

The Patent Lawyer

GLOBAL REACH, LOCAL KNOWLEDGE

www.patentlawyermagazine.com

May /
June 2024

The Invention Stack: harvesting and protecting intellectual property



Chris Johns, Partner at Finnegan, and Leonard Stewart, Assistant General Counsel for Fidelity Information Services, draw insights from Jim McKelvey's *The Innovation Stack* to relate business success over conglomerates with the parallel necessity to protect innovations.

Litigation more dangerous?

Page 12



China's design system

Page 41



Amazon's Patent Evaluation Express

Page 48





IGE | IPI
ip-search



Patent searches for experts.

Reliable. Precise. Meaningful.



THE PATENT LAWYER Issue 72

Editor & COO

Faye Waterford
faye@ctclegalmedia.com

Publishing Director

Chris Dooley
chris@ctclegalmedia.com

Publishing Sales Manager

Katie Kerr
katie@ctclegalmedia.com

Head of Digital

Ellen Peet
ellen@ctclegalmedia.com

Finance Director

Carla Dooley
accounts@ctclegalmedia.com

Subscription Enquiries

subscriptions@ctclegalmedia.com

Published by:

CTC Legal Media Ltd,
23 Hedgers Way, Kingsnorth,
Ashford, Kent TN23 3GN
Tel: +44 7718 278253

Design and Repro by:

Design and Printing Solutions Ltd
Unit 45C, Joseph Wilson Industrial
Estate, Whitstable, Kent CT5 3PS

Printed by:

Pureprint Group, Crowson House,
Bolton Close, Bellbrook Park, Uckfield,
East Sussex TN22 1PH

Whilst every effort has been made to ensure that the information contained in this journal is correct, neither the editor, contributors or CTC Legal Media can accept any responsibility for any errors or omissions or for any consequences resulting therefrom.
© CTC Legal Media 2023, and contributors.

The contents of this journal are protected under the copyright law of the United Kingdom, the Berne Convention and the Universal Copyright Convention. Any unauthorised copying of the journal may be in breach of both civil and criminal law. Infringers will be prosecuted.

ISSN 2051-3682



Editor's welcome



Protecting innovation and business success go hand in hand. Drawing on insights from Jim McKelvey's business book *The Innovation Stack*, our cover story discusses the related success businesses can expect to leverage from investing in IP across the business from a private practice and in-house perspective.

From here, we explore the impact recent cases seen before the US Supreme Court have had on IP litigation, questioning whether the outcomes are detrimental to the continued protection of innovation; we have advice for filing your first office action at the USPTO, covering the avoidance of delays and pointers for a successful grant; strategies for framing issues as violations of the Administrative Procedure Act; an update on the Chinese design system which addresses patent term extension and the accession to the Hague Agreement; an introduction to the amendments to the Hungarian IP Act that is set to impact the protection of designs, patents, and copyright; a review of the effectiveness of Amazon's APEX program in the fight against counterfeit goods; and a guide to Hangzhou in advance of the AIPPI World Congress in October.

“
**Protecting
innovation
and business
success go
hand in hand.**
”

This issue features our Award Winning Law Firm Rankings for Europe. Our *Women in IP Leadership* segment features Federica Combariati, Senior IP Counsel at ASSA ABLOY Group, and Anya Dushine, Global Head of the Clarivate IP Management Consulting Practice. Special thanks go to the segment sponsor Clarivate for their continued support of the empowerment of women in the sector.

There is still time to book for the AIPPI World Congress Special Edition, contact us today to reserve your space. Enjoy the issue.

Enjoy the issue.

Faye Waterford
Faye Waterford, Editor

Mission statement

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

Sustainability pledge

We pride ourselves on using a sustainable printer for our hardcopy magazines. Pureprint Group was the first printer in the world to become CarbonNeutral® and has worked to remove non-recyclable materials from the manufacturing processes while creating dynamic allocations to reduce energy, waste, transport, and materials. Find out more at www.pureprint.com/sustainability/



Contents

6 Meet the Editorial Board

Meet our Editorial Board members who help determine the direction of this magazine.

9 Cover Story: The Invention Stack: harvesting and protecting intellectual property

Chris Johns, Partner at Finnegan, and Leonard Stewart, Assistant General Counsel for Fidelity Information Services, draw insights from Jim McKelvey's *The Innovation Stack* to relate business success over conglomerates with the parallel necessity to protect innovations.

12 Did The United States Supreme Court make litigation more dangerous for defendants in IP cases? Probably not...

Marc J. Pernick, Partner at Maschoff Brennan, details the intricacies of the Mallory case that raised important questions surrounding personal jurisdiction to conclude the potential impact that the verdict could have on IP cases in the US.



20

16 Getting the most from your first office action from the United States Patent and Trademark Office

Jeremy W. Miller and Wendy M. Slade of Dowell & Dowell provide best practices for avoiding delays and receiving successful grants when filing US National Stage applications with the USPTO.

20 Framing issues in an APA context: recent outcomes

David McCombs, Eugene Goryunov, and Adam Erickson of Haynes and Boone highlight recent strategies from appellants to frame issues as violations of the Administrative Procedure Act for a less deferential standard of review on appeal.

23 Women in IP Leadership:

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

Featuring: Federica Combariati, Senior IP Counsel at ASSA ABLOY Group, & Anya Dushine, Global Head of the Clarivate IP Management Consulting Practice
Sponsored by: Clarivate



31 Rankings: Europe & the UK



10 of the best law firms from each of the top European jurisdictions, including Germany, Poland, and the UK.

41 A new era for China's design system

Lunwei Huang, Partner at Beijing Sanyou Intellectual Property Agency Ltd., addresses the implementation of the latest Chinese Patent Law from patent term extension to the accession to the Hague Agreement to provide insight into the changing legal landscape.



41

46 Recent changes in Hungarian IP Law

Ádám György and István Molnár of SBGK introduce the amendments to Hungarian IP Acts that will have a significant impact on the protection of designs, patents, and copyright.

48 Amazon's Patent Evaluation Express (APEX) program has declaratory judgment action risks for patent owners

Joseph Kim and Paul Ainsworth of Sterne, Kessler, Goldstein & Fox PLLC evaluate the recent *SnapPower v. Lighting Defense Group* to draw conclusions on the effectiveness of Amazon's APEX program in protecting IP owners.

50 A guide to Hangzhou for your time at AIPPI World Congress

Ahead of the 2024 AIPPI World Congress set to take place in Hangzhou, China, October 19-22, *The Patent Lawyer* takes a look at the city's highlights and provides travel advice for your trip to experience the economic hub and exquisite cuisine.

52 Directory of services

An A to Z list of the international law firms who provide IP related services.



50



Pravin Anand: Managing Partner, Anand & Anand. India

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



Rafael Beltran: Principal & Partner, Beltran Fortuny y Beltran Rivera, S.C. Mexico

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



Mark Bloom, CLP®, RTTP™: NSABP Foundation, Inc. United States

Mark is the Director of Contracts for the NSABP Foundation, Inc. (Pittsburgh, PA, USA). The NSABP Foundation is a non-profit research organization that sponsors and manages clinical trials focused on treatments for breast and colorectal cancer.



Noel Courage: Partner, Bereskin & Parr. Canada

Noel's practice focuses on the patenting of biotechnological, chemical, and mechanical inventions. He also drafts and negotiates IP agreements, such as research collaboration agreements and licences.



Eugene Goryunov: Partner, Haynes & Boone. United States

Eugene is an experienced trial lawyer that represents clients in complex patent matters involving diverse technologies. He has extensive experience and regularly serves as first-chair trial counsel in post-grant review trials (IPR, CBMR, PGR) on behalf of both Petitioners and Patent Owners at the USPTO.



Jean-Christophe Hamann – CEO, IPSIDE INNOVATION. France/US

J.C. is EP Patent Attorney and US Patent Agent. After working for research and industry, J.C. joined French IPSIDE Law firm in 2009, part of SANTARELLI GROUP and founded IPSIDE INNOVATION as US subsidiary.



Stefan Schohe: Founder, SCHOHE. Germany

Stefan works primarily in the fields of information technology, physics and medical devices for domestic and international clients. Apart from prosecution, a main part of his work is litigation, especially pre-litigation advice, representation of clients in court, and coordinating international patent litigation.



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

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



Sarah Taylor: Senior Practice Development Lawyer, Pinsent Masons' IP practice. UK

Formerly a practicing patent litigator, she specializes in European patent matters. She advises and supports her team and clients on all aspects of patent law and litigation strategy across all sectors, with a particular focus on Life Sciences and Technology. Sarah has written extensively on a wide range of topical patent matters, including AI and UPC.



Osamu Yamamoto: Partner, Yuasa & Hara. Japan

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.

GOODRICH RIQUELME ASOCIADOS

MULTIDISCIPLINARY LAW FIRM OFFERING TAILORED SOLUTIONS TO YOUR BUSINESS SINCE 1934.

COMMITTED TO
EXCELLENCE

CONNECTED TO
PEOPLE

ENRIQUE DÍAZ

TEL: +52 55 5525 1422

E-MAIL:

EDIAZ@GOODRICHRIQUELME.COM

GUILLERMO SOSA

TEL: +52 55 5207 7561

E-MAIL:

GSOSA@GOODRICHRIQUELME.COM

JUAN SUÁREZ

TEL: +52 55 5207 9261

E-MAIL:

JCSUAREZ@GOODRICHRIQUELME.COM

JULIO PRIETO

TEL: +52 55 5207 8183

E-MAIL:

JPRIETO@GOODRICHRIQUELME.COM

GOODRICHRIQUELME.COM

For over 50 years
our business is to empower
the innovation of business
all around the world.



For more than five decades, **GLP** has been offering a complete range of services for the **structured protection of intellectual property**.

Our Clients range from artisans to some of the Top Companies on the *Forbes 500* list, for whom we provide initial consultancy and support in lawsuits – both as plaintiff and defendant – throughout the world.

The quality of our services, commitment of our team and ability to achieve our Clients' highest objectives, led GLP to be a world-class leader in the IP business.

- Patents
- Trademarks
- Designs
- IP Strategy
- Online Brand Protection
- Legal Actions & Contracts

MILANO

UDINE

BOLOGNA

glp.eu

Other offices:
PERUGIA · ZÜRICH
SAN MARINO

+39 02 54120878
glp.mi@glp.eu

+39 0432 506388
glp@glp.eu

+39 051 328365
glp.bo@glp.eu

Scan and
download our app
EU IP Codes:
Get your
IP toolbox now!



The Invention Stack: harvesting and protecting intellectual property

Chris Johns, Partner at Finnegan, and Leonard Stewart, Assistant General Counsel for Fidelity Information Services, draw insights from Jim McKelvey's *The Innovation Stack* to relate business success over conglomerates with the parallel necessity to protect innovations.

In his book *The Innovation Stack*, Jim McKelvey describes going "nose-to-toe" against the world's most dangerous company" and surviving. McKelvey, who co-founded Square with Jack Dorsey in 2009, recalls Amazon copying Square's product and undercutting its pricing. But after about six years, Amazon discontinued its competing product – and even mailed a Square card reader to its former customers. Naturally, this raised questions. Why did Amazon discontinue its competing product? Why did Square survive the Amazon threat?

After reflecting for three years on what Square had done and why it worked against Amazon, McKelvey noticed a pattern. This pattern often appears in businesses whose aim is to "square up" bringing fairness to a previously unfair system." Squaring up, righting a wrong, driven by a survival instinct, forces creativity and sparks a series of interlocking inventions, which he calls the "Innovation Stack."

McKelvey noticed that innovation stacks were at the core of world changing businesses throughout history. But a stack alone does not adequately protect its innovators. We believe that adequate protection using intellectual property is critical to truly edging out competitors – and refer to this as the "Invention Stack."

Problem solving

McKelvey and Dorsey had wanted to solve a problem, a problem that was personal for them and the people they knew – making payment processing for small merchants cheaper and easier. They wanted to "square up" the world of 52 million small merchants that paid 45 times more than larger merchants when processing credit card payments. Square's "innovation stack"



Why did Amazon discontinue its competing product? Why did Square survive the Amazon threat?





Résumés

Chris Johns is a partner at Finnegan who maintains a diverse patent practice, ranging from patent application drafting, international patent prosecution, and strategic portfolio development to district court litigation, Patent Trial and Appeal Board (PTAB) trials, and appeals to the US Court of Appeals for the Federal Circuit. With more than 15 years of experience in the patent field, his practice touches on nearly all aspects of patent prosecution and litigation. He coauthored and coedited a book on patent eligibility around the world.
Author email: johnsc@finnegan.com

Leonard Stewart is an assistant general counsel for Fidelity Information Services advising business leaders and executives regarding IP, technology transactions, commercial risk management, and compliance. He has over 20 years of experience enabling the technological and digital transformation of enterprises to deliver product, brand, and market value and to improve operational productivity. This includes more than 15 years as a patent attorney and corporate counsel advising clients when developing and deploying electronics, software, digital, and data analytics technologies and solutions, and seven years as an engineer and organizational leader building disruptive innovations and redesigning inefficient processes.
Author email: Leonard.Stewart@fisglobal.com

resulted from this decision to serve people outside the existing market.

McKelvey gives an example of a company with an innovation stack that many are likely familiar with: IKEA. He describes its origins as a furniture business that was banned from furniture trade fairs in Sweden for undercutting its competitors. With no way to present its wares publicly, IKEA turned to sending a catalog directly to consumers. Because of a boycott by manufacturers in its home country, IKEA had to turn to overseas manufacturing. But overseas manufacturing had old factories with poor quality, so it had to build efficient, modern factories. This led to reduced costs. But shipping furniture from overseas was expensive. So IKEA started shipping furniture in a disassembled fashion. Reassembling disassembled furniture requires high labor costs, so



Chris Johns



Leonard Stewart

“In addition to providing a straight business advantage, in many situations, this innovation stack can be harnessed from an IP perspective.”



the furniture was designed to be assembled by consumers.

McKelvey uses this example to make the point that solving a problem – whether it be economic, practical, physical, or otherwise – with a new solution generally leads to the discovery of more problems, each of which requires their own solution. This iterative problem-solving process leads to a massive “stack” of innovations that differentiates the ultimate offering from other, similarly-situated solutions.

While the end solution alone might not be something irreplaceable, the stack of solutions to the multiple problems identified along the way can create an irreproducible market differentiator – the sort of thing that separates middling companies that follow innovation from those that lead innovation. Anyone can copy the end result of “self-assembled furniture,” but IKEA was able to harness its learnings from each step along the path – catalogs, overseas manufacturing, factory improvements, disassembled custom furniture – to make the end result cost effective and efficient. Without copying each aspect of the stack, competitors cannot compete effectively.

Invention stack

In addition to providing a straight business advantage, in many situations, this innovation stack can be harnessed from an IP perspective. For example, each technologically advantageous solution can provide the foundation for a new patent application or a new trade secret. For example, along the path to “self-assembled furniture,” developing factory improvements can yield innovations such as new machine tools, process management efficiencies, or logistics optimizations. Each of those innovations may have one or more protectable inventions therein. The differentiation that comes from each solution can be harnessed on a business level and on an exclusionary level.

Innovative organizations need a way to capture each innovation that is developed through that iterative problem-solution-problem-solution process. Focusing only on the ultimate solution means leaving valuable ideas uncaptured and unprotected. Failing to protect those intermediate solutions can lead to competitors copying most of your ultimate innovation, which takes away from its distinctiveness and market-differentiating aspects. On the other hand, capturing those innovations needs to be easy: with too onerous of a process, would-be inventors simply will hold back on disclosing their results.

As we argued in our piece in Corporate Counsel magazine last year, an easy invention disclosure process is critical to keeping the “patent flywheel” moving. Here, too, an easy invention disclosure process is critical for capturing

as many of the innovations as possible. Inventors need to be able to easily submit as many invention disclosures as they desire – and they should be encouraged to over-submit rather than under-submit.

Each incremental solution may not be individually patentable, of course. Indeed, McKelvey even notes that they never successfully patented the iconic “credit card reader that plugs into a headset jack” that is no commonplace these days, despite it being a strong differentiator. But an effective stack does not require everything to be patented. Instead, it is critical to have a regular check-in with inventors to uncover as many solutions as possible.

In-house and outside counsel would do well to treat invention disclosure meetings like a probing deposition – asking inventors what the basis of the problem they identified was, what direction they went in first, what solution they came up with, what problems that led to, and where it went to next. For particularly complex inventions, counsel should also schedule follow-up meetings to uncover potential variations or additional solutions.

Why protect the stack?

If the innovation stack itself – that interlocking stack of innovations – provides a market differentiator, why go through the hassle – the time, the expense, the struggle – of protecting innovations with IP?

First, patents help to foreclose any meaningful copying by would-be competitors. Patents in the innovation stack can block competitors from entering the field by raising their transaction costs to copy even parts of the ultimate solution. Protecting certain aspects with trade secrets can prevent those intermediate solutions from being expropriated to a competitor.

IP also has financial value. A 2006 study by Hsu *et al.*, “Patents as Quality Signals for Entrepreneurial Ventures,” found that doubling the size of a patent portfolio led to a 28% increase in overall valuation. A 2021 study by Richardson *et al.*¹ found that the asking price for the average patent was \$208,000. And recent cases with damages into the millions and billions show that trade secrets can be quite valuable as well.

The ability of IP to enable its owners to exclusively commercialize its innovations induces competitors to spend time and resources inventing around the stack – even if only part of the stack is protected. Strategically aligned patents further provide the opportunity to capture all of the economic value that the patented innovations generate.

Companies can also leverage the IP they generate through this process defensively or



offensively. For example, if that company is sued for infringement, the patents for the solutions that are uncovered during the problem-solving process can be used for counter-assertion (or, better yet, deter would-be plaintiffs from suing at all).

Conclusion

McKelvey's innovation stack is a fantastic insight into what makes innovative companies distinctive and what keeps them competitive in the marketplace. Identifying not just the ultimate solution to a problem as an “invention” but many solutions to the problems that unfold along the way to the ultimate solution is how a company can maintain its competitive edge. To keep that edge, and to develop future value, innovative companies should also protect their stack with IP.

¹ <https://www.ipwatchdog.com/2017/04/18/2016-patent-prices-key-diligence-data/id-81708>

“In-house and outside counsel would do well to treat invention disclosure meetings like a probing deposition.”



Contact

Finnegan

901 New York Ave NW, Washington, DC 20001

Tel: +1-202-408-4155

www.finnegan.com

Fidelity Information Services

www.fisglobal.com



Did The United States Supreme Court make litigation more dangerous for defendants in IP cases? Probably not...

Marc J. Pernick, Partner at Maschoff Brennan, details the intricacies of the Mallory case that raised important questions surrounding personal jurisdiction to conclude the potential impact that the verdict could have on IP cases in the US.

The US Supreme Court returned last year to a subject that it analyzes regularly: personal jurisdiction. *Mallory v. Norfolk S. Ry. Co.*, 600 U.S. 122 (2023), wrestled with the constitutionality of a Pennsylvania corporate registration statute. The law required non-resident corporations that register to do business in Pennsylvania to submit to "general personal jurisdiction" in the state for any suits brought against them, regardless of the parties' and suits' connections to Pennsylvania. A sharply divided Court held that the statute did not offend due process.

The reported case law suggests that, right now, Pennsylvania is the only state with a registration statute like the one in *Mallory*. However, if other states enact registration statutes like Pennsylvania's,



Marc J. Pernick

defendants in patent and other intellectual property cases could find themselves subject to suit in forums – like the district courts of Texas – that many tech companies typically try to avoid. No such trend seems to exist currently. If that changes, it could have a dramatic impact on intellectual property litigation.

Background

The facts in *Mallory* were simple. Plaintiff Robert Mallory worked as a freight-car mechanic for defendant Norfolk Southern for almost 20 years – both in Ohio and Virginia. After leaving, Mallory was diagnosed with cancer, which he attributed to his work for Norfolk Southern. Mallory sued Norfolk Southern in Pennsylvania state court under the Federal Employers' Liability Act.

At the time of suit, Mallory lived in Virginia – where Norfolk Southern was incorporated and had its headquarters. Further, Mallory's complaint alleged that he was exposed to carcinogens while working for Norfolk Southern in Ohio and Virginia.

Given the lack of any connection to Pennsylvania, Norfolk Southern contended that the due process clause of the 14th Amendment prohibited Pennsylvania courts from exercising jurisdiction over it. The Pennsylvania Supreme Court agreed. In light of tension between that decision and a recent Georgia Supreme Court decision, the US Supreme Court granted cert.

The Supreme Court's decision was narrow and fractured. Justice Gorsuch wrote an opinion that Justices Thomas, Sotomayor, and Jackson joined, and which found that the Pennsylvania statute did not violate due process. Justice Alito joined portions of that opinion, creating a five-Justice

majority in favor of vacating the decision below. Justice Jackson wrote a separate concurrence, and Justice Alito wrote a separate opinion concurring in part and concurring in the judgment. Justice Barrett, joined by Chief Justice Roberts and Justices Kagan and Kavanaugh, dissented.

Majority opinion

Justice Gorsuch emphasized that the question in *Mallory* was not new: the Court's decision in *Pennsylvania Fire Ins. Co. of Philadelphia v. Gold Issue Min. & Mill. Co.*, 243 U.S. 93 (1917) – which pre-dates *Int'l Shoe Co. v. State of Wash., Off. of Unemployment Comp. & Placement*, 326 U.S. 310 (1945), by almost 30 years – permitted the Pennsylvania law and squarely controlled. Justice Gorsuch explained that *Pennsylvania Fire* "unanimously held that laws like Pennsylvania's comport with the Due Process Clause." While the Pennsylvania Supreme Court held that subsequent US Supreme Court cases had "implicitly overruled" *Pennsylvania Fire*, Gorsuch – writing for a five-Justice majority that included Justice Alito – said that the Pennsylvania high court had "clearly erred." Gorsuch stated that "if a precedent of this Court has direct application in a case, as *Pennsylvania Fire* does here, a lower court 'should follow the case which directly controls...'"

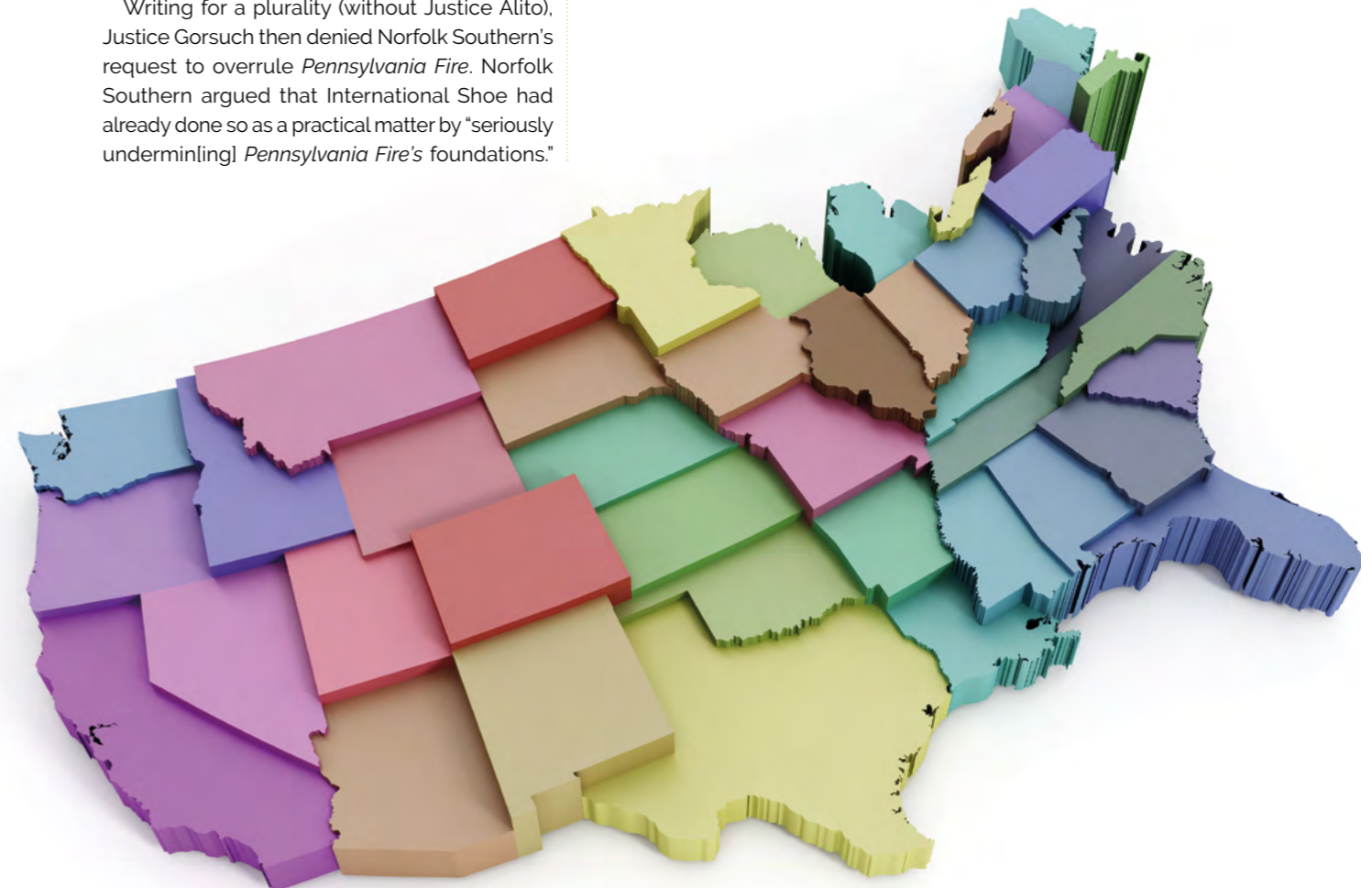
Writing for a plurality (without Justice Alito), Justice Gorsuch then denied Norfolk Southern's request to overrule *Pennsylvania Fire*. Norfolk Southern argued that International Shoe had already done so as a practical matter by "seriously undermin[ing] *Pennsylvania Fire's* foundations."

“*Mallory* may have a dramatic impact on civil litigation in the United States, including intellectual property cases. But it is too soon to tell.”

Gorsuch disagreed because "If the two precedents sit comfortably side by side."

Justice Gorsuch framed *International Shoe* as a case that expanded on the traditional bases for personal jurisdiction that already existed. In Gorsuch's telling, *Pennsylvania Fire* had previously "held that an out-of-state corporation that has consented to in-state suits in order to do business in the forum is susceptible to suit there." *International Shoe* went further by holding that "an out-of-state corporation that has not consented to in-state suits may also be susceptible to claims in the forum State based on 'the quality and nature of [its] activity' in the forum." As long as it comported with "fair play and substantial justice," *International Shoe* allowed a forum state to exercise jurisdiction over a non-resident corporation even when it had not consented to suit in and was not present in the forum.

Viewed through that prism, Justice Gorsuch rejected Norfolk Southern's claim that *International Shoe* tolerated only two types of personal jurisdiction: *i.e.*, "specific jurisdiction" for suits related to the defendant's in-state activities, and "general jurisdiction" for all suits but only in forums where the defendant is at home. Gorsuch maintained that other types of jurisdiction can still exist.





As evidence of this, Justice Gorsuch cited *Burnham v. Superior Ct. of California, Cnty. of Marin*, 495 US 604 (1990). Burnham upheld the traditional “tag rule,” by which an individual who was physically served in the forum state was subject to suit there regardless of whether they were subject to specific or general jurisdiction. Gorsuch underscored that it would be “incongruous” for the tag rule to have survived *International Shoe* (in the context of individuals), but for *International Shoe* to have overruled *Pennsylvania Fire* sub silentio (in the context of corporations).

Justice Alito's concurrence

Justice Alito concurred in part and concurred in the judgment. Alito agreed with Gorsuch that the “parallels between *Pennsylvania Fire* and this case [] are undeniable,” that *Pennsylvania Fire* “held that there was no due process violation in these circumstances,” that “[g]iven the near-complete overlap of material facts, this *Pennsylvania Fire* holding, unless it has been overruled, is binding here,” and that “*Pennsylvania Fire*’s holding, insofar as it is predicated on the out-of-state company’s consent, is not ‘inconsistent’ with *International Shoe*.” Alito emphasized that, because this was the sole question before the Court, he agreed that the judgment below should be vacated.

Most of Justice Alito’s opinion analyzed another issue. Alito explained that Norfolk Southern asserted a defense below based on the “dormant commerce clause.” Although the commerce clause allows Congress to regulate interstate commerce, the US Supreme Court has held that the clause also includes a negative component. This is the so-called “dormant commerce clause,” which prohibits state laws that unduly restrict interstate commerce. The Pennsylvania Supreme Court did not address this issue, but Alito presumed that Norfolk Southern can litigate the defense on remand.

Justice Alito wrote that a state law may violate the dormant commerce clause “when the law discriminates against interstate commerce or when it imposes ‘undue burdens’ on interstate commerce.” Alito stressed that Pennsylvania’s registration statute “seems to discriminate against out-of-state companies by forcing them to increase their exposure to suits on all claims in order to access Pennsylvania’s market while Pennsylvania companies generally face no reciprocal burden for expanding operations into another State.” Justice Alito therefore said that “there is a good prospect that Pennsylvania’s assertion of jurisdiction here – over an out-of-state company in a suit brought by an out-of-state plaintiff on claims wholly unrelated to Pennsylvania – violates the Commerce Clause.” Alito acknowledged, nonetheless, that no commerce clause challenge was before the Court.

“Companies – especially smaller ones – might decide that doing business in states with Pennsylvania-style registration laws is not worth the risk.”

Justice Barrett's dissent

Justice Barrett viewed things differently. Barrett pointed out that, for 75 years since *International Shoe*, the Court has not allowed state courts to assert general jurisdiction over a foreign defendant merely because it does business in a state. Barrett claimed that the majority found “a way around this settled rule.” According to Justice Barrett, “[a]ll a State must do is compel a corporation to register to conduct business there (as every State does) and enact a law-making registration sufficient for suit on any cause (as every State could do).” Barrett objected to “permit[ting] state governments to circumvent constitutional limits so easily[.]”

Justice Barrett also found Gorsuch’s analysis of *Burnham* unpersuasive. According to Barrett, Burnham confirmed the vitality of the “tag rule” in part because the Court did “not know of a single state” that, as of then, had abandoned the doctrine. By contrast, the *Mallory* parties agreed that Pennsylvania was the only state with a statute treating registration as sufficient to confer general jurisdiction. Further, Justice Barrett disputed the notion that tag jurisdiction over an individual based on physical presence is “essentially the same” as registration jurisdiction over a corporation based on deemed consent. Barrett called this “a non sequitur.”

Justice Barrett stated that the majority’s “approach does not formally overrule our traditional contacts-based approach to jurisdiction, but it might as well.” Barrett warned that, “[i]f States take up the Court’s invitation to manipulate registration, [precedents like] *Daimler* and *Goodyear* will be obsolete, and, at least for corporations, specific jurisdiction will be ‘superfluous.’” Barrett opposed “this sea change.”

Impact on intellectual property cases

Mallory may have a dramatic impact on civil litigation in the United States, including intellectual property cases. But it is too soon to tell.

Most post-*Mallory* attempts to establish general personal jurisdiction based on the decision have failed. These cases have held that the forum state’s registration statute did not require consent to jurisdiction in the manner that Pennsylvania’s law did. See *Madsen v. Sidwell Air Freight*, 2024 WL 1160204, at *13, 15-16 (D. Utah Mar. 18, 2024) (“[n]one of Utah’s registration statutes expressly include a consent to general jurisdiction, as the Pennsylvania statute [] did”); *Simplot India LLC v. Himalaya Food Int’l Ltd.*, 2024 WL 1136791, at *9-10 (D.N.J. Mar. 15, 2024) (“[u]nlike the express consent statute at issue in *Mallory*, New Jersey’s registration statute does not include such an express consent requirement”); *Sahm v. Avow Corp.*, 2023 WL 8433158, at *4 (E.D. Mo. Dec. 5,



2023) (“absent a Missouri statute providing an explicit grant of general jurisdiction over registered foreign corporations, [] *Mallory* is not applicable”); *AssetWorks USA, Inc. v. Battelle Mem’l Inst.*, 2023 WL 7106878, at *2 (W.D. Tex. Oct. 23, 2023) (“the Texas statute concerning registration of nonresident corporations neither mentions general jurisdiction nor mirrors the structure of the Pennsylvania statute”); *In re Aqueous Film-Forming Foams Prod. Liab. Litig.*, 2023 WL 6846676, at *4-5 (D.S.C. Oct. 17, 2023) (“South Carolina’s ... insurance registration statute ... contains no consent by foreign corporations to the general jurisdiction of the South Carolina courts”); *Union Home Mortg. Corp. v. Everett Fin., Inc.*, 2023 WL 6465171, at *3, n. 6 (N.D. Ohio Oct. 4, 2023) (“the corollary Ohio statutes contain no such consent provision [as was at issue in *Mallory*]”). At the same time, Georgia and North Carolina courts have held that their registration statutes (despite lacking language expressly stating that a registering company consents to general jurisdiction) give rise to general personal jurisdiction. See *Sloan v. Burist*, 2023 WL 7309476, *4 (S.D. Ga. Nov. 6, 2023); *Harris Teeter Supermarkets, Inc. v. ACE Am. Ins. Co.*, 2023 WL 6568766, at *12-14 (N.C. Super. Oct. 10, 2023).

Accordingly, as of now, it does not appear that *Mallory* has led to a sea change in intellectual property cases or in civil litigation more generally. Nonetheless, Justice Barrett warns that if other states enact registration statutes similar to Pennsylvania’s, then corporate defendants may get dragged into litigation in plaintiff-friendly forums that they would have previously been able to avoid.

“Only time will tell how this ultimately shakes out.”

To be sure, state legislatures may not pass such statutes. Companies – especially smaller ones – might decide that doing business in states with Pennsylvania-style registration laws is not worth the risk, and this possibility could dissuade state legislatures from copying the Pennsylvania approach. That is what has happened in New York, where the governor vetoed legislation that would have made New York’s registration statute similar to Pennsylvania’s. Only time will tell how this ultimately shakes out.

Contact

Maschoff Brennan

450 Sansome Street, Suite 1005,
San Francisco, CA 94111, USA

Tel: +1 415 738 6228

www.mabr.com



Getting the most from your first office action from the United States Patent and Trademark Office

Jeremy W. Miller and Wendy M. Slade of Dowell & Dowell provide best practices for avoiding delays and receiving successful grants when filing US National Stage applications with the USPTO.

The Patent Cooperation Treaty (PCT) Branch of the United States Patent and Trademark Office (USPTO, the Office) ensures pre-examination formalities of patent applications entering the United States (i.e. national stage from international applications) are met as they pertain to the USPTO. The pre-examination process performed by the PCT Branch has greatly slowed in the past few years. Getting a

national stage patent application from filing stage to examination stage can take considerably more time when compared with a regular non-provisional application filing, including those applications claiming priority to a foreign-country application.

To enter the national stage in the USPTO from a PCT application, you only need to provide the WO publication and pay the basic filing fee to the USPTO. These simple steps will start the US national stage and secure a filing date. But moving that application to an issued patent ultimately requires much more and can be a drawn-out and costly endeavor. There are ways to reduce costs, make the most of entrance into the USPTO national stage filing system, and set the application up for the best and least costly prosecution. Efficient prosecution of national stage applications will require more upfront cost and effort but can ultimately save time and money in the long run.

The easiest step an applicant can take to reach examination faster is to file all necessary documents at once when entering the national stage. This includes filing signed inventor declarations, paying all required fees, including search, examination, and any excess claim or size fees, and providing an English translation of the application if the WO publication is in a language other than English. Ensuring the application is filed complete will ensure a quicker route through the pre-examination process. The USPTO will grant additional time to meet these requirements if they are not satisfied at filing, but at least one additional government surcharge will be required. Additionally, this delay can also affect any additional patent term the applicant may be entitled to due to patent term adjustment.

The next step to reduce costs and delay is to submit a preliminary amendment at filing to remove claims with multiple dependency. While multiple dependent claims are allowed in most WIPO countries, including the United States, the USPTO is very restrictive in its acceptance of multiple dependent claims. The Office discourages the use of multiple dependent claims through hefty fees levied for each multiple dependent claim present in an application. Additionally, the Office prohibits multiple dependent claims from depending on another multiple dependent claim. The Office also counts the total number of claims based on every possible combination of claim dependency. Since the base Office filing fees allow only for an initial 20 total claims, which can include only three independent claims, multiple dependent claims can significantly increase claim fees.

Another item that can extend time in pre-examination is the abstract. The Office often issues corrected paper requirements for the abstract of the application. In the PCT application, the abstract can be taken directly from the claims,



Jeremy W. Miller



Wendy M. Slade

“Moving that application to an issued patent ultimately requires much more and can be a drawn-out and costly endeavor.”

Résumés

Jeremy W. Miller is a patent attorney with more than 10 years of patent prosecution experience. He began his IP career in 2013 at Dowell & Dowell, P.C. as a summer student working with attorneys on a variety of matters, including both patent and trademark prosecution. In 2014, he passed the US Patent Bar examination and became a registered US patent agent and continued working at Dowell & Dowell prosecuting patent and trademark applications before the USPTO. In 2015, Jeremy passed the Virginia Bar exam and became a licensed patent attorney. After the retirement of Dowell & Dowell's previous managing attorney, Ralph Dowell, Jeremy took over ownership of the firm and oversees all firm matters, including patent and trademark prosecution before the USPTO.

Wendy M. Slade is a registered US patent agent with over 20 years of experience. She began her IP career in 1997 as a patent researcher conducting patentability, infringement, and clearance searches, as well as validity and invalidity studies across a wide variety of subjects including sunscreen formulations, cleaning compositions, medical instruments, and general mechanical devices. In 2003, after completing the patent agent's exam, Wendy began prosecuting patent applications, maintaining maintenance fee information, and working with foreign associates entering the United States national stage from PCT applications. Wendy now oversees the day-to-day operations of the firm.

be over 150 words, and contain claim language. However, the Office neither allows legal claim language nor a word count of over 150. By addressing these issues at filing via preliminary amendment, the applicant can avoid processing delays, such as Notices to File Corrected Papers.

A preliminary amendment is considered a more labor-intensive way to reduce costs because the Office has many requirements concerning changes to the application, with the requirements for claim amendments being the most detailed. Namely, all changes must be shown along with claim identifiers, with even more nuanced rules for the manner in which they are shown.



If all the formalities of an application have been addressed, the application will move on from the PCT Branch to await examination by an examiner. While the application is out of pre-examination, there is still time to place the claims of the application in a better format for prosecution. Many years ago, the Office routinely issued multiple non-final Office actions, especially if the prosecution was proceeding, before issuing a final Office action. However, since Request for Continued Examination practice began in the 2000s, the Office almost always issues one non-final action followed by a final action. This means that if the claims of the application do not at least conform to US practice or easily understood English, as considered by an examiner of the USPTO, the first Office action may be spent simply addressing grammar and sentence structure instead of relevant prior art. This is one of the more difficult ways to ensure a smooth and less costly prosecution. Making substantive amendments to put claims into conformity with US practice before examination will more likely ensure meaningful prior art is obtained by the examiner in the non-final Office action. Simple amendments before examination, such as replacing pronouns like "it" with specific elements, correcting antecedent basis issues, and replacing "characterized in that" language with "wherein", can have a significant positive impact on examination. An examiner can delay searching and providing art if they deem that the claim language is full of too many grammatical errors. This results in the

“
While the application is out of pre-examination, there is still time to place the claims of the application in a better format for prosecution.
 ”

Contact
Dowell & Dowell, P.C.
 408 E. Fourth Street,
 Suite 302, Bridgeport,
 PA 19405, US
 Tel: +1 484 232 8227
 dowell@dowellpc.com
 www.dowellpc.com

first Office action being spent simply on fixing grammar and procedural issues, which costs the applicant more time and money in the long term. In summary, getting the most from the first office action means addressing any items that may slow the process through pre-examination and ensuring the claims are in a format that US examiners wish to see. These steps, combined with ensuring information disclosure statements are provided to the Office promptly, filing responses to office action by the three-month date, and conducting interviews, will reduce the overall cost of prosecution, help safeguard favorable patent term adjustments, and help the application arrive at an allowance with the greatest speed. Knowledgeable and experienced US counsel can help navigate applicants through the many Office requirements, provide the necessary know-how at a reasonable price to make the most from a first office action, and accelerate an application to issuance.

DOWELL & DOWELL, P.C.

~~~~~  
 PROVIDING COMPREHENSIVE AND PERSONALIZED  
**PATENT AND TRADEMARK**  
 SERVICES FOR OUR CLIENTS FOR OVER  
**100 YEARS**



**WE SPECIALIZE IN ASSISTING ATTORNEYS AND PATENT AGENTS IN CANADA, EUROPE AND AROUND THE WORLD IN OBTAINING U.S. PATENT AND TRADEMARK PROTECTION**

**408 E. FOURTH STREET, SUITE 302, BRIDGEPORT, PA 19405**  
**T: 484-232-8227 | DOWELL@DOWELLPC.COM**

**WWW.DOWELLPC.COM**





# Framing issues in an APA context: recent outcomes

**David McCombs, Eugene Goryunov, and Adam Erickson of Haynes and Boone highlight recent strategies from appellants to frame issues as violations of the Administrative Procedure Act for a less deferential standard of review on appeal.**

The Administrative Procedure Act (APA) governs the process by which federal agencies develop and issue regulations. The Federal Circuit reviews Patent Trial and Appeal Board (PTAB) decisions for compliance with the APA. See *Alacritech, Inc. v. Intel Corp.*, 966 F.3d 1367, 1370 (Fed. Cir. 2020).

As applied to the PTAB, the APA requires that the board provide an adequate explanation of its decisions and ensure that its decisions are grounded in arguments presented by the parties, allowing both parties an opportunity to respond. On close inspection, these traditional categories are reasonably implicated in conjunction with many other issues raised in *inter partes* review (IPR) proceedings. And due to the broad applicability of APA compliance issues, appeals to the Federal Circuit alleging that a PTAB board violated APA provisions are plentiful. For example, because there is no clear-cut line as to whether the PTAB's decision was adequately explained or sufficiently grounded in arguments raised by the parties, arguments that the board exceeded its authority under the APA become simple line drawing exercises highly amenable to attorney argument. As a result, APA compliance reasonably relates to more commonly raised IPR issues, such as claim construction, adequate petition disclosure, priority disputes, etc.

Considering whether existing issues additionally raise possible APA compliance concerns can also increase a party's chances of success on appeal. In some cases, compliance with the APA is reviewed *de novo*, making remand or reversal more likely.

In any case, it's important to be aware of the types of decisions the Federal Circuit has recognized as violating the APA, and those it hasn't. Some of the more common issues recently raised in the context of potential APA violations include (1) adequate explanation of the board's reasoning, (2) adequate notice of claim con-



David McCombs



Eugene Goryunov



Adam Erickson

struction, and (3) decisions regarding motions to amend.

## Adequate explanation

Perhaps one of the most commonly alleged APA violations is inadequate explanation of the Board's reasoning. Chief Judge Moore's opinion in *Medtronic, Inc. v. Teleflex Innovations S.a.r.l.* recently provided guidance on the level of explanation required by the APA. 70 F.4th 1331 (Fed. Cir. 2023). The Federal Circuit explained that "recount[ing] the parties' *prima facie* arguments and evidence" and "identifying] the prevailing argument driving its decision" was adequate explanation under the APA. *Id.* at 1344. The additional step of identifying the prevailing argument was apparently enough to meet the threshold as compared to the inadequate explanation from *In re Nuvasive, Inc.*. See 842 F.3d 1376, 1383 (Fed. Cir. 2016) ("[I]t is not adequate to summarize and reject arguments without explaining why the PTAB accepts the prevailing argument."); see also *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327 (Fed. Cir. 2016).

## Claim construction

While claim construction is commonly raised due to *de novo* review even outside of the context of APA compliance, it has recently been raised as an APA issue in several cases. For example, the Federal Circuit has now repeatedly decided that the PTAB does not violate the APA when it adopts a claim construction in a final written decision that was not expressly presented by either party. See, e.g., *Google LLC v. EcoFactor, Inc.*, 92 F.4th 1049 (Fed. Cir. 2024); *Qualcomm Inc. v. Intel Corp.*, 6 F.4th 1256 (Fed. Cir. 2021); *Parkervision, Inc. v. Vidal*, 88 F.4th 969 (Fed. Cir. 2023). The guiding factor in each of these cases was, expectedly, whether the parties had notice and opportunity to respond. See *id.* However, even when the specific words chosen by the board were presented for the first time in the final written decision,

the Federal Circuit held that the parties had adequate notice and opportunity to respond when each party had thoroughly "disputed the meaning and scope of the...limitation." *EcoFactor*, 92 F.4th at 1057.

## Motions to amend

Parties have also recently argued that APA compliance is implicated in decisions to allow or deny motions to amend during an IPR. For example, the Federal Circuit affirmed the PTAB's denial of a motion to amend as to one claim because the amended claim would have been obvious in view of the prior art under substantial evidence review. See *Pfizer Inc. v. Sanofi Pasteur Inc.*, 94 F.4th 1341, 1353 (Fed. Cir. 2024). But in that same case, the Federal Circuit decided that the Board's decision denying other proposed amended

## 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.

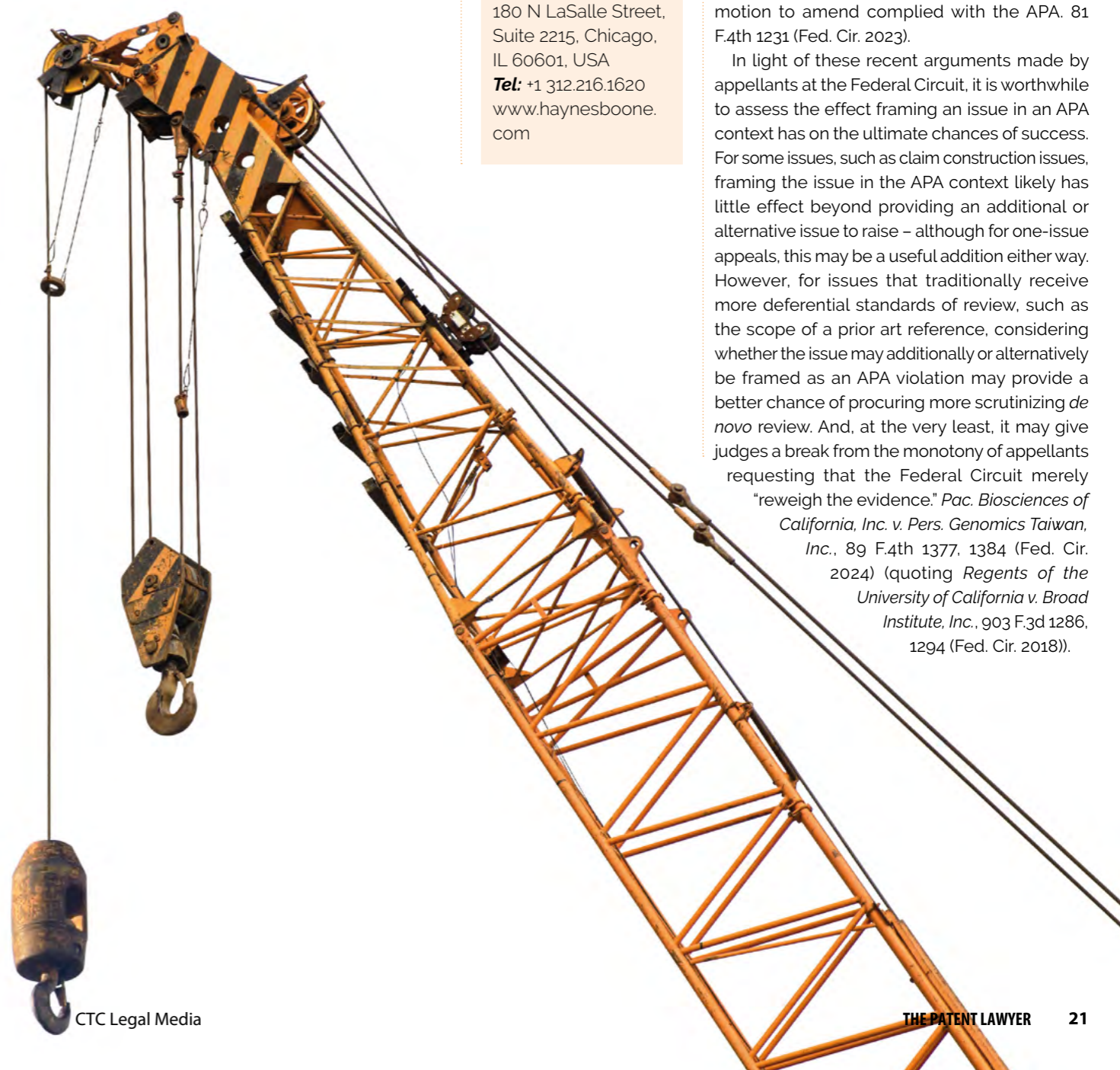
**Adam Erickson** is an associate in the Washington DC office of Haynes and Boone LLP.

## Contact

**Haynes and Boone LLP**  
180 N LaSalle Street,  
Suite 2215, Chicago,  
IL 60601, USA  
**Tel:** +1 312.216.1620  
www.haynesboone.com

claims did violate the APA because it was not supported by substantial evidence. *Id.* But in *Sisvel International S.A. v. Sierra Wireless, Inc.*, the Federal Circuit held that the PTAB's decision to deny a motion to amend complied with the APA. 81 F.4th 1231 (Fed. Cir. 2023).

In light of these recent arguments made by appellants at the Federal Circuit, it is worthwhile to assess the effect framing an issue in an APA context has on the ultimate chances of success. For some issues, such as claim construction issues, framing the issue in the APA context likely has little effect beyond providing an additional or alternative issue to raise – although for one-issue appeals, this may be a useful addition either way. However, for issues that traditionally receive more deferential standards of review, such as the scope of a prior art reference, considering whether the issue may additionally or alternatively be framed as an APA violation may provide a better chance of procuring more scrutinizing *de novo* review. And, at the very least, it may give judges a break from the monotony of appellants requesting that the Federal Circuit merely "reweigh the evidence." *Pac. Biosciences of California, Inc. v. Pers. Genomics Taiwan, Inc.*, 89 F.4th 1377, 1384 (Fed. Cir. 2024) (quoting *Regents of the University of California v. Broad Institute, Inc.*, 903 F.3d 1286, 1294 (Fed. Cir. 2018)).





# 2024 IPO ANNUAL MEETING

SEPTEMBER 22-24, 2024  
HYATT REGENCY | CHICAGO, IL



REGISTER ONLINE @ [IPO.ORG/AM2024](https://www.ipo.org/am2024)

This must-attend event brings together IP professionals from corporations, law firms, government, academia, and service providers from around the world to discuss strategies, trends, and best practices. The annual meeting offers a mix of educational programs, committee meetings, networking opportunities, and exhibits.

[WWW.IPO.ORG/AM2024](https://www.ipo.org/am2024)



# Women in IP Leadership

Celebrating achievements and continuing the empowerment of women



Sponsored by



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.



Sponsored by  Clarivate™



**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.

# Federica Combariati: Senior IP Counsel, ASSA ABLOY Group

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



**F**ederica is the Senior IP Counsel for the ASSA ABLOY Group. In her role, she over-see the spearheading strategies to safeguard and leverage the company's intellectual property assets. Her responsibilities encompass managing IP portfolios, managing legal disputes, and crafting innovative approaches to protect the company's innovations.

Federica is an attorney-at-law. Prior to joining ASSA ABLOY, Federica worked as an attorney at Quinn Emmanuel Urquhart Sullivan LLP and at the European Patent Office in Munich. She holds an LLM in IP law awarded with Distinction by Queen Mary University of London and a master's degree in law awarded with *summa cum laude* by LUISS University in Rome.

### What inspired your career?

Growing up, I never thought I could be anything different from a lawyer: I had this vocation in my blood since day zero. I brought my career across borders because I always felt like a citizen of the world and, despite having strong and deep roots in my home country, I needed to be challenged at international levels.

As far as IP is concerned, as I delved deeper into understanding the role of intellectual property in safeguarding innovation, especially witnessing as a millennial, the rapid pace of technological advancement and the ever-evolving landscape of intellectual property, as well as the incredible impact that technologies have on our life, I realized the profound value and meaning of IP.

I firmly believe today there remains a wide-spread lack of awareness and understanding of IP among the general public. I am astonished by the fact that, in the vast majority of big corps, IP rights still have a marginal role. This is why I decided to work in this field: I feel it as much now as when I started, that I could contribute to spreading recognition around IP and its pivotal role in driving innovation, fostering economic growth, and shaping industries.

In addition to that, I was drawn to the dynamic nature of IP law, where each case presents unique challenges and opportunities for problem-solving and strategic thinking.

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

The journey to my current position has been a blend of intentional decisions and unforeseen opportunities. Central to my career path has been a deep commitment to studying and specializing in intellectual property. This focus allowed me to build a solid foundation of





knowledge and expertise in a niche field with growing demand.

Along the way, I remained open to diverse opportunities that allowed me to apply and refine my skills in real-world settings. This included internships and clerkships at law firms and international organizations, where I gained hands-on experience and valuable mentorship relationships. These experiences not only enhanced my legal skills but also expanded my professional network within the legal community.

Recognizing the global nature of IP practice, I proactively invested in learning foreign languages and engaging with the international legal community. This commitment to linguistic and cultural fluency opened doors to international collaborations and cross-border opportunities.

Reflecting on my journey, my advice for aspiring international lawyers and those pursuing a career in IP is to specialize in your field and stay current with industry developments. Be open to new opportunities, build a strong network of mentors and peers, embrace global perspectives, and advocate for diversity and inclusion within the legal profession.

By following these principles and seizing the opportunities that come your way, you can carve out a fulfilling career path as an international lawyer specializing in intellectual property.

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

Working internationally as a lawyer presents a unique set of challenges due to differences in legal systems, cultural norms, languages, and business practices.

These challenges are often intertwined with navigating the complexities of working in a male-dominated field and in cross-cultural environments.

One significant barrier has been overcoming bias and stereotypes, both within the legal profession and in international settings. I have faced instances where my expertise and abilities were underestimated or questioned simply because of either my nationality or my foreign qualifications to practice law, within a team where I was the only foreign qualified lawyer.

Overcoming this challenge has required me to assert my capabilities confidently, demonstrate my expertise through my work, and challenge stereotypes by advocating for myself and other women in the legal profession.

Despite the personal obstacles and sacrifices involved, working internationally offers unique experiences and professional growth opportunities that can be immensely rewarding. It requires resilience, adaptability, and a willingness to step outside one's comfort zone, but the personal and professional growth that comes from these experiences is invaluable.

“ I am astonished by the fact that, in the vast majority of big corps, IP rights still have a marginal role. ”

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

My most significant achievement in my career thus far lies in successfully navigating and thriving in an international, cross-border legal landscape while demonstrating adaptability to diverse cultures. On a personal level, I take pride in my ability to seamlessly transition between different cultural contexts, fostering meaningful connections and collaborations across borders.

On a more technical and case-related level, I am proud to have had the opportunity to work with prestigious organizations such as the European Patent Office, Quinn Emanuel, and ASSA ABLOY. These experiences have not only honed my legal skills but have also afforded me invaluable insights into the complexities of IP law and practice at the highest levels.

My major achievement, during my time at Quinn, was being part of the team of attorneys leading litigation proceedings between Qualcomm and Apple, reaching, after strenuous court battles, a satisfying settlement for the parties involved.

At the European Patent Office, instead, I had the opportunity to work with the team in charge of the Unitary Patent project. This was a momentous experience, marked by dedication, collaboration, and the pursuit of a vision decades in the making. For over 20 years, the UPproject has represented a monumental endeavor to establish a unified patent and litigation system across Europe, aimed at streamlining patent enforcement procedures, reducing legal uncertainty, and fostering innovation and economic growth. I have had the privilege of witnessing and contributing to this historic initiative, which promises to transform the European patent landscape and enhance the competitiveness of businesses operating in the region.

Finally, one of the most significant achievements during my tenure at ASSA ABLOY as the in-house Senior IP Counsel has been the successful development and implementation of a comprehensive IP strategy to protect and leverage the company's valuable intellectual property assets. This accomplishment involved leading strategic planning processes to assess ASSA ABLOY's existing IP portfolio, identify areas for improvement, and align IP strategies with the company's business objectives. Working closely with internal stakeholders and external advisors, I spearheaded efforts to optimize ASSA ABLOY's IP portfolio and foster collaboration and alignment between the IP legal team and other departments within the company. Overall, the successful development and implementation of this comprehensive IP strategy have had a transformative impact on ASSA ABLOY's ability to protect and leverage its intellectual property assets, positioning the company for long-term success in the global marketplace.

In short, my greatest achievements encompass both personal and professional dimensions, reflecting my ability to excel in an international legal career while contributing positively to the organizations I have been fortunate to be a part of.

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

My overarching career aspiration is to ascend to a leadership position within the corporate landscape, specializing in intellectual property strategy and management. However, my ultimate vision extends beyond personal achievement – it encompasses a transformative shift in how IP is perceived and integrated within the fabric of corporate governance.

At the core of this aspiration lies a deeply held belief in the pivotal role that IP plays in driving innovation, securing competitive advantage, and ultimately, shaping the trajectory of businesses in an increasingly knowledge-driven economy. To this end, my aim is to advocate for the elevation of IP considerations to the highest levels of executive decision-making.

This vision entails establishing a dedicated framework within corporate reporting structures that systematically quantifies and articulates the strategic value of IP assets. This framework would encompass comprehensive metrics and analyses that go beyond traditional financial indicators to encompass aspects such as IP portfolio strength, technological relevance, and potential for future growth and monetization.

Moreover, I envision spearheading initiatives aimed at fostering a culture of IP awareness and appreciation throughout the organization. This includes implementing educational programs, training sessions, and knowledge-sharing platforms to empower stakeholders at all levels to understand the significance of IP and its implications for business strategy and innovation.

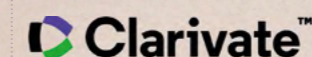
From a technical standpoint, achieving this vision necessitates a multifaceted approach that combines legal acumen, strategic foresight, and stakeholder engagement expertise. It involves leveraging advanced data analytics tools and methodologies to derive actionable insights from complex IP data sets, as well as collaborating closely with cross-functional teams to integrate IP considerations into broader strategic initiatives.

Furthermore, it requires navigating the intricate landscape of IP law and policy, staying abreast of regulatory developments, and anticipating emerging trends that may impact the organization's IP strategy. This entails forging strategic partnerships with external legal counsel, industry associations, and regulatory bodies to ensure alignment with best practices and compliance requirements.

By championing this cause and driving tangible change from within, I aspire to cultivate

“ Providing ongoing training and education on implicit bias, cultural competency, and diversity awareness for all employees within the IP industry is a basic but essential first step. ”

Sponsored by



a corporate environment where IP is not merely viewed as a legal asset, but as a strategic imperative that underpins sustainable growth, innovation, and competitive advantage.

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

Providing ongoing training and education on implicit bias, cultural competency, and diversity awareness for all employees within the IP industry is a basic but essential first step. This includes raising awareness of unconscious biases that may impact hiring, promotion, and decision-making processes, and providing tools and resources to mitigate bias and promote inclusivity in the workplace.

I would like to see more women in leadership roles. To this end, implementing initiatives to increase the representation of women in leadership positions within the IP industry, including law firms, corporate legal departments, and professional organizations is desirable. This involves identifying and addressing barriers to advancement, providing leadership development opportunities, and promoting gender diversity in leadership recruitment and succession planning. Going beyond basic diversity training by developing a deep understanding of diverse cultures, perspectives, and lived experiences, and fostering an environment where individuals feel valued, respected, and empowered to bring their whole selves to work. Engaging with local communities, educational institutions, and diversity-focused organizations to build pipelines of diverse talent and support initiatives that promote diversity and inclusion in the IP field.

By prioritizing these nuanced and proactive strategies, the IP industry can create a more inclusive, equitable, and thriving environment where all individuals have the opportunity to succeed and contribute to innovation and progress.

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

Encouraging women to pursue leadership roles within IP organizations and firms is vital for fostering diversity and inclusion. This can involve mentorship programs, leadership training, and initiatives to mitigate biases in promotion and hiring processes. Encouraging and supporting women entrepreneurs and innovators in navigating the IP landscape is equally crucial. Providing resources such as legal clinics, incubators, and funding opportunities tailored to women-led startups can help foster a more diverse and inclusive innovation ecosystem.





# Annya Dushine: Global Head of the Clarivate IP Management Consulting Practice

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

Annya is the Global Head of the Clarivate IP Management Consulting Practice and is based in Florida, US. She has spent her career in the Intellectual Property (IP) field with more than 20 years of expertise. Her journey began in the dynamic realm of IP law firms in the Bay Area. After transitioning in-house, Annya played a pivotal role in establishing and managing IP departments across various US corporations. She now partners with global law firms and corporate legal departments, providing strategic and practical consulting services in all aspects of IP portfolio and operations management. Annya focuses on driving innovation, enhancing efficiency, mitigating risks, and boosting profitability. Her expertise includes designing optimal organizational models, streamlining IP business processes, aligning IP strategy with business objectives, and ensuring compliance with patent and trademark law.

#### What inspired your career?

I grew up in Silicon Valley, and when I started my career, the Bay Area was the epicenter of innovation. This was where groundbreaking advancements in technology and entrepreneurial spirit came together to create a thriving environment for intellectual property development. This dynamic period, marked by the rise of Silicon Valley's tech giants, the dot-com boom, and my parents' influence with their mechanical engineering backgrounds, inspired my career. It demonstrated the power of ideas and the importance of protecting them. I was fortunate enough to work at startups that fostered creativity and IP law firms that protected cutting-edge ideas born in those startups. Witnessing the

“If you're willing to take some risks, experiment, learn, and adapt, that will ultimately guide you to where you are meant to be.”

success of the tech pioneers and hard-working attorneys protecting innovation, motivated me to pursue a path where I could contribute to advancing and protecting ideas. I wished to ensure inventors and companies could thrive in a competitive market while also empowering the next generation of innovators.

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

I studied finance in college and planned to pursue a career in investment banking. I wanted a challenging, fast-paced, high-stakes career on Wall Street where I could influence global markets and prove that, as a woman, I could excel in a very male-dominated industry. Shortly after I graduated from college, I took a summer job at an IP boutique law firm, working in the file room. For those of you in the industry, you may remember old-school trifolds with metal prongs as fondly as I do. Something about the patent and trademark process really intrigued me, and that experience significantly altered the trajectory of my career. Over the next 20 years I spent time at law firms, startups, corporates, vendors, and consultancies. Exploring diverse opportunities was essential for discovering my pathway to a successful career in IP. Embracing varied roles and industries not only broadened my skill set but also opened new perspectives and unexpected passions. I believe each experience, whether it aligns perfectly with your initial goals or takes you in a completely different direction, contributes to professional growth and adaptability. By stepping out of my comfort zone and trying different things, I gained valuable

insights into what truly excited and motivated me, leading to a more informed and deliberate career choice in IP. If you're willing to take some risks, experiment, learn, and adapt, that will ultimately guide you to where you are meant to be.

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

The number of women in the IP space, from entrepreneurs to inventors to Chief IP Officers, is underrepresented. Although we have made tremendous strides in the last five years, much work remains to be done. This starts with STEM opportunities in classrooms and educational support, followed by recruitment initiatives and leadership development. As a woman in the IP field, I have faced numerous challenges, including gender bias, underestimation, lack of consideration for senior roles and colleagues taking credit for my work supporting their career progression. I encountered situations where my ideas were overlooked and often had my contributions go unrecognized. Navigating a traditionally male-dominated world often required me to work harder to prove my capabilities and earn the respect of peers and clients. I could have chosen to give up or let this divert my career path but instead, I focused on enhancing my expertise, seeking out mentors who provided guidance and support, and building a strong professional network. I established my reputation as a knowledgeable and reliable expert by actively participating in industry associations and speaking at conferences. My perseverance and collaboration with people I respected and trusted in the industry, enabled me to break through barriers and succeed in the IP field, hopefully inspiring other women to pursue and thrive in similar careers. I gained strength and maturity by overcoming difficulties, and I will say "thank you" to those who challenged me. Those experiences made me who I am today.

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

I've had the privilege of achieving several milestones that I'm incredibly proud of. I co-founded and managed the IP department at a biotech startup that successfully went through an Initial Public Offering and developed a life-changing treatment for blindness approved by the FDA. I've had the pleasure of working with some of the greatest IP industry leaders of all time, including George Rathmann, one of the founding fathers of the biotech industry who taught me to never be afraid of taking risks. I've also had the opportunity to mentor and influence aspiring professionals, helping to foster a new generation of intellectual property leaders. Today, I am incredibly honored and proud to lead a new

“I've experienced the rigorous yet rewarding journey of safeguarding ideas as an inventor.”

global IP management consulting practice as part of the recently launched Clarivate Center for IP and Innovation Research™. The Center will guide corporations and research organizations in their mission to create innovative ideas, valuable technology, and brand IP assets. It aims to pave the way in developing and implementing new strategies that will take IP to the next level. Lastly, most people don't know that I'm also an inventor and hold four utility patents on technology that supports health and nutrition, so I've experienced the rigorous yet rewarding journey of safeguarding ideas as an inventor.

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

I am excited about the future in my new role as the Global Head of IP Management Consulting at Clarivate and focusing my efforts on making a positive impact on our business today. As I think forward about the future, my passion lies in inspiring younger generations, guiding them to become the next wave of innovators and leaders. I enjoy mentoring and supporting young talent, sharing my knowledge and experience to help them navigate their own paths. By fostering their creativity, confidence, and resilience, I aim to create a positive impact that extends beyond





my individual achievements. My focus is on building a legacy of encouragement, ensuring that the next generation is well-equipped to drive progress and make meaningful contributions to their fields. I was fortunate enough to have incredible mentors, colleagues and leaders throughout my career who influenced my personal and professional development, and I want to pay that forward.

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

In my career as an IP leader, I've worked across different industries and working environments, and I've seen firsthand how inclusion and diversity drive innovation, creativity, passion, and results. Women have succeeded in their careers by leveraging their resilience, intelligence, and strategic acumen to excel. They have broken barriers by consistently demonstrating exceptional performance, often having to work harder and smarter to prove their worth. If we simply continue to foster diversity and inclusion, we can pave the way for future generations, showing that success in any business or industry is attainable through tenacity and commitment to our goals. Additionally, action at the organizational level will be equally as important. Organizations need to take a proactive approach to ensure equal representation and build a culture that achieves equality. I'm proud to be part of an organization that embraces inclusion and diversity and proves its commitment through initiatives such as *The Women in IP Leadership* that is driving a positive and meaningful impact for the future of Clarivate.

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

The pioneering spirit and success of women in the industry today have opened doors to women worldwide who are just starting their careers. We can continue expanding on this through a multi-faceted approach that includes mentorship, education, and advocacy. Establishing robust mentorship programs where experienced female IP professionals guide and support younger women can build confidence and provide valuable industry insights. Encouraging women to pursue IP law careers and leadership roles through scholarships, workshops, networking, and internships will create a stronger talent pipeline. Companies and law firms should implement actionable policies that promote diversity and inclusion, ensuring equal opportunities for leadership roles and career advancement. Additionally, advocating for and evangelizing STEM programs in early education will promote

“ Establishing robust mentorship programs where experienced female IP professionals guide and support younger women can build confidence and provide valuable industry insights. ”

innovative and creative thinking. Helping to provide opportunities to educate and excite young girls while exposing them to science and technology will plant the seeds for future inventors. Advocacy for gender equality within professional organizations and through public speaking engagements can also raise awareness and drive cultural change. By fostering a supportive and inclusive environment, we can create a thriving community where women are empowered to innovate, lead, and shape the future of the IP industry.



# The Patent Lawyer

GLOBAL REACH, LOCAL KNOWLEDGE  
www.patentlawyermagazine.com

## LAW FIRM RANKINGS 2024

The UK and Europe

A comprehensive list of the 10 most well-respected law firms from the UK and Europe







# The Patent Lawyer Magazine

GLOBAL REACH, LOCAL KNOWLEDGE

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

## Austria

- ABP Anwälte Burger und Partner
- CMS
- DORDA
- Gassauer-Fleissner Rechtsanwälte GmbH
- GEISTWERT
- Puchberger & Partner
- Schoenherr
- Schwarz Schönherr
- Wildhack & Jellinek
- Wiltschek Plasser

Anwälte Burger und Partner  
Rechtsanwalt GmbH

**IP**

We protect success!

Anwälte Burger und Partner Rechtsanwalt GmbH  
Rosenauerweg 16 | 4580 Windischgarsten | AUSTRIA  
Phone +43 7562 20531-0 | [kanzlei@abp-ip.at](mailto:kanzlei@abp-ip.at) | [www.abp-ip.at](http://www.abp-ip.at)

WINDISCHGARSTEN | VIENNA | MUNICH | ZURICH

## Belgium

- ALTIUS
- Bird & Bird
- Cape IP
- Crowell & Moring
- Fieldfisher
- Hoyng Rokh Monegier
- Janson
- NautaDutilh
- Simont Braun
- Stibbe

## Bulgaria

- Boyanov & Co.
- CMS
- Djingov, Gouginski, Kyutchukov & Velichkov (DGKV)
- Georgiev, Todorov & Co
- IP Consulting
- Kambourov & Partners
- KGK Law Firm
- K TAHTADJIEV
- Manev & Partners
- Penkov, Markov & Partners

**M. Sc. Konstantin Tahtadjiev**  
Bulgarian & European Patent Attorney (EQE qualified)  
Bulgarian & European Trademark & Design Attorney

Invent hard, IP it smart

**TAHTADJIEV**  
INDUSTRIAL PROPERTY

PATENTS  
UTILITY MODELS  
TRADEMARKS  
INDUSTRIAL DESIGNS

We offer an individually tailored approach for getting the best possible protection for your business inventiveness and creativity in Bulgaria and Europe.

[tahtad@ktpatent.com](mailto:tahtad@ktpatent.com) | [www.ktpatent.com](http://www.ktpatent.com)

## Cyprus

- AGP Law Firm | A.G. Paphitis & Co. LLC
- Coucounis (Andreas Coucounis & Co LLC)
- Chrysostomides
- Elias Neocleous & Co LLC
- E & G Economides LLC
- Haviaras & Philippou LLC
- IP Cyprus
- Koushos Korfiotis Papacharalambous LLC (KKP LLC)
- Lellos P. Demetriades Law Office LLC
- Michael Kyprianou & Co LLC

## Czech Republic

- Baker McKenzie
- Bird & Bird
- Čermák a Spol
- Havlík Švorčík & Partners
- Havel & Partners
- Korejzová Legal
- PATENTSERVIS
- Rott, Růžička & Guttman
- ROWAN LEGAL
- THK Legal s.r.o

## Denmark

- AWA
- Bech-Bruun
- BUGGE VALENTIN
- Gorrissen Federspiel
- Horten
- Kromann Reumert
- Lundgrens
- Plesner
- Plougmann Vingtoft
- Zacco

## Estonia

- AAA Legal Services
- COBALT
- Ellex Raidla
- Hedman Law Firm
- Käosaar
- KPMG Law in Estonia
- NJORD Law Firm
- Sorainen
- TGS Baltic
- TURVAJA OÜ

## Finland

- Backström & Co
- Berggren
- Boco IP
- Borenius
- Castrén & Snellman
- Espatent
- Hannes Snellman
- Heinonen & Co
- Papula-Nevinpat
- Roschier

## Greece

- A & K Metaxopoulos & Partners
- A.Papapanagiotou & Partners Law Firm
- Ballas, Pelecanos & Associates
- Bernitsas Law
- HP&P | Dr. Helen G. Papaconstantinou and Partners
- Drakopoulos
- Kiortsis & Associates Law Offices
- KLC Law Firm
- Patrinos & Kilimiris
- Tsibanoulis & Partners

**DR HELEN G. PAPACONSTANTINOU & PARTNERS LAW FIRM**

Established 1920

2, Coumbari Str., Kolonaki, 10674 Athens, Greece  
T: +30 210 3626624 • F: +30 210 3626742  
E: [mail@hplaw.biz](mailto:mail@hplaw.biz) • W: [www.hplawfirm.com](http://www.hplawfirm.com)

- Patents
- Utility Models
- SPC's
- Plant Breeders' Rights
- Trademarks
- Designs
- Copyright
- Anti-Counterfeiting & Anti-Piracy
- Litigation
- Licensing
- Franchising
- Commercial and Corporate Services
- Internet
- E-Commerce and Domain Names
- Competition Law
- Advertising / Consumer Protection
- Foreign Jurisdictions
- Consultancy





**glp**  
Your European IP Partner

For over 50 years our business is to empower the innovation of business all around the world.

Patents  
Trademarks  
Designs  
IP Strategy  
Online Brand Protection  
Legal Actions & Contracts

glp.eu

MILANO UDINE BOLOGNA Other offices:  
+39 02 54120878 +39 0432 506388 +39 051 328365 PERUGIA ZÜRICH SAN MARINO  
glp.mi@glp.eu glp@glp.eu glp.bo@glp.eu

## Italy

- Bird & Bird
- BonelliErede
- Franzosi Dal Negro Setti
- GLP
- Hogan Lovells
- IP Law Galli
- Jacobacci & Partners
- Modiano & Partners
- Simmons & Simmons
- Trevisan & Cuonzo

## Germany

- Bardehle Pagenberg
- Boehmert & Boehmert
- Cohausz & Florack
- Eisenführ Speiser
- Grünecker
- Hoffmann Eitle
- Kuhnen & Wacker
- Maiwald Intellectual Property
- Vossius & Partner
- Weickmann

## France

- ABELLO
- Allen & Overy
- Armengaud Guerlain
- August Debouzy
- Bardehle Pagenberg
- Casalonga
- Germain & Maureau
- Gide Loyrette Nouel
- Lavoix
- Plisseraud IP

## Hungary

- Bérczes Fulajtár Law Office
- Bird & Bird
- Danubia
- Germus & Partners
- Gödölle, Kékes, Mészáros & Szabó
- Kovári Patent and Trademark Attorneys
- Oppenheim
- Pintz & Partners
- SBGK
- Szecskey Attorneys at Law

**GERMUS & PARTNERS**  
ATTORNEYS AT LAW

IP services in Hungary and in the region  
Patent litigation  
Trademark litigation  
Full scope of legal services in life sciences and IT  
Advising in technology transfers and transactions

Read more: <https://germus.hu/en/patent-lawyer>

## Latvia

- Agency TRIA ROBIT
- COBALT
- Ellex Klavins
- Eversheds Sutherland Bitāns
- Latiss
- METIDA
- PĒTERSONA PATENTS - AAA LAW
- Sorainen
- TGS Baltic
- VILGERTS

## Lithuania

- AAA Law
- COBALT
- Ellex Valiunas
- Eversheds Saladžius (Eversheds Sutherland)
- GLIMSTEDT Bernotas & Partners
- METIDA
- NOOR
- Sorainen
- TGS Baltic
- TRINITY JUREX

Move your inventions forward. We take care of the rest!

www.boehmert.com

**Industries**

- Chemistry
- Electrical Engineering
- Internet
- Creative Industries
- Physics
- Pharmaceuticals
- Life Sciences
- Mechanical Engineering
- Software / IT

**Legal Areas**

- Patents and Utility Models
- Unfair Competition
- Employee Inventions
- Domains
- Licensing
- Trade Marks
- Information Technology
- Data Protection
- Designs
- Patent Valuation
- Patent Litigation
- Product Piracy
- Copyright

90+ Patent Attorneys & Attorneys at Law  
90+ Years of Competence & Client Confidence  
9 Locations in Germany & worldwide

**BOEHMERT & BOEHMERT**

European patent, trademark and law

in black & white

EST. 1983

**PINTZ & PARTNERS**  
PATENT | TRADEMARK | LAW

Check us here: [pintz.com](https://pintz.com)





# PATENT 42

Patents – Trademarks - Designs

**YOUR IP ANSWER IN EUROPE**

Representation in Europe, Benelux, Luxembourg, France and Belgium

BP 297  
L-4003 Esch-sur-Alzette  
Luxembourg  
www.patent42.com  
info@patent42.com

## Luxembourg

- Allen & Overy
- Arendt
- C Law
- Clifford Chance
- Decker & Braun
- Elvinger Hoss Prussen
- Lecomte & Partners
- NautaDutilh
- Office Freylinger
- Patent 42

## Netherlands

- BarentsKrans
- Bird & Bird
- Brinkhof
- De Brauw Blackstone Westbroek
- Freshfields Bruckhaus Deringer
- Houthoff
- Hoyng Rokh Monegier
- Simmons & Simmons
- Vondst
- V.O. Patents & Trademarks

## Norway

- Acapo
- BAHR
- Bryn Aarflot
- GjessingReimers
- Haavind
- Kvale
- Schjødt
- Thommessen
- Wikborg Rein
- Wiersholm

## Poland

- Hasik Rheims & Partners
- JWP
- Kulikowska & Kulikowski
- LDS Łazewski Depo & Partners
- Patpol
- Polservice
- ROA Rasiewicz & Associates
- Soltysiński Kawecki & Szlęzak
- Traple Konarski Podrecki & Partners
- Wardyński & Partners

## Portugal

- Abreu Advogados
- A.G. da Cunha Ferreira
- BMA | Baptista Monteverde & Associados
- Caiado Guerreiro
- Garrigues
- INVENTA
- JPC | J. Pereira da Cruz
- PLMJ
- SÉRVULO
- VdA

## Romania

- CABINET M. OPROIU
- CWB
- Milcev Burbea
- Muşat & Asociații
- Nestor Nestor Diculescu Kingston Petersen (NNDKP)
- Popovici Nitu Stoica & Asociații
- ROMINVENT
- STOICA & ASOCIATII
- Țuca Zbârcea & Asociații
- Zamfirescu Racoti Vasile & Partners

## Spain

- Balder
- Bird & Bird
- Clifford Chance
- ELZABURU
- Garrigues
- Gómez-Acebo & Pombo
- H&A
- Hoyng Rokh Monegier
- PONS IP
- Uriá Menéndez

## Switzerland

- Homburger
- iPrime
- Lenz & Staehelin
- MLL Legal
- Pestalozzi
- Rentsch Partner
- Schellenberg Wittmer
- TIMES Attorneys
- Vischer
- Walder Wyss



**Intellectual Property Services**

Talk to us  
[caiadoguerreiro.com](http://caiadoguerreiro.com)

**CAIADOGUERREIRO**




**PROTECTING YOUR CREATIVITY DEVELOPING YOUR BUSINESS**

[www.jwp-poland.com](http://www.jwp-poland.com)



**JWP PATENT & TRADEMARK ATTORNEYS**



**CABINET M. OPROIU**  
EUROPEAN PATENT AND TRADEMARK ATTORNEYS

Founded in March 1995, CABINET M. OPROIU is a professional partnership of industrial property attorneys, engineers, chemists, physicists and attorneys-at-law, all specialized in the field of industrial property rights, based in the city of Bucharest, Romania.

**Address:** Popa Savu Street No. 42, Ground Floor, P.O. Box 2-229, Bucharest, Romania  
**Tel:** +40 21 260 2833; +40 21 260 2834  
**Fax:** +40 21 260 2835; +40 21 260 2836  
**Email:** [raluca@oproiu.ro](mailto:raluca@oproiu.ro)  
**Website:** [www.oproiu.ro](http://www.oproiu.ro)





# .fenixlegal

INTERNATIONAL PATENT AND LAW FIRM

SWEDEN • SCANDINAVIA • EUROPE

- European Patents
- EU Trade Marks
- Community Designs
- Copyright & Marketing Law
- IP Due Diligence & Business Law
- Domain Name Disputes & Internet Law
- Mediation
- Social Network Law
- Artificial Intelligence



Brahegatan 44 • 11437 Stockholm • Sweden  
info@fenixlegal.eu • www.fenixlegal.eu

## Sweden

- AWA
- Barker Brettell
- Fenix Legal
- Groth & Co
- Lind Edlund Kenamets
- Roschier
- Sandart & Partners
- Setterwalls
- Westerberg & Partners
- Zacco

## United Kingdom

- Allen & Overy
- Appleyard Lees
- Bird & Bird
- Bristows
- EIP
- HGF
- Marks & Clerk
- Osborne Clarke
- Pinsent Masons
- Potter Clarkson

## Global expertise from a European base



Austria France Germany Ireland Netherlands Switzerland United Kingdom

HGF offers a fully integrated IP solution, bringing together trade mark attorneys, patent attorneys and IP solicitors across 25 offices throughout Europe.



hgf.com  
in HGF Limited  
@HGF\_IP



## Leading Global Intellectual Property Expertise

**300**  
practitioners  
around the world

**137**  
years  
of excellence


**15**  
offices  
across three continents

**1**  
leading firm  
in IP services

Our patent attorneys, trade mark attorneys, and lawyers are **the** legal and technical experts. Providing an award winning full-service IP offering, we help you achieve your business ambitions.

[www.marks-clerk.com](http://www.marks-clerk.com)

 Marks & Clerk
  marksandclerk
  marksandclerk



## Securing your IP is just the start. We're here to help unlock its potential.

Potter Clarkson is proud to be recognised as one of The Patent Lawyer's leading global IP practices.

Our unique full service, multidisciplinary, pan-European team of experienced IP attorneys and lawyers are here to help you identify, protect, exploit and enforce your most valuable assets.

Together we will find the best way to ensure your IP maximises the value of your business.

**IP STARS**  
Managing IP's  
IP STARS 2024

**IAMI Patent 1000**  
The World's Leading  
Patent Professionals 2023

**WTR 1000**  
The World's Leading  
Trademark Professionals 2024

potterclarkson.com





# A new era for China's design system

Lunwei Huang, Partner at Beijing Sanyou Intellectual Property Agency Ltd., addresses the implementation of the latest Chinese Patent Law from patent term extension to the accession to the Hague Agreement to provide insight into the changing legal landscape.

In recent years, China has embraced a series of changes involving the patent system. The latest version of the Chinese Patent Law came into force as of June 1, 2021, then the accordingly amended Implementation Rules for the Patent Law and the Guidelines for Patent Examination came into force as of January 20, 2024. All these brought significant changes to China's patent system, including the design system. This article aims to provide insight into the latest developments in China's design system.

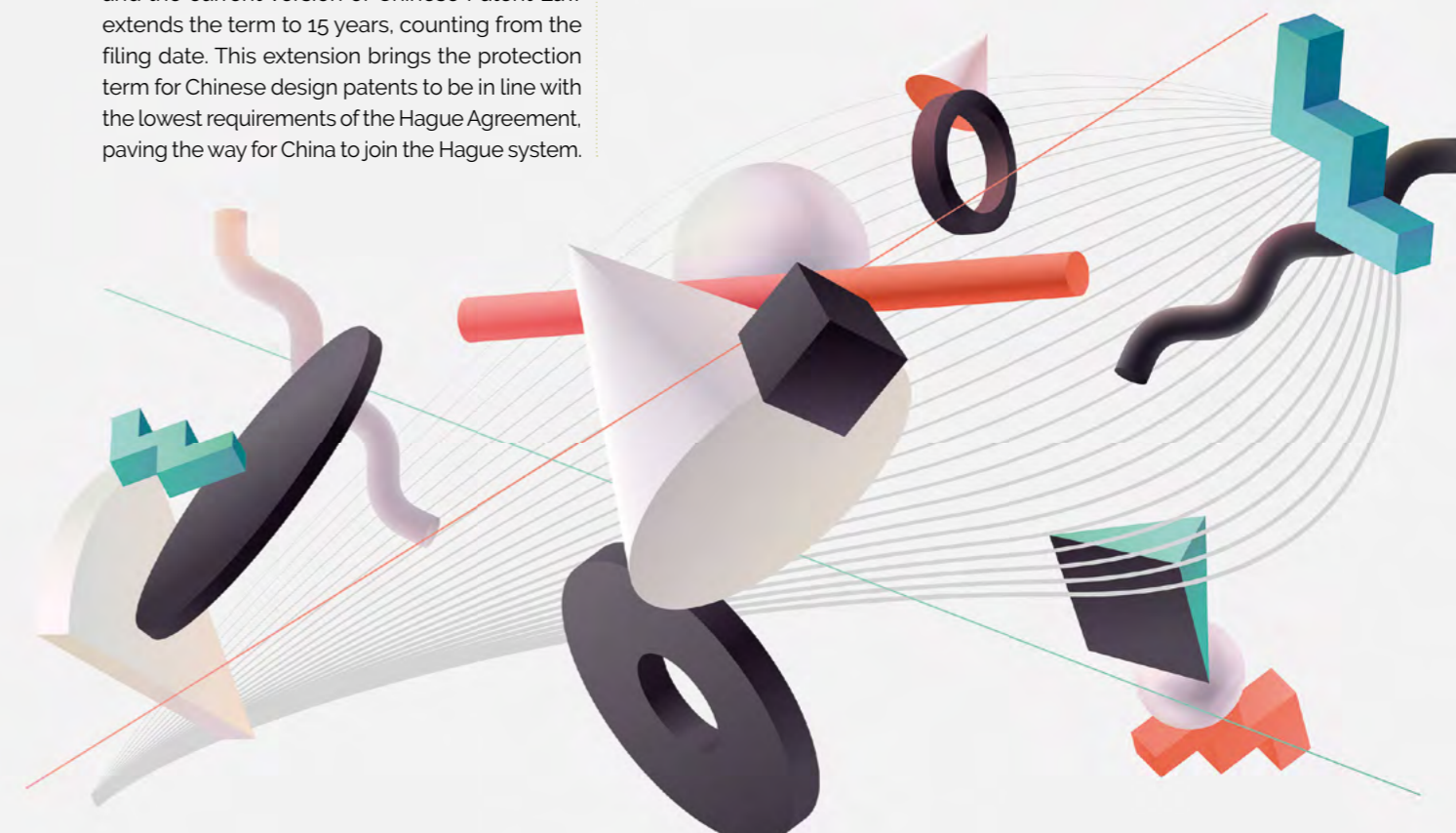
### Extension of patent term for design

The patent term for design used to be 10 years, and the current version of Chinese Patent Law extends the term to 15 years, counting from the filing date. This extension brings the protection term for Chinese design patents to be in line with the lowest requirements of the Hague Agreement, paving the way for China to join the Hague system.

“  
The patent term for design is extended to 15 years.  
”

### Deferment of examination

According to the current version of the Guidelines for Patent Examination, the applicant of a Chinese design application may request to defer examination of the design application. The deferment term may be up to 36 months, in units of one month. One thing that needs to be noted is that the request for deferred examination has to be made along with filing the application, and any later-made requests will not be accepted. Another is that the applicant may withdraw the request for deferred examination at any time before the deferment term expires.



## WHERE THE IP COMMUNITY CONNECTS

The **International Trademark Association** offers exclusive benefits to INTA members around the world, including networking opportunities, Practice Guides and other resources, cutting-edge content, professional development, and discounts on the Annual Meeting and other events.

**Join us!**

Learn more at [www.inta.org](http://www.inta.org)





## Résumé

**Lunwei Huang** is a Partner and Senior Patent Attorney at Beijing Sanyou IP Agency Ltd., which is a full-service IP law firm founded in 1986 in Beijing, P.R. China. With over 20 years of experience in the IP industry, he has wide-ranging expertise including patent prosecution, invalidation, reexamination, administrative and infringement litigation, patent search and analysis in the fields of semiconductor, telecommunication, electronics, and computer systems, etc.  
Author email: [lunwei.huang@sanyouip.com](mailto:lunwei.huang@sanyouip.com)



Lunwei Huang

Under China's patent system, a design application won't be published until it gets granted. Therefore, by taking advantage of the deferment of examination, the applicant of a Chinese design application may maneuver the time at which their patented design gets published according to their business plan.

### Priority claim

The new Patent Law and Guidelines for Patent Examination bring major changes to priority issues.

The first one is that one can file a design application in China by claiming priority from a prior patent application or utility model application, besides a design application. Of course, the priority must be claimed within six months from the prior application date.

Another change is that domestic priority was made available, which means a Chinese design application can claim priority from another Chinese design application. Maybe to the surprise of many, before the new patent law, a Chinese design application can claim priority only from a foreign design application, if any, and domestic priority for design application was not applicable.

One thing that still needs to be noted is that, in claiming domestic priority from a prior design application, the claimed prior design application will be deemed to be withdrawn, and cannot be reinstated even if the priority claim turns out to be invalid at a later stage. However, if a design application claims priority from a prior patent or utility model application, the claimed prior patent or utility model application will not be deemed to be withdrawn.

### Examination of significant distinctiveness

Under the new Guidelines for Patent Examination, a design application may be subjected to an examination on significant distinctiveness before it is granted.

Although the Chinese Patent Law provided that a design has to be new and have significant distinctiveness over prior art designs or a combination of features of the prior art designs to be granted a patent right, there is no substantial examination procedure for design applications. In other words, a design application may be granted after going through only a formality examination, which is referred to as preliminary examination in the context of the Guidelines for Patent Examination.

The number of Chinese design applications keeps growing year on year. In 2022, CNIPA received roughly 798,000 design applications, which accounts for more than half of the yearly global number. Amid the increase in the number of design applications, voices calling for improvement of the quality of design patents mount. Therefore, in the previous version of Guidelines for Patent Examination, it is provided that the examiners may conduct an examination as to whether a design pertains to existing designs, i.e., whether the design is new, in the preliminary examination procedure. Then in this latest version of Guidelines, it is further provided that the examiner may conduct an examination as to whether a design has the aforementioned "significant distinctiveness". Therefore, although there is no substantial examination procedure for Chinese design applications, applications may be subjected to this "quasi-substantial" examination, which sometimes makes applicants filing design applications in China confused. It is referred to as "quasi-substantial" herein in that although the examination is related to substantial issues such as newness and distinctiveness of a design application, the examination is conducted in a formality examination procedure anyway, but not in a substantial examination procedure.

In particular, this "quasi-substantial" examination is conducted on a random basis, which means only a fraction of Chinese design applications are subjected to such examination on newness and distinctiveness. In addition, according to wordings in the Guidelines for Patent Examination, in general, the examiners are required only to compare an examined design with a single cited prior art design to determine whether the examined design obviously does not have significant distinctiveness from the prior art design, without need to compare the examined design with a combination of a plurality of prior art designs. These two points make the "quasi-substantial" examination different from a literal substantial examination that involves a search of prior art designs and a strict and overall examination of newness and distinctiveness.

### Partial design system

The partial design system was first introduced in the new Chinese Patent Law effective as of

June 1, 2021, from which date applicants may file partial design applications in China. Then the Implementation Rules for the Patent Law and the Guidelines for Patent Examination provide specific requirements for filing and examining the partial design applications, which are summarized below.

1. The same as other jurisdictions having a mature partial design system, a Chinese partial design application shall be based on a specific product, which means the drawings for a partial design application shall depict a whole product, with the claimed part being differentiated from other parts of the product.

Basically, there are two ways to make the drawings. One is to depict the claimed part with solid lines while depicting the unclaimed part with broken lines, and dot-dash lines may be adopted to indicate the boundary between the claimed part and the unclaimed part when necessary. The other way is to indicate the unclaimed part with color overlays. In addition, auxiliary views such as enlarged views and sectional views may be filed if necessary.

2. If the claimed part involves a three-dimensional shape, a perspective view showing the claimed part must be submitted. It is important to submit such perspective views when filing an application, as late submission of any views may incur a new-matter problem.
3. The claimed part has to form a relatively stand-alone and closed area on the product or form a relatively complete design unit. For example, it is not allowed to claim a ridge or an open area on the product. For an open area on the product, a dot-dash line may be used to confine the claimed part.
4. It would be not allowed if the claimed part is simply a pattern on the product, or if the claimed part is of a simple or common shape, which cases will result in rejection as not being an eligible "new design" defined in the patent law.
5. The title of a partial design application is required to be in the form of "claimed part of whole product", such as "door of a vehicle" and "detection part of a supersonic probe". If the claimed part occupies a majority of the product, the design may be named in the form of the "main body of whole product", such as "main body of a vehicle".

“  
The applicants having no habitual residence or business office in China mainland have to communicate with CNIPA via a patent agent.  
”

5. It is necessary to indicate in the "brief description" section, respectively, the usages of the whole product and the claimed part, such as "the whole product is to be used as a speaker, and the claimed part functions as waveguides positioned on both sides thereof".
6. Such amendments as changing a whole design into a partial design, changing a partial design into a whole design, and changing a partial design from claiming one part to another part of a product, are allowable if they are made within





two months from the filing date of the application and if no new-matter problem is involved. However, such amendments are not allowable after two months from the filing date, for example, when responding to any Office Action.

- It is not allowed for one design to include two or more separate claimed parts, unless these claimed parts are associated with each other in functionality or design concept to form a certain aesthetic effect, such as designs for two legs of spectacles, or four concerns of a mobile phone.
- The multi-design application scheme, in which a plurality of similar designs is included in one single application, applies also to partial design applications. For such a multi-design application scheme to be applicable, the plurality of partial designs must be of the same product and share the same or similar design features. For example, the difference among the plurality of partial designs needs to be of local and minor variations, or of customary designs in the art, or of repetitive arrangement of the same design element, or merely variation of color elements, or customary variation of position and/or proportion of the claimed part with respect to the whole product.

### China's accession to the Hague Agreement

China deposited its instrument of accession to the 1999 Geneva Act of the Hague Agreement on February 5, 2022, and the 1999 Act entered into force in China on May 5, 2022. Since then, China may be designated for any Hague applications. Provided below are some takeaways for Hague applications designating China.

- The applicants having no habitual residence or business office in China mainland have to communicate with CNIPA via a patent agent. For example, in receipt of a Notification of Refusal issued by CNIPA, the applicant has to file a response via a Chinese patent agent.
- Although it is allowed for a Hague application to include at most 100 designs, CNIPA requires that the number of designs included in one application cannot exceed 10. Furthermore, CNIPA's requirements are much stricter in this respect. For a Hague application, a plurality of designs can be included in one single application if only they belong to the same class of the

“**CNIPA requires a Hague application designating China to include a brief description of features of the claimed design.**”

Locarno Classification. In contrast, CNIPA's requirement is that for two or more designs to be included in one application, they must pertain to the same product and be similar enough. This point needs to be taken into full consideration in filing a Hague application which includes a plurality of designs with China being designated.

- CNIPA requires a Hague application designating China to include a brief description of features of the claimed design. Therefore, it is important to submit such a brief description when filing a Hague application designating China, as failing to do so would end up with a Notice of Refusal. This brief description can be a simple clause such as, "feature of the design resides in the shape of the product". If a color claim is intended, it shall be indicated in the brief description.
- If neither the priority document nor DAS code has been furnished when filing a Hague application designating China, it is necessary to submit a copy of the priority document to CNIPA within three months from the international publication date. Failing to do so will cause the priority claim to be dismissed by CNIPA.

Summarized above are the latest developments of China's design system, which, along with other changes brought about by the new Chinese Patent Law, the Implementation Rules thereof, and the Guidelines for Patent Examination, marks a new era of China's IP protection.

### Contact

**Beijing Sanyou Intellectual Property Agency Ltd.**  
 16th Fl. Block A, Corporate Square, No.35 Jinrong Street, Beijing, 100033, P.R.China  
**Tel:** +86 10 8809 1921 | + 86 10 8809 1922  
**Fax:** +86 10 8809 1920  
 sanyou@sanyouip.com  
 www.sanyouip.com



# SANYOU IP GROUP

BUILD IP PROTECTION WORLDWIDE

WWW.SANYOUIP.COM

ESTABLISHED IN 1986

Established in 1986, Sanyou IP Group started as Beijing Sanyou Patent Agency founded by the former President Ms. Qiang Li. Sanyou is one of the first private patent agency approved by CNIPA.

As a pioneer dedicating to intellectual property for more than 37 years, Sanyou is committed to pursue excellence and continues safeguarding IP rights for domestic and overseas clients with professionalism and craftsmanship.

Sanyou is one of the first batch of firms awarded by the Chinese Patent Office the title of Outstanding Patent Agency, a vice president member of ACPAA, a standing committee member of CTA, and a vice president member of CIPS, etc.

After more than 37 years' development, Sanyou has become a comprehensive IP group providing all-round IP services for domestic and international clients from rights procurement to enforcement.

Sanyou IP is always striving to improve services in the hope to share a win-win future with our clients.

# SANYOU

## Professional Staff Structure

More than  
**400**  
employees

Over  
**300**  
professionals

Over  
**180**  
patent attorneys  
and lawyers

A trademark  
team of  
**30**  
members

### OUR HEADQUARTER

16th Fl., Block A, Corporate Square, No.35 Jinrong Street,  
 Beijing, 100033, P. R. China  
 TEL: +86-10-88091921  
 FAX: +86-10-88091920  
 Email: sanyou@sanyouip.com  
 Website: www.sanyouip.com







# Recent changes in Hungarian IP Law

Ádám György and István Molnár of SBGK introduce the amendments to Hungarian IP Acts that will have a significant impact on the protection of designs, patents, and copyright.

There have been several changes to the Hungarian Intellectual Property Acts, some are very significant, such as in the Act XLVIII of 2001 on the Legal Protection of Designs (Design Act) which presents a new option for right holders. Additionally, there are amendments in the Act LXXVI of 1999 - On Copyright (Copyright Act).

## Design Act

Several new institutions have been introduced to the Design Act. Until now, the Hungarian Intellectual Property Office (HIPO) conducted novelty research if the filing complied with the requirements for the recognition of the filing date and if the fees had been paid. This was a



Ádám György



István Molnár

## Résumés

**Dr. Ádám György, Partner, Attorney at Law**

Advising full scope of IP legal advice, with a special focus on designs & trademarks, as well as providing legal representation before HIPO, EUIPO, and litigation in the field of IP; also providing mentoring activity for the Hungarian Fashion and Design Agency and national start-ups.

**Dr. István Molnár PhD Patent Attorney, Head of Business Development and Client Relations**

Advising IP counseling, with a special focus on chemical & biotech IP solutions & R&D projects, preparing national, European, and PCT patent applications covering pharmaceutical solutions. Preparation of IP management policies, IP contracts audits, Freedom to Operate searches, and developing prior use policy.

part of the process. As a completely new section (33/A), there is a new institution, namely the "Protectability Assessment".

With the payment of a service fee (if the author is the only holder of the claim for entitlement to a design or the holder of the design, one-half of the fee payable for the protectability assessment shall be charged), the applicant or holder of the design can request a protectability assessment by the HIPO if protection has already been granted. A protectability assessment issues a statement by the HIPO containing justification. It is made based on a novelty search, which has no binding force beyond the legal effects provided in the Design Act, to decide if the given design satisfies the criteria of protectability (novelty and individual character) and if there are any grounds for exclusion. The protectability assessment is made for one design only and it is separated from the main design application examination process. This means that the design protection may be granted even before the protectability assessment is completed.

During the course of the protectability assessment, the HIPO provides a novelty search founded on the representation of the design, paying attention to the description of the product in which the design is incorporated. The protectability assessment shall indicate the documents or data that may be taken into account regarding the design with the aim of providing an opinion about novelty and individual character.

The HIPO shall prepare the full protectability assessment including documenting relevant designs available on the day of the application for assessment. The HIPO must complete the protectability assessment within three months of the protectability assessment filing date. The protectability assessment should be provided to the applicant and/or the holder of the design by the HIPO with copies of reference documents. Once the protectability assessment has been

finalized, it must be published in the Official Journal of the HIPO.

The protectability assessment is a very important addition to the Design Act and could prove useful in the design protection pallet. The main new element and difference is that the protectability assessment will be performed after a separate request from the applicant or the right holder and not automatically as part of the examination of the design application. The protectability assessment procedure is separated so the examination of the design application can flow on a normal course.

Besides these deleted and added elements to the Design Act, there were a few textual changes and several procedural changes including shortening of the time limit to pay the fees from two months to one.

## Patent Act

The most important issue at the EU level is the Unified Patent Court (UPC). It started to officially operate last year after a long period of uncertainty when the last obligatory member state, Germany, ratified the UPC Treaty. Hungary is not a member of UPC, so it has no jurisdiction. Hungary's case is interesting because it was one of the signing countries of the treaty but the Constitutional Court has been asked to provide an opinion before ratification. The Constitutional Court found that the UPC Treaty cannot be ratified as it is not an EU legal institute and the superiority of the EU law cannot apply as it would limit judicial sovereignty.

These amendments are from 2021 but they are important to mention. The Bolar rules are clearer as the exceptions have more information and have been defined more precisely. The reconsideration of the bifurcated system has also happened. A new procedural rule amendment was introduced, where nullity and infringement matters may be heard in the same proceedings. Another change has made it possible for the

“  
**The protectability assessment shall indicate the documents or data that may be taken into account regarding the design with the aim of providing an opinion about novelty and individual character.**  
”

HIPO (and Hungarian courts) to decide several European Patent issues in its own jurisdiction/ authority as long as it is legally and factually available for them to do so.

## Copyright Act

Into the Copyright Act: a new regulation has been added in 2021. The Provisions Applicable to Content-sharing Service Providers are very important because they create a safe regulatory background for content-sharing service providers. In the sections there are definitions, strict rules about liability and authorization, and dispute resolution mechanisms implied by the providers.

## SME funds

Currently, there are several SME funds available to cover industrial intellectual property costs arising from procedures before the HIPO and other IP offices, usually the official fees and the costs of patent attorneys or other legal representation. This is a very good opportunity for SMEs who would like to protect their intellectual property. SBGK is offering SMEs consultation and preparation assistance to apply for the funds, and representation in the intellectual property protection procedure. This consultation possibility is very new in the services offered by our firm, and we have made significant investments (human resources too!).

The SME funds are a huge possibility and SBGK is glad to aid companies with consultation.

## Contact

**SBGK**

1062 Budapest, Andrássy Út 113, Hungary

**Tel:** +36 1461 1000

mailbox@sbgk.hu





# Amazon's Patent Evaluation Express (APEX) program has declaratory judgment action risks for patent owners

Joseph Kim and Paul Ainsworth of Sterne, Kessler, Goldstein & Fox PLLC evaluate the recent *SnapPower v. Lighting Defense Group* to draw conclusions on the effectiveness of Amazon's APEX program in protecting IP owners.

Amazon's Patent Evaluation Express (APEX) program provides an expedited and low-cost tool for patent owners to stop the sale of infringing products on Amazon's platform. But low cost does not mean low risk. The US Court of Appeals for the Federal Circuit's recent decision in *SnapPower v. Lighting Defense Group*, 2023-1184 (Fed. Cir. May 2, 2024), confirms that one risk to a patent owner of availing itself of the APEX program is that it may expose the patent owner to declaratory judgment actions outside their home forum.

In *SnapPower*, a Delaware company initiated an APEX enforcement proceeding against a Utah-based seller of electrical receptacle covers. When a patent owner initiates an APEX proceeding against a seller on Amazon's platform, Amazon sends the Agreement to all identified sellers with three options for the sellers: (1) opt into the third-party APEX proceeding; (2) resolve the claim directly with the patent owner; or (3) file a lawsuit for declaratory judgment of noninfringe-

“There is no discovery and the dispute is resolved based on briefing submitted by the parties.”

ment. If a seller takes no action within three weeks, Amazon will remove the accused product listing from its platform. In the case of *SnapPower*, the accused infringer opted to file a declaratory judgment action in Utah. The patent owner moved to dismiss for lack of personal jurisdiction, and the US District Court for the District of Utah granted LDG's motion. The accused infringer then appealed. The Federal Circuit reversed and remanded the district court's finding.

The Federal Circuit concluded that the patent owner, by initiating an APEX proceeding, necessarily affected "sales, marketing, and other activities" of the accused infringer. In particular, the court concluded that the patent owner had purposefully directed its enforcement activities at the accused infringer in Utah. The court explained that the patent owner knew that Amazon would notify the accused infringer and inform it of its options. The patent owner also knew that if the accused infringer took no action, its Amazon listings would be removed, which would necessarily impact its marketing, sales, and other activities within Utah. Ultimately, the patent owner's intentional actions directed at Utah and the foreseeable impact on the accused infringer's activities in Utah subjected the patent owner to declaratory judgment action in Utah.

The APEX program does offer some advantages for patent owners. For one, it's an expedited process that is typically completed within a couple of months. The process is presided over by a neutral attorney who is experienced in US patent disputes. There is no discovery and the dispute is resolved based on briefing submitted by the parties, which includes an opening brief by the patent owner, a rebuttal brief by the accused infringer, and a reply by the patentee. If the patentee

prevails, Amazon immediately delists the accused products. The ability to stop infringing sales within a couple of months is a potent tool for a patentee, and something not available in district court unless a party is able to persuade a court to grant a temporary restraining order.

While speed is one important consideration, APEX proceedings are also substantially less expensive because there is no discovery available and the substantive legal work is limited to two briefs for the patentee, and one brief for the accused infringer. Moreover, the program limits the evaluation to a single patent claim.

Another advantage of the APEX program for patentees is that an accused infringer's defenses are sharply curtailed. Invalidity or unenforceability are not available defenses unless there is a prior finding of invalidity from a US district court, the Patent Trial and Appeal Board, or the International Trade Commission. The only other defense available to an accused infringer is if it can demonstrate that its products were actually on sale one year before the earliest effective filing date. This requires independently verifiable evidence, such as an earlier Amazon listing, and evaluators will not accept testimonial evidence.

There is also no procedure for reconsideration of an evaluator's decision. If either the patentee



Joseph Kim



Paul Ainsworth

or the accused infringer does not prevail in the APEX program, their only recourse is to go to US district court. Once Amazon has delisted a product due to an APEX proceeding, it will only relist the product if there is a subsequent court decision that conflicts with the evaluator's infringement finding.

Despite these advantages to a patent owner of using an APEX enforcement proceeding to stop infringing sales, patent owners should still consider the impact of the Federal Circuit decision in *SnapPower*. A patent owner will be opening itself up to the risk of having to defend a declaratory judgment suit in any jurisdiction where an accused infringer may reside. While not every seller on Amazon may have the means or incentives to bring a declaratory judgment suit, the *SnapPower* decision makes it easier by allowing the infringer to bring suit in its home forum.

## Contact

**Sterne, Kessler, Goldstein & Fox PLLC**  
1101 K Street NW, 10th FL,  
Washington DC 20005  
**Tel:** + 1 202 371 2600  
[www.sternekeessler.com](http://www.sternekeessler.com)

## Subscribe now!

A subscription to *The Patent Lawyer* magazine will ensure that you and your colleagues have detailed information on all the most important developments within the international trademark law industry.

*The Patent Lawyer* magazine is dedicated only to the trademark industry and is written by trademark experts for trademark professionals worldwide.

A subscription includes a hard copy and an electronic copy which can also be read easily on your smartphone or tablet.



## Résumés

**Joseph H. Kim** is an associate in Sterne Kessler's Trial & Appellate Practice Group. His practice involves complex intellectual property disputes in federal district court, before the Patent Trial and Appeal Board, and before the US International Trade Commission.

**Paul A. Ainsworth**, a Director in Sterne Kessler's Trial & Appellate Practice Group, is a first-chair trial attorney with a practice focused on patent and trade secret disputes in federal district courts, at the US International Trade Commission (ITC), and before the US Court of Appeals for the Federal Circuit. Paul's clients include established and emerging leaders in the pharmaceutical, biopharmaceutical, medical devices, chemical manufacturing, and consumer products industries.





# A guide to Hangzhou for your time at AIPPI World Congress

Ahead of the 2024 AIPPI World Congress set to take place in Hangzhou, China, October 19-22, *The Patent Lawyer* takes a look at the city's highlights and provides travel advice for your trip to experience the economic hub and exquisite cuisine.

Once again, AIPPI will be opening its doors to IP professionals worldwide for educational sessions and networking this October – this time in Hangzhou, the capital city of Zhejiang Province in China. Known for its iridescent West Lake and rolling green hills, the city is expected to be a welcoming host for those traveling to the conference.

As a thriving economic hub, Hangzhou is an obvious choice for developing business connections, and AIPPI World Congress will offer a range of networking opportunities alongside the educational program to offer the opportunity to explore the rich cultural heritage, captivating natural scenery, historical sites, and mouth-watering culinary delights. To find out more about the program, register your attendance, and to reserve a space on the association's excursions, please visit [www.aippicongress.org](http://www.aippicongress.org).

## Travel tips for China

Before diving into the delights of Hangzhou, it's

“As a thriving economic hub, Hangzhou is an obvious choice for developing business connections.”

important to familiarize yourself with some essential tips for traveling in China.

**Downloading WeChat and Weixin Pay:** we spoke to Tencent, owners of WeChat, about travel advice for China and they recommend preinstalling WeChat or Alipay and linking a bank card to Weixin Pay to ensure you have access to communication and payments as soon as you land in the city. The app can be used to pay for transport and dining as well as general transactions. You can also use the WeChat App to scan local QR codes as and when needed during your travels. Find out more at [www.tencent.com/en-us/media/weixin-pay.html](http://www.tencent.com/en-us/media/weixin-pay.html)

**Currency exchange:** before arriving in China, exchange your currency to Chinese Renminbi (CNY) at the airport or local banks.

**Language barrier:** while English is increasingly understood in major cities like Hangzhou, it's still recommended to learn a few basic Mandarin

phrases or carry a translation app to facilitate communication.

**Transportation:** Hangzhou has a well-developed transportation network, including taxis, buses, and an efficient subway system. Utilize ride-hailing apps like Didi or the hailing function in WeChat or Alipay for convenient travel around the city.

**Mobile connectivity:** purchase a local SIM card upon arrival for seamless connectivity, ensuring access to navigation apps and communication services. Major service providers like China Mobile, China Unicom, and China Telecom offer affordable options.

For further details on travel tips, please visit the Congress website: [www.aippicongress.org](http://www.aippicongress.org) - Did You Know?!

## Restaurants to savor the local flavors

All situated within 30-minute drive of the Hangzhou International Expo Center, home to the conference, our three top picks for local dining experiences include:

**Lou Wai Lou:** as one of the oldest restaurants in Hangzhou, Lou Wai Lou offers a superb dining experience overlooking West Lake. Delight in signature dishes such as Dongpo Pork and West Lake Vinegar Fish, which embody the essence of Hangzhou cuisine.

**Zhi Wei Guan:** nestled in a charming historical building near Qing he Fang, Zhi Wei Guan serves authentic Hangzhou delicacies. Try their Beggar's Chicken, a traditional dish cooked inside a lotus leaf, infusing it with exquisite flavors.

“We spoke to Tencent, owners of WeChat, about travel advice for China and they recommend preinstalling WeChat or Alipay and linking a bank card to Weixin Pay.”

<sup>1</sup> <https://www.aippicongress.org/event/29e154b4-b10b-4b4c-883c-f94153adeb43/websitePage:597bed6c-fd2d-494b-8da2-3a8ce4b77dfc>

**Hubin 28:** situated on the 28th floor of a high-rise building, Hubin 28 provides an elegant setting with panoramic views of the city. The menu features a fusion of local and international flavors, making it an excellent choice for business meetings accompanied by a fine selection of wines.

## Unwind at Hangzhou's vibrant bars

After a day of business meetings and exploration, relax and unwind at some of Hangzhou's vibrant bars just a short drive from the Expo Center.

**JZ Club:** renowned for its live jazz performances, JZ Club offers a cozy ambiance that transports you to the golden age of jazz. Enjoy the music while sipping a classic cocktail or trying some local craft beer.

**V+ Lounge Bar:** located in the iconic Grand Hyatt hotel, the V+ Lounge Bar offers an upscale and sophisticated atmosphere. Indulge in their extensive selection of wines, and signature cocktails while enjoying sweeping views of West Lake.

**Mega Club:** For those seeking a lively and energetic atmosphere, Mega Club is the place to be. With a spacious dance floor and renowned DJs, it's the ultimate destination for a night of vibrant entertainment and socializing.

Registration for the AIPPI World Congress is open at [www.aippicongress.org](http://www.aippicongress.org). If you are attending, we hope you enjoy the delights Hangzhou has to offer and we look forward to seeing you there!

## Contact

[www.aippicongress.org](http://www.aippicongress.org)



# Directory of Services

## ARGENTINA



### O'Conor & Power

O'Conor & Power's trademark and patent practice group has wide experience in handling portfolios for international and domestic companies in Argentina and Latin America. Our services in the region include searches, filing and registration strategies, prosecution, opposition, renewals, settlement negotiations, litigation, enforcement and anti-counterfeiting procedures, recordal of assignments, licences, registration with the National Custom Administration, general counselling in IP matters, and counselling in IP matters in Argentina and the region.

**Address:** San Martín 663, 9th Floor, (C1004AAM) Buenos Aires, Argentina  
**Tel/Fax:** 005411 4311-2740/005411 5368-7192/3  
**Website:** [www.oconorpower.com.ar](http://www.oconorpower.com.ar)  
**E-mail:** [soc@oconorpower.com.ar](mailto:soc@oconorpower.com.ar)  
[ocp@oconorpower.com.ar](mailto:ocp@oconorpower.com.ar)  
[oconor@oconorpower.com.ar](mailto:oconor@oconorpower.com.ar)

## ARMENIA



### Yakhnina & Partners

The team at "Yakhnina & Partners" comprises of highly-qualified patent and trademark attorneys and lawyers. Major areas of expertise of our patent team: Chemistry, Pharmaceuticals, Biotechnology, Biochemistry, Life Science etc. 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.

Our attorneys are members of INTA, FICPI, AIPI, LESI, ECTA, PTMG.  
**Address:** Yerevan, Republic of Armenia  
**Tel:** +374 91 066393  
**Email:** [Armenia@vakhnina.com](mailto:Armenia@vakhnina.com)  
**Website:** <http://about.vakhnina.com>  
**Contact:** Dr. Alexey Vakhnin, Partner

## BAHRAIN



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** United Trademark & Patent Services Office 21, Sabha Building No. 338 Road 1705, Block 317 Diplomatic Area, Manama, Bahrain  
**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [Bahrain@unitedtm.com](mailto:Bahrain@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Talal F.Khan & Mr Imad

## INDIA



### L.S. DAVAR & CO.

We are India's oldest Intellectual Property and Litigation Firm. Since 1932, we have been as a trusted IP partner of Global Large and Mid-size companies and foreign IP law firms. We have been widely acknowledged by Govt. of India. In the last 90 years, we have retained number one position in India in not only filing the Patents, Designs, Trademarks, Copyright, and Geographical Indications but also in getting the grants.

**Tel:** 033- 2357 1015 | 1020  
**Fax:** 033 - 2357 1018  
**Website:** [www.lsdavar.com](http://www.lsdavar.com)  
**Email:** [mailinfo@lsdavar.in](mailto:mailinfo@lsdavar.in)  
**Contact:** Dr Joshita Davar Khemani  
 Mrs. Dahlia Chaudhuri

## INDIA



### Y. J. Trivedi & Co.

The firm is elated to have completed 50 years in the practice of IPR Law (full service) with offices in Mumbai, Delhi and Jaipur. The firm has a strong base of well-credentialed legal and technical professionals offering quality services in all areas of IPR. Whether working on a precedent-setting case or preparing opinions, the firm endeavours to be innovative in its approach and adopt pragmatic strategies to meet its client's interest. Through interdisciplinary collaboration and specialized experience in its clients' industries, the firm provides effective solutions that aligns with clients' short-term and long-term business objectives.

**Address:** 2nd Floor, City Square Building, Opp. Kashiram Hall, Polytechnic, Ahmedabad - 380 015, Gujarat, India  
 +91 79 26303777, 26305040  
**Tel:** +91 79 26303777  
**Website:** [www.yjtrivedi.com](http://www.yjtrivedi.com)  
**Email:** [jatin@yjtrivedi.com](mailto:jatin@yjtrivedi.com)  
**Contact:** Mr. Jatin Trivedi

## ISRAEL



### Gold Patents and Financial Services (1992) Ltd.

Gold Patents and Financial Services (1992) Ltd. is an intellectual property solution provider firm that operates in Israel as well as worldwide. We specialize in providing evaluation and analyses of IP portfolios; prosecuting and drafting complex patent, design, and trademark applications; freedom-to-operate, due diligence, patentability, validity and infringement opinions. We provide high quality services and solutions that support our clients' business goals and deliver superior IP services in a timely and cost-effective manner.

**Address:** 15 Yohanan Hasandiar St., Haifa 31251  
**Tel/Fax:** +972-48110007/ +972-46892283  
**Website:** [www.gold-patent.co.il](http://www.gold-patent.co.il)  
**Email:** [office@gold-patent.co.il](mailto:office@gold-patent.co.il)  
**Contact:** Marganit Goldraich

## BOLIVIA



### Landivar & Landivar

Established by Gaston Landivar Iturricha in 1961, Landivar & Landivar is a pioneer firm in the field of Intellectual Property in Bolivia. Our international reputation was gained through a competent and complete legal service in our area of specialization. Our firm has grown into a Chain of Corporate Legal Services and Integral Counseling, with the objective of guiding national and international entrepreneurs and business-people towards the success of their activities.

**Address:** Arce Ave, Isabel La Catolica Square, Nº 2519, Bldg. Torres del Poeta, B Tower, 9th floor, off. 902. La Paz, Bolivia, South America  
**Tel/Fax:** +591-2-2430671 / +591 79503777  
**Website:** [www.landivar.com](http://www.landivar.com)  
**Email:** [ip@landivar.com](mailto:ip@landivar.com) - [info@landivar.com](mailto:info@landivar.com)  
**Contact:** Martha Landivar, Marcial Navia

## COLOMBIA



### VERA ABOGADOS ASOCIADOS S.A.

VERA ABOGADOS was founded 50 years ago to attend to legal needs of the business sector in the area of IP. Today they provide their services to all fields of law. The law firm is a reference in the Andean community and they are part of international associations such as INTA, ASIPI, ABPI and ASIPI. They were ranked in 2022 by Leaders League as a highly recommended Colombian law firm and in addition, they are a member of PRAGMA, the International Network of Law Firms.

**Tel:** +57 60-1 3176650  
 +57 60-1 3127928  
**Website:** [www.veraabogados.com](http://www.veraabogados.com)  
**Email:** [info@veraabogados.com](mailto:info@veraabogados.com)  
**Contact:** Carolina Vera Matiz, Natalia Vera Matiz

## DJIBOUTI



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** United Trademark & Patent Services Djibouti Branch Djibouti, Rue Pierre Pascal Q.commercial Imm, Ali Warki, Djibouti  
**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [Djibouti@unitedtm.com](mailto:Djibouti@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Imad & Faima Al Heyari

## JORDAN



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** United Trademark & Patent Services Suite 7, 2nd Floor, Chicago Building, Al Abdali, P.O. Box 925852, Amman, Jordan  
**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [jordan@unitedtm.com](mailto:jordan@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Mrs Fatima Al-Heyari

## KYRGYZSTAN



### Yakhnina & Partners

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

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

Our attorneys are members of INTA, FICPI, AIPI, LESI, ECTA, PTMG.

**Address:** Bishkek, Kyrgyz Republic  
 +996-551-655-694  
**Tel:** +996-551-655-694  
**Email:** [ip@vakhnina.com](mailto:ip@vakhnina.com)  
**Website:** <https://www.vakhnina.com>  
**Contact:** Dr. Alexey VAKHNIN and Mr. Vlad PEROV

## LEBANON



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** United Trademark & Patent Services 6th Floor, Burj Al Ghazal Building, Tabaris, P. O. Box 11-7078, Beirut, Lebanon  
**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [lebanon@unitedtm.com](mailto:lebanon@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Hanadi

## DOMINICAN REPUBLIC



### WDA International Law Firm Intellectual Property

For over 25 years we have provided excellence in Intellectual Property protection to worldwide renowned companies including the most iconic pharmaceutical, beauty and clothing, beverages and motion pictures companies.

Our main practice is devoted to Intellectual Property which specializes in docketing maintenance of trademarks and patents and litigation attorneys of high profile IPR infringements, border protection and counterfeiting cases in Dominican Republic.

**Tel:** 809-540-8001  
**Website:** [www.wdalaw.com](http://www.wdalaw.com)  
**Email:** [trademarks@wdalaw.com](mailto:trademarks@wdalaw.com)  
**Contacts:** LIC. Wendy Diaz  
 LIC. Frank Lazala  
**Whatsapp:** 829-743-8001

## GUATEMALA



### Ideas Trademarks Guatemala, S.A.

Ideas is a firm specialized in the defense of intellectual property rights, offering advice on all kinds of issues related to them and in the management of portfolios of distinctive signs and patents, at competitive prices, in the Central American and Caribbean region.

Ideas is focused on meeting the needs and solving the problems of its clients, setting clear expectations and obtaining creative solutions with minimal exposure and cost-effective. Proactivity has determined our constant growth and modernization, maintaining a high standard of quality and satisfaction in our professional services.  
**Tel:** +502 2460 3030  
**Website:** <https://www.ideasips.com/?lang=en>  
**Email:** [guatemala@ideasips.com](mailto:guatemala@ideasips.com)  
**Contact:** Gonzalo Menéndez, partner, [gmenendez@ideasips.com](mailto:gmenendez@ideasips.com)  
 Gustavo Noyola, partner, [noyola@ideasips.com](mailto:noyola@ideasips.com)

## INDIA



### Chandrakant M Joshi

Our law firm has been exclusively practicing Intellectual Property Rights matters since 1968. Today, Mr. Hiral Chandrakant Joshi heads the law firm as the senior most Attorney. It represents clientele spread over 35 countries. The law firm conducts search, undertakes registration, post-registration IP management strategies, IP valuation, infringement matters, domain name disputes and cyber law disputes of patents (including PCT applications), trademarks, industrial designs and copyrights.

**Address:** 6th Floor, Solitaire-II, Link Road, Opp. Infinity Mall, Malad (West), Mumbai 400 064, India.  
**Tel:** +91 22 28886856 / 57 / 58 / 64  
**Fax:** +91 22 28886859 / 65  
**Website:** [www.cmjoshi.com](http://www.cmjoshi.com)  
**Email:** [mail@cmjoshi.com](mailto:mail@cmjoshi.com)  
[patents@cmjoshi.com](mailto:patents@cmjoshi.com)  
[trademarks@cmjoshi.com](mailto:trademarks@cmjoshi.com)

## LUXEMBOURG



### Patent 42

Patent 42 is a leading law firm offering a full range of services in the field of Intellectual Property rights. Our team of high-qualified patent and trademark attorneys are entitled to represent client's interests in Europe, Luxembourg, France, and Belgium. Patent 42 provides concrete and careful solutions in the area of patents, trademarks, and designs. We support clients in all stages of elaboration and implementation of an intellectual property strategy adapted to your needs at both national and international level.  
**Whatever your question is, we will find an answer for you.**

**Address:** BP 297, L-4003 Esch-sur-Alzette, Luxembourg  
 (+352) 28 79 33 36  
**Tel:** (+352) 28 79 33 36  
**Website:** [www.patent42.com](http://www.patent42.com)  
**Email:** [info@patent42.com](mailto:info@patent42.com)

## MACAU



### IPSOL

IPSOL is a key service line focused on the planning, registration and management of trademark, patent and other IP rights portfolios, offering solutions that enable to maximize the protection of your IP assets in Macau and worldwide.

**Address:** Avenida da Praia Grande, 759, 5° andar, Macau  
 (853) 2837 2623  
**Tel:** (853) 2837 2613  
**Fax:** (853) 2837 2613  
**Website:** [www.ipsol.com.mo](http://www.ipsol.com.mo)  
**Email:** [ip@ipsol.com.mo](mailto:ip@ipsol.com.mo)  
**Contact:** Emalita Rocha

## MALAYSIA



### Adastra IP

Adastra IP is a full service IP firm with offices across the South East Asia, India and Australia with a full team of legal and technical specialists to handle drafting, responses and filings for Trademarks, Patents and Designs with emphasis on value and service for our clients. In addition, we have IP analytics and IP valuation capabilities aside from prosecution work to support our clients' IP needs.

**Tel:** +60322842281  
**Website:** [www.adastraip.com](http://www.adastraip.com)  
**Email:** [info@adastraip.com](mailto:info@adastraip.com)  
**Contact:** Mohan K. Managing Director





# Directory of Services

# Directory of Services

**MALAYSIA**



**MarQonsult IP**  
MarQonsult® was established in February 2002 and is located in Petaling Jaya, nearby the MYIPO. MarQonsult® was founded by Clara C F Yip, who holds a double degree in law and economics from Auckland University, NZ. MarQonsult® is synonymous with effective delivery of services marked by its: quick response time; in-depth client counselling; affordability and adaptability; commercially viable IP strategies; result-oriented approach; and a high rate of success.

Tel: +603 78820456  
Fax: +603 78820457  
Website: [www.marqonsult.com](http://www.marqonsult.com)  
Email: [clara@marqonsult.com](mailto:clara@marqonsult.com)  
Contact: Clara C F Yip (Ms)

**MEXICO**



**Goodrich Riquelme Asociados**  
Our staff of attorneys, engineers and computer specialists help adapt foreign patent specifications and claims to Mexican law, secure patent inventions and trademark registrations and maintain them by handling the necessary renewals. Our computer system, which is linked to the Mexican Patent and Trademark Department, permits us to provide our clients with a timely notice of their intellectual property matters. We also prepare and register license agreements.

Address: Paseo de la Reforma 265, M2, Col. Y Del. Cuauhtemoc, 06500 Mexico, D.F.  
Tel: (5255) 5533 0040  
Fax: (5255) 5207 3150  
Website: [www.goodrichriquelme.com](http://www.goodrichriquelme.com)  
Email: [mailcentral@goodrichriquelme.com](mailto:mailcentral@goodrichriquelme.com)  
Contact: Enrique Diaz  
Email: [ediaz@goodrichriquelme.com](mailto:ediaz@goodrichriquelme.com)

**MEXICO**



**TOVAR & CRUZ IP-LAWYERS, S.C.**  
We are a specialized legal firm providing intellectual property and business law services. Founded in 2009. The purpose is that our clients not only feel safe, besides satisfied since their business needs have been resolved, so, our professional success is also based on providing prompt response and high quality, personalized service. "Whatever you need in Mexico, we can legally find the most affordable way"

Tel: +52 5528621761 & +52 5534516553  
Address: Rio Mixcoac No. 25, Floor Mezzanine A, Crédito Constructor, 03940 Mexico City.  
Website: [www.tciplaw.mx](http://www.tciplaw.mx)  
Email: [ecruz@tciplaw.mx](mailto:ecruz@tciplaw.mx); [mtovar@tciplaw.mx](mailto:mtovar@tciplaw.mx); [contactus@tciplaw.mx](mailto:contactus@tciplaw.mx)  
Contact: Elsa Cruz, Martin Tovar

**POLAND**



**Sigeon IP, Grzelak & Partners**  
Sigeon IP, Grzelak & Partners are professionals specializing in the protection of intellectual property rights, as well as in broadly defined patent, trademark, design, legal, IP- related business, management and strategic consulting. Thanks to the close cooperation within one team of the Polish and European Patent & Trademark Attorneys, Attorneys-at-Law and business advisors, we offer the highest quality "one-stop-shop" service in Poland and Europe.

Tel: +48 22 40 50 401/301  
Fax: +48 22 40 50 221  
Website: [www.sigeon.pl/en](http://www.sigeon.pl/en)  
Email: [ip@sigeon.pl](mailto:ip@sigeon.pl)  
Contacts: [anna.grzelak@sigeon.pl](mailto:anna.grzelak@sigeon.pl) (patents, management & international cooperation)  
[tomasz.gawrylczyk@sigeon.pl](mailto:tomasz.gawrylczyk@sigeon.pl) (trademarks, designs & legal)

**QATAR**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services Ahmed Al-Misnad Building, Building No. 241, 2nd Floor, Office 9, Street No. 361, Zone No. 37, Mohammad Bin Thani Street, Bin Omran P.O.Box : 23896 Doha  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [qatar@unitedtm.com](mailto:qatar@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: Ahmed Tawfik & M.Y.I. Khan

**RUSSIA**



**KHUSAINOV KHOMYAKOV**  
intellectual property attorneys  
**KHUSAINOV KHOMYAKOV** is a full-service IP law firm with offices in Kazan (Russia) and Istanbul (Türkiye), providing services to clients in Russia and Eurasia. We specialize in a range of services, including filing and prosecuting trademark and patent applications, handling registration and protection of rights to designs, software, and copyrights, conducting patent and trademark searches, handling IP legal disputes, and supporting transactions with IP rights.

Tel: +7 843 215 00 55  
Web: <https://en.khp.legal/>  
Email: [info@khp.legal](mailto:info@khp.legal)  
Contact: Ramzan Khusainov, LL.M., Managing Partner  
Anton Khomyakov, Ph.D., Senior Partner

**MEXICO**



**Uthoff, Gómez Vega & Uthoff, S.C.**  
Uthoff, Gómez Vega & Uthoff, S.C. is the clear leader of the IP firms in Mexico. For over a century the firm has been providing legal services to clients both domestically and around the globe. The firm is one of the most prestigious and recognised law firms in the country, with an undeniable track record of success across a spectrum of services in an array of different industries. The combined expertise at the firm, not only in delivering the legal services clients expect, but in doing so with the insight and awareness of what drives clients' passion for innovation is what sets the firm apart.

Address: AV. Paseo de la Reforma 509 22nd floor Col. Cuauhtemoc, 06500 Mexico City 52 (55) 5533 5060  
Tel: <https://en.uthoff.com.mx/>  
Website: [mailbox@uthoff.com.mx](mailto:mailbox@uthoff.com.mx)  
Email: [javier.uthoff@uthoff.com.mx](mailto:javier.uthoff@uthoff.com.mx)  
Contact: Javier Uthoff, Senior Partner  
J.uthoff@uthoff.com.mx  
Eugenio Pérez, Partner  
[eugenio.perez@uthoff.com.mx](mailto:eugenio.perez@uthoff.com.mx)


**MOROCCO**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services 58, rue Ibn Battouta 1er étage, no 4. Casa Blanca, Morocco  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [morocco@unitedtm.com](mailto:morocco@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: Yawar Irfan Khan

**NIGERIA**



**ALN Nigeria | Aluko & Oyebo**  
The IP practice at ALN Nigeria | Aluko & Oyebo is recognised as a leader in handling patents, trademarks, copyrights, designs, and related IP litigation in Nigeria. The Firm's IP team has an extensive trial experience and provides an incomparable expertise in a variety of IP matters, including clearance searches, protection, portfolio management, use and enforcement of trademarks, copyright, patents, design and trade secrets, licensing, technology transfer (interface with the National Office for Technology Acquisition and Promotion), franchising, media law, packaging, advertising, labelling, manufacturing and distribution agreements, and product registration with the National Agency for Food and Drug Administration and Control (NAFDAC).

Website: [www.aluko-oyebode.com](http://www.aluko-oyebode.com)  
Email: [AQIP@aluko-oyebode.com](mailto:AQIP@aluko-oyebode.com)  
Contacts: Uche Nwokocho (Partner): [Uche.Nwokocho@aluko-oyebode.com](mailto:Uche.Nwokocho@aluko-oyebode.com)  
Tel: +234 703 400 1093  
Regina Onwumere (Senior Associate)

**RUSSIA**



**Vakhnina and Partners**  
The team at "Vakhnina & Partners" comprises of highly-qualified patent and trademark attorneys and lawyers. Major areas of expertise of our patent team: Chemistry, Pharmaceuticals, Biotechnology, Biochemistry, etc. We handle our clients' cases in Russia, Armenia, Kyrgyzstan, at Eurasian Patent Office, and cooperate with partners and associates in other Eurasian countries: Georgia, Belarus, Kazakhstan, Azerbaijan, Turkmenistan, Uzbekistan, Moldova, Tajikistan. Our attorneys are members of INTA, FICPI, AIPLI, LESI, ECTA, PTMG.

Address: Moscow, Russia  
Tel: +7-495-946-7075  
Website: <https://www.vakhnina.com>  
Email: [ip@vakhnina.com](mailto:ip@vakhnina.com)  
Contact: Dr. Tatiana VAKHNINA  
Dr. Alexey VAKHNIN

**SAUDI ARABIA**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services 30th Street, Olaya Opposite to Madarris Al Mustaqqil, P.O. Box 15185, Riyadh 11444, Kingdom of Saudi Arabia  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [saudia@unitedtm.com](mailto:saudia@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: Dr.Hasan Al Mulla & Justice R Farrukh Irfan Khan

**SRI LANKA**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: U.T.P.S Lanka (Pvt) Ltd 105, Hunupitiya Lake Road, Colombo - 2, Sri Lanka  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [srilanka@unitedtm.com](mailto:srilanka@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: Krishni & M.F. Khan

**OMAN**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services Suite No. 702, 7th Floor, Commercial Centre, Ruwi Muscat, Sultanate of Oman, P. O. Box 3441, Postal Code 112 Ruwi, Sultanate of Oman  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [oman@unitedtm.com](mailto:oman@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: S.Maqbool & T.F. Khan

**PAKISTAN**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
United Trademark and Patent Services is a leading firm of lawyers and consultants specialising in Trademarks, Patents, Designs, Copyrights, Domain Name Registration, Litigation & Enforcement services.

Address: 85 The Mall Road, Lahore 54000, Pakistan  
Tel: +92 42 36285588, +92 42 36285590, +92 42 36285581, +92 42 36285584  
Fax: +92 42 36285585, +92 42 36285586, +92 42 36285587  
Website: [www.utmps.com](http://www.utmps.com) & [www.unitedip.com](http://www.unitedip.com)  
Email: [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: Yawar Irfan Khan, Hasan Irfan Khan

**POLAND**



**LION & LION Kancelaria Patentowa Dariusz Mielcarski**  
We offer:  
- a full range of services related to patents, utility models, designs and trademarks in Poland as well as Community Designs and European Trademarks in the EU  
- cooperation with patent agencies in all PCT countries  
- preparation of patent applications from scratch for filing in the USA  
- validations of EU patents in Poland,  
- annuity payments

Tel: +48 663 802 804  
Website: [www.LIONandLION.eu](http://www.LIONandLION.eu)  
Email: [patent@lionandlion.eu](mailto:patent@lionandlion.eu)  
Contact: Dariusz Mielcarski, Patent and Trademark Attorney

**SWEDEN**



**Fenix Legal**  
Fenix Legal, a cost-efficient, fast and professional Patent and Law firm, specialized in intellectual property in Europe, Sweden and Scandinavia. Our consultants are well known, experienced lawyers, European patent, trademark and design attorneys, business consultants, authorized mediators and branding experts. We offer all services in the IP field including trademarks, patents, designs, dispute resolution, mediation, copyright, domain names, IP Due Diligence and business agreements.

Tel: +46 8 463 50 16  
Fax: +46 8 463 10 10  
Website: [www.fenixlegal.eu](http://www.fenixlegal.eu)  
Email: [info@fenixlegal.eu](mailto:info@fenixlegal.eu)  
Contacts: Ms Maria Zamkova  
Mr Petter Rindforth

**TAIWAN, ROC**



**Deep & Far Attorneys-at-law**  
Deep & Far attorneys-at-law deal with all phases of laws with a focus on IPRs, and represent some international giants, e.g. InterDigital, MPS, Schott Glas, Toyo Ink, Motorola, Cypress. The patent attorneys and patent engineers in Deep & Far normally are generally graduated from the top five universities in this country. More information regarding this firm could be found from the website above-identified.

Address: 13 Fl., 27 Sec. 3, Chung San N. Rd., Taipei 104, Taiwan  
Tel/Fax: 886-2-25856688/886-2-25989900  
Website: [www.deepfar.com.tw](http://www.deepfar.com.tw)  
Email: [email@deepfar.com.tw](mailto:email@deepfar.com.tw)  
Contact: C.F. Tsai, Yu-Li Tsai

**TAIWAN R.O.C.**



**Giant Group International Patent, Trademark & Law Office**  
Giant Group is specialized in domestic and international patent application, litigation and licensing, as well as trademark and copyright registration. Regardless of whether you are seeking legal protection for a piece of intellectual property, or being accused of infringing someone else's intellectual property, you can deal with this complex area of law successfully through Giant Group.

Tel: +886-2-8768-3696  
Fax: +886-2-8768-1698  
Website: [www.giant-group.com.tw/en](http://www.giant-group.com.tw/en)  
Email: [ggi@giant-group.com.tw](mailto:ggi@giant-group.com.tw)  
Contacts: Marilou Hsieh, General Manager, Tel: +886-911-961-128  
Amanda Kuo, Manager  
Tel: +886-2-87683696 #362  
Email: [amandakuo@giant-group.com.tw](mailto:amandakuo@giant-group.com.tw)



# Directory of Services

## TAIWAN, ROC



### LEWIS & DAVIS

LEWIS & DAVIS offers all services in the IPRs field, including prosecutions, management and litigation of Trademarks, Patent, Designs and Copyright, and payment of Annuity and Renewal fee. Our firm assists both domestic and international clients in Taiwan, China, Hong Kong, Macau and Japan. Our experienced attorneys, lawyers, and specialists provide professional services of highest quality while maintaining costs at efficient level with rational charge.

Tel: +886-2-2517-5955  
Fax: +886-2-2517-8517  
Website: [www.lewisdavis.com.tw](http://www.lewisdavis.com.tw)  
Email: [wtoip@lewisdavis.com.tw](mailto:wtoip@lewisdavis.com.tw)  
[lewis@lewisdavis.com.tw](mailto:lewis@lewisdavis.com.tw)  
Contact: Lewis C. Y. HO  
David M. C. HO

## TANZANIA



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services  
Shauri Mayo Area, Pugu Road,  
Dar-Es-Salaam, Tanzania  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [tanzania@unitedtm.com](mailto:tanzania@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: Mr Imad & Fatima Al Heyari

## TÜRKİYE



### Destek Patent

Destek Patent was established in 1983 and has been a pioneer in the field of Intellectual Property Rights, providing consultancy services in trademark, patent and design registrations for almost 40 years. Destek Patent provides its clients with excellence in IP consultancy through its 16 offices located in Türkiye, Switzerland, Kazakhstan, UAE and the UK. Besides its own offices, Destek Patent also provides IP services in 200 jurisdictions via its partners and associates.

Address: Spine Tower Saat Sokak No: 5 Kat:13  
Maslak-Sarıyer / İstanbul - 34485 Türkiye  
Tel: +90 212 329 00 00  
Website: [www.destekpatent.com](http://www.destekpatent.com)  
Email: [global@destekpatent.com](mailto:global@destekpatent.com)  
Contact: Simay Akbaş  
([simay.akbas@destekpatent.com](mailto:simay.akbas@destekpatent.com))

## U.A.E.



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services  
Suite 401-402, Al Hawaii Tower,  
Sheikh Zayed Road, P.O. Box 72430,  
Dubai, United Arab Emirates  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [uae@unitedtm.com](mailto:uae@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: M.F.I. Khan, SM. Ali & Maria Khan

## UKRAINE



### Pakharenko & Partners

Pakharenko & Partners provides full IP service coverage in Ukraine, CIS countries and Baltic states and has offices in Kyiv and London. We pride ourselves on an exclusive expertise and experience in the fields of IP law, anti-counterfeiting and anti-piracy, pharmaceutical law, competition law, advertising and media law, corporate law, litigation and dispute resolution.

Address: P.O.Box 78, 03150 Kyiv, Ukraine  
Visiting: Business Centre 'Olimpiysky',  
72 Chervonoarmiyska Str., Kyiv 03150,  
Ukraine  
Tel/Fax: +380(44) 593 96 93  
+380(44) 451 40 48  
Website: [www.pakharenko.com](http://www.pakharenko.com)  
Email: [pakharenko@pakharenko.com.ua](mailto:pakharenko@pakharenko.com.ua)  
Contact: Antonina Pakharenko-Anderson  
Alexander Pakharenko

## VIETNAM



### Annam IP & Law

ANNAM IP & LAW is one of the most professional Intellectual Property & Law Firms in Vietnam, member of APAA, INTA and VIPA. We provide our clients with a full range of IP services to protect their inventions, trademarks, industrial designs and related matters not only in Vietnam, but also in Laos, Cambodia, Myanmar and other jurisdictions. We also provide our clients with legal advices on Finance and Corporate and Business Law.

Tel: (84 24) 3718 6216  
Fax: (84 24) 3718 6217  
Website: <https://annamlaw.com/>  
Email: [mail@annamlaw.com.vn](mailto:mail@annamlaw.com.vn)  
[annamlaw@vnn.vn](mailto:annamlaw@vnn.vn)  
Contact: Le Quoc Chen (Managing Partner)  
Dzang Hieu Hanh (Head of Trademark  
Department)

## VIETNAM



### ELITE LAW FIRM

ELITE LAW FIRM is very pleased to assist our esteemed clients in Registration of their Intellectual property rights Safely, Effectively and Handle IP Rights disputes Quickly So that Clients can Do Business Strongly and Successfully Develop.

Tel: (+84) 243 7373051  
Hotline: (+84) 988 746527  
Website: <https://lawfirmelite.com/>  
Email: [info@lawfirmelite.com](mailto:info@lawfirmelite.com)  
Contact: Nguyen Tran Tuyen (Mr.)  
Patent & Trademark  
Attorney  
[tuyen@lawfirmelite.com](mailto:tuyen@lawfirmelite.com)  
Hoang Thanh Hong (Ms.)  
Manager of IP Division  
[honght@lawfirmelite.com](mailto:honght@lawfirmelite.com)



## VIETNAM



### Pham & Associates

Established in 1991, staffed by 110 professionals including 14 lawyers and 34 IP attorneys, Pham & Associates is a leading IP law firm in Vietnam. The firm has been being the biggest filers of patents, trademarks, industrial designs and GIs each year and renowned for appeals, oppositions, court actions, out-of-court agreements and handling IP infringements. The firm also advises clients in all aspects of copyright and other matters related to IP.

Tel: +84 24 3824 4852  
Fax: +84 24 3824 4853  
Website: [www.pham.com.vn](http://www.pham.com.vn)  
Email: [hanoi@pham.com.vn](mailto:hanoi@pham.com.vn)  
Contact: Pham Vu Khanh Toan, Managing  
Partner,  
General Director  
Tran Dzung Tien, Senior IP Consultant

## VIETNAM



### Tri Viet & Associates

Tri Viet & Associates is a registered and fully licensed IP & LAW FIRM based in Hanoi, Vietnam. The firm provides a full range of IP services, strongly focuses on PATENT and PCT services, in a wide range of industries and modern technologies, in Vietnam, Laos, Cambodia, Myanmar, and other jurisdictions upon client's inquiries. Tri Viet & Associates is a member of AIPPI, INTA, APAA, VBF, HBA, VIPA.

Tel: +84-24-37913084  
Fax: +84-24-37913085  
Website: [www.trivietlaw.com.vn](http://www.trivietlaw.com.vn)  
Email: [info@trivietlaw.com.vn](mailto:info@trivietlaw.com.vn)  
Contact: Nguyen Duc Long (Mr.), Managing Partner -  
Reg. Patent & Trademark Attorney  
LinkedIn: <https://www.linkedin.com/in/longnguyen-tva>



*A Foundation to Your Success!*







**IGE | IPI**  
**ip-search**



# Patent searches for experts.

Reliable. Precise. Meaningful.

