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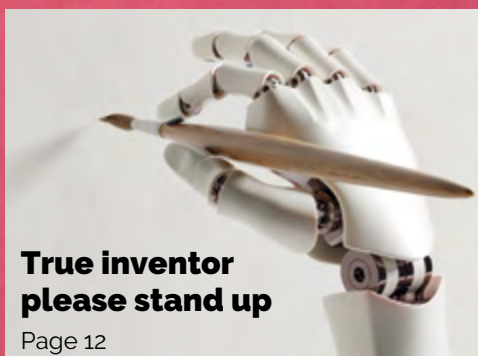
March /
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The power of paralegals post-pandemic


IP TrendMonitor

The Patent Lawyer investigates the changing legal landscape that has resulted in a shift in the function of paralegals, discovering how one particular solutions provider is opening the door to new opportunities for leveling up in the patent space.



**True inventor
please stand up**

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Editor's welcome



Recent years have seen a huge shift in the ways of working, forced first by the pandemic and encouraged by the continued evolution of technology. One positive outcome is the evolution of the role of the paralegal which, if harnessed correctly, could greatly benefit law firms now and in the future. Our cover story this issue investigates how one recent entrant to the service provider space, iPify, is empowering IP professionals to optimize the benefits of this shifting role.

Our guest interview this issue is with Helen Kemmitt, GC at Quant, a service provider in the blockchain economy field. Helen describes the Overledger platform making blockchain accessible to all along with her excitement around Quant's growing patent portfolio.

Further, we delve into the continued debate over AI inventorship; review standpoints on IPR estoppel and products that are splitting courts; assess strategies for inventor interviews; debate the possibilities for the revocation of evergreen patents; and much more!

Also find the latest IP Trend Monitor in collaboration with the Dennemeyer Group which focuses on projections for eight industries that are pivotal for the global economy.

Our *Women in IP Leadership* segment features Jamie Soon-Kesteloot, Head of Innovation Protection and Valorisation, EssilorLuxottica & President of I3PM, and Jacinthe Tay, Qualified European Patent Attorney. Special thanks to Clarivate for sponsoring the segment, supporting a platform to encourage the continued empowerment of women in the sector.

We hope you enjoy the issue!

Faye Waterford, Editor

Mission statement

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

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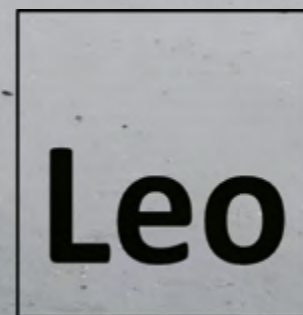
Osamu is a patent attorney specializing in the fields of biotechnology, pharmaceuticals and diagnostics. Osamu is extensively experienced in all aspect of patent issues in these technical fields.

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



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The power of paralegals post-pandemic

The Patent Lawyer investigates the changing legal landscape that has resulted in a shift in the function of paralegals, discovering how one particular solutions provider is opening the door to new opportunities for leveling up in the patent space.

While the pandemic brought little to be thankful for, we can be grateful for the evolution that it has encouraged for the role of the paralegal. With the necessity to work remotely thrust upon the world, the ways of working were forced to change too. The rapid reliance on technology and the need for adaptation not only highlighted the value of paralegals but exacerbated it through the adapted role that became – given the space to use their minds, the modern-day paralegal has far surpassed the admin role it once was.

A 2019 Annual Insight Report produced by Totally Legal "indicate[d] a gradually rising number of career Paralegals taking on the fee earning work traditionally reserved for [Attorneys] [...]. These professionals aren't using the role as a stepping-stone to qualification or as a means of gaining experience but are instead choosing to carve out long-term Paralegal careers."¹ The advantages of this adaption are obvious, and just one of the many factors demanding recognition and respect for paralegals in the space.

In addition to the changes brought by the need for remote working, many European IP firms are struggling to hire and retain paralegal talent which is raising important questions about workplace culture and opportunities in the industry. Attitudes from the next generation entering the workforce – Gen Z – are also influencing workplace culture which is having a ripple effect on how firms are adapting their way of working, not just for new hires but throughout the firm with some going to exceptional lengths to show recognition for their paralegals including offering increased salaries, broader opportunities, and equity partnerships to attract and retain talent, something that many firms are finding more and more challenging. If handled correctly, IP firms can leverage this influence to better their services and client experiences, as well as to retain highly skilled and experienced support staff.

“**The advantages of this adaption are obvious, and just one of the many factors demanding recognition and respect for paralegals in the space.**”

Influenced by both the pandemic and Gen Z's push for an equal and prosperous work culture², there has been a visible shift in expectations for firms to up their game when it comes to equality and diversity in the workplace (In a 2023 report conducted by ThoughtExchange, amongst a study group of 600 Gen Z members, "71% of respondents specifically look for company diversity when applying for jobs."³), as well as to provide opportunities and an environment in which professionals of all levels can thrive. We see that corporates are pushing their law firms to do better, and forcing the needle by voting with their feet by selecting firms that conform to shared values.

Additionally, the recent introduction of the European patent administration certificate (EPAC), issued by the European Patent Office, supports the evolution of the role of paralegals, patent administrators, and formalities officers. The qualification, obtained via exam, demonstrates the "required knowledge and skills to deal independently and autonomously with the procedures associated with the filing, prosecution, grant and maintenance of European and international patent applications before the EPO, as well as post-grant procedures."⁴ The creation of this qualification, and the obtention of it, is commanding the deserved value recognition from law firms for their staff members in these relevant roles.

At a glance, the evolution of the paralegal role has an outlook of positivity for the IP industry, with an influenced workforce dedicated to leveraging their skill sets to benefit both their employers and clients. However, in recent years, the race to the bottom has seen an attempted shift to cut out legal professionals, threatening roles including paralegal. Bypassing the legal professional doesn't just result in the lost value found in the lived and earned experiences that have always defined the success of the profession, the provided service can also fall short when it comes to strength, interpretation, and client interaction. This pursuit

to save on margins is leading to a compromise in quality and customer experience, resulting in a trajectory of dissatisfaction.

So, how can the industry protect and leverage the value of the modern-day paralegal?

It is well known that the implementation of service provider solutions can benefit a firm's way of working, ultimately benefiting the end client. Understandably, some in positions such as paralegal feel threatened by the adoption of service provider solutions; with workloads reduced by automation, the need for support staff can be reduced. As suggested by Michele Vrouvas on the topic of the evolving job role, "[t]he paralegal job description changed when law firms realized they could use non-lawyer professionals to cut costs and boost profits."⁵

However, one recent entrant to the service provider space is determined to change this narrative, with a mission statement to "keep IP professionals at the heart of the industry."

Whether returned to the office, hybrid, or working remotely, empowering paralegals with solutions that streamline their workflows for maximum efficiency frees up time for them to delve deeper into complex legal analysis and enhance client support, including facilitating pro-

active interactions, providing a more comprehensive service to better client satisfaction.

Backed by a team of professionals with over 100 years of combined experience in the IP field, iPify is opening up the opportunity for paralegals to take on larger responsibilities and to explore and provide better outcomes for their clients.

iPify's solutions help to streamline repetitive tasks without compromising on quality to redirect resources toward improving the overall customer experience while providing paralegals with a greater purpose. As a result of paralegals leveraging these solutions to level up, clients, in turn, benefit from faster turnaround times, reduced risk, and a heightened personalized service that only a human-driven legal team can provide.

Lesley Fenton, IP Administration Manager of Simmons & Simmons LLP and user of the iPify platform, stated:

"There are many validation services out there, each with varying prices and offerings, but I can certainly recommend iPify for its user-friendly online platform and comprehensive legal database which makes checking current validation requirements simple. But this is not why we have chosen iPify as our provider; we have partnered with them due to the customer experience. From the get-go,

“

By investing in solutions that empower support staff, IP firms demonstrate the value they place on the paralegal position while providing room for growth and space to make a difference.

”





iPify evaluated our needs and requirements for our workflows and helped us tailor their platform accordingly to maximize our output. They actively seek feedback on user experience and make changes to their platform appropriately. We value iPify's customer service team who check in on us to ensure everything is working well and we appreciate being able to contact them directly through their live chat (and converse with an actual person!) to receive immediate assistance. We have worked with many big providers where we, the client, are only a tiny fish in their sea, but working with iPify feels like working with a family-owned business where we are valued regardless of our size. Our relationship with iPify continues to be friendly and personalized to our firm's needs."

iPify offers the bridge to provide teams with an efficient solution for all work structures, as well as being an effective tool for integrating teams, training new staff, and even incorporating workflows during or after acquisition. By prepping IP professionals with comprehensive solutions, IP firms can provide a supportive and prosperous working environment that will not only benefit the firm and its staff directly, but also the clients as a byproduct. This goes hand in hand with supporting the evolved expectations of the workforce. By investing in solutions that empower support staff, IP firms demonstrate the value they place on the paralegal position while providing room for growth and space to make a difference, equating in that desired sense of purpose. "Companies will need to adapt their policies, processes, and technologies in order to recruit and retain the best new talent – but those who invest [...] will be rewarded with long-term, dedicated employees who will hold them accountable and keep them relevant."²

A glimpse into iPify's offering

On the face of it, iPify offers two main services: European patent validation services coordinated by their team of industry experts in collaboration with prestigious IP law firms across Europe, including instant quotes backed by unique, expert technology to compare validation with unitary effect; and patent annuities services with a digitized "quote to instruct" process for coordinated renewals - technology set to revolutionize the process for the industry with impactful benefits for both teams and margins. The software offering is made up of a white-label quoting engine designed to allow instant generation of quotes for PCT national and regional phase entries, exclusively using your network of foreign

- [1] Ethan Cumming (2020), The Paralegal Profession in 2020, <https://www.totallylegal.com/article/the-paralegal-profession-in-2020>
- [2] Ali Francis (2022), Gen Z: The workers who want it all, <https://www.bbc.com/worklife/article/20220613-gen-z-the-workers-who-want-it-all>
- [3] ThoughtExchange (2023), Gen Z at Work, <https://thoughtexchange.com/wp-content/uploads/2023/12/guide-to-corp-gen-z-at-work-2023.pdf>
- [4] <https://www.epo.org/en/learning/professional-hub/epac-european-patent-administration-certification>
- [5] Michele Vrouvas, How the Job Description of the Paralegal Has Changed Over the Last Twenty Years, <https://work.chron.com/job-description-paralegal-changed-over-last-twenty-years-20096.html>
- [6] Ritu Kaushal (2024), Evolution of Paralegal and its Impact on the Legal Industry, <https://www.cogneesol.com/blog/evolution-of-paralegal/>

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associates and the fees they apply to your firm. Also offered is a standalone web tool allowing for unitary patent/traditional validations cost comparison to support client decision-making. This is another example of iPify's respect for business relationships, as its solutions enhance rather than displace law firms' practices.

But these offerings encompass much more than initially meets the eye.

Led by the vision to *build the ultimate platform for cohesion in the IP industry*, and supported by their core values ('Your trusted, long-term partner,' 'recognizing and supporting, not disrupting,' and 'empowering all professionals') iPify is committing itself as an ally to professionals in the IP community, taking pride in offering exceptional customer service with a promise to avoid compromise on attention to detail or quality.

Additionally, iPify respects diverse ways of working, offering completely customizable solutions built with the client's requirements at the core to support new and existing workflows. iPify's solutions are not designed as a replacement for IPMS, instead, they can be connected to and integrated with IPMS to sync with your existing way of working. Their platform eliminates the traditionally rigid and closed processes, enabling IP professionals to establish their own ecosystem within. Their services and software can be tweaked or be entirely customized based on analysis from mapping a firm's entire process, then remapping with a new and improved process executing iPify's tailored solutions. To assist, their internal team of experts will provide conduct of change consultancy to ensure a fluid transition with support on hand as and when required throughout the partnership.

The team's way of working means they constantly predict and override concerns before they become a barrier to their clients, and they track software usage trends to optimize and improve the platform, demonstrating assurance in providing the needed solutions to their clients.

iPify's focus is centered around empowering IP professionals across the board, specifically acknowledging paralegals' contribution to the industry and supporting them to evolve. In a recent article, Ritu Kaushal, Legal Associate and Trainer at Cogneesoli Inc., stated, "As the landscape changes constantly, the paralegal role will continue to evolve. Not only legal firms but paralegals must embrace this change, continually learning and adapting to meet the demands of the industry. By doing so, [they] will be well-positioned to contribute to the ongoing success of their legal firms and clients."⁶

Adopting the very same notion, iPify's solution is not designed to replace paralegals, but actively enable their growth to thrive in an era where purpose and innovation are key to success.



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The debate on the inventorship of artificial intelligence: will the true inventor please stand up?

Ricardo Costa Macedo and Inês da Silva Henriques of Caiado Guerreiro analyze the views on artificial intelligence systems as inventors when it comes to protecting innovation according to different jurisdictions.

The ongoing Fourth Industrial Revolution presents artificial intelligence as its driving engine for technological innovation, potentially relegating the human being to a secondary role in the inventive process. Faced with this paradigm shift, has humankind and its unique inventive capacity been overtaken by the wonders of artificial intelligence, or is the claimed inventiveness of computers a mere illusion?

Answering this question entails an analysis into the relationship between an invention and the nature of its inventor, whether human or not.

Ever since immemorial times, Man has possessed a distinguished capability to accommodate to its surrounding nature and, consequently, to flourish alongside it through the transformation of nature in its primal state into products and manufacturing processes that have enabled humankind to steadily progress.

From the advent of the electric light bulb to the proliferation of the telephone, the most noteworthy developments in the way people conduct their daily lives have consistently found their nexus in the ingenuity and innovation prowess of human beings. The omnipresence of this nexus connecting Man to the discovery of novel and useful inventions emphasizes the central role



Ricardo Costa Macedo



Inês da Silva Henriques

played by human agency in steering and shaping societal evolution through its inventiveness.

Somewhere along the way, this trajectory of unceasing discovery paved by human inventors has been disrupted by the emergence of artificial intelligence systems and the applicability of its unrivalled features to virtually every essential sphere of one's existence, ushering in an unprecedented intensity in the flow of innovation.

While the First Industrial Revolution was powered by steam, the Second by electricity, and the Third by machinery, the Fourth Industrial Revolution is being shaped by the advent of intelligent computers. Artificial intelligence is no longer the science-fiction dystopia it was traditionally perceived to be, but rather a tool being incorporated into a multitude of sectors, particularly the financial, healthcare, energy, insurance, and transport sectors, rendering a wide range of innovative activities highly dependent on artificial intelligence-based technologies for their development and deployment.

Testimonies to the incorporation of artificial intelligence in said sectors may be found, *inter alia*, in the potential of intelligent computers to mitigate human errors in the processing and analysis of financial data, diagnose pathologies and automate drug discovery, improve supply

and demand forecasts for energy, enhance risk assessment models and develop autonomous vehicles. It is, therefore, undeniable that this technology is fuelling a profound transformation of the industry, operating as a tool at the disposal of the human hand to further technological progress.

Beyond functioning as invention tools, there is an understanding that artificial intelligence systems harbor an unparalleled degree of inventiveness. Underpinned by the ambition to replicate the intelligent behavior exhibited by the human mind, artificially intelligent systems – particularly those employing machine learning and deep neural networks – are capable of engaging in inventive processes in a way that was previously thought to be restricted to human agency.

Ever more so, artificial intelligence is emerging as a painter rather than a mere paintbrush, evolving from its role as a mere tool to assist humans in the process of creating innovative outputs to creating the outputs itself, with little or – as clamored for by the minority understanding – no human involvement. Such inventive potential is attained through the aptitude of artificial intelligence systems to pinpoint an innovative solution to a problem of a technical nature through the meticulous analysis and interpretation of intricate datasets,

Résumés

Ricardo Costa Macedo, Lawyer and Partner, Head of the Life Sciences and Intellectual Property groups

Ricardo's practice covers a wide range of contentious and non-contentious patent, trademark, and other IP-related rights, such as trade secrets and unfair competition, in particular in the pharmaceutical, home care, food, and insurance sectors. Moreover, he has vast knowledge of regulatory matters in these sectors.

Ricardo graduated in 1998, from the Faculty of Law of the Catholic University of Lisbon. He undertook postgraduate studies in information society law at the Faculty of Law of the University of Lisbon in 2000 and in commercial law at the College of Law, London in 2003.

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Inês da Silva Henriques, Junior Lawyer

Inês has been collaborating with Caiado Guerreiro since 2022 and forms part of the Intellectual Property group.

Inês graduated from the Faculty of Law of the University of Porto in 2021. In that same year, she enrolled in the Master's program in Business Law and Technology at NOVA School of Law, which she is currently completing.

At present, she is attending the Portuguese Bar Association internship in order to finalize her admission and become a fully qualified lawyer.



thereby broadening the scope of inventiveness beyond conventional human limitations.

In view of the alleged inventiveness of intelligent computers, a puzzling new debate has arisen: can a non-human entity be designated as an inventor within the patent granting process? As can be anticipated, the outcome of this debate might potentially lead to revolutionizing consequences for the current legal framework surrounding intellectual property rights, ultimately dictating whether or not it is necessary for legislators to adapt the patent system, as it stands, to the era of artificial intelligence.

Under the contemporary patent system, whoever invents or discovers any new and useful product or process, or any new and useful improvement thereof, will be considered its inventor. Accordingly, the inventor merits being designated as such in a patent granting process.

Having established this common ground, it should be emphasized that the majority of the juridical orders do not provide for an express definition of inventor, nor do they specify who may assume this position, what requirements a subject should fulfil in order to occupy this position and, even less so, the human or non-human nature of the inventor.

Regardless of the absence of an established definition of inventor, it is unanimously recognized that the inventor is the one who conceives the inventive idea and reduces that idea to practice, retaining full control over the technical execution of the invention. Furthermore, according to the interpretation of most juridical orders, only a human being is eligible to occupy this position, as they are the only real bearers of creative intellectual thought.

The patent system reflects this inherently anthropocentric vision, with the legal framework governing patent rights having been designed centered on the human being as the sole bearer of the "fire of genius in the discovery and production of new and useful things".¹ As such, throughout recorded history, the concept of inventorship has been connected to human agency, involving the capacities – previously thought to be unique – of Man to conceive intellectual creations through his ingenuity.

Nevertheless, recent developments challenge this conventional understanding as artificial intelligence systems increasingly display capabilities that resemble human creativity. Existing legal frameworks, which were devised with human inventors at heart, are now grappling with the complexities introduced by artificial intelligence-generated inventions.

A paradigmatic example is the patentability of the inventions allegedly generated by DABUS, the Device for the Autonomous Bootstrapping of Unified Sentience. In the words of the inventor



of DABUS, Dr. Stephen Thaler, this machine learning algorithm was responsible for the development of two inventions, namely a food container and devices and methods for attracting more attention as an emergency signal.²

Faithful to the conviction that DABUS deserved to be designated as the veritable inventor of the subject matter, Dr. Stephen Thaler and the team supporting the Artificial Inventor Project declared, in the patent applications, that the technical process of invention had been conducted autonomously by the intelligent system. They went one step further, claiming that DABUS identified the novelty of its own invention before a natural person did.³

These patent applications were the very first of their kind, challenging the orthodox practice or expectation that only humans can be named as inventors in a patent granting process. Accordingly, the filing of patent applications for the DABUS's alleged inventions with patent offices throughout the world sparked an intense debate over the attribution of inventorship to a machine.

In this regard, it is noteworthy to mention the decisions of three patent offices from different juridical orders, namely those of the UKIPO, the EPO and the USPTO.

In the patent applications filed before these patent offices, Dr. Stephen Thaler unanimously designated the DABUS system as the inventor. To lodge these patent applications, however, Thaler would have to prove his entitlement to do so, insofar as the designated inventor did not

coincide with the patent applicant. Thaler justified his legitimacy in acting as the patent applicant and, in this capacity, filing the patent application, based on different justifications: before the UKIPO, Thaler argued that he was the proprietor of the DABUS system;⁴ before the EPO, he presented himself, at first, as the employer of the DABUS system and, later, as its successor in title;^{5,6} lastly, before the USPTO, he claimed to be acting as the assignee of the DABUS system.⁷

Despite the differing justifications put forward, these patent offices reached the same decision, concluding that the patent application should be rejected. The rationale underlying this decision shares a common denominator – namely, the understanding that an artificial intelligence machine cannot be designated as the inventor in a patent granting process, since the inventor must be a natural person.

A further argument concerns the failure of the patent applicant to fulfil the necessary conditions to file the patent application in representation of the DABUS system, since machines do not possess legal personality. The rulings of the UKIPO and the EPO converge in this judgement, refuting Thaler's argument that he had acquired the right to the patent from DABUS through, respectively, his ownership of the machine, his position as the employer of the machine and his succession in the right to request the patent.

As artificial intelligence systems do not possess legal personality, they are therefore not entitled

¹ Abraham Lincoln's Patent (n.d.). Retrieved.

² Decision J/0008/20, Paragraph II, Boards of Appeal of the European Patent Office. Retrieved.

³ Decision J/0008/20, Paragraph II, Boards of Appeal of the European Patent Office. Retrieved.

⁴ Decision of December 4, 2019 on Applications No. GB1816909.4 and GB1818161.0, Paragraph 3. Retrieved.

⁵ Grounds for the European Patent Office Decision of January 27, 2020, on EP 18 275 163, Paragraphs 3 and 4. Retrieved.

⁶ Grounds for the European Patent Office Decision of January 27, 2020 on EP 18 275 174, Paragraphs 3 and 4. Retrieved.

⁷ Decision on Petition No. 16/524,350, United States Patent and Trademark Office, Page 1-2. Retrieved.

⁸ Judgment given on December 20, 2023, on *Thaler (Appellant) v Comptroller-General of Patents, Designs and Trademarks* (Respondent), United Kingdom Supreme Court, Paragraph 56. Retrieved.

to rights over their outputs and, in consequence, are unable to enter into any contract to assign their right to request a patent for the invention they have generated. This absence of legal personality is further reflected in the impossibility of a machine being a party to an employment contract in the legal sense.

The unacceptability of the designation of intelligent computers as inventors is therefore an understanding currently shared by patent offices around the world, concluding the debate on the attribution of inventorship to artificial intelligence with a negative answer. The most recent judgement of the UK Supreme Court ruled along the same lines, reiterating that the inventor must be a natural person, not an artificial intelligence system that does not figure as a person, either natural or legal.⁸

Emphasis should be placed, however, on the finding that the decisions on the DABUS inventions were considered unpatentable, not because the inventions themselves were unpatentable, but because of the nature of the inventor, who necessarily would have to be a human being. *De facto*, these decisions merely focused on the fulfillment of the formal requirement to nominate the inventor in the patent application and did not pronounce whether the DABUS system actually invented or whether it was simply used as a tool by the human inventor. Therefore, the debate regarding the inventive capacity of artificial intelligence systems remains unsettled.

De jure condendo, and empathizing with philosopher Daniel Dennett's understanding, perhaps society will be better served with artificial intelligence acting as a means of assisting human inventors in their inventive endeavors, without giving them ulterior motives to invent, than it would be with artificial intelligence as a colleague in the race for inventiveness.

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An interview with Helen Kemmitt, General Counsel at Quant

Helen sits down with *The Patent Lawyer* to discuss Quant's vision to make blockchain accessible to all, her excitement around Quant's growing patent portfolio, and her appreciation for dedicated outside counsel.

Can you start by introducing yourself, Quant, and your role within the company?

I'm General Counsel at Quant. I'm an IT commercial lawyer with a background in advising tech companies over many years. I spent over 10 years at Baker McKenzie in their IT team and I've been in-house since 2015. I started in the telecoms industry and have advised tech companies mainly on the expansion of new products into new territories. I came to Quant three years ago.

Quant was set up in 2018 and we provide services to the blockchain economy either through projects for enterprise clients or through a self-service, online subscription service that gives access to our platform called Overledger.

I'm General Counsel but I'm the only lawyer. I came in as the first in-house lawyer and I do everything. Previously, Gilbert, the CEO and Founder, relied heavily on outside lawyers. I sit on the ELT and get involved in strategic decisions and so the role is incredibly varied – I can be dealing with anything from NDAs to very cutting-edge work, which can prove difficult to even know where to start! My role is incredibly varied and busy.

How is Quant working to make distributed ledger technology simple, trusted, and future-proof?

Our main product is a platform called Overledger which is a low-code platform. One of the main principles behind the platform is that it's easy to use if you're not a blockchain engineer. There are a lot of software engineers, but only a small



Helen Kemmitt

“One of the main principles behind the platform is that it's easy to use if you're not a blockchain engineer.”

percentage of those are blockchain engineers; Overledger is easy to use for people who aren't expert coders, enabling them to access blockchain. Everything we release is looked at through this guise.

So, when we first launched the Overledger platform – and I'm not a software engineer, I can't do any coding – it was easy for me to set up and launch my own digital token. So that's what we do with everything, we try to make it as accessible for companies as possible.

How is Quant disrupting the market compared to others in the blockchain finance space?

We have different competitors depending on whether we're project-based or subscription-based. Our focus is much more on financial services and the regulated industries, likely because our Founder and Head of Product were heavily involved in this space previously. We have a massive emphasis on standards and security, so I'd say that is what distinguishes us from others – we're very focused on making our products secure.

What process does Quant use to capture IP?

We are a small and relatively new company, so we are still setting processes in place. I've worked pretty hard – as all of the leaders within Quant have – to make sure we're really clear with the engineers about the value of the IP. We aim to foster an environment where individuals recognise the value of their creations.

We always say that the most important thing is our people – and it is – but the value of the company is also in our IP. We've hosted a lot of training; we have sessions with our external lawyers who come in to talk about IP and how to protect it. We have an IP register which we've encouraged people to look at just as any other asset register – IP is an important, valuable asset to us, and we need to know what it is and how to identify it. We've worked with our engineers and our R&D team to make sure that they update the register constantly. Essentially, we are always talking about IP!

It's nice to be in a new company where I can start those processes. I have worked with well-established companies in the past, and when they reach a point where they are considering acquisition, they often realise that they don't have a proper record of their IP. This can be a challenging situation as it's difficult to create an IP register at such a late stage. I consider myself lucky to have come in at an early stage as I've been able to set up a process and make sure we review it regularly. But that is at a very early stage at the moment. We did some training in the second half of 2023 and we're working through making sure people update the register and they're clear on the guardrails of what to (and what not to!) include. Then we review regularly to identify what might be patentable.

What is Quant's main mission? And how are you leveraging IP to achieve this?

Our main mission is to make blockchain simple and accessible to all. Our products are designed to do that, and obtaining patents for those products is part of our overall mission. We have developed a truly innovative product, we want to protect it from others in the market.

Do you believe developing a patent portfolio is crucial for success in the finance and technology sector?

It is interesting because I can think of tech companies that have been very, very successful without a single patent. The first patent we were granted was our Japanese patent, and we've just been granted a US patent and EU patent. I was really excited about it because I've worked for very established companies that haven't had patents for their tech, receiving grant was significant recognition that what we are doing really is innovative. But I don't think it's essential to success as companies do succeed without patents. But it's fantastic for us.

It's genuinely really exciting for us as a company in our position and for the engineers. It's a big achievement for them and deserved as they put in a lot of work. The process is costly; external advisors are expensive, but it's also a big cost internally. We are lucky that the Head of R&D is really interested in IP protection and puts in a lot

“Patenting is a big commitment. I can understand why some companies don't do it, but I'm glad to be at a company that does.”

of time to translate the technical side to the external lawyers. Patenting is a big commitment. I can understand why some companies don't do it, but I'm glad to be at a company that does.

How do you predict the blockchain economy to develop in the coming years? And how will Quant's innovations assist as a solution?

We believe at Quant that this technology has the power to transform the payment system for financial institutions. There have been some high-profile cases in the last year with criminal convictions for people within the cryptocurrency space and I think that it's really important to distinguish between crypto and the technology that powers it (i.e., blockchain). These cases show the importance of the need for regulation and this will help blockchain to move into the mainstream. I think that's what will happen over the next few years.

The development of Central Bank Digital Currencies (CBDC) has started and we know that most of the G20 countries are really at an advanced stage of developing their own CBDC

Sometimes regulation can be seen as a real issue because it is a cost and a burden on companies, particularly for small companies like Quant it is an extra burden. But because of the association with crypto, regulation of blockchain really is needed. This space needs clear regulations, and they are coming: for example, the EU has the Markets in Crypto-Assets Regulation (MiCA), and many countries including the UK have clearly indicated a move towards regulation, which will help it become more acceptable and widespread. But I think it's going to take time.

How do you utilise outside counsel to strengthen your IP portfolio?

Heavily! I'm not an IP lawyer. So for patents, we use Phil Horler at Withers who is fantastic. We rely heavily on him. He's quite integrated into the business, he'll come in and do training sessions for us, he is super technical, he really understands what Quant does, and he's been instrumental in us getting the patent grants. For trademarks, we use Bristows.

What qualities do you value most in your outside counsel?

The most important thing for me is that they've got a passion for the technology, they're interested in what we are doing, they understand Quant, and they share our enthusiasm. We get that from both Withers and Bristows. We need external lawyers who can understand software engineers. Also, flexibility. I mentioned the training, coming in and helping us out, being on the end of the phone, and understanding the position that we're in including that we have to work within tight budgets.




IP TrendMonitor
ANNUAL
STUDY
2023

IP FRONTIERS

Navigating innovation in eight key industries



The latest IP Trend Monitor study gathers the opinions of IP specialists to identify far-reaching research and legal trends in eight critical industries.



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ABOUT THIS EDITION

The 2023 edition of IP Trend Monitor, the annual survey established by the Dennemeyer Group in cooperation with CTC Legal Media to investigate current and emerging topics in Intellectual Property (IP), focuses on projections for eight industries that are pivotal for the global economy. All of these commercial endeavors are undergoing significant change thanks to disruptive technologies, new business models, and external commitments such as meeting the United Nations Sustainable Development Goals.

The report is based on 1,803 answers and opinions from the most active members of the IP Trend Monitor Panel, which represents the full range of IP practitioners – lawyers, consultants, inventors, businesspeople, and scientists, working in all areas of the industry – large corporations, small and medium-sized enterprises (SMEs), law firms, IP service providers, and IP offices.

The main findings for each industry are described below, along with key data, reflecting on differences between respondent groups where appropriate.

The future role of IP

The IP Trend Monitor report touches on patterns in just eight industries, but the findings support some broader conclusions. In particular, it is likely that AI tools based on machine- and deep learning will have a significant impact across the entire economy.

In addition, the transition to net-zero carbon emissions will lead to fundamental changes in the automotive and energy industries, among others. Meanwhile, the pressures of aging populations in advanced economies, combined with new technologies and techniques, will transform healthcare.

Innovative products, services, and business models, as well as disruption from new entrants, will reshape previously stable markets. In all these aspects, IP rights will have a critical role to play in determining the direction of research, which entities are successful, and how deliverables reach consumers. The next few years promise to be very exciting for all involved in developing, commercializing, and protecting IP rights.

By analyzing the expected trajectory of future industry, the IP Trend Monitor report serves as a companion piece to Dennemeyer's recent retrospective study **Technology in the 21st century: Innovation trends since 2000**.



AUTOMOTIVE INDUSTRY

Batteries at full charge

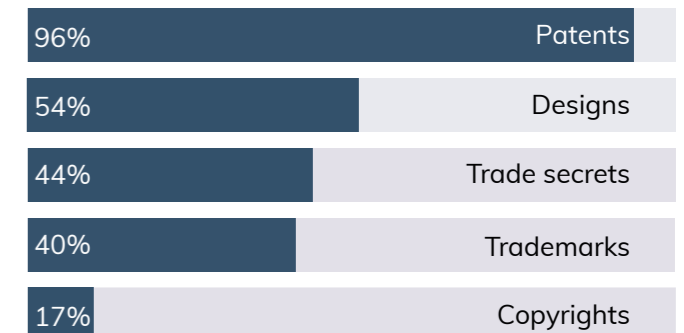
The automotive industry is being revolutionized with electric power, wireless communications, autonomous or semi-autonomous driving, and a wide variety of sensors and analytics. The IP Trend Monitor panel was asked to rank four emerging technologies according to their effect on the sector in the next five years on a scale of 1 (most impact) to 4 (least impact).

Advanced/solid-state batteries came out on top, with 85% of respondents ranking the energy storage solutions either 1 or 2. This reflects the impact of electric vehicles (EVs) and the need for further research into making batteries that last longer, are lighter, and can charge quickly.

It is perhaps surprising that 71% of all respondents ranked autonomous driving as either 1 or 2 (although this proportion fell to 56% among law firm respondents). There has been huge investment in this area by companies such as Waymo, Tesla, and Uber, with autonomous cars already on roads in U.S. cities such as Phoenix and San Francisco. With patent applications in this field growing massively in recent years, as shown in Dennemeyer's Technology in the 21st century, it is likely that we will see the results of this extensive R&D within the next five years.

The rapid changeover from internal combustion engines to electric motors will inevitably have a knock-on effect on IP strategies in the industry, from the direction of inventive activity to patent portfolio development and licensing. More than half of respondents predicted increased patenting of battery technologies and more collaboration between automakers and technology companies, with slightly fewer (46%) expecting more focus on software and IP related to artificial intelligence (AI). However, 58% of patent specialists said it will result in more software and AI-related IP, in what was the most popular answer among this specialism.

Which IP protections will be essential for the automotive industry's future growth?



MULTIPLE CHOICE QUESTION



BIOTECH INDUSTRY

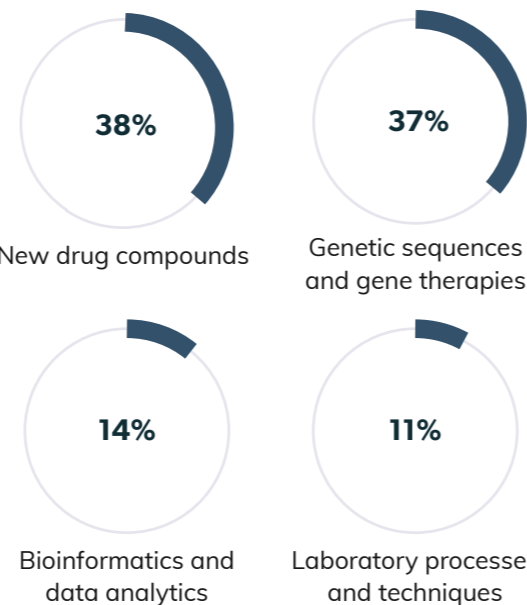
Growing innovation strategies

The biotechnology industry has burgeoned over the past three decades, and all evidence suggests that its reach will extend immensely thanks to research into areas such as genetic sequencing, gene editing, and precision (or personalized) medicine. Recent breakthroughs in the field have been awarded Nobel Prizes – for example, the 2023 Nobel Prize in Physiology or Medicine for the development of mRNA vaccines against COVID-19 and the 2020 Nobel Prize in Chemistry for the discovery of CRISPR/Cas9 genetic scissors.

When asked what the primary focus of IP protection in this sector should be, the most popular response from the IP Trend Monitor panel was "new drug compounds," followed by "genetic sequences and gene therapies." By contrast, just 14% said "bioinformatics and data analytics" (though this proportion increased to 20% among patent specialists and to 25% among corporate respondents), and around 1 in 10 said "laboratory processes and techniques."

At the same time, the panel recognized the potential for "open innovation and sharing of research findings" to redefine IP in the biotech industry. An overwhelming 80% either agreed or strongly agreed with the contention that a cooperative approach is essential for accelerating innovation, while just 16% agreed or strongly agreed that it is not a priority for biotech IP strategies.

In the biotech industry, what should be the primary focus of IP protection?



ENERGY SECTOR

Electrifying change

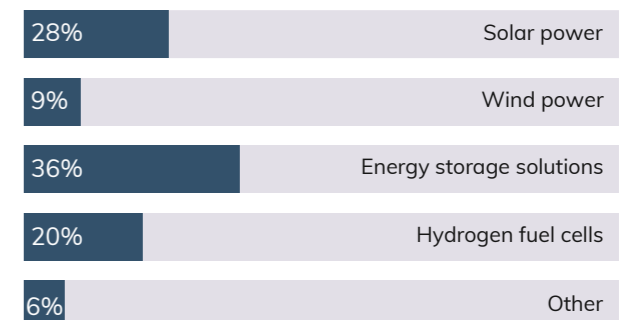
If there is one industry that is likely to look very different in the future, it is energy production. Over the coming decades, the way we power most aspects of our lives will change substantially, from everyday appliances to transportation to domestic and industrial heating.

Asked which renewable energy technology will dominate over the next five years, contributors were split, with "energy storage solutions" the most popular response, ahead of "solar power," "hydrogen fuel cells," and "wind power." Other energy technologies mentioned by respondents included hydroelectric, smart grids, and next-generation nuclear methods.

Curiously, a slightly higher proportion of patent specialists (33%) selected solar power compared to the average (28%), suggesting a potential for further improvement upon a familiar concept.

The fundamental shift the industry is undergoing poses a number of IP hurdles, particularly around how to incentivize original research and encourage broad take-up. Selected by a third of respondents, the biggest single hindrance identified was "balancing the need for collaboration and exclusive IP rights" – in other words, ensuring that different entities work together to advance technology without giving up rights to the fruits of that research. Next came "navigating complex patent landscapes," with 5% of respondents selecting "IP infringement risks in emerging markets," increasing to 11% among patent specialists.

Which renewable energy technology will dominate over the next five years?





DIGITAL MEDIA

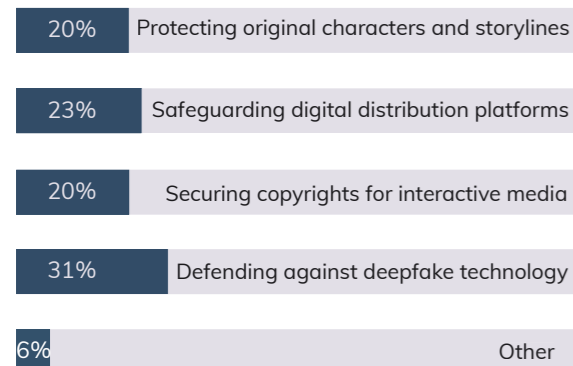
Defending against deepfakes

The digital media industry faces unusual dilemmas compared to most sectors covered in this report. Of all these priorities, "defending against deepfake technology" was the one selected by most respondents at 31%. Deepfakes potentially threaten IP rights in various ways, such as by facilitating highly convincing trademark and copyright infringement, producing fake endorsements, and spreading misinformation.

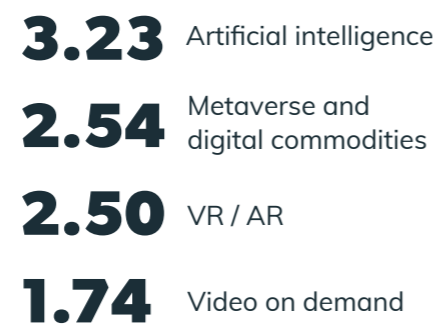
Unsurprisingly, AI models dominated the outlook for the entertainment sector, with almost three quarters of participants ranking it 1 or 2. This result climbed to 77% among patent experts. After AI technology, the panel regarded metaverse concepts and digital commodities as the next most influential field, closely followed by the interactive tools of virtual reality (VR) and augmented reality (AR).

What is the most critical aspect of IP protection

for the digital media industry's future success?



Ranking score



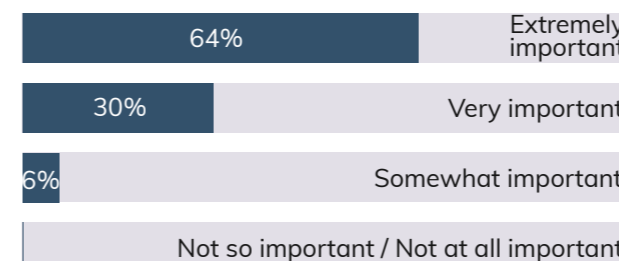
MEDICAL DEVICES

Data protection is paramount

The medical device industry is expansive and well-established, but wearable medical devices such as smartwatches and remote health monitoring tools are still relatively new and raise several interesting business and IP complications.

One of the most pressing is data security, which almost all respondents said was either "extremely important" or "very important" (94%). Given the quantity of information wearables are able to collect, its sensitive nature, and the need to process it for research purposes, airtight privacy standards and ethical usage are essential. These hazards are compounded by the fact that many companies – including healthcare specialists and IT hardware and software providers – are divergently innovating in this field.

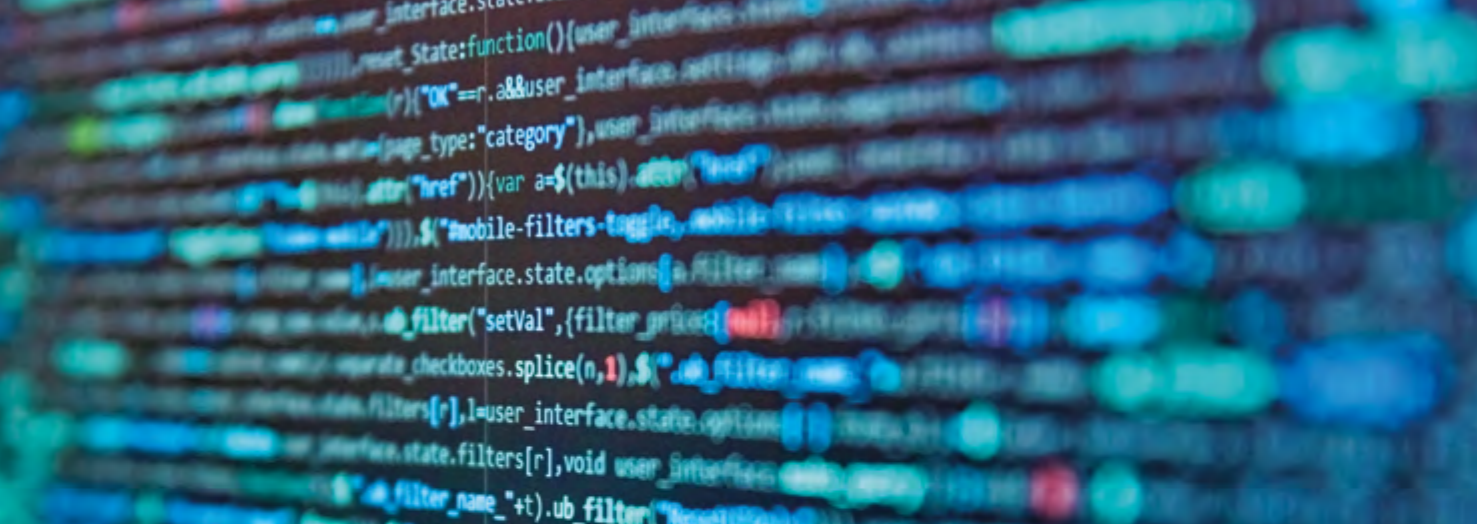
How important is data security in the context of wearable medical devices?



The sensitivities around wearable health devices and remote monitoring are clear from the survey. Nearly half of all respondents (and 52% of patent specialists) ranked this field as the top priority for robust IP protection. That put it ahead of "surgical and diagnostic tools" and "nanotechnology," and well in front of "3D printing." The majority of respondents gave this last technology a ranking of 4, though it was more popular among large corporate and SME respondents, 28% of whom ranked it as 1 or 2.

The dynamic and complex nature of the medical device industry is on display in responses to the question about the main reason for IP protection. Taking a closer look, only a fifth of respondents said it is to protect against infringement (possibly because high technical and regulatory barriers make such breaches difficult), while twice that proportion (and an impressive 46% of patent specialists and 50% of C-suite/management) said that it allows for commercialization. This highlights the role that IP rights can play in helping organizations obtain finance, monetize technology, and negotiate deals.





ICT INDUSTRY

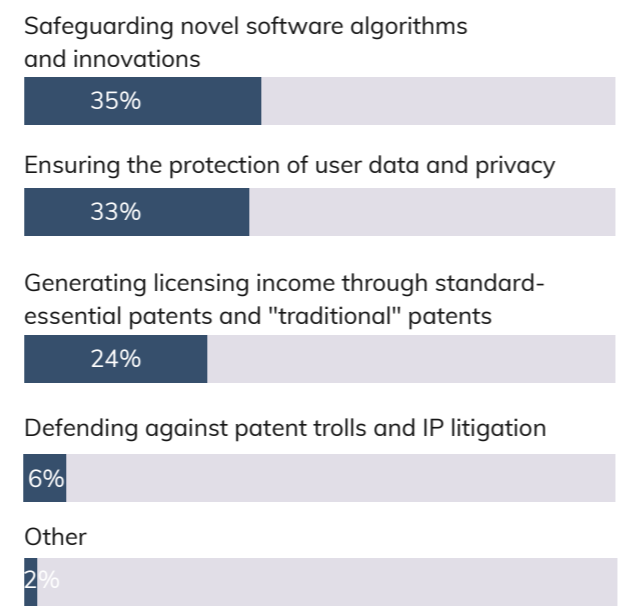
Keeping software safe

ICT operators have been among those most affected by the aggressive assertion of patents in court disputes over the past two decades, yet only a relative handful of the IP Trend Monitor panel members identified "defending against patent trolls and IP litigation" as the primary goal of IP protection here.

Instead, most respondents identified challenges arising from ambiguous, unharmonized, or complex areas of law, such as protecting software and upholding data security. Among responses from law firms, "ensuring the protection of user data and privacy" was the most popular, with 47%, while just 12% (half of the average) selected generating income through standard-essential patents (SEPs) and "traditional" patents.

Among patent respondents, there was slightly more enthusiasm for "blockchain and distributed ledger technology" compared to overall responses, with 37% ranking either 1 or 2.

What is the primary goal of IP protection in the future of this industry?



SINGLE CHOICE QUESTION



PHARMA INDUSTRY

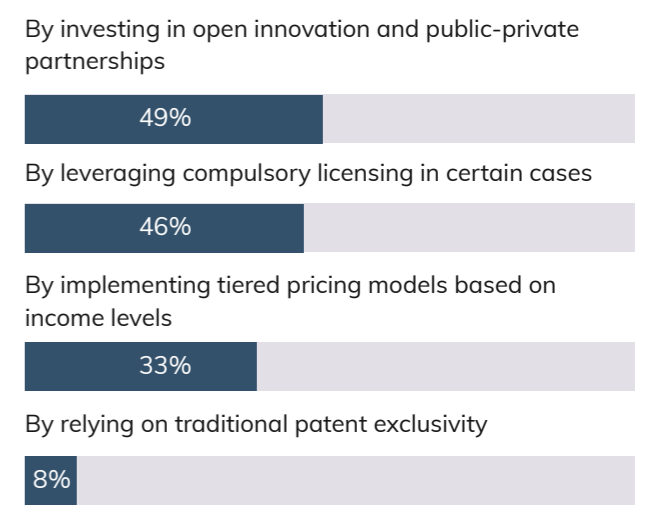
Synthesis and distribution

The pharmaceutical industry has matured to a point where the role of IP – particularly patents and trademarks – is massively valued. However, as in other fields, it is being disrupted by new technologies and business models. For instance, recent research has demonstrated the power of AI to improve the understanding, diagnosis, and treatment of complex diseases. In one example, a study found that AI was almost twice as accurate as a biopsy in assessing how aggressive sarcomas are.

A clear majority of IP Trend Monitor panelists agree or strongly agree that the use of AI in drug discovery will "increase patenting of AI-generated drug candidates" (66%), "result in IP challenges related to data ownership" (69%), and "create challenges in identifying true inventors" (60%). This emphasizes the extent to which the use of machine learning will cloud issues that were previously considered transparent (such as who is an inventor) and increase uncertainty for researchers (if many more drug candidates are patented).

However, only 35% of panelists agreed or strongly agreed that the use of AI will encourage more open collaboration, with more than half either disagreeing with the statement or being neutral.

How should pharmaceutical companies balance the need for IP protection with ensuring affordable access to life-saving medications?



MULTIPLE CHOICE QUESTION





SPACE TECH

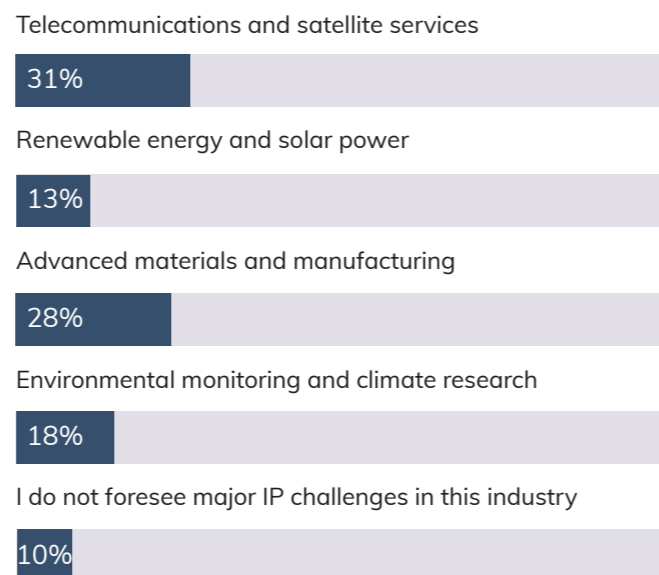
Still on the launchpad

Space is one area where the impact of IP protection is yet to become evident; nevertheless, respondents identified certain areas as likely to pose IP challenges. Top among these was "telecommunications and satellite services," followed by "advanced materials and manufacturing." However, issues relating to renewable energy and the environment generally received less attention. That being so, fewer patent specialists than the average selected advanced materials (23%) and more chose "environmental monitoring and climate research" (26%).

Surprisingly, 1 in 10 respondents did not foresee any major IP problems in the space industry – perhaps because such matters have not yet developed or are of a lower priority. At this time, questions around jurisdiction are still uncertain, and the size of the sector remains hard to predict.

Where will the most significant IP challenges

arise due to space-derived technologies?



SINGLE CHOICE
 QUESTION

Ranking score

- 3.14** Satellites
- 2.33** Lunar and planetary exploration
- 2.31** Space tourism and commercial rockets
- 2.22** Asteroid mining and resource harvesting



IPR estoppel and products? A question that's splitting hairs and courts

David McCombs, Eugene Goryunov, and Adam Erickson of Haynes & Boone LLP discuss the distinction between raising a patent and raising the identical product as grounds for invalidity after a recent ruling that provoked divided opinions.

IPR petitioners can rely on only two types of prior art: "patents and printed publications." 35 U.S.C. § 311(b). As an example, if an IPR petitioner wanted to use a telephone as prior art in an IPR petition, they would have to use US Patent No. 174,465, "Improvement in Telegraphy," as grounds for unpatentability, not the telephone device itself.

For most petitioners, this isn't a problem. But it does present a unique question regarding IPR estoppel. If our example telephone petitioner loses the IPR – meaning the PTAB, in a final written decision, finds the challenged claims not unpatentable – can that petitioner continue to argue the invalidity of the claims based on the *product* (i.e., the telephone itself), *not the patent*?

At first glance, you might think that question is splitting hairs. But, while the distinction between raising a patent and raising the identical product as grounds for invalidity is certainly narrow, it's actually splitting courts.

The reasoning

35 U.S.C. § 315(e)(2) provides that, if a challenged claim is found not unpatentable in a final written decision, that IPR petitioner "may not assert...that the claim is invalid on any ground that the petitioner *raised or reasonably could have raised* during that *inter partes* review."

Everyone agrees that once our example telephone petitioner raises the telephone patent in an IPR and loses, they are unlikely to be able to raise it again. But everyone also agrees that

“ A majority of district courts have held that IPR estoppel does not apply to the product itself, even if it's identical. ”

our telephone petitioner did not raise *the telephone itself* in the IPR and *could not have reasonably raised it* either because they were statutorily prohibited from doing so. As a result, a majority of district courts have held that IPR estoppel does not apply to the product itself, even if it's identical (sometimes referred to as "cumulative").¹ Some courts have adopted the opposite position.²

Grounds vs. evidence

In most cases, the decision of whether IPR estoppel applies to products turns on how the court defines the terms "grounds" and "evidence," and how patents and their underlying products fall into those categories.

As shown below, the majority interprets grounds in an IPR to be limited to the specific combinations of patents and printed publications. Evidence is everything else, including the underlying product.

Grounds	Evidence
Patents/Printed Publications	Products

The minority, on the other hand, defines grounds more broadly as the legal argument of unpatentability. Grounds are supported by the evidence, but that evidence can take any form. Just because IPR petitions are limited to using



patents and printed publications as evidence doesn't mean that swapping it for the underlying product changes the ground. The legal argument is the same.

Grounds	Evidence
Legal Argument	Patents/Printed Publications
	Products

Recently, Judge Bryson, sitting by designation in the District of Delaware, addressed this issue and explained his reasoning in support of the majority position. He presented primarily two reasons for his interpretation: the distinction between how the terms "grounds" and "evidence" are used in statute and the way the term "grounds" is used specifically in the IPR context. See *Prolitec Inc. v. ScentAir Techs., LLC*, No. CV 20-984-WCB, 2023 WL 8697973, at *21-23 (D. Del. Dec. 13, 2023).

Judge Bryson first explained how the distinction between "grounds" and "evidence" is consistent with defining grounds as including only patents and printed publications. See *id.* at *23 (citing 35 U.S.C. 312(a)(3) (referring to "grounds" separately from "the evidence that supports the grounds")).

Judge Bryson next pointed to "the way the term 'grounds' has been used by the Federal Circuit in the IPR context...to mean a specific combination of references." *Prolitec*, 2023 WL 8697973, at *23. Here, he essentially explained that anyone familiar with IPR petitions understands that grounds refer to specific combinations of patents and printed publications: reference A with reference B, reference A with reference C, and so on.

A mammoth loophole

Critics of the majority position, including Judge Wolson in the District of Delaware, argue that it "allow[s] for a mammoth loophole: an IPR petitioner would always add a physical device that is identical to patents or printed publications in the subsequent civil case just to evade estoppel." *Wirtgen Am., Inc. v. Caterpillar, Inc.*, 2024 WL 51010, at *9 (D. Del. Jan. 4, 2024).

The minority generally argues that it's illogical or unfair to allow similar arguments to be heard first in an IPR within the bounds of patents and printed publications and then essentially relitigated in district court. However, what is unfair is for IPR estoppel to apply to arguments (call them grounds or evidence – you choose the semantics) that were impossible to raise in an IPR.

In addition, to say that "an IPR petitioner would always add a physical device" in district court litigation overlooks the fact that not all patents



David McCombs



Eugene Goryunov



Adam Erickson

Résumés

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

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

Adam Erickson is an associate in the Washington DC office of Haynes and Boone LLP.

and printed publications presented in an IPR even have a corresponding physical product or system. To the extent the majority creates a loophole at all, it is far from a "mammoth" one, and consistent with full consideration of a patent's validity. Regardless, given the plain text of the statute and the weight of cases supporting it, where physical product or system prior art is even at play in the first place, IPR estoppel should certainly not preclude it.

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¹ See *IOENGINE, LLC v. PayPal Holdings, Inc.*, 607 F. Supp. 3d 464, 509 (D. Del. 2022); *Medline Indus., Inc. v. C.R. Bard, Inc.*, No. 17 C 7216, 2020 WL 5512132 (N.D. Ill. Sept. 14, 2020); *EIS, Inc. v. IntiHealth Ger GmbH*, No. 19-1227, 2023 WL 6797905 (D. Del. Aug. 30, 2023); *Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, No. 17-1612, 2022 WL 2643517 (D. Del. July 8, 2022); *Prolitec Inc. v. Scentair Techs., LLC*, No. CV 20-984-WCB, 2023 WL 8697973 (D. Del. Dec. 13, 2023); *Singular Computing LLC v. Google LLC*, No. 19-12551, 2023 WL 2839282 (D. Mass. Apr. 6, 2023); *Willis Elec. Co. v. Polygroup Macau Ltd.*, 649 F. Supp. 3d 780 (D. Minn. 2023); *Pavo Sols. LLC v. Kingston Tech. Co.*, No. 8:14-cv-01352, 2020 WL 1049911 (C.D. Cal. Feb. 18, 2020); *Solutran, Inc. v. U.S. Bancorp & Elavon, Inc.*, No. 13-cv-02637, 2018 WL 1276999 (D. Minn. Mar. 12, 2018); *Polaris Industries, Inc. v. Arctic Cat, Inc.*, 2019 WL 3824255 (D. Minn. Aug. 15, 2019); *Zitovault, LLC v. International Business Machines Corp.*, 2018 WL 2971178 (N.D. Tex. Apr. 4, 2018); *Clearlamp, LLC v. LKQ Corp.*, 2016 WL 4734389 (N.D. Ill. Mar. 18, 2016).
² *Wasica Fin. GmbH v. Schrader Int'l, Inc.*, 432 F. Supp. 3d 448 (D. Del. 2020); *Boston Sci. Corp. v. Cook Grp. Inc.*, 653 F. Supp. 3d 541 (S.D. Ind. 2023); *Oil-Dri Corp. of Am. v. Nestlé Purina Petcare Co.*, No. 15 C 1067, 2019 WL 861394 (N.D. Ill. Feb. 22, 2019); *Cal. Inst. of Tech. v. Broadcom Ltd.*, No. CV 16-3714, 2019 WL 8192255 (C.D. Cal. Aug. 9, 2019); *Biscotti Inc. v. Microsoft Corp.*, No. 2:13-CV-01015, 2017 WL 2526231 (E.D. Tex. May 11, 2017); *Milwaukee Electric Tool Corp. v. Snap-On, Inc.*, 271 F. Supp. 3d 990 (E.D. Wis. 2017); *Wirtgen Am., Inc. v. Caterpillar, Inc.*, No. 1:17-cv-00770-JDW-MPT, 2024 WL 51010 (D. Del. Jan. 4, 2024).

Women in IP Leadership

Celebrating achievements and continuing the empowerment of women



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



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

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

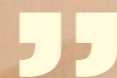
This segment is sponsored by Clarivate, who, like *The Patent Lawyer*, are passionate to continue the empowerment of women. Clarivate's sponsorship enables us to remove the boundaries and offer this opportunity to all women in the sector. We give special thanks to Clarivate for supporting this project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



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



Gordon Samson, President, IP, Clarivate

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

Jamie Soon-Kesteloot: Head of Innovation Protection and Valorisation, EssilorLuxottica & President of I3PM

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

Jamie is an IP Strategist, scientist, and advocate for innovation, diversity, equity, and inclusion.

With nine years of academic and 15 years of industrial experience under her belt supporting the biggest French multinational companies in their R&D, she builds the bridge between fundamental research and IP with the aim of extrapolating towards future business objectives.

Currently Head of Innovation Protection and Valorisation at EssilorLuxottica and President of International Institute for Intellectual Property Management, she delivers her skills and passion to the communities she serves professionally and pro-bono.

What inspired your career?

When asked what I wanted to be when I grew up – and my family won't let me forget this – I would boldly state that I wanted to be the First Lady. They would all laugh at me. The reason why I wanted to be a First Lady was because, at that time, I thought that the president must be a man.



One of I3PM's key pillars is to promote inclusion in IP as we value the diversity of our ecosystem.





so if I wanted to be in a position where I could help people then the best available position to me would be the First Lady. That was a very light-hearted episode of my childhood, but it strikes me as an adult that when I was young the notion of gender inequality, biases, and the gender of presidents was already so strong. So, it has remained one of the cornerstone moments of my life.

My second childhood ambition was to be a lawyer because it seemed like a noble profession. I didn't end up being the First Lady or a lawyer. I ended up studying science and I have a PhD in nanotechnology. I work with thin films that are nanometre size in thickness – so thin that they are invisible to the eye! Many industrial applications that are very common today are examples of this technology, such as the antireflective coating that is developed for eyeglasses. I also used to work in the building industry on a special coating for windows that keeps the cold out in the winter and the heat out in the summer. These are just some of the applications of nanotechnology.

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

I started my career with nine years as a research scientist in academia and then I switched to industry where I started as a research engineer. I moved up the ladder and started taking care of portfolio projects. This is when top management began asking me what could be protected as IP in the individual projects that I was managing – that's how I began to advise them and that's when my love for IP flourished – it's not just an intellectual concept, it's a real-life strategy that could be applied!

So I decided to go deeper into IP and in 2020 I did my master's in IP Law and Management to complete my PhD in nanotechnology. Now I'm the Head of Innovation Protection and Valorisation for EssilorLuxottica. We are a large company – more than 190,000 people worldwide – and we are owners of brands like Oakley and Ray-Ban. We are licensed to produce for top brands such as Chanel, Prada, etc.

I'm also very active in the ecosystem, notably in promoting diversity, equity, and inclusion in science, technology, and IP. I'm the president of I3PM; one of I3PM's key pillars is to promote inclusion in IP as we value the diversity of our ecosystem. We value people of all genders, sexual orientations, and origins; we want everyone to be able to contribute their unique viewpoints to I3PM to be an opinion leader in the field of IP so we provide the platform to be able to express that.

I think that the code of our society is such that we are often taught that things are black and white – in math there is only one correct answer,

“
We make judgments very quickly, and if we are not aware of it ourselves, we might end up making subpar decisions driven by our biases. We are human beings, right?!
”

in science there is a standard answer – but society is less like this. Even when I joined the workforce it took me some years to understand that there could be grey zones... grey is great! For example, often when I speak to young girls in school to motivate them to be interested in science and technology, a lot of them are just so afraid that if they choose science and technology then they have to do it for life. But that is not true and I can think of so many people that have changed career paths, myself included having started as a purely technical research engineer and then moving half-way between a technical and strategic-legal role.

I think that we have to tell our young children to stop thinking in black and white, if we stop restricting our minds to think in a binary way then the opportunities are endless. We should encourage young people to explore all opportunities. Some of the best opportunities are beyond our imaginations! The paths that are less walked are the best opportunities because they are imagined by us and tailor-made to us, and I think that would be the best career that anyone could have.

“There are only a few basic colours. Yet you can always mix them. You can never see all the shades of victory.”
Sun Tzu, The Art of War

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

I think one of the reasons why I'm such a great advocate for women's diversity, inclusion, and equity in science, tech, and IP is because I think there are still a lot of biases – whether it's conscious or unconscious – in our society today. It is less of a problem if people are outright biased because we can identify the problem and we can manage it. The problem is that a lot of us – including myself – have unconscious biases, sometimes it's just the way our brain works. We make judgments very quickly, and if we are not aware of it ourselves, we might end up making subpar decisions driven by our biases. We are human beings, right?!

So, I think one of the biggest challenges that I have seen is trying to figure out my own unconscious biases and blind spots to be aware of them and to try to correct them the next time. And I'm pretty sure that other people have the same thing towards me. I'm constantly learning how to balance this in terms of relationships with other people to be a more positive society, so I think that is indeed very challenging.

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

Some may think I would talk about the scholarships or awards and prizes, but actually my proudest moment was brought to my realisation by a photo after the fact. It is a photo of me talking to the



Jamie speaking to the French President

French President, Mr Emmanuel Macron, and around me were all these men, well-dressed in ties and suits, looking and listening to me speak. Somebody took that photo for me and when I saw it I felt so proud of myself. I thought back to 16 years ago, in 2008, when I arrived in France alone for a job, I didn't speak a word of French and I didn't have a lot of savings, I was quite young at that time and I was literally nobody in France. Now in 2024, I've picked up French, built a career, have a network, I have a personal calling which is to promote diversity, inclusion, and equity in IP and in STEM and here I am talking to the President in French in a room full of male professionals. I was just so intensely proud of that photo!

What future career aspirations do you have and how will you work to achieve them?

The more I work in the field of IP, the more I realize that the term 'IP strategy' is a misunderstood concept even for people within the IP industry. When we talk about IP strategy,

people often think we are talking about in which country we need to file the patent, extend it, meet deadlines, etc. That part of IP is critical – but in my day-to-day role, and also one of my supporting roles for I3PM, is to enforce IP strategy in the sense of how to align IP portfolios with business objectives, not just for this year but the next three, five, 10 years to come to build an IP portfolio that is valuable for the business. Implementing a secure IP strategy can reduce risk and position a business to be less vulnerable to attack.

This is not trivial: having a collection of unrelated patents is not as valuable as a cohesive portfolio. By putting thought into what type of patents we would like to file, what the links between these patents are, and what function each patent is bringing for our product from the onset, we are creating a patent strategy with patents that are very valuable in maintaining a competitive edge for our company.

IP strategy under these terms is not well understood and not a lot of people are competent in doing it so education in this area is needed and I'm determined to help. For example, in December 2023 I presented for the EPO on How to Develop an IP Strategy: A Step-by-Step Guide for Start-ups and SMEs. This is a topic I hold close to my heart and I would like to spread the message so that more people can understand IP strategy and the importance of it.

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

I think that it's still a very male-dominated industry, let's be honest about that, and the problem is not IP specific, the problem is deep-

“
Now in 2024, I've picked up French, built a career, have a network, I have a personal calling which is to promote diversity, inclusion, and equity in IP and in STEM and here I am talking to the President in French in a room full of male professionals.
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rooted. A lot of patent engineers have a scientific background; there are still fewer women in science which means there are fewer women becoming IP engineers.

For this to change, more women have to choose science when they are teenagers. So if there are not enough women – or people of color or diverse people with underprivileged backgrounds – who are choosing to study science then this chain effect will continue. For this reason, IP is at the back end of all these problems around a lack of diversity, of opportunities for people with underprivileged backgrounds. If we don't fix the problem upstream, then we are going to continue having these challenges downstream.

I did a fun exercise just last year: I stumbled upon this report from a French organization that studied students in school throughout their childhood and adulthood to assess the correlation between children whose parents were white or blue collar, for example, and what percentage of these children made it to a master's degree or more. A comprehensive table pinpoints by percentage the likelihood of a child's educational outcome based on their parents' profession (see Table 1). The fun part was calculating the score for myself. I come from a middle-class family background, my dad was a small business owner and my mum is a housewife; I calculated that, according to the statistics, the probability of me receiving the education I did is less than 0.5%. And I came from a reasonably privileged position. I think this is very revealing and shows there are deep-rooted societal problems that we must start working on to offer better opportunities for people of all backgrounds to bring about improvement.

“
The problem is not IP specific, the problem is deep-rooted.”

To be in a position to better promote equality and diversity beyond IP, I have accepted the nomination as a Co-President of the Women@EssilorLuxottica France network, as well as a global Ambassador for the company to build internal engagement for our culture. Independently, I am also appointed jury member for the Cartier Women's Initiative to drive change by empowering impact-driven women entrepreneurs.

How can we continue to empower women in the IP sector?

We need to include the voices of women when we talk about IP. In the I3PM committees, we try to have a balance of men and women in committees whenever possible. As I explained before, we are limited by the societal tendency that there are simply fewer women in science and hence fewer women in the patenting space. So we try to create this balance ourselves as the Board of I3PM.

In my professional work, I also keep an eye on the men-women inventor ratio. EPO released a report in 2022 saying that one in seven inventors in Europe are women. I looked at how they calculated the report and I calculated that for my company, we have a much higher percentage of women inventors, both at the European level but also at the French level (my company is a French company) - I was really proud to learn this. I did the calculations year by year and it helped me identify some years where we had fewer women inventors – why is that? Is it something that could be within my control as my role of Head of Innovation for the company? I looked into the statistics and realized that, in one particular year, we conducted several sessions to generate IP and only men were invited to this meeting. In my professional role moving forward it is my responsibility to make sure that when we organize internal working sessions like this, we must invite both men and women. This is a concept that all industries should be implementing to help balance the scales of gender disparity.

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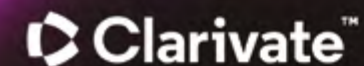


¹ Source: French Ministry of National Education – Data 2019-2020 – Observatory of Inequalities, <https://www.inegalites.fr/Les-milieus-populaires-largement-sous-representes-dans-l-enseignement-superieur>

Table 1: Social Origins of University Students by Curriculum¹

	Bachelor	Master	Doctoral
Farmers	1.4	1.7	1.4
Craftsmen, retail shop owners and small business owners	7.9	7.4	6.5
Top or Senior Executives	29.3	40.2	40.3
Intermediate professionals	16.0	13.5	11.0
Clerks or junior white-collar workers	19.8	12.8	8.7
Blue-collar workers	12.3	8.5	5.9
Retired or not in the workforce	13.3	16.0	26.2
Total	100	100	100

Reading: 12.3% of students doing a Bachelor's degree have parents who are blue-collar workers.



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Jacinthe Tay: Qualified European Patent Attorney

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



Jacinthe is a qualified European Patent Attorney and a local IP expert for the EUIPO IP Scan and Horizon IP Scan. She has more than 10 years of experience in the IP industry. In addition to patent drafting, she also undertakes IP prosecution, IP management consultancy, and negotiations on behalf of clients. She works closely with clients to conduct IP audits and formulate IP strategies that support their business strategies to maximize the value of their IP assets. She is a current member of INTA's Brands and Innovation leadership committee, I3PM - International Institute for IP Management, and IPOS Society.



You really have to pace yourself so you don't get burnout.



What inspired your career?

While working as a trademark examiner at the Intellectual Property Office of Singapore, I actually realized the importance of IP as an economic pillar, a business tool, a legal tool, and also a tool for consumer protection, and a tool for spurring technological innovation. I still hold that very fondly to this day.

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

To be honest, it was a little bit of a random chance. I chanced upon the job opening of a trademark examiner when I was job searching as a fresh university graduate. As I did my research I thought, 'this is very interesting because it is an area that is an intersection of technology, law, and business'. I thought I would apply and I got lucky - I got it! After two years as a trademark examiner, I wanted to expand my knowledge, so I embarked on a journey of becoming a patent attorney.

For anyone starting on this IP journey, remember that it is a long marathon - it is not a sprint. You really have to pace yourself so you don't get burnout. It helps to constantly remind yourself why you do what you do. It makes the whole

journey more meaningful and purposeful for you and it can help you to take the next step in your career if you go back to your original purpose and meaning of doing something. I find that it helps to become a member of professional associations (for example I3PM - International Institute for IP Management, IPOS Society, INTA - International Trademark Association, EPI - European Patent Institute, etc.) in order to meet and form a network of meaningful connections with other like-minded professionals to support you on your journey.

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

I think it's probably something that most attorneys face, and that is balancing time. The majority of attorneys do what we do because we're doing it out of passion - we really like our jobs. So, sometimes we will forget that we need to put in personal time, not just because, well you need time with your family, right?!, but also because you need to force yourself to rest, again, so that you don't get burnout. It takes a lot of discipline to set aside time for family and for yourself, and it also helps when your family understands your passion. That discipline that a lot of attorneys have with achieving their career goals and their jobs can actually be put into having that discipline to set aside time for other things in life.

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

For me, the greatest achievement so far has been the moments where my clients come back to me and say, 'I adopted the strategy you told me to adopt, and I managed to get investment for the company' or 'I managed to turn the company around, and the business began to survive or to thrive.' For me, those are the best achievements because they go back to why I do what I do - back to the meaning and purpose behind it.

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

I'm trying to work towards updating my qualifications to be a representative for the Unified Patent Court. It's a little milestones that I want to achieve because it will allow me to do more for my clients.

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

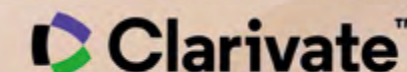
I hope to see more female attorneys in the IP industry because it is still a very male-centric industry; less than 50% are female. It will bring a different perspective to things.

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

As a start, it would help if more firms actually recognized and offered flexibility in work arrangements needed by some working females in order to balance the other hats that they wear - be it the hat of a mother or the hat of a caretaker. Having in the back of your mind the knowledge that the firm recognizes the need - recognizes your other hats - and is supportive of it, they will not penalize you for requiring that flexible arrangement, actually provides an emotional safety net to empower the women to continue to work hard and to take more steps to grow in their career. Knowing that I don't have to be in the office at 08:00, meaning I can do some caretaking work in the morning and maybe start a little later, for example, helps tremendously.

We can put in place a lot of other training opportunities or support groups but at the end of the day it goes back to the firm's culture and the human resource policies of the firm; I believe these are the first steps.

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It would help if more firms actually recognized and offered flexibility in work arrangements.





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The Americas and The Caribbean

A comprehensive list of the 10 most well-respected law firms from the Americas and the Caribbean





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

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- Blake Cassels & Graydon
- Fasken
- Gowling WLG
- McCarthy Tétrault
- Norton Rose Fulbright
- Osler, Hoskin & Harcourt
- ROBIC
- Smart & Biggar

Nicaragua

- Alvarado y Asociados
- Arias
- Bendaña & Bendaña
- BLP
- Consortium Legal
- Dentons Muñoz
- Estudio Caldera, S.A.
- García & Bodán
- Guy José Bendaña-Guerrero & Asociados
- LatinAlliance

Panama

- Alfaro, Ferrer & Ramirez
- Arias, Fábrega & Fábrega (ARIFA)
- Arosemena, Noriega & Contreras
- Cedeño & Méndez
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- Guinard & Noriega
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- TACTIC Estudio Legal
- Zürcher IP

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Jurisdictional Briefing, Russia: 30th anniversary of the Eurasian Patent Office

Dr. Tatiana Vakhnina and Dr. Alexey Vakhnin of Vakhnina and Partners detail the EAPO's commitment to bettering their strong patent system, reflected by developments over the past 30 years.

The Eurasian Patent Convention was signed on September 9, 1994, in Moscow by the Republic of Armenia, Republic of Azerbaijan, Republic of Belarus, Republic of Georgia, Republic of Kazakhstan, Kyrgyz Republic, Republic of Moldova, Russian Federation, Republic of Tajikistan, and the Ukraine and came into force on August 12, 1995, after Turkmenistan, Belarus, and Tajikistan deposited their instruments of accession to the Convention to the WIPO Director General, on March 1, 1995, May 8, 1995, and May 12, 1995, respectively. EAPC allows applicants to obtain regional legal protection along with the national patent registration procedures.

September 9, 2024, marks the 30th anniversary of The Eurasian Patent Organization.

For 30 years the single Eurasian patent has proved itself as an important legal mechanism for the business community.

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 that ratified the Convention.

Dr. Grigory Ivliev has served as the EAPO President since February 11, 2022. Dr. Ivliev is a Former Head of the Federal Service for Intellectual Property (Rospatent).

To date, the following countries are members of the Eurasian Association: **Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Russia, Tajikistan, Turkmenistan.**

The Eurasian patent system is one of the most successful integration projects throughout the region that has been gradually developed in line with global trends, including cross-border economic links. In 2019 the competencies of the Office were broadened through the adoption of the Protocol on Industrial Designs to the Eurasian Patent Convention.

The main advantages of the Eurasian patent system

The Eurasian patent system is a cost-efficient and simple procedure granting a single patent



Dr. Tatiana Vakhnina



Dr. Alexey Vakhnin

through a single application in one language with a single set of fees, as well as involving a single patent attorney.

Following the decision taken by the EAPO neither additional validations nor translation of the application into national languages are required. The unified Eurasian patent for an invention is valid in eight countries from the date of its grant. It can be optionally maintained in the countries of interest to the applicant paying the annual fees only for the selected countries.

The regional system for industrial design protection retains the advantages provided for the inventions in entirety, namely the single registration procedure and the unified nature of the granted patent. The protection covers seven countries (Turkmenistan is in the process of accessing the Protocol). Thus, the unified nature of the procedure remains the same for the renewal process.

Users of the Eurasian patent system

The Eurasian regional system, with its huge geographical coverage, is being used by applicants from 133 countries around the globe.

The top-filing applicants are the USA, Russia, and European states. As of today, the EAPO has received more than 72,000 patent applications for inventions. Annually, more than 3,600 applications are filed and more than 2,700 patents are granted for inventions.

Among the EAPO Member States, the most active applicants represent Russia, Belarus, and Kazakhstan. China ranked fifth in Eurasian patent applications for inventions in 2022, reflecting a recent increase in patent activity.

The vast majority of applications, around 80%, entered the regional phase under the PCT procedure. Since July 1, 2022, the EAPO has been functioning as an International Searching Authority and a Preliminary Examining Authority under the PCT, which allows international applications to go through the entire lifecycle of the examination process within the regional office.

From June 1, 2021, the filing of applications for industrial designs is available,

High quality is confirmed by 30 years of EAPO service

The Eurasian patent is a strong one since it is granted following the patent search and substantive examination procedures with a relevant decision. To guarantee the impartiality and quality of the examination results, the decision to grant a patent or refuse the application is taken by three different experts, representing different EAPO Member States. The Eurasian Patent Office implements additional activities to ensure diversity and the widest possible geographical representation at the EAPO. EAPO has an opportunity to involve the best experts and examiners from all EAPO Member States.

Due to the EAPO system for managing the examination quality, as well as the opposition and appeal system, the quantity of opposition remains extremely low. Overall, the EAPO revokes around 0.04% of patents a year under the invalidation procedure.

The Patent Law Treaty (PLT) provisions are duly implemented in the EAPO regulations. To increase the patent search quality, the EAPO uses the Collective Patent Classification (CPC), and, moreover, in cooperation with several IP Offices, the EAPO implements the Patent Prosecution Highway (PPH) programs.

PPH program

The Patent Prosecution Highway (PPH) program is based on the international work sharing between the EAPO and the Partner Office in the processing of applications, filed to both offices and where the requirements of the PPH program are met. In particular, one of the requirements is that all claims of the application, in respect of which an accelerated examination under the PPH program is requested, must sufficiently correspond to one or more claims that were positively indicated as patentable at the other office.

The PPH program constitutes bilateral agreements between the Eurasian Patent Office and other patent offices designed to provide applicants with opportunities to get a patent faster and more efficiently, in one of the participating patent offices. The program allows for an accelerated examination of patents compared to applications from non-participating patent offices. Currently, partner offices participating in the program include the Japan Patent Office, European Patent Office, China National Intellectual Property Administration, Korean Intellectual Property Office, and the Finnish Patent and Registration Office.

The Eurasian Patent Office also has a number of PPH agreements that do not include PCT work products.

Résumés

Dr. Tatiana Vakhnina is a Senior Partner and Founder of Vakhnina and Partners, Eurasian Patent Attorney, Patent and Trademark Attorney of the Russian Federation with extensive experience in IP since the 1970s.

Tatiana is one of the first registered Eurasian Patent Attorneys with reg. no. 38.

Tatiana is an Honorary Advocate of the Russian Federation, an active member of a number of Russian and International IP Organizations and professional communities of Patent Attorneys in Russia.

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

Alexey is a member of the Eurasian Patent Attorneys Assembly (EPAA), FICPI, AIPPI, LES Russia/LESI, INTA, ECTA, PTMG etc.

Having a PhD in Medicine (Biochemistry and Immunology), while working on patent matters, Alexey specializes in medicine, biotechnology, biochemistry, pharmacology, and pharmaceuticals.

The Eurasian Patent Office (EAPO) and the China National Intellectual Property Administration (CNIPA) agreed to continue cooperation on the PPH program for an indefinite time period starting April 1, 2023.

Following the appointment of the EAPO as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT), the Offices also agreed to expand the existing PPH program and to include the PCT-PPH.

EAPO digitalization

The EAPO is a highly digitalized IP Office, including the paperless patent workflow implemented in 2015. Furthermore, in 2022, the EAPO initiated granting electronic titles of protection that are



available in users' personal accounts, as well as on the web portal.

The EAPO adapts the processing and examination of applications, as well as administrative procedures, taking into account digital technological capabilities. The EAPO develops and enhances its information systems to make e-services as convenient as possible to meet the needs of applicants.

Thanks to digitalization and modern technologies, paperwork is greatly accelerated, and applicants and patent holders from many countries of the world note the speed of work and professionalism of the Patent Office.

Development prospects

The Eurasian Patent Office aims to reveal the entire potential of the regional integration related to IP. The EAPO possesses ambitious development plans based on the interests of its Member States. The EAPO is currently expanding the EAPO Pharmaceutical Register by adding national patents – the relevant decisions have already been taken by the EAPO governing bodies and national patents have already been included in the Register.

Furthermore, EAPO is ready, with the support of the EAPO Member States, to expand the number

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of regionally protected IP rights, i.e., to create a Eurasian registration system for trademarks and utility models.

The Eurasian Economic Union (EAEU) regional trademark registration system is currently under development. The relevant Treaty came into force in April 2021, at the same time, the procedural framework is still on the way.

The EAPO is cooperating with Uzbekistan and Mongolia to engage them in integration projects and further expand the coverage of the Eurasian patent system.

We hope that the number of EAPO participating countries will grow every year and wish the Eurasian Patent Office success in its professional development.

Patent and Trademark Attorneys of Vakhnina and Partners will be pleased to assist you and your clients, if you have any questions or inquiries on IP matters in EAPO, Russia, Armenia, and other Eurasian countries. Our specialists in Moscow (Russia) and Yerevan (Armenia, office@vakhnina.am) offices are ready to provide more information on your request.



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Jurisdictional Briefing, US: inventor interviews – do a great job on these and make patent law easy

Howard Levy, Partner at Cantor Colburn LLP, discusses how patent attorneys can approach inventor interviews to ensure that they are as successful as possible.

Patent attorneys must learn to be good interviewers. The initial inventor interview is the foundation of a patent, the “prep and pros” follows, and ultimately commercialization or enforcement. The good news is that interviewing inventors is perhaps the best thing about being a patent attorney. Inventors are almost always happy to talk about their work, their challenges, and how they overcome those challenges.

The following are essential practice tips for the inventor interview.

The outset – manage the mission & shared expertise

- **Establish your credentials.** When inventors ask about my background, I let them know that I have more than



Howard Levy

20 years of experience writing and prosecuting patent applications, and how many years I have been working in their technology area. Then I add, “that said, you should assume I don’t know anything.” This lessens the formality of the interview while establishing that I have patent law expertise and they have technical expertise.

- **Inventors should know what the goal of the interview is at the start.** I have developed a script that accomplishes this and works for me. I’ll say: “I’ve reviewed the disclosure and I believe I have a good handle on the invention. Let’s have the inventive team go through it, talk about the prior art, what the problems were, and how you went about solving those problems. I’ll jump in with questions.” The inventors take it from there.

Of note, a colleague handles interviews differently. He lets inventors know that he will describe their invention to them to ensure he understands it and invites them to interrupt. Ultimately, our approaches arrive at the same understanding. Over time, you will find the approach that works best for you.

- **Be upfront with inventors if you are confused about something.** They’ll

appreciate your honesty and may even be happy that you have an appreciation for the complexities of their work.

The meaty part – claim structure

- **The primary goal of any patent attorney should be to fully understand the invention,** including additional and/or alternative embodiments, by the end of the interview. If you need to go over the disclosure again, say so. It’s almost certainly better to acknowledge difficulty with a concept during the interview than to pretend it doesn’t exist only to have more difficulties later when you might not be able to get in touch with the inventors.

- **Once the meat of the interview starts, don’t hesitate to ask questions.** Remember that there are no bad questions. If there is an acronym, a term, or data in the disclosure that you don’t recognize, request a definition or an explanation.

- **Make use of your technical background.** If a disclosure refers to some electrical phenomena but doesn’t mention others, ask why that is. Inventors may use that opportunity to rethink something. They will usually welcome your insight.

- **Think about claim structure.** If the disclosure refers to an apparatus and a method, the application could have broad and narrow independent apparatus claims along with an independent method claim. If the disclosure includes multiple distinct ideas, identify a generic way to cover all of them in one claim.

Winding down – prosecution

- **If the disclosure relates to a computer-implemented method, there may be a subject matter rejection.** You may want to preempt this by asking the inventors to develop ideas relating to automated tangible actions. For example, if the disclosure relates to health data analysis, request the inventors to develop ideas relating to using analysis results to take automatic therapeutic actions.

- **Let the inventor know that you are playing devil’s advocate** and trying to think about the invention the way an Examiner with limited time would. If the invention is a modification of a device that already exists, obviousness rejections are

“Be upfront with inventors if you are confused about something.”

likely. Ask the inventors why a skilled person might be dissuaded from making the modification. Ask if there are negative effects or bi-products.

- **If the disclosure does not go into detail on an important aspect, request that the inventors generate additional descriptions.** I’ll say: “I don’t relish asking you to do this, but it’s necessary to develop fall back positions. A hand drawing and a short writeup is enough for me to get started.”
- **Try to consider the invention in an abstract sense** and to see if the abstracted invention can apply to other technical fields the inventors may not have considered.

Finish strong – accentuate the positive

- **Set expectations** regarding when a draft can be expected and explain the timeline of traditional patent prosecution.
- **Finish the interview positively.** I suggest that the inventors continue thinking about the invention and let me know if they come up with anything. I encourage them to enjoy the creative process. This message almost always gets through.

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Résumé

Howard Levy, Partner

Cantor Colburn Partner, Patent Attorney, and Mechanical Engineer, Howard has more than 20 years of experience in patent law, working with some of the most innovative companies in the world. Howard’s favorite part of his job is meeting with inventors, learning about their work, and helping them obtain patents that encourage further innovation. His talent for quickly understanding various technologies related to aerospace, power generation systems, electronics, semiconductors, computer science, and more allows him to easily connect with inventors working in all sorts of industries.

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Comparing the protection of selection achievements in Russia, Ukraine, and Kazakhstan

Anna Degtyareva, Olga Kotsyubalska, and Arman Sauganbayev of Gorodisky & Partners provide a comparative analysis for the protection of plant and animal varieties and breeding materials through patents granted for selection achievements in their respective jurisdictions.

Organic farming is a rising issue amid the most promising strategies for a safe and healthy life. Farming itself is the most natural human activity, the foundation of human civilization, something that brought dissipated and wild pre-humans into the first urban-type formations and supplied them with food resources that eliminated hunger, lowered dependency on the forces of nature, and resulted in a burst of various cultural developments. Organic farming is closely associated with and even dependent on selection achievements (SA) – perhaps, the oldest intellectual property rights that belong to human creativity. Despite tremendous developments in modern technologies belonging to the inanimate world, SA are in no way lost or lower





in importance, at least because economies of countries with large territories always comprise a large share of farming products, optimized by the ongoing investments in science to apply selection methods. SA enjoy protection in Russia, Ukraine, and Kazakhstan. In this article, we discuss and compare the main aspects of the protection of SA in these countries.

Russia

In Russia, plant varieties and animal breeds can be protected as SA. The protection of SA is regulated by part 4 of the Civil Code of the Russian Federation No 230-FZ of December 18, 2006 (CC RF), the Federal Law No. 454-FZ "On the Seed Industry" of December 30, 2021, and

Résumés

Anna Degtyareva, Lawyer at Gorodissky & Partners, Russia

Anna graduated from the Faculty of Law of Lomonosov Moscow State University.

She received professional training at the law offices of Schlütius Eulitz Schrader Rechtsanwälte and Meissner, Bolte. Anna started her career as a lawyer in the non-profit partnership "Lawyers for Civil Society". From 2010 to 2013, she worked in the Moscow office of the law firm Gowlings International (Canada).

Since 2013 she has been working at Gorodissky & Partners, where she represents and advises clients on selection achievements, trademark and patent protection, customs registration of IP, Internet and domain names, advertising and unfair competition, anti-counterfeiting and parallel import.

Olga Kotsyubalska, MBA, Attorney-at-law at Gorodissky & Partners, Ukraine

Olga obtained a Master of Law at Kyiv National University, received an MBA at IMI-Kyiv, completed professional Courses at Carnegie Mellon University (Pittsburgh PA, USA). She was a speaker at the 7th Global Forum on Pharmaceutical Anti-Counterfeiting & Diversion, (Washington DC, USA) and a speaker at the Workshop on IP for Plants at CIOFORA Academy (Madrid, Spain).

Olga gained considerable experience in the Life Sciences & Health Care business. She served as Advisor to the Minister of Economy, where she handled contentious cases including enforcement matters on IP rights with an accent on PVR. She is a researcher on IP for Plant Varieties.

Arman Sauganbayev, Kazakh Patent Attorney, Eurasian Patent & Design Attorney, Regional Director of Gorodissky & Partners, Kazakhstan

Arman graduated from Kurgan State University. Arman started his career at the Scientific Research Institute of Agricultural Biotechnology. From 2016 to 2021 he worked at the Kazakh Agro Technical University named after Saken Seifullin, starting as a lawyer and leaving as Deputy Head of the Legal Department.

Since 2021 he has been working at Gorodissky & Partners, where he represents and advises clients on selection achievements, patenting of inventions and utility models, managing of intellectual assets, licensing, and technology transfer.

Federal Law No. 123-FZ "On Pedigree Stock Breeding" of August 03, 1995, and related rules and regulations.

The exclusive right to an SA is recognized based on a selection achievement patent (Article 1409 of CC RF). In order to protect exclusive rights to an SA, the originator/breeder or its assignee/successor may file a patent application with the State Commission of the Russian Federation for Selection Achievements Test and Protection of the Ministry of Agriculture (the State Commission). The patents are granted only to those SA that meet the criteria of novelty, distinctiveness, uniformity, and stability (DUS).

An SA shall be considered new if the seeds of a plant variety or animal breeding material have not been sold or otherwise transferred by the breeder, their successors, or under their consent to the third parties prior to one year in the territory of Russia and prior to four years outside of Russia before the patent application filing date (six years for grape, decorative, or fruit tree varieties, or forest tree breeds).

The State Commission then conducts an examination of the novelty of the SA and the DUS tests, and may also use and assess the DUS test results based on the data provided by the applicant or a competent authority of a UPOV state member. If all criteria are met, the SA shall be included in the State Register of Protected Selection Achievements and the applicant shall be granted a patent.

The patent certifies the priority of the SA, authorship, and exclusive rights to the SA.

The exclusive rights to use an SA can be licensed by the patent holder to third parties. In the license agreement, it is necessary to indicate the SA with its patent number, type of license, (exclusive/non-exclusive), allowed ways of use of the SA, territory for which the license is granted, term of the agreement, whether the right to sublicense is granted and whether the unilateral termination is allowed, and compensation amount. If the license is royalty-free, it should be directly indicated in the agreement.

A grant of rights under a license agreement is subject to obligatory registration with the State Commission. In order to register the license agreement, it is necessary to file a corresponding application accompanied by one of the following documents signed by the parties: the agreement itself, an extract from the agreement certified by a notary public, or a notification of license.

However, in some cases obtaining a patent or a license for an SA may not be sufficient for effective use of the SA in Russia. For example, in order to market some plant varieties in the territory of Russia, it is necessary to include them in the State Register of the Varieties and Hybrids of the Agricultural Plants (the Register) as stipulated by

the Law "On the Seed Industry" (Article 16, paragraph 2). The list of such plant varieties is adopted by the Government of the Russian Federation. To be included in the Register, a plant variety has to pass a value for cultivation and use test (VCU test). The State Commission handles similar registrations for animal breeds, too.

It should be noted that for the effective protection of exclusive rights to the SA, it is necessary not only to obtain a patent, but also to be able to enforce such rights against potential infringers.

Under Article 1446 of the CC RF, infringement of the exclusive rights to an SA includes, among others:

- 1) Unauthorized use of an SA;
- 2) Assigning a name to produce and/or sell seeds or breeding material that differs from the name of the corresponding registered SA;
- 3) Assigning the name of the corresponding registered SA to produce and/or sell seeds and breeding material, if they are not of this SA;
- 4) Assigning a name to the produced and/or selling seeds and breeding material that are confusingly similar to the name of the registered SA.

As in any case of infringement of exclusive rights, the initial step for enforcement is approaching the infringer of an SA with a cease and desist letter requesting acknowledgment of the owner's rights and the termination of infringing activities and/or payment of damages or compensation. This step is usually rather effective as the parties are eager to negotiate. However, in case such a letter does not bring the expected effect, court action is the next option.

In court, the patent holder may request that the infringer acknowledges the owner's rights, ceases the unauthorized use of the SA and/or pays damages or compensation. It is also possible to request that the court seize the subject of the infringement and publish the court decision.

In addition, it should be noted that, currently, new legislation and rules regulating SA are being introduced in Russia aimed at the substitution of imports for some varieties. For instance, recently, measures related to the localization of the production of seeds in Russia and import limitations for the most significant agricultural crops have been adopted.

Considering the above, it is recommended that SA owners aiming to enter the Russian market keep an eye on the constantly changing rules and regulations.

Ukraine

Ukraine is a member of two major treaty systems that set out comprehensive rules for their members regarding IPRs over plant varieties: the International



Anna Degtyareva



Olga Kotsyubalska



Arman Sauganbayev

Convention for the Protection of New Varieties of Plants (UPOV) (1991 Act) and TRIPs Agreement each requiring protection of new plant varieties via patent rights. Ukraine approximates its legislation to European laws including the Plant Breeders' Rights (PBR). Therefore, the Laws of Ukraine "On Protection of Rights to Plant Varieties" and "On Seeds and Seedlings" were significantly revised in 2023.

Registration requirements are novelty, distinctness, uniformity, and stability (DUS). The variety's denomination must be eligible to be adopted. The application is accepted or rejected based on formal criteria within 20 days and then, after substantive examination (DUS test), a PBR patent is granted. The DUS test (field trial) of UPOV country members can be accepted by the registration authorities. The term of patent protection is 25 years, except for vine, woody, and bush, which are protected for 30 years, with an option to extend such protection for up to five years.

Patents provide holders with exclusive rights in propagating material like production or reproduction, conditioning for the purposes of propagation, offering for sale, selling or other marketing, exporting, importing, or stocking for any of these purposes. Patent holders gain financial benefits from licensing and royalties, payments for the use of farm-saved seeds (FSS). The law provides for some exceptions and limitations, like private, noncommercial, and research exceptions; FSS recognizes an explicit farmers' privilege, but one that is limited in scope.

Temporary protection is ensured from the date of application until the PBR is granted. Sensitive data defined by the breeder as confidential, e.g., breeding schemes, is safeguarded. Unauthorized access to breeding material leads to penalties.

One key novelty in the law is the allowance for listing plant varieties duly registered in the EU and/or US without field trials. The plant variety shall be put into the National List of Varieties in 15 days upon successful acceptance of the application, without substantive examination proceedings. The revised law also provides for a new option for market release for non-registered vegetable varieties following the application accepted by the authorities, which is one more step towards EU PBR system alignment.

The rightsholder and related joint owners may bring administrative or judicial action in case of PVR infringement, and an applicant may appeal to the court against any action (inaction) of the competent body related to the PBR obtained.

Claims regarding, e.g., cessation of actions that infringe or threaten to infringe on rights and pecuniary penalties may be filed to civil or commercial courts.

The court may decide on such issues in one of the following ways: compensation for non-



pecuniary damage determined by the court and compensation for the amount of damages; or recovery of income obtained due to the infringement; or recovery of compensation determined by the court. The court may also impose a fine on the infringer that is paid to the State Budget of Ukraine.

Criminal actions can be taken for illegal use of protected plant variety, authorship misappropriation, or other willful infringement of the IP rights where severe damage has been inflicted. The penalties are fines, correctional labor, prison (up to six years), confiscation, and destruction of products, and equipment.

Kazakhstan

In Kazakhstan, a new plant variety or a new breed of animal is recognized as an SA. The protection of SA is regulated by Chapter 53 of the Civil Code of the Republic of Kazakhstan (Special Part) (CC RK), Law of the RK "On the Protection of Selection Achievements" (Law), LRK "On Seed Production" and the LRK "On Livestock Breeding" and related rules.

The right to SA is protected subject to the grant of a patent for SA.

An application for a patent for SA is submitted to the RSE "National Institute of Intellectual Property" of the Ministry of Justice (NIIP) and after a preliminary examination, the application materials are sent to the state commissions under the Ministry of Agriculture (for test and approbation of breeds/variety test of crops), which verify the correctness of the proposed name of SA, examination and test of SA for patentability. In order for SA to be protected, it must meet the following criteria: novelty, distinctiveness, uniformity, and stability.

A variety or breed is considered new if, on the date of filing the application, seeds, other planting material, or breeding material of this SA were not sold or transferred to other persons for the use of the variety or breed in Kazakhstan prior to one year before. On the territory of another country, prior to four years for annual crops and six years before the application date for perennial crops and breeds.

The test for distinctiveness, uniformity, and stability of the variety and breed is carried out by state commissions according to accepted methods and within the established time frame.

Upon completion of this, in accordance with SA criteria of protection, a decision is made to grant a patent.

Thus, a patent for SA certifies the exclusive right, priority, and authorship of the breeder to the patent holder to use SA.

Patent holders of SA can not only sell breeding products, seeds, and planting material, but also issue licenses for the use of SA, while receiving

“ Failure to comply with the written form and (or) the registration requirement entails the nullity of the agreement. ”

additional income, which is not unimportant.

The license is issued by signing a license agreement. In Kazakhstan, in addition to an exclusive and non-exclusive license, there is such a type of license as the sole license - with the licensor retaining the possibility of using SA, but without the right to issue a license to other individuals.

License agreements for the use of SA are concluded in written form and are subject to registration in the State Register of SA in the NIIP. Failure to comply with the written form and (or) the registration requirement entails the nullity of the agreement.

It should also be noted that, in addition to the patentability test, it is necessary to conduct tests for economic usefulness and include them in the registers of recommended products for the possibility of using SA in production.

It is not enough to simply obtain protection for SA, it is necessary to protect exclusive rights against potential infringers since any individual using a plant variety or animal breed in infringement of the Law is considered guilty of infringing the right of the patent holder.

Kazakhstan provides for both civil and criminal liability.

In the event of filing a claim to the court, it is possible to claim compensation from the individual who infringed the rights of the patent holder for the use of SA as well as compensation for other damages.

Currently, Kazakhstan is discussing the possibility of the country's integration into the UPOV. Kazakhstan's entry into the UPOV should be the next step in the development of breeding work in the country.

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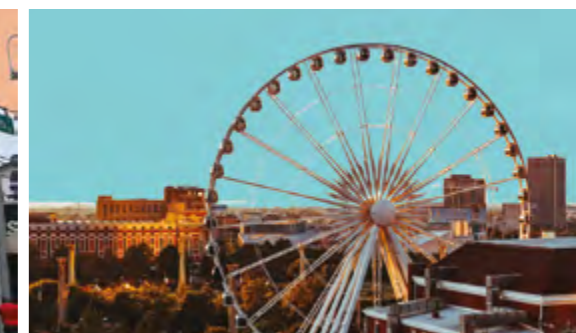
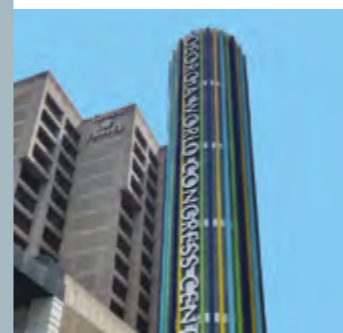


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The evolving debate on forum selection in patent proceedings

Ranjan Narula and Suvarna Pandey of RNA, Technology and IP Attorneys assess the current position for court selection based on territorial jurisdiction factors for both native and foreign filers.

The jurisdiction of a court in a patent appeal, revocation, patent infringement suit, and the case of a writ can be tricky terrain. With the abolition of the Intellectual Property Appellate Board (IPAB) and the power being transferred to the High Court, the forum choice is dictated by several factors. The post summarizes various situations concerning forum selection and cases on the subject:

Territorial jurisdiction for filing a patent application in India

When a patent application is to be filed at the Indian Patent Office, the applicant or first mentioned applicant of joint applications must apply for a patent at the appropriate patent office under the jurisdiction in which:

- The applicant normally resides or has their domicile (as an example place of their residential address/ location); or
- The applicant has a place of business (as an example, business/company address); or
- The place from where the invention originated (an example, Laboratory address, R&D center address).

For a foreign applicant, the address for service in India or the place of business of their patent agent determines the appropriate patent office where patent applications can be filed. Thus, if the foreign applicant's agent or the law firm has an office in Chennai, the patent application will be filed in Chennai.

There are four patent offices, located in Mumbai, Chennai, New Delhi, and Kolkata. These offices cover the following territories. For an Indian applicant,





the company address or R&D lab address generally would dictate the patent office where the person would apply. In the case of a foreign applicant, it would be the patent agent that they engage. The Patent Act provides the office (referred to as appropriate office) once chosen cannot be ordinarily changed. (See table right)

Territorial jurisdiction for filing a patent appeal in the High Court

With the digitization of the patent office, the work is distributed among different controllers/examiners with expertise in different technology areas. It is common, for example, for an application filed at the Delhi Patent Office to be examined by the Controller based in Chennai.

Résumés

Ranjan Narula, Managing Partner

Ranjan founded the specialist IP law firm, RNA, Technology and IP Attorneys in 2004, and is now 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.

Suvarna Pandey, Associate Partner

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

Patent Office Branch, Mumbai	The States of Maharashtra, Gujarat, Madhya Pradesh, Goa, and Chhattisgarh and the Union Territories of Daman, Diu & Dadra, and Nagar Haveli
Patent Office Branch, Chennai	The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu, Telangana, and the Union Territories of Pondicherry and Lakshadweep
Patent Office Branch, New Delhi	The States of Haryana, Himachal Pradesh, Punjab, Rajasthan, Uttar Pradesh, Uttarakhand, Delhi, and the Union Territory of Chandigarh, Jammu, Kashmir and Ladakh
Patent Office, Kolkata	The rest of India



Ranjan Narula



Suvarna Pandey

In the above example, if a patent application is refused by the Indian Patent Office, the order of the controller can be challenged before the High Court where the patent application was filed (in this case Delhi). The courts have held that irrespective of whether the hearings and other procedures like examination taking place in a different office, an appeal against the final order must be filed to the jurisdictional High Court where the application was filed. In other words, for any patent refusal order issued by the Chennai, Mumbai, Kolkata, or Delhi Patent Office, the appeal against the refusal order would lie to the respective High Court i.e., Madras High Court, Bombay High Court, Calcutta High Court, and Delhi High Court. The court's reasoning for this conclusion was:

- a) The appeal is a continuation of the original proceeding;
- b) The entire record of the patent application is readily available at the appropriate office;
- c) As per the scheme of the rules, the concerned applicant would be domiciled, carrying on business, or normally residing within the said territorial jurisdiction;
- d) The invention may have originated from the said territory;
- e) The address of service in India in case of a foreign applicant would be in the territory where the appropriate office is located.

Territorial jurisdiction for filing a patent revocation action

A revocation petition under Section 64 of the 1970 Act can be filed:

- 1) As original proceedings by any 'person interested'; or
- 2) By the Central Government; or
- 3) As counterclaims in a suit for infringement of a patent.

In cases falling in category 3, the petition would obviously be filed before the court where the suit for infringement is already pending.

For cases under category 1, firstly the person interested needs to be understood. As per Section 2 (t) of the Patent Act "person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates."

The courts have laid down that "person interested" would include a person who has a direct, present, and tangible interest in a patent, and the grant of the patent would adversely affect their rights. A "person interested" would include any individual who desires to make independent use of either the invention itself (which has been patented) or desires to exploit the process (which has been patented) in their production activity.

The Delhi High Court in *Dr. Reddys Laboratories Limited & Anr. v. The Controller of Patents & Ors.* laid down that a large number of persons could be "persons interested in respect of a patented invention. The grant of a patent has an all-India effect. Once granted, the exclusive rights of the patentee spelled out in section 48 of the 1970 Act extend to the entire length and breadth of the country. Persons who are interested in seeking the revocation of the patent could, therefore, be located in any part of the country where the factum of the grant and its effect would determine their conduct. For example, a person may be prevented from continuing particular research for commercial purposes, a person may be prevented from manufacturing or selling a particular product, or an entity may be prevented from expanding its manufacturing activities due to a grant of a patent. Thus, the effect of the patent could be felt wherever the conduct of the person interested is likely to be affected.

Thus, an original revocation petition can be filed in the jurisdictional High Court where the patent application was filed and would also extend to other High Courts where the commercial interest of the person interested may be affected.



For a foreign applicant, the address for service in India or the place of business of their patent agent determines the appropriate patent office where patent applications can be filed.



Territorial jurisdiction for filing a patent infringement suit

The jurisdiction for filing a patent infringement suit is governed by Section 104 of the Indian Patents Act, 1970, and Section 20 of the Civil Procedure Code, 1908.

Section 20 of the Code of Civil Procedure, 1908, clauses (a) and (b) of Section 20 provide that a suit can be instituted *where the defendant actually and voluntarily resides, or carries on business, or personally works for gain.* Further, clause (c) of Section 20 provides that a suit can also be instituted in the jurisdiction of a court where the cause of action has wholly or in part arisen.

Thus, based on clause (c) of Section 20, a suit for patent infringement can be filed before any High Court where the infringing product is sold/available.

Territorial jurisdiction for filing a writ petition

A recent case at the Madras High Court titled *University Health Network v. Adiuvo Diagnostics Private Limited* has brought into focus the powers of the court in writ jurisdiction.

Facts of the case

University Health Network, a Canadian company filed a Patent application no.9067/DELNP/2010



in respect of a device and method for fluorescence-based imaging and monitoring at the Patent Office, Delhi.

A pre-grant opposition was filed by Adiuvo Diagnostics Private Limited (ADPL) pleading lack of novelty, lack of inventive step, non-patentable subject matter, and insufficient disclosure. The application for examination and pre-grant opposition was allotted to the controller in Chennai (Madras). The pre-grant opposition filed by ADPL was dismissed and, consequentially, the patent was granted in favor of the University Health Network. ADPL challenged the order by way of writ to the Madras High Court.

The issue of jurisdiction of Madras High Court in this case was raised by the University Health Network office mentioning that:

1. The present patent application was filed at the Delhi Patent Office. The opposition against the application was filed only in Delhi, the grant of the patent was by the Delhi Office, and the certified copy of the grant was also applied from there;
2. Even if the hearings in relation to the patent opposition took place in different offices, by Rule 4(2) of the Patent Rules, the hearing is deemed to have taken place at Delhi as it is the 'appropriate patent office';
3. As per Rule 28 of the Patent Rules, location-neutral and administrative exigencies would not change the appropriate office of the patent application and thus, the entire cause of action is deemed to have arisen only in Delhi, therefore, the writ petition before this court is without territorial jurisdiction;
4. The Delhi High Court would only be the convenient forum and the action of the writ petitioner;
5. Amounts to forum shopping.

Single judge ruling

The single judge dismissed the territorial objection stating that a writ under Article 226 of the Constitution of India is not dependent upon where the 'appropriate patent office' is situated and therefore, Rule 4 of the Patent Rules is not dispositive of the jurisdiction. The learned judge noted that upon allotment of the application to the Controller in Chennai, the Officer undertook all the material tasks in respect of the patent such as Patent Examination Report, issue of hearing notices, physical hearing, and the issue

“
A suit for patent infringement can be filed before any High Court where the infringing product is sold/ available.
”

of impugned order rejecting the opposition only in Chennai and therefore, it cannot be said that no part of cause of action arose in Chennai.

Appeal before the Division Bench

An appeal was filed by University Health Network to the Division Bench (two-judge bench) and the Court ruled that in the case of a writ petition, the appropriate office will not be decided on the basis of "address for service". In this case, even if the patent application was filed in Delhi, however, an appeal against the pre-grant opposition order was allowed to be maintained before the Madras High Court. The important findings from this order are the following:

- A writ petition filed under Article 226 of the Constitution of India and therefore, jurisdiction has to be decided as per Article 226 (2), which states that "(2) The power conferred by clause (1) to issue directions, orders or writs to any Government, authority or person may also be exercised by *any High Court exercising jurisdiction in relation to the territories within which the cause of action, wholly or in part, arises for the exercise of such power notwithstanding that the seat of such Government or authority or the residence of such person is not within those territories.*"(emphasis added)
- Thus, it can be seen that irrespective of the location of the 'appropriate patent office', this Court would have territorial jurisdiction to entertain the matter if part of the cause of action arose within its jurisdiction.
- The court considered that the cause of action in this case arose from the petitioner carrying on its business pursuant to the patent granted to it in no. IN323440 and if the fourth respondent is granted patent on its claim, the same will affect its business. The writ petitioner has a patent and is conducting its business in Chennai and the same is an integral part of the reason for the writ petitioner to oppose the grant of the patent.
- On the contrary, the fourth respondent is based in Canada and, through their attorney, is filing the application in India. Therefore, it cannot be said that the primary geographical area where the rights of parties play out is Delhi, and that jurisdiction is artificially vested in Chennai. If the geographical area

in which the rights of parties play out is to be considered, then Chennai stands on a better footing than Delhi.

Thus, the concept of 'appropriate patent office' is relevant for the proceedings during the examination of the patent application and the procedures of patent appeal. However, this requirement does not apply while deciding "cause of action" for a writ petition. The Division Bench observed that the proceedings that happened before the Delhi Patent Office do not undo the part of the action that happened in Chennai, which forms part of the cause of action, for filing of the writ petition. Thus, the writ petitions filed under the Patent Act challenging a decision where no appeal process is provided (such as a pre-grant opposition), is with this decision not restricted to the appropriate office and the petitioner can rely on the "cause of action" for filing the writ petition.

Conclusion

The Madras High Court's observation that, "with the advent of technology, in the times of quick and instant communication and virtual hearings, the very ethos relating to forum convenience and prejudice to the parties have all to be

“
In many cases, forum convenience may need to be construed more broadly.
”

recalibrated" is an apt one. The four patent offices dividing the jurisdiction by their location was done at the time when the patent applications were physically filed, and prosecution would happen with documents being delivered by post and objections being attended by paper filing. All the documents and responses are now filed digitally, the hearings take place virtually. Therefore, in many cases, *forum convenience* may need to be construed more broadly.

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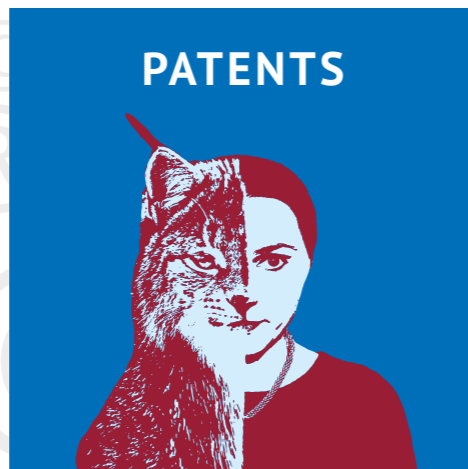
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Old and new possibilities for revocation of evergreen patents

Ludmila Lisovskaya, Patent and Chemical Specialist at Zuykov and partners, reviews the current position of evergreening in Russia provoked by the amendments to the Invention Rules in 2021 that has deemed many instances of evergreening unlawful.



Since the monopoly of the originating companies lasts “forever”, they are forced to challenge the legality of the issuance of such patents in the Chamber of Patent Disputes or before the court.



Ludmila Lisovskaya

An evergreen patent can otherwise be called a constantly renewable patent, which means “obtained by artificial extension of exclusive rights”. The pharmaceutical industry is most often interested in obtaining such patents associated with lengthy and expensive research. Since the patent protection provided by such patents lasts 20-25 years, large pharmaceutical companies often do not have time to recoup their investments, and are forced to obtain secondary patents for crystalline forms of a known active drug, substances that are the basis of a medicinal product, pharmaceutical compositions, new finished dosage forms, more effective dosages and modes of administration of pharmaceutical compositions, the use of known compounds or pharmaceutical compositions for a new purpose, etc.

Résumé

Ludmila Lisovskaya has worked as a Patent Specialist and Chemical Specialist with Zuykov and partners LLC since 2017. Ludmila specializes in patent searches for inventions and utility models, preparation and filing of patent applications on inventions, utility models, software and database, response preparation on request for substantive examination on inventions, utility models, software and database applications, etc.





In this regard, companies specializing in the production of generics cannot begin to release cheaper and more accessible drugs on the market. Since the monopoly of the originating companies lasts "forever", they are forced to challenge the legality of the issuance of such patents in the Chamber of Patent Disputes or before the court.

Let's consider the grounds for *recognizing a patent for an invention as invalid* in whole or in part, according to Art. 1398 of the Civil Code of the Russian Federation.

A patent for an invention, utility model, or industrial design may be declared invalid in whole or in part by Rospatent if:

- the invention does not comply with the conditions of patentability;
- non-compliance with the application documents for an invention with the requirement of disclosing the essence of the invention, with completeness sufficient for the implementation of the invention;
- the presence in the claims of the invention of features that were absent on the date of filing the application in the description of the invention and in the claims, if it was presented on the date of filing the application;
- the presence of several applications for identical inventions having the same priority date, in violation of the conditions: if during the examination it is established that different applicants have filed applications for identical inventions, and these applications have the same priority date, the patent for the invention may be issued only according to one of such applications to a person determined by agreement between the applicants.

Also in the Intellectual Rights Court if:

- the indicated author or patent holder is not as such.

Based on the first reason, for the possibility of revocation of a patent, an international patent information search is necessary to identify sources that disclose the claimed solution before its priority date. The analysis of the identified documents allows us to draw conclusions on how non-compliance based on the condition of patentability ("novelty" or "inventive step") can be opposed. To assess compliance with "industrial applicability", the presence of a technical result, as well as means and methods confirming the possibility of its implementation, is checked. In

addition, the content of the application and the revoked patent is analyzed in detail, the availability of examples and experimental data confirming the achievement of the declared technical result is assessed.

The features of the claim are compared with the features disclosed in the description for challenge on the third ground. Moreover, in the case of "evergreen patents", when one protects a slightly "narrower" solution compared to the previously patented one, prior applications of the same authors and applicants are analyzed for challenge, subject to non-compliance with the "author's benefit" (six months from the date of disclosure).

The most important thing is to establish the connection between the chain of "evergreen patents" and make sure that a narrower solution has not been fully explored by the developer, which is where "gaps" in the sufficiency of disclosure often arise.

In general, the Eurasian patent legislation, which is generally harmonized with the legislation of the Russian Federation, proceeds with the same approach. Therefore, the task was to limit the issuance of "evergreen patents", leaving them only for those drugs whose properties were previously unknown, which would make it possible to take advantage of the experience of other states to achieve technological sovereignty in the pharmaceutical industry.

In April 2020, amendments were made to the Rules for the Consideration and Resolution of Administrative Disputes, which allow the presentation of additional arguments and additional supporting documents and materials as part of the consideration of objections, including the declaration of new grounds for annulment that were not initially stated when filing objections. These changes have made it possible to reconsider approaches to the revocation of evergreen patents; now the proceedings can last quite a long time until the person who filed the objection runs out of arguments and grounds. This new approach increases the chances of success, since by presenting additional arguments and documents, the objector has the opportunity to correct mistakes made in his original strategy.

Amendments to the Invention Rules dated March 31, 2021, allowed new strategies to be applied to the revocation of evergreen patents.

Now, any illegal solution to grant a patent for non-compliance with the condition of patentability "inventive step" falls under suspicion of unlawful grant of a patent for non-compliance with the condition of patentability "inventive step". These solutions may be:

- The form of a known chemical compound (isomer, stereoisomer, enantiomer, amorphous, or crystalline form);

- It's derivative (salt, solvate, hydrate, complex compound, or ether);
- A compound that does not exhibit new properties in comparison with a known compound in qualitative or quantitative terms that are not obvious to a specialist from the prior art.

If a certain form or derivative of a known chemical compound exhibits biological activity useful for the prevention and/or treatment of certain diseases in humans or animals, the following information should be provided:

- Indicating the influence of this form or derivative on the etiopathogenesis of the disease or on the condition of the body;
- About the connection with them of the diagnostic factor;
- About reliable data confirming the suitability of a certain form or derivative of a known chemical compound, obtained, in particular, in an experiment on adequate models.

It is worth noting that changes to the Rules were introduced in 2021, and today there are many "evergreen patents" obtained in an earlier period to which these rules do not apply.

In practice of 2021-2022, when considering objections in the Chamber of Patent Disputes, it was noticed that the panel willingly takes into account arguments regarding the absence in the application description of: reliable experimental data obtained on adequate models confirming the suitability of a certain form or derivative of a known chemical compound for prevention, diagnosis and/or treatment of the specified disease or condition, including if the compound is a salt, ester, enantiomeric, or crystalline form of a previously patented compound, etc.

Rospatent is skeptical about solutions aimed at protecting compounds that do not exhibit new properties in comparison with a known compound in qualitative or quantitative terms, which have not been specifically obtained and studied.

Therefore, when filing objections to invalidate patents for isomers, stereoisomers, enantiomers, amorphous, or crystalline forms, salts, solvates, hydrates, and esters of previously patented biologically active compounds, first of all, you need to focus on a comparative analysis of how different the description of the new application is from the description of the previous one (earlier in the chain of "evergreen patents"), check all the patents received by the same authors on



You need to focus on a comparative analysis of how different the description of the new application is from the description of the previous one.

this topic, including international applications, assess whether this derivative or a new form of the compound was specially studied and investigated, whether the obtained research data on adequate models provide specific indicators confirming improved properties, and if not, then there is every chance to prove that this patent was issued illegally.

Thus, tightening the requirements for patent applications will not only prevent the creation of unwarranted evergreen patents in the future, but also provide a clear picture of which patents did not have the right to evergreen in the past.

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

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