders, this can only be done with the consent of all members of the group. If there is no agreement between all rights holders, then changes in the composition of rights holders are possible only by a court decision.

Let's consider situations where there is fundamental consent from all rights holders specified in paragraphs 1 – 6; and this article does not apply to changes in the name of the rights holder associated with the correction of obvious technical errors and typos, as well as, for example, with a change in the surname of the rights holder. The emphasis in the article is on cases when it is necessary to replace, exclude, or add a new rights holder.

So, in order to make changes to the composition of rights holders, it is necessary to:

1. Submit an application of the established form (approved by order of the Ministry of Economic Development of Russia dated October 7, 2022 N 552 (On approval of application forms necessary for carrying out legally significant actions to amend the State register of inventions of the Russian Federation, the State Register of utility models of the Russian Federation, the State Register of the industrial designs of the Russian Federation), as well as patents for inventions, utility models, and industrial designs).

2. Pay two fees: for consideration of the rights holder's application to make changes to the State Register of Inventions of the Russian Federation (2000 rubles), and for consideration of the rights holder's application to amend the patent for an invention (also 2000 rubles).

It should be noted that a fee is paid for changes to the register and to the patent for each patent.

> **In addition to the application, it is necessary to attach a power of attorney, if the application is submitted through a representative who is not a patent attorney.**

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If several patents need to be amended, the fee must be multiplied by the number of patents.

The application is submitted for one patent and signed by the applicant(s) or representatives; on behalf of a legal entity, the application is signed by the head of the organization or another person authorized to do so in accordance with the legislation of the Russian Federation or the constituent documents of the legal entity. If there are several rights holders, then the application must be signed by all rights holders or their representatives.

If the application indicates the need to make changes to the relevant state register and patent regarding the composition of rights holders and if one or more legal entities or individuals were not previously indicated as such, in the absence of a dispute between all specified persons, the application must be signed by both persons included in the composition of the rights holders and persons excluded from the composition of the rights holders.

If there is a dispute regarding the identification of the rights holder and a change in the composition of rights holders and its resolution in court, a court decision on the identification of rights holders that has entered into legal force is attached to the application regarding the change in the composition of rights holders.

In addition to the application, it is necessary to attach a power of attorney, if the application is submitted through a representative who is not a patent attorney. The power of attorney is presented in accordance with Article 185.1 of the Civil Code of the Russian Federation.

Thus, it would not be difficult to make changes to the list of rights holders for a patent if there was no dispute between all the rights holders. All the "old" and "new" rights holders would need to agree to be included or excluded from the list and confirm their consent with a suitable statement.

The rise of patents in Indian IP law: a year of transformative developments

Pravin Anand, Vaishali Mittal, and Siddhant Chamola of Anand and Anand dive into the significant developments in Indian patent law over the past year, exploring major case outcomes, evolving legal principles, and new legislative changes that have shaped the patent landscape in the region.

In the past year, patents have become the focal point of Indian intellectual property (IP) law, as reflected in both legislative changes and significant judicial decisions. This period has marked a notable surge in patent activity, with the Indian government prioritizing patents at the national level. Between March 2023 and March 2024, India witnessed a record-breaking grant of over 100,000 patents, averaging around 250 patents per working day. This article delves into the key developments in Indian patent law over the past 12 months, examining major case outcomes, evolving legal principles, and new legislative changes that have reshaped the patent landscape in India.

Major judicial outcomes

***Ericsson v. Lava:* a landmark decision on SEPs**

The case of *Ericsson v. Lava* is a landmark decision concerning Standard Essential Patents (SEPs) in India. This case represents India's second final judgment on SEPs and involves a dispute between Ericsson, a global telecommunications giant, and Lava, an Indian mobile phone manufacturer. The legal saga began in 2016 when Ericsson sued Lava for infringing eight SEPs related to 2G and 3G technologies. Lava's refusal to sign a licensing agreement despite prolonged negotiations led Ericsson to seek judicial intervention.

> **The Court determined that FRAND royalties should be calculated based on the end device rather than the smallest saleable patent-practicing unit.**

In March 2024, the Delhi High Court issued a comprehensive judgment that addressed several critical aspects:

- **Validity and infringement:** the Court upheld the validity of seven out of eight SEPs and confirmed that these patents were infringed by Lava. The decision involved a detailed analysis of patent validity and infringement, incorporating the Court's new 'Seven Stambhas' or 'Seven Pillars' approach to assess the novelty of an invention. This method includes understanding claims, identifying and analyzing prior art, and documenting the analysis.

- **FRAND rate assessment:** the Court determined that FRAND (Fair, Reasonable, and Non-Discriminatory) royalties should be calculated based on the end device rather than the smallest saleable patent-practicing unit. This aligns with international practices and ensures that licensing rates reflect the value of the entire device. The Court also established that damages should be based on the full portfolio rather than just the number of infringed patents.

- **Patent exhaustion and hold-out:** The Court clarified that patent exhaustion at the chipset level does not apply if the patent claims the entire handset. For an exhaustion defense to be valid, there must be indemnity from the chipset manufacturer and due diligence by the implementer. Additionally, the Court found that Lava's refusal to negotiate and its insistence on accessing Ericsson's third-party licensing agreements constituted bad faith hold-out.

- **Damages:** The Court set the royalty rate at 1.05% of the selling price of Lava's phones and awarded damages of approximately USD 29 million. It determined that damages could be calculated from the pre-grant publication date of the patent, diverging from the usual three-year limitation period under Indian law. The damages were calculated based on the number of devices sold by Lava.

***InterDigital v. Oppo:* the issue of pre-trial discovery**

The global FRAND dispute between InterDigital and Oppo featured a significant Indian segment where both parties sought disclosure of each other's patent license agreements. Oppo sought access to InterDigital's agreement with Qualcomm to support its defense on patent exhaustion, while InterDigital sought Oppo's agreements with Qualcomm, Ericsson, and Orange SA for FRAND royalty assessments and to counter Oppo's exhaustion defense.

The Court's decisions included:

- **FRAND determination:** the Court ruled that FRAND terms should be based on comparable agreements for InterDigital's portfolio rather than other licensors. This aligns with the approach taken in previous cases, such as *Ericsson v. Lava.*

- **Disclosure orders:** Oppo was ordered to produce its agreement with Qualcomm to clarify the scope of licensed technology and potential indemnity. Similarly, InterDigital was required to disclose its agreement with Qualcomm to address arguments related to patent exhaustion and the applicability of the SEP.

> **The Court found that the invention, which focused on converting raw sensor data into lightweight messages, was not obvious and thus met the inventive step requirement.**

***Vifor v. MSN (and Others):* product-by-process claims**

The *Vifor v. MSN* case involved a dispute over a product-by-process claim for Ferric Carboxy-maltose (FCM), an iron deficiency treatment. Vifor's patent was challenged by several defendants manufacturing and selling FCM. The initial court decision denied Vifor's request for an interim injunction, ruling that a product-by-process claim only covered products made using the specific process described in the patent.

On appeal, the Division Bench, reversed this decision, establishing several key principles:

- **Scope of protection:** the Court ruled that product-by-process claims protect the product itself, regardless of the manufacturing process used. This aligns India with global standards in jurisdictions like the UK, EU, and Japan.

- **Examination of claims:** the Court emphasized that product-by-process claims should be examined based on the novelty of the product, not just the process. Patentees can use such claims when a product's characteristics are best described through the process used to create it.

- **Difference in product claims:** the Court clarified the distinction between products 'obtained by' and 'obtainable by' a process. 'Obtained by' means the product is only achievable through the described process, while 'obtainable by' implies that the process is illustrative, and protection extends to the product regardless of the method used.

The FWR test and claim construction

1. ***SNPC Machines Private Limited v. Mr Vishal Choudhary:* the FWR test**

In *SNPC Machines Private Limited v. Mr Vishal Choudhary,* the Court introduced the function-way-result (FWR) test for determining the doctrine of equivalence. This test assesses whether a product performs substantially the same function, in substantially the same way, to achieve a similar result as the patented invention.

- **Application of the FWR test:** The Court applied this test while granting an interim injunction, finding that minor differences between the parties' machines

did not preclude a finding of equivalence. This test emphasizes functional similarity and is useful in determining infringement despite differences in products.

2. *ITW GSE v. Dabico Airport Solutions & Ors:* claim construction

In *ITW GSE v. Dabico, t*he Court addressed the issue of claim construction, holding that claims should be interpreted based on their plain and ordinary meaning rather than being restricted by specific embodiments described in the patent specification. Key aspects included:

- **Interpretation of claims:** claims must be read in light of the specification, but limitations cannot be imported from the specification unless explicitly stated. The Court rejected arguments that claims should be limited to modular configurations described in the specification, finding that the claims covered non-modular systems as well.

Evolving jurisprudence on nuanced patent issues

1. New outlook on divisional patents

The *Syngenta v. Controller of Patents* case provided clarity on divisional applications and the concept of plurality of inventions. The Court held that the concept of plurality of inventions can be assessed based on the entire patent specification, not just the claims. This overturns previous decisions and allows divisional applications to be filed either *suo motu* by the patentee or upon the Patent Office's recommendation.

2. Assessment of damages on the lost-profits principle

In *Communication Components v. Mobi*, the Delhi High Court awarded substantial damages based on the lost profits principle. The plaintiff demonstrated that the defendant's infringing products led to lost sales, and damages were calculated based on the difference between the sale price and manufacturing cost. The Court's willingness to award significant damages reflects a growing trend in India towards substantial financial compensation in patent disputes.

3. Call for code of conduct for patent and trademark agents

In *Saurav Chaudhary v. Union of India*, the Court highlighted the need for a code of conduct for patent and trademark agents. The case involved an abandoned patent application due to inadequate communication from the patent agent. The Court directed the Controller of Patents, Designs, and Trademarks to establish a code of conduct by December 2024, aiming to improve accountability and professionalism among patent agents.

4. Test for determining obviousness

The High Court of Madras in *Microsoft Technology Licensing v. Assistant Controller of Patents* cited the Windsufer-Pozolli test for determining obviousness. The test involves assessing the Person Skilled in the Art (PSITA), the inventive concept, differences with prior art, and whether these differences would be obvious to PSITA without knowledge of the invention. The Court found that the invention, which focused on converting raw sensor data into lightweight messages, was not obvious and thus met the inventive step requirement.

5. Technical contribution trumps Section 3(k) for software patents

In the case C.A.(COMM.IPD-PAT) 318/2022, *Blackberry Limited v. Controller of Patents* and Designs, the High Court of Delhi reviewed a patent application by Blackberry. The patent, filed on April 6, 2009, concerns a method for auto-selecting media files based on user preferences. The Controller of Patents initially refused the application under Section 3(k) of the Patents Act, 1970, which excludes algorithms and computer programs from patentability. Blackberry argued that the invention offered a technical solution to managing media content and had been granted patents in other countries, asserting that it provided a technical effect beyond a mere algorithm. They contested the Indian Patent Office's reliance on the European Patent Office's rejection. The Controller of Patents maintained that the invention was essentially a computer program and did not address a technical problem but rather automated user preferences. The Court analyzed the invention, noting that it involved technical features like cache management, metadata management, and synchronization of media content, which offered a substantial technical effect and improved device functionality. The Court concluded that the invention was not just an algorithm but had a significant technical impact. As a result, the Court directed the Controller to allow the patent application, provided that claims be amended to focus on "automatic selection" and "cache management." The judgment emphasizes recognizing technical contributions despite initial objections under Section 3(k) of the Patents Act.

6. Legislative changes

The 2024 amendments to the Patents Rules, effective from March 15, 2024, introduced several key changes to streamline patent prosecution:

- **Reduced examination timeline:** requests for examination can now be filed within 31 months, down from the previous 48-month period, accelerating the examination process.
- **Simplified submission process:** Foreign patent submissions now need to be filed within three months of receiving the first statement of objections, with late submissions allowed if condoned by the Controller.
- **Relaxed filing norms:** Statements of working under Form 27 need to be filed only once every three financial years, simplifying compliance for patent applicants. Further on August 26, 2024, the Indian Patent Office clarified the rules for filing the statement of commercial working of patents the key points are:
- **First statement:** must be filed according to specific due dates;
- **Subsequent statements:** required every three financial years. For instance, if filed in 2024, the next is due by September 30, 2027;
- **Last statement:** should cover the entire 20-year patent term or until the patent expires. The final statement period may be shorter, depending on the remaining term.
- **Extensions:** the filing deadline of September 30 can be extended up to three months with a fee of INR 10,000 (approx. USD 125) per month. A further extension of up to six months can be requested with a fee of INR 50,000 (approx. USD 600) per month.

Conclusion

The past year has been pivotal for Indian patent law, showcasing a period of significant transformation and refinement.

These changes aim to align Indian practices with international standards and reflect India's growing focus on strengthening its patent system and addressing intricate legal issues. As India continues to evolve its IP landscape, the impact of these changes will likely foster a more dynamic and globally competitive patent environment.

Résumés

Pravin Anand is the Managing Partner at Anand and Anand. In a career spanning over four decades, Pravin has emerged as an IP trailblazer with an experience of appearing in over 2500 cases.

He has strengthened India's IP jurisprudence with a practice encompassing all areas of IP litigation including patents, copyright, design, trademarks, enforcement, and dispute resolution.

Pravin joined Anand and Anand in 1979 as an extension of the law firm established by his grandfather in 1923.

From a one-room office in Old Delhi, he took the firm to new heights with offices in four major cities and a diverse gene pool of 400 professionals.

His approach in and out of court has broken new grounds in Intellectual Property Rights and today, from Christian Louboutin to Cartier, from pharma to tech majors to policymakers and from art to entertainment, Pravin represents most famous brand owners, leading industries and eminent personalities who rely on his matchless experience for protection of their Intellectual Property.

Vaishali R Mittal is a litigation partner and strategist at Anand and Anand. Vaishali has been engaged as a lead in many firsts and also some of the most ground-breaking IP matters including case protecting personality rights of Bollywood actor Anil Kapoor against any misuse including by use of generative AI and dark patterns *(Anil Kapoor v. Simply Life);* India's first judgement on product-by-process patent *(Vifor International v. MSN Labs & Ors)*; India's first protem security order *(Nokia v. Oppo)*; Aaradhya Bachchan fake news matter; India's first anti-anti suit injunction, India's first final judgment on Standard Essential Patents; order directing an implementer to deposit pro tem security in favor of an owner of Standard Essential Patent(s), before determination of infringement, validity etc. *(InterDigital v. Oppo* (2022-24); *Nokia v. Oppo* (2022)); landmark judgement on trans-border reputation, landmark judgment on aggravated damages being the highest ever quantum in a copyright, trademark, and design infringement case, besides earning well-known status for many marks.

Vaishali has been consistently recognized as a leader in intellectual property by some of the most prestigious bench-marking tables.

Siddhant Chamola is an Associate Partner at Anand and Anand. Over the years, his focus and expertise has grown in more niche and grey areas of the law, such as emerging issues in patent law (life sciences, SEPs and FRAND in the Indian context), intermediary liability, and new complications brought about by the almost daily changes in technology.

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> **These changes aim to align Indian practices with international standards.**

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Unfair competition liability for patent infringement: implications, sanctions, and case law analysis

Anton Melnikov, Senior Lawyer at Gorodissky & Partners, delves into the legal and financial consequences of exploiting patents without the owner's consent and examines the application of competition protection law in such cases.

Exploiting a patent without the owner's consent amounts to patent infringement as well as an administrative offense. Moreover, this action may also constitute a crime.

Unconsented use of others' patents in business can also amount to a violation of competition protection law and result in significant negative consequences for the infringer. The sanctions provided by the competition protection law are the subject of this paper.

Art. 14.5 of the Competition Protection Law prohibits unfair competition through the unlawful use of others' patent rights. This provision entitles any interested company to file an unfair competition complaint with the Russian Federal Antitrust Agency (hereinafter – the Agency) or its regional departments against any company unlawfully using others' patents.

The antitrust legislation establishes two sanctions for a violation of the Competition Protection Law:

1. Income-based fine by which the defendant should transfer all income received from unfair competition to the federal budget (Art. 51 of the Competition Protection Law);

2. Revenue-based fine by which the defendant should pay 0.01–0.15% of the revenue received from selling the product or rendering service on the market where the violation of the Competition Protection Law was committed (Art. 14.33 of the Russian Code of Administrative Offenses).

Anton Melnikov

The mentioned fines are also applied for unconsented use of trademarks and copyrights. Therefore, the case law adopted by the court in unfair competition cases related to the illegal use of trademarks and copyrights is also applicable to unfair competition cases associated with the unlawful use of patents and vice versa.

The Russian case law clarifies when and under which circumstances the said sanctions can be imposed.

Competition

In comparison with a patent infringement lawsuit, a petitioner in an unfair competition case needs to prove one extra fact: that the parties to the case are competitors. It is worth noting that the recent case law provides a more flexible approach to examining the issue of whether the parties are competitors.

In the FERRERO case (A38-4009/2019), the court had to answer the question of whether relations between affiliated companies should be taken into account when deciding whether the petitioner and defendant were competitors. In that case, the defendant claimed that there was no competition because the claimant was a manufacturer and the defendant was an importer, which meant that they could not compete in the same market because they ran businesses in different areas.

However, the court did not agree with the defendant's arguments and noted that each party to the case related to the groups of companies that were competing on the market. According to the court, it was permissible to consider one group of companies as one business entity when examining the issue of competition.

Therefore, it is possible to refer to a group of companies when deciding whether the parties to the case are competitors. The adopted approach allows broadening the application of the Competition Protection Law to unlawful exploitation of patents on the market by taking into account not only the parties to the case but also their groups of companies.

The mentioned interpretation was sustained by the Supreme Court and included in its Resolution of the Plenum #2, dated March 3, 2021.

What fine should be imposed?

As was mentioned, the applicable law provides two sanctions for unlawful use of a patent in competition. At the same time, the law provides that only one fine can be imposed on the defendant. In the event that the income-based fine is imposed, the revenue-based fine shall not be applied (Art. 51 of the Competition Protection Law).

Moreover, according to the Anti-trust Agency practice, if it is possible to calculate the defendant's revenue from unfair competition, the revenue-based fine should be imposed rather than the income-based fine (the letter of the Agency N ИА/46433/16) of July 8, 2016). Therefore, the income-based fine can be applied only when it is not possible to calculate the defendant's revenue related to unfair completion.

How should the revenue be determined?

When calculating the amount of revenue, the Agency should take into consideration only revenue that the defendant has received from selling the infringing product, i.e., the product in which the patent was used without the patent owner's consent (the Resolution of the Supreme Commercial Court №11 of 17.02.2011 N 11). Therefore, the Agency should not take into account the revenue for selling all goods of a particular kind (for instance, all medicine of any kind put on the market by the defendant), irrespective of exploiting the patent in question.

In the Drastop case, the Agency calculated the revenue received from selling the infringing medicine in the amount of RUR 488,399,426.00 (about USD 5,600,000.00); the revenue-based fine was imposed in the amount of RUR 23,851,950.00 (about USD 270,000.00).

The defendant appealed the decision of the Agency to the Moscow Commercial Court (case №A40-127716/2021), acting as the trial court for reviewing decisions delivered by the Agency. The court noted that the medicine in question was manufactured in two versions; it was established that the patent was used only in the first version, while the second version of the medicine does not violate the patent rights.

However, the Agency took into account both versions of the medicine when calculating the revenue. In this case, the court concluded that the Agency incorrectly calculated the revenue as well as the fine amount.

> **"According to the court, it was permissible to consider one group of companies as one business entity when examining the issue of competition."**

Résumé

Anton Melnikov is a Senior Lawyer at Gorodissky & Partners. He has more than 18 years of experience in patent disputes, protection of trademark rights, including domain disputes, the fight against counterfeit goods and parallel imports, cases on early termination of legal protection of trademarks due to non-use, copyright defense, and handling cases related to unfair competition.

He is intensively involved in trademark cancellation cases for non-use, domain disputes, disputes over the protection of the exclusive rights to inventions, and cases against parallel importers.

The Intellectual Property Court, which reviewed the case as the court of cassations, upheld the reasoning of the trial court.

The same approach was confirmed by the court in the Artogistan case (№A56-41146/2021), where the Agency calculated the revenue based on the value of all medicine put on the market, irrespective of whether the patent was used in all medicine or not. The court repeated once again in its decision that when calculating the turnover, the Agency should find out what product the patent was used for, as only this product can be taken into account to calculate the revenue and fine for unfair competition.

Who is liable for unfair competition?

The revenue-based fine can be imposed only on the company that first puts the infringing product on the market. Therefore, this sanction is not applicable to companies that will further resell the infringing product. This interpretation is provided in p. 17 of the Resolution of the Supreme Commercial Court №11 of 17.02.2011 N 11.

Unfair competition complaint and patent infringement lawsuit

Initiating an unfair competition investigation does not prevent the patent owner from filing a patent infringement lawsuit before, simultaneously, or after the investigation is completed.

However, it is necessary to take into account the statute of limitations established for an unfair competition investigation. According to art.41.1. of the Competition Protection Law, an unfair competition case cannot be initiated after three years since the act of unfair competition.

Moreover, the ongoing investigation should be terminated after the three-year term expires. It means that the Agency needs to complete its investigation and issue the decision within the three-year term. In case of continuing unfair competition (for instance, ongoing selling of the infringing medicine), the three-year term starts from the date when unfair competition is over or was revealed by the Agency.

In the Nilotinib case, the income-based file was imposed on the defendant in the amount of RUR 19,116,994.00. The decision of the Agency was sustained by the court. It is worth noting that the unfair competition case was initiated by a distributor of the patented medicine after the patent owner (Navartis A.G.) had won the patent infringement lawsuit (case №A41-85807/16). As was mentioned, the Competition Protection Law entitles any company suffering from unfair competition to bring an unfair competition complaint against a bad-faith competitor unlawfully exploiting others' patents in competition.

> **The Agency should find out what product the patent was used for, as only this product can be taken into account to calculate the revenue and fine for unfair competition.**

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Why is it reasonable to file an unfair competition complaint?

The following advantages can be mentioned:

1. When filing a patent infringement lawsuit, which is adjudicated according to civil procedural rules, the plaintiff should collect and secure evidence confirming the scope of the patent infringement, which is the value and number of the infringing goods put on the market.

   The Russian procedural rules do not require the defendant to discover all documents and information related to the alleged patent infringement. Although the court is authorized to request upon the plaintiff's motion that the defendant submit related documents, the court is reluctant to do so because it may affect the adversarial principle and the principle of equality of parties in civil procedure, according to the court's reasoning. Therefore, it may be difficult to collect evidence confirming the scope of the infringement, as most of the evidence is at the disposal of the defendant.

   On the other hand, an unfair competition case is investigated by the Agency or its regional department, which is vested with broad powers regarding collecting evidence from companies and government bodies.

   The patent owner who initiated the unfair competition case can use the said evidence in a patent infringement lawsuit, which can help to prove the scope of the patent infringement and calculate the compensation or damages.

2. All fines imposed in an unfair competition case should be transferred to the federal budget. Therefore, the remedies provided by the Competition Protection Law were not designed to compensate a patent owner for damages caused by unfair competition.

   However, negative consequences suffered by a defendant can deter them or other potential infringers from using others' intellectual property.

Therefore, patent owners can invoke sanctions provided by the Competition Protection Law as a supplementary option for enforcing their IP rights and fighting infringers unlawfully exploiting others' intellectual property in their business.

Navigating sufficiency and credibility requirements in Mexican Patent Law

Esau Andrade, Patent Practitioner at Dumont, discusses the recent interpretation and practice of the MPO regarding sufficiency and credibility requirements, exploring how the practice aligns with concepts from the USPTO and the EPO.

Sufficiency of disclosure is a vast and interesting topic to delve into that relates to other requisites such as novelty, inventive step, industrial applicability, and, in some jurisdictions, it closely relates to the concepts of plausibility and undue burden. This text discusses a relatively recent interpretation and practice that the Mexican Patent Office (MPO) is increasingly performing on the sufficiency of disclosure requirement from the point of view of technical disclosure, specifically, experimental evidence necessary to validate an alleged technical effect over the full scope of the claims.

Esau Andrade

This practice attempts to align itself with the concepts of USPTO's undue burden and, to a greater extent, plausibility as applied by the EPO. However, it seems to be creating a unique credibility requirement that is neither regulated nor the same as the previously mentioned concepts, while also lacking the legal guidance that case law provides in the previously mentioned jurisdictions. Consequently, it introduces significant uncertainty for users and practitioners.

Résumé

Esau Andrade is a Patent Practitioner at the Mexican IP firm Dumont. He holds a B.Sc. in chemistry, a M.Sc. in biochemistry, and a B.A. in Law. He has 17 years of experience including private and public sectors. He was Head of the Chemical Department at the Patent Examination Division of the Mexican Patent Office for 10 years. Esau's experience includes handling administrative and technical aspects of patents, industrial designs, and utility models. He participated in the committee for the review of the Industrial Property Law and has been invited to internship programs and training programs in international events both as a participant and as a speaker.

Sufficiency of disclosure

In principle, the requisite of sufficiency of disclosure is similar to that of other jurisdictions: patent applicants must disclose their inventions to foster innovation and technological development. While not explicitly stated in this way in Mexican law, the requirement arises from the principle that exclusive rights are granted in exchange for the disclosure of the invention, that is the *quid pro quo* of the patent system.

As to the legal grounds, the Mexican legislation contemplates an obligation for a description of the invention to be sufficiently clear and complete in a manner that it guides or allows its fulfillment by a person skilled in the art and indicates the best method known by the applicant to carry out the invention, along with the information relative to the industrial application of the invention. This indication should be performed through practical examples, when suitable.

As to the scope of claims, Mexican Law states that claims should have support in the specification and not surpass or exceed its contents.

Although the Law does not specifically set a standard in the nature and exhaustivity of examples or the minimum amount of technical evidence, it is understood and accepted that the specification should include information that allows the skilled person to understand and reproduce anything that falls within the scope of the claim which is soundly illustrated by working examples. This is especially true for inventions where an effect is claimed (i.e., use claims, purpose-limited product claims, and product claims that include functional features).

It is under these circumstances and practices that the MPO usually assesses this requirement. Significant contradictions in the specification, missing information or figures, and sometimes lack of working examples have been usually objected to with little chance of being overcome since the Law also bans the introduction of additional subject matter, increasing the scope of the invention.

MPO's credibility-related practice

As mentioned, in addition to the standard assessment, the MPO practice has recently seen a significant expansion of the sufficiency of disclosure requirement into a practice that aims, without much success, to resemble the EPO concept of "plausibility", under which, depending on the case and circumstances thereof the application must include information, particularly experimental evidence and examples rendering the invention and the associated technical effect plausible (i.e., seeming reasonable, probable, or likely to be true) thereby justifying the scope of the claims.

"This practice attempts to align itself with the concepts of USPTO's undue burden and, to a greater extent, plausibility as applied by the EPO."

The MPO interprets the MX sufficiency of disclosure statutes as grounds for raising objections on applications on the premise that the full breadth of the claims should be backed by experimental evidence. When this is not the case, as often happens, applicants are required to narrow down the scope of the claims to match the matter illustrated in the examples.

Thus, the MPO practice ends up distancing itself from the plausibility requirement of major Examining Offices and, under the umbrella of the sufficiency of disclosure and a stated – but not technically assessed – non-credibility objection, the applicant is simply required to limit the scope of the claims rather than explaining how the information and examples in the specification would render the alleged or claimed effect plausible from a technical standpoint.

Even when the possibility of submitting post-filing evidence is open, there is no guidance about the necessary amount thereof to satisfy the requirements since there are no technical grounds for it in the first place. Further, experience

shows that sometimes post-filing evidence is accepted or rejected under unclear circumstances and criteria.

As can be noted, this "credibility" practice is not a mere new criterion or addendum to the sufficiency of disclosure practice of the MPO but, in practice, constitutes a new administration that introduces a significant amount of uncertainty. It does not find adequate legal grounds in Mexican Law, seems to contravene at least one administrative law principle, and it is not technically motivated in relation to the state of the art, the inventive step, or the industrial applicability of the invention but rather relies on a seemingly subjective approach from the examiner.

Based on the legal grounds, it seems that the MPO is only entitled to require an application to offer complete information and instruction that allows a skilled individual to understand and carry out the invention while giving no clue concerning its efficacy or technical effectiveness.

This leads us to the question of whether it is possible for an application to be sufficiently disclosed and, at the same time, lack technical evidence that renders the full scope of claims plausible. Assuming that cases should be analyzed individually, it is understood that once the requirement of sufficient description is met, a person skilled in the art would have the necessary information to carry out the invention, achieve the claimed technical effect, and thus understand how it could be obtained within the intended scope. In other words, it would be unlikely to think that, once sufficiency of disclosure is achieved, the technical effect would need to be demonstrated across the entire claimed scope to establish plausibility, especially if the reader is a person skilled in the art. However, if the requirement is related solely to the lack of *credibility* that the technical effect has been achieved in each embodiment of the invention as claimed, the description could be clear and complete in its guidance and teachings and yet still not satisfy such a requirement.

> **A balance between two aspects of sufficiency of disclosure should be sought.**

Not only is an objection based on this practice/approach legally conflicting with Mexican IP Law, but with Mexican Administrative Procedural Law. By issuing such an objection, the MPO is adding an administrative requirement that is not contemplated in the specialized legislation and is also contravening the principle of good faith by assuming a *priori* that the alleged effect is not supported by the evidence submitted. This implies that said effect was likely not achieved or cannot be achieved, so narrowing the scope of the claims to the exemplified embodiments is mandatory and the only valid way to overcome the objection. This renders the legal action by the Examination Division false or erroneously motivated.

The practice has unfortunate consequences at different levels and perspectives. If the applicant complies and addresses the requirement as issued, amendment of the claims results in the loss of protection over valid subject matter falling under the non-credibility mantle.

This practice could ultimately burden applicants with building up technical information prior to the filing of new applications, delaying the filing of new applications and the availability of innovative products; it could also burden the MPO with an examination of bulky evidence applications, probably creating a backlog, both cases acting against the spirit of the patent system by delaying R&D processes and examination and granting of exclusive rights.

Proposals and perspectives

The previous discussion does not imply that a requisite, like plausibility, is unnecessary or useless in the Mexican IP environment. On the contrary, a well-established standard of experimental or at least prophetic (in silico simulations, AI prediction models, etc.) evidence would add to the legal certainty of patent system users and to the Mexican innovation environment as well, both in terms of predictability of prosecution of patent applications and patent rights validity. However, it must be constructed differently and preferably count with solid legal grounds.

Legal grounds have their own dynamics and timing, which usually take significant time to change. However, more immediate actions could be taken both by the MPO and practitioners to address the issue.

On the side of the MPO, the requirement could be aimed at closing in on the EPO plausibility standard, even under the legal grounds of sufficiency of disclosure, that is, to establish whether the specification contains enough information required to determine if a technical effect could be achieved over the claimed scope.

To do this, the Examination Division could start by adequately motivating the objection, technically establishing the reasons giving rise to a reasonable and reasoned doubt in those cases that it determines that plausibility is not clearly demonstrated and only after considering the state of the art and the skilled in the art person. The nature of the invention and its inventiveness must also be included in this assessment.

A balance between two aspects of sufficiency of disclosure should be sought: first, in its meaning of guidance and instruction on how to realize and perform the invention and achieve its associated technical effect, and second, in the aspect of technical plausibility.

For example, when dealing with clearly disruptive inventions that should be awarded a broader scope of protection, the need to guide and instruct a person skilled in the art to realize and perform the invention is high, while the examples or experimental evidence could be presented as an illustrative but not necessarily exhaustive proof of efficacy. This is under the assumption that the examiner would be less likely to have reasonable doubts about the technical effect being achieved when there is little or no state-of-the-art to cast a shadow on that topic. A suitable

> **Using clear and concise language, leaving as little room as possible for assumptions and speculations, should also prove useful.**

example of this would be a new genus of the compound with pharmaceutical activity that is synthesized for the first time in which presumable the examiner would have no obvious reason to doubt that a technical effect is achieved if illustrated by a limited number of examples.

On the contrary, incremental inventions in heavily contested or developed technical fields could require less guidance on how to understand and perform them and more evidence to support a technical effect if a broad scope is pursued.

As to the recommendations on the side applicants and practitioners, the obvious one is to consider this new practice from a strategic perspective, preparing and pouring technical evidence that may address possible objections in applications to be filed, also minding the industrial applicability of the invention as it is declared since changing thereof during prosecution and not having the information to back up said changes could prompt suspicion on the Examination Division.

Using clear and concise language, leaving as little room as possible for assumptions and speculations, should also prove useful. When ranges are claimed, it would also be helpful to submit evidence (examples) in the upper and lower limits of those ranges; the same would happen with groups or families of compounds or species-grouped inventions, aiming to enable generalizations of the technical effect over these groups or ranges.

Final thoughts

As discussed, the current MPO credibility approach is not only legally unfounded but also detrimental to all participants, efforts like those discussed above should be made to steer this approach into legally sound "plausibility" standard aimed to ensure a fair exchange of sufficient information and temporal exclusive rights. These concerted efforts could be a first step in trying to better harmonize the Mexican practice with other jurisdictions to the benefit of stakeholders.

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Celebrating the 30th anniversary of the Eurasian Patent Convention: an interview with EAPO President Grigory Ivliev

Alexey Vakhnin, Partner and Managing Director of Vakhnina and Partners, sits down with Dr. Grigory Ivliev, the EAPO President, to discuss the EAPO's achievements over the past 30 years along with future goals and aspirations.

Opening remarks by Alexey Vakhnin

The 30th anniversary of the Eurasian Patent System which is celebrated this year, 2024, is an important date for intellectual property in all countries in the region.

Over the past 30 years, the Eurasian Patent Office (EAPO) has shown serious professional growth, strengthened its position among other Patent Offices, and consolidated the highest quality of expertise and office work, which for many other Patent Offices in different countries is a level to which one should strive. Therefore, it is a great honor for me to present an exclusive interview with the President of the EAPO Dr. Grigory Ivliev.

For reference, the 30th anniversary of the signing of the Eurasian Patent Convention, an international treaty establishing the Eurasian patent system, will be celebrated on September 9, 2024.

The Eurasian Patent Organization unites eight countries: Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Russia, Tajikistan, and Turkmenistan. The Eurasian Patent Office is an executive body administering the regional system of legal protection of inventions and industrial designs on the basis of a unitary Eurasian patent.

Résumés

Dr. Grigory Ivliev is EAPO President.
Eurasian Patent Office (EAPO) is an executive body of the Eurasian Patent Organization, administering the regional patent registration system, covering eight countries of the Eurasian region, Member States: Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Russia, Tajikistan, Turkmenistan.

Objects for IP rights protection: inventions and industrial designs.

Dr. Alexey Vakhnin is Partner and Managing Director of Vakhnina and Partners, Russian and Eurasian Patent and Trademark Attorneys Firm. He is a Eurasian Patent Attorney, and a Patent and Trademark Attorney of the Russian Federation, with extensive experience in IP since the 1990s.

Dr. Vakhnin is a member of the Eurasian Patent Attorneys Assembly (EPAA), FICPI, AIPPI, LESI, INTA, ECTA, PTMG etc.

Having PhD in Medicine (Biochemistry and Immunology), while working on patent matters, Alexey specializes in Medicine, Biotechnology, Biochemistry, and Pharmacology.

Dr. Ivliev, the EAPO started celebrating the 30th anniversary within the framework of WIPO Assemblies. What events did the EAPO organize?

We organized a session of our governing body - the Administrative Council - as well as an exhibition on "Advancing the Future" devoted to young innovators from the EAPO Member States to recognize their inventions' contributions to the achievement of the UN Sustainable Development Goals.

We also enjoyed a performance of folk music and a degustation of national cuisine from all our Member States. It was a great demonstration of our multilateral nature and our unity in diversity. I am glad that many international partners, including patent attorneys and inventors' associations, have joined our celebration.

Why did you decide to celebrate in Geneva?

WIPO has greatly contributed to the formation of the Eurasian Patent Organization. I would like to commemorate and pay my deepest respect to Dr. Arpad Bogsch, who headed WIPO for more than 20 years. He personally significantly contributed to the drafting and signing of the Convention and the creation of our Organization.

On October 2, 1995, WIPO Headquarters hosted the very first extraordinary session of the EAPO Administrative Council. The representative of Turkmenistan chaired the session. Almost 30 years after the Convention was signed, we gathered in that historical meeting room once again in Geneva on the extraordinary session of the Administrative Council under the chairmanship of Turkmenistan.

For us, WIPO Headquarters is not only a convenient venue to gather on the sidelines of the Assemblies. This meeting symbolizes continuity, the use of global experience, and the transfer of the best traditions and knowledge from IP professionals – living legends of our field. Besides, this meeting indicates deep integration into the global patent system.

What do you consider to be the EAPO's main achievements over the last 30 years?

We managed to establish a modern regional patent office with a high level of examination quality.

In 1997, the EAPO granted 24 patents, but in just one year, this number increased by 10 times. Currently, our Office is celebrating the anniversary of the EAPC with more than 48,000 granted Eurasian patents, from applicants in 133 countries.

The EAPO has also succeeded in expanding the regional registration system. This year is a jubilee year for the Eurasian system for the protection of not only inventions but also industrial designs. The Protocol to the Eurasian Patent Convention on the Protection of Industrial Designs was adopted five years ago.

Throughout these years, we have been constantly improving our quality control system. Since 2021, the EAPO has upgraded its status in the PCT system and started operating as an International Searching Authority and an International Preliminary Examining Authority. For us, this means joining the leading patent offices and an important indication of credibility to the quality of examination.

This year, the EAPO was successfully certified as per ISO 9001:2015 to confirm the global quality level of our services at all stages: formal examination, patent search, substantive examination, and granting of a patent. Our management system has proven to apply the highest world standards.

Is the quality reached by the development of regulations or with digital instruments?

Both elements are constantly being improved.

Dr. Grigory Ivliev

Dr. Alexey Vakhnin

Eurasian patent law incorporates the norms of the most important international treaties, such as PCT, the Patent Law Treaty, and the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure. It also includes provisions that reflect best global practices and focuses on the users of the Eurasian Patent system.

Nowadays, the EAPO is a strong digital patent office that meets all the requirements in the IT field. The patent procedure in the EAPO has been fully digitalized since 2015. We are upgrading our information systems in line with the most advanced international standards. For example, we started granting patents in electronic form, implemented the option to file applications with 3D models, and are finalizing integration with all advanced WIPO systems. EAPO is implementing AI tools in its operations.

What are the next steps?

Short-term plans include accession to the Hague system of international registration of designs. Turkmenistan has already adopted the national acts to accede to the Eurasian system for design registration. With the eight Contracting States of the Protocol, the EAPO will be ready to accede to the Geneva Act of the Hague Agreement

> **"The EAPO has developed the EA-PPH Patent Prosecution Highway Program in cooperation with the patent offices of the EAPO Member States."**

Concerning the International Registration of Industrial Designs.

Medium-term plans are reflected in the Development Program of the EAPO 2023-2028. In addition to improving the quality standards of the Office's products and services, the Office will keep working towards the formation of a common Eurasian information and examination space. The aim is to ensure the highest possible harmonization level of approaches to the granting of patent protection.

The EAPO has developed the EA-PPH Patent Prosecution Highway Program in cooperation with the patent offices of the EAPO Member States. A Eurasian project for the electronic exchange of priority documents' copies when seeking priority under the Paris Convention for the Protection of Industrial Property was developed. We are convinced that these projects will be a valuable opportunity to reduce costs for applicants and improve the quality of our work.

Moreover, the Development Program envisages the development of the Eurasian Pharmaceutical Register, the expansion of international cooperation, and the development of educational projects, which the EAPO implements jointly with the Member States.

With the Member States' support, we hope to launch the Eurasian trademark and utility model registration systems.

> **With the Member States' support, we hope to launch the Eurasian trademark and utility model registration systems.**

Are there any prospects for the geographical expansion of the Eurasian patent system?

The EAPO initiated the dialogue on the accession of Uzbekistan to the Eurasian patent system and organized consultations on its advantages. In July 2024, the EAPO signed a Memorandum on bilateral cooperation with the Ministry of Justice of the Republic of Uzbekistan. I am sure that both parties will benefit from this multisector partnership.

What is your opinion concerning the latest EU restrictive measures in the IP field against Russian applicants, inventors, and IP rights owners?

I strongly believe that obtaining and managing IP rights shall not be associated with any political grounds. The restrictions are a threat to the global IP system based on international treaties and fundamental principles of national treatment. The IP sanctions impact third parties and exacerbate uncertainty for IP users all over the world. The EAPO is committed to international obligations and provides all the services to all applicants regardless of their origin. IP Offices should not obstruct technological progress and, in particular, the implementation of socially significant technologies.

What do you think about the EAPO's future?

I am sure that regional registration systems are significant elements of the global IP system. They have great influence, taking into account the process of economic regional integration all over the world. My personal view is that the role of regional protection will grow because of the transformation of national IP Offices' functionality. Currently, they are more engaged in the development of national IP ecosystems and focused on technology transfer, promotion of IP among the youth, and universities, etc. Regional IP Offices accumulate examination competencies with their diverse staff.

We will continue our work and cooperation with EAPO Member States in order to ensure that the Eurasian patent system becomes more reliable, effective, and convenient for users.

Closing remarks by Alexey Vakhnin

Dr. Ivliev, thank you very much for your detailed and informative interview! I would like to wish the Eurasian Patent Office further professional growth and development, an increase in the number of participating countries, and a growth in the number of applications filed and patents registered. I hope that, in the near future, we will also see the development of new directions in the registration of utility models, and perhaps even Eurasian trademarks.

Once again, I congratulate you on the EAPO 30th anniversary and wish you and your team all the best!

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A person skilled in the art is not "Omniscient"

Ranjan Narula and Suvarna Pandey of RNA Technology and IP Attorneys raise key points around the role of a person skilled in the art of determining patentability, drawing on recent cases related to inventive step and patent eligibility under section 3(k) of the India Patent Act.

Résumés

Ranjan Narula founded the specialist IP law firm, RNA, Technology and IP Attorneys in 2004 and is now its Managing Partner. He has 27 years' post-qualification experience working on contentious and non-contentious IP and Technology issues. Ranjan has been practicing as an advocate and patent attorney since 1991, handling a wide range of IP, IT, and Technology matters, including IP management issues and strategic advice on IP clearance, acquisition, and enforcement. Ranjan has worked in-house and in private practice, including a stint with an international IP practice heading India operations. In 2019, Ranjan was invited to join the INTA Board of Directors.

Suvarna Pandey is a registered patent agent and a law graduate. Having been in the practice for around 15 years, her specialties include patent searches, patent drafting, and providing patentability and infringement opinions. She is also involved in patent prosecution proceedings at the patent office, opposition and other invalidity proceedings. She specializes in the development and strategic management of patent portfolios in areas that include biotechnology, chemical, and pharmaceutical inventions. She has been advising clients on global patent strategy, including PCT applications and national phases in designated countries. Suvarna has also authored various articles and delivered training sessions in the domain of Indian Patent practice.

Ranjan Narula

Suvarna Pandey

Role of a Person Skilled in the Art

A "person skilled in the art (PSITA)" is a very important and determinative factor in determining the patentability of an invention on the pillars of novelty, inventive step, and industrial applicability. These grounds are considered from the view of a PSITA and not a common person.

The Indian Patent Act does not explicitly describe PSITA. The manual by IPO refers to the "person skilled in the art" as a competent craftsman or engineer as distinguished from a mere artisan.

There have been many cases where the term has been discussed and interpreted in various manners. For example, In the matter of *Ericsson (India) Limited versus Alloy Wobben* [The Intellectual Property Appellate Board, Chennai, Case No: ORA/39/2009/PT/CH And Miscellaneous Petition Nos. 16/2010, 41/2010, 76/2010, 47/2011 & 22/2013 In ORA/39/2009/PT/CH)], the PSITA is interpreted as the person who has more than average knowledge of the state of the art and also has common sense- *"37. In this case the art is wind energy. Since this obviousness test is the most frequently debated issue in patent litigations. It may be better if in the future, the pleadings or evidence tells us who this person is. This person is skilled in the art. This person is presumed to know the state of that art at that time, and to have the knowledge that is publicly available. The Act is quite clear and free of ambiguity. This person is skilled in the art and has more than average knowledge of the state of the art and also has common sense. Indian law expects the non-obviousness to be tested against this person and not the person who is the touchstone in U.S. Law. She is Ms. P. Sita (Person Skilled in the art) and not Mr. Phosita or Mr. Posita who are both ordinary by definition!"*

The two recent cases decided by the Madras High Court, both being Appeals filed by the Microsoft Technology Licensing LLC against the order of the Assistant Controller of Patents, discusses inventive step from the point of view of the PSITA with respect to software technology. The Court judgment also highlights the patent eligibility under section 3(k), and the inventive step of the claimed invention. Under the exclusions under Section 3(k) of the India Patent Act, mathematical or business methods, computer programs *per se*, or algorithms are not patentable.

Brief background and facts of the two cases

I. Patent Application No. 5584/CHENP/2010 filed on September 7, 2010, for an invention titled "Associating Command Services with Multiple Active Components." The application was published on April 8, 2011, and the First Examination Report (FER) dated March 23, 2018, raised objections on the grounds of lack of inventive step, exclusion from patent protection under sections 3(k) and 3(m) of the Patents Act, 1970, and lack of sufficient disclosure under section 10(5).

II. Patent Application (no.1783/CHENP/2012) in India relating to "Message Communication of Sensor and Other Data." The application was refused by the Indian Patent Office during its examination on the grounds of the invention lacking inventive step and non-patentability under section 3(k).

Technical effect in computer-related inventions

The court reiterated the following principles:

1. Technical effect and contribution: the patentability of a computer program depends on whether it exhibits a technical effect or advancement. If a computer program leads to tangible benefits like reduced energy consumption, cost savings, or improved comfort levels, it may be considered patentable.

2. Algorithm implementation: an algorithm by itself may not be patentable, but if implemented within a device in such a way that it transforms the device's capabilities, it can be considered for patentability.

3. *'Per se'* clarification: the term *'per se'* in Section 3(k) implies that inventions based on algorithms and computer-executable instructions cannot be rejected if they offer a practical application in solving technical problems and provide technical advancements.

4. General-purpose computer: if the invention is implemented on a general-purpose computer and provides a technical effect that improves the computer system's functionality and effectiveness, the claimed invention cannot be rejected.

5. Functional enhancement: the question of whether an invention falls under the purview of algorithms should be analyzed based on whether the algorithms are directed at enhancing the functionality of a system or a hardware component.

> **"Microsoft argued that the invention provides a solution to the complexity of sensor data integration by using a lightweight messaging system, which was not properly considered by the IPO."**

The court also referred to the case of Innovations *Pvt. Ltd. v. Controller general of patents, designs and trademarks*, where the court identified 'technical effect' in the computer-related inventions through the following pointers:

"i) whether the claimed technical effect has a technical effect on a process which is carried on outside the computer;

ii) whether the claimed technical effect operates at the level of the architecture of the computer; that is to say whether the effect is produced irrespective of the data being processed or the applications being run;

iii) whether the claimed technical effect results in the computer being made to operate in a new way;

iv) whether there is an increase in the speed or reliability of the computer;

v) whether the perceived problem is overcome by the claimed invention as opposed to merely being circumvented."

Court Ruling in 5584/CHENP/2010:

Exclusion under section 3(k):

The court further held that the invention does not fall under the exclusions mentioned in section 3(k) as the claimed invention processes commands to multiple unrelated applications by associating the command surface to more than one component registered to receive commands from the command surface, ultimately enabling the outflow of commands to unrelated applications from a single command surface, removing the necessity of multiple command surfaces. This technical

contribution makes the claimed invention efficacious over conventional systems, which require the presence of multiple command surfaces on the web page to process unrelated applications. Thus, the invention possesses a 'technical effect' that enhances the system's functionality by processing multiple unrelated applications using the same command surface. This eliminates the need for multiple command surfaces, reduces the use of memory space in the system, and augments efficiency. As a result, it is patent-eligible under Section 3(k) of the Patents Act.

Inventive step from the view of PSITA:

- **Who is a PSITA in this case?**
  The court considered whether the above-mentioned steps are obvious to a PSITA, who is a software engineer conversant with the functioning of commanding systems and armed with knowledge of hardware systems or a team with such skill set, in this case.

- **Is the invention inventive when viewed from the view of PSITA?**
  The court, when analyzing the teachings of the cited documents from the view of PSITA, found that although both systems are designed to receive or send multiple inputs or commands, their nature of operation varies markedly. It would not be obvious to a PSITA imputed with knowledge of D1, which teaches attaching the service to a commanding node consisting of a table of bindings and entries through which the input passes and invoking an associated command handler, to arrive at the claimed invention's commanding system wherein multiple components are connected to the commanding surface which relays the commands to the relevant components after identifying the command lists with the respective components registered to receive the command. Such a commanding system results in a shared command surface that accommodates the functioning of various unrelated applications, a technical advancement that would not be obvious to PSITA.

> **"The judgment highlighted that the claimed invention's approach to reducing complexity by converting raw sensor data into easy-to-read messages would not have been obvious to the PSITA from the prior art."**

Facts and background in 1783/CHENP/2012:

1. Microsoft argued that the invention provides a solution to the complexity of sensor data integration by using a lightweight messaging system, which was not properly considered by the IPO.

2. The IPO rejected the patent application by relying on a prior art D4, stating that the claimed invention was obvious and lacked an inventive step, citing a 2012 order from the Intellectual Property Appellate Board. To this, Microsoft contended that the respondent's analysis was flawed and did not follow the proper steps for assessing inventive step, specifically relying on *Agriboard International LLC v. Deputy Controller of Patents and Designs*.

3. The court, on comparing the invention with D4, found that while both involve the transmission of sensor data, the claimed invention focuses on reducing complexity by converting raw sensor data into easy-to-read messages, which was not addressed by D4.

4. The court considered that the claimed invention provides a technical advancement by simplifying the processing of sensor data and that this advancement would not be obvious to a person skilled in the art from prior art D4.

The appeal was allowed, the impugned order was set aside, and the application was directed to proceed to grant subject to the specified amendments.

The court's comments on the "Person Skilled in the Art" (PSITA), with respect to software technology, are significant in the judgment. The judgment highlighted that the claimed invention's approach to reducing complexity by converting raw sensor data into easy-to-read messages would not have been obvious to the PSITA from the prior art, as it required ingenuity and not mere skill in the art. This analysis by the court underscores the importance of the PSITA's perspective in evaluating the inventive step of a patent application. The court's discussion regarding software patents and the role of hardware in software is centered around the inventive step and the technical advancement provided by the invention over the prior art.

The key points that emerge from the judgment:

- **Definition of PSITA:** the court defined the PSITA in the context of the invention as a software engineer with an understanding of hardware/computer electronics. The PSITA is considered to have above-average skills and the ability to do the job well.

- **PSITA's role in inventive step:** the court emphasized that the inventive step should be assessed from the perspective of the PSITA (and not a common man). The invention must involve a technical advance or have economic significance that makes it non-obvious to the PSITA.

The PSITA's role affects the inventive step in the following ways because the assessment of the inventive step of a claimed invention is to be made by a two-step process:

(1) Identification of feature(s), if any, that involve technical advancement over prior knowledge or having economic significance or both; and

(2) Determination of whether the technical advance or economic significance, or both, of said feature(s) makes the invention not obvious to a person skilled in the art.

- **Software Patents:** the court acknowledges that the invention in question involves software that enables applications in computers to receive sensor data through a messaging system. The inventive step is assessed based on the technical advancement this software provides compared to the existing knowledge.

- **Role of hardware:** the court notes that the "Person Skilled in the Art" (PSITA) for this invention would be a software engineer with an understanding of hardware/computer electronics. This indicates that the invention's assessment considers the interplay between software and hardware components.

- **Technical advancement:** the court emphasizes that the invention's technical advancement lies in its ability to reduce complexity by converting raw sensor data into lightweight, easy-to-read messages, which is not addressed by the prior art.

The above points highlight the court's approach to defining software patents in terms of their technical contribution and the role of hardware in enabling the software to achieve its intended purpose. The emphasis on non-obviousness and technical advancement underscores the importance of these factors in the patentability of software-related inventions.

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Insider's look: the growing importance of patents in the UAE

David Aylen and Rachel Armstrong of Gowling WLG discuss patents in the UAE, highlighting the basics for establishing a strong application and the balance between enforcement and tech transfer.

About being a UAE expat

Rachel: David, at least 80% of the UAE workforce is made up of more than 200 nationalities of expats, each of whom has a unique story about getting here. What's yours?

David: My career in intellectual property has been as fulfilling and interesting as I could have ever imagined. I began as a trainee and junior lawyer in Ottawa, Canada, where both the Canadian Patent Office and Federal Courts are headquartered. I later moved to Toronto to head up numerous IP-related firm initiatives. In 2009, the offer by my firm to develop an IP practice in Russia was one I could not refuse. It is enormously challenging, and ultimately satisfying, to reinvent oneself in a new country and to learn the local laws, practices, and procedures, not to mention the cultural differences. After 13 years in Russia, I was a seasoned expat, and it was intuitive for me to see that the UAE should be my next stop on my IP journey.

[1] Global Innovation Index 2023, Innovation in the Face of Uncertainty, (WIPO) 16th ed., Table 5, p.58: https://www.wipo.int/edocs/pubdocs/en/wipo-pub-2000-2023-en-main-report-global-innovation-index-2023-16th-edition.pdf

Rachel, the business vibe here seems so positive and intense compared to what is happening in the West these days. I note that WIPO's Global Innovation Index put the UAE in the Top Quartile of the World's Best Performers in terms of innovation for 2023[1]. Everyone seems to be buzzing and on a mission. Why is that?

Rachel: The UAE was formed in the early 70s and is a very young nation comprising seven Emirates. They recognized early on that it would become a strategic hub connecting Asia to the East, Africa to the South, and Europe to the North. It's

> **"WIPO's Global Innovation Index put the UAE in the Top Quartile of the World's Best Performers in terms of innovation for 2023."**

an economically diversified place situated in a business-friendly, ultra-safe, and modern environment where business and innovation are front and center.

About the patent system

David: The UAE patent system was established by legislation in 1992, and it wasn't until much later that the actual processing of applications began. At just a few decades old, the patent system has come a long way in an extremely short period of time. When it comes to patents, today, the UAE is a member of the Paris Convention, TRIPS, and PCT. Where do you see the patent system going from here?

Rachel: The patent system is administered by the DIEPD, which is the *Development of Innovations in the Economy and Patents Department* within the Ministry of the Economy (MoE) based in Abu Dhabi. Filing and prosecution are coordinated entirely on an e-filing platform. The MoE's short-term strategic objectives include a continued focus on intellectual property rights as a means for developing new economic sectors and achieving leadership and competitiveness in innovation[2].

The UAE has engaged in an intense international IP development agenda that dates back more than a decade[3]. There have been several waves of improvements to the patent system year upon year. For example, in May of 2024, the UAE Minister of Economy and the Undersecretary of Commerce for Intellectual Property and the USPTO signed a new Memorandum of Understanding (MOU). Under the terms of the MOU, they have undertaken to engage in exchanges of best practices related to IP to explore technical assistance and capacity-building programs and activities, and to discuss IP protection issues of mutual concern.

David Aylen

Rachel Armstrong

David: The USA-UAE undertaking shows great promise for USA innovators looking at the UAE as a place for doing business. The UAE is collaborating with other countries as well. Can you tell us how the Korean Intellectual Property Office (KIPO) is involved?

Rachel: The MoE is working closely with representatives of the Korean Patent Office (KIPO) and has been doing so for more than 10 years. This collaboration is aimed at optimizing service levels and best practices throughout the UAE patent application process. The KIPO has also stationed experienced examiners on site within the UAE patent office for training purposes.

In February of this year, the MoE also announced the launch of its new intellectual property IP system, which includes 11 integrated initiatives in various fields and applications of intellectual property. The initiatives cover a broad spectrum and include everything from incubation hubs, education in IP, faster TM registration targets, and much more[4].

UAE Patent Basics

David: Let's talk about the basics:

- The UAE has a first-to-file system based on absolute novelty but with a 12-month novelty grace period from the priority filing date in respect of an inventor's prior public disclosure.
- Novelty, inventive ingenuity, and industrial applicability requirements are in line with international standards.
- Ineligible subject matter includes plant or animal varieties and research or biological processes for the production of plants or animals, with the exception of microbiological processes and products resulting from such processes; methods of diagnostic, therapeutic, and surgical treatments of the human or animal body; principles, discoveries, scientific theories, and mathematical methods; schemes, rules, computer programs, or methods for doing business, performing mental acts or playing games; natural materials, even if purified or isolated from nature, with exception of the methods of purification or isolation of natural materials from the original environment; inventions the exploitation of which would be contrary to the public order or morality, or harmful to the health or life of humans or the environment.
- Since 2021, there is a right to file divisional applications.
- A regime for the publication of patent applications is underway.
- No patent term extension is available for pharma patents, and conversely, there is no experimental use exception available to generics for obtaining early regulatory approval.

Rachel: I would add that the UAE is fully TRIPS compliant.

David: Many countries have signed on to the *Patent Prosecution Highway* with great results in terms of getting to grant. Are there plans in the works for the UAE patent office to sign on as well?

Rachel: At the moment, there has been no announcement of intention to sign on to PPH, but this is likely in the works. The availability of expedited examination was one of the improvements introduced in 2021 under Article 14, and this is a critical step towards participating in the PPH. Under the recent MOU signed with the USPTO, this can't be far off.

David: Let's discuss the GCC, the Gulf Cooperation Council, and GCC patents. But first, what is the GCC, and what role does the Emirates (UAE) play?

Rachel: In May of 1981, six Arab nations came together to form a political and economic alliance under a comprehensive Charter that affirmed their ties of special relations, common characteristics, and similar systems founded on the creed of Islam. The six nations are: the United Arab Emirates, The State of Bahrain, The Kingdom of Saudi Arabia, The Sultanate of Oman, The State of Qatar, and The State of Kuwait. The GCC website acknowledges that the decision to form

[2] https://www.moec.gov.ae/en/strategy-and-policies
[3] WIPO Technical Assistance database: https://www.wipo.int/tad/en/activitysearchresult.jsp?bcntry=AE
[4] https://www.moec.gov.ae/documents/20121/0/Economy+Magazine+-+Q1-English+2024.pdf/f9568f43-b374-622c-d3b5-e294435b038a?t=1713167328930

Résumés

David Aylen is a seasoned patent expert with several decades of hands-on experience in Canada, the United States, and internationally. An engineer and Canadian lawyer, he is certified by the Law Society of Ontario as a Specialist in patents, trademarks, and copyrights. He holds a WIPO certificate in Advanced IP Management and currently leads the IP Asset Management and Strategy practice. He is a key member of the firm's MENA Patent team. Before joining the Dubai office, he served as the Managing Partner of Gowling WLG's Eurasian IP practice, based in Moscow.

Rachel Armstrong has been a prominent figure in the UAE's IP landscape since 2013, establishing herself as one of the region's leading intellectual property practitioners. Her expertise spans the entire lifecycle of IP rights, from strategic filing advice to commercialization and enforcement. Rachel has successfully managed IP portfolios, contentious disputes, and commercial IP matters across the Middle East and beyond. Her clientele includes some of the world's most renowned companies, particularly in the leisure, entertainment, fashion, e-commerce, technology, and FMCG sectors, as well as government entities and R&D labs.

the GCC was not a product of the moment but an institutional embodiment of a historical, social, and cultural reality[5].

The UAE has consistently maintained a leadership position in regard to GCC joint integration and important economic initiatives.

David: I've heard that the term "GCC Patent" and the GCC patent system have gone through changes in the last few years. Can you expand on that?

Rachel: The role played by the GCC and what a GCC patent is understood to mean has evolved over time.

For about 23 years, beginning in 1998 and ending in January 2021[6], one could obtain a GCC patent with coverage extending to all six member countries with the scope of protection resembling that available by way of national application and grant. In January 2021, the GCC Patent Office stopped receiving applications.

After about a two-year hiatus, restarting from January 1, 2023, for the Kingdom of Bahrain and The State of Kuwait, and from July 1, 2023, for The State of Qatar, the GCC Patent Office resumed receiving patent applications on behalf of these countries but only to examine them formally and substantively[7]. Unlike the earlier GCC patent concept that existed until 2021, GCC Patents are no longer granted. The current role of the GCC is to effectively act as an agent to receive and examine national applications intended for grant in Bahrain, Kuwait, or Qatar as the applicant may choose. Applicants still have the option of filing individual applications directly at the national offices of Bahrain, Kuwait, and Qatar. However, for applicants seeking patent protection in all three GCC states, the GCC Patent Office offers a simpler, more cost-effective solution. Applicants can file one application directly at the GCC Patent Office through the e-filing system. Once examination is complete, the application is then forwarded to the national offices for grant or rejection[8].

> **"The UAE has consistently maintained a leadership position in regard to GCC joint integration and important economic initiatives."**

David: I take it that if I am a foreign entity looking for a patent filing strategy in both the UAE and in the other GCC countries, one should plan on filing directly in the UAE, Saudi Arabia, and Oman for a national patent and optionally either via the GCC Patent Office, or directly for patents in Bahrain, Kuwait, and Qatar.

Rachel: Agreed. One should start from the premise that, for the UAE and Saudi Arabia, the two most economically active regions, only national applications can be filed, and these can be done via PCT.

Balancing priorities: enforcement and tech transfer

David: People ask, what about enforcement? Is there a plan for a specialized IP court?

Rachel: No plan has been announced, although IP specialized courts onshore in the UAE are desirable to provide confidence for IP rights holders enforcing their rights in the UAE and to provide even more credibility on the world stage.

David: As I see things at the moment, the strategic focus need not be on enforcement as much as on facilitating tech transfer and collaboration. As part of the UAE's drive to evolve *from pearls to petrol to patents*, the UAE's motive to import technology is not to copy it but to engage in the process of legitimately linking and connecting with international networks of knowledge and innovation and, ultimately, to domesticate external knowledge sources in the UAE's people, institutions, and firms[9].

This is important to appreciate because the priority regarding foreign tech transfer initiatives should be on building patent portfolios within the UAE - not for enforcement purposes, but for efficient technology transfer and collaboration purposes.

Putting it simply, the main reason foreign innovators should build patent portfolios in the UAE is not to erect a fortress against infringement but to build a platform for monetization and tech transfer.

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5 Secretariat General of the Gulf Cooperation Council (GCC): https://www.gcc-sg.org/en-us/Pages/default.aspx; https://www.gcc-sg.org/en-us/AboutGCC/Pages/Primarylaw.aspx; https://www.gcc-sg.org/en-us/AboutGCC/Pages/StartingPointsAndGoals.aspx

6 See the timeline provided on the GCC Patent Office website: https://www.gccpo.org/AboutUsEn/News

7 https://www.gccpo.org/AboutUsEn/News

8 El-Shabib, Fayek, Parker, (2024) "Qatar joins Bahrain and Kuwait as third national patent office to refer patent applications to GCCPO": https://gowlingwlg.com/en/insights-resources/articles/2024/qatar-patent-applications

9 Kowalski, Stanley P. (2018) "Establishing Appropriate Best Practices in Intellectual Property Management and Technology Transfer in the United Arab Emirates: Building Human Capital, Global Networks and Institutional Infrastructure to Drive Sustainable Knowledge-Based, Innovation-Driven Development," Indian Journal of Law and Technology: Vol. 14: Iss. 2, Article 1. (https://repository.nls.ac.in/cgi/viewcontent.cgi?article=1094&context=ijlt). The expression "pearls to petrol to patents" was artfully used by Kowalski in this article.

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The team at "Vakhnina & Partners" comprises of highly-qualified patent and trademark attorneys and lawyers.

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We handle our clients' cases in Armenia, Russia, Kyrgyzstan, at Eurasian Patent Office, and cooperate with partners and associates in other Eurasian countries: Georgia, Belarus, Kazakhstan, Azerbaijan, Turkmenistan, Uzbekistan, Moldova, Tajikistan.

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