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September / October 2023

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# *Amgen v. Sanofi:* The Supreme Court tackles patent enablement

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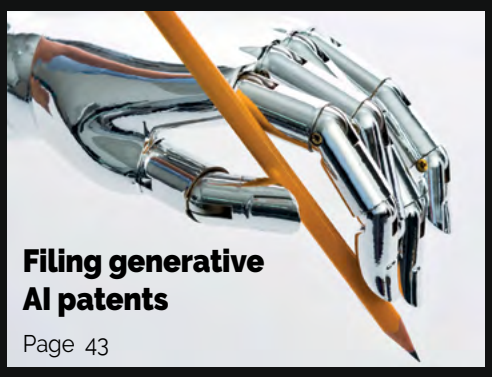

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AIPPI 2023 WORLD CONGRESS SPECIAL EDITION

CTC Legal Media




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**Issue 68**

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# Editor's welcome

Welcome to our AIPPI 2024 World Congress special edition! For those attending, we hope you enjoy your time in Istanbul. If you enjoy this issue, visit patentlawyermagazine.com to access our latest issue free upon release.

On May 18, 2023, the US Supreme Court solidified the enablement requirement in the decided case of *Amgen v. Sanofi*, concreting that a patent specification must be sufficiently detailed to enable a person skilled in the art to make and use the same. Our cover story this issue details the case to provide key takeaways for future enablement disputes. One not to miss!

> ***Welcome to our AIPPI 2024 World Congress special edition!***

Our guest interview this issue is with Kathi Vidal, Director at the United States Patent and Trademark Office. Kathi discusses the many highlights from her first year in the Director's chair along with key insights into future developments.

Further, we have details on the successful launch of the European Unitary Patent Court including strategic consideration for enforcement; updates on the recent changes affecting technology transfer in Brazil; an informative review of the introduction of patent punitive damages in China; a look into the available protection for traditional knowledge in Africa; an assessment of data asset protections in relation to AI inventions; and much more!

Our *Women in IP Leadership* segment features Winnie Tham of Amica Law and Shu-Pei Oei of Palfinger Europe. Contact us to find out how you can support the segment, a platform for women to share their experiences to encourage empowerment.

We hope you enjoy the issue, wherever you may be reading from!

Faye Waterford

**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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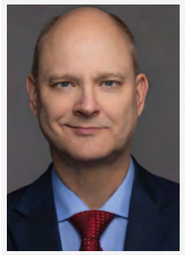

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***The Patent Lawyer*** **would like to thank the Editorial Board for their time and support.**

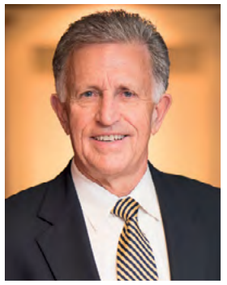
# *Amgen v. Sanofi:* The Supreme Court tackles patent enablement

**Craig Metcalf of Kirton McConkie reviews the findings in the case that has solidified the enablement requirement for pharmaceuticals in the US patent system.**

On May 18, 2023, the United States Supreme Court decided the case of *Amgen Inc. et al v. Sanofi et al.*[1] In that case, the Supreme Court addressed the patent requirement of enablement under 35 U.S.C. 112(a). Section 112 provides that a patent specification shall contain a written description of an invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same…"

The case arose from a dispute over an Amgen patent claiming antibodies for use in the treatment of elevated LDL cholesterol. LDL cholesterol is sometimes referred to as "bad cholesterol" because of its link with cardiovascular disease, heart attacks, and strokes. The antibodies at issue in this case bind at a precise location on the LDL molecule called PCSK9 and thereby prevent impairment of the body's mechanism for removing LDL. The antibodies were found to bind PCSK9 in a special region that Amgen referred to as the "sweet spot," a location where PCSK9 would otherwise bind LDL receptors. "By binding there, the antibodies block PCSK9 from binding to LDL receptors."[2]

Both Amgen and Sanofi were working in this area of technology, as were other pharmaceutical companies, including Pfizer and Merck. Amgen and Sanofi both obtained patents covering specific promising antibodies for binding PCSK9 to lower LDL levels in humans. Amgen's patent is US Patent No. 8,030,457, issued October 4, 2011 (the '457 patent). Both Amgen and Sanofi later succeeded in getting FDA approval for their preferred candidates and began marketing pharmaceutical products containing the preferred antibodies under the names Repatha and Praluent respectively.



**Craig Metcalf**

1 21-757 *Amgen Inc. v. Sanofi* (05/18/23)
2 Brief for Petitioners (Amgen), p. 10
3 US Const. Art. I, section 8, cl.8.

Following the filing of its original patent application, Amgen again approached the United States Patent and Trademark Office (USPTO) and filed two continuation applications relating back to the original '457 patent filings. These applications later matured into US patent numbers 8,829,165 and 8,859,741 (the '165 and '741 patents). In addition to claiming specific antibodies as set forth in the original Amgen '457 patent, these new patents claimed a genus of antibodies defined by the performance of specific functions: binding to specific amino acid residues on PCSK9, and blocking PCSK9 from binding to LDL receptors.

Upon issuance of the genus claims, Amgen sued Sanofi for patent infringement arguing that Sanofi's antibody product (Praluent) fell within the scope of the claimed genus. Sanofi admitted to infringement, agreeing that its antibody did fall within the scope of Amgen's claimed genus, but argued that Amgen's genus claims were invalid for failure to provide enabling disclosure under 35 U.S.C. 112(a). The two then entered extensive litigation, including two jury trials and two appeals to the Federal Circuit. Ultimately, the Supreme Court decided the matter holding that Amgen's claims were invalid for lack of enablement.

The Constitution provides Congress with the power to "promote the Progress of Science and the useful arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[3] The entire patent system has sometimes been described as a bargain, where an inventor discloses an invention in exchange for a right to exclude others from using that invention for a defined period of time. The basic concept is that the invention will be adequately disclosed so when the patent expires, the public will have access to the previously patented technology. Thus, the patentee upholds its end of the bargain.

From the Patent Act's beginnings, Congress has sought to ensure the benefit of this bargain for the public by requiring the patent applicant to deposit a "specification…so particular…as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art of manufacture…to make, construct, or used the same" (1 Stat. 110). Over time Congress has left this "enablement" obligation largely intact.[4]

As pointed out in the case's opinion and briefing, the current enablement requirement is similar in scope to the original Patent Act of 1790, which required a patent to contain a "specification in writing, containing a description…of the thing or things…invented or discovered…so particular as to enable a…person skilled in the art…to make, construct, or use the invention." To enable an invention, an inventor must provide a description sufficient that a person of skill in the art can make or use the invention without "undue experimentation."

In cases where the patent claim is directed to a single or limited number of fully defined embodiments, providing a description that enables the use of the invention may be relatively straightforward. For example, Sanofi pointed out that the specific antibodies claimed in Amgen's original '457 were enabled because there was adequate disclosure in the patent specification to allow one of skill in the art to duplicate the claimed, specific, antibodies of the claims.

However, when a patentee expands the scope of the claims to cover an entire genus, additional problems in complying with the enablement requirement present themselves. As the Supreme Court pointed out:

If a patent claims an entire class of processes, machines, manufactures, or compositions of matter, the patent's specification must enable a person skilled in the art to make and use the entire class. In other words, the specification must enable the full scope of the invention as defined by its claims. ***The more one claims, the more one must enable.*** (emphasis added).[5]

The Supreme Court discussed three primary cases to illustrate this point. The first was the inventor Morse.[6] In this case, Morse developed an electromagnetic telegraph. While Morse described specific structures of a telegraph system, one of his claims extended to "the use of motive power of the electric or galvanic current…however developed…" The Court held that this claim was overbroad. The claim covered all means of producing a telegraph, yet Morse had only described his particular embodiments.

The second case discussed by the Court was incandescent lamp patent, which involved a patent using a filament of fibrous and textile materials.[7] Inventors Sawyer and Man obtained a patent where they disclosed a lamp using carbonized fibrous or textile material but included a claim covering fibrous or textile materials generally. However, the carbon paper material disclosed in the patent specification did not function well. Thomas Edison entered the scene and developed an incandescent lamp using bamboo filaments. Sawyer and Man sued Edison for infringement of their patent. The Court held that the patent was not enabled stating, "The fact that paper happens to belong to the fibrous kingdom did not invent [Sawyer and Man] with sovereignty over this entire kingdom."

> **"However, when a patentee expands the scope of the claims to cover an entire genus, additional problems in complying with the enablement requirement present themselves."**

The third case was Holland Furniture[8] In that case, the inventor developed a starch furniture glue that had properties of previously used animal glues. The patent's claims, however, went beyond the specific glue developed by the inventor and instead claimed all starch glues of a specific formulation. The glue was claimed using functional language rather than by defining physical or chemical characteristics. The Court held that the claim was not enabled because it extended beyond the specifications.

In a fourth case, Wood[9], a generally defined claim was upheld. In that case, the patent related to a method for making bricks from coal dust and clay. The patent included a general rule about the proportion of materials to be mixed. The Court upheld the claim indicating that some minor differences in the proportions are sometimes required by the nature of the materials used, so even though the claim was general in nature, it was adequately enabled.

Turning to the Amgen patent, the Court found it provided inadequate disclosure to enable a claim to the entire genus claimed. It was agreed that the defined genus was large, possibly including millions of possible antibodies. Nevertheless, Amgen insisted that its patent enabled the genus.

It is interesting to look at the specific disclosure provided by Amgen. The Amgen patents each provide well over 300 pages of disclosure, which

4 *Amgen v. Sanofi*, Syllabus.
5 598 U.S. ___ (2023).
6 *O'Reilly v. Morse*, 15 How. 62 (1854).
7 The Incandescent Lamp Patent, 159 U.S. 465 (1895)
8 *Holland Furniture Co. v. Perkins Glue Co.*, 277 U.S. 245 (1928)
9 *Wood v. Underhill*, 5 How. 1 (1846)


## Résumé

**Craig Metcalf** is a member of Kirton McConkie's Intellectual Property section with experience in litigation, government, utilities, and healthcare. He has extensive experience in patents, trademarks, and copyrights and has successfully drafted and prosecuted more than 1,000 US patents and related foreign counterparts. He has worked in several technology and industry areas, including medical devices, pharmaceuticals, biotechnology, automotive, defense, chemicals, materials, mining, explosives, and environmental.

Craig has been named as one of Utah's Legal Elite in intellectual property, is AV rated by Martindale-Hubbell, is a Top-Rated Lawyer by Martindale-Hubbell, and is recognized by Mountain States Super Lawyers.

include extensive data, drawings, sequence listings, and 26 specific examples of antibodies within the scope of the genus. As characterized by Amgen, the patent specification sets out a step-by-step roadmap for generating antibodies within the scope of the genus. Amgen argued that this roadmap is effective well beyond the 26 specific examples disclosed. Amgen discussed in its brief further experimentation, which had produced an additional 384 antibody candidates. Amgen also argued that the patent describes how, using a claimed antibody, it is possible to make additional antibodies using what they called the "well-known technique" of conservative substitution. In addition, Amgen pointed out that the two jury trials resulted in verdicts upholding the patents on the enablement issue.

Sanofi, on the other hand, argued that Amgen's disclosure is only a trial-and-error process and there is an "astronomically large number" of possible antibodies within the genus. Sanofi further discussed that antibody science is unpredictable, even though Amgen argued that its roadmap never failed to successfully identify viable antibodies. Sanofi argued it is necessary to enable the full scope of the claimed genus.

The Court ultimately agreed with Sanofi. In doing so, it discussed some of the factors that may come into play in cases like this one. The Court pointed out that what is reasonable in any case will depend on the nature of the invention and the underlying art. The Court stated that "despite recent advances, aspects of antibody science remain unpredictable." The Court obviously did not accept Amgen's argument that the roadmap rendered the art predictable.

The Court also discussed the use of examples, stating that it may suffice to give an example (or a few examples) if the specification also discloses "some general quality…running through" the class that gives it "a peculiar fitness for the particular purpose," citing the incandescent lamp case. Amgen's patents provided examples, but the Court did not address why the examples were considered insufficient.

## Summary

Claiming a genus is a common technique in chemical and biotech patent practice. This technique includes the use of functional language rather than physical characteristics or chemical properties. Dealing with an invention that lends itself to such claims has always presented challenges to chemical and biotech patent practitioners. For the past 35 years, the factors of In Re Wands provided requirements guidance.[10] The Court discussed several of the Wands Factors in *Amgen v. Sanofi*. However, in *Amgen v. Sanofi*, the Court provided little specific guidance for drafting a valid application claiming a genus.

The Court emphasized the large number of possible embodiments that potentially fall within the claimed genus. Even though Amgen presented an extensive disclosure, including examples and a roadmap for locating claimed antibodies, the Court believed that too much experimentation was necessary to define the invention's scope. The Court stated that Amgen's disclosure offered "little more than advice to engage in 'trial and error.'" The Court held that Amgen's disclosure forced scientists to engage in "painstaking experimentation" to see what works. As a result, the Court affirmed the holding of the Federal Circuit that Amgen's claims were invalid for lack of enablement.

[10] In Re Wands, 858 F. 2d 731 (Fed Cir. 1988) set forth eight factors to consider when deciding whether claims are enabled and whether they require "undue experimentation," namely (1) the quantity of experimentation necessary; (2) the amount of direction or guidance presented; (3) the presence or absence of working examples; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability of unpredictability of the art; and (8) the breadth of the claims.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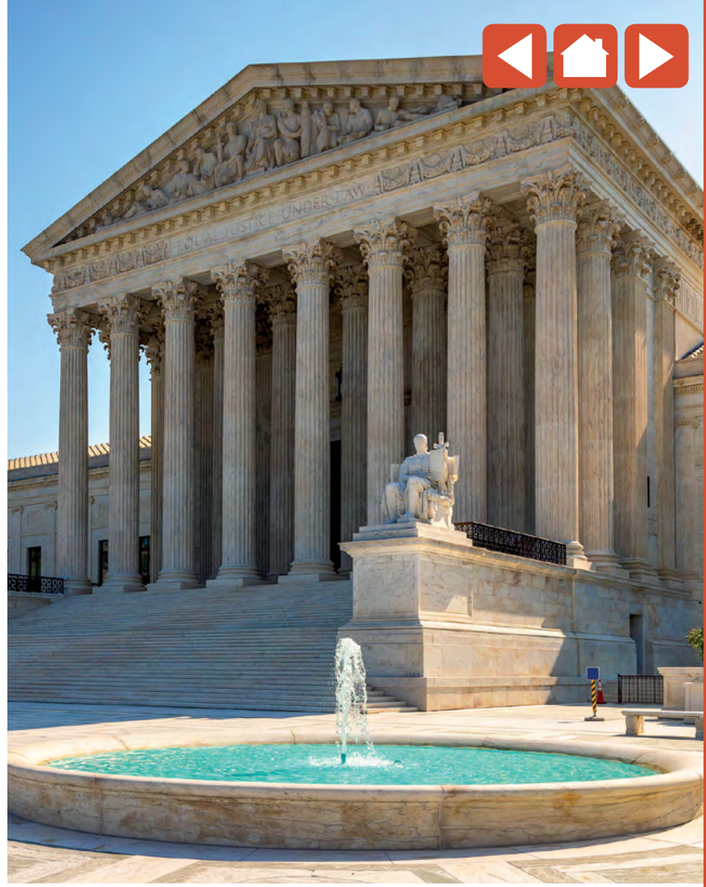

# An interview with Kathi Vidal, Director at the United States Patent and Trademark Office

**Kathi sits down with *The Patent Lawyer* to discuss highlights from her first year as Director, sharing insights into key developments that are striving for a secure future for the IP field.**

**Can you describe your pathway into IP and to your current role?**

I was interested in everything in High School, especially math and science. I was encouraged to go into the engineering field because there weren't that many women in the field at the time. I ended up getting a job at General Electric working in engineering. This was in the early 90's. I went through the Edison Engineering Program, which is a program, under Jack Walsh at the time, where I rotated from one business unit to another every six months. It gave me a really wide exposure to different technologies. And it was at that time that I was also pursuing my master's degree in electrical engineering focusing on artificial intelligence. I realized that as much as I liked technology, what I really loved about it was learning new technologies as opposed to deep diving into one specific area. When it came to deciding whether to pursue a Ph.D. or to pivot, I thought about this and the fact that even, as a young child, I always loved the law. That's when I decided that I'd go to law school and pursue a career in IP.

**Why did you aspire to become the Director of the USPTO?**

I'm the type of person that is happy doing what I'm doing, and I always put my whole heart and mind into it. I never have a five-year plan; I just want to do the best that I can and have the most impact for other people. When the position of Director was mentioned to me, I thought about the possibility of this role, the work that I had been doing for other people, and how I could amplify all of that in this position. I also thought about the challenges our country faces, and other countries face, in terms of innovation and entrepreneurship and solving world problems. The work our teams at the USPTO have been able to accomplish in this past year and a quarter has been incredible. My work as the Director is both exhilarating and purposeful.

Kathi Vidal

> **"I just want to do the best that I can and have the most impact for other people."**

**You've spent the last year, the first in your current role as Director, listening and gathering input from stakeholders, via fireside chats and the 'Engage with the Director' inbox. Can you recall some of the insights that you found most valuable?**

I would say two things really stood out to me: first, we regularly request public comment, and recently we did an ANPRM; when we read the comments, for the most part, they tend to be very binary because everybody is advocating for exactly what is best for them as a stakeholder and not looking at the country as a whole. One thing that really surprised me was that, when we get people into a room, the conversation is different; people understand what we need to solve for as a country, people understand what like-minded countries are facing, and the importance of an IP ecosystem that is strong and works for everyone. Once we have those discussions, we're really able to thread the needle. As an example, when I first came in as Director, the big issue facing the USPTO was the SEP policy, whether to continue with the 2019 policy or move forward with what was the draft 2021 policy. Looking at the comments, people were full bore one way or the other on the matter, but once I got people in a room together and told them that I'm not here to serve any one interest, I'm here to hear from everyone and do what's best for the country, people had a lot of great ideas. When we came to a resolution, by withdrawing the policies, people understood why we made that decision.

Second, our country, our nation, and I would apply this to like-minded nations as well, needs the progress and growth that only IP protections can provide. It's what solved the COVID-19 crisis; it's how we got vaccines to market so quickly. Patents incentivized the investments that brought the vaccines to market. They also incentivized the collaboration that was necessary. Because companies had patents, they felt secure collaborating knowing what each was bringing to the table. A strong IP ecosystem is what we need not only for solving problems like those we faced with COVID, but for job creation, for more stable jobs, for economic growth. When I get out and speak with folks, it's very clear that, although people may have different ideas of what an ideal intellectual property system looks like based on their own experiences, or based on what may help their particular organization or company, everybody's aligned with our higher-level mission.

> **"We are doubling down on our pro bono programs so that more people can participate in the innovation ecosystem and secure patents even if they don't have the funding."**

**What element or experience in the past year have you found most rewarding?**

One is my visits to schools. Last year, in conjunction with the National Inventors Hall of Fame® (NIHF), the USPTO hosted over 280,000 children for education related to IP and entrepreneurship. Hearing six to nine year-olds talk about their ideas, innovations, and the problems they want to solve in the world, giving them exposure to IP, and the knowledge that you can file for a patent at any age, creates an energy and enthusiasm that is so infectious. It just reminds me that children are our future; we need to get out there and make sure that, as much as we're working on solutions at all levels, including in higher education, communities, in the military, we first and foremost need to make sure that we're always there in the schools.

In June, I was at the Pearl Harbor-Hickam military base in Hawaii visiting students who were presenting innovations they were working on. One nine-year-old girl had a phenomenal idea for a dissolvable food bag for use in space to prevent waste in space, and a boy had an idea for swimming gloves that collect plastic particulates so that you could clean the ocean while you're swimming. These are just a couple of the remarkable ideas that the students came up with in a week in preparation for my visit.

Another element that I find really rewarding is the number of positive comments I get from the public relating to specific people at the USPTO; I can't tell you how many inventors have named their patent examiner, thanked me, and asked me to thank their examiner for their great work. I started an 'Engaged the Director' website so that anyone could communicate directly with me; I presumed that I'd get a lot of comments about improvements, because I asked for those, but what I didn't realize was how many comments that I'd get thanking me and specific employees; that also gets me really excited. We have great, excellent, committed people here at the USPTO and nothing gives me more joy than to see them recognized.

“Most experts agree that fakes account for 3.3% to as much as 7.5% of global trade which runs into the hundreds of billions of dollars annually.”

**Turning to the 2022-2026 Strategic Plan, can you tell us about: How will you work to drive inclusive US innovation and global competitiveness?**

There are two main components to that goal: first, we need to drive more innovation from more people, including those already innovating; second, we need to focus on driving innovation in key technology areas. To do this, we are doubling down on our pro bono programs so that more people can participate in the innovation ecosystem and secure patents even if they don't have the funding. We are expanding our patent and trademark resource centers at universities and libraries around the country so people can go to their local library and get help securing a trademark or patent. We're offering a lot more programs to meet people where they are. For example, with Secretary of Commerce Gina Raimondo, I founded the WE (Women Entrepreneurship) initiative where we are focusing on bringing great content to women who are interested in becoming entrepreneurs. We've just started a mentoring program for women too.

We have written an IP identifier tool for those thinking about starting a business, and we're trying to transform the way that we conduct business so that we appear less like a government institution and more like a user-friendly business that's here to help. One of the things that we're looking at is what we send to people who first communicate with us. Do we just send them a formal filing receipt, or do we welcome them and let them know about all of the resources that are available to make them successful?

We also need to focus on key technology areas, I just got back from hosting the IP5 meeting with the other four largest IP offices in the world – Europe, Japan, Korea, and China – where the focus was on climate change. We've put together a pamphlet that let's everybody know what the five offices are doing to incentivize and drive innovation in the climate space and to bring that innovation to impact. We are focusing on key technologies that will solve for world problems but also on new and emerging technologies including artificial intelligence, and technologies such as pharma where people are bringing life-saving drugs and solutions to the market.

As to AI, we've developed a new AI/ET technology partnership because we want to use data and input from stakeholders when creating solutions in the space; we're engaged with the community regularly.

**How do you currently measure the reliability of IP rights? And how will the USPTO work to promote efficient delivery of rights?**

We have a number of metrics that check quality within the agency on both the trademark and patent sides of the house; we do regular quality checks; we measure against statutory provisions; and we have feedback loops between the Patent Trial and Appeal Board (PTAB) to make sure we're continuously learning and with the court system to make sure we are up to date with case decisions and potential impact.

I will say that what is equally important is how people perceive the quality of our work. Are people relying on the patent system, and is it incentivizing innovation? Are the inventors we rely on investing in the technologies that we're incentivizing people to create?

We will continue to work on improving both the quality and the perceptions of the work that we're doing. We are investing in guidance and training and developing new tools to make sure that, as technology is evolving and converging so quickly, we are ahead of the game. On the patent side, we are using AI for routing and classification to ensure the patent application is assigned to an examiner who best understands the technology. And, we have adapted our practices so that examiners in one technology field who are assigned an application that contains multiple technologies can consult with examiners in other technology areas. On the trademark side, we are using bots and other technological advances to improve our processes for examination.

**What new and persistent threats to rights do you feel are currently underrepresented and require more exposure within the IP community?**

One of my biggest concerns is counterfeiting and piracy. While estimates vary as to the full scope of counterfeiting for both physical and online markets, and how much of global trade is in counterfeit goods, most experts agree that fakes account for 3.3% to as much as 7.5% of global trade which runs into the hundreds of billions of dollars annually and will soon, if not already, cross the $1 trillion mark per year. This means an astronomical amount of hard-earned money is just flowing out the door because people are ripping off products and selling them against brand owners or content creators. Beyond this, these fake goods are hurting Americans and people across the globe every day, whether it be through fires caused by faulty electronics, safety devices like fake bike helmets that don't work or through medications laced with fentanyl. We've been extremely focused on this; we're using awareness campaigns, including the Go for Real™ campaign. We also work with countries around the globe and on key trade routes to build their capacities and enforcement mechanism. We work with other agencies in the United States on the same. And, we've just released a request for comments to engage with our stakeholders on best practices and what more we can do.

We're also focused on any threat to the USPTO itself. We've had people impersonating the USPTO in an attempt to obtain money from people filing for patents and trademarks, and we've had people who are misusing our processes for personal monetary gain.

Lastly, we want to protect innovators and entrepreneurs everywhere, so one thing that we're looking at is a collaboration with the FBI and others to make sure that startups and companies throughout the country are protected from cyber threats and IP theft. We're dedicated to helping people that don't have the funding to be fully secure because it can cost a lot of money to find solutions.

**What would you identify as the key elements of a robust IP ecosystem?**

At the end of the day, we need to make sure that we are protecting the technologies that need to be protected and supporting innovation while ensuring that we're not overprotecting to the point where we're stunting competition. That's a very difficult line to draw and has become even more challenging with AI – determining inventorship if AI enables the invention, what types of innovation should be incentivized, what is obvious and who is a person of ordinary skill in the art given AI capabilities, and so forth. We need to continue to develop a system to support innovation and entrepreneurship, whether through awarding a patent or registering a trademark, to grow businesses, a system that people have faith in. And, those with IP need a reliable and accessible way of enforcing their IP.

**How are you working in response to new and emerging technologies such as AI?**

The bottom line is that the USPTO plays an important role in both incentivizing and protecting innovation in critical technologies such as AI and other emerging technologies like quantum computing, synthetic biology, blockchain, precision medicine, and virtual reality, and we need to make sure this continues so that these technologies can be brought to impact. We are working on policy across the government so that commercial impact is considered for that which can be secured through IP – or can be stunted through IP if it's not done correctly. We also need to make sure that we're supporting the full ecosystem so we're not only encouraging innovation but also bringing that innovation to impact.

Under my leadership, we founded an AI/ET (Emerging Technology) Partnership and we are working with that partnership, with other agencies and with the Copyright Office to address the hard issues such as inventorship, obviousness and person of ordinary skill in the art, in addition to policies implicating the rights of copyright holders and rights related to data.

**Having compiled invaluable insight over the past year, what passion project do you have for the year ahead?**

This year is about pushing things over the finish line and finding ways to have impact at speed and scale. All of the projects I'm working on are passion projects, whether it's trying to evolve the rules around patents to make them stronger – that's something we're looking into in response to stakeholder feedback – whether it's strengthening our PTAB procedures, or collecting broad feedback and distilling it to figure out how we can thread the needle to make meaningful, sustainable change. We are digging deep when it comes to AI and are working on inventorship issues then turning to obviousness and person of ordinary skill in the art. We are focused on standards and other issues at the intersection of intellectual property and competition. We are focused internationally to make sure we work with like-minded countries and build and support strong IP ecosystems that grow jobs in all our nations and solve world problems. And, as I noted early in my term, I am also very focused on counterfeiting and piracy, not only because of the economic impact they have on our nations, but also the harms and deaths they cause. Then, of course, there are other buckets as well; expanding our bars so that more people can participate before the USPTO, creating a design bar that never existed before, expanding the patent bar into technologies like computer science that should be readily recognized, to expanding the PTAB bar.

Then there's everything that we're doing around inclusive innovation and creating marketplaces including for green technology. We want to get out into more communities, and one of our big focuses is the military, military spouses and veterans. Only by bringing everyone into the innovation and entrepreneurship ecosystem and giving them full access and support will all our nations reach our full potential.

“We are working on policy across the government so that commercial impact is considered for that which can be secured through IP – or can be stunted through IP if it's not done correctly.”

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# The new European patent landscape: what companies should know

**Dr. Michael Rüberg, LL.M., Dr. Dennis Kretschmann and Dr. Matthias Hofmann detail the successful launch of the European Unitary Patent Court, explaining strategic consideration for enforcing patents across the continent.**

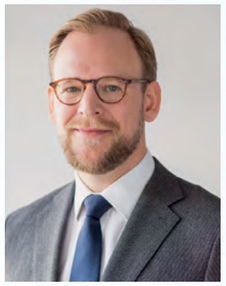
After more than 50 years of preparatory work and numerous setbacks, the European Unitary Patent system entered into force on June 1, 2023. For the IP world, this is a project of the century, both in terms of its long and eventful history and its far-reaching effects. It has the potential to fundamentally enhance the enforcement of patents in Europe and offers market participants numerous new options.

The European Unitary Patent system comprises on the one hand a new "European patent with unitary effect" (UP) in all participating EU member states, and on the other hand a new Unified Patent Court (UPC), which will decide on these unitary patents, but ultimately also on all conventional European patents (EP, or so-called "bundle patents").

## Standardized patent protection in all participating EU countries

The aim of the Unitary Patent system is to establish a more uniform approach to the enforcement and defense of European patents in the various EU member states. The already centralized grant and opposition procedures at the European Patent Office (EPO) remain unchanged for this purpose. However, the new system adds centralized post-grant infringement and revocation procedures.

In the new system, it is possible to file a request for unitary protection with the EPO for each European patent instead of validating the patent individually in several countries. The unitary effect leads to unitary protection in all participating EU countries (17 countries at the start of the system, aimed at including, eventually, all EU member states). Therefore, only one common annual fee will have to be paid to the EPO to maintain protection in all these countries. The unitary patent will coexist with national patents and traditional bundle patents.



Dr. Michael Rüberg, LL.M.

Dr. Dennis Kretschmann

Dr. Matthias Hofmann

Thus, once the patent has been granted by the European Patent Office, the applicant will have the choice of whether to opt for the new Unitary Patent, or not. However, it is important to note that the new patent system does not only affect newly granted patents. All validations of existing bundle patents in countries that have ratified the UPC Agreement are also subject to the jurisdiction of the UPC – and are so by default.

However, during a transitional period of at least seven years, patent owners can individually remove their patents from the UPC system - the so-called "opt-out". Then, only national courts will continue to have jurisdiction over these patents. Patent owners can also re-enter under certain conditions after they have opted out by withdrawing the opt-out. During the transition period, there will also be an option to continue to bring patent litigation before national courts for patents that have not been opted out.

As of August 2023, about one third of all European patents and applications had been opted out of the jurisdiction of the Unified Patent Court (UPC). While this is a figure far from being insignificant, it needs to be considered that it also leaves the remaining two-thirds to the present jurisdiction of the UPC.

## Strategic considerations for enforcing patents before the UPC

Holders of traditional bundle patents (EP) are now faced with the question, with immediate effect and continuing during the entire transitional phase, whether and under which circumstances they should enforce the IP rights in question before the UPC, or whether preference should not be given to national proceedings. The same applies, and will apply even beyond that date, to owners of parallel national patents and Unitary Patents (UP). For the owners of traditional bundle patents (EP), this question should best be asked at an







> **During the transition period, there will also be an option to continue to bring patent litigation before national courts for patents that have not been opted out.**

## Résumés

**Dr. Michael Rüberg, LL.M., Attorney at Law**
Michael Rüberg is an attorney at law with many years of experience in patent litigation. In cooperation with patent attorneys from various technical fields, he and his team of attorneys represent clients before all infringement courts and in parallel litigation. At the same time, Michael Rüberg is involved in the coordination of numerous major patent litigation proceedings, also on an international level.

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Dennis Kretschmann focuses on the development and management of patent portfolios in the areas of physics, optics, electrical engineering, IT, and software. He represents clients in examination proceedings before German and international patent offices. Dennis Kretschmann also has wide expertise in patent litigation matters. He regularly conducts patent infringement and nullity proceedings before the German courts, and often coordinates cross-border infringement cases.

**Dr. Matthias Hofmann, Patent Attorney**
Matthias Hofmann focuses on examination, opposition, and appeal proceedings before the European Patent Office and the German Patent and Trade Mark Office. Most of his work is related to computer-implemented inventions, in particular relating to artificial intelligence. He has in-depth technical expertise in the fields of machine learning, medical imaging, video and image processing, computer architecture, telecommunications, and bio-informatics (computational genomics).

early stage during the transitional phase since there is a risk that the potential opponent may otherwise take over the decision-making (of whether to stay in the UPC or opt-out) by simply filing suit (in the form of a declaratory action for non-infringement or a validity attack) in the system to which the EP is currently assigned.

Companies must therefore know about the factors to be considered when deciding for or against national jurisdiction in comparison with the new UPC and how these should be weighted in each case. Depending on the industry, this is likely to be done with different emphases and from different perspectives. For example, one of the great promises of the new system is the possibility of obtaining a uniform injunction for the first time across all countries (in the case of a UP for all member states of the UPC, in the case of an EP for all validation states that are also members of the UPC). Also, one other important promise is to recover damages uniformly and for all countries in question. Compared to the conventional model of exemplary enforcement of patents in only one or two core markets, such as Germany in particular, this is of particular interest and importance if the distribution structure of the infringer gives reason to assume that they will continue the infringement outside the core market in question, i.e., to simply "duck away" from the enforcement.

In this regard, the UPC's simultaneous enforceability of an injunction and, where applicable, a seizure order, results in considerable commercial pressure on the infringer, in particular as no shifting of manufacturing and/or distribution to other relevant markets in Europe will be allowed for. This pressure, in most cases, will apply immediately following a first-instance decision, which will be declared provisionally enforceable as a rule before the new unified court. Not least for this reason, the new system will also be attractive to those companies whose goal is not to obtain or defend an exclusive market position, but who primarily want to monetize the IP right in question.

In addition, for those patent owners who, due to their own local manufacturing and/or sales activities, seek an exclusive position in one of the European countries that are traditionally rather reluctant or inexperienced in enforcing patents (sometimes also referred to as "patent-poor countries"), will see in the UPC a welcome opportunity to put competitors in their place even outside the usual core markets.

On the other hand, companies whose products are covered by only individual patents (such as pharmaceutical companies), will probably be afraid of the centralized, all-national parts of the EP or the entire UPC and will carefully consider whether a corresponding counter-reaction should be triggered by an action before the UPC. However, this risk can be mitigated by skillful filing strategies, in particular by exploiting the possibility of obtaining national property rights in parallel – a possibility that has been newly created for Germany, so that it does not necessarily have to discourage the use of the new jurisdiction.

> **Patent applicants now have various options for obtaining patent protection in one or more European countries.**

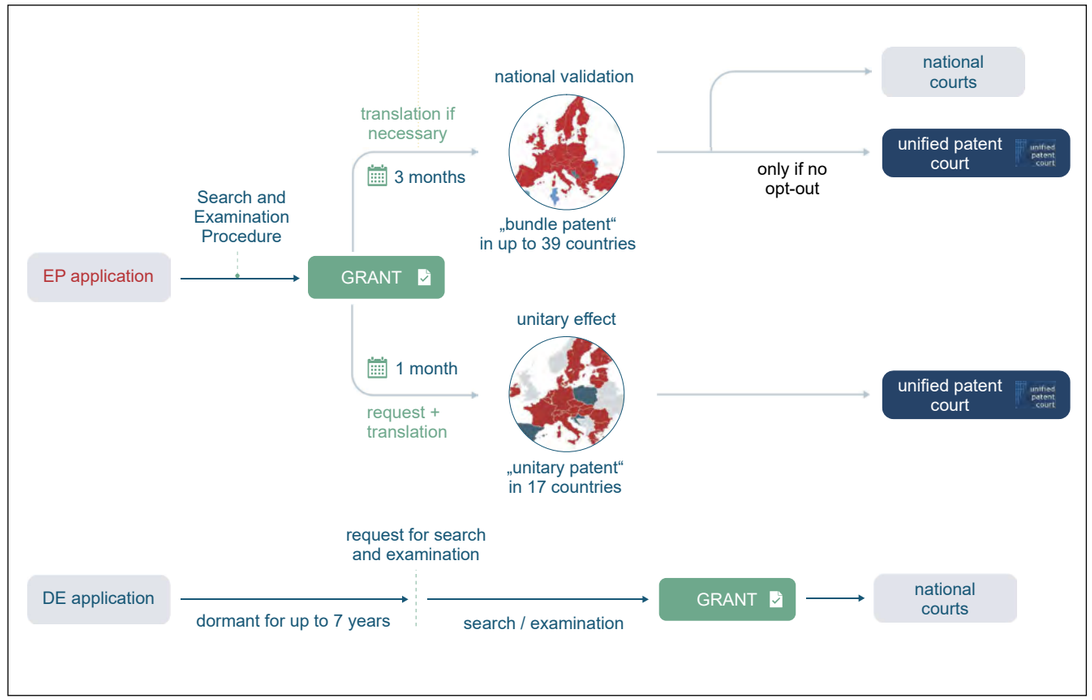
One disadvantage of the new system, and this applies equally to all areas, is of course its novelty as such. This entails the unpredictability of certain decisions due to the lack of real precedents in the initial phase of the UPC, as well as the likelihood that in the initial phase almost any decision, even those of a purely procedural nature, can be appealed as long as there is no established case law practice to guide the way in this respect.

The general reluctance to be among the first to test the system seems to be confirmed by the rather low number of initial cases brought with the UPC (about 25, as of August 2023). Also, most of these cases have been brought in the German local divisions, with the apparent hope of being able to rely on the well-established German case law in patent matters for those areas of current uncertainty. While the first decisions by the German local divisions have just recently (as of August 2023) been handed down (on preliminary injunction requests), most cases will not be decided before mid-2024, so that only the UPC's own case law will start to develop. From those preliminary injunction requests decided already, one may draw the conclusion that the judges will, as expected and at least initially, follow their national tradition and concepts, to the extent allowed for in the new system.

Another factor to be weighed up when deciding on whether to use the UPC will certainly be the costs associated with enforcement, which cannot be reliably estimated at present due to a lack of practice. However, it is probably quite certain that, due to the challenges posed by the new system to the conduct of proceedings, the legal teams in the UPC will be larger than in national proceedings, as a result of which the costs will considerably exceed at least one national proceeding as a comparative figure. Whether and to what extent this will also apply to parallel national proceedings in multiple jurisdictions remains to be seen. In certain constellations, however, the traditional approach of a lawsuit in Germany, for example, followed by an out-of-court settlement for the whole of Europe is likely to remain the preferred path, also from a cost perspective.

So, in summary, there is no clear "yes" or "no" to using the new system. For some companies, "wait and see" may be the ideal way to gain initial orientation. However, whether the early phase of the system does or does not also offer real entrepreneurial opportunities should at least be considered.






## Considerations on patent application practice with regard to the UPC

Patent applicants now have various options for obtaining patent protection in one or more European countries.

Anyone who only needs protection in one or two European countries achieves this most cost-effectively via national patent applications. German patent applications in particular, with an application fee of EUR 40 and an examination and search fee of EUR 350, remain very attractive.

Applicants seeking patent protection in three countries are likely to achieve their goal most efficiently with a classic European bundle patent. With an opt-out, they prevent the bundle patent from being destroyed in one fell swoop before the UPC, but by withdrawing the opt-out they still keep open the option of suing before the UPC themselves.

Once protection is sought in four or more countries, the Unitary Patent will usually be the least expensive option – which is confirmed by the fact that about 25 % of all European patents granted in June and July 2023 have been given, upon applicants' request, unitary effect.

Although the unitary patent cannot be removed from the jurisdiction of the UPC, it can be combined with a national patent, for example in Germany. An interesting filing strategy can therefore be to file a European and a German patent application in parallel. In the case of the German patent application, the filing of the request for examination can be waived for seven years, so that the applicant does not incur any costs during this time, apart from the filing fee and the (small) renewal fees.

> **Although the unitary patent cannot be removed from the jurisdiction of the UPC, it can be combined with a national patent.**

Especially when protection is sought in several countries, the Unitary Patent offers a cost-effective way (compared to the previous European bundle patent) to obtain patent protection in the territory of 300 million inhabitants. Thus, there is considerable hope and trust that the Unitary Patent system will also be a success internationally.

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# Technology transfer unlocked in Brazil: breakthroughs in know-how and patent licensing

**Bruna Valois and Stefany Kokkinovrachos of Vaz E Dias Advogados & Associados address the recent changes affecting technology transfer with 10 key points in favor of patent licensing agreements.**

The end of 2022 brought significant and highly anticipated changes that made the technology transfer environment in Brazil more flexible and less dependent on state authorizations. On 30 December 2022, Federal Law 14,286/2021 came into force one year after its publication, which revoked 14 federal laws and over 40 regulations regarding foreign exchange controls, making more flexible remuneration remittances overseas. In addition, Provisional Measure 1,152 of 28 December 2022 was published by the President of Brazil, and it was converted into a Federal Law by Law 14,596 of 15 June 2023, implementing the transfer price mechanism in Brazil, which directly affects licensees' ability to use the payment of royalties for tax deductibility purposes.

As a result of the new law coming into force, on 30 December 2022, the Brazilian Patent and Trademark Office (BPTO) published the minutes of an Internal Meeting held on 28 December 2022, convened by the institute's presidency, which, amongst addressing procedural recordation matters, recommended the acceptance of know-how licensing. Additionally, the BPTO sought to streamline and facilitate the procedure and formalities for the recordation of licensing agreements, aligning the new procedures with the demands of a modernized technology market. These recommendations were incorporated in the BPTO's Ordinances 26 and 27 of 11 July 2023, thereby revoking the previous Ordinances 70 and 199/2017.

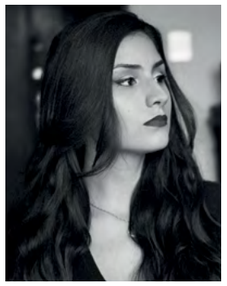
This article aims to briefly address the recent changes and for this purpose depicts 10 of the most relevant points that evidence the parties' freedom to contract in patent licensing agreements, the remaining required formalities and legal inconsistences applicable to such agreements.

> **"The benefit of adopting a bundle agreement is the fact that the licensor will be able to charge royalties from different rights but always in diverse times."**

## 1. Accelerating royalty remittances: removing unnecessary layers at the Central Bank and BPTO

Concerning the procedure and government approvals for licensing agreements, Law 14,286/2021 has phased out the requirement to register these agreements before the Brazilian Central Bank (BACEN) and recordation at the BPTO for a licensee to proceed with royalty remittances overseas to licensors. Therefore, licensees may now remit royalties at any commercial bank by evidencing the amount due for royalty payment and the withheld income tax. This new procedure significantly speeds up the operationalization and timeframe for remittances abroad since a layer of governmental approvals has been eliminated.

Notwithstanding, recordation of licensing agreements at the BPTO is still required under Articles 62 and 211 of the Industrial Property Law and specific taxation. Therefore, recordation is required for the following purposes: (i) effectiveness of the agreement before third parties, especially if licensor has granted exclusive rights and licensee is required to enforce in court such rights, or when the granted rights encompass licensee's ability to defend or join licensor in disputes involving the licensed patents or trademarks in courts against infringers; and (ii) qualify



Bruna Valois

Stefany Kokkinovrachos

licensee for tax deductions on the remitted amount to licensor, which is still mandatory until the end of 2023.

## 2. Empowering patent filing: if it is not protected in Brazil, you cannot license it

The filing of a patent application at the BPTO is a fundamental step to protect an invention, especially to secure exclusive rights, for commercial exploitation, and to prevent third parties from using, selling, or producing their creation without authorization.

It should be highlighted that the PCT filing of a patent application is a way to facilitate patent protection in various countries around the world through a centralized request submitted to the World Intellectual Property Organization (WIPO) and corresponding national phase entry. Thus, only the PCT filing does not directly secure the applicant a patent filing in Brazil. The applicant must proceed with the "national phase entry" and obtain a patent application number to consolidate the local filing.

Further to that, it is noteworthy that as of the publication of this article, the prevailing rules on remittances are that only patents duly granted are entitled to royalty remittances, although the exploitation of patent applications can generate royalties. Collection of royalties in patent applications, in this case, may involve the opening of an escrow account in Brazil where the collected amounts will be deposited until the licensed patents are duly granted, when remittances will be permitted. Thus, the general rule now is that payments abroad for the exploitation of patent applications are not permitted.

Given that the BPTO recently decided to allow collection and remittances of royalties abroad from trademark applications, such inconsistency raises concerns as there is no normative or legal justification for such a hindrance related to patent applications. This situation presents a discriminatory legal treatment towards patent applications, while also constituting an unwarranted interference in the contractual relationship between private parties.

When questioned, the BPTO stated that they had merely followed the decisions of the Internal Meeting held on 28 December 2022, wherein the possibility to extend payment of royalties for the exploitation of patent and industrial design applications was discussed, but not approved.

This matter deserves close monitoring, and we believe it is necessary to submit a formal request for the BPTO to reconsider such restrictive and outdated interpretations.

## 3. To infinity and beyond? Do not overextend your license

Article 2 of Ordinance 26/2023 establishes that the maximum contractual period of a patent license cannot exceed the period of the related patent protection. The duration of the patent protection is determined by the Industrial Property Law, which according to Article 40 will be 20 years as from the date of the patent filing in Brazil.

We should recall that the Supreme Court issued a decision on 6 May 2021, which declared unconstitutional the sole paragraph of Article 10 of the Industrial Property Law and therefore eliminated the 10-year minimum period from the date of patent grant. The effects of the Supreme Court's decision were already addressed in *The Patent Lawyer* publication,[1] but we briefly highlight that different rules apply to specific situations. For example, granted patents benefiting from the exceptional and revoked period of the Sole Paragraph of Art. 40 of the IP Law may be licensed to the last day of the maximum 10-year period of patent protection. New patent applications filed at the BPTO after 14 May 2021 and granted after the said date, the maximum patent validity and licensing will be 20 years from filing.

Moreover, bundle agreements comprising the licensing of patents, know-how, trademarks and the rendering of technical assistance to the licensee are accepted for recordation. The benefit of adopting a bundle agreement is the fact that the licensor will be able to charge royalties from different rights but always in diverse times. Therefore, matching the licensing with the industrial property rights is of the essence to prevent the overextension of the license.

## Résumés

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Bruna is an attorney-at-law and has specialized in international business transactions since 2014. She conducts the preparation and negotiations for commercial agreements in the technology sphere, especially in relation to matters such as technology transfer, licensing of industrial property rights, copyright agreements, merchandising, research and development, franchising, distribution, confidentiality agreements, and other agreements involving the exploitation of intellectual property rights.

**Stefany Kokkinovrachos, Associate at Vaz e Dias Advogados & Associados**

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## 4. Breaking barriers: flexible royalty rates between related parties

Another significant development in the technology transfer scenario that stems from Federal Law No. 14,286/2021 is the parties' freedom to set the royalty rates in cases where the foreign licensor and the local licensee hold a controlled-controlling relationship. Article 50 of Law 8,383/1991 formerly restricted the payable royalties to a foreign licensor on the fiscal deductibility ceilings stipulated by Ministerial Ordinance 436/1958, which ranged from 1% to 5% of the net revenue derived from the sales of the licensed product, contingent on the specific field of activity. For instance, patent licensing within the oil and gas industry would grant licensees the opportunity for deductions of the royalty remittances up to 5% of the net revenue. This amount was used as a maximum royalty charge for licensing of related companies.

This freedom for the parties to negotiate and determine royalty rates has successfully bridged the gap in treatment between agreements involving related and unrelated contracting parties, as the prevailing laws no longer impose limitations on setting royalties and remittances abroad when the parties are related. Accordingly, under the new ruling, the remuneration to a foreign licensor will no longer be bound by fiscal deductibility ceilings. Remuneration will be established on customary and prevailing market and industry prices, or through negotiations based on the parties' bargaining powers.

## 5. Transfer price is now a prevailing taxation rule

Federal Law 14,596 of 15 June 2023 determined the new transfer pricing rules that are aligned with the standards of the Organization for Economic Cooperation and Development (OECD) and adopted the "arm's length principle" for cross-border transactions involving related companies. The transfer pricing rules reach out to royalties and therefore the pricing for licensing technology between a parent and its subsidiary or affiliate company should be set as though they were not related. The prices commonly practiced in the international market should prevail and further to that the fiscal deductibility rules set out by Normative Ordinance 425 of 1958 that limit licensee's deductions from royalty will not be applicable.

Although the new transfer price ruling will be in effect from January 2024, foreign licensors may choose to adopt them from now on during their licensing relationship with their local subsidiary.

## 6. Know-how licensing is a reality

Know-how licensing is classified as a type of technology transfer agreement that permits unpatented technology to be exploited by a licensee. Up to Ordinance 26/2023, the BPTO adopted a very restrictive attitude for the recordation of these agreements since the agency understood that know-how did not generate a property right to the owner (licensor). Therefore, its disposal to a licensee meant the effective transfer of rights without the possible return of the know-how to the licensor after the contractual relationship ended. In practical terms, the BPTO demanded the elimination of covenants or wording that would demand the licensee to cease the use of the technology when termination derived from the licensor's fault. Further to that, recordation

**"Article 2 of Ordinance 26/2023 establishes that the maximum contractual period of a patent license cannot exceed the period of the related patent protection."**

[1] VAZ E DIAS, José Carlos. "A New Dress Code for Patent Validity in Brazil: the Practical Effects of the Supreme Court Decision". *The Patent Lawyer* – May/June 2021. Pages 24-29.

**“The transfer pricing rules reach out to royalties and therefore the pricing for licensing technology between a parent and its subsidiary or affiliate company should be set as though they were not related.”**

would be limited to a period of five years with a possible additional period of up to five years upon justification, which restricted royalty remittances. After this period, the technology would be regarded as fully and permanently transferred to the local licensee.

Such restrictions finally ended on 11 July 2023 with Article 2, Item III, letter A. of Normative Ordinance 26/2023, since the BPTO recognized the possibility of recording know-how licensing. The argument was grounded on the fact that such kind of licensing would be considered as a non-typical agreement dealt with adequately under Articles 104 and 425 of the Civil Code. Therefore, recordation of know-how licensing is fully accepted, which means that greater contractual period and clauses determining the licensee's obligation to cease the use of the know-how licensing with termination will be fully accepted if set by the contracting parties.

## 7. Trade secret is now secret in licensing

Under the new recordation ruling provided by Ordinances 26 and 27/2023, confidentiality clauses are fully accepted in licensing agreements with no restrictions. This is a particular relevant development in know-how licensing, since the BPTO did not accept clauses in the know-how licensing agreement that stipulated confidentiality for a period longer than five years as from the date of information disclosure or the agreement's termination.

In view of the new ruling, contractual clauses dealing with confidentiality issues are now accepted without time limitations insofar as the information is classified as a trade secret, prevailing the provisions of Items XI and XII of Article 195 of the Industrial Property Law. In this regard, it is always important to recall that trade secret demands in compliance with three essential requirements, as follows: (a) the information must have commercial value; (b) the information under protection must be new and confidential and (c) the holder of the information may evidence that it has taken measures to make the information secret, such as adopting confidentiality agreements.

## 8. Navigating the differences: technical assistance v. specialized professional technical services

Agreements of a technical assistance nature and those involving specialized technical services have significant differences, especially regarding their recordation at the BPTO that may be relevant for foreign investors. Technical assistance refers to agreements in which one company provides knowledge, technical support, or training to another company with the objective to effectively transfer knowledge. Therefore, these agreements necessarily involve the transfer of know-how, the disposal of complementing technology under a patent license through service rendering, or specific techniques to improve the production, operation, or performance of certain products or processes. As per Article 211 of the Industrial Property Law, technical assistance agreements are subject to recordation before the BTPO.

On the other hand, specialized professional technical services pertain to agreements in which a company or person provides highly specialized technical services or consulting to another company, without involving the disposal of technology, training, teaching, or know-how supply in general, even if the service is rendered with the purpose of enabling or facilitating the use of a patent or manufacturing process. Such services involve commercial agency and logistics services, preventive maintenance or repair services, refurbishment provided on equipment or machinery, supervision services for assembly or disassembly, and installation of equipment or machinery, broad consulting services, among others. They are enlisted by BPTO Resolution 156 of 9 November 2015 and therefore they are not subject to prior recordation at the BPTO, which further eases the possibility of remitting remuneration overseas for service rendering.

## 9. Recordation formalities: lessened but still required

Normative Ordinances 26 and 27/2023 set out the formalities that the contracting parties will need to comply with for the purpose of recording licensing agreements at the BPTO, as follows:

1) Patent licensing agreements need to be executed by the contracting parties, observing the peculiarity that digital signatures without certification provided by public and private organizations that assure the veracity of the signatures by public and private organizations (so-called ICP Brazil) are now accepted. To evidence the veracity of the digital signatures, the contracting parties are to provide an extract that detects and confirms that the signatures are really of those who sign the agreement.

2) Notarization of the signatures issued by a notary public and the Apostille under the Hague Convention are no longer requirements when adopting the digital signatures. However, these formalities are to be complied with when the signatures are placed by hand.

3) Execution of the agreement by two witnesses is no longer required when one of the parties is Brazilian and therefore the licensing agreement is executed in Brazilian territory. However, when the licensor and licensees are foreign parties and execution takes place outside Brazilian territory, the execution of the agreement by two witnesses is required.

4) The initials of the contracting parties on each page of the agreement were regarded as an unnecessary formality and therefore the requirement was revoked by Ordinances 26 and 27/2023.

## 10. Fostering innovation: embracing ownership of improvements in licensing agreements

The Industrial Property Law explicitly stipulates in its Article 63 that any improvements made to a licensed invention will be considered the property of the party who effectively conceived it. Therefore, if the licensee develops any improvements to the licensed invention, the ownership of those improvements will rest with the licensee, regardless of any contractual provision to the contrary. Consequently, Article 63 prevents the presumption that such improvements automatically belong to the licensor.

Nevertheless, article 63 opens the opportunity for the contracting parties to negotiate a grant-back clause and set the licensor's priority right to obtain a license to use any improvements or developments resulting from the licensee's use of the licensed patent. This clause may serve as an incentive for the parties to share knowledge and invest in further advancements. Therefore, the licensor and the licensee possess the liberty to determine the terms and conditions of the licensing agreement, provided that they adhere to the general principles of good faith and contractual balance, and do not violate any laws or regulations regarding the economic order and free competition.

## Concluding Comments

The recent novelties and subsequent regulatory adjustments have significantly transformed the landscape of patent licensing and technology transfer in Brazil, leading the way for a more flexible environment, making it easier for national companies to invest in foreign patent and technology transfer. Moreover, the new procedures provide various advantages and opportunities that foster a more efficient and open environment, encouraging collaborations, and embracing modern practices in patent licensing, technology transfer, and, consequently, innovation.

The ongoing evolution of these regulations will likely continue to attract investments and further establish Brazil as a destination for industrial property ventures.


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**“The licensor and the licensee possess the liberty to determine the terms and conditions of the licensing agreement, provided that they adhere to the general principles of good faith and contractual balance.”**

# What you need to know about China's punitive damage for patent infringement

**Lunwei Huang, Partner at Beijing Sanyou IP Agency Ltd., informs of the patent punitive damage system that has been introduced as part of the latest version of Chinese patent law and provides advice and guidance for patent practitioners.**

Punitive damage for patent infringement, which was introduced along with the new version of the Chinese patent law, is one of the latest developments of the intellectual property system of China.

Lunwei Huang

## History of China's punitive damage system

In the background of strengthening the protection of intellectual property rights, China has gradually established the punitive damage system for IP rights. As a timeline, in 2013, punitive damage


## Résumé

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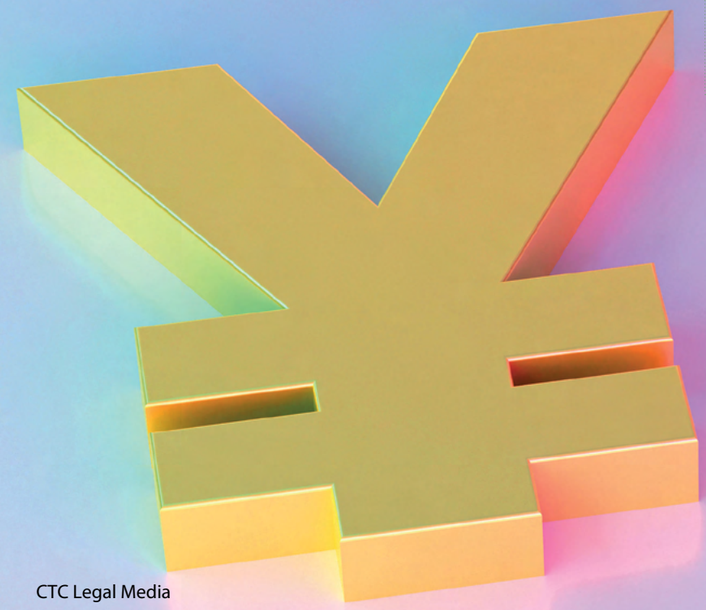

**"At last, punitive damage is introduced into the amended Patent Law, which came into effect as of June 1, 2021."**


**In principle, there are three ways to determine the base damage, which is the actual amount of losses suffered by the plaintiff, the amount of profits obtained by the defendant from infringement, and a multiple of licensing fees.**

for trademark infringement was first introduced into the Chinese Trademark Law, then the multiple of punitive damage was increased from "one to three times" to "one to five times" in the amended Trademark Law and the Anti Unfair Competition Law which were both issued in 2019. In the "Civil Code", which came into effect as of January 1, 2021, it is stipulated that "in case of intentional infringement of the intellectual property rights of others, and the circumstances are serious, the infringed party has the right to request corresponding punitive damages.". In March 2021, China's Supreme Court issued the Judicial Interpretations on Application of Punitive Damage in Litigation of Intellectual Property Right Infringements, which stipulates specifically the conditions for the application of punitive damage and methods for determining the amount of punitive damage. At last, punitive damage is introduced into the amended Patent Law and Copyright Law, which both came into effect as of June 1, 2021. Up to this point, China established a relatively comprehensive and complete punitive damage system for intellectual property.

Before June 1, 2021, on which the amended patent law came into force, China followed the so-called make-whole principle. Just as stipulated in the patent law before the amendment, "the amount of damage for patent infringement shall be determined based on the actual losses suffered by the patentee due to the infringement". The make-whole principle means that, theoretically the damage ruled by the court can cover the actual loss of the patent right holder caused by infringement, however in practice, it is often difficult to provide adequate evidence for determining the actual loss suffered by the right holder. As a result, a majority of China's patent infringement cases end up in statutory damage, which is determined by the judge at his discretion when the right holder fails to provide evidence for determining the loss suffered due to the infringement, the infringer's profit from the infringement, and the licensing fees of the patent right, and in many cases is significantly lower than the actual loss. Therefore, there was a long-standing outcry about patent infringement that the cost is too high for protecting one's patent right while is too low for the infringers.

The punitive damage system, along with other new features in the latest version of the Chinese Patent Law, bring changes to this situation.

## Conditions for the punitive damage to be applicable

Article 71 of the Chinese Patent Law is the legal basis of patent infringement damage, it reads:

> "The damage for infringement of patent rights shall be determined based on the actual losses suffered by the right holder due to the infringement or the benefits obtained by the infringer from the infringement; If it is difficult to determine the losses of the right holder or the benefits obtained by the infringer, it shall be reasonably determined by referring to a multiple of the patent licensing fee. For intentional infringement of patent rights, if the circumstance is serious, the damage may be determined between one and five times the amount determined according to the above method.
>
> If it is difficult to determine the losses of the right holder, the benefits obtained by the infringer, and the patent licensing fee, the court may determine a damage of not less than 30,000 yuan but not more than five million yuan based on factors such as the type of patent right, the nature and circumstances of the infringement.
>
> The damage should also include the reasonable expenses paid by the right holder to stop the infringement act."

According to Article 71 of the Chinese Patent Law and the Supreme Court's Judicial Interpretations, for the punitive damage to be applicable, two conditions need to be met: the infringement is intentional, and the circumstance is serious.

The Judicial Interpretations make it clear that to determine whether the infringement is intentional, factors such as the type of intellectual property, status of the IP right, popularity of the related product, and the relationship between the defendant and the plaintiff or interested parties need to be comprehensively considered. The Judicial Interpretations further lists, non-exhaustively, five specific scenarios that can be considered "intentional":

1. The defendant continues to conduct the infringement act after being notified or warned by the plaintiff or interested party;
2. The defendant or its legal representative or manager is the legal representative, manager, or actual controller of the plaintiff or interested party;
3. The defendant has such relationships with the plaintiff or interested party as labor, labor service, cooperation, licensing, distribution, agency, or representative, and has had access to the infringed intellectual property rights;
4. The defendant has business dealings with the plaintiff or interested party, or has conducted negotiations with the plaintiff or interested party to reach a contract, and has had access to the infringed intellectual property rights;
5. The defendant commits piracy or counterfeiting of registered trademarks.

Although the Judicial Interpretations are not dedicated to patent issues, the above-listed scenarios one-four are applicable to patent infringements.

While as to whether the circumstance is serious, the Judicial Interpretations specifies the factors to be comprehensively considered, such as the means and frequency of infringement, the duration, geographical scope, scale, consequences of the infringement, and the actions of the infringer in the litigation process. Further, the Judicial Interpretations lists, non-exhaustively, six scenarios that can be considered "serious":

1. The defendant conducts the same or similar infringement act again after being subjected to administrative penalty or court judgment for infringement;
2. The defendant commits infringements of intellectual property as a profession;
3. The defendant has behaviors of forgery, destruction, or concealment of evidence of infringement;
4. The defendant refuses to comply with a preservation ruling;
5. The profit gained from the infringement or loss suffered by the infringement is significant;
6. The infringement may endanger national security, public interests, or personal health.

**If it is anticipated that punitive damage is applicable, claim it when filing a lawsuit against the infringer.**

## Calculation of the amount of punitive damage

According to Article 71 of the Chinese Patent Law and the Judicial Interpretations, the amount of punitive damage is to be determined as a base damage multiplied by a multiple.

In principle, there are three ways to determine the base damage, which is the actual amount of losses suffered by the plaintiff, the amount of profits obtained by the defendant from infringement, and a multiple of licensing fees. The plaintiff may request the court to determine the base damage by adopting any one of these three ways as per their applicability. However, if all these three ways for determining the base damage are not applicable, the court may reject the plaintiff's request for punitive damage.

As a negative example, in a design patent infringement case judged by the Beijing IP court, the punitive damage requested by the plaintiff was rejected, as the plaintiff failed to submit any evidence of the actual loss suffered from the infringement, and the benefits obtained by the defendant from the infringement cannot be determined from the evidence on record, furthermore, the involved patent has no history of licensing.

The statutory damage cannot serve as a base for punitive damage. The theory is that the statutory damage is determined by comprehensively

considering many factors including intentionality and seriousness of the infringement, and therefore the statutory damage alone may have a punitive nature. In addition, the expenses incurred by the plaintiff for stopping the infringement acts cannot be included in the base damage.

Further, it is also stipulated that if the court orders the defendant to provide the account books and materials related to the infringement, but the defendant refuses to provide or provides fake account books and materials without justified reasons, the court can determine the base of the punitive damage by referring to the plaintiff's claims and evidence.

As to the multiple, it is to be determined by taking into account factors such as the level of the defendant's subjective fault and the seriousness of the infringing act.

## Examples of courts' rulings involving punitive damage

Since punitive damage was introduced into China's patent system, there has been an increasing number of court rulings involving punitive damage.

For example, in a design patent infringement case judged by Shenzhen intermediate court, the plaintiff and the defendant are both online store operators, and the plaintiff is the holder of a design patent. The plaintiff accused the defendant of infringing the design patent and has raised a number of complaints in the online mall, however, instead of stopping the infringement, the defendant continued selling the infringing goods by simply changing to other URLs, and this process lasted for more than three years. Based on these facts, the court determined that the infringement was intentional and the circumstance was serious, and ruled a punitive damage of two times.

In another patent infringement case, the plaintiff sued the defendant for two times. For the first lawsuit, the two sides reached a settlement which included stopping infringement and paying damage by the defendant, however, the defendant continued selling the infringing goods after the settlement, and then the plaintiff sued the defendant for the second time and requested punitive damage. In the first instance, the court did not rule on punitive damage, then the plaintiff appealed to the Supreme Court. In this case, the Supreme Court ruled punitive damage by reasoning that the infringer has reached a settlement to stop the infringement with the patent holder, but sells the same infringing product again; it can be determined that the infringement is intentional and the circumstance is serious, and thus punitive damage is applicable. In addition, the Supreme Court ruled that the amount of damage agreed in the earlier settlement can be taken as a base for the punitive damage.

> **The court won't rule punitive damage if the plaintiff does not request it.**

## Advice to patent practitioners

The punitive damage system is going to bring changes to the patent ecology of China, and accordingly, the patent practitioners need to get prepared for this punitive damage system.

For the patent right holder, more leverage may be gained from the punitive damage to deter potential infringements. To take advantage of the punitive damage, it is advisable to, before filing an infringement lawsuit against the infringer, collect evidence that can prove the intentionality and seriousness of the infringement, with reference to the standards introduced above.

If it is anticipated that punitive damage is applicable, claim it when filing a lawsuit against the infringer. Anyway, the court won't rule punitive damage if the plaintiff does not request it.

In addition, it is crucial to collect evidence and materials for determining the base damage, bearing in mind that only the actual amount of losses suffered by the plaintiff, the amount of profits obtained by the defendant from the infringement, and the licensing fees of the involved patent can be served as the base damage, excluding the statutory damage.

On the other hand, the defendant or anyone alleged of patent infringement needs to be wary of the punitive damage. For example, if an infringement warning letter is received from a patentee, it is advisable to conduct an infringement analysis in a timely manner, and, if the analysis indicates a rather high possibility of infringement, it is prudent to stop implementing the involved patent immediately to avoid an intentional infringement.

In addition, it is advisable to conduct an FTO search before launching a new technology. The FTO search helps to eliminate any risk of patent infringement, and, even if there are any patents missed in the FTO search, an FTO report furnished by a third party indicating the to-be-launched technology does not infringe any known patents is perfect evidence of non-intentionality of any potential infringements, and therefore avoiding the punitive damage.


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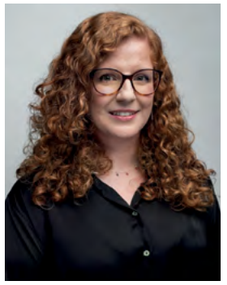
# Safeguarding traditional knowledge in Africa: legal and ethical challenges

**Marisol Cardoso, Patent Consultant at Inventa, details the available protection for traditional knowledge crucial for the preservation of cultural heritage and the promotion of fair and equitable use.**

Africa covers about one-fifth of the total land surface of the Earth and is home to a rich and diverse animal, plant, and marine biodiversity. Africa is also a land rich in cultural diversity and Traditional Knowledge (TK), i.e., the ancestral knowledge passed down from generation to generation.

TK can be found in several contexts, from agriculture to medicine and cosmetics. However, since this invaluable heritage holds promising opportunities, especially for biotechnological innovation, its preservation and recognition face legal and ethical challenges.



Marisol Cardoso


## Résumé

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## Legal framework:

Various African countries have implemented laws, regulations, and policies aimed at safeguarding TK, by covering aspects such as access to natural resources, fair and equitable use of knowledge, and participation of local communities in decision-making related to the exploitation of the knowledge.

**Intellectual property protection:**

Traditional knowledge and traditional cultural expressions are products of creative intellectual activity and therefore fall within the scope of intellectual property. Even though TK as such - knowledge that has ancient roots and is often oral - is not protected by conventional intellectual property (IP) systems, innovations based on TK can be protected as patents, utility models, trademarks, industrial designs, and geographical indications.

Patent protection covers products or processes that provide a new way of doing something, for example, new tools and techniques for hunting or agriculture. Distinctive Indigenous words, names, and symbols can be protected as trademarks. Industrial design rights can be used to protect handicrafts, such as jewelry, to textile and fabric designs. The geographical indication provides the holders of traditional knowledge with means to differentiate their product from a competitor by highlighting its link with the geographical area from which it comes.

African IP landscape encompasses two regional offices (the African Regional Intellectual Property Organization – ARIPO – and the African Intellectual Property Organization – OAPI), which provide practical ways to use the patent system and mitigate the burdensome acts and high costs of filing independent applications in a plurality of countries.

ARIPO is mandated under the Swakopmund Protocol on the Protection of Traditional Knowledge and Expression of Folklore to protect TK holders against any infringement of their rights and protect expressions of folklore against misappropriation, misuse, and unlawful exploitation. The Protocol has been in force since May 11, 2015, and has eight contracting states: Botswana, Malawi, Namibia, Rwanda, Gambia, Liberia, Zambia, and Zimbabwe.

Even though OAPI is committed to contributing to the promotion and protection of the expression of cultural and social values, there is no regulation or protocol in force today.

**Plant breeders' rights**

Many plant-based technologies justify the commercial interest in natural medicinal resources and associated traditional knowledge used in the development of new plant varieties.

Plant varieties can be protected by an alternative *sui generis* system called Plant Breeders Rights (PBR) or Plant Variety Rights (PVR), wherein the cultivar must be new, distinct, uniform, and stable. The rights are granted to the breeder and give them exclusive control over the propagating material (including seed, cuttings, divisions, tissue culture) and harvested material (cut flowers, fruit, foliage) of the new variety over a period of time.

However, not all African countries have a *sui generis* system designed to reflect the particularities of breeding, cultivation, and use of new varieties of plants. Currently, only Morocco, Tunisia, Egypt, South Africa, Kenya, Tanzania, and OAPI (with its 17 Member States from West and Central Africa) have joined the Union for the Protection of New Varieties of Plants (UPOV).

**Trade secret**

The concept of a trade secret is to protect confidential information (i.e., undisclosed knowledge) that would give a competitive advantage to a company, for example, a manufacturing technique or the components of a composition.

As regards traditional knowledge, the understanding is divided: while some people agree that the knowledge maintained within a community could be considered a trade secret, others argue that the secrecy requirement is not fulfilled once the information is disclosed amongst the individuals of such a community. Another point relies on the fact that, even though TK has cultural value, the information must have commercial value to be eligible for protection as a trade secret.

**International agreements:**

Various international agreements, such as the Convention on Biological Diversity (CBD) and the Nagoya Protocol, provide legal boundaries for the protection of traditional knowledge and access to genetic resources.

The CBD is a multilateral treaty that covers biodiversity at all levels (ecosystems, species, and genetic resources) and which aims to develop national strategies for the conservation and sustainable use of biological diversity. With 196 nations, the CBD has near universal participation among the countries of the United Nations.

> **Patent protection covers products or processes that provide a new way of doing something, for example, new tools and techniques for hunting or agriculture.**

The Nagoya Protocol is a supplementary agreement to the CBD and provides a transparent legal framework for the effective implementation of one of the three objectives of the CBD: the fair and equitable sharing of benefits arising out of the utilization of genetic resources.

## Ethical framework:

African ethical frameworks prioritize the idea that traditional knowledge belongs to the communities that have generated and nurtured it. This further involves acknowledging the spiritual, historical, and social significance of the traditional practices, ensuring they are treated with sensitivity and respect.

Due to this fact, decisions about the use, sharing, and management of TK should be made collectively by the community and any commercialization or utilization must lead to tangible benefits for the communities that contributed to the knowledge.

Obtaining informed consent from the indigenous communities before using their TK is a central issue to be addressed. Such a measure ensures that the communities are aware of how their knowledge will be used, and they have the right to approve or reject such usage.

In the same way, collaborative research involving indigenous communities is encouraged. Incorporating indigenous perspectives can foster mutual learning and, at the same time, guarantees that research and documentation of traditional knowledge are done in consultation with and approval from the community.

The pursuit of harmonious collaboration between researchers, governments, and local communities is a way to make it possible for TK holders to receive fair recognition for their contributions to humanity's scientific and cultural heritage. The objective is not related solely to the protection

itself, but also to ensuring that no commercial use is carried out without prior consent and fair benefit-sharing.

**TK databases**

The importance of preserving traditional knowledge for future generations involves strategies to document, protect, and pass on the information. Some African countries have created registries and databases where the communities can register their Traditional Knowledge and medicines. In this way, documented evidence of the ownership and existence of this knowledge is established.

The National Indigenous Knowledge Management System (NIKMAS[1]), for example, is responsible for the recording, storing, management, and dissemination of Indigenous Knowledge (IK) and related information in South Africa. Up to the moment, the system has registered 33 communities and over 2400 IK holders.

The Ghanaian Indigenous Knowledge of Medicinal Plants[2] aims to identify, capture, document, and digitize indigenous knowledge, on forest foods and medicinal plants. The project, which aims to preserve IK information and explore its importance in livelihood and socio-economic development in Ghana, embraced nine communities.

At a regional level, the PROTAbase[3] is a repository of around 7,000 useful plants in tropical Africa. It details their scientific and vernacular names, geographical distribution, properties, and uses, including diagrams and images.

## Other issues to address:

**Cultural appropriation**

The traditional knowledge is subject to cultural appropriation when members of a majority group adopt cultural elements of a minority group in an exploitative, disrespectful, or stereotypical way.

The African traditional knowledge represents a living repository of centuries-old wisdom, acquired through intimate relationships with the land, biodiversity, and ancestral practices. Cultural appropriation from such TK allows mass-produced products to flood the market and compete with products that were legitimately produced by such communities, which are "prevented" from commercializing their culture in their own ways and for the benefit of their own families.

**Plant varieties can be protected by an alternative *sui generis* system called Plant Breeders Rights (PBR) or Plant Variety Rights (PVR).**

**Exploitation and biopiracy**

Biopiracy, the unauthorized appropriation of traditional knowledge and genetic resources of farming and indigenous communities, continues to be a significant threat.

Apart from the effects on biodiversity (such as the extinction of existing species and deforestation of the wildlife), the biopiracy undermines the rights of local communities due to the gaining of exclusive monopoly control through patents or intellectual property by an external entity.

Thus, strengthening patent examination procedures to prevent the grant of unjustified patents based on existing traditional knowledge is essential.

## Conclusions:

The protection of the traditional knowledge derived from African ancestral wisdom is crucial not only for the preservation of cultural heritage but also for the promotion of fair and equitable use, as well as sustainable development.

Developing robust and enforceable legal frameworks, construed with ethical principles, requires establishing *sui generis* systems or adapting existing laws to accommodate the unique features of TK.

By respecting the rights of local communities and fostering collaboration, this legacy will continue to thrive and contribute to the well-being of people not only in Africa, but all over the world.


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# Overview of intellectual property, contractual, and statutory frameworks for protecting data assets in view of artificial intelligence applications

**Kevin Post, Kevin Angle, and Shong Yin of Ropes & Gray review the available forms of protection for data assets, considering benefits and limitations with specific attention to AI.**

Data's value has been increasing as ever larger data sets are required to train large language models used in machine learning (ML) and artificial intelligence (AI). For example, OpenAI's GPT-3 model was trained on 45 terabytes of data.[1]

Recognizing this value, several online platforms have implemented technical and legal measures to protect their data. In early 2023, Reddit updated its terms of service to preclude "training a machine learning or AI model."[2] Twitter has limited the number of posts accessible by users to 2,400/day to limit server "strain" and reduce harvesting of its data.[3]

This paper examines various frameworks for protecting data against this backdrop of competing interests. For discussions herein, data sets are generally classified into: (a) public data (e.g., publicly accessible from a website); and (b) restricted data (e.g., restricted behind credentialed portals or by agreement).

## Intellectual property rights

A first category of protection for data is derived from intellectual property rights, namely copyright and trade secrets.

> **To be protectable under copyright, data must reflect some modicum of creativity.**

### Copyright

Copyright protects creative expression and allows a proprietor to control the reproduction, distribution, and preparation of derivative works. A data proprietor may assert copyright infringement to curb unauthorized uses of individual data records and compilations of data in both public data and restricted data. However, the data proprietor must have sufficient rights in the data to have standing to assert copyright infringement and must show that the data is protectable by copyright.

To be protectable under copyright, data must reflect some modicum of creativity. Purely functional or factual data records (such as experimental data) are less likely to be protectable by copyright. On the other hand, user-generated content, alone as individual records or combined and made accessible as a compilation through an online platform, may reflect the minimum needed creativity.[4] Even if the platform proprietor wants to use copyright to restrict the copying of user-generated content from its platform, it may do so only if the users, with whom the copyright initially vests, have assigned sufficient rights to the platform proprietor to do so.[5]

### Trade secrets

Trade secrets generally protect information that has independent economic value derived from its secret status. Trade secrets are often intertwined with contractual confidentiality obligations with an alleged misappropriating party. As such, trade secrets are often actionable only against a party that is in contractual privity with the data proprietor.

Trade secret protection may be asserted over restricted data that is already subject to confidentiality provisions, both as individual records or as a compilation. On the other hand, trade secret protection is less likely to apply to indi-vidual records of public data, which are typically made accessible through online platforms. But a database of records of public data may be protected by trade secret, even if individual records are not.[6]

For example, a court noted that "taking enough of [the database's information] must amount to misappropriation of the underlying secret at some point," and distinguished between "implicit permission to access as many quotes as humanly possible" from "collect[ing] more quotes than any human practically could" by a robot.[7]

Even if a database of records may be protectable by trade secret, a proprietor must demonstrate that reasonable steps were taken to protect the confidentiality of the database. For example, a database was not subject to trade secret protection where the contents of the database had been previously distributed 2,500 times in printed form with insufficient restrictions.[8]

## Contractual protections

A second category of protection for data is derived from contract law. Access to data, whether through online platforms or commercial engagements, is governed by agreements between the data proprietor and the data user. These are often deployed on online platforms as terms of use agreements, acknowledged during an enrollment process. Data proprietors may assert breach of contact claims based on alleged violations of restrictive covenants in these agreements.

Success of such assertions varies widely depending on the terms of the agreement, and the manner by which the agreement was allegedly assented. For example, click-wrap agreements are more likely to be enforceable due to affirmative assent and notice, compared to shrink-wrap or browse-wrap agreements. Courts have determined that contractual restrictions against copying of data from a website for commercial purposes are enforceable where a user sufficiently assented to the terms.[9]

Contracts can be customized between parties and therefore may specify restrictions that are not fully captured within intellectual property rights discussed above. For example, a data proprietor

## Résumés

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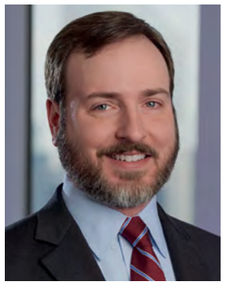

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may rely upon contracts to assert a breach of a restriction against copying in cases where the data proprietor may not have sufficient rights to user-generated content to assert copyright infringement.[10]

However, because contracts are customizable, they should be carefully tailored to preserve rights and remedies. For example, broad mutual limitation of liability provisions would limit a data proprietor's recovery of monetary damages.[11]

Data proprietors may tailor provisions to avoid having to elect among different causes of action. For example, courts have determined that breach of contract claims are not pre-empted by copyright infringement actions, where the breach of contract claims include an additional element that prohibited certain acts in copying and reproduction beyond what were governed by copyright law.[12]

### Anti-hacking statutes and common law trespass

A third category of protection for data arises from anti-hacking statutory rights and common law trespass rights. Anti-hacking statutes are intended to protect computer systems from unauthorized access. The relevant federal statute is the Computer Fraud and Abuse Act (CFAA), accompanied by several state statutes including the California Comprehensive Computer Data Access and Fraud Act (CDAFA), Florida Computer Abuse and Data Recovery Act (CADRA), and the Virginia Computer Crimes Act (VCCA).

The CFAA precludes access to a protected computer in a way that "exceeds authorized access," or "without authorization." However, the scope of these protections has been limited through a series of court decisions. In 2021, the US Supreme Court curtailed the scope of "exceeds authorized access"[13] by determining that violations of contractual restrictions were not actionable under "exceeds authorized access." In 2022, the Ninth Circuit determined that the CFAA likely would not prohibit the access of public data, though it left open the possibility that the CFAA could prohibit improper access to restricted data.[14] The recoverable remedy under the CFAA has also been limited to costs of investigation, to preclude recovery of consequential harms such as misappropriation of data as a result of the improper access.

State anti-hacking statutes, in contrast to the CFAA, may provide additional remedies in addition to the CFAA's recoverable costs of investigation, and may also include additional elements against unauthorized data users. For example, one court has determined that an alleged violation of the state anti-hacking statute was still actionable, even while dismissing an alleged violation of the CFAA.[15] However, because the statutes vary by state, personal jurisdictional concerns over alleged unauthorized uses would need to be investigated.

Common law trespass has also been asserted by data proprietors against alleged unauthorized users. However, courts have analyzed these trespass theories using a similar framework as the anti-hacking statutes. For example, courts have declined to find violations of trespass where there was no actual harm to underlying computer systems, regardless of whether public data[16] or restricted data[17] was in dispute. The courts have also distinguished between the harms of trespass, compared to other common law claims such as conversion.[18]

### Data protection frameworks require tailoring

A summary of the various data protection frameworks and associated tradeoffs is provided in the table below. The strategy for data protection and assessment of risks will likely be tailored to the specific context of the data

| | *IP-copyright* | *IP-trade secret* | *Contract* | *CFAA* | *State Law Anti-Hacking* | *Common Law Trespass* |
|---|---|---|---|---|---|---|
| Public Data | Y | N | Y | N | Varies | N |
| Restricted Data | Y | Y | Y | Y | Y | Y |
| Data Record | Varies by data type | Varies by data type | Y | Y | Y | Y |
| Database | Y | Y | Y | Y | Y | Y |
| Contractal Privity | N | Y | Y | N | N | N |


proprietor or data user.

For example, if the data proprietor is seeking to protect public data, the proprietor may opt for protection based on copyright and contractual restrictions, rather than trade secrets. If the proprietor is seeking to protect public data against users without contractual agreements in place, it may elect to do so primarily based on copyright, but after ensuring that it has sufficient rights to the disputed data.

The contours of these various frameworks have been reflected in past and pending disputes. For example, in the *hiQ v LinkedIn* dispute, LinkedIn had sought to stop hiQ from copying public and restricted user profiles from LinkedIn's site. Although a series of decisions determined that hiQ's acts were not violations of the CFAA, the court ultimately determined that hiQ's activity could be breaches of contract, unless defenses of estoppel applied.[19]

Recent litigation around data rights in the context of artificial intelligence platforms also demonstrates the recognition of data's value and risks arising from the various data protection frameworks. One class action has relied upon contractual obligations to allege that OpenAI, the company that developed ChatGPT, breached terms and conditions of open-source software from a GitHub repository that was used to train ChatGPT.[20] Another class action against OpenAI has asserted copyright infringement based on alleged unauthorized creation of derivative works by ChatGPT from training data that allegedly included original works of the plaintiffs' class of authors.

Moving forward, data protection strategies and assessments of data risks will require careful consideration of various frameworks tailored to relevant contexts and use cases.

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1 Brown, Tom, et al. "Language models are few-shot learners." available online from https://arxiv.org/abs/2005.14165.

2 *See* Reddit Data API Terms last Revised April 18, 2023 available online at http://web.archive.org/web/20230418234231/https://www.redditinc.com/policies/data-api-terms, at Sections 2.4 User Content, 3.2 Restrictions ("You must not … train a machine learning or AI model without the express permission of rightsholders in the applicable User Content").

3 *See* "About Twitter limits" available online at http://web.archive.org/web/20230401055003/help.twitter.com/en/rules-and-policies/twitter-limits.

4 *Craigslist Inc. v. 3Taps Inc*, 942 F. Supp. 2d 962 (2013) (Craigslist, a proprietor of a platform that provided user-generated advertisements, sought to restrict competitors from copying the advertisements from Craigslist's platform to repost on the competitor's sites for commercial use. The court determined that there was sufficient creativity in the individual user-generated postings, and the compilation user postings as reflected by its organization of records, to have copyright protection.).

5 *But see id.* (the court also determined that Craigslist's terms of use were insufficient to confer rights from the users to Craigslist to provide standing to assert copyright infringement over certain advertisements.).

6 *Compulife Software, Inc v. Newman*, 959 F.3d 1288, 1314 (11th Cir. 2020).

7 *Id.*

8 *Events Media Network, Inc. v. Weather Channel Interactive, Inc.*, No. CIV. 13-03 RBK/AMD, 2015 WL 457047, at *10 (D.N.J. Feb. 3, 2015).

9 *See Chegg, Inc. v. Doe, No.* 22-CV-07326-CRB, 2023 WL 4315540, at *4 (N.D. Cal. July 3, 2023) (Defendant "likely breached Chegg's terms, resulting in damage to Chegg."); *see also Sw. Airlines Co. v. Kiwi.com, Inc.*, No. 3:21-CV-00098-E, 2021 WL 4476799, (N.D. Tex. Sept. 30, 2021) (determining that Defendant had knowledge of and assented to contractual terms in multiple ways, including by agreeing to plaintiff's terms when purchasing tickets from plaintiff's website).

10 *See hiQ Labs, Inc. v. LinkedIn Corp.*, No. 17-CV-03301-EMC, 2022 WL 18399982, at *8 (N.D. Cal. Nov. 4, 2022) (determining that "hiQ breached LinkedIn's User Agreement both through its own scraping of LinkedIn's site" but declining summary judgment due to disputes over legal defenses).

11 *Events Media Network, Inc. v. Weather Channel Interactive, Inc.*, No. CIV. 13-03 RBK/AMD, 2015 WL 457047, at *14 (D.N.J. Feb. 3, 2015).

12 *Bold Ltd. v. Rocket Resume, Inc.*, No. 22-cv-01045-BLF (N.D. Cal. June 22, 2023).

13 *Van Buren v United States* 141 S. Ct. 1648 (2021).

14 *hiQ Labs, Inc. v. LinkedIn Corp.*, 31 F.4th 1180 (9th Cir. 2022); *see also Convoyant LLC v. DeepThink LLC*, 2021 WL 5810638 (W.D. Wash. 2021) (granting summary judgment of no violation of public data, denying summary judgment of no violation of private data).

15 *See Carfax, Inc. v. Accu-Trade*, 2022 WL 6 57976 (E.D. Virginia 2022).

16 *See Am. Airlines, Inc. v. Red Ventures LLC*, 4:22-cv-0044-P (N.D. Tex. July 15, 2022) ("more recent cases acknowledge that intangible property is not contemplated by Texas common law trespass claims").

17 *See Iacovacci v. Brevet Holdings, LLC*, No. 1:18-CV-08048-MKV, 2023 WL 2631966, at *9 (S.D.N.Y. Mar. 24, 2023) (Trespass to chattels "does not encompass an electronic communication that neither damages the recipient computer system nor impairs its functioning."); *InfoTek Corp. v. Preston*, 626 F. Supp. 3d 885, 895 (D. Md. 2022) (defendant's intrusion did not impair plaintiff's system, deprive plaintiff from accessing their own system or any other part of plaintiff's network; or "diminish the value of plaintiff's possessory interest in its computer network).

18 *See Pragad v. Davis*, 2023 N.Y. Slip Op. 31209 (N.Y. Sup. Ct. 2023) ("'trespass to chattels' often include[s] interference that causes damage to computer systems or involves the sending of unsolicited content."; court found acts instead gave rise to misappropriation).

19 *hiQ Labs, Inc. v. LinkedIn Corp.*, No. 17-CV-03301-EMC, 2022 WL 18399982, at *8, 10 (N.D. Cal. Nov. 4, 2022).

20 *Doe v. Github, Inc. et al*, Lead Case No. 4:22-cv-06823-JST (N.D. Cal.).

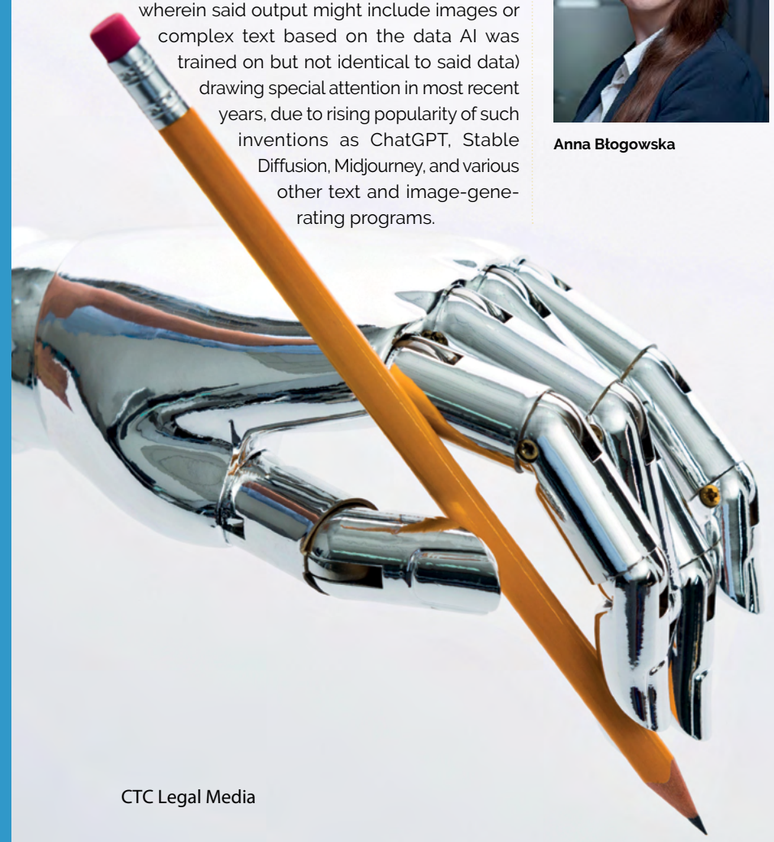
21 *Sarah Silverman et al v. OpenAI, Inc.*, Case No. 3:23-cv-03416 (N.D. Cal.).

# Filing generative artificial intelligence patent applications at the European Patent Office

**Anna Błogowska, Junior Patent Specialist at Patpol Kancelaria Patentowa, discusses pointers for the patentability of generative AI in light of the recent boom while assessing the applicability of current EPO Guidelines.**

The rapid development of Artificial Intelligence of different types can be easily observed and has been heavily covered by different media, with generative AI (namely an AI that is able to generate, on its own, i.e., unassisted by a human user beyond initial parameters, an output, wherein said output might include images or complex text based on the data AI was trained on but not identical to said data) drawing special attention in most recent years, due to rising popularity of such inventions as ChatGPT, Stable Diffusion, Midjourney, and various other text and image-generating programs.

Anna Błogowska



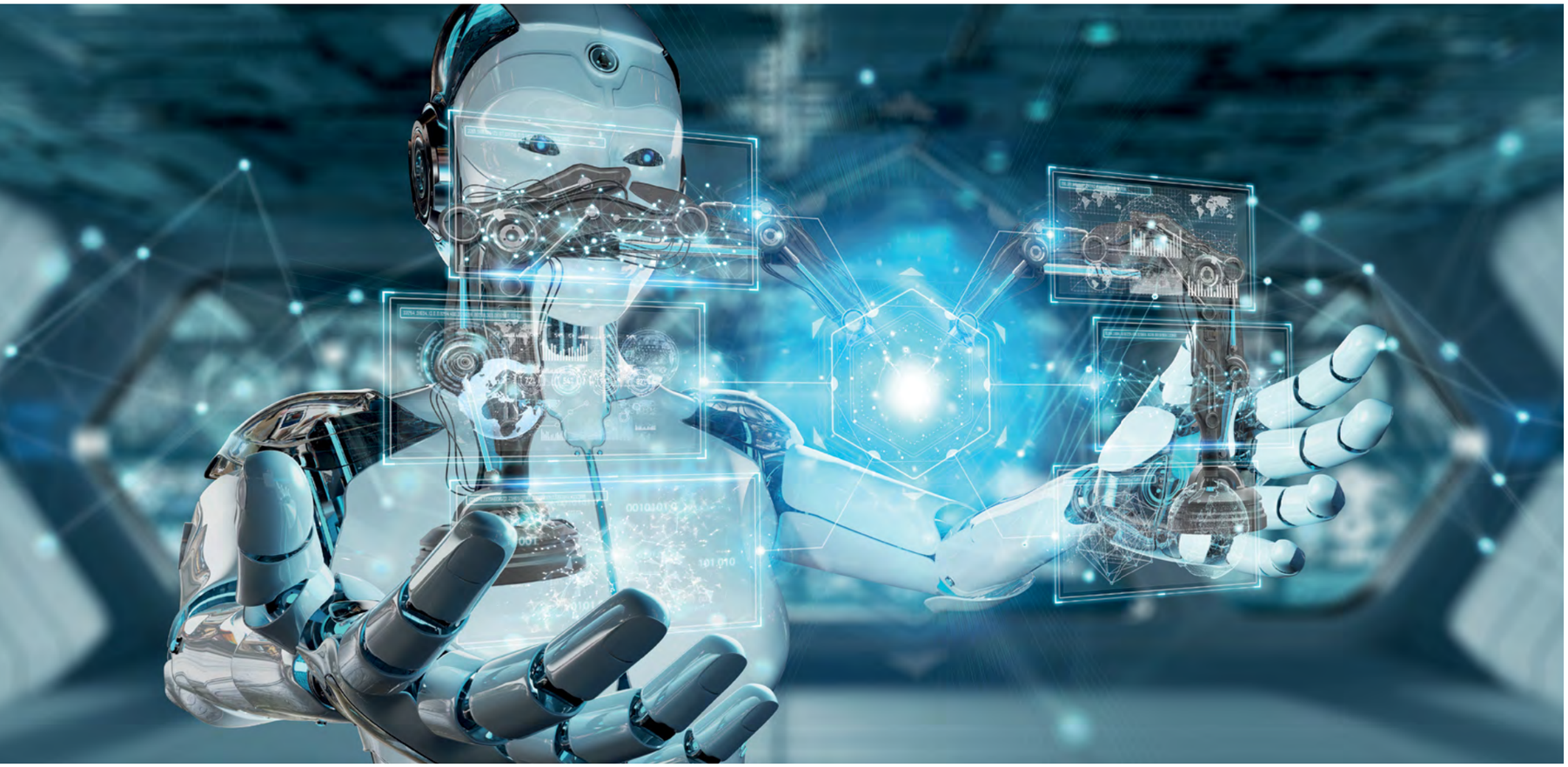
The patent landscape clearly reflects these developments. According to the World Intellectual Property Office's (WIPO) statistic presented in one of the documents from the 6th session of *WIPO Conversation on IP and Frontier Technologies*, the last six years marked an increase of over 700% in AI-related patent applications submitted.

This increase in AI implementation across all industries is being followed by European law regulations, as the European Patent Office (EPO) Guidelines for Examination (further referred to as EPO Guidelines or Guidelines) update from 2022 noticeably modified the Mathematical Models-related section. The European Union is in the process of creating legislation for its member states, with the Artificial Intelligence Act (the AI Act) having been voted in by the European Parliament just last June and now proceeding to a further stage, with the aim of reaching the final form of the proposed law by the end of this year.

The AI Act concerns itself mainly with ensuring that AI technologies will be implemented safely and with respect to fundamental human rights,

## Résumé

**Anna Błogowska** is a Junior Patent Specialist for Patpol Kancelaria Patentowa, with her work focusing on the fields of Electrical and Power Engineering and Telecommunication technologies. She conducts patent and prior art searches and validation filings before the PPO and assists Patent Attorneys with preparing and filing of patent applications.



so its focus is obviously different from the intellectual property laws. The Act explicitly mentions the generative AI, mentioning training of the models and training data, with broader mention of generated content.

The EPO Guidelines parts dedicated to the Computer Implemented Inventions (CII) (Part F-IV 3.9) (as a number of AI-related inventions would be considered a CII invention by the EPO) and dedicated to the mathematical methods (Part G-II 3) do not mention generative AI by name, but it should be clear, that the generative AI falls within the scope of solutions mentioned within those parts. All kinds of AI applications are being filed with the EPO and are being considered in relation to the CII or mathematical model part of EPO Guidelines. The more notable cases in the past include the DABUS case, in which the EPO refused to consider generative AI as the inventor, and the examination of the application EP 03793825.5, which prompted the G1/19 decision, where analysis of the use of AI tools for simulations was the point of contention (albeit the G1/19 precedes the 2022 update and was the reason for some of the changes). However, there

> **All kinds of AI applications are being filed with the EPO and are being considered in relation to the CII or mathematical model part of EPO Guidelines.**

are no Guideline sections where the generative AI is explicitly mentioned, although the term is being used in EPO's Board of Appeals decisions.

So how can one strategize when preparing an AI-implementing European Patent Application, especially one that focuses on AI generative properties?

While an abstract AI algorithm itself cannot be patented, as it falls under Article 52(2)(a) of the European Patent Convention, which excludes abstract mathematical methods from patentability, it can be considered a part of the invention if certain conditions are met, for example when there are other elements, devices or steps included in the scope of protection of the invention.

Simply pairing an AI algorithm with a computing device and achieving "further technical effect" by this pairing would satisfy the requirement of technical character of the invention, therefore satisfying the requirement of patentability. Even so, it is the examination of the invention in terms of novelty and inventive step that is the real obstacle in obtaining an AI-related patent. While for novelty, evidencing that there are no identical solutions known in the relevant state of the art might be easier to achieve, the inventive step is harder to prove.

Only features possessing technical character can contribute towards inventive step, but the non-technical features are also considered if they contribute towards the technical effect. The AI-related features, to be examined for inventive step, just as any other features in the claims, should contribute towards technical effect. There are several approaches to consider when assessing technical character and technical effect of the invention. As mentioned above, it is possible to pair the algorithm with the device which provides further technical effect, but other approaches are possible:

- Application – the AI algorithm is used in a way that contributes to the technical process, such as piloting or monitoring. However, it is important, that the feature is described in a specific manner, for example pointing out the goal of the operation, as a description too general might result in insufficient disclosure or disregarding it as having concrete technical character;
- Implementation – the AI algorithm is purposefully designed for specific implementations, such as the classification of received data, and said classification step (its results) is further used in the technical process;
- Interaction with the real world – the effect of the algorithm work interacts with the real world by providing results that could be considered as technical.

> **The AI Act concerns itself mainly with ensuring that AI technologies will be implemented safely and with respect to fundamental human rights, so its focus is obviously different from the intellectual property laws.**

The analysis of Board of Appeals decisions concerning AI shows that a significant amount of the decisions issued in recent years refused grant of the patent based on a lack of inventive step.

With inventions employing generative AI models, the issues of novelty and inventive step are even more complicated than with standard AI; the model learns on known data, similarly to traditional AI but the whole idea behind these models has the goal of limiting human user input required to receive desired output in mind, with any inventive process usually being executed in previous steps of the model.

There are different aspects to keep in mind at the stage of drafting claims for the invention that uses generative AI that can maximize chances of success, such as including information regarding data processing or training methods used by the AI, and evidencing in the description (or later during examination stage, if necessary) that either processing of said data by the model or training of the model is inventive. Proving that the generated content on its own is inventive would pose a bigger challenge and could open the invention to the questions regarding technical effects of the invention, so the above-mentioned implementation approach, where the output would be further used in technological process and proving that this process is inventive, would work better.

No matter the approach chosen by the Applicant, current Guidelines provide a framework that can be used when preparing patent applications relating to inventions using generative AI. Therefore, assuming that the proper requirements are met, it is possible to obtain the desired protection.

Nevertheless, with the recent focus on generative AI in general and in the context of Intellectual Property - the upcoming September WIPO session of *Conversation* will concern Generative AI and IP and China recently announced implementation of *Interim Measures for the Administration of Generative Artificial Intelligence Services*; one might wonder if the 2024 update to the EPO Guidelines will comprise changes targeted at generative AI or will the current EPO Guidelines be considered as sufficient framework in this rapidly changing field.

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# Potatoes - that's all you need!

**Maria Zamkova, CEO at Fenix Legal, details the weird and wonderful uses and inventions born from the humble potato in advance of Sweden's annual Potato Day.**

Maria Zamkova

On October 26, when the potatoes are freshly harvested, the yearly traditional Potato Day is celebrated in Sweden. It is organized by the Potato Academy in connection with the Potato Industry Foundation.

The academy's motto is "For the potato in time". So, what is so special about potatoes?

The potato, originating in the Bolivian-Peruvian Andes region around 10,000 years ago (according to Wikipedia), arrived in Europe, via Spain and the British Isles, by the end of the 16th century. Today, it is the world's fourth most important food crop, according to the CABI Digital Library.

In Sweden, the potato was first mentioned in print in 1658, when the botanist and professor of medicine Olof Rudbeck (1630–1702) published a Latin text listing the plants in Uppsala University's botanical garden, which he had recently founded, with "botanical plants" brought from the Netherlands. Rudbeck classified the plant, *Solanum tuberosum*, as both an ornamental and edible plant.

However, this plant is useful for so much more than just food. Some practical examples found when searching on the Internet:

> **However, this plant is useful for so much more than just food.**

- Fertilize plants: just make a hole in a large potato and pop a geranium stem inside and the potato will help the plant get off to a great start, whether independent of where it is planted;

- Soothe burns: apply a slice of raw potato in a compress to help relieve a minor burn;

- Remove rust: cut a potato in half, dip the cut side in baking soda and then rub the baking soda-covered side against the rust spot;

- Avoid fogging up the bathroom mirror: Cut a potato in half, rub the cut surface against the mirror and let the juice dry thoroughly before showering.

- Potato face mask: puree some raw potato with water to form a paste, then spread over your face. Leave for around half an hour, then rinse off thoroughly.

- Remove broken light bulbs: Cut a potato in half, then press gently onto the remaining glass and carefully unscrew.

- Stop ice forming on windshields and glass cold frames: just rub a potato on the glass during winter.

- Reduce puffy eyes: a perfect alternative to the traditional cucumbers – put slices of raw potato around the eyes.

- Soothe itchy skin: apply sliced raw potato under a compress until the itchiness is relieved.

- Stamps: halve a potato, pat the cut ends dry, press your chosen cutter into the cut end of one of the potato halves, remove the cutter from the potato – You have a stamp

- Soothe a headache: try massaging your temples with slices of raw potato.

(Sources: netto.se, ruralsprout.com, cookist.com, bbcgoodfoood.com, etc)

Well, while many of the abovementioned examples are old traditional folk uses, which are not always fully scientifically tested (but work well in practice), and not patent protected, there is a lot of intellectual property protection where potatoes are the main (or at least important) ingredient.

Some examples (around 600) are listed at JUSTIA Patents (patents.justia.com), and a search in the Swedish PTO's database gives close to 4,300 examples of patents associated with potato biotechnology or other technical solutions related to potatoes.

> **The Swedish PTO's database gives close to 4,300 examples of patents associated with potato biotechnology or other technical solutions related to potatoes.**

## Potato-based vodka

As noted, potatoes came to Sweden in the 17th century, but were initially not much appreciated as food, other than for livestock and poor farmers. That changed in 1746 when Countess Eva Ekeblad invented potato flour (to be used for makeup) and a productive way to make potato-based vodka ("brännvin"). She wrote to the Swedish Royal Academy of Sciences and presented her inventions, which resulted in her being elected two years later – at the age of 24 – as the first female member of the Academy.

Her inventions were very important: when the spirit was now made from potatoes, the traditional grain could instead be used for more general useful things, like bread. And using potatoes as an arsenic-free powder became very popular at a time when powdering the face and wig was a necessary part of the daily dressing routine for both men and women from the upper class.

It is rumored that Mrs Ekeblad decorated her wig with potato flowers, thereby also showing the possible use of potatoes in the fashion industry of the future.

Today, Swedish vodka is back to being made with traditional grain (rye, wheat, barley), like the internationally famous vodka ABSOLUT. Potato is more common in Norway and Poland. However, there is a new local Swedish vodka made of 100% Swedish potatoes, from Bergslagens Destilleri. The trademark is, of course: GOLDEN POTATO.

Potato-based inventions are continuously seeing the daylight in today's Sweden.

## Potato-based vaccine

In 2004, at the University of Uppsala, Sweden, the researcher Niclas Rydell doctorate on the development of a new, drinkable vaccine against diphtheria ("Development of a New Oral Vaccine against Diphtheria and the Study of its Immunogenicity in Mouse and Man", ISBN 91-554-6069-0). Diphtheria is a bacterial disease that spreads in much the same way as the common flu, that is, through mucous membranes in the mouth and nose. The disease is serious and often leads to death. The best protection is preventive vaccination. But today's diphtheria vaccine must be injected. A potable vaccine would make mass vaccinations easier and less expensive, and at the same time provide better protection against the disease. Rydell's solution is based on a genetically modified variant of the traditional bacterial toxin. The


## Résumé

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substance is 99% identical to the original bacterial poison, but without the toxic effect. It has then been linked to porous microparticles of starch. The particles make the response from the body's immune system stronger and the protection better, at least as long as the vaccine is tested on mice. When tested on healthy human volunteers, the protective effect disappeared, likely – according to Rydell – because the starch particles break down in the digestive system. The idea is however still alive, and modified versions are being tested.

## "Potato Plastic"

In 2018, the Swedish industrial designer Pontus Törnqvist, was the Sweden National winner of the James Dyson Award for his "Potato Plastic". The fast-food industry consumes massive volumes of single-use plastic every year – and researchers calculate it often takes 450 years for plastic to decompose after serving human needs for an average of just 20 minutes. In Sweden, around 40% of plastic packaging is recycled. This means that 60%, or 98,550 tonnes, is still not taken care of. Much ends up in the oceans and causes great damage. At the same time, the plastic that is incinerated contributes to greenhouse gases and global warming. There is indeed a need for alternative solutions. Törnqvist developed a material that is similar to plastic but consists of potato starch and water. With the help of heat, a thick liquid is created that can be placed in molds. Through further heating, the material takes on a malleable solid form. The material is perfect for use in disposable items that do not require a long service life, such as eating utensils, condiment bags, and to replace plastic straws.

"My aim with this project was that we should question the way that we are using and producing plastic, and therefore illustrate an example of a material that could work as a substitute material for it. This material is made of what comes from our earth, and it can later on just as well end up in the soil without any risks to nature," said Törnqvist when he received the award.

## Potato-based ice cream

One of the most recent examples of potato-based inventions is the company Veg of Lund AB's Swedish patent (SE 2250375-9) for a vegetable ice cream, based on a combination of potatoes, rapeseed oil, and a vegetable protein in the form of a frozen emulsion.

Professor Eva Tornberg, founder of Veg of Lund, said in a press release,"The fact it is based on such an everyday crop as potatoes shows the uniqueness and strength of the patent."

This is not the first potato invention from Veg of Lund. The company has also a patent for a plant-based potato drink, "vegan potato emulsion" (EP3687298), trademarked as DUG and available in food stores around Europe. As to the summary of the invention: "It has surprisingly been provided according to the present invention a vegan, potato emulsion which is an excellent substitute for milk. The potato emulsion has similar properties to milk and can be consumed as such or used as an additive in a drink such as tea or coffee".

> **"Potato-based inventions are continuously seeing the daylight in today's Sweden."**

## Potatoes as fuel

And food becomes gas, which runs factories for the manufacture of food, whose remains become gas which... The Swedish potato chip factory Estrella in Angered outside Gothenberg, is the leading producer with millions of snack bags yearly. The chip factory has switched from natural gas to biogas and reduced its carbon dioxide emissions by 92% since 2017. In addition, the potato residues from chip production contribute to increased biogas production.

So, have that in mind next time you buy potatoes. It is not just for making pommes frites. You can drink it, clean your car, reduce your puffy eyes, and get a clear bathroom mirror. Make sure you have potatoes in your home. That's all you need.


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# Women in IP Leadership

## Celebrating achievements and continuing the empowerment of women

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

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

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

# Winnie Tham: Director, Amica Law

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

Winnie Tham is a Director of Amica Law LLC, and has been practicing in the intellectual property field since 1993. Winnie is an advocate and solicitor of the Supreme Court of Singapore and a registered patent attorney (Singapore). She was admitted to the Bar in 1993 winning the Justice Tan Ah Tah Prize for Professional Ethics. She has also attained a Bachelor of Laws (Hons) and is admitted to the Supreme Court of Victoria in Australia.

She has a multi-disciplinary background, encompassing both legal and technical expertise. She has a particular specialization in life sciences and pharmaceuticals as she holds a Bachelor of Science (Pharmacology & Biochemistry), in addition to her law degree, and regularly advises on patent and regulatory matters. However, her experience in intellectual property spans various industries including pharmaceuticals, technology, retail and fashion, hotels and the food and beverage industry.

**What inspired your career?**

I had already set my sights on a career in law when I was in secondary school, and this was reinforced in school when I did a short stint in a law firm as part of my work experience. However, beyond that, I did not know what area of law I wanted to specialize in. I was in a double degree program at university, studying Bachelors of Science and Law, and ultimately it was my science degree that determined my field in law. Whilst I thought I might go into corporate law, every law firm I interviewed with steered me towards intellectual property because of my science degree, and the possibility that I could be not only a lawyer, but also a patent agent. I was fortunate that the partners interviewing me were passionate about intellectual property and took the time to talk to me about a career in this area. Looking back, I think I was quite curious and had lots of questions, but they were very kind and hopefully took it as enthusiasm!

After that, I did some of my own investigation in the field and decided that it might be an interesting area to specialize in. The rest is history, and I have never looked back on that pivotal decision.

> **“Juggling a family and career is tough, especially if you are trying to be the best you can be at both.”**

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

Looking at my own pathway, I have learned that you should always keep an open mind, and whatever opportunities come your way, seize the day. Treat others as you think they would like to be treated and always put in your best effort. People around you recognize the effort and it stands you in good stead.

Also, don't be discouraged when things seem to be going awry; there is usually a silver lining behind the cloud. It may sound like a cliché, but life is really a journey. The quote by Robert Frost encapsulates my career – "two roads diverged in a wood and I – I took the one less traveled by, and that has made all the difference".

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

There are always challenges along the way, as we evolve in our careers. First, there is the road to partnership and proving yourself in the workplace It takes hard work and a little bit(or maybe a lot!) of luck. Juggling a family and career is tough, especially if you are trying to be the best you can be at both. Having a strong support system is important. It is fortunate that in Singapore, it is not too difficult to bring in domestic help and with family support, it does allow you to focus on your career at the same time.

I think it is important to enjoy your work and find fulfillment in what you do. If you are just in it for the money, you are more likely to burn out before you reach your potential. And work hard and smart because that is unavoidable if you want to reach your goals.

In terms of career, I think founding Amica Law LLC in 2006 with three other colleagues from my previous firm is the highlight of my career and has probably been the biggest challenge of my career as well. It is a true test of your lawyering and management skills, and also the relationship

> I would really like to see more awareness, training, and policies for firms to create more workplaces that reflect the desire to be equal, diverse, and inclusive.

you have with your employees and clients. Apart from that, you have employees who depend on you as well and you can't let them down. It's an exciting and invigorating experience, and sometimes more than a little daunting. I never cease to be grateful for the people around me, my employees, clients, and friends who put their faith and trust in you. Although we are now in our 17th year, it still seems like yesterday when we first announced the opening of the Firm.

Another highlight is my appointment to the Intellectual Property Office of the Singapore Board of Directors. It is a great honor to serve, and I feel that it has really added a new dimension to my career.

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

At this time in my career, my aspirations are to see Amica Law grow from strength to strength. When we first began the Firm, survival was key. Now, as our Firm has consolidated and expanded, it is really about planning for the future and succession in the Firm and ensuring that the groundwork is properly laid.

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

I think the IP industry is doing quite well in terms of equality and diversity for women but there is always room for improvement. The legal sector in Singapore has pretty even numbers of men and women, and to this end, I have been fortunate not to face obstacles in my career simply because of gender. In my own firm, the founding directors are balanced between males and females, as well as in management. I think these augurs well for the future. However, this is not necessarily the case in other firms, and it would be good to see more women holding management positions at the executive committee level.

However, if we look at equality and diversity from the perspective of minorities, gender diversity, and being more inclusive for people with disabilities, this may not come as naturally in the workplace. I would really like to see more awareness, training, and policies for firms to create more workplaces that reflect the desire to be equal, diverse, and inclusive.

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

I was privileged to have a strong female mentor as a role model in my legal career, and this really shaped me and provided opportunities. As a result, I always felt that I had every opportunity available to me, and I could achieve my goals based on my abilities and merit. In my view, this is really important for the empowerment of women in the IP sector, and more broadly, the workplace.

I also think positive policies that are institutionalized in firms are vital because they educate the management and staff as to what sorts of behavior are acceptable and can influence perceptions of how they see women in the workplace. This is a dynamic process because, as progress is made and social mores may change, the workplace needs to keep up.

At the community level, we need to also emphasize the message in schools and universities that women's roles in the workplace need not be confined because of their gender. In the legal sector, I think we are well on the way, but if we look at the STEM area, there is an underrepresentation of women as inventors and in management roles. This is where role models are important, to lead the way and show that it can be done.

Finally, in my own personal experience, it is difficult to be a "superwoman" and do everything at home and excel at work. And women should not have that burden on them. I think it is key to have a good support network that enables women to focus on their careers as well. It really takes a village.

Finally, it is also important for women to consider the needs of their colleagues and workplace, and there has to be some give and take. In this way, a culture of trust and respect can be developed, which is absolutely essential to pave the way for women's empowerment.





# Shu-Pei Oei: Global IP Team Lead, Palfinger Europe

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

Shu-Pei Oei is a European Patent Attorney based in the DACH region, and Global IP Team Lead at Palfinger Europe. In addition to holding a master's in IP Law and Management (LLM) from CEIPI, Shu-Pei is a qualified ISO 9001 Quality Management lead auditor. Her thesis on "Risk Management Practices and their Applications in Intellectual Property and Trade Secrets Management" has highlighted the need for standards in IP leadership and management. Shu-Pei is an appointed Chair of the Committee 'Risk Management' at I3PM (International Institute of Intellectual Property Management). She holds a Ph.D in Engineering (Cambridge) and degrees in Electrical and Electronics Engineering (M.Sc, BEng) from Stanford and UCL.

**What inspired your career?**

My first encounter with IP was in the UK, when I had the chance to intern at a Patent Attorney firm in London. It was 2008-2009, around the time of the global financial crisis. I was nearing the end of a PhD in Engineering at Cambridge, and the thought of finally being able to put knowledge to practice was an appealing one. Although the ad in the careers magazine had described patent attorney life quite well, I remember being anxious at the thought of entering the legal profession. I didn't feel brainy enough to be a lawyer, yet, I couldn't abandon the feeling that patent law would suit me rather well.

So, I embarked on the journey to find a firm that would accept me as an intern. It was important to me to get a fair assessment of my strengths before I took the plunge.

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

The first indicator that I was on the right track was the buzz I felt after the internship. I had received sufficient positive affirmation from the partners to take it further. But more importantly, I felt a happiness while working on patent cases that I had never felt while working in a lab. It sounds cheesy, but it is true. When you're finally doing what you're meant to be doing, everything feels right.

> The second piece of advice I can offer is to negotiate for the life that you know will fulfill you.

So, the first piece of advice I can offer others is to rely on both your inner voice and external validation when making choices. While it may have become a trend to choose one exclusively over the other, both can play a part in achieving success and satisfaction. The inner voice sets the direction for where you want to go, while external voices provide pathways and options for you to get there.

The success of the internship gave me confidence to expand my career search to more places, such as Singapore, London, Germany and Australia. It also emboldened me to apply to larger firms.

I ended up in Munich, Germany, where I learned German, trained for the European Qualifying Exam (EQE), passed it several years later, and became a patent attorney. I stayed on the rather predictable *Tao* of the patent attorney for 11 years until my inner voice started vocalizing again.

This time, it was telling me that my other human faculties weren't being exercised fully in that role.

It soon became clear that being in-house, in a person-oriented organization, was where I wanted to direct my expertise and energies. When the inner voice starts speaking, it is usually a matter of time before I act on it. But the trouble is, that even with a pretty loud inner voice, I learned that children are louder. And this time, I had two of them to contend with!

It took a little longer to negotiate the change with my family, but the change eventually did happen.

So, the second piece of advice I can offer is to negotiate for the life that you know will fulfill you. When you've succeeded, grasp the opportunity, and go onward.

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

At 21, I had to cope with the death of a parent while in a foreign country. It was a simple phone call telling me that my father had passed suddenly two weeks before my final exams. A decade later, I saw another parent through end-of-life care. It affected my morale and how I viewed my life in an overseas country. Despite this, I returned to Germany to rebuild and sit for the EQE.

Becoming a first-time parent and raising children in a foreign country, all while trying to keep my career alive, is still by far the greatest challenge I face,

> **Becoming a first-time parent and raising children in a foreign country, all while trying to keep my career alive, is still by far the greatest challenge I face.**

because it is an amalgamation of all the missing pieces from the past that I wish I could have had. Coping with prematurely missing pillars, such as identity, roots, family ties and support, can be rather challenging for a young woman.

My story is not unique, as most of us face questions and doubts about parenthood, identity, mortality, invincibility, and loss, sooner or later. But I guess what makes it quite rare is to have met and overcome these challenges so early on- in my early thirties.

When it comes to overcoming uncomfortable situations, I give myself time to sort out my desires, and sources of regret and grief. Then, I try to make decisions that are in sync and authentic with my being. This process allows me to make life choices I can live with, accept trade-offs, and to perform my responsibilities with peace of mind.

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

Fully bridging and overcoming "the motherhood penalty" is something I am particularly proud of. I feel comforted that I have been able to do this quite quickly, and I want to help more women do the same. Overcoming the motherhood penalty isn't an award or prize for "best patent attorney" or anything glitzy. To me, it simply means that I have exceeded my own expectations, and I can stand shoulder to shoulder again with the peers I started out with. It's an amazing feeling to be back in the game.

As an introvert, I rely on my intuition and inner self to set both personal and professional goals, while ignoring external hype. It is nice to know that this intuition led me to become Singapore's first female European Patent Attorney, purely by accident.

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

I will stay in the IP profession and continue to lead or contribute, wherever needed.

In recent years, it has become clear to me that the IP tech community urgently needs professionals who can gel and execute. To me, that means not only being proficient in technology, business, and different aspects of law – which is challenging enough! We also have to hone our decision-making skills, and organize data and people in a way that jives with the organization.

Yep. Shimmying and jiving with the organization are words I never thought I'd publish in a Patent Lawyers magazine, but here we go.

On a personal note, I'll keep up-skilling because I value competency-based leadership, and like many women out there, I still tend to over-prepare when I lead.

I will also keep learning from other experts, particularly senior IP experts. There are many to learn from.

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

The tech IP industry is known to be quite male-dominated, rather competitive, and at times, intimidating. It is not unusual for people to speak dismissively of one another. I would like to see less of that, because it can create an anxious environment for newcomers.

It can also be quite hard to find information in the IP industry, unless you're plugged into a good network. I think all newcomers to the IP industry would benefit from an IP environment that is more open, less intimidating, and that prioritizes information sharing.

If we can agree on the basic tenets that would address skill shortages in general, we might then be able to have a proper discussion on how to bridge gaps brought on by our preferences and differences.

Meanwhile, I encourage minorities to be fearless when seeking out information, and never let a couple of bad experiences define your future. There are many good people in the tech IP industry who are willing to help you. You might just have to poke the bear a little bit.

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

I would really like to see more career acceleration programs for mature women in organizations, including the IP sector. It's such an obvious demographic that needs help, yet for some reason they have been left off the radar. I love that we are seeing more young leaders programs emerging. Yet, ironically, they are usually directed at an age where women are focused on family life. While many YLPs do not have a strict age cut-off, the needs of youth and mature women are rather different.

I would support schemes where more help is given to mature women returning to the workforce. Particularly in terms of relationship-building and leadership mentorship.

I would also like to bring attention to organizations like Young Members Congress (YMC) of the Licensing Executives' Society (LES) and the International Institute of Intellectual Property Management (I3PM), which I am involved in. In recent times, they have been active in extending their reach to a wider demographic. There are many supportive people in IP to be found there.



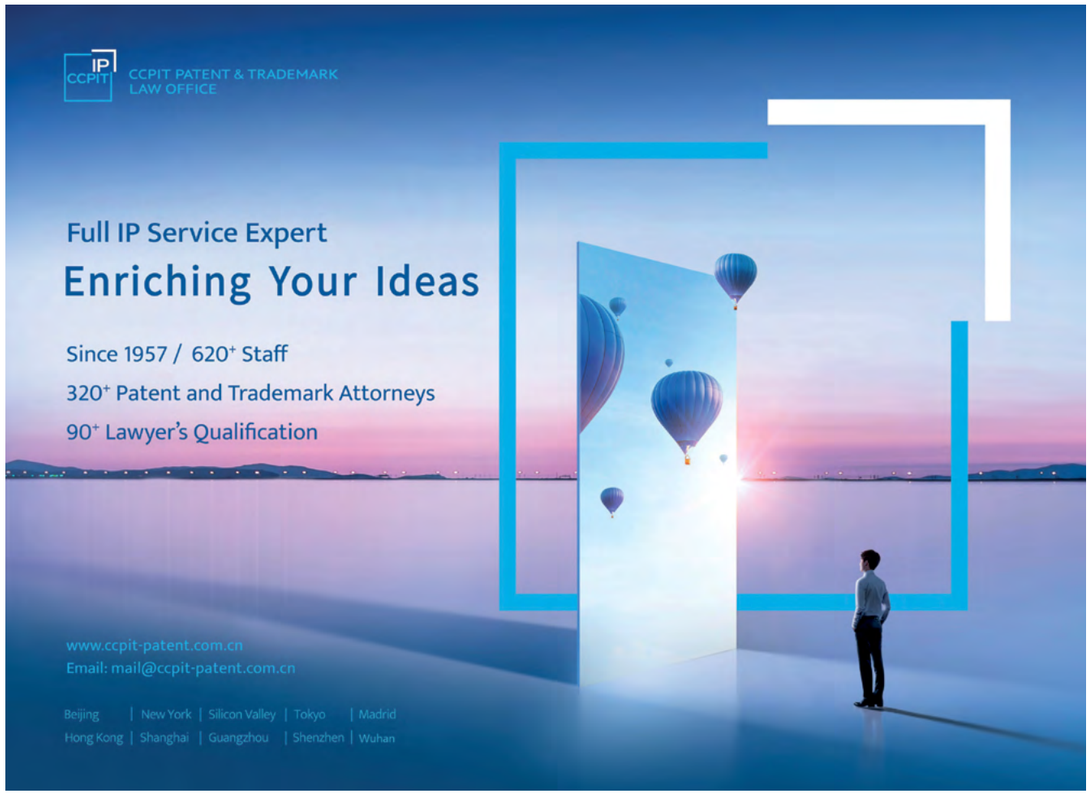

# The Patent Lawyer Magazine

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 IP Agency
- CCPIT Patent & Trademark Law Office
- Chang Tsi & Partners
- China Patent Agent (H.K) Ltd.
- Han Kun Law Offices
- IP March
- Liu Shen & Associates
- Unitalen Attorneys at Law
- Wanhuida Intellectual Property
- ZY Partners





## Australia

Allens
Ashurst
Clayton Utz
Corrs Chambers Westgarth
Davies Collison Cave
Gilbert + Tobin
Griffith Hack
Herbert Smith Freehills
Jones Day
Spruson & Ferguson

## Hong Kong

Baker McKenzie
Bird & Bird
Deacons
Hogan Lovells
Jones Day
SIPS – Simone Intellectual Property Services
Tiang & Partners
Wenping Patent & Trade Mark Agent LTD.
Wilkinson & Grist
Vivien Chan & Co.

## Indonesia

Am Badar & Am Badar
AMR Partnership
Biro Oktroi Roosseno
FAIP Advocates & IP Counsels
Hadiputranto, Hadinoto & Partners
Januar Jahja & Partners
K&K Advocates
PRAWIRANEGARA International Patent & Trademark Law
SKC Law
Tilleke & Gibbins

## India

Anand & Anand
KAnalysis
Kan and Krishme
Krishna & Saurastri Associates
L. S. Davar & Co.
Lakshmikumaran & Sridharan
LexOrbis
Obhan & Associates
Remfry & Sagar
R. K. Dewan & 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
CreateIP
Dentons Kensington Swan
Henry Hughes IP
Hudson Gavin Martin
James & Wells
Simpson Grierson
Tompkins Wake

## Pakistan

Abu-Ghazaleh Intellectual Property | AGIP
Absam IPS
Ali & Associates
Bharucha & Co.
Codex & Co.
Liaquat Merchant Associates
Raza & Associates
United Trademark & Patent Services
Vellani & Vellani
Zafar & Associates

## Singapore

Allen & Gledhill
Amica Law
Baker McKenzie Wong & Leow
Bird & Bird ATMD
Donaldson & Burkinshaw
Drew & Napier
Francine Tan Law Corporation
Mirandah Asia
Ravindran Associates
Shook Lin & Bok

## Japan

- Abe, Ikubo & Katayama
- Anderson Mori & Tomotsune
- ASAMURA IP P.C.
- Hiroe and Associates
- Kubota
- Nakamura & Partners
- Ohno & Partners
- Sonoda & Kobayashi
- TMI Associates
- Yuasa and Hara

## Vietnam

- Annam IP & Law
- ASL LAW
- Elite Law
- Gintasset
- INVESTIP
- Pham & Associates
- Rouse
- Tri Viet & Associates
- Vision & Associates
- WINCO

## Sri Lanka

D.L. & F. De Saram
F. J. & G. de Saram
IP Chambers
John Wilson Partners
Julius & Creasy
LegalBase
Neelakandan & Neelakandan
Nithya Partners
Sudath Perera Associates
Varners

## Philippines

ACCRALAW
Bengzon Negre Untalan
Castillo Laman Tan Pantaleon & San Jose
Cruz Marcelo & Tenefrancia
Federis & Associates
Hechanova Group
Quisumbing Torres
Romulo Mabanta Buenaventura Sayoc & De Los Angeles
SyCip Salazar Hernandez & Gatmaitan
Villaraza & Angangco (V&A)



## South Korea

AIP Patent & Law Firm
Bae, Kim & Lee
DARAE Law & IP Firm
FirstLaw P.C.
Kim & Chang
Lee & Ko
Lee International
Yoon & Lee International Patent & Law Firm
Yoon & Yang
Yulchon

## Taiwan

Baker McKenzie
Deep & Far
Formosa Transnational
Giant Group
Lee and Li Attorneys-at-Law
SUNDIAL Intellectual Property Law Firm
Tai E International Patent & Law Office
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

## Malaysia

- Henry Goh & Co
- Lee Hishammuddin Allen & Gledhill
- MarQonsult
- Patentsworth International
- Rahmat Lim & Partners
- Shearn Delamore & Co.
- Skrine
- Tay & Partners
- Wong Jin Nee & Teo
- Wong & Partners

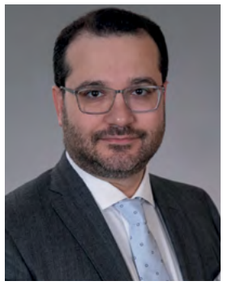
# Expanding the USPTO's Director review process

**David McCombs, Eugene Goryunov and Jonathan Bowser of Haynes Boone evaluate the recent updates that are set to adjust the procedure and expand the scope of the Director review process.**

In *United States v. Arthrex, Inc.*,[1] the US Supreme Court held that the USPTO Director must have the authority and opportunity to unilaterally review a PTAB final written decision before that decision becomes the final decision of the agency. Consistent with Arthrex, the PTAB implemented an interim Director review process.[2] On July 24, 2023, after nearly two years of experience and in response to comments the USPTO received from various stakeholders, the USPTO updated the Director review process by expanding its scope and adjusting its procedure to match.[3]

The underlying purpose of Director review is to resolve issues that might not be germane for appeal – either because of a different standard of review or other issues that might otherwise be unappealable – but nevertheless implicate the resolution of the specific case or would address broader legal issues. Director review may be initiated *sua sponte* by the Director or requested by a party to a PTAB proceeding. While the original Director review process was limited to review of final written decisions, the revised process allows parties to seek review of the PTAB's "(1) decision whether to institute a trial, (2) final written decision, or (3) decision granting a request for rehearing." Expansion of the Director review process to cover institution decisions is a **big deal** at least because, absent Director review, institution decisions are unappealable.

David McCombs



Eugene Goryunov

Jonathan Bowser

Turning to the specifics of the revised Director review process, a request can be made for any issue(s) addressed in a PTAB institution decision, final written decision, or rehearing decision. If the request is directed to the PTAB's decision whether to institute a trial or a decision granting rehearing of such a decision, the review "shall be limited to decisions presenting (a) an abuse of discretion or (b) important issues of law or policy." Both "discretionary and merits-based issues may be raised" in the review request and issues of law or policy are reviewed "*de novo*." On the other hand, if the request is directed to the PTAB's final written decision or a decision granting rehearing of such a decision, the review shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law. All issues raised are reviewed "*de novo*."

It is expected that most Director reviews will be conducted upon request by one of the parties to a PTAB proceeding, but the Director has the authority to *sua sponte* initiate a review. In the case of *sua sponte* initiation, the PTAB will issue a notice to the parties informing them that a Director review will be initiated prior to either party filing of a notice of appeal or the lapse of the time for filing such a notice, whichever is sooner. As a general matter, Director review is intended to review the record to decide whether a particular PTAB panel's decision should be sustained. The Director may, however, elect to accept briefing by the parties on the subject of the review and, where appropriate, order oral argument. This may be particularly helpful when the review is aimed at a legal issue or the Director is reviewing an issue that has broad-reaching implications for the PTAB as a whole.

To request Director review, a party (and only a party) to the proceeding must concurrently (1) file a Request for Rehearing by the Director and (2) send a notification of the Request for Rehearing by the Director by email to Director_PTABDecision_Review@uspto.gov, copying counsel for all parties. The page limit for the request is 15 pages.

The deadline for filing a Director review request is the same as filing a request for rehearing: within 30 days of entry of a final written decision, within 30 days of entry of a decision denying institution, or within 14 days from the entry of a decision whether to institute trial.[4] The Director has the authority to extend the request deadline for good cause, and a request for Director review resets the time for appeal or civil action.

Once a party has requested review, a Director-created Advisory Committee will advise the Director on whether the decision merits review. The Committee includes at least 11 members and includes representatives from various USPTO business units. Typically, the Committee will include members from: the office of the Under Secretary (but not including the Director or Deputy Director), the PTAB (but not including members of the panel that originally issued the decision on review), the Office of the Commissioner of Patents (but not including the Commissioner for Patents or any person involved in the examination of the challenged patent), the Office of the General Counsel, and the Office of Policy and International Affairs. While not all members of the Committee are necessary to render a recommendation, a quorum of at least seven members must be present.

Director review begins when the Director (with the help of the Committee) has either approved a party's request or initiated review *sua sponte*. As with *sua sponte* Director review, parties may not include new evidence or arguments in a request, but the Director may ask for additional briefing, allow the submission of new evidence, and even order oral argument, when appropriate. Third parties are not permitted to request Director review or participate in the review process, unless the Director specifically invites a third party to participate.

It is important to note that a granted Director review does not automatically stay the underlying proceeding. The Director may, however, stay the case if necessary. In any case, the Director maintains authority over all issues in the case during the pendency of review but may, where appropriate, delegate authority to the PTAB panel to handle routine interlocutory matters or attend to matters outside of the intended scope of review.

A decision from the Director review process of a final written decision is appealable as any other PTAB final written decision. But a decision reviewing a decision on institution is not appealable. The revised process allows a party to seek rehearing of a Director review decision, regardless of the decision the Director reviewed. The moving party must show that the Director's decision "should be modified" but the USPTO notes that rehearing requests "should be rare…and only for very focused purposes."

Since its inception, Director review decisions have been entered in 25 cases, with some cases receiving multiple decisions.[5] In short, the process is being used more than many have expected. Indeed, on August 4, 2023, shortly before this article was submitted for publication, the Director decided N*eurocrine Biosciences, Inc. v. Spruce Biosciences, Inc.* under the USPTO's revised procedure.[6] There, the PTAB denied institution of a PGR trial finding that Petitioner failed to meet the threshold requirement of prevailing on its anticipation, obviousness, and written description challenges. Petitioner filed a request for rehearing and requested review by the PTAB's now-retired Precedential Opinion Panel (POP). The Director took advantage of the revised, expanded scope of Director review to *sua sponte* review the PTAB's decision denying institution of a PGR trial. The Director vacated the PTAB's decision finding that the panel incorrectly applied controlling law. This is just the most recent example of the Director vacating or correcting what she perceived to be an incorrect application of law.

The USPTO has yet to finalize the Director review process and issue a final set of rules and procedures governing its administration. Practitioners should nevertheless monitor how the Director is addressing cases to make sure they are up to speed on the current state of the law and application of various USPTO procedures. The Director review process was a very useful tool when it was initially created in 2021. It has become even more useful and powerful since the USPTO revised the procedure governing Director review and expanded its scope to include decisions on institution.


## Résumés

**David McCombs** is a partner at Haynes and Boone 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 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.

**Jonathan Bowser**
Jonathan focuses his practice on patent litigation disputes before the PTAB and federal district courts, and related appeals before the Federal Circuit.


1 141 S. Ct. 1970 (2021).

2 *USPTO implementation of an interim Director review process following Arthrex*, available at: https://www.uspto.gov/patents/patent-trial-and-appeal-board/procedures/uspto-implementation-interim-director-review.

3 *Revised Interim Director Review Process, available at:* https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process.

4 37 C.F.R. §§ 42.71(d)(1)-42.71(d)(2).

5 https://www.uspto.gov/patents/patent-trial-and-appeal-board/status-director-review-requests

6 *Neurocrine Biosciences, Inc. v. Spruce Biosciences, Inc.*, PGR2021-00088 & PGR2022-00025.

*This article reflects only the present personal considerations, opinions, and/or views of the authors, which should not be attributed to any of the authors' current or prior law firm(s) or former or present clients.*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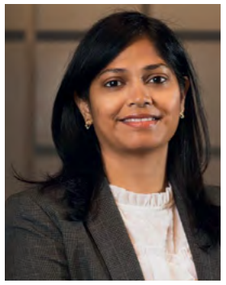
# How and why: standard essential patent licensing in India

**Ranjan Narula and Suvarna Pandey of RNA, Technology and IP Attorneys summarize three recent decisions addressing the subject of contentious issues in SEP litigation.**

Standard Essential Patent (SEP) regime envisages a candid and transparent negotiation between a willing licensor (patentee) and willing licensee (implementer). The regime incorporates mutual reciprocal obligations on both the essential patent holder and the implementer. It is not a 'one-way street' where obligations are cast on the essential patent holder alone, rather it is important that both parties should agree to avoid any conflicts and legal proceedings in the future about royalty payments, etc. However, the determination of royalty is a contentious issue. Often the negotiations fail and parties land in Court(s) for determining royalty. Whether the royalty calculation should be based on chipsets or the end-device price is a contentious issue. SEP holders argue that Chipsets constitute a small portion of mobile phones. The hardware and other software technologies form a major part of the smartphone so royalty calculation should be based on end-device price. In many cases, the implementor would challenge the validity of the patent in question as part of the royalty negotiation process. The complaints are also filed before the Competition Commission of India (CCI) to probe the conduct of the SEP holder and its dominant position while negotiating terms and the grant of license.

The courts are mindful of the need to balance the rights of SEP holders by providing them adequate monetary compensation with those of implementors to use the SEPs. The Courts in SEP cases do make a conscious attempt not to pass interim injunction against an implementer until a final decision has been taken on all relevant issues, while at the same time providing appropriate monetary security and protection to SEP holders in the form of a pro-tem deposit.

Ranjan Narula



Suvarna Pandey

Our article summarizes three recent decisions on the subject addressing the contentious issues in SEP litigation. All the cases had come up in Appeal before the Division Bench (two judge bench). Therefore, binding on the Single judges in the IP Division. The decisions also provide clarity on the SEP landscape.

## Oppo against Nokia

In this case, an appeal was filed by the appellant-plaintiff ('Nokia') challenging the order (dated 17 November 2022) passed by the Single Judge of the Delhi High Court dismissing Nokia's application for the interim payments by Oppo. Nokia, in its appeal, sought directions asking:

a) Oppo to deposit interim security of an amount based on either the latest counteroffer made by it for a global license of Nokia's portfolio of Standard Essential Patents; or

b) an amount equivalent to the royalty paid under the Agreement executed between the parties proportionate to the ratio of the number of devices sold by Oppo in India *vis-à-vis* the number of devices sold globally.

The court held that the payment of pro-tem security is the implementer's obligation even in the negotiation phase. To balance the equities, the Indian court has the power to pass a pro-tem order, if the facts so warrant. The Court outlined the situations for payment of pro-tem order to be passed by the Court:

- If the negotiations between the parties fail, it does not mean that an implementer can continue to derive benefits by using the technology of the Standard Essential Patent proprietor in the interregnum without making any payments for such use.

- The Court also noted that nearly two years have elapsed since the institution of the suit, and not a 'single farthing' has been paid by Oppo. Consequently, to balance the equities between the parties, this Court has the power to pass a pro-tem order being a temporary arrangement without a detailed exploration of merits if the facts so warrant.

- The Court also relied on *Ericsson v. Intex, CS(OS) 1045/2014* where the Delhi High Court Rules governing patent suits, 2022 has recognized the concept of pro-tem security and has held that the Courts have the power to pass deposit orders even on the first date of hearing if the facts so warrant.

- The Court opined that a pro-tem security order cannot be linked to an injunction order because, unlike an injunction order, it does not stop or prevent the manufacturing and sale of infringing devices. The intent of a pro-tem security order is to either ensure maintenance of status quo or to retain the Courts' power and ability to pass appropriate relief at the time of the decision of the injunction application. In the facts of the present case, the pro-tem security order does not confer any advantage upon Nokia as it only balances the asymmetric advantage

> **"Whether the royalty calculation should be based on chipsets or the end-device price is a contentious issue."**

## Résumés

**Ranjan Narula, Managing Partner Board Member, International Trademark Association (INTA)**

Ranjan founded the specialist IP law firm, RNA, 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, strategic advice on IP clearance, acquisition, and enforcement. Ranjan has worked in-house and in private practice including a stint with international IP practice heading its India operations. In 2019, Ranjan was invited to join the INTA Board of Directors.

Ranjan has been ranked as a leading IP practitioner by various publications including WTR 1000, IP Star (Managing IP), WIPR leaders, Who's Who legal, Asia IP experts, and others. Ranjan is regularly invited to speak by Universities and chamber of commerce on IP issues. He has authored several articles and papers on key IP issues that are published by IP magazines and blogs such as IAM, World Trade Mark Review, Bloomberg, Lexology, IP Kat etc.

**Suvarna Pandey, Associate Partner**

Suvarna is a registered patent agent and a law graduate. Having been in the practice for around 13 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 is specialized 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.

SEPS IN INDIA

**The order establishes that SEP holders can ask the Court for the direction of a "Pro-tem security deposit" during the initial stages even when the matter is not dealt with in detail by the Court.**

that an implementer has over a standard essential patent holder.

- The Court further directed Oppo to deposit the money in Court, which will be reimbursed to Oppo should it succeed at the interim or final stage.

- The Court allowed Nokia's appeal to set aside the challenged order. The Court also directed the respondent to deposit the 'last paid amount' attributable to India i.e., 23% of the last paid amount under the 2018 Agreement within four weeks.

The order establishes that SEP holders can ask the Court for the direction of a "Pro-tem security deposit" during the initial stages even when the matter is not dealt with in detail by the Court. On the point of *prima facie* infringement by Oppo, the Court importantly mentioned that an injunction can be secured, even if the infringement of one patent is established either *prima facie* or at the final stage. Thus, to restrain the sale of an infringing device, an SEP holder does not have to base its case on each of the thousands of patents that it owns and are used in the product; it can do so by showing that one or a handful of representative patents are infringed. This is a welcoming move for SEP holders.

Oppo has since filed an Appeal against the order in Supreme Court, establishing their case. However, the Supreme Court refused to disturb the findings of the High Court and simply extended time for Oppo to comply with the High Court order on pro-tem deposit by 25 August.

## Intex to pay royalty for use of Ericsson's SEPs:

In this case, Ericsson (SEP holder) had brought a suit against Intex seeking royalties on Fair, Reasonable and Non-Discriminatory (FRAND) terms for the use of its patents as prolonged negotiations had failed. The Court, after hearing both parties, held that:

1. Ericsson's eight suit patents were *prima facie* valid and essential, and Intex has *prima facie* infringed Ericsson's patents.

2. Ericsson demonstrated *prima facie* compliance with its FRANDcommitment and Intex's act of prolonging pre-suit negotiations and thereafter initiating proceedings against Ericsson before the Competition Commission of India (CCI) and Intellectual Property Appellate Board (IPAB) during licensing negotiations *prima facie* showed its unwillingness to execute a FRAND license.

3. Chipset basis for the calculation of Royalty cannot be accepted and the practice of royalty calculation on the end-device price is non-discriminatory.

Finally, the Court directed Intex to pay 50% royalty at the interim stage and balance 50% by way of a bank guarantee.

Cross Appeals were filed by both Ericsson and Intex against the Single Judge decision to the Division Bench of the Delhi High Court.

- Ericsson in its Appeal had prayed that Intex be directed to pay the entire royalty amount and not split as a bank guarantee and royalties.

- Intex on the other hand argued that:

  - A single judge could not have passed a direction to pay as well as deposit royalty at the interim stage since standard essential patent owners' only entitlement, even according to the law laid down by foreign Courts, is royalties at the end of the trial.

  - In standard essential patent matters no injunction can be granted, even if an implementer is an unwilling licensee.

The four-factor test to be satisfied is not made out in this case (i) the asserted suit patents are in fact standard essential patents, (ii) the technology used by the implementer infringes the standard essential patents, (iii) the royalty rate at which patentee is willing to license its standard essential patents are FRAND, and (iv) the implementer is unwilling to take the license at the FRAND rate.

Finally, the Court found that Ericsson had shown in its cross-appeal that "the terms suggested by Ericsson are *prima facie* FRAND terms" and that "to ensure parity with other implementers, Intex must pay in full for the past use of the standard essential patents." The Court based its decision in part on the fact that the "telecom industry has


overwhelmingly accepted Ericsson's standard essential patents" and "more than one hundred licenses have been executed by Ericsson for the same technology globally, and similar implementers are paying royalty in accordance with the terms suggested by Ericsson." The Court did not discuss those licensing terms beyond noting at the outset of its decision that the lower Court rejected Intex's argument that the royalty base should be the chipset, not the end product, where the lower court "held that the chipset basis for calculation of royalty cannot be accepted and the practice of royalty calculations on the end-device is non-discriminatory." The Court ultimately ordered that "Intex [to] pay the entire royalty amount to Ericsson within four weeks."

## Role of the CCI in SEP cases

*When a patent is issued in India, and the patentee asserts such rights, can the Competition Commission of India (CCI) inquire into the actions of such patentee in exercise of its powers under the Competition Act, 2002 ("Competition Act")"*

This was dealt by the Division Bench of Delhi High Court in an appeal by Ericsson on a complaint made by Micromax and Intex that Ericsson was imposing conditions for licensing certain SEP" in the field of telecommunications that are not fair, reasonable, or non-discriminatory. A similar question was raised by Monsanto as the Court had observed there was no bar in law to proceedings initiated by CCI for violation of Section 3 and 4 of the Competition Act (Section 3 essentially bars agreements which will have an adverse effect on competition and Section 4 bars any enterprise from abusing its dominant position).

The Division Bench (two-judge bench), in their analysis, discussed that "the Competition Act is a general legislation pertaining to anti-competitive agreements and abuse of dominant position". The Court also opined that for deciding an application for compulsory licensing, the controller is empowered by the Patents Act to consider the reasonability of conditions imposed in a license agreement. Chapter XVI of the Patents Act (relating to Working of Patents, Compulsory Licenses, and Revocation) is a complete code, on all issues pertaining to unreasonable conditions

**To balance the equities, the Indian court has the power to pass a pro-tem order.**

> **Therefore, a pro-tem deposit or an interim calculation of royalty is essential to incentivize companies to innovate.**

in agreements of licensing of patents, abuse of status as a patentee, inquiry in respect thereof, and relief to be granted. Therefore, the court concluded that the Patents Act should be invoked while dealing with anti-competitive agreements and abuse of a dominant position by a patentee while exercising his rights under the Patents Act.

## To sum up

The courts by the above decisions have tried to simplify the a) royalty calculation b) made it clear that pending challenge to the Patent pro-tem deposit can be ordered by the court c) the Patents Act is the relevant statute to decide on issues pertaining to unreasonable conditions in agreements of licensing of patents, abuse of status as a patentee, inquiry in respect thereof, and relief to be granted.

Overall, the jurisprudence, including the enforcement of SEPs with these series of judgements would be simplified and in line with the stand taken by the courts in other countries. It was also much needed as the Court noted in *Ericsson v Intex* case the fact that the judge-population ratio is extremely poor in India, expeditious disposal of patent suits cannot be expected at the cost of other suits. Therefore, a pro-tem deposit or an interim calculation of royalty is essential to incentivize companies to innovate.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# From past to present: shifting interpretations of The Mexican Patent Office on divisional applications

**Sergio Olivares, Daniel Sánchez and Rommy Morales of OLIVARES compare the new approach to divisional applications implemented with the Federal Law for the Protection of Industrial Property 2020 with the old to provide guidance for proceeding.**

The coming into effect of the Federal Law for the Protection of Industrial Property (FLPIP) on November 5, 2020, was a turning point that brought substantial changes to Mexico's Industrial Property law, particularly concerning the practice with respect to divisional applications, marking the beginning of a new approach in this field.

Divisional applications play a crucial role in intellectual property protection by allowing applicants to pursue distinct inventions separate from those claimed in the initial application and any prior divisional applications. In this regard, it is important to consider that Mexican law only recognizes divisional applications, unlike the US law where continuation or continuation in part applications exist as well.

Before the FLPIP was enacted, the submission date of a divisional application was one of the most important points to bear in mind. Divisional applications could be filed as long as the parent case was still pending, regardless of whether said parent case was a divisional application or whether the initial application was pending or had already been granted.

Nonetheless, the implementation of the current law imposed new constraints and additional requirements for applicants to contemplate when filing one or more divisional applications, which directly impact the two types of divisional applications recognized by IMPI, those voluntarily submitted, and those submitted in response to a lack of unity of invention objection.

## Voluntary divisional applications

Voluntary divisional applications are commonly used when the applicant wishes to pursue a different scope, seek protection for a different invention, or simply as a strategy to maintain the pendency of the patent family.

> **If the patent application encompasses multiple inventions not linked by the same inventive concept, the applicant can even file a single divisional application pursuing several of these inventions.**

Unlike the abrogated law, which was silent on voluntary divisional applications, the current law does so by stating that a pending initial patent application can be voluntarily divided. However, this provision does not extend to divisional applications.

Voluntary divisional applications can be submitted at any time and up until before the grant fee payment or the issuance of the notice of denial, with no limit imposed on the number of divisional applications that may be submitted. Taking this provision into consideration, it becomes possible to submit multiple voluntary divisional applications, each directed to a different invention or group of inventions, all directly derived from the initial application while it remains pending.

## Divisional applications submitted by request of IMPI

Mexican legislation stipulates that a patent application should refer to one invention or a group of inventions sharing a single inventive concept. This requirement of unity of invention involves having a clear relationship between the essential technical features present in the invention or group of inventions, contributing to the state of the art.

During the substantive examination process, if it is found that the patent application fails to comply with the unity of invention requirement, IMPI issues an office action requesting the applicant to limit the claims to the main invention and submit one or more divisional applications for the remaining inventions.

The first invention pursued in the claims is considered the main invention, which according to the current law should be examined on the merits. However, in practice, IMPI usually allows applicants to claim the invention of interest, even if it does not always correspond to the main invention.

## Résumés

**Sergio Olivares** joined OLIVARES in 1987 and has been practicing intellectual property 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, but works most 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 Sánchez** 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, Mr. Sanchez 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 also has led Olivares' team in obtaining alcoholic beverage advertisement approvals from COFEPRIS, has authored various articles on IP and Life Sciences-related matters, and he has lectured on IP topics in both national and international forums.

**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 Morales 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.

Rommy has participated in numerous legal proceedings related to life sciences, including litigation cases involving pharmaceutical products of significant commercial interest.

When faced with the unity rejection, applicants have several routes to consider. One option is to maintain the claims focused on the invention of interest while eliminating the remaining claims. Applicants have the opportunity to pursue these eliminated claims through one or more divisional applications, which must be submitted along with the response to the office action objecting to the unity of invention.

If the patent application encompasses multiple inventions not linked by the same inventive concept, the applicant can even file a single divisional application pursuing several of these inventions. This would trigger a new unity of invention objection, thereby providing a new opportunity to submit cascade divisional applications in the future.

Alternatively, applicants can choose to submit arguments to persuade the examiner that the claimed invention(s) are indeed related by the same inventive concept. Another viable approach is to make amendments to the claims, ensuring compliance with the unity of invention requirement without the need to submit divisional applications.

## Restrictions for subject-matter that can be pursued in divisional applications

At the time of submission, every divisional application must include the specification, claims, drawings, and sequence listings (where applicable), along with the official filing fee payment. These divisional applications are not allowed to introduce new subject matter or broaden the scope of the original case.

Divisional applications must pursue a different invention from the one claimed in the initial application and any other previous divisional applications. While the law does not define what is understood by a "different invention", the law does set a clear boundary: a patent will not be granted for subject matter that is already protected by another patent or for non-substantial variation, regardless of whether the applicant remains the same.

As a consequence, IMPI could reject a divisional application seeking protection for a non-substantial variation of the subject matter claimed in the initial application or applications within the same family, although the claimed matter is not identical, but there is overlapping subject matter.

Another significant limitation found in the current law is that once an invention or group of inventions is no longer claimed when a division takes place, it cannot be claimed again in the initial application or the one that triggered the division.

It is important to highlight that these limitations apply not only to patent applications but also to utility model and industrial design applications.

## Cascade divisional applications

Before the entry into force of the LFPPI, cascade divisional applications were accepted by IMPI as long as the immediate predecessor application was still pending, regardless of the status of the initial application or the generation of the immediate predecessor (e.g., first-generation, second-generation, etc.).

Nevertheless, a substantial restriction was incorporated into the current law, as it stipulates that divisional applications cannot consist of the division of other divisional applications unless they are deemed appropriate by IMPI or filed in response to a unity objection. Failure to meet this condition results in the application not being recognized as a divisional, depriving it of the legal filing date or priority rights of the application from which it seeks to derive. Instead, it will be treated as an independent application filed on the date it was submitted to IMPI, which would finally lead to the refusal of the application due to lack of novelty in view of the publication of the initial patent application.

Regardless of the major limiting factor discussed above, the transitional articles of the new law provide an exception. They state that patent, utility model, or industrial design applications that were pending at the time of the law's enactment would continue to be prosecuted in accordance with the provisions in force at the time they were filed.

Considering the above, the limitations imposed on cascade divisional applications should apply solely to initial (root) applications filed on or after November 5, 2020. In contrast, any applications that remained pending and were filed before this date should be prosecuted according to the provisions outlined in the preceding law.

However, the authorities' interpretation of the aforementioned legal provisions has been uncertain, as IMPI has adopted a series of varying criteria over time. This has led to a shifting landscape for divisional patent applications. The following section will explore the evolution of IMPI's interpretation and the impact it has had on the prosecution of cascade divisional applications.

Analyzing the journey of cascade divisional applications: where do we stand now?

Despite the provisions contemplated of the new law and the provisions established in our constitution that indicate that laws cannot be applied retroactively to the detriment of the applicant, since November 5, 2020, and for approximately one year thereafter, IMPI rejected voluntary cascade divisional applications, even those that derived from applications prosecuted under the previous law.

These cascade divisional applications were not recognized as divisional patent applications but considered as independent applications under the premise that the prosecution of their initial parent case had already been concluded. In other words, divisional applications that derived from an initial application filed under the previous law were being analyzed by IMPI according to the new law just because they were filed after November 5, 2020, instead of using the law applied to the initial application.

**Sergio Olivares**

**Daniel Sánchez**

**Rommy Morales**

Given the significant impact of this uncertain criteria on Mexico's patent system, OLIVARES, in conjunction with various affiliated associations, promoted a shift in criteria for proper interpretation of the legal framework by the authority. As a result of these efforts, in 2022, IMPI began accepting cascade divisional applications deriving from those filed under the previous law.

Unfortunately, this revised approach did not last long, since recently, IMPI reverted to its original position, dismissing voluntarily submitted cascade divisional applications once again. This time, the authority is grounding its arguments on a court decision, asserting that a divisional application cannot be accepted once the prosecution of the parent application has concluded. As a consequence, litigation on these matters will be necessary.

This prevailing scenario could have a profound impact on the patent landscape since it raises the potential for initiating legal actions by third parties seeking the nullity of cascade divisional applications that had been previously accepted by IMPI. Parties may challenge the validity of these divisional applications based on the IMPI's interpretation of the law. Moreover, it could set a precedent, questioning the legitimacy of other cascade divisional applications, even those granted under different interpretations of the law.

Facing this uncertainty of IMPI's criteria, predicting the future of divisional applications becomes quite challenging. Therefore, it is essential to stay aware of this evolving patent landscape. This will enable patent holders to adapt and formulate appropriate strategies for the timely filing of divisional applications.

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# Using 'Common General Knowledge' to determine obviousness

**DPS Parmer, Special Counsel at LexOrbis, provides guidelines for the use of common general knowledge to support the application and subsequent approval of a patent in India.**

The term 'Common General knowledge' (CGK), though not found in the patent act and patent rule, is extensively relied upon in patent refusal reasoning and as grounds for invalidation of patents. What constitutes CGK remains elusive to understand at the time when the examiner/controller undertakes the exercise to look into the known aspects of the invention. The examiner in general is believed to have the background knowledge in the relevant art which they might have gained through, or are expected to have gained through, the study of basic hand-books and textbooks. What appears in these textbooks or handbooks is believed to be the undisputed knowledge that can qualify for being used to find obviousness in any invention.

DPS Parmer

Additionally, the knowledge commonly known and generally accepted by the large majority of those in the art may come from various sources like research papers, articles in journals, and magazines widely circulated among the subscribers. The later content, though widely circulated, alone would not make this content CGK. More so, the knowledge known to the workers that is available within closed walls of an industrial unit or research lab would not qualify as CGK.

Another pertinent point relating to the CGK is often raised that the CGK is not static, and it keeps on changing. It is true that CGK is not always stable and can switch to create new common knowledge. A well-known example in this regard often quoted is that for centuries it was common knowledge in Europe that the Sun revolved around the Earth, but after years of arguments, it is now common knowledge that the Earth revolves around the Sun. So, what was once considered common knowledge amongst a group, society, or community may later turn out to be false. Having said that, does it mean that CGK has no role to play in the determination of obviousness during the analysis of an invention for purpose section 2(1) (j), (ja), and section 2(l)?

## Common general knowledge v. common belief

Patent analysis by an examiner is usually done to prove certain facts based on known facts. Legally speaking, it is hard to define fact from common belief. Basically, common belief can be easily defined as its only requirement is for a majority of people within a specific group, community, or society to believe something to be true. On the other hand, CGK, in addition to meeting this requirement, should also be fact. It may be noted that, depending on the context and professional setting, many techniques may be employed in response to the question of distinguishing truth from fact in matters that have become CGK. However, in the legal setting, rules of evidence generally exclude hearsay, which may draw on "facts" someone believes to be "common knowledge".

## Common general knowledge and anticipation

Rules relating to the determination of anticipation are contained in Chapter VI (section 29-section 34) of the Patents Act, 1970 which states what is not an anticipation. There is nothing in this chapter that points towards CGK to state as a reason to deny a patent on the grounds of novelty. However, when it comes to grounds of opposition under section 25 (1) (c) (*inter alia* publicly known in India),25 (2) (d) (inter alia publicly known in India), and invalidation under section 64 (e) (*inter alia* publicly known in India) the question of common knowledge comes to the forefront. Regarding an investigation by an examiner, section 13 states "[...] anticipated by publication in India or elsewhere in any document," which means the examiner's investigation is limited to published documents. However, when it comes to the revocation of a patent, the invention may be hit by what is 'publicly known in India' before the priority date of the application.

## Combining common general knowledge with prior art for inventive step

'Inventive step' is defined under section 2(1) (ja) which states it "means a feature of an invention that involves technical advance as **compared to the existing knowledge [...] and that makes the invention not obvious to a person skilled in the Art.**" The 'existing knowledge' referred to here does include the CGK and the prior art and nothing else. Therefore, for inventive step analysis, the investigation into both would be mandatory. Further, for an objection of lack of inventive step, the relevant CGK is that knowledge which is known at the priority date of the claim in question. This means when the claim in question is filed by the applicant. The first reported case on the use of CGK for investigating the question of inventive step was *Automatic Coil Winder Co Ld. v. Taylor Electrical Instruments Ld.* (1944) 61 RPC 41 at page 43) where the Canadian court classified 'common general knowledge' as that knowledge which every worker in the art may be expected to have as part of their technical equip-ment. It is compounded by training, experience, observation, and reading. In this case, the court accepted the evidence of Dr Eccles, who could rely on his teaching experience. In relation to proof of exitance of CGK in patent matters a passage from Terrell on Law of Patents, 16th Edition, is worth noting, which states that:

> *"Proof of common knowledge is given by witnesses competent to speak upon the matter, who, to supplement their own recollections, may refer to standard works upon the subject which were published at the time and which were known to them. In order to establish whether something is common general knowledge, the first and most important step is to look at the sources from which the skilled addressee could acquire his information.*
> *The publication at or before the relevant date of other documents such as patent specifications may be to some extent prima facie evidence tending to show that the statements contained in them were part of the common knowledge, but is far from complete proof, as the statements may well have been discredited or forgotten or merely ignored. Evidence may, however, be given to prove that such statements did become part of the common knowledge."*

In a court situation, CGK may be established by the direct evidence of a person skilled in the art, but such advice is usually unavailable during the examination of the application to ascertain its patent eligibility.

> **"In the legal setting, rules of evidence generally exclude hearsay, which may draw on "facts" someone believes to be "common knowledge".**

## Evidentiary proof of CGK is necessary

It is common to raise the objection based on CGK at the stage of FER in India and other jurisdictions. But when the applicant's reply is received and the existence of CGK is contested, it is necessary that the contention of the examiner is supported by direct material evidence. The Australian Patent Office manual issued guidelines on use of CGK and particularly suggested that the examiner give evidence in support of CGK:

> *"Note, however, that when responding at further report stage, depending on the evidence and argument supplied by the applicant, it may be appropriate to support further arguments on the nature of the common general knowledge, by reference to written material."*

In the absence of such guidelines, the Controllers in India are inclined to raise objections, like prior art read with common general knowledge, to make the invention obvious by treating themselves as a person skilled in the art and who possess the common knowledge. Obviously, the result of such objection may lead to the refusal of a patent and that is what happened in the AGFA NV case where a patent was refused on this ground. Delhi High Court, while disposing of the appeal in *AGFA NV v. Asstt. Controller P&D (C.A.(COMM.IPD-PAT) 477/2022),* 2 June 2023, laid

## Résumé

**DPS Parmar, Former Technical Member (Patents), erstwhile Intellectual Property Appellate Board Special Counsel, LexOrbis**

DPS Parmar heads the Patents Contentious Practice Group at LexOrbis. After joining the IPAB as a Technical Member (Patents) in 2011, he has been instrumental in writing some path breaking and insightful decisions on Indian patent law issues. These include establishing legal positions on excluded subject matter under Section 3(d), 3(i), and 3(k), divisional applications, disclosure requirements under Section 8, working statements and compulsory license, to name a few. Before joining IPAB, Mr. Parmar worked with the Indian Patent Office (IPO) for over 27 years and had played a vital role both at the administrative and policy levels. He represented India at various rounds of discussions organized by the World Intellectual Property Organization (WIPO) and attended follow-on programs at the European and Japanese Patent Offices. He was instrumental in the recognition of IPO as the 15th ISA and IPEA under the Patent Cooperation Treaty (PCT). He also served as the head of the Intellectual Property Training Institute (IPTI) in Nagpur, which was responsible for providing training to new examiners at the IPO.

the rules in relation to the situations where proof in the form of evidence would be necessary to support the objection of exitance of CGK. Justice Amit Bansal examined the use of common knowledge in the context of patent law in various jurisdictions including India and ruled that:

*"37. In the present case, however, the Controller* ***has failed to give any source of the common knowledge that has been considered. Therefore, it cannot be construed as to what precise element of 'common general knowledge' has been considered along*** *with the cited prior art to claim that the combination of the teachings of the prior art and the 'common general knowledge' led to a finding of lack of inventive step."*

The Delhi High Court relied on Terrel (para referred ante) and observed that:

"34. […] for the Controller to rely on 'common general knowledge' as a ground for refusing a patent application, **it is essential to specify the source of the said knowledge**. It would be essential that the said source of the 'common general knowledge' would have been published before the priority date of the patent application. ***In addition, the fact that a theory or principle or knowledge has become common knowledge needs to be substantiated by some evidence. The said evidence could be in the form of references to the 'common general knowledge' textbooks or research articles or standard documents."***

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## Cautionary remarks

The value of CGK for the purpose of raising objections at the FER stage cannot be denied. But when the existence of such knowledge is disputed by the applicant in the reply to FER, the examiner/ controller would now be required to provide the substantive proof that could be in the form of references to CGK in textbooks, research articles, or standard documents. It is important to note that the Delhi High Court allowed the grant of the patent in the AGFA case for lack of evidence on CGK. Since this ruling on common general knowledge is binding on the IPO, CGPDTM may issue suitable guidelines to stay in tune with international practice on this issue. Expert opinion would be useful to deal with objections raised under section 2(1) (ja) where the examiner/ controller uses CGK to prove obviousness of the claimed invention.

# Current practice of patenting new crystalline forms of biologically active compounds in the Russian Federation

**Elena Nazina and Lev Zhilin of Gorodissky & Partners detail the changes to Rospatent's approach to the patentability of crystalline forms that are resulting in the termination of issuance or protection.**

A patent in the Russian Federation can be obtained both in accordance with the national patent legislation in the Federal Service for Intellectual Property (Rospatent), or/ and in accordance with the Eurasian patent legislation in the Eurasian Patent Office (EAPO).

Obtaining a patent for such inventions as a group of compounds, an individual chemical compound, or salts, esters, isomers thereof, as well as crystalline forms of the compound became possible in 1991 with the entry into force of the USSR Patent Law.

Until recently, the requirements and approaches for the examination of such inventions, in particular crystalline forms, were the same for national and Eurasian applications and were harmonized with many other jurisdictions.

The crystalline form of a compound in comparison with its amorphous form, as a rule, has a number of physicochemical properties providing it with certain advantages that make it possible to obtain, store, and use the drug more efficiently.

However, obtaining the crystalline form of a biologically active substance, both the first and subsequent, is a complex process with unpredictable results. Despite the fact that various methods of obtaining crystals are generally known, due to the many factors affecting the formation of a crystal and its growth, knowledge of the state of the art does not allow the inventor to predict in advance with confidence not only the conditions of obtaining a crystal, but even the possibility of formation of the crystal of a particular compound, not to mention physicochemical properties of the resulting crystalline form.

Elena Nazina

Lev Zhilin

Such principle was adhered to by Rospatent when examining inventions related to the crystalline forms of known compounds. The same is also adhered to by the EAPO up to date.

To obtain a national patent in Russia for the crystalline form of a known compound, it was previously sufficient to indicate and confirm that the crystalline form is new and has some improved properties, such as solubility, non-hygroscopicity, stability, etc., compared with the known crystalline form(s) or amorphous form of the compound. Such information is still sufficient for obtaining a patent for a new crystalline form for the Eurasian application.

Rospatent's approach has changed dramatically with the introduction of the following regulations in 2021 for some inventions:

***Item 83 of the Rules:***
*Not to be recognized as conforming to the condition of the inventive step, inventions which in particular are based on:*
*- the creation of a chemical compound that is a form of a known chemical compound (in particular, isomer, stereoisomer, enantiomer, amorphous or **crystalline form**) or its derivative (in particular, a salt, solvate, hydrate, complex compound or ester), if such compound does not exhibit **new qualitative or quantitative properties in comparison with known compound, which are not obvious for a specialist explicitly from the state of the art.***

***Item 55 (6) of the Requirements:***
*To confirm the possibility of implementing an invention related to a substance, the following information is provided:*
*6) if the invention relates to a chemical compound that is a form of a known chemical compound (in particular, an isomer, stereoisomer, enantiomer, amorphous or **crystalline form**) or its derivatives (in particular, salt, solvate, hydrate, complex compound or ester), then information is provided about its **new qualitative or quantitative properties in comparison with known compound, which are not obvious for a specialist explicitly from the state of the art** as well as the data reliably confirming such new properties.*

As can be seen, the additions introduced relate to the need to identify new properties for the forms or derivatives of the compound in comparison with properties known for the compound that do not follow explicitly from the state of the art for a specialist.



## Résumés

**Elena Nazina, Partner, Chief of Chemical & Life Science Department, Russian & Eurasian Patent Attorney**
Elena joined Gorodissky & Partners in 1999 and was promoted to partner in 2004. She is skilled in general organic, bio, agricultural, and petrochemistry, and also in pharmaceutics, perfumery, and cosmetics. She has vast experience in counseling Russian and foreign companies in the fields of pharmaceuticals, animal drugs, crop protection, and oil and gas refining on forming patent strategies in Russia and abroad. Elena represents clients before the Russian PTO and commercial courts, and also the Russian IP Court in objection cases against patent grants, court cases on infringement, etc. She also provides technical and legal evaluations for clients.

**Lev Zhilin, Russian and Eurasian Patent Attorney**
Lev graduated from the People's Friendship University of Russia in 2005. Till 2007 he worked as a patent expert in the Russian PTO. Since 2007 he has been with Gorodissky & Partners where he deals with the representation of Russian and foreign pharmaceutical, food, cosmetics, and chemical companies before Russian and Eurasian PTOs, and advises on patenting strategy in Russia and Eurasia. His areas of particular experience include: biologically active substances, in particular; drugs, veterinary drugs, detergents, disinfectants, cosmetics, perfumes, and their use; targeted medical products, means of diagnostics; treatment, prevention, and diagnosis methods. Lev represents clients before the Russian & Eurasian PTO in objection cases against patent grants.

Thus, in essence, the regulations were supplemented by the requirements for the listed subjects of the invention, which were actually applied by Rospatent when evaluating the inventive step thereof.

It is quite obvious that the amended regulations do not limit new qualitative and quantitative properties, of the new crystal form, which ensures that this form corresponds to the inventive step. Therefore, the **amendments made suggest that the crystalline form of the compound may have any new properties related to both biological activity and physicochemical properties** of the crystalline form, such as stability, non-hygro-scopicity, solubility, uniform particle size distribution, etc.

Consequently, said amendment in the regulations allow the applicant to provide data confirming those properties that were discovered and declared by the applicant in the description of the application as a technical result achieved during the implementation of the invention.

However, the current practice of Rospatent shows that, apparently, the introduction of the above requirements was used by Rospatent to tighten the requirements for establishing the patentability of crystalline forms, which in essence led to the termination of granting patents for inventions related to new crystalline forms of known compounds.

Despite the absence of any grounds in the amended requirements, Rospatent believes that the new crystalline form of a biologically active compound, both the first and subsequent, can be recognized as having the inventive step only if it has unexpectedly improved biological activity compared to the known non-crystalline and/or crystalline form of the compound.

As for other new improved and non-obvious properties of the new crystal form, namely, physico-chemical properties, from the point of view of Rospatent, such properties are obvious to a specialist in the art.

Common arguments and conclusions of Rospatent experts used to deny the inventive step of new crystal forms are the following:

- *It is well known that the crystalline forms of compounds are obtained in order to improve various physico-chemical properties, for example, stability, solubility, hygroscopicity, etc.;*

- *The state of the art discloses the general principles and methods for obtaining polymorphs with the necessary characteristics;*

- *The discovery of a new form of a known compound with a known activity is not sufficient for such form to meet of the inventive step patentability condition;*

- *Improvement of stability, solubility, bioavailability, non-hygroscopicity and others cannot be recognized as an unexpected technical result for a new crystalline form;*

- *There is no data in the application materials confirming the achievement of an unexpected technical result in terms of treatment when using the claimed crystalline form;*

- *An invention based on the choice of optimal or operating values of parameters is not recognized as conforming to the condition of the inventive step, if the influence of these parameters on the technical result is known, and if the choice can be made by the usual trial and error method or by using conventional technological methods.*

Thus, Rospatent believes that no technical results for a new crystalline form, apart from improved biological activity/therapeutic effect, can serve as a basis for recognizing its inventive step due to the fact that general methods for obtaining crystals are known and it is obvious to the specialist that: crystalline form of the compound might have improved physicochemical properties, how to obtain new crystal forms with the expected improved physicochemical properties, which, in fact, deprives such an invention of the inventive step.

The absence of experimental data confirming the improved biological activity/therapeutic effect of the new crystalline form in the application materials on the date of its filing with Rospatent may serve as a serious obstacle to obtaining a patent. The submission of such data during the examination of the application (which is allowed by national legislation) is currently considered by Rospatent as an *"indication of the technical result that is provided by the invention and is not related to the technical result disclosed in the original application documents"*. As a result, such data is often rejected by Rospatent, even though the relationship of biological activity/therapeutic effect with biological availability and solubility is obvious to a specialist.

At the same time, the process of obtaining a new crystalline form is recognized by Rospatent as an invention having an inventive step.

The current position of Rospatent has led to that, starting from the middle of 2021, the issuance of patents for inventions related to new crystalline forms of compounds, hydrates, solvates, co-crystals, has essentially ceased.

At the moment, the Chamber of Patent Disputes of Rospatent (CPD)/which is the first (administrative) instance for considering appeals against Rospatent's decisions, fully supports Rospatent's position and none of the appeals filed against decisions to refuse to grant patents for new crystalline forms of a known compound has been satisfied by CPD at the moment.

A certain optimism is caused by the position of the Intellectual Property Rights Court (IPC) and the IPC Presidium, which clearly disagree with Rospatent's position on the discussed issue, which is reflected in the decisions that have entered into force at the moment on several appeals against the decisions of the Rospatent (CPD) on the retention of Rospatent's decisions on crystalline forms. However, since the consideration of appeals is still ongoing in the IPC, it is too early to judge the prospects for patent protection of crystalline forms in Rospatent.

It should be noted that to date, the position of the EAPO with respect to the inventions relating to crystalline forms differs significantly from the current position of Rospatent. The EAPO issues patents for new crystalline forms of known biologically active compounds that exhibit any properties improved in comparison with that of the previously known form/forms of the compound.

Thus, when deciding to file a new application in Russia for an invention directed to a new crystalline form of a known compound, the applicant should carefully consider the choice of patenting procedure, taking into account the fact that without experimental data in the application materials contained on the date of its filing, confirming the improved biological activity/therapeutic effect of the new crystalline form in comparison with that of the known forms of the compound, obtaining a patent for a crystalline form in Rospatent is not guaranteed.

If an application for a new crystalline form has already been filed with Rospatent, taking into account the current position of Rospatent regarding the patentability of new crystalline forms, behind which, in fact, the goal is to terminate the issuance of national patents for crystalline forms, as well as, in light of the pending proceedings currently taking place in the CPD and IPC on applications related to crystalline forms, the main recommendation for the applicant may be to maintain the application in Rospatent in force. This can be done, in particular, by submitting a division application(s) in anticipation of a possible change in the position and practice of Rospatent.

**Starting from the middle of 2021, the issuance of patents for inventions related to new crystalline forms of compounds, hydrates, solvates, co-crystals, has essentially ceased.**

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# Fair hearing: mapping the intricacies of natural justice in intellectual property disputes

**Tusha Malhotra and Yamini Jaswal of Anand & Anand detail the components of a fair hearing with reference to various judicial precedents specific to patent cases.**

*Reasoning is the life of law and helps in the observance of the law of precedent.* It is a mandatory requirement of procedural law and an indispensable part of the basic rule of law. A litigant has a legitimate expectation of knowing reasons for the rejection of their claim, and a court's failure to give reasons amounts to the denial of justice. A reasoned judgment is primarily written to clarify one's thoughts, communicate the reasons for the decision to the concerned, and provide appropriate consideration by the appellate/higher court.[1]

In its broadest sense, natural justice may simply mean, "the natural sense of what is right and wrong" and in its technical sense it is often equated to 'fairness'.[2] By developing the principles of natural justice (*hereinafter* referred to as 'PNJ'), the Courts have devised guiding factors for a fair administrative procedure.

The PNJ are rooted in three cornerstones. Firstly, *nemo judex in causa sua*, the '**rule against bias**' which means that no person shall be a judge in their own cause. This guarantees that any authority entrusted with a hearing and judgment is impartial and acts without bias. Secondly, *audi alteram partem*, the '**right to fair hearing**' which creates an obligation on the adjudicating authority to hear the party concerned since no person should be censured unheard. Thirdly, the 'rule of speaking order/reasoned order' or 'the rule of reasoning', which imposes a duty on the authority to give reasons in support of the decision delivered by it.

In the year 1962, the Hon'ble Supreme Court of India[3] embarked on an expansionist course

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wherein it recognized the nature of the right affected and the power conferred on the authority with respect to the right of fair hearing given to the party concerned. Thereafter, several Courts have evolved the jurisprudence to reach a stage of universalization of the principals involved in hearings before the Courts as it insists that fair play applies to all proceedings, whether administrative or quasi-judicial in nature.

In the present article, the authors have endeavored to briefly encapsulate the components of fair hearing and the various judicial precedents, particularly in the intellectual property sphere with a special focus on patent cases.

a. **Notice:** It simply means making something known, of what a person was or might be ignorant of before. Any proceeding taken against a person without notice to them violates natural justice[4]. A notice, to be valid and effective, must be properly served on the concerned person. The notice must give the individual concerned sufficient time to enable them to prepare their defense and file their objections.[5] A notice not specifying the grounds is bad and would vitiate the entire proceedings.[6] The statutory provisions may ordinarily prescribe the form in which the notice is to be issued to the affected party.

b. **Disclosure of materials to the party:** The general principle is that no material should be relied on against a person, without them being given an opportunity of explaining them.[7]

c. **Hearing:** Lord Morris emphasized in *Ridge v. Baldwin*[8] that the essential requirements of natural justice at least include that before someone is condemned, they should have an opportunity to defend themselves.

d. **Receiving evidence in the presence of the other party:** Ordinarily, in an oral hearing, the ideal procedure is to take evidence against the party concerned in their presence.[9]

e. **Receiving evidence produced by the concerned person:** A basic principle of natural justice is that a party should have the opportunity to adduce all relevant evidence on which they rely.[10]

f. **Right to counsel:** In a case where complicated questions of law and fact arise, where evidence is elaborate and the party concerned may not be in a position to meet the situation themselves effectively, denial of legal assistance may amount to denial of natural justice. In India, certain statutes recognize the right to be represented through a lawyer.

g. **Reasoned decision:** In *Breen vs. A.E.U*[11], Lord Denning has emphasized that giving reasons for a decision is one of the fundamentals of good administration and it is a safeguard against arbitrariness on part of the decision maker. Further, every quasi-judicial order must be supported by reasons.[12]

## Scrutiny of natural justice by administrative and quasi-judicial authorities

In light of the evolution of the jurisprudence on fair hearing and corresponding judicial precedents, the principles of natural justice, while not enshrined under any law expressly, have been sufficiently effectuated and upheld. In the wake of the recent abolition of the Intellectual Property Appellate Board (*hereinafter* referred to as 'IPAB'), the decisions of the examiners under different statutory bodies have come under the scrutiny of the Courts which has effectively and fairly provided the aggrieved parties with a forum to seek remedy for technical, reason-based defaults and lapses by such authorities.

**Adequacy of reasons:** When a statute imposes the requirement of giving reasons for taking a decision, the provision is treated as mandatory and thus, the failure to give reasons would be fatal to the action taken. The statutory duty to record reasons for a decision can be enforced through a writ of *mandamus*. The recording of reasons ensures that the authority applies its mind to the case and that the reasons which impelled the authority to take the decision in question are germane to the content and scope of the power vested in the authority.[13]

It is not required that the reasons should be as elaborate as in the decision of a Court of law. What is necessary is that the reasons are clear and explicit so as to indicate that the authority has

> **"A litigant has a legitimate expectation of knowing reasons for the rejection of their claim, and a court's failure to give reasons amounts to the denial of justice."**

## Résumés

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1 Assistant Commissioner, Commercial Tax Department, Works Contract and *Leasing, Kotaa vs. Shukla and Brothers*, (2010) 4 SCC 785
2 WADE & FORSYTH: Administrative Law, 9th Edn., 2005, p.440
3 *Board of High School vs. Ghanshyam Das*, AIR 1962 SC 1110: 1962 Supp (3) SCR 36
4 *Abdul Ghaffar vs. State of U.P.*, AIR 1984 All 283
5 AIR 1982 MP 59
6 *Wirenetting Stores vs. Delhi Development Authority*, (1969) 3 SCC 415
7 *State of Madhya Pradesh vs. Chintaman*, AIR 1961 SC
8 (1964) AC 40
9 *Roshan Lal vs. Ishwar Dass*, AIR 1962 SC 646
10 *Union of India vs. T.R. Verma*, AIR 1957 SCC 882
11 (1971) 2 QB 175
12 *Siemens Engineering and Manufacturing Co. of India Ltd. vs. The Union of India*, AIR 1976 SC 1785
13 *Collector of Monghyr vs. Keshav Prashad*, AIR 1962 SC 1694

given due consideration to points in controversy. Recording of reasons guarantees consideration, introduces clarity, and minimizes chances of arbitrariness.

A mere repetition of the statutory language in the order does not make the order a reasoned one.[14] The Indian Supreme Court has stated that it is not necessary for the authority to 'write out a judgement as courts of law do'.[15] However, at least an 'outline of process' of reasoning must be given.[16] Further, administrative orders may not require as detailed reasons as court judgments, but they must still be supported by rationality.

The Indian Supreme Court feels that the judicial review over adjudicatory bodies would be very much weakened if such bodies do not give reasons for their decisions.[17] Also, if lower authorities do not give reasoned decisions then the higher authorities cannot effectively review their decisions. Thus, failure to give reasons by lower adjudicatory bodies effectively deprives the person affected of their right to seek review at a higher level even when they have a statutory right to do so.[18]

The Hon'ble Apex Court and the High Court of Delhi, have delivered well-reasoned and landmark decisions wherein they have elaborately expounded upon the principles of fair hearing, while emphasizing the sufficiency of reason in many orders.

i. **Transparency and clarity while considering claims:** In a case, the Hon'ble High Court of Delhi has held that in contentious patent disputes, given the seriousness and sensitivity of the issues involved, the Courts are supposed to lend their *imprimatur* to a proper procedure, or it would open floodgates for misuse. It may lead to the Patent Office unilaterally hearing one of the parties in the absence of the other and proceeding to take a decision. What may transpire during such a hearing would remain entirely a matter of conjecture. Such procedure cannot be permitted, if the rule of law is to be observed. Transparency and clarity as to what claims are being considered by the Patent Office ought to be clearly elaborated in its order.[19]

ii. **Notice of amendment of original claims:** Interestingly, in another case, the Hon'ble Delhi High Court observed that even if the amendment was trivial or insignificant in the perception of the patentee, it may not have been so, for the opponent and given an opportunity, it may have been able to justify the opposition. Therefore, holistically read, the impugned order suffered from legal infirmities, being a non-speaking and unreasoned order, besides there being violations of principles of natural justice.[20]

> **It, therefore, cannot be left to the applicant to deduce as to what is the known substance and thereafter give efficacy data.**

iii. **Reasoned and speaking order while refusing patent applications:** A Co-ordinate Bench of the Hon'ble Delhi High Court[21] remanded the matter back to the Competent Authority for fresh consideration on the ground that the decision refusing to grant the patent was unreasoned. Reliance was placed on the judgments of the Supreme Court[22], wherein it was categorically held that passing of a reasoned and a speaking order is an integral part of the principle of *audi alteram partem* and the application of mind and recording of reasoned decision are the basic elements of natural justice. There can be no doubt that scrupulous adherence to these principles would be required while rejecting patent applications.

iv. **Identification of known substance through notice:** In another case[23], the Patent Office rejected the patent application on the grounds of non-patentability under Section 3(d) of the Patents Act, 1970. However, the impugned order was rendered in the absence of the proper identification of the "known" substance in the hearing notice and without affording a proper opportunity for the applicant to respond to the same. Therefore, the High Court set aside the order and granted a fair opportunity to the applicant to respond and held that if an objection under Section 3(d) was to be raised, the pre-condition would be the identification of the "known" substance which could have been specifically mentioned in the hearing notice itself. It, therefore, cannot be left to the applicant to deduce as to what is the known substance and thereafter give efficacy data.

v. **Reasoning must be discernible:** The Hon'ble Delhi High Court, in another case[24] noted that no elaboration or reasons were given for lack of inventive step in the refusal order. It emphasized the degree of elaboration required for a speaking order. *It* held t*hat it is not the length of the order that matters. However, it is necessary that the deciding factors and reasoning must be discernible from the order which comes to a conclusion of grant or rejection.*

vi. **Real prejudice caused to the complainant:** In another case before the Hon'ble Delhi High Court[25], it was upheld that for the application of the concept of fair play, there must be flexibility. There must also *have been some real prejudice caused to the complainant and there is no such thing as a merely technical infringement of natural justice.* Further, in the said judgement it was held that a Writ petition is not maintainable if the petitioner has already availed an alternative remedy.

vii. **Order to include grounds of refusal/ acceptance and the material relied upon:** In another case[26] before the Hon'ble Delhi High Court, wherein a petition was filed challenging the order of the Registrar of trademarks by the Petitioner for the rejection of a trademark 'RELAXEDFIT'. The Hon'ble Court directed the Learned Registrar of Trademarks to pass an order as per the conditions under Section 18(5) of the Trade Marks Act *containing the grounds for refusal/conditional acceptance and material used by him in arriving at his decision to the applicant.* Ultimately, the Learned Judge passed orders to proceed with the registration of the Petitioner's mark.

viii. **Application of mind to be clear from the order:** In a very recent order[27], the Court has held that intellectual property rights are priceless, and are required to be scrupulously safeguarded. The entire industry is affected by a decision either to grant, or to refuse, a patent, and, in either case, the commercial and financial ramifications are huge. Incisive examination of the objections in the FER, and the response of the patent applicant thereto, must be manifest from the order passed by the Controller. There is no scope for any short shrift in the matter. At the very least, application of mind to the objections contained in the FER, *vis-à-vis* the defense of the patent applicant thereto, must be manifest from the decision of the Controller.

ix. **Patent Office to pass a speaking order:** In several decisions[28] passed by the Hon'ble Delhi High Court, it has been held that the Patent Office is required to pass a speaking order analyzing what is the existing knowledge and how the subject invention lacks inventiveness in light of the prior art.

> **The Courts have reaffirmed that natural justice is not a fixed but flexible concept.**

In view of the above discourse, the application of natural justice is to be regarded as a rule, its non-application, an exception, in administrative proceedings. Over a period of time, the Courts have reaffirmed that natural justice is not a fixed but flexible concept, there is no invariable standard of fair hearing, and each case has to be decided on its own merits.


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14 *Imperial Chemical Industries Ltd vs. Registrar of Trademarks*, AIR 1981 Del 190
15 *Bhagat Raja vs. Union of India*, AIR 1967 SC 1606
16 *Sri Rama Vilas Services vs. Chandrasekaran*, AIR 1965 SC 107
17 *Nagendra Nath Bora vs. Commissioner*, Hills Division, AIR 1958 SC 398
18 *Jagannath vs. Union of India*, AIR 1967 Del 121
19 *Natco Pharma Limited vs. Assistant Controller of Patents & Designs and Ors.*, Neutral Citation: 2023/DHC/000268
20 *Best Agrolife Limited vs. Deputy Controller of Patents and Anr.*, AIR 2022 (NOC 784) 369
21 *Agriboard LLC vs. Dy. Controller of Patents* Neutral Citation: 2022/DHC/001206
22 Assistant Commissioner, *Commercial Tax Department vs. Shukla and Brothers*, (2010)4 SCC 785 and *Manohar vs. State of Maharashtra & Ors.*, AIR 2013 SC 681
23 *DS Biopharma Limited vs. Controller of Patents* Neutral Citation: 2022/DHC/003563
24 *Gogoro Inc vs. Controller of Patents*, Neutral Citation: 2022/DHC/003259
25 Haryana Pesticides Manufactures Association vs. Willowood Chemicals Private Limited, Neutral Citation: 2022/DHC/3562
26 Skechers, USA INC II vs. Union of India and Ors. Neutral Citation: 2022/DHC/2633
27 Dr. Sapna Nangia vs. The Assistant Controller of Patents and Designs, C.A. (COMM IPD-PAT) 10/2022. Neutral Citation: 2023/DHC/1283
28 *Impact Selector International LLC vs. Controller of Patents* C.A.(COMM.IPD-PAT) 138/2022, *Auckland Uniservices Limited v. Assistant Controller of Patents and Designs* C.A. (Comm-IPD-Pat)8/2022, *N.V. Satheesh Madhav and Anr. v. Deputy Controller of Patents and Designs* 2022 SCC OnLine Del 4568 and *Alfred Von Schukmann v. The Controller General of Patents, Designs and Trademarks and Ors* C.A.(COMM.IPD-PAT) 435/2022

# Eurasian Patent Office: further developments in Eurasian designs

**Dr. Alexey Vakhnin discusses current developments of Eurasian Designs at the EAPO with Dr. Grigory Ivliev, the President of the Eurasian Patent Office. We are glad to introduce, prepared exclusively for *The Patent Lawyer* magazine, the summary of the recent developments of the Eurasian Patent System.**

**Mr. Grigory Ivliev, last year you became the Head of the Eurasian Patent Office (EAPO). Could you tell our readers what kind of organization it is? What role does it play in the modern world of intellectual property? What countries are currently represented in it?**

The Eurasian Patent Organization is an independent, intergovernmental organization established under the Eurasian Patent Convention. Next year the EAPO will celebrate its 30th anniversary. Currently, it is one of the most successful and major integration projects in the Eurasian space.

The Eurasian Patent Organization consists of eight states: Turkmenistan, the Republic of Belarus, the Republic of Tajikistan, the Russian Federation, the Republic of Kazakhstan, the Republic of Azerbaijan, the Kyrgyz Republic, and the Republic of Armenia. The Organization has thus become one of the largest regional patent systems in the world to provide legal protection for inventions and industrial designs on the vast territory of the Eurasian continent, which covers more than 21 million km2 with a total GDP of about 1.8 trillion dollars and a population of more than 810 million people.

The Eurasian patent is valid on the territory of eight EAPO Member States. This is a cost-effective and simple procedure for obtaining protection by filing one application in one language and paying one set of fees. The patent does not require additional validation in the EAPO Member States. The regional legal protection reduces impediments to mutual trade and promotes economic activity in the region.

Dr. Alexey Vakhnin

Dr. Grigory Ivliev

The users of the Eurasian Patent System are applicants from more than 130 countries. More than 500 Eurasian patent attorneys represent their interests. I would like to mention that the EAPO started to cooperate with the Assembly of Eurasian Patent Attorneys in April this year. The Assembly has become an important source of information on law enforcement practice and the needs of applicants, businesses, and inventors, as well as a platform for the formation of a consolidated opinion of patent attorneys on the improvement of regulations and approaches to examination.

The EAPO implements Patent Prosecution Highway (PPH) programs under bilateral agreements with a number of patent offices (Japan (JPO), the People's Republic of China (CNIPA), the Republic of Korea (KIPO). Currently, we are negotiating with the patent offices of India and Brazil.

Since July 1, 2022, the EAPO has been functioning as an International Searching Authority and an International Preliminary Examining Authority within the PCT system. The patent offices of seven countries have already recognized the EAPO as a competent ISA.

**The Protocol to the Eurasian Patent Convention (EAPC) on the Protection of Industrial Designs (Protocol to the EAPC) was signed in 2019. What guided the EAPC member states when they signed this document?**

This was a step to improve the regional system for the legal protection of intellectual property for the benefit of users of our system from all over the world. I would like to mention that applicants from more than 130 countries use the Eurasian regional system. Currently, they can use different mechanisms for obtaining an industrial design patent in the Eurasian space, depending on their business interests and development strategy. It is possible to choose a national registration system, obtain national patents in several states, use the regional system for protection by obtaining a single Eurasian patent, or use the Hague System for the International Registration of Industrial Designs.

An applicant can initiate an international patenting procedure by selecting the jurisdictions they are interested in. However, it is important to realize that each patent office will make a separate decision in accordance with the requirements of national legislation.

Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Russia, and Tajikistan are the Member States of the Protocol to the EAPC. In this case, if you obtain a Eurasian patent, you receive legal protection in the territory of seven states.

**Could you please describe the main features of filing a Eurasian industrial design application?**

In order to obtain legal protection for an industrial design simultaneously in the territory of seven states, it is necessary to file only one Eurasian application in one language. Such Eurasian applications may include up to one hundred industrial designs from one class of the International Classification for Industrial Designs (ICID). At the same time, these designs do not necessarily have to be interconnected by a single creative concept. Each design can have its own features.

When applying for a Eurasian industrial design patent, the "Single Window" principle applies. It means that all stages of examination and granting of a unitary patent are carried out at the Eurasian Patent Office (EAPO) with the payment of one set of fees in one currency. If necessary, only one patent attorney is appointed to deal with the EAPO.

As for similarities, the registration procedure in the EAPO, as in many national offices, consists of a preliminary examination and a substantive examination, as well as the registration of the industrial design and the granting of a patent in the case of a favorable decision. One of the procedural features is the mandatory publication of the Eurasian application.

**When is an application for a Eurasian industrial design patent published in the public access?**

The application is published after the completion of a preliminary examination with a successful outcome. After publication, third parties, including national patent offices of the States Parties to


## Résumé

**Dr. Grigory Ivliev** is EAPO President. He is a Former Head of the Federal Service for Intellectual Property (Rospatent).

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 a Eurasian Patent Attorney, Patent and Trademark Attorney of the Russian Federation.

Dr. Vakhnin is a Council member of the recently founded Assembly of Eurasian Patent Attorneys; vice-president of the Chamber of Patent Attorneys of the Russian Federation; member of INTA, FICPI, AIPPI, LES Russia/LESI, PTMG, ECTA, etc.

Alexey is Partner and Managing Director of Vakhnina and Partners.

the Protocol to the EAPC, may, within two months from the date of publication of the Eurasian application, file an opposition against the grant of a Eurasian patent if it is provided for by the national legislation.

This stage of the so-called "pre-registration opposition" is also part of the substantive examination. The EAPO conducts the examination with due regard to the opposition against the grant of a Eurasian patent.

At the same time, some of the examinations provided for in the Patent Regulations to the EAPC (Patent Regulations), are carried out *ex officio*, i.e., without additional requests by third parties. In particular, industrial designs are subject to examination even if there are no oppositions from third parties, if they include official and state symbols or cultural heritage items, if the product appearance is contrary to public interests or the principles of humanity and morality, or if all its features are solely driven by the product's technical function.

**What are the grounds for invalidating a granted Eurasian industrial design patent?**

For example, the existence of information confirming that an industrial design does not meet the patentability criteria, where the design has been previously disclosed and is not new or original. The patent may then be invalidated by the EAPO under the administrative revocation procedure.

**To what extent does such a system meet the interests of the applicant?**

It fully meets the interests of all market participants. The applicant undergoes a fairly rapid registration procedure by using the Eurasian system. At the same time, stakeholders, whose rights or interests may be affected, have an opportunity to present their views on a particular industrial design using the mechanisms of "pre-registration" and "post-registration" opposition.

**How do such approaches correlate with global practice?**

Different approaches to the registration of industrial designs are applied worldwide. There are registration, examination, and partial registration systems.

Approaches in line with current trends were chosen when creating the Eurasian system. As I have mentioned earlier, industrial design, along with a trademark, plays an important role in business strategy, promoting products, and strengthening market positions. Therefore, long-term examinations that include information searches in both patent and non-patent data sources can be a significant obstacle for businesses. Deep search significantly influences the duration of examination and the timeframe for deciding on the application, but it cannot completely exclude the possibility of disputes.

> **The Eurasian system for the registration of industrial designs is a very convenient tool for the centralized recording of agreements concerning the disposal of one's exclusive right.**

The evaluation of the "originality" of an industrial design is always subjective in all offices around the world. The positions of market participants in supplementing the registers of protected industrial designs with new solutions contribute to the formation of a balanced system for the protection and enforcement of intellectual property rights. In turn, the administrative dispute resolution procedure in the EAPO reduces the burden on the judicial and competent authorities of the EAPC Member States.

In general, the procedure based, *inter alia*, on the opposition system encourages applicants and right holders to be more careful in developing their designs and to treat their exclusive rights seriously.

**Could you please provide an example?**

For example, products designed for interior decoration, such as cornices, moldings, skirting boards, and decorative panels, have been patented under the Eurasian system. This year, these Eurasian patents have been subject to an administrative revocation. Some patents have been invalidated on the basis of evidence collected by a third party. One patent has been upheld on the basis of the patent owner's position and analysis of all the arguments presented. Some of the oppositions are under consideration. There are examples of oppositions filed after the publication of Eurasian applications. During the substantive examination, a favorable decision was made in one case, and in another, a decision was made refusing the grant of a Eurasian patent.

Thus, both the examination and the collegium thoroughly examine both the arguments of market participants, who state their position on the patentability of the industrial design, and of applicants and patent owners, who use the Eurasian patent system.

Another characteristic of the Eurasian patent procedure is the following. We examine whether the industrial design does not belong to solutions whose essential features are obviously not derived from the creative nature of the product's features. This enables us to exclude or minimize the risk of obtaining exclusive rights and, consequently, the monopoly on apparently non-original products due to the possible lack of oppositions.

Our system also allows for the mediation of disputes in connection with the use of a copyright object in an industrial design that is known on the territory of at least one of the EAPC Member States and whose rights arose before the priority date of the industrial design. We are now studying the possibility of settling disputes through mediation in cases where the industrial design involves an element confusingly similar or identical to the trademarks of other persons or where the industrial design completely embodies another person's trademark.

**How does the Eurasian system handle the transfer of rights?**

The Eurasian system for the registration of industrial designs is a very convenient tool for the centralized recording of agreements concerning the disposal of one's exclusive rights. The exclusive right to an industrial design protected by a Eurasian patent, as well as the right to an industrial design protected by a national patent, may be transferred to another person by agreement or become a subject of pledge. The right to use a protected industrial design may be granted through license agreements. Since the Eurasian patent is valid on the territory of seven Eurasian states, it can be a convenient tool for a patent owner to centrally control and record the results of the management of their intangible assets in Eurasia.

The EAPO frequently deals with agreements on the transfer of the right to obtain a Eurasian industrial design patent, agreements on the transfer of an already registered exclusive right, and license agreements for the use of industrial designs protected by Eurasian patents.

It demonstrates that industrial designs are not only patented but also actively used by patent holders as an intangible asset.

**Are there any other arguments that may inspire businesses to obtain Eurasian patents?**

When a Eurasian patent is obtained, the patent owner receives industrial design protection for five years with no annual maintenance required, which is very convenient.

The term of a Eurasian patent is calculated from the filing date of the Eurasian application and may be extended for each subsequent five-year term. The maximum term of a Eurasian patent may be 25 years from the filing date of the Eurasian application.

**What are the available options for applying for a Eurasian industrial design patent?**

We pay great attention to the development of our digital services so that applicants can interact with our Office easily. A Eurasian application can be submitted either on paper or in electronic form. Electronic Eurasian applications are submitted through the EAPO-ONLINE system. It enables us to register the date of application receipt, monitor the current status of the application file, and receive notifications on receipt of new correspondence from the EAPO.

**How popular is the Eurasian system for registration of industrial designs with applicants?**

We are recording a steady growth in the number of applications thanks to our advantages, which include coverage of an entire region with a single application, ease of processing, rapid registration, cost and time savings, and centralized asset management.

> **When a Eurasian patent is obtained, the patent owner receives industrial design protection for five years with no annual maintenance required.**

The EAPO started receiving applications on June 1, 2021. While we received 92 applications for 190 industrial designs from June to December 2021, in 2022 we received 233 applications for 639 industrial designs in 12 months.

The number of applications has more than doubled if we compare the figures for the first half of 2022 with those for the same period in 2023. The number of industrial designs is also increasing. In the first half of 2022, the EAPO received 65 applications for 236 industrial designs, while in the same period in 2023, it received 143 applications for 328 industrial designs. The EAPO has granted 320 Eurasian patents containing 808 industrial designs so far.

The geographic diversity of applicants is expanding. The EAPO has received applications from residents of 24 countries. These include both EAPC Member States and other jurisdictions, such as the USA, Germany, Turkey, Singapore, Finland, China, and others.

**What are the upcoming development prospects of the regional system for industrial design protection?**

We expect Turkmenistan to join the system in the near future. And our system, as well as the system for the legal protection of inventions, will be valid for all eight EAPC Member States. We also intend to join the Hague System for the International Registration of Industrial Designs. Then potential applicants from all over the world will be able to specify a whole region as the intended territory of protection when filing one Hague application with the International Bureau

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FURTHER DEVELOPMENTS IN EURASIAN DESIGNS

# Suspension of examination for divisional applications in Japan while parent is under appeal

**Debora Cheng of Sonoda & Kobayashi Intellectual Property Law details the process, eligibility, advantages, and disadvantages of the introduction of this new practice.**

The concept of a divisional application within the Japanese patent system is partially akin to that found in other legal jurisdictions, e.g., trademark and design. Article 44 of the Patent Act outlines the procedure for dividing patent applications, allowing applicants to create new patent applications from portions of an original application containing multiple inventions. When a division occurs, the new application is retroactively considered to have been filed at the same time as the original application. This divisional application mechanism is designed to offer maximum legal protection for inventions within patent applications that lack unity, in line with the overarching purpose of the patent system – to grant exclusive rights for a set duration in exchange for public disclosure.

Notably, the strategic utilization of divisional applications in Japan offers several advantages.

Debora Cheng

In cases where an original application is rejected, including instances of a "Decision of Rejection" or Final Office Action, the disputed inventions can remain in the original application and be contested via written opinions or amendments.


## Résumé

**Debora Cheng** is a New Zealand Lawyer in the International Affairs Department at Sonoda & Kobayashi Intellectual Property Law. She graduated from the University of Auckland Law School and was admitted as a Barrister and Solicitor of the High Court of New Zealand in October 2022.

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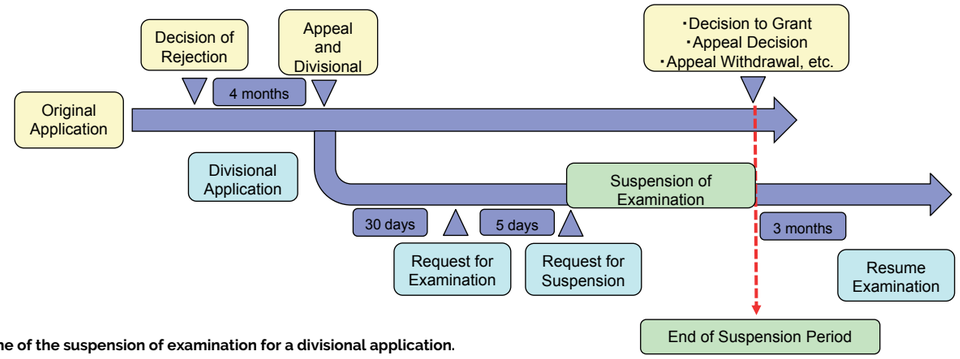
Simultaneously, inventions unaffected by the rejection grounds can be separately filed in a divisional application.

Another advantage to divisional application, also found in other jurisdictions, is the ability to secure a retroactive effect, where the divisional application is treated as though it were filed concurrently with the original application. Failure to attain retroactive effect due to an improper division[1] results in the application being treated as filed on the division's actual filing date, depriving it of the benefits associated with the original filing date.

## New practice: suspension of examination for divisional applications




**Timeline of the suspension of examination for a divisional application.**

Beginning April 1, 2023, the Japan Patent Office (JPO) introduced a new practice pertaining to divisional patent applications, allowing applicants to suspend the examination of a divisional patent application while the parent (original) application remains under appeal. This suspension remains in effect until three months following the conclusion of a pre-appeal reexamination or an appeal examination pertaining to the parent application. Importantly, this new practice applies solely to divisional applications for which a Request for Examination is submitted on or after April 1, 2023.

In the realm of Japanese patent practice, since there is no guarantee under the Patent Act that an opportunity for filing a divisional application is obtained during an appeal, in many cases, the final opportunity to file a divisional application is the same period in which an appeal can be filed against the rejection decision for a parent application by the Examiner[2]. As such, it is common for applicants considering an appeal to simultaneously consider the filing of a divisional application as a precautionary measure to mitigate risk. However, as both the divisional and parent applications are processed concurrently by the JPO, there is a possibility that a first Office Action is issued for the divisional application before the outcome of the appeal for the parent application is revealed. This forces applicants to address the divisional application's Office Action without the benefit of knowing the result of the parent application's appeal. This predicament is less than optimal, as most applicants prefer to handle the two cases sequentially, where they wait on results from the parent application first and modify or withdraw the divisional application based on those results.

Under the new practice introduced by the JPO, applicants can request the suspension of substantial examination for a divisional patent application. This option becomes available when the divisional application is filed after the issuance of a Decision of Rejection concerning the parent application. This suspension of examination falls under the provisions of Patent Law Article 54, Paragraph 1. The suspension remains in effect until three months after the conclusion of a pre-appeal reexamination or appeal examination relating to the parent application.

## Criteria for eligibility and procedural steps

Several criteria govern the eligibility of patent applications for the new practice of suspension:

1. The subject applications must be divisional applications filed after the issuance of a Decision of Rejection by the Examiner in relation to the parent application.

2. An Appeal must have been filed against the rejection imposed on the parent application.

3. The parent application must be pending preliminary examination or undergoing appeal examination by the Board of Appeal.

4. Waiting for the outcome of preliminary examination or examination by the Board of Appeal should be deemed suitable.

To request suspension, the following procedural steps are required:

1. Submission of a petition outlining the circumstances necessitating the suspension of examination in line with Article 54, Paragraph 1 of the Japanese Patent Law.

2. Provision of a statement in a specified format, explaining the circumstances leading to the request for suspension of examination as per Article 54, Paragraph 1 of the Japanese Patent Law.

Both procedures 1 and 2 described above must be done within five working days from the filing of the request for examination for the divisional application. Note that the request for suspension incurs no JPO official fees.

## Following the request for suspension

Once the request for suspension of examination is made and accepted, the examination of the divisional application will be suspended until three months after the below-mentioned scenarios of 1 or 2 as long as the appeal is not dismissed or withdrawn:

1. A Decision to Grant is issued for the parent application based on the preliminary examination;

2. The first Appeal Decision is issued concerning the appeal; or

It is crucial to note that retracting a Request for Suspension of Examination is not permitted.

## Strategic implications and considerations

The new practice of suspending examination for divisional applications introduces several advantages and disadvantages, influencing the strategies adopted by applicants:

**Advantages:**

1. Informed decision-making: applicants gain the ability to tailor their divisional application based on the outcome of the parent application's rejection appeal, thus devising a more efficient and effective overall strategy.

2. Enhanced examination efficiency: the divisional application's examination can be conducted with greater efficiency, as the examiner can take the results of the parent application's reexamination or appeal into account. As such, this potentially reduces the burden of examination on the applicant's side.

> **The introduction of the option of suspending examination for divisional applications in Japan marks a significant improvement in the patent filing system.**

Moreover, applying for the suspension of a divisional patent application can be useful in maximizing time for amending divisional applications for certain filing strategies, including:

- When industrial standards are under discussion but yet to be finalized, keeping a divisional application pending until the finalization of standards allows for subsequent adjustments to claims.

- For pharmaceutical inventions where the authority acknowledges the effectiveness of the same compound/molecule for different indications one by one, keeping a patent with the first indication pending until the subsequent indications are authorized allows amendments to be made to target the authorized indications through divisional applications.

**Disadvantages:**

Delayed rights acquisition: the suspension approach precludes the early acquisition of rights for the divisional application.

Waiting period: despite substantially determining the divisional application's claims, the applicant must wait for the parent application's outcome.

Cost: the official fee for the examination of a divisional application must be paid before the appeal result is issued. As the fee is calculated based on the number of claims, it is recommended to reduce the number of claims to one, which can be later increased after the result of the appeal is revealed, so long as the amendment is submitted before the first Office Action is issued.

The introduction of the option of suspending examination for divisional applications in Japan marks a significant improvement in the patent filing system. By offering the option to defer examination until the resolution of a parent application's appeal, this practice allows for greater examination efficiency as well as enabling applicants to make more informed decisions and devise more efficient filing strategies.

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[1] An improper division is, for example, when the division is made at an inappropriate time, or when the divisional application introduces new matter that is not present in the original application.

[2] On the other hand, if an Office Action is issued during a pre-appeal reexamination or an appeal examination, a divisional application can be filed in the response period.

# Creating patentable AI inventions according to EPO standards

**Robert Klinski, founder of Patentship, explains the patentability criteria for filling a grantable application for AI inventions at the European Patent Office.**

AI serves as a powerful catalyst for technology as it enables myriads of new applications requiring specifically arranged processing platforms. The real-world impact of AI is best demonstrated with a look at the stock market: a multi-month bear market has been reversed on a dime with the publication of ChatGPT, a pre-trained AI language model that gives a first glimpse into the AI universe. The technology sector, in particular the chips manufacturer, has switched into turbo-mode in expectation of new market opportunities.

AI is clearly a disruptive technology that has already entered the technology growth stage and captured the attention of R&D departments in a majority of technology companies. The financial sector, notably hedge funds like Citadel, is fueling this development with massive investments in AI-related technologies.

The flip side of this disruptive, parabolic development of AI technologies is that not only R&D departments but also patent offices have been "caught cold" as to how to handle AI-related technologies.

The crucial question for the assessment of whether an AI invention is patentable or not is whether an AI invention is allocated in a technical domain, i.e., serves a technical problem. Unfortunately, different patent offices have different answers to this question, which makes establishing a unified AI patenting strategy difficult.

For example, the USPTO and the JPTO currently deploy a less restrictive approach to assess the patentability of AI inventions. The most recent patent grants show that AI core inventions have already been patented in the USA and Japan.

In contrast, the EPO holds a rather restrictive stance and assesses AI-implemented inventions in general and AI core inventions in particular, which may result in a situation where the same AI invention will be patented at the USPTO and JPTO but rejected by the EPO.

> **"Most recent patent grants show that AI core inventions have already been patented in the USA and Japan."**

More specifically, the EPO requires that a patentable invention make a reproducible contribution to the technical solution of a technical problem. Therefore, AI core inventions addressing, for example, AI structures as such, are regarded by the EPO as non-patentable mathematical methods that are not associated with any technical purpose. On a side note, the often-overlooked reproducibility requirement prevents patenting AI "black box" implementations at the EPO.

Surprisingly, the often-overlooked key hurdle for obtaining an AI patent at the EPO is inventive step. In this regard, the EPO has developed a unique problem-solution approach, requiring that an invention involving an inventive step must technically solve a technical problem. For example, a software invention solving an accounting problem with accounting methods does not *per se* involve an inventive step because neither accounting nor accounting methods serve a technical purpose.

The situation gets, however, more complicated when a software invention is technical, which is often the case with AI inventions. Who would deny that AI controlling an autonomous industrial truck does not serve a technical purpose?

In these situations, the EPO makes use of the principles for assessing inventive step of software inventions set forth by EPO's landmark decision T 0641/00, often referred to as COMVIK-decision, stating: "an invention consisting of a mixture of technical and non-technical features and having technical character as a whole is to be assessed with respect to the requirement of inventive step by taking account of all those features which contribute to said technical character whereas features making no such contribution

cannot support the presence of inventive step."

As a result, despite the possible technical character of an invention as claimed, the EPO can just ignore or blend out particular claimed features of a claim that do not appear to contribute to a technical solution to a technical problem. This may have unexpected consequences for the assessment of an inventive step, in particular, if the ignored claim features are actually essential to define an invention this thereby renders the remaining claim plain common knowledge. Take as an example a computer system with a processor implementing an AI core to classify data records received from an autonomous truck over a communication interface. The EPO would probably ignore the feature referring to the AI core classifying data records when assessing the inventive step, and examine the claim remainder, i.e., a computer system having just a processor and an interface without any further functionality. Clearly, such a computer system stripped of any functionality forms common knowledge and does not involve an inventive step.

Nevertheless, AI inventions are patentable at the EPO, provided you know exactly how to draft sustainable AI claims. In other words, expert claim drafting is essential for obtaining an AI patent.

As to patenting AI, it should be noted that every AI application includes two phases: the first phase is the training of an AI model with training data to obtain a trained AI model; the second phase is the deployment of the trained AI model to achieve a certain task.

Usually, these phases are separated from each other, which is best shown with: the development training of the AI model behind ChatGPT is performed by the OpenAI LP, i.e., a profit-oriented company. The resulting, trained AI model is provided by the OpenAI LP as a software product to its users who deploy the trained AI model in various applications. Clearly, the OpenAI LP generates revenue by providing the trained AI implementation to its users. In fact, developing and training the AI model is comparable to programming a software product. Usually, the training phase *per se* does not form a paid service. Rather, the users are paying for the use of the implemented software product.

The above example provides a first hint towards generating valuable AI patents: Training an AI model with training data and deploying the trained AI model for a technical purpose shall, if feasible, be claimed separately with distinct sets of claims. Clearly, there are scenarios as well where an AI model is trained and utilized by a customer, for example when an AI model controlling a robot is trained during robot operations. In such exceptional cases, training and deploying an AI model should be claimed within the same set of claims.

> **AI application includes two phases: the first phase is the training of an AI model with training data to obtain a trained AI model; the second phase is the deployment of the trained AI model to achieve a certain task.**

### 1. Patenting the training of AI models with data

In order to obtain a patent directed to training AI, the characteristics of data used for training the AI model are decisive for obtaining a patent at the EPO. In this context, please recall that the EPO does not consider AI models patentable as such. However, training an AI model with specific data for a specific technical task, i.e., specifically provisioning an AI model, is considered by the EPO as a technical purpose and therefore accessible to patent protection.

Interestingly, the EPO makes a distinction where the data used for training an AI model originates from. Clearly, the AI models can be trained on the basis of simulated data originating, e.g., from a simulated digital twin of an environment. For example, an AI model for controlling the operations of an autonomous industrial truck in an environment can equally be trained with "real world data" originating from sensing the environment or with simulated data originating from simulations of a digital twin of the real-world environment.

Training the AI model with simulated data is actually a computer simulation of a technical system. Such a computer simulation is, according to the EPO (decision G 001/19), not sufficient to overcome the patentability hurdle of the EPO. In consequence, AI inventions directed to training an AI model upon the basis of a computer simulation of a physical system such as an environment may be considered by the EPO as non-patentable.

Conversely, physical interaction with the "real world", such as the environment of an autonomous truck, when training an AI model may render a corresponding invention patentable. This implies, for example, that the training data used for training an AI model shall directly originate from, e.g., physical measurements of the physical environment, which may be taken by the autonomous industrial truck when moving within that environment. Paradoxically, the same AI invention may be considered patentable or not patentable by the EPO depending on the way the data utilized for training an AI model is generated.

> **The same AI invention may be considered patentable or not patentable by the EPO depending on the way the data utilized for training an AI model is generated.**

### 2. Patenting specifically adapted AI implementations

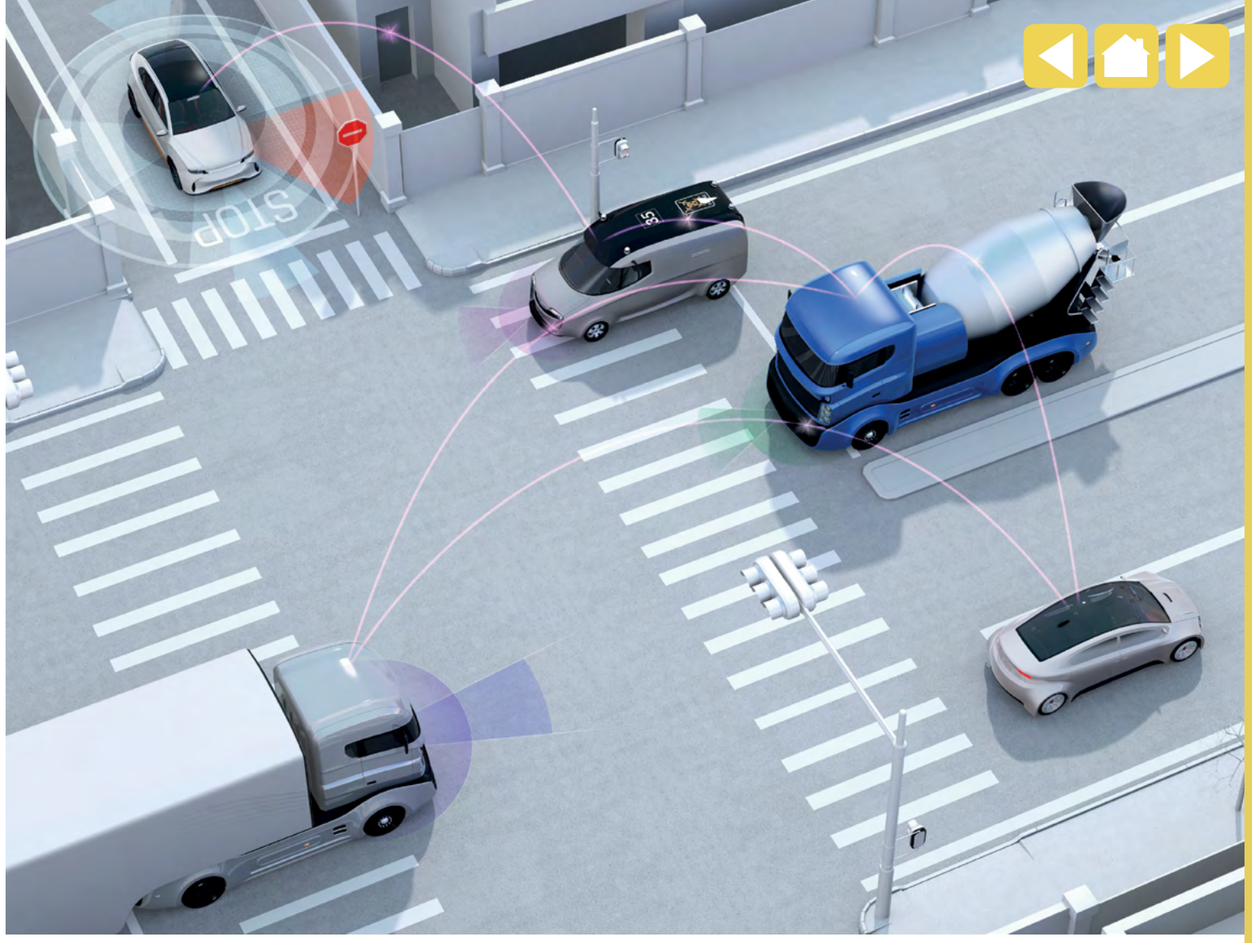
A second cluster of AI inventions that are patentable at the EPO addresses AI that is specifically adapted to solve a technical problem in the context of a technical application. An example of a patentable AI application is the specific use of a neural network in a heart monitoring apparatus for the purpose of identifying irregular heartbeats. Here, AI is a tool deployed in the context of a technical application.

The above examples of patentable AI inventions may serve as a blueprint for patenting AI at the EPO. Take as an example a hypothetical IP portfolio that should be developed to cover AI control of movements of autonomous industrial trucks in a closed indoor environment, e.g., an industrial storage area. Such autonomous trucks are prone to collisions with other autonomous trucks and with storage disposed in the area. Moreover, the environment layout may change


## Résumé

**Robert Klinski** is a German and European patent, trademark, and design attorney, and the founder of Patentship. 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. Dr Klinski 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 300 inventions. Dr Klinski 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



due to storage disposed of by the industrial trucks in the storage area.

Clearly, the AI model used for controlling autonomous trucks must be trained specifically with regard to the storage area. Unfortunately, a digital twin of the storage with simulated autonomous trucks could render the inventions directed to training the AI model not patentable.

For this reason, the data for training the AI model should be collected during the operation of the autonomous trucks in order to obtain a patentable invention. This restriction appears to be acceptable as it reflects dynamically changing environments in our simplified example.

In order to provide the data for training the AI model, the autonomous trucks can be equipped with a positioning system indicating current positions as well as movements of the autonomous trucks. Moreover, the digital trucks shall also send position information indicating the current position of disposed storage goods forming an obstacle for the industrial trucks. On the basis of such information, the AI model can dynamically be trained and adapted to the changing environment for controlling the movements of the autonomous trucks. The benefit of AI is clearly the ability to react quickly to changing environments without the necessity of running complex optimization algorithms to find optimum routes for autonomous trucks in rapidly changing conditions.

In the above example, the dynamically trained AI model is specifically deployed to control the operations of the autonomous trucks to determine the most efficient truck movements within the storage area based on the actual position information of the autonomous trucks and the disposed storage goods. This requires interaction with the "real world" which may render the AI implementation patentable.

A further enhancement of the above idea could be the deployment of a 5G network architecture to provide fast communications to a server implementing the AI control. Such a specific network architecture could be implemented as a 5G network slice providing the necessary functionality to dynamically train an AI model for autonomous truck control. Such a specifically designed 5G slice could implement a patentable business case by providing the 5G slice functionality as a service for dynamically controlling autonomous trucks in indoor environments.

The above example may serve as a blueprint for systematically generating valuable AI inventions that are possibly patentable at the EPO despite its currently restrictive stance on AI. With this knowledge, you can design and patent a sustainable IP portfolio worldwide that can cover future AI applications.

> **"The EPO does not consider AI models patentable as such."**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