

The Patent Lawyer

GLOBAL REACH, LOCAL KNOWLEDGE

www.patentlawyermagazine.com

Annual 2021



The effect of design space on patent grant and recognition for designs

Dr. Yongqiang Qi, Partner and Patent Attorney at Corner Stone, examines the latest judicial interpretation and what it means for design.



**Protect
against
crises**

Page 13



AI patenting

Page 18



**Patent validity
terms**

Page 56

Women in IP Leadership

Celebrating achievements and continuing
the empowerment of women



Sponsored by



We give special thanks to LexOrbis 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 LexOrbis, who, like *The Trademark Lawyer*, are passionate to continue the empowerment of women. LexOrbis' sponsorship enables us to remove the boundaries and offer this opportunity to all women in the sector. We give special thanks to LexOrbis 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.

Sponsored by



“

A diverse environment and an inclusive culture are the core principles for reaching better outcomes. LexOrbis as a Firm has and will always aim to achieve equality and diversity in our workplace, as these two factors count for the best discussions and all success stories. It is important to treat everyone equally, as that gives each individual a sense of belonging.

”

Manisha Singh, Managing Partner - LexOrbis

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.

Carlyn Burton: Partner, Osha Bergman Watanabe & Burton

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

Carlyn obtained her Bachelor's and Master's degree from Emory University in Chemistry before obtaining her Doctor of Jurisprudence from the University of Houston Law Center. Carlyn then joined Osha Bergman Watanabe & Burton, where she specializes in using IP in a creative way to help clients achieve their business goals. Carlyn recently became a named partner in the firm.

“We have to make an environment where everyone is valued.”



What inspired your career?

I started out assuming, thinking, and planning that I would be a PHD Chemist and work in research, so that's what I began doing. However, when I was working in the lab I realised that that was not what I wanted to do! So, I started looking at other options, and I was lucky that the school that I went to had a fair amount of career guidance for scientists looking for options outside traditional academia. I spoke to a few patent attorneys and thought it was very interesting, so I changed my plans and headed to law school.

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

It has been a fairly straight path; I went from grad school to law school, then during my last year of law school I started working for a firm and joined them and I haven't left! Which is not typical! That's where I am, and I am very happy doing it - I have been with the firm for 16 years now. I had worked for other firms as a summer associate, and I found that I didn't think I could really be me,

I knew I would spend too much time at work and with colleagues to feel like that.. I went into my last year of law school turning down a position for this reason, not knowing what I was going to do but within weeks had an interview with my current firm. You work with people a lot so you need to find a place where you can be true to yourself, and don't feel like you have to hide part of yourself - it is critical for happiness.

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

I would say the biggest challenge I've had is knowing how and when to say no, I tend to say yes to a lot which puts a lot on my plate so I need to say no sometimes. Especially as I have a six-year-old. And certainly now during the

“
You work with people a lot so you need to find a place where you can be true to yourself, and don't feel like you have to hide part of yourself – it is critical for happiness.
 ”

current circumstances with the pandemic where the work life balance is even worse, I would say that this and time is my biggest challenge.

I think my approach to saying yes has changed since I have had a child, but I still say yes more than I should. It has made me reassess, when I really want to say yes to something now, I choose what to prioritize and what to back out of to do it. For example, I served on my college alumni board, which required me to travel back to Atlanta from Houston three times a year for board meetings. I was eligible for one more term but I decided I was saying yes as natural progression, but it was time to close that service out. I am still involved with them, but it was too complicated to continue as it was as the timing coincided too much with the professional travel commitments I had to make.

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

I would say honestly for me it's client satisfaction. We recently changed the name of our firm so I am now a named partner, and as a part of that I emailed all my clients to let them know so that they wouldn't just receive our general announcement on the subject. The amount of emails I got back from clients was really nice. One that stands out in particular was from a client that said "your firm is highly regarded, however it is your name that is held in such esteem for us". That is really nice, thinking about it from an achievement perspective, that it is my work that is being recognised here.

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

I don't know, let's see! I would say continued growth and development of our work. We work very collaboratively in our firm, which is quite atypical in a law firm, so it is 100% a team effort in that, but I work best knowing that I am pulling my weight and bringing work to the table, and knowing that I deserve the seat at the table that I have. I also know that without my team, this wouldn't be possible. I will continue to mentor and teach so that my team members can flourish.

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

I'm passionate on this subject, I do a lot of work on this. I am Vice Chair of the Diversity & Inclusion Committee for IPO. Everyone is quick to cite a pipeline problem (and I do think there is one generally, particularly in IP), but it isn't just a pipeline problem. We have to make an environment where everyone is valued. This

goes back to the reasons for why I am where I am and why I have stayed there, I am in a place where I am comfortable being me. And I think this is so important for inclusivity, our profession is not going to achieve diversity without inclusivity, and inclusivity means everybody has to be comfortable being them. And at present that is not the case. I think that real change has to start at the top, and by recognising that there is no one path, one mould.

I think it takes commitment and innovative thinking. As an example, we have an atypical hiring process for a US law firm in that we have quite a European/international approach to hiring for patent prosecution. We bring in scientists and engineers and have a very intensive training programme for those individuals, and if they want to go to law school we will provide tuition assistance. I am in a position where I can say "in addition to posting a job on Indeed, we should also post on the Society of Hispanic Professional Engineers." This will help increase the diversity of applications we have coming in with targeted posts to reach and encourage diverse individuals to enter the field of IP."

I encourage anyone looking at how we can have a more diverse and inclusive profession to look at the "Practical Guide for Diversity and Inclusion in the Legal Profession" that was put together by the IPO committee on which I serve, and is available on IPO's website. This guide can be used in a formal or informal manner to help reach a more diverse and inclusive profession. As part of the formal launch of the toolkit, I spoke this fall about allyship, and the amount of discussion, which was all via Zoom in the webinar, showed a real appetite for these conversations. I encourage all to think about ways in which you can be an ally. Allyship does not take a single form, but can be so impactful on the career of a diverse or female individual.

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

I get the struggle of being a working mom - I have a six-year-old. Right now, that six-year-old is downstairs doing virtual school in a pod led by someone I have hired because I cannot teach her and work. We spent five months over the spring and summer at my parents' while I worked because my husband is deemed essential and was out of the house. I had to have help. These are unusual times. But thinking back to pre-2020, I was shocked when, at a lunch a few years ago in Houston where an informal 'women in IP' group meet semi-regularly, another attorney partner was talking about an associate of hers who was on

maternity leave and she was basically waiting for that associate to resign. The number of women that don't come back after having a child is high – I questioned this, and they were equally surprised that I hadn't experienced it. We've never lost a lawyer from having a child. I have since helped write some white papers on these issues and know that indeed, there is a sharp drop-off of women in the profession in the child-bearing years.

We've come up with flexible arrangements, shifting off of the 1800-hour billable requirement when desired by the employee. The idea of losing a valuable member of my team because I'm inflexible is crazy! The result of this flexibility is that we've never lost a staff member to having a child. And it doesn't impact their career path either, I have team members that have come back from maternity leave and proceeded to make partner. It's crazy to me to think that you must do 'x, y, z' to be on this career path, but I know that is happening elsewhere.

After child birth, I do think it is helpful to have a flexible scheme, or a ramp-on period.. When I had my child, I was a partner so I could control my own workload and I introduced the workflow back slowly which really helped and enabled me to share childcare with my husband. I think it is a really healthy way to do it, people can't just flip a switch, and this also allows people to build their work load back up again after not being present during maternity/paternity/any type of leave.

I also think providing a mentor, particularly for first time mothers, could be really comforting and successful in making employees feel supported. Which is ultimately what we want, we want everyone to feel supported and feel that they can and will be successful. Yes, it may be crazy at times, but a person should never feel like their only option is to stop working. Things don't have to be black and white, there are a lot of shades of grey between!

We've never placed huge emphases on employees having to be in the office from 'x' to 'x' hour. We can work from anywhere, this last year has certainly proved that so I hope this is a step in the right direction for the profession. It's okay if I leave early to pick my child up from school as I'll sign back on later. Granted, this is where I struggle with my work life balance but it is important to be flexible across the board, not just with women – I have a male associate that always picks the kids up etc. but he gets home and logs back on – we can all do that. I think to an extent it's even more impactful when men are doing that too because that in itself is equality. We need to find the balance, I don't just think of my male colleagues' work life, but their home life too. And that isn't to say

you have to have kids either. I think it's more impactful to be 100% equal and give those flexible opportunities to everyone.

Also, if people take a break from the profession this should not be questioned, whether they come back on a flexible basis or fulltime. I imagine for many this is a difficult idea, but I think being open to that type of hiring, choosing someone who is out of the loop but ultimately knows what they are doing, could be great for everybody. People may also need to be more supportive of older family members. My grandfather is 100, and I am his power of attorney and very involved in his life from a health standpoint. This can cause a great amount of pressure on people too. Flexibility would be so valuable here.

There can be very personal reasons for people needing flexibility, there should be a system in place to make people feel safe and to protect confidentiality. And this shouldn't be questioned, it's not my business to know why you need to step back or work differently. Equally, the same approach is needed if a person needs to have time off completely. These things should not negatively impact a person or their career either.

In sum, because the work-life struggle is the biggest reason why women leave the profession, I encourage all leaders to be flexible, and not let that flexibility impact the overall track of a person's career. You want these brilliant women on your team, so do not put them in a situation where they feel they are being set up to fail.

“

Things don't have to be black and white, there are a lot of shades of grey between!

”

Sponsored by

LexOrbis | INTELLECTUAL
PROPERTY
ATTORNEYS

Liz Cohen: Joint Managing Partner and IP specialist, Bristows LLP

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

Liz obtained her MA in Natural Sciences (Neurosciences) from the University of Cambridge before joining Bristows where she trained and qualified in IP Law. Liz has built her career at Bristows where she is now Joint Managing Partner, with a focus on counselling clients in the life sciences sector on national and international patent strategy and litigation.

“
Finding the balance between work and home life has not always been easy.
”



What inspired your career?

I studied science at university. I thought about law before then but I had a disastrous experience in a high street practice – they shut me in an office for a week with a pile of dusty old files to review and it put me right off. So, rather than pursue law, I went and got my science degree, and, whilst at University, Bristows organized a graduate recruitment event and I went along as I thought that it sounded interesting.

It went from there. I applied to Bristows for a place on one of their work experience schemes and afterwards I got invited to interview for and subsequently offered a training contract. On qualification I qualified as a patent litigator which is what attracted me to Bristows in the first place. Over time, my role has changed within the firm and that variety, together with the quality of the work, clients, and colleagues is what has kept me interested. Whilst I started as a scientist I became a lawyer, and over time I have become a manager. I am currently a Joint Managing Partner, which means that I have a fascinating insight into the firm as a whole.

How have you found the pathway to your current position?

I've always tried to make the most of opportunities when they have presented themselves, and I have tried to stay open minded as to where my career would take me. I have not worked anywhere apart from Bristows and whilst there are many reasons for that, in a large part it is because there have always been new and exciting opportunities for me to develop my skillset and develop my career. At Bristows we hire people who are curious, ambitious, and brave, but also friendly, and I have been incredibly supported in developing myself and my practice. So, in terms of pathway, I have never really had a particular goal in mind, but I have taken the opportunities as they have arisen – even if it wasn't something I was sure I

wanted to pursue ultimately, and even if it took me out of my comfort zone (which it often did!).

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

I've encountered all the usual challenges that most working parents face in managing a busy full-time career with bringing up a family. I'm not sure there have been any particular challenges in my career in itself but finding the balance between work and home life has not always been easy, particularly where travel has been involved.

And the circumstances and challenges associated with those circumstances have changed over time: when I started at Bristows we didn't have mobile devices or even a dedicated email account of our own and working from home wasn't an option. So when you think about where we have come from to now, where I am sitting at home with two screens, a phone, an iPad, and a laptop, you can say we are lucky. We have all had to be flexible to adapt to all of these changes, and in some ways the development of technology has enabled us to achieve the balance between work life and home life more easily.

However, this flexibility is not without its challenges: while it is now possible to work anywhere, at any time, the challenge is in ensuring that you maintain some divisions between worktime and play time and to try and develop good habits in this regard, whilst remaining available to your clients and colleagues and competitive in the market. I think this balance is a struggle for everyone, not just working parents.

I've learnt that you have to be kind to yourself in this regard. If you expect to have the balance right at all times then I think you will be disappointed. There is a bit of give and take, and you have to keep an eye on it. There will always be times when I think I should be at home more, and there will also be times where I think I should be at work more. My approach has been that, if I feel I have the balance right about 75% of the then that is pretty good – there will always be times when I feel I haven't got it right and you can't expect it to be perfect.

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

There have been many different achievements on different levels. I think you can say that every milestone, no matter how small is a bit of an achievement. During my time at Bristows I have progressed through the firm from trainee to Joint Managing Partner which in itself for me is a huge accomplishment. When I joined the firm as a trainee 21 years ago I never had that in my sights so that has been a unexpected achievement over a long period of time

“ I think that it would be enormously helpful to get children interested in IP at a school age. ”

However, everyday small achievements are just as important. Successfully arbitrating a commercial dispute between two parties, or taking a difficult decision that turns out well are all to be celebrated. Even though my management role takes up much of my time, I still have a busy client practice, so taking a case through to trial, or advising a client on how to reach their commercial objectives are all small victories which shouldn't get overlooked.

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

I've just started my second term as Joint Managing Partner, each term lasts for three years, and so for the next three years much of my time will be spent on management issues which are varied and interesting.

But, once I step down from management, I look forward to focusing purely on my client facing practice and all that that entails.

All of our partners play an active part in running the Bristows' business and so I will continue to be involved with helping to develop the firm's practices and people. One lovely thing about working in a law firm is that it is constantly evolving. There are always new trainees joining and qualifying every year as well as the natural flow of people joining and retiring, so your position in the firm and role you play is constantly changing over time. I find it fascinating because with every generation that comes through you have a new role to play and a new set of skills to learn. The trainees that are coming in now have different expectations and needs to those when I came in as a trainee, so learning about that and understanding how it drives particular behaviors is really quite interesting.

Inevitably my management role has changed my perspective too; as part of the management team you are involved in all of the important decisions that the firm makes and you get to see all of the different perspectives and positions on those decisions. Bristows is still self-managed so every partner gets a vote on important issues, but quite often by the time initiatives or opportunities are put to the partnership a position is recommended. If you aren't part of the management team you don't always get to see the thinking behind that recommendation or how it has been reached, whereas at the moment I get to see all the raw data, all the opinions and the background and get a much more intimate view into how people are feeling and what's driving various initiatives.

Having this wider overview of the firm as a whole gives me a useful context and perspective for my own practice and stops me getting stuck in a rut. It's always good to lift your head up every once in a while and have a look around to make sure everyone else is okay. This is a real privilege of the role.

“
I think we
need to show
that it is
possible.”

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

I think that the IP industry and law firms in general are doing a lot more now to make people much more aware of inclusivity and diversity. It would be hard now to find a firm that does not have a really thorough and comprehensive diversity and inclusivity program and this is really encouraging. We do a lot of this at Bristows and put a lot of time and energy into it because we think it is very important. We have got to be doing the right things, all of us.

One real challenge for the legal industry is ensuring that we create opportunities in these programs for people as young as possible. We need to plan for more than four or five years ahead. We're good at educating our own staff and going to universities and launching or using programs there to help with a wider diversity of application, but sometimes that's too late. What we actually also need to be doing is targeting schools, to get children to look ahead and think that this might be something they want to do even though they might not have an immediate role model that would encourage that. I think that it would be enormously helpful to get children interested in IP at a school age.

Such an approach would take a certain amount of investment and it is difficult to monitor whether you are targeting the right people in the right way because you are inevitably waiting a long time for your investment to bear fruits and it is difficult to track and quantify. But that doesn't mean we shouldn't do it and once there is that long-term commitment to that kind of diversity and inclusion program, then over time it could make a huge difference; probably not during my career but 10, 20, 30 years in the future.

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

I think we need to show that it is possible to achieve a satisfying, fulfilling, and challenging career whilst bringing up a family. You always wonder whether you are going to decide, when your children are older, that you made a big mistake and you shouldn't have been trying to do it all. My children are a little bit older now, they are 12 and 10, so I can start to see how they and my practice are growing delightfully!

Often we try and show that it is possible to balance a career and family commitments by showing that it is all working well, and that there are no problems, but actually we are not doing anyone any favors. I think it is important to share weakness and vulnerability and the challenges we face, to give a realistic picture of what achieving that balance is like. Of course we should also

share the positives of a fulfilling career and recognize that if you have got it right the majority of the time then that is good enough, and understand that nobody is perfect.

It's also important to be realistic about what a fulfilling career requires. Flexibility is incredibly important but when you work in a service industry, like law, we have to accept that sometimes you will have to work very hard and may go home late, but other times it will be balanced by a less busy time where you can afford to recuperate or catch up on other tasks. Taking the peaks with the troughs is really important. It's important to lead by example and to be generous in giving flexibility to those that are fantastic but are trying to figure it all out for themselves.

I remember when I first became a partner and my children were really young and I was trying to find that work-life balance. I was determined to get home to put the children to bed, or give them a bath, but inevitably conference calls would be organized about the same time and I'd end up in a massive juggle. There were numerous times where I would be on a call and bathing a child at the same time. If you speak to our IT team, they would tell you that there were frequent requests for replacement Blackberry's because they had somehow ended up wet or in the bath! From an outsider's perspective you probably wouldn't know any of that because I was very careful that if I was, for example, bathing a child while on a conference call, you couldn't hear the splashing in the background and that I would still contribute – but actually that was the reality of it at the time. Those kinds of examples are really important to share. Looking back on it I either should have missed the bath or asked to make the call an hour later, but that was the way it was. Today we can do better, collectively.

Like everyone else, when I became a partner I put pressure on myself. Although at Bristows about a third of partners are female, there weren't many female role models in my practice and I felt that I had to be performing in exactly the same way as everybody else – and everybody else was, pretty much, male. That pressure didn't come from anybody else, I put it on myself, and actually looking back now I should have given myself more of a break and backed myself a little bit more. None of my male partners worked in exactly the same way as each other so it was crazy to assume that they did. Luckily today I see some of my female colleagues coming through who are doing it their way and nobody bats an eyelid and it is healthy. This is a reflection of the way things have moved on which is very positive for the future.

Ultimately, I think we all need to keep sharing these real experiences to prove it is possible but in a realistic and relatable way.

Sponsored by



YOUR MOST TRUSTED IP PARTNER

- » **IAM Strategy 300, 2020** - Manisha Singh has been recognized as world's leading IP strategist
- » **IAM 1000, 2020** - LexOrbis is recognized as "Recommended Firm"
- » **IAM 1000, 2020** - Manisha Singh is recognized as "Recommended Individual"
- » **The Asia-Pacific Trademark Law Firm Rankings (India), 2020** - LexOrbis has been recognised as the most well respected law firm by The Trademark Lawyer Magazine
- » **Managing IP, 2020** - Manisha Singh recognized as "IP Star" 2020 for Patent litigation, Patent strategy & counselling.
- » **Managing IP Trademark Rankings for 2020** - "Trade mark prosecution tier 2 firm"
- » **India Business Law Journal's** - Indian Law Firm Awards 2020 for Intellectual Property Protection
- » **"Patent Law Firm of the Year" by Legal Era** - Legal Media Group, 2020
- » **Manisha Singh recognized as Star Women** in law for the year by Legal Era-Legal Media Group, 2020
- » **WTR 1000, 2020** - LexOrbis has been recognized as "Recommended Firm"
- » **2019 IP Star women of the year by Legal Era** - Legal Media Group awarded to Manisha Singh

- » **2019 GIPC** - Award for Excellence for invaluable services in the field of IP to Manisha Singh
- » **Ranked in WTR1000 2019**
- » **Innovation & excellence** - IP law firm of the year 2019" by The Corporate LiveWire.
- » **Awarded as "Corporate INTL Global awards 2019"**-"Intellectual Property Law firm of the year in India".
- » **IAM Patent 1000** : Most recommended prosecution firm for 2019 recognized Manisha Singh
- » **The IAM Strategy 300** – The World's Leading IP Strategists
- » **The Award for "IP Excellence Recognition" for 2019**, at Questel Executive IP Summit 2019
- » **Diversification of Practice** – 2019 by Indian Corporate Counsel Association (ICCA).
- » **The Acquisition International for 2019 Global excellence award:** Manisha Singh recognized as the most influential women in IP
- » **Asia Law:** Recognized for the category Intellectual Property in Asialaw Profiles 2020
- » **Best Patent Law Firm in India** - 2019 Asia IP awards.
- » **India Business Law Journal, 2019:** Manisha Singh recognized as one of India's Top 100 Lawyers, The A-List