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The specific effects of introducing manifest inventiveness examination into utility patent examination in China



Dr. Yongqiang Qi, Partner & Patent Attorney at Corner Stone & Partners, outlines the amended patent examination guidelines, criteria for inventiveness identification, and examination procedures to highlight the impact on the examination of utility patents in China.



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Editor's welcome



Delving into a comprehensive analysis of the impact of manifest inventiveness examination on utility patent examination in China, our cover story this issue sheds light on the amended patent examination guidelines and criteria for inventiveness identification.

Our guest interview this issue is with Steph Dales, interim Strategy Director at the UKIPO, providing an overview of the UKIPO's 3-year strategy aimed at fostering an innovative and creative UK.

From here, we explore a wide range of topics, from the potential impact of a new EU parliament proposal on plant innovation in Europe

to the evolving intersection of artificial intelligence and patent law in the United States. We also explore case studies and practical insights, including a detailed examination of patent litigation in Poland, how the *Graham* factor applies to design patents in a post-LKQ world, and why provisional applications should be considered.

Further, we look at developments in sports technologies from wearable tech to innovative fabrics to analyse the importance of IP in this industry; review the removal of attorneys' fees by the federal circuit; assess

the ban on most employee non-compete agreements; present the "three-step method" for evaluating inventive step in patent applications; and provide an overview of the process and requirements for patenting an industrial design in Russia.

Our *Women in IP Leadership* segment features Stephanie Curcio, CEO and Co-Founder of NLPatent. Special thanks to the segment's sponsor, Clarivate.

Plus, find our Award Winning Law Firm Rankings for South America inside.

Enjoy the issue.

Faye Waterford, Editor

Mission statement

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



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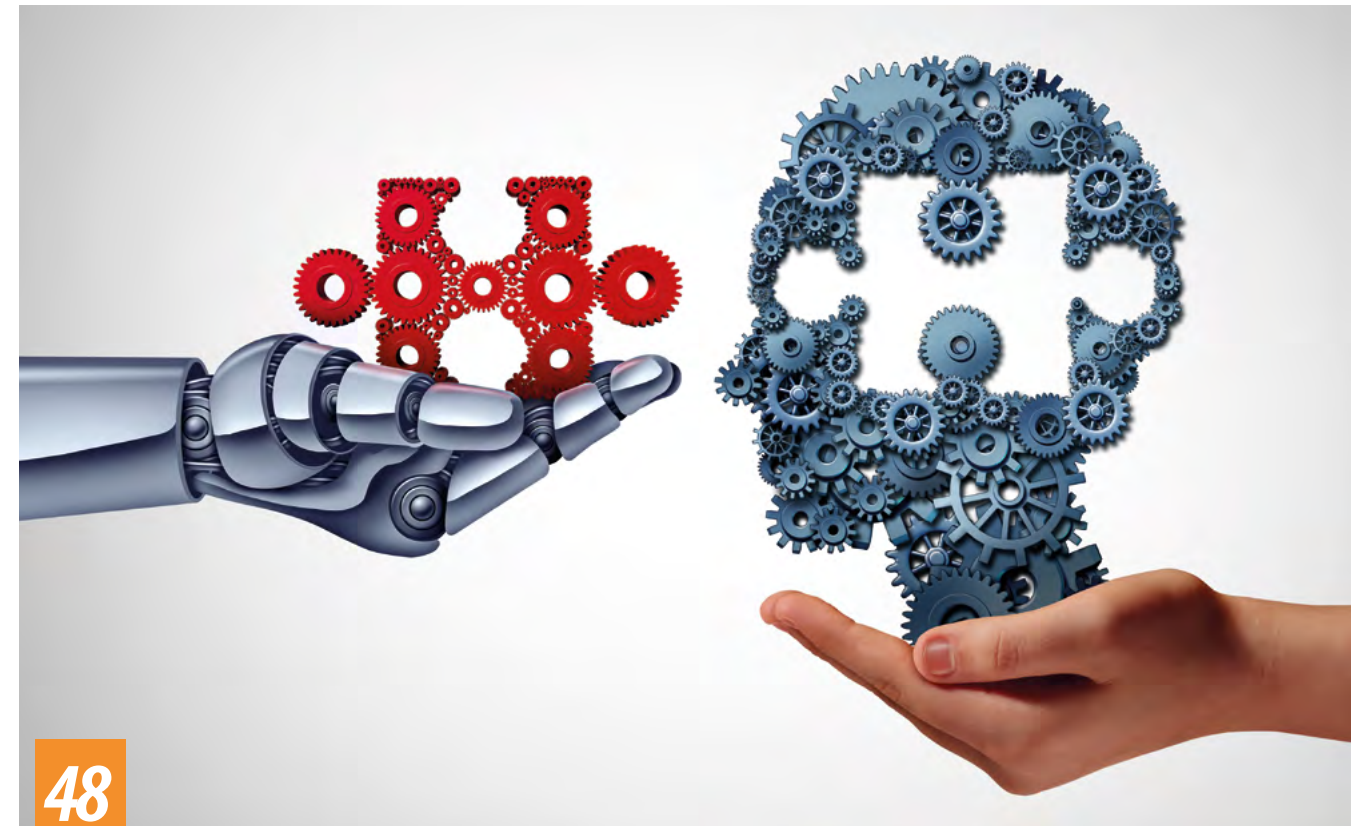
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In a career spanning over four decades, Pravin has emerged as an IP trailblazer having strengthened India's IP jurisprudence with a practice encompassing all areas of IP litigation including patents, copyright, design, trademarks, enforcement and dispute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



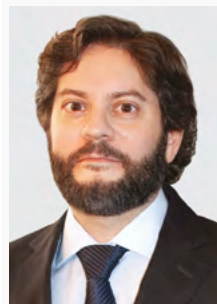
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Formerly a practicing patent litigator, she specializes in European patent matters. She advises and supports her team and clients on all aspects of patent law and litigation strategy across all sectors, with a particular focus on Life Sciences and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



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

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

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CORNER STONE & PARTNERS, Winner of Trademark Lawyer Top 10 Trademark Firms in China 2024, is a boutique law firm established in 2010 specializing in intellectual property matters. Our team of experienced professionals are dedicated to delivering quality services and solutions to address our clients' IP needs in China.

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The specific effects of introducing manifest inventiveness examination into utility patent examination in China

Dr. Yongqiang Qi, Partner & Patent Attorney at Corner Stone & Partners, outlines the amended patent examination guidelines, criteria for inventiveness identification, and examination procedures to highlight the impact on the examination of utility patents in China.

On December 21, 2023, China National Intellectual Property Administration (CNIPA) issued the newly revised Patent Examination Guide (2023) and published No. 78 CNIPA Directive to specify that the new Patent Examination Guide would take effect on January 20, 2024. The newly revised Patent Examination Guide has undergone adaptive amendments to adapt to the latest economic and social development changes and to support the introduction of manifest inventivity examination for utility models in particular. The revised Patent Examination Guide

specifies the criteria for manifest inventivity to be examined for utility models to intensify the requirement for utility patent inventivity, optimizes the examination procedure to improve the efficiency and accuracy of examinations, and adapts to the development of new businesses to make adaptive amendments to patent examination policies for big data, AI, genetic technology, etc.

As for the examinations of utility patents, the new Patent Examination Guide sets out the criteria for inventivity identification in detail, stating that a utility patent should have prominent substantive





Résumé

Dr. Yongqiang Qi, Partner & Patent Attorney

Focused on patent matters, including drafting applications, replying to OAs, invalidations, prosecution, etc., Yongqiang engaged in research at the Chinese Academy of Sciences for seven years before going to Japan to study and work for eight years. He has practiced as a patent attorney for 15 years and has handled a large number of cases for domestic and foreign companies. He studied the European patent system in the UK in 2012 and studied the Japanese patent system in Japan in 2016. He joined CORNER STONE in 2018 and is responsible for the Japanese Department. His rich experience and outstanding skills in looking after clients from Japan and other parts of the world have made him one of the core members of our patent team.



Dr. Yongqiang Qi

features and obvious technological progress. This amendment is to ensure that the utility patents granted have higher technology and innovativeness. The new Patent Examination Guide introduces manifest inventivity examination into utility patent examination, requiring that a utility patent should have inventivity and the inventivity must be manifest. This means the examination board will apply stricter criteria when evaluating the inventivity of utility models. The amended Patent Examination Guide standardizes the examination procedure for utility models, defining the steps and processes that examiners should follow during the examination. This helps to ensure impartiality, openness, and transparency of the examination procedure and improve the quality and efficiency of examinations. In terms of the restoration of the right of priority, the amended Patent Examination Guide specifies the timing of restoration, the documents to be submitted, and the fees to be paid. This amendment helps to protect the legitimate rights and interests of applicants and foster technological innovations and transformation of achievements.

At present, however, the countries retaining utility patents, such as Germany, Japan, and South Korea, implement a system of registration whereby a utility patent is registered and published after the formal examination of application documents is conducted.

According to the new Patent Examination Guide, examiners follow the following procedure when examining utility patents:

“ Examiners will carefully examine the applicant’s response and modifications to ensure that the utility model modified meets the requirements of China’s Patent Law. ”



In the preliminary phase of examination, examiners will perform the formal examination of application documents to ensure the documents are complete, the format is correct, and the fees are paid. The examination board will see whether the utility patent to be granted has any obvious substantive defects against the regulations of the new Patent Examination Guide, for instance, whether it is a utility model for which a patent cannot be granted under China’s Patent Law.

In the phase of manifest inventivity examination, firstly, examiners will carefully analyze the technical features of the utility model and determine the closest prior art; secondly, examiners will identify the distinguishing features between the utility model and the closest prior art, and determine the technical problems these distinguishing features can actually solve; thirdly, the examination board will, according to the criteria of inventivity set out in the Patent Examination Guide, assess whether the utility model has prominent substantive features and obvious progress, compared to the closest prior art, that’s whether it is unobvious.

In the phase of giving the notification of examination opinions, if examiners hold that the utility model has defects or does not meet the requirements for manifest inventivity, they will send the notification of examination opinions to the applicant, pointing out the problem and asking the applicant to give a response or make modifications within the prescribed time limit.

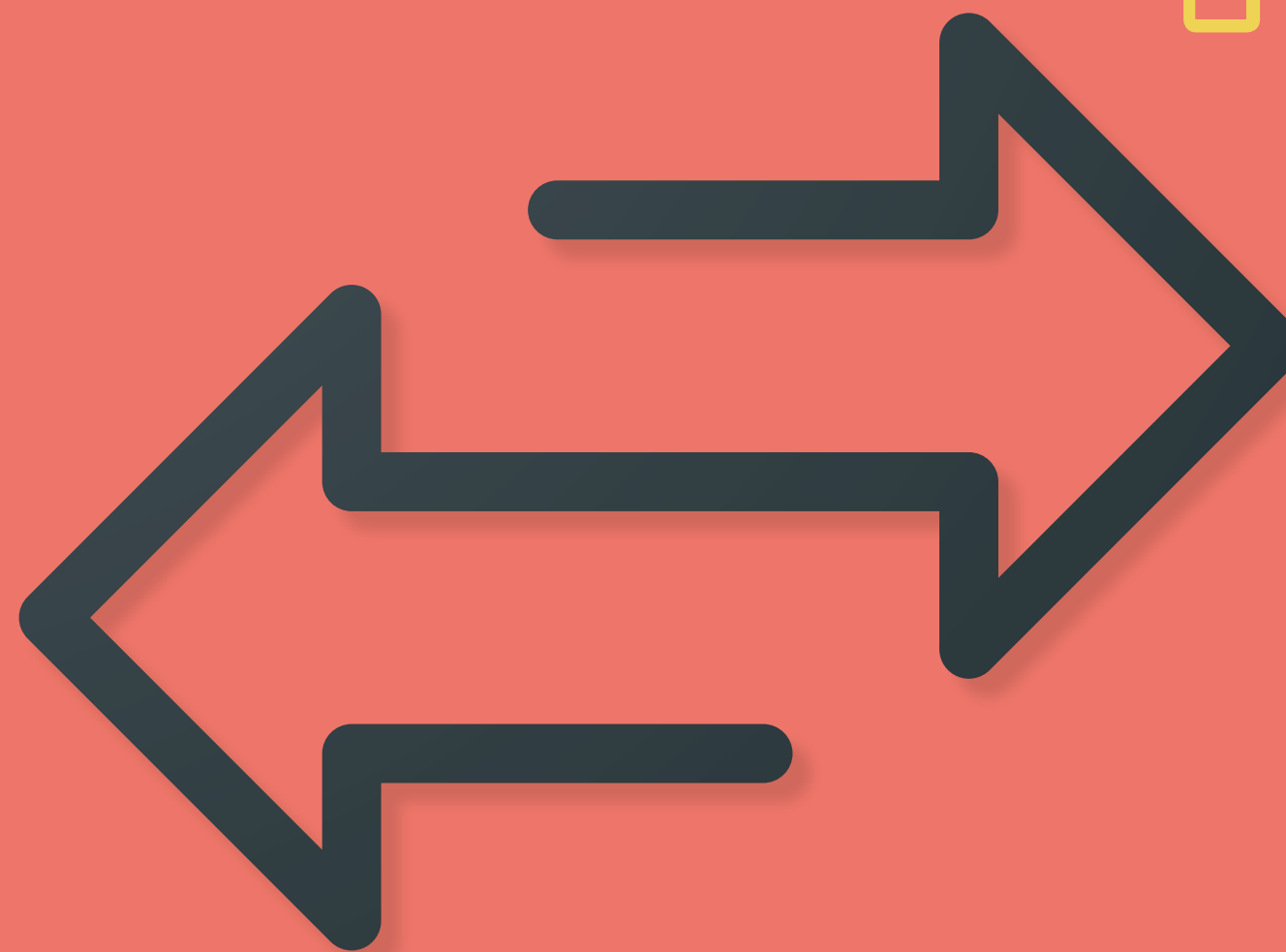
In the phase of examining the applicant’s response and modifications, examiners will carefully examine the applicant’s response and modifications to ensure that the utility model modified meets the requirements of China’s Patent Law.

In the decision-making phase, examiners will decide whether or not to grant the patent for the utility model after comprehensively considering the applicant’s response and modifications.

At present, the specific effects of the introduction of manifest inventivity into utility patent examination in China are as follows:

The examination criteria has significantly improved, and the examination of utility patents is no longer limited to novelty and practical use anymore, but extends to a comprehensive examination including inventivity. This means that the threshold for the granting of utility patents has been raised, and technical contribution and innovation of utility patents are further underlined.

The number of applications and the grant rate for utility patents have changed greatly due to the improvement of examination criteria. According to the data available, in 2023, the number of granted utility patents decreased by 25.47% compared to last year, while the number of granted invention patents increased by 15.36%.



It is predicted that the number of granted patents for utility models and designs will also decrease significantly in 2024. This indicates that the grant of utility patents has become stricter and more prudent with the introduction of manifest inventivity examination.

The response to examination opinions has obviously increased. The improvement of examination criteria entails more examination opinions given to applicants and more responses from them. This will lead the applicants to treat utility patent applications more seriously and will help to improve the quality of applications; meanwhile, the workload of the patent examination board in the examination of utility patents has increased.

The quality of utility patents has significantly improved. The decrease in the number of applications and the grant rate for utility patents implies the enhancement of the quality of utility patents that passed the examinations. These utility patents granted feature more technologies and innovations, which will facilitate technological advances and industrial upgrades.

The market environment for patent applications has been optimized. By intensifying the examination of utility patents, abnormal patent applications can be effectively curbed, and low-quality and repetitive utility patent applications can be reduced, thus optimizing the market environment and improving the overall quality and value of patents.

“ The number of applications and the grant rate for utility patents has changed greatly due to the improvement of examination criteria. ”



Technological innovations have been further fostered. The introduction of manifest inventivity into utility patent examination will lead applicants to invest more heavily in technological innovations and R&D and thus promote technological advances and the transformation of innovation achievements. This will help to enhance China’s technological strength and core competitiveness.

To sum up, after the introduction of manifest inventivity into utility patent examination, despite the decrease in the number of patent grants, patent quality has significantly improved, market environment has been optimized, and examination procedure has become more standardized, unified, and transparent. These effects are conducive to stimulating technological innovations and R&D investment, facilitating technological advances and transformation of innovation achievements, and enhancing the level and reputation of China’s patent industry.

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Will a new EU parliament proposal stunt plant innovation in Europe?

Ellie Purnell and Punita Shah of HGF Ltd evaluate the proposal for a new regulation that would relax the rules for market approval of low-risk NGT plants, but potentially threaten innovation with its broad exclusions on patentability.

Marketing genetically modified (GMO) plants in the EU requires a complex regulatory process, meaning that few GMO plants gain approval. Under existing legislation, all GMO plants – whether transgenic or created by a New Genomic Technique (gene-edited without the introduction of foreign genetic material) – must undergo the same approval process. The EU parliament has recognized the significant benefits that NGT plants offer towards developing sustainable agriculture, becoming food secure without reliance on imports, and satisfying the farm-to-fork and the Green Deal aims. They have therefore proposed a new Regulation to relax the regulatory rules for lower-risk NGT plants. This should align Europe with the way such plants are treated for regulatory approval by the US and Japan.

The proposed Regulation intends to create two categories of NGT plants:

- NGT1 plants, which comprise fewer than 20 genetic modifications and could occur naturally or by conventional breeding, and which have a sustainability-related trait (with the exception of herbicide-resistant traits). Such plants would be exempt from the GMO regulatory legislation.
- NGT2 plants, which have greater than 20 genetic modifications and would be subject to the current GMO regulatory legislation.

To "avoid legal uncertainties, increased costs, and new dependencies for farmers and breeders," the EU Parliament has proposed an amendment



Ellie Purnell



Punita Shah

to the Regulation which, via amendment of the EU Biotech Directive, excludes from patentability "NGT plants, parts thereof, genetic information, and the process features they contain." This exclusion notably does not distinguish between NGT1 and NGT2 plants. The draft amendments further propose limiting the scope of protection of a patent insofar as it relates to NGT plants.

In April 2024, the EU Parliament voted to adopt the proposed Regulation, opening discussions on the exact wording.

Whilst the proposed relaxation of the regulatory rules for NGT1 plants may be beneficial for plant breeders, what will be the effect of the proposed ban on patents for NGT plants and innovation in Europe, and how should innovators alter their IP strategy?

What is the scope of the proposal?

In more detail, the proposal aims firstly to exclude from patentability:

1. All NGT plants (plants obtained by targeted mutagenesis and cisgenesis (including intragenesis);
2. Plant parts and plant material thereof, genetic information (genes and gene sequences) and the "process features such plants contain";
3. Plants, plant material, parts thereof, genetic information, and process features they contain that can be yielded by mutagenesis and cell fusion.

The scope of terms such as 'NGT plant' and 'cover' have different definitions and uses in the

proposal, which are somewhat confusing as to their scope. What is clear is that the exclusion is very broad, extending not only to plants *per se* and their parts, such as seeds and harvested material, but also to genes and genetic information *per se*, outside of the plant and to "process features contained in a plant." This latter term is also undefined and could be interpreted broadly to include the genetic tools *per se*, such as CRISPR/Cas proteins. This is unlikely to be the intention of the legislators, but shows that the amendments are hasty and could lead to significant confusion as to their scope.

The proposed legislation goes further than exclusions on patentability, including a proposed amendment to Articles 8 and 9 of the EU Biotech Directive to limit the scope of existing patents and pending applications which include claims directed to plants, processes, and plant-derived material, such that they do not "extend to biological material possessing the same characteristics that are obtained independently of the patented biological material and from essentially biological processes," or to "biological material obtained from such material through propagation or multiplication."

The intention of the Regulation is to provide greater freedom to plant breeders and farmers, but the broad language means that it may include any "biological material," such as animal material, microorganisms, and viruses, and limit the scope of protection to exclude such material that was created independently of the patented material by an essentially biological process, i.e., sexual crossing.

More specifically, the proposed amendment to the EU Biotech Directive states that the scope



Résumés

Ellie Purnell, Partner and European Patent Attorney

Ellie is a UK and European qualified patent attorney with a strong academic background in Life Sciences, particularly in Plant Sciences. In addition, Ellie holds a qualification as a Patent Attorney Litigator with advocacy experience working on oppositions and appeals before the European Patent Office. She specializes in dealing with technology in the Agritech, Gene Editing, Antibody, and Peptide fields. Ellie is interested in helping SMEs, start-ups, and spin-outs to maximize their potential by exploiting IP protection and good IP management. She enjoys working with challenging IP portfolios and developing IP strategies, particularly for those cases experiencing difficulty in European prosecution.

Ellie has worked with all types of clients, from multinational companies, including AstraZeneca, Novartis, and Syngenta, to SMEs, and spin-outs such as Solasta Bio, Pepgen, BioMara, Antibody Analytics, and Healome Therapeutics.

Punita Shah, Partner and European Patent Attorney

Punita's expertise lies predominantly in the area of biotechnology, with a specific focus on the technical fields of plant biology, diagnostics, personalized medicine, biologics, and gene therapy. Her experience also includes leading multi-disciplinary teams handling innovations which span the life sciences and electronics sectors. Punita has worked extensively with multinational corporations, universities, and small to medium-sized enterprises.

She has a practical and commercially focused approach and is highly experienced in obtaining commercially valuable patent protection for her clients. Her practice includes routinely managing large global patent portfolios, as well as conducting due diligence to support corporate acquisition and investment, conducting freedom-to-operate analysis, and advising her clients on third-party rights and infringement. Punita has defended her clients' patent rights and commercial position in leading opposition and appeal proceedings before the EPO.



of protection of a claim to a product containing genetic material or process for making the product will not extend to plant material containing the product if the plant material is not distinguishable from plant material which is obtained or can be obtained by an essentially biological process. Therefore, plant material that may be non-distinguishable from naturally occurring plant material (i.e., NGT1 plant material) is excluded from the scope of protection of products comprising genetic material, and processes for making the products. Notably, the language is not limited to the exclusion of plant material which is *exclusively* the result of an essentially biological process, and appears to exclude from the scope of protection plant material that can be generated by both the patented process and an essentially biological process.

What is the difference with the current situation in Europe?

It is worth remembering that there are already restrictions in place under the EPC that limit the patenting of essentially biological processes for the production of plants and plant varieties in Europe (Article 53b EPC).

These exceptions to patentability have been shaped by years of case law and several decisions of the Enlarged Board of Appeal, and can be summarised as follows:

- Plants can be claimed generically, but it is not allowable to claim a specific plant variety (Enlarged Board of Appeal Decision G1/98);
- Processes for the production of a plant that contain a step of sexual crossing of a plant are not allowable, on the

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The draft amendments further propose limiting the scope of protection of a patent insofar as it relates to NGT plants.
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basis that they relate (even in part) to an essentially biological process (Enlarged Board of Appeal Decisions G2/07 and G1/08);

- Plants that result from an essentially biological process are not patentable (Enlarged Board of Appeal Decision G3/19).

Currently, UK patent law is harmonized with that of the EPO.

The proposed legislation would further narrow what is available as patentable down to non-NGT plants, i.e., where the plant is modified to comprise foreign (non-cis) genetic material, plant material, and related methods.

What is next for the legislation?

Innovators in the sector and intellectual property professionals have raised their concerns that while the proposals may smooth the way for NGT1 plants to enter the market in the EU, the proposed ban on patents for NGT plants and plant material could deter innovators from operating commercially in this region.

The proposal has been met with pushback by member states at the European Parliament. Thus far, there are still some major territories that stand against the idea. Notably, Germany has abstained from the vote, possibly to avoid having to choose between a position that may be perceived as favoring either breeders or corporate multinationals. This leaves Poland as the key territory carrying the next largest majority of the EU population, which thus far stands against the proposals. In an effort to change Poland's vote, the Belgian presidency of the EU council proposed a compromise whereby the exclusions to patentability

should only apply to NGT1 plants, or that patentees should waive their rights in respect of NGT1 plants because these plants would benefit from the reduced regulatory process. This attempt was not successful, but the Belgian presidency is committed to reaching a solution. That said, it is unlikely that we will see any progress on this matter over the coming months, especially since the presidency is due to change hands to Hungary and Poland in the remainder of 2024.

The Regulation requires a consultation to be carried out to understand the impact of patents on access to plant reproductive material by plant breeders and farmers, and the impact of patents on innovation and opportunities for SMEs. There appears to be a recognition by many member states that an exclusion of patentability and limitations on patent enforcement in the plant sector could reduce investment in, and access to, innovation in Europe, and, consequently, a decrease in agricultural productivity and an increase in the reliance on pesticides and herbicides, which would be contrary to the EU's green deal and Farm to Fork objectives. Restricting enforcement of patents may be unconstitutional in some countries, and open to national challenge. Further problems are envisaged in situations where the patent rights are held by a third party, not the party seeking regulatory approval.

In order to implement the proposed legislation, amendment of the EU Biotech Directive will be necessary. Many will be reluctant to re-open this legislation, given the length of time to bring it into force. Amendment to the EU Biotech Directive may then cause issues at the EPO, because Article 53 detailing exclusion to patentability would not match the directive. Even though the EPO is not an EU body and, therefore, not legally obliged to harmonize its laws with that of the EU, the European Patent Convention typically reflects EU directives. It is unlikely that the EPO could achieve harmonization with an amended EU Directive without amending the EPC and, therefore agreement of all 38 contracting states. To implement any exclusion to patentability via the EPC may, therefore, take many years.

Can plant variety rights fill the gap?

The EU Parliament has justified its position by suggesting that protection of NGT plants should be solely via Community or National Plant Variety Rights. A plant variety right protects a distinctive, uniform and stable phenotype of a plant, but does not protect the underlying technology or the method by which it was produced.

A plant variety right provides protection for the variety, as well as for progeny, seeds, and harvested material of that variety. The scope of protection extends to "Essentially Derived Varieties" (EDV), which are defined as being predominantly

“
Are NGT plants being squeezed from protection by the combined approaches of the EU Commission and UPOV?
 ”

derived from the protected variety, distinguishable from the initial variety, but otherwise conforms to it in relation to essential characteristics that result from the genotype of the initial variety. Protection does not extend to plants or materials which are the result of breeding the EDV. However, an Explanatory note issued by UPOV in October 2023 has been interpreted as suggesting that NGT plants fall under the category of EDV, meaning that they would still be afforded a narrower scope than the protection conferred to an initial variety.

There is an argument that NGT plants are being unintentionally squeezed from protection by the combined approaches of the EU Commission and UPOV, given this EDV interpretation.

But what about the UK?

UK food imports represent a significant share of the world's and Europe's import value (10% and 15% respectively).

Since Brexit, the UK is no longer bound by EU laws. Post-Brexit, England has passed the Genetic Technology (Precision Breeding) Act (2023), which simplifies the regulatory requirements for gene-edited (NGT) organisms. This legislation does not include any corresponding ban on patents for NGT plants, as has been proposed by the EU. It would seem unlikely that the UK would consider following any proposed EU restriction on the patentability of plants. However, no implementing regulations have yet been issued to say how this act will be interpreted nor how it will function.

Further, under UK law it may be an infringement to use a patented plant for breeding, or discovering and developing other varieties. In many EU member states such acts are exempt from infringement by way of a "Farmer's exemption."

Therefore, the UK may be an attractive jurisdiction for plant innovators. It is worth noting however that the Genetic Technology Act does not define such Precision Breeding Organisms (PBOs) in the same way as the EU parliament proposal, which refers to NGTs with a much more specific definition. This could lead to complexity and confusion with different levels of regulation.

How can we protect innovation in this narrowing landscape?

Given the impending proposal from the EU parliament, which could significantly modify the patentability of plant innovations in Europe, coupled with the Precision Breeding Act in England, it is clear that protecting innovation in this area will require a strategic approach comprising patent protection directed to transgenic plants and parts thereof, plant variety rights, and trade secrets, as well as national protection in countries such as the UK and Switzerland, in order to navigate the complexities created by the existing and proposed limitations on protection for plants.

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How *Graham* factor one applies to design patents in a post-LKQ world

R. Parrish Freeman and Matthew Petersen of Maschoff Brennan discuss the impact of the *LKQ Corp. v. GM Global Tech.* case on design patent obviousness, highlighting the shift from the *Rosen-Durling* test to the more flexible *Graham* factors.

L*KQ Corp. v. GM Global Tech.* shook up the world of design patents, as the Federal Circuit, sitting en banc, overruled the longstanding *Rosen-Durling* test for determining design patent obviousness. 102 F.4th 1280, 1293 (Fed. Cir. 2024). In the wake of such seismic precedential activity, the *LKQ* court left only the *Graham* factors, broad guidance on how they apply to design patents, and a flood of questions from patent practitioners. *See id.* at 1295-1300. This article, while briefly walking through the background of *Rosen-Durling*, focuses on one of those questions: how does *Graham* factor one apply to design patents?

Over-ruling *Rosen-Durling*

Before *LKQ*, to establish obviousness of a design patent claim under § 103, a party had to provide prior art in the form of a primary reference and a secondary reference, and those references had to satisfy the two-part *Rosen-Durling* test. *Id.*; *see also MRC Innovations, Inc. v. Hunter Mfg., LLP.*, 747 F.3d 1326, 1331-1332, 1334 (Fed. Cir. 2014) (applying the *Rosen-Durling* test). The primary reference, referred to as the "*Rosen* reference," comprises step one of the *Rosen-Durling* test. *LKQ*, 102 F.4th at 1289. That is, the primary reference had to be "basically the same" as the challenged design claim – leaving little wiggle room for prior art references that differed, even if only slightly. *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982). If this first step of the test was not satisfied, the obviousness analysis proceeded no further. *LKQ*, 102 F.4th at 1289. The second step of *Rosen-Durling* focused on a secondary reference (or references). There, one or more secondary references might serve as a source for ornamental features missing from the primary reference, but only if each



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Matthew Petersen

secondary reference was "so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other." *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996). This "so related" requirement further limited the availability of viable prior art references. *Id.*

Given the "rigidity" of the *Rosen-Durling* test, the court was quick to replace it with a more "flexible" approach. *See LKQ*, 102 F.4th at 1293. In doing so, the court based its reasoning in the statutory language of § 103, and the Supreme Court precedents of *Graham*, *KSR*, and *Whitman Saddle* (a nineteenth-century horse saddle case that invalidated a design patent under § 103 by flexibly combining two prior art references). *See id.*; *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007); *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 680-682 (1893). To summarize this transition to flexibility in design patent obviousness, the *LKQ* court quoted *KSR*: an "obviousness analysis cannot be confined by a formalistic conception." *KSR*, 550 U.S. at 419. Unsurprisingly, then, the *LKQ* court *did not* fall victim to a "formalistic conception" in replacing the previous *Rosen-Durling* regime for determining design patent obviousness. *Id.*

Out with *Rosen-Durling*, in with *Graham*

The Federal Circuit explained that, despite the differences between design and utility patents, "design patents, like utility patents, must meet the nonobviousness requirement of 35 U.S.C. § 103." *LKQ* 102 F.4th at 1293 (citing *Titan Tire Corp. v. Case New Holland, Inc.*, 566 F.3d 1372, 1380,

1384-85 (Fed. Cir. 2009)). As such, the court reaffirmed its precedent that "[i]nvalidity based on obviousness of a patented design is determined [based] on factual criteria similar to those that have been developed as analytical tools for reviewing the validity of a utility patent under § 103, that is, on application of the *Graham* factors." *LKQ*, 102 F.4th at 1295 (quoting *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1462 (Fed. Cir. 1997)). And just like that, goodbye *Rosen-Durling*, hello *Graham*. But how, exactly, do the *Graham* factors apply to design patents? The court walked through each factor, describing such application with varying levels of specificity. *LKQ*, 102 F.4th at 1295-1301. This article, however, is primarily concerned with the first *Graham* factor – the "scope and content of prior art." *Graham*, 383 U.S. at 17.

Graham factor one and the primary reference

While the en banc *LKQ* court abandoned the need for a *Rosen* reference, it made clear that, when applying *Graham* factor one to determine the "scope and content of the prior art," a "primary reference must be identified." *LKQ*, 102 F.4th at 1298. Maintaining this primary reference requirement is necessary to prevent hindsight bias, as the court noted, because "almost every new design is made up of elements which, individually, are old somewhere in the prior art." *Id.* (quoting *In re Glavas*, 230 F.2d 447, 450 (C.C.P.A. 1956)). Unlike the *Rosen* reference, though, a primary reference "need not be 'basically the same' as the claimed design." *LKQ*, 102 F.4th at 1298. Instead, as stated in *In re Jennings* and quoted by the court, the primary reference must be "something in existence – not ... something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature." 182 F.2d 207, 208 (C.C.P.A. 1950); *see also LKQ*, 102 F.4th at 1298. In other words, a primary reference must be considered, and exist, "as a whole." *Jennings*, 182 F.2d at 208, and cannot merely be a conglomeration of various designs to meet the features of the claimed design, *LKQ*, 102 F.4th at 1298.

Résumés

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“This “so related” requirement further limited the availability of viable prior art references.”



To determine a proper primary reference, *Jennings* does little more than establish that the reference must exist, so the *LKQ* court provided a bit more guidance. *See id.* Specifically, the court states:

“[t]he primary reference will likely be the closest prior art, i.e., the prior art design that is most visually similar to the claimed design. The more visually similar the primary reference design is to the claimed design, the better positioned the patent challenger will be to prove its § 103 case.”

LKQ, 102 F.4th at 1298. Thus, instead of needing to clear the “basically the same” bar, a primary reference can exist on a spectrum of “visual similarity.” *Id.* And the court keeps it simple: the more a primary reference looks like a claimed design, the more likely the claim will not survive the obviousness analysis. *LKQ*, 102 F.4th at 1298.



Importantly, the court provides one last piece of advice regarding the primary reference requirement: "The primary reference will typically be in the same field of endeavor as the claimed ornamental design's article of manufacture, but it need not be, so long as it is *analogous art*." *Id.* (emphasis added). Put differently, the primary reference may or may not be in the same field of endeavor as the claimed design (though it usually will), but it *must* be analogous art. *Id.* This holding begs the inevitable question: what constitutes analogous art for design patents?

Institution of the design patent analogous art requirement

At the outset of its discussion of *Graham* factor one, the *LKQ* court held that "an analogous prior art requirement applies for obviousness of design patents" – not just utility patents. *LKQ*, 102 F.4th at 1296. The court then outlined this requirement, quoting Federal Circuit precedent: "a reference qualifies as prior art for an obviousness determination only when it is analogous to the claimed invention." *Id.* (quoting *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1379 (Fed. Cir. 2019)). It also laid out the rationale behind such a requirement: to fall in line with the language of § 103 (tying the scope of prior art to the knowledge and understanding of the hypothetical person of ordinary skill in the art), and to "defend against hindsight." *LKQ*, 102 F.4th at 1296 (citing *Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358 (Fed. Cir. 2023)).

Finally – to further solidify the correctness of its analogousness holding – the *LKQ* court walked through *In re Glavas*, a case that paved the way for the *Rosen-Durling* test. See *LKQ*, 102 F.4th at 1296–1297. There, the then-C.C.P.A. instituted an analogous art requirement for design patents but held that it could not be applied in the same way it applied to utility patents. *Glavas*, 230 F.2d at 450.

As such, the court made the following rule: "The question in design cases is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are *so related* that the appearance of certain ornamental features in one would suggest the application of those features to the other." (emphasis added). *Id.* With that, the "so-related" prong of *Rosen-Durling* was born, only to become more rigid with time.

In overruling the *Rosen-Durling* test, the en banc *LKQ* court effectively overruled the *Glavas* analogous art rule. However, the court found "no basis for abandoning the underlying analogous art requirement for assessing nonobviousness of design patents" that was established in *Glavas*. *LKQ*, 102 F.4th at 1296. Instead, the court wrote of a "return to a more flexible fact-based analysis of whether the references are analogous art in



Unlike the *Rosen* reference, though, a primary reference "need not be 'basically the same' as the claimed design."



a manner similar to utility patents"; an approach that "casts aside a threshold 'so-related' requirement but maintains the threshold analogous art requirement." *Id.*

Application of the design patent analogous art requirement

Currently, it seems that the court succeeded in creating a flexible approach to the threshold analogous art requirement. Whereas utility patents depend on a two part test to determine the scope of analogous art – (1) whether the art is from the same field of endeavor as the claimed invention; and (2) if not within the same field of endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved – the test is now much more open-ended for design patents. See *id.*

That is, speaking to the first part of the analogous art test, "prior art designs for the same field of endeavor as the article of manufacture will be analogous," but the court does "not foreclose that other art could also be analogous." *Id.* at 1297. Thus, the court wrote, "[w]hether a prior art design is analogous to the claimed design for an article of manufacture is a fact question to be addressed on a case-by-case basis." *Id.* at 1297–1298. Put differently, the first prong of the analogous art test applies to design patents, but that a reference fails to directly satisfy that prong does not preclude it from being considered analogous prior art. See *id.*

Regarding the second part of the analogous art test, because it deals with the solving of a problem – not the appearance of a design – the court noted that "the second part of the two-part analogous art test for utility patents would not seem to apply to design patents in the same way, and how to translate this part of the test into the design context is less apparent." *Id.* at 1297. The court further discussed the difficulties of applying the second part of the test to design patents, but conspicuously avoided an outright rule stating that it would *never* apply to design patents. See *id.*

Importantly, to cover its bases on analogous prior art as a whole, the court wrote the following: "In this opinion, we do not delineate the full and precise contours of the analogous art test for design patents," adding, "[we] leave it to future cases to further develop the application of this standard." *Id.* at 1297–1298. The bottom line: an analogous art requirement has been instituted for design patents – not dissimilar to that of the requirement for utility patents – and a prior art reference is analogous if it is from the same field of endeavor as the claimed design, though it doesn't have to be. See *id.* Rigidity be gone; the analogous art requirement for design patents apparently knows no bounds (yet).

A summary of *LKQ*'s application of *Graham* factor one and a bit of advice

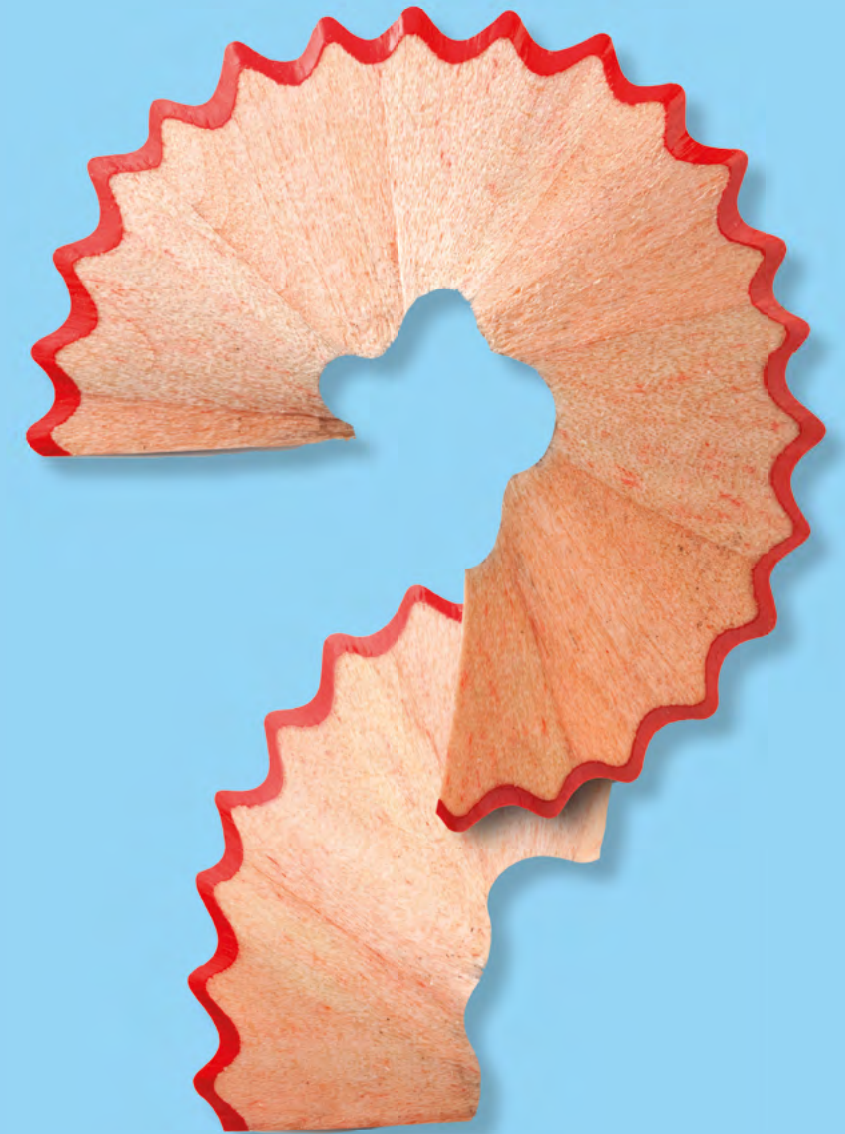
Following *LKQ*, the *Graham* factors now apply to obviousness analyses for design patents. *Id.* at 1295. To satisfy the first *Graham* factor, a patent challenger must provide a primary reference. *Id.* at 1298. The primary reference must be considered, and exist, as a whole. *Id.* And, at the very least, the primary reference must be analogous art. *Id.* at 1297. Secondary references, if needed, must also be analogous art (and do not need to be "so related" to the primary reference). *Id.* at 1299. A prior art reference is analogous if it is from the same field of endeavor as the claimed design; however, depending on the facts, a reference may still be analogous if it falls outside of that field. *Id.* at 1297–1298. Thus, if a potential main or secondary reference exists, whether it will be deemed analogous cannot easily be predicted. Evidently, *LKQ* intentionally left an enormous amount of space for arguments to be crafted, and caselaw to be made, regarding design patent obviousness. See *id.* So, perhaps the best piece of advice in this post-*LKQ* world is this: take a page out of the Federal Circuit's book and use a *flexible* approach when dealing with obviousness for design patents – particularly as it pertains to applying *Graham* factor one.

Contact info

About Maschoff Brennan

Maschoff Brennan provides legal counsel and representation to some of the world's most innovative companies. With over 40 attorneys and offices in the technology-focused regions of Utah, California, and New York, our attorneys are known for having the breadth of experience and the forward-thinking insight needed to handle complex technological and business issues across all industries and geographic boundaries. In addition, we have extensive experience representing clients before the ITC, PTAB, TTAB, and other administrative agencies in Washington DC.

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The primary reference may or may not be in the same field of endeavor as the claimed design (though it usually will), but it must be analogous art.





Game changers: patents shaping the future of sports

Teresa Aguilar, Associate at Uthoff, evaluates technological developments from innovative fabrics for lighter sportswear to wearable tech to evidence the importance of IP protection in the sports industry.

In recent years, the intersection of sports and technology has demonstrated how, through patents, we can envision the future of sports. It cannot be denied that from a business view, sports is one of the most exciting industries that generates over \$500 billion globally annually¹. The sports industry is undergoing a period of rapid growth driven by technological developments. Sports are providing ground for new technologies, and technology, at the same time, is a major source of disruption in sports². While the rules and governing bodies of sports may seem strict, they are also flexible, adapting to innovations such as lighter gear and more durable equipment, from tennis rackets and swimming suits to running shoes. These innovations are often patented, giving companies a competitive advantage and incentivizing further innovation.

From elite to amateur levels, athletes are increasingly turning to new technologies to maximize their capabilities and gain a competitive advantage. As a result, new performance records have been set. These sports innovations can be safeguarded under the intellectual property system by patents. A patent grants an inventor the exclusive right to make, use, and sell an invention for a period of 20 years from the filing date of the application. This legal protection is provided in exchange for publicly disclosing the details of the invention, enabling others to learn from and build upon it once the patent expires. Additionally, once patents expire, competition increases as other manufacturers can produce similar products, often leading to lower prices. This makes advanced sports technologies more affordable and accessible to a broader audience, eventually becoming a common part of sports culture.



Teresa Aguilar

“Sports companies are investing heavily in research and development to create cutting-edge gear that enhances performance and safety.”



To be eligible for a patent, an invention must meet three requirements: it must be novel, meaning it has not been previously disclosed to the public; it must be non-obvious, signifying that it is not an evident improvement or variation of existing products or processes; and it must have industrial application. Sports companies are investing heavily in research and development to create cutting-edge gear that enhances performance and safety as well as patenting its advances. Because of this, the evolution of sports can be told by means of patent literature. For example, Flyknit technology is one of Nike's most groundbreaking innovations in the footwear industry. Introduced in 2012, Flyknit represents a significant leap in the design and manufacturing of running shoes and other athletic footwear. This technology involves creating the shoe's upper using a single piece of knitted fabric, which offers numerous benefits in terms of performance, sustainability, and customization. These patents were pivotal to Nike's competitive advantage in producing a harmonious blend of stability, airflow, comfort, and eco-friendly footwear.³

Flyknit technology is protected by over 300 patents that cover various aspects of the knitting process, the materials used, and the specific designs of the shoe's upper. These patents ensure that Nike retains exclusive rights to its innovative technology, preventing competitors from copying or replicating their designs without authorization. For example, in 2023, Nike filed lawsuits before the Federal Court of Los Angeles against its competitors New Balance and Skechers for infringement and non-consensual use of patented technology known as 'Flyknit'⁴. Nike has previously been involved in legal disputes related to these



patents that protect its Flyknit technology with Adidas, Puma, and Lululemon for infringement. For example, in one of the most high-profile patent disputes in the sportswear industry, Nike, Inc. filed a lawsuit against Adidas AG in 2012, alleging that Adidas's Primeknit technology infringed on several of Nike's patents related to Flyknit technology. Nike accused Adidas of infringing on their patents that cover the process and design of the Flyknit technology. The dispute centered on the similarities between Nike's Flyknit and Adidas's Primeknit, both of which use advanced knitting techniques to create shoe uppers that are lightweight, form-fitting, and reduce material waste. The case saw various developments over several years, including multiple filings, responses, and counterclaims. Eventually, the two companies reached a settlement in 2014⁵.

The details of the settlement were not publicly disclosed, but it is understood that the agreement allowed both companies to continue using their respective knitting technologies without further litigation. The rivalry between Nike and Adidas in the area of advanced footwear technology has pushed both companies to continually improve their products. This ongoing competition benefits consumers by providing access to state-of-the-art athletic footwear that enhances performance, comfort, and the environment. The settlement between the two giants has allowed both to continue pushing the boundaries of footwear technology.

Résumé

Teresa Aguilar has been an Associate of Uthoff in Mexico since 2016, where she is part of the Patent Department as a Legal Attorney. Her daily practice is focused on the management and protection of new creations with the main goal of making sure that new creation rights are properly protected.

She holds a Bachelor of Law from Instituto Tecnológico y de Estudios Superiores de Monterrey, Mexico City Campus.

Additionally, she studied for her Master of Laws (LLM) in Intellectual Property at the University of Leeds in the United Kingdom, where she was awarded with distinction.

Teresa is also a university lecturer at Instituto Tecnológico y de Estudios Superiores de Monterrey, Mexico City Campus, where she has taught IP Law since 2021.

¹ Sports Industry Revenue and Top Trends for 2024 and Beyond, The business Research Company, on April 17, 2024. <https://blog.marketresearch.com/sports-industry-revenue-and-top-trends-for-2024-and-beyond>

² Sascha L. Schmidt 21st Century Sports, How Technology will change Sports in the Digital Age, Second Edition, Springer Nature Switzerland AG 2024, PAGE .. 4

³ Carly Fink, Nike: Sustainability and Innovation through Flyknit Technology, NYU Center for Sustainable Business on August 2016. https://www.stern.nyu.edu/sites/default/files/assets/documents/Nike_Carly_04.2017%20-%20Copy.pdf

⁴ Miriam Martinez Perez, Nike defends its Flyknit technology by suing for patent, The Patent Lawyer, December 2023, <https://patentlawyermagazine.com/nike-defends-its-flyknit-technology-by-suing-for-patent-infringement/>

⁵ Dhanu Eliezer, Patent Wars: Nike and Adidas Battle Over Knitted Shoe, Legalvision, <https://legalvision.com.au/patent-wars-nike-and-adidas/>



According to publicly accessible databases, patents in the sports sector have experienced steady growth over the years, with a notable tendency to increase significantly year by year from 2010 to the present. This trend indicates the expanding intersection of sports and technology⁶. Patents can also provide insights into the most popular sports globally. The data reveals a slight prevalence of patents related to ball games and their accessories. However, it's essential to recognize that this is only a hint of the broader landscape of sports innovations.

In addition to equipment, wearable technology has become a game-changer in sports. Devices that monitor an athlete's vital signs, track their movements, analyze performance data, and smart sports equipment equipped with sensors and advanced information are becoming increasingly common. These smart technologies enable athletes, along with their trainers, to monitor and assess performance, highlighting areas for improvement. Initially adopted by elite athletes, these technologies eventually become accessible to the general public, allowing everyone to benefit from capabilities such as tracking daily exercise and monitoring hydration levels. Patents in this field typically cover various aspects of the devices, including the sensors used, the methods for data collection and analysis, and the integration of these systems into wearable technology. These patents encompass innovations across various segments, including GPS navigation, aviation, marine, fitness, and outdoor activities⁷.

Sports not only benefits from patents, the industry covers a wide range of intangible assets such as copyright, trademarks, and trade secrets. For example, the logo printed on a jersey can be subject to trademark registration. These registrations help to protect the value of the unique and innovative design of the gear and increase its marketing capabilities. Socially, the significance of trademarks has also evolved; trademarks are part of everyday conversation and expressions. They contain high communicative power and transmit information not only about the source identifier but also information and characteristics of the trademark owner⁸. Most Sports trademarks are associated with hard work, explosive movement, and also the achievement of goals; slogans such as "just do it", "impossible is nothing", "always on the run", tell consumers that they can do anything if they just try. It also urges them to take the "you can't" into action⁹. With that being said, it is majorly evident that intellectual property is immensely important in the field of sports¹⁰.

Copyrights are also involved in sports and play a vital role for sports organizations, as they rely on broadcasters to deliver event coverage and engage fans globally, which in turn helps



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The dispute centered on the similarities between Nike’s Flyknit and Adidas’s Primeknit, both of which use advanced knitting techniques to create shoe uppers.
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⁶ <https://www.lens.org/lens/search/patent/analysis?q=sports> Last visited June 19, 2024.
⁷ Intellectual Property and Sports: Tracing the Connections https://www.wipo.int/web/ipday/2019/ip_sports
⁸ Giulio Yaquinto, "The Social Significance of Modern Trademarks: Authorizing the Appropriation of Marks as Source Identifiers for Expressive Works" [2017], Texas Law Review Vol. 95, 740
⁹ Zareen Islam, "Nike's Brilliant Marketing Strategy - Why You Should Be (Just) Doing it Too" (Referral Blog, 9 March 2017) <<https://www.referralcandy.com/blog/nike-marketing-strategy/>> accessed 2 December 2018
¹⁰ Victor Sérgio Moreira, "The Role of Patent in Sports" (June 19, 2019) <https://inventa.com/en/news/article/415/the-role-of-patents-in-sports?utm_source=mondaq&utm_medium=syndication&utm_content=articleoriginal&utm_campaign=article> accessed June 19, 2024

attract sponsors. Copyright and related rights, particularly those concerning broadcasting organizations, form the foundation of the relationship between sports, television, and other media. Although sports events themselves do not typically qualify for copyright protection, media companies invest substantial amounts for the exclusive rights to broadcast major sports events live. These events draw millions of fans who are eager to experience the unfolding excitement of the competition. The revenue from the sale of broadcasting and media rights, which has surged in recent years, has become the primary income source for most sports organizations. This income helps cover the costs of hosting major sports events, renovating stadiums, and funding grassroots sports development.

In conclusion the sports industry significantly benefits from a broad spectrum of intangible assets, including patents, copyrights, trademarks, and trade secrets. Ultimately, the protection and strategic use of these intangible assets are crucial for the growth and sustainability of the sports industry, driving innovation, brand loyalty, and consumer engagement. While athletes and teams seek to break records, achieve victories or just have fun, patents, in parallel, are shaping the future of sports by protecting and promoting

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The settlement between the two giants has allowed both to continue pushing the boundaries of footwear technology.
 ”

innovation and even make them more accessible and interesting for the public. They provide a legal framework that incentivizes the development of new technologies, from sports equipment and wearables to training methods. By safeguarding intellectual property, patents ensure that inventors and companies can reap the benefits of their investments, driving further advancements in the industry. As technology continues to evolve, the role of patents in sports will only become more significant, paving the way for even greater achievements and breakthroughs in the world of sports.



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US provisional applications should be a consideration

Jeremy W. Miller and Wendy M. Slade of Dowell & Dowell detail the benefits of a provisional application, emphasizing the flexibility and slimmed-down requirements that are advantageous to filers.

When deciding whether to pursue full patent protection, a provisional patent application filed with the United States Patent and Trademark Office should always be an initial consideration. The provisional patent application is an application type relatively unique to the United States, and its slimmed-down requirements provide flexibility to filers to pursue many different types of strategies.

To obtain a filing date, unlike a non-provisional patent application, the USPTO requires only the name, city, and country of each inventor, rather than a full address. This information can be provided on a simple coversheet rather than a complete Application Data Sheet. Further, a provisional application can be filed without the names of inventors which can be supplied later. The Office will issue a requirement for names and addresses of inventors, but this ability will allow you to obtain a filing day even if inventorship is not clear at filing. Once the inventorship and/or applicants are known, the avenues for making those corrections in a filed application are much simpler and less expensive than filing those same corrections in a non-provisional application.

While a written description of the invention must be included, the format of the description has no formal requirements. A handwritten description, articles or photos can be provided, and a filing date obtained. While drawings are encouraged to help explain the written disclosure, those drawings submitted may be rudimentary.

The application may be filed in a language other than English. This is very helpful in obtaining a filing date as there is no need to wait for a translation of the documents. If priority to the application is later claimed, an English translation must be submitted in the provisional application, but this can happen closer to the one-year date of the application filing.

The provisional application is not examined, so applicants planning to focus on patent protection in the United States do not need to worry about



Jeremy W. Miller



Wendy M. Slade

producing formal claims or adhering to a particular application structure which is otherwise necessary for a non-provisional application. It is important to note, however, that applicants planning to pursue patent protection outside of the United States based on a claim of priority from a provisional patent application should plan to initially file a more formalized application with a fully prepared specification, drawings, and claims. There are jurisdictions outside the United States that require complete, direct support from priority documents to ensure valid priority claims.

The initial filing of a provisional application crucially acts as an effective filing date for later filed non-provisional applications. Notably, while any pre-filing disclosure in other countries may be fatal to a patent application, filing a provisional application within one year of a public disclosure by inventors or applicants preserves an applicant's ability to pursue patent protection in the United States.

Applicants have one year from the initial filing date of the provisional application to file a non-provisional or foreign patent application, as allowed, claiming priority to the provisional application. This one-year window afforded by filing a provisional application allows applicants time to pursue investors or other potential commercialization opportunities. Further, inventors can use this time to further refine their invention, add embodiments, or pursue related projects.

Further, given the relatively inexpensive nature of the provisional application, it is possible to file the application more quickly and follow up with additional provisional applications as new information becomes available. As long as any priority application is filed within one year of the first application filing, any number of provisional applications may be included in the priority claim.

Most importantly to some applicants, the filing of a provisional application allows for the term "Patent Pending" to be used with related products or services.

While these reduced requirements make a provisional application an attractive starting point for invention, the more detailed and complete the written description is for an application, the better and more solid a foundation that is provided for any applications that claim priority to the first filing. So, while a provisional application and drawings do not need to be highly formal, they should show and explain all aspects of the invention as understood by the applicant at the time of filing.

Another often overlooked aspect of the provisional application is that it does not affect patent term in the United States. In other words, if a provisional application is filed in 1999 with a non-provisional filed in 2000 claiming priority to the provisional application, the patent term for any issuing patent would be counted from the non-provisional patent application, and the patent term would be 20 years or 20 years before lapsing, assuming all fees were paid, and no patent term adjustments were included.

If you are interested in filing a provisional application, or have more questions, please reach out to authors Jeremy Miller or Wendy Slade to help with any of your patent-related needs.

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.

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A provisional application can be filed without the names of inventors which can be supplied later.





Case study: patent litigation in Poland

Urszula Gagata of JWP Patent & Trademark Attorneys delves into the nuances of inventive step, providing insights and perspectives on determination informed by recent case law.

One of the important advantages of the work done by an attorney in intellectual property matters is its multidisciplinary nature. Industrial property law, copyright law, the code of administrative procedure, procedure before administrative courts, the code of civil law, and even customs law are among the areas in which an attorney must demonstrate expertise. And, in addition to having comprehensive legal knowledge, an attorney has to understand their client's invention in order to be able to suggest the best possible protection for it and to present a plan for moving forward or provide appropriate guidance, which means they also need to exhibit technical knowledge.

As an attorney dealing with intellectual property matters, even if you have been practicing for several years, you cannot assume that you already know everything and that your next case will not surprise or challenge you. One of the many beauties of the profession is that, in order to best assist clients in protecting their intellectual property – such as through patents, which cover inventions of a technical nature and whose specificity and level of complexity may require more than even the best-educated lawyer or legal adviser is familiar with – it is often a collaboration that works well. Duos of a lawyer or legal adviser plus a patent attorney have proven successful both in preparing legal opinions and in litigation to invalidate a patent for an invention.

For example, in patent invalidation proceedings before the Patent Office of the Republic of Poland, it is important to understand the scope of protection of a given patent as defined in the independent patent claims and how to interpret them. When acting as an attorney on behalf of a petitioner and requesting the Patent Office to invalidate a patent for a particular invention, you should state the grounds on which it is considered that the invention does not meet the requirements for the grant of exclusive rights. Often the grounds for invalidation are those set out in



Urszula Gagata

“There are situations where the solution under dispute is novel but at the same time obvious compared to known solutions because it represents a simple technical improvement.”



Article 26(1) of the Industrial Property Law (consolidated text in the Journal of Laws of 2023, item 1170, hereinafter IPL), i.e., lack of inventive step. In the substantive assessment of the non-obviousness of a solution, the entire prior art is taken into account. A solution is considered obvious if it is apparent to an average skilled artisan from the prior art disclosed in one or several publications. There are situations where the solution under dispute is novel but, at the same time, obvious compared to known solutions because it represents a simple technical improvement, as in the case described below. To assess non-obviousness, the closest prior art is identified in the form of one or more documents on the basis of which a skilled person would most quickly arrive at such a disputed solution. Often at this stage it is a professional attorney who, by consulting the petitioner and conducting searches in patent databases, is able to find additional prior art documents that may be considered useful in the case. Thus, when filing a petition to invalidate a patent for an invention, it is necessary to provide arguments to show that the citations disclose all the information necessary for a person skilled in the art to be able to develop a solution identical to that protected by the disputed patent. At this stage, when writing the petition and constructing an appropriate argumentation, it is very helpful and recommended to have the assistance of a patent attorney with the appropriate technical background.

In this article, we will look at the case of a petition to invalidate a patent for an invention relating to a connector in gas installations and to a method of its manufacture. Particularly important is the manufacturing method for this connector, which comprises bending the connector appropriately and applying an insulating layer using a suitable electrochemical or chemical process. The patent was granted by the Patent Office in 2015. Our client, a market competitor of the patent holder, was sued in the District Court for infringement of the patent in question in its operations. They

came to us for legal assistance. As the attorney of the defendant, we advised them to file a petition to invalidate the patent with the Polish Patent Office, which was received by the Office in 2018. The grounds for the invalidation petition were that the description of the invention did not disclose details of any specific electrochemical or chemical process by which a step of the method for manufacturing the connector was carried out. The result of this failure to provide details was that the Office accepted the petitioner's citations. In the case analyzed, the Patent Office agreed with the arguments of the petitioner (our client) and found that the patent had been granted in violation of Article 26 of the IPL, i.e., the solution did not involve an inventive step. The patent holder can appeal against this decision of the Office to the Provincial Administrative Court. Still, the latter does not examine the facts, but only the decision of the Office as to whether it was made in accordance with the rules. In the case studied, the appeal was lodged, and the Court of First Instance upheld the decision of the Office that it had been right to invalidate the patent for the invention in question.

The patent holder has one final stage left, which is to appeal against the decision of the Court of First Instance in cassation to the Supreme Administrative Court. In the cassation appeal, the appellant must indicate the violations committed by the Court of First Instance. Pursuant to Article 174 of the Law on Proceedings before Administrative Courts (Journal of Laws of 2023, items 1634, 1705, 1860, hereinafter LPAC), an appeal in cassation may be based on the following grounds:

- 1) Infringement of substantive law through its misinterpretation or misapplication;
- 2) Infringement of procedural rules, where such infringement may have had a significant effect on the outcome of the case.

The Supreme Administrative Court is bound by the grounds of the appeal in cassation because, in accordance with Article 183(1) of the LPAC, when examining the case within the scope of the appeal in cassation, it only *ex officio* considers the invalidity of the proceedings. Following the above, the proceedings before the Supreme Administrative Court do not consist of a re-examination of the case as a whole, but are limited to an examination of the individual charges raised in the cassation appeal in connection with the specified grounds of cassation. The task of the Supreme Administrative Court is to check the legality of the decision of the Provincial Administrative Court and of the proceedings leading to that decision.

“In patent invalidation proceedings before the Patent Office of the Republic of Poland, it is important to understand the scope of protection of a given patent as defined in the independent patent claims and how to interpret them.”



If the invalidity of the proceedings is not found *ex officio* (Article 183(2) of the LPAC), the Supreme Administrative Court only assesses the correctness of how the Court of First Instance interpreted the legal provisions referred to in the appeal in cassation. In the case under analysis, the appeal in cassation contained grounds that included a violation of both substantive and procedural law by the Court of First Instance. However, in the case analyzed, the grounds were formulated in such a way that they were not directed against the judgment of the Court of First Instance but against the decision of the authority, i.e., the Patent Office of the Republic of Poland. An appeal in cassation is a legal measure that is different from an appeal to the Court of First Instance, is highly formalized, and must comply with the legal requirements, including those relating to its correct structure as set out in Articles 174-176 of the LPAC, and is addressed to the Court of Second Instance rather than the Court of First Instance. It is very important that the grounds of the appeal in cassation are correctly stated and separately substantiated so that it is clear why the appellant claims that the judgment of the Court of First Instance infringes the specified provisions of substantive or procedural law. If the grounds are not properly formulated, the Supreme Administrative Court will not be able to examine them on their merits. For this reason, the Polish legislator has introduced compulsory representation by lawyers and, in industrial property matters, by patent attorneys.

In the case under discussion, the appellant in cassation erroneously assumed that the Office, and subsequently the Court of First Instance, should have carried out a more extensive evidential procedure in order to determine whether the disputed invention lacked inventive step. This is inconsistent with the fundamental principle of litigation contained in Article 255(4) of the IPL, according to which the Patent Office may not go beyond the petition and the legal grounds indicated by the petitioner. This distinguishes litigation from classic administrative proceedings, which are governed solely by the provisions of

Résumé

Urszula Gagata specializes in industrial property. She is responsible for patent purity examinations, verifies translations of patent descriptions, and prepares formal documents for the Polish Patent Office and the European Patent Office. She also translates European patents in the fields of biology, biotechnology, and pharmacy from English into Polish.

She has many years of scientific experience, supported by participation in research projects, international conferences, and scientific publications in the fields of biology and biotechnology.



the Code of Administrative Procedure. Therefore, the obligations of the Patent Office under Articles 7 and 77(1) of the Code of Administrative Procedure (Journal of Laws of 2024, item 572, hereinafter CAP) regarding the taking of evidence cannot be transferred to these proceedings.

Litigation before the Patent Office is adversarial in the sense that the petitioner states certain grounds and produces evidence in support of their claim, while the patent holder attempts to refute these accusations with all the evidence and measures known to them, and the Patent Office is obliged to establish the facts correctly on the basis of the evidence produced and to issue a decision stating the reasons for its position in accordance with the requirements of Article 107(3) of the CAP on the substantiation of an administrative decision.

In the case under discussion, concerning the patent for an invention relating to a gas connector, the appellant in cassation (the patent holder, i.e., our opponent in the proceedings) did not submit any evidence during the proceedings to counter the evidence submitted by the petitioner, but only challenged its credibility by polemicizing with the position of the petitioner and the authority. In this situation, the Office only had evidence submitted by the petitioner.

In addition, the Administrative Court does not normally conduct evidentiary proceedings, but only examines the legality of the decision issued by the Patent Office and the procedure followed by the Office, referring to the administrative acts and the evidence collected by the Patent Office in the course of the proceedings. The Court reviews the course of action which led to that particular decision of the Office. The taking of evidence by the Court of First Instance is of a supplementary nature only and it is for the Court of First Instance to decide whether it deems it necessary to take new evidence.

The Supreme Administrative Court found that the substantiation of the Provincial Administrative

“**The appellant in cassation erroneously assumed that the Office, and subsequently the Court of First Instance, should have carried out a more extensive evidential procedure.**”

Court’s decision contained all the structural elements required by Article 141(4) of the LPAC. The fact that the author of the appeal in cassation does not agree with the position of the Court of First Instance and claims that not all the grounds of the appeal have been considered, without specifying them, does not constitute a basis for an appeal against the judgement. There can be no allegation of a breach of law by the Court of First Instance simply because the decision is not in accordance with a party’s expectations. When the Administrative Court applies the measures provided for in the Act, each of its rulings, whether favorable or unfavorable to the appellant, are the exercise of the Court’s function of controlling public administration.

As a result, the Supreme Administrative Court dismissed the appeal in cassation, stating that the disputed invention lacked an inventive step and thus upholding the decision of the Patent Office to invalidate the patent for the invention.

As can easily be seen from the situation described above, the role of a professional attorney in intellectual property matters is very important. When deciding to request the invalidation of a patent that in some way threatens its market activity, often in response to an action brought by the patent holder, the petitioner must be aware that the proceedings may be lengthy and take place before several authorities. Both parties to the proceedings want to win the case and gain benefits, usually financial. Due to the complexity of the proceedings and the formalities involved at later stages, it is advisable to engage a professional lawyer from the outset, who will ensure that the charges are correctly formulated, that the formalities are complied with and who will represent the petitioner before the relevant authority. Patent firms have teams of specialists who, often working together, can win even the most complex cases. It should be emphasized that a patent attorney is a person who has a degree in technical or legal studies and specializes in industrial property matters. They can thus provide legal and technical assistance, which is particularly important in complex proceedings relating to patents. In addition to having in-depth knowledge of intellectual property matters, as a person exercising a profession of public trust, they act in the interests of their client with respect for ethics and professional secrecy.

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# Women in IP Leadership

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

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

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



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

**Gordon Samson, President, IP, Clarivate**

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

# Stephanie Curcio: CEO and Co-Founder, NLPatent

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

Stephanie Curcio is the CEO and Co-Founder of NLPatent, a leading AI-based patent research platform. She holds leadership roles in IP organizations in Canada and the US, and is recognized globally as a leader in IP strategy (IAM Strategy 300) and as a “Powerful Woman in IP” (WIPF). Recently, she was honored as one of The DMZ’s “Women of the Year” and The Peak’s “Emerging Leaders” in the Legal category, highlighting her contributions to the innovation economy.

“  
**The truth is, having someone influential in the industry give you a chance is, bar none, the best way to open doors.**  
”

### What inspired your career?

The core inspiration for my career is that I've always loved the pursuit of discovery – understanding the “why” behind how things work, which led me to the sciences. As I began my university studies, nothing fascinated me more than the workings of the brain, so I majored in neuroscience. I found the pace of evolution of the field of neuroscience to be incredible; many sections in the neuroscience textbook I purchased in second year – meant to take me through three years of studies – became so obsolete that they were plain wrong by the time I was in fourth year!

I pursued neuroscience for two years following graduation, working in Parkinson's research under a powerhouse female scientist whom I admired greatly. When it came time for me to figure out next steps (graduate school? professional school?), I turned to her for advice. She patiently sat with me, discussing my passions and aspirations, and we ultimately agreed that lab life was probably not right for an extrovert like me! She encouraged me to apply to law school, and even wrote a letter supporting my application.

In law school, my science background naturally pushed me into IP and after serving as President of the school's IP club, I landed my dream job at a Band 1 IP firm in Toronto. I later moved to a top full-service firm, working under some of the brightest IP minds in Canada. I loved my job, but something was missing.

In 2017, I was introduced to language-based AI and was blown away by the possibilities. I recognized that with AI, some of the most mundane and tedious tasks patent attorneys perform can be automated and improved tremendously. I knew this was going to be massive and, without a second thought, I left my practice as a Big Law IP attorney to co-found a startup determined to bring modern AI techniques to the patent process. The rest is history!







“  
**What I am most proud of is making an impact on the profession by ushering in entirely new workflows supported by technology.**  
 ”

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

Junior IP attorneys are often tasked with the most mundane and tedious mandates – for example, patent searching – ostensibly to learn the trade and create a foundation for knowledge. Indeed, there is much useful information hidden in patent data; not only to evaluate key issues of patentability, freedom to operate, and validity, but also strategic business decisions and competitive intelligence. However, through their search efforts, attorneys get exposed to the inefficiencies and difficulty in working with raw patent data. There's so much of it, and patent language is incredibly complex. And, as it turns out, lawyers are not great at working with this data; their hourly rates are high, and their (expensive) intellectual skills are better suited for drafting claims and crafting arguments – “three-dimensional chess,” as my law firm mentor would say.

When introduced to AI in 2017, I had my first “holy crap” moment when I could see so clearly how the problems with accessing and analyzing patent data could be solved by technology. There was no doubt in my mind that modern AI techniques were the future of our profession and I had to, without question, be part of it. I saw the opportunity to be an early mover at the intersection between AI and patent law and went for it. After taking that leap of faith, I could never have predicted where my career would take me nor how happy I would be pursuing it.

Without hesitation, I would encourage young lawyers to have an open mind and follow whatever direction excites them or, if they're lucky, blows them away. Taking risks is inherently uncomfortable, but you'll never know where your career might take you if you don't take a chance.

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

Getting my business off the ground was incredibly difficult. Despite my conviction that we were on the right path, the industry was generally not ready to adopt AI. We had some success with early adopters, but the wins were slow, and the

work signing them on as clients was grueling. Lack of education on AI, and lack of trust in the output, were big factors.

In those early days, I became an evangelist for AI and I put myself out there to talk to as many people as possible to get the word out, expand my network, and establish myself as a thought leader in AI for IP. I had the tremendous good fortune of meeting an individual who was highly influential in the patent world and who heard me out, saw something in me, and gave me an opportunity to shine. Without knowing almost anything about me besides my work and interest in the space, he invited me to give a key presentation on AI in patent search. That presentation, and the opportunities that ensued, propelled my career forward in ways I couldn't imagine. Even to this day, this individual would modestly say he did nothing, but the truth is, having someone influential in the industry give you a chance is, bar none, the best way to open doors.

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

I started a business that not only I believe in wholeheartedly but, I am proud to say, our clients believe in as well. The road to get here hasn't been easy – there have been plenty of ups and downs. But looking back on what my team has achieved, and the great satisfaction and fulfillment that has given me, I am full of pride. Building a business has brought many great achievements, but what I am most proud of is making an impact on the profession by ushering in entirely new workflows supported by technology.

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

AI technologies have become ubiquitous, impacting nearly every profession in profound ways. Legal practice is no exception. Modern large-language model (“LLM”)-based tools have transformative potential across the patent profession, and we're already starting to see their proliferation. My goal is to take the core LLM my team has designed and apply it across the innovation lifecycle, to facilitate invention harvesting, assist with patent prosecution, identify competitors, facilitate licensing and patent valuation, and manage entire patent portfolios. The possibilities are endless. Achieving these goals will require strategic thinking and continuing to foster relationships within the industry to ensure we are building solutions that address real challenges with intuitive design.

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

Over the past few years, organizations have made

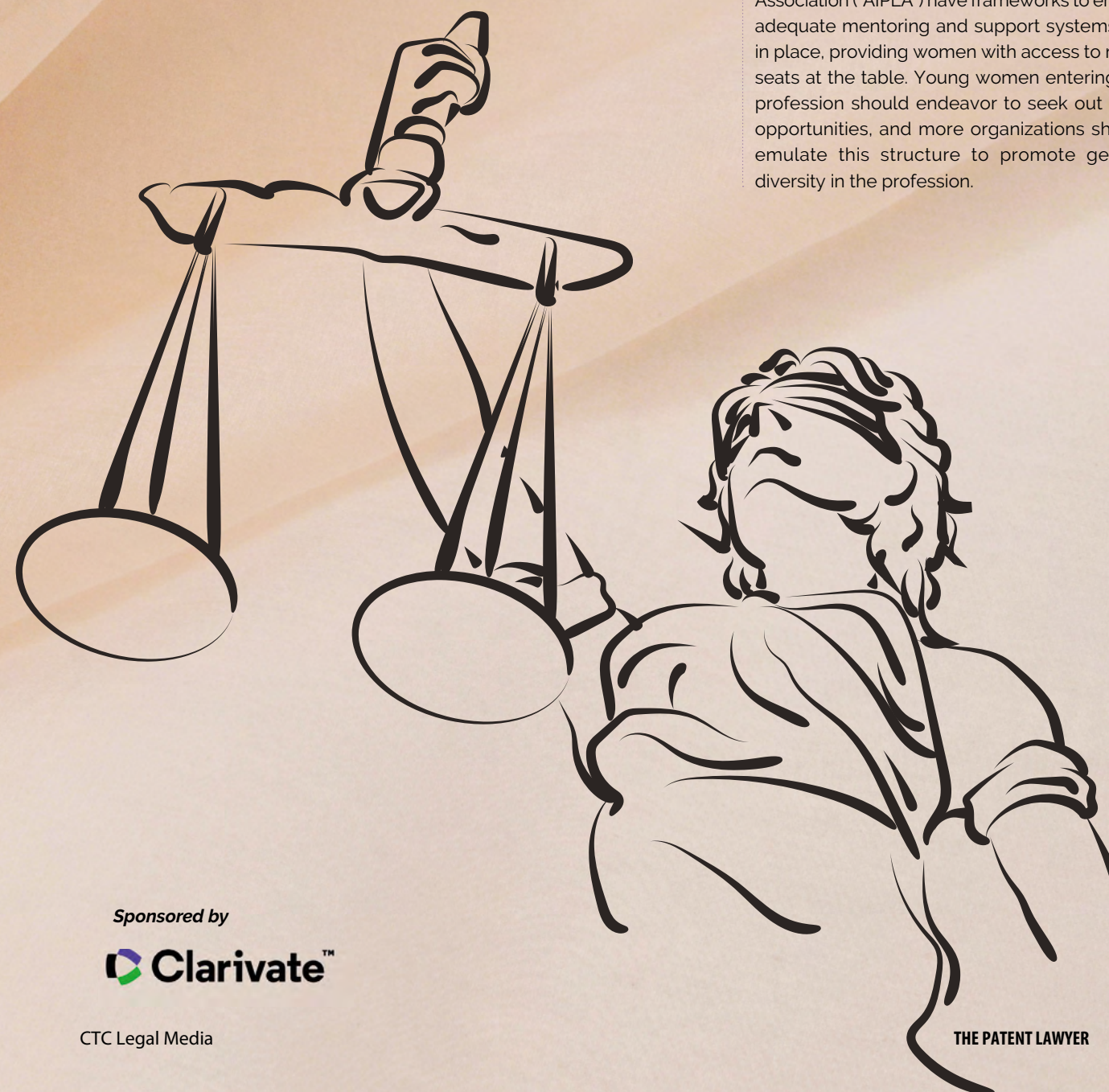
strides in prioritizing diversity and inclusion across all business units and functions. However, there is still much work to be done. The focus in the next five years should shift from identifying the issues to taking concrete actions. Given the pivotal role that mentorship has had in my own career, I believe that initiatives focused on expanding mentorship programs and creating clear pathways for career advancement for underrepresented groups will be crucial. This effort should extend beyond practitioners to include cross-discipline mentorship of diverse entrepreneurs and inventors who have historically faced barriers.

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

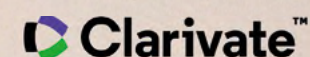
Unfortunately, transitioning from being a female patent practitioner to becoming a female tech entrepreneur didn't change much in terms of demographics, as both industries (IP and tech)

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**To continue empowering women in both sectors, it is essential to foster inclusive work environments and establish mentorship programs that provide guidance and support.**  
 ”

are heavily male dominated. To continue empowering women in both sectors, it is essential to foster inclusive work environments and establish mentorship programs that provide guidance and support. Great organizations like the American Intellectual Property Law Association (“AIPPLA”) have frameworks to ensure adequate mentoring and support systems are in place, providing women with access to more seats at the table. Young women entering the profession should endeavor to seek out such opportunities, and more organizations should emulate this structure to promote gender diversity in the profession.



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A comprehensive list of the 10 most well-respected law firms from South America







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## 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 South America, in alphabetical country and company order. Our focused list is derived from a multifaceted methodology, which uses months of industry research and feedback from our readers, clients, and esteemed connections around the world. All firms are ranked top 10 in their jurisdiction but are displayed alphabetically to avoid bias.

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- Berton Moreno IP LAW
- G Breuer
- Marval, O'Farrell & Mairal
- Mitrani Caballero & Ruiz Moreno
- Moeller IP Advisors
- Noetinger & Armando
- O'Connor & Power
- Ojam Bullrich Flanzbaum
- Palacio & Asociados
- Pérez Alati, Grondona, Benites & Arntsen (PAGBAM)

### Bolivia

- Bolet & Terrero
- Bufete Aguirre, Quintanilla, Soria & Nishizawa (BAQSN)
- Cervieri Monsuárez
- C.R. & F. Rojas Abogados
- DAK Intellectual Property
- Escobar & Escobar
- Landivar & Landivar
- Lima & Asociados
- Moreno Baldivieso
- Rigoberto Paredes & Associates

### Brazil

- Bhering Advogados
- BMA Advogados
- Daniel Law
- Dannemann Siemsen Advogados
- Gruenbaum, Possinhas & Teixeira Intellectual Property
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# Jurisdictional Briefing, US: FTC bans most employee non-compete agreements

**Steven M. Coyle and Michael J. Rye of Cantor Colburn introduce the new Non-Compete Clause Rule, outlining its ramifications alongside the specific notice requirements for existing non-compete clauses in workers' employment agreements.**

The Federal Trade Commission recently published a Final Rule on the Federal Register, which, barring successful legal challenges to the Rule, is projected to be effective on September 4, 2024. Subject to exceptions, the Rule generally states that entering into an agreement containing a non-compete clause (defined in 16 C.F.R. §910.1 (1)) with a worker – including a senior executive – after the Rule's Effective Date, is an unfair method of competition.

In January 2023, pursuant to its authority under Section 5 and Section 6(g) of the FTC Act, the Commission published a notice of proposed rulemaking about non-compete clauses. Over a year later, the Commission issued and ultimately voted to adopt the Rule. The requirements in the Rule are largely reflected in 16 C.F.R. §910.

The Commission cited the preservation and protection of fair competition as the primary reason for the Rule. Further, the Commission pointed to empirical research over the years that demonstrated the negative effects of non-compete clauses on labor markets as well as constraints on product and service markets, which limits the blossoming of new businesses and innovation more generally.

While the Rule institutes "a comprehensive ban" on employers entering non-compete agreements with all workers, including senior executives, after the Rule's Effective Date, the Rule treats existing workers and senior executives differently.



Steven M. Coyle



Michael J. Rye

## The treatment of workers

The Commission gave a lot of consideration to who should be included in the definition of a "worker" between the Commission publishing the notice of proposed rulemaking about non-compete clauses and the Commission's issuing of the Rule over a year later. The FTC ultimately declined a narrow definition of a "worker." A worker, according to 16 C.F.R. §910.1, includes, "an employee, independent contractor, extern, intern, volunteer, apprentice, or sole proprietor who provides a service to a person." The Rule bans and renders unenforceable existing non-compete agreements between workers other than senior executives and employers as well as non-competes entered into after the Rule's Effective Date.

## The treatment of senior executives

The Commission also addressed the classification of "senior executives" (in contrast to workers) as defined in 16 C.F.R. §910.1. The Rule holds that non-compete agreements involving senior executives are also unfair methods of competition. Thus, any non-compete agreements entered into with a senior executive after the Rule's Effective Date are ineffective. However, any non-compete agreements entered into with a senior executive before the Rule's Effective Date may remain in force.

More generally, the Rule includes a notice requirement for existing non-compete clauses included in worker's employment agreements,

who are not senior executives, requiring employers to give those workers "clear and conspicuous notice" of the date the non-compete clause will no longer be effective against the worker. The Commission also outlined what must be included in that notice.

There are three exceptions to the Rule. First, the requirements listed in 16 C.F.R. §910 do not apply to "a non-compete agreement that is entered into by a person pursuant to a bona fide sale of a business entity, of the person's ownership interest in a business entity, or of all or substantially all of a business entity's operating assets." In addition, 16 C.F.R. §910 does not apply to a cause of action arising from a non-compete agreement entered into prior to the Effective Date of the Rule. Lastly, it is not a violation of Section 5 of the FTC Act to attempt to enforce a non-compete agreement or "make representations" related to a non-compete agreement when the individual is doing so under a good faith belief that 16 C.F.R. §910 does not apply to the present situation.

There have already been lawsuits instituted against the FTC related to the Rule, one of the first of which, was by Ryan LLC, a global tax services and software provider. *Ryan LLC v. FTC*, 3:24-cv-00986-E (N.D. Texas) (Apr 23, 2024). While it is unclear at this time how this and other legal challenges will impact the Rule, employers should consider taking steps to be in compliance with the Rule, including with respect to any notice requirements.

## Résumés

### Steven M. Coyle, Partner Litigation Practice Co-Chair

Steve litigates and tries complex disputed matters, and specializes in patent and all varieties of intellectual property litigation. Steve's areas of focus include ANDA and Hatch-Waxman litigation, where he has represented the rights of generic drug manufacturers and helped them to bring products to market. In addition to patent litigation, Steve has litigated trademark and trade dress cases, trade secret cases, copyright cases, non-compete disputes, licensing matters, and complex commercial disputes. He has handled cases in numerous courts throughout the country and has argued before the First and Federal Circuit Courts of Appeals.

### Michael J. Rye, Partner Litigation Practice Co-Chair

Mike's varied experience with intellectual property litigation over the past 25 years runs the gamut of litigation from injunction hearings through appeal for domestic and international clients in a wide variety of industries, often involving complex technologies. Mike's practice emphasizes patent litigation, but often involves trademark, trade dress, copyright, trade secrets, unfair competition, false advertising, licensing, and other related commercial and business litigation. Mike has acted as lead litigation counsel in courts throughout the United States, including multi-district litigation and numerous Federal District courts.

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# Federal Circuit removes attorneys' fees for meritless claims in IPR

David McCombs, Eugene Goryunov, and Adam Erickson of Haynes & Boone review a recent precedential decision by the Federal Circuit that ended the decade-long argument regarding the award of attorneys' fees.

In patent law, attorneys' fees are only awarded if the case is "exceptional."<sup>1</sup> As a result, fee shifting is both rarely requested and rarely granted. But a recent precedential decision from the Federal Circuit has made awarding attorneys' fees from an IPR proceeding all but impossible.

The decision ended a decade-long dispute between Dragon Intellectual Property LLC, a law firm headquartered in Beijing with "more than 300 employees,"<sup>2</sup> and 10 different entities it had targeted, including DISH Network and Sirius XM Radio. Dragon acquired the patent at issue about a year before beginning its assertion campaign.<sup>3</sup>

DISH and Sirius XM petitioned for IPR and the district court litigation was stayed for those defendants.<sup>4</sup> After a claim construction hearing, all defendants "stipulated to noninfringement as to the accused products, and the district court entered judgment of noninfringement in favor of all defendants."<sup>5</sup> In 2016, one month before the patent's expiration date, the PTAB issued a final written decision "holding unpatentable all asserted claims."<sup>6</sup>

DISH and Sirius XM then moved the district court for attorneys' fees.<sup>7</sup> After multiple appeals and remands, the district court found the case "exceptional" under 35 U.S.C. § 285 and granted attorneys' fees "for time spent litigating" in district court, but denied attorneys' fees "incurred solely during the IPR proceedings."<sup>8</sup> Both sides appealed.

The Federal Circuit affirmed the district court's decision not to award attorneys' fees incurred during the IPR. The majority supported this decision primarily for two reasons. First, the IPR was a separate case that the defendants "voluntarily pursued," and was thus not "part and parcel" of the district court case, as DISH argued.<sup>9</sup> And second, the district court "is particularly well-positioned to determine whether a case before it is exceptional because 'it lives with the case over a prolonged period of time,'" but it has no jurisdiction over "IPR proceedings."<sup>10</sup> The majority noted that allowing district court judges to decide whether attorney fees from an IPR should be shifted would be inappropriate because it would require them to review evidence and assess the strength of cases they did not preside over.

Notably, District Court Judge Bencivengo, sitting by designation, dissented. Responding to the majority, she explained that the defendants "did not 'voluntarily' seek to invalidate [the] patents through IPR," but were "instead compelled" in response to the "meritless infringement suit."<sup>11</sup> Judge Bencivengo further explained that the IPR proceeding was not a separate case because the district court case was stayed pending the resolution of the IPR. The IPR "substituted for district court litigation on Appellants' validity challenge."<sup>12</sup> And, finally, the district court's exceptionality decision would and could be based on the record before it – not the IPR record – and so does not require the district court to improperly review IPR evidence.<sup>13</sup>

Judge Bencivengo concluded that "in a case such as this, where exceptionality is based on a determination that the case was objectively baseless from its inception, it should be within the discretion of the district judge to award all reasonable fees incurred by the prevailing defendant, including fees incurred in an IPR that resolved any invalidity defenses that were required to be asserted in response to the baseless complaint."<sup>14</sup>



David McCombs



Eugene Goryunov



Adam Erickson

## Résumés

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

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

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

The Federal Circuit's apparently categorical denial of attorneys' fees in IPR proceedings rippled across the patent community, with many expressing concerns that the decision would further embolden frivolous patent infringement claims.

“A recent precedential decision from the Federal Circuit has made awarding attorneys' fees from an IPR proceeding all but impossible.”

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# AI and the US patent system: navigating the complexities of patent law and practice

Jonathan B. Thielbar of Loeb & Loeb explores the evolving intersection of artificial intelligence and patent law in the United States, reflecting on challenges and considerations for patent practitioners before the USPTO.

The rapid evolution of AI systems raises complex questions related to patent law and practice in the United States. The US federal courts and the US Patent and Trademark Office (USPTO), along with the patent practitioners, are confronted with the challenge of fitting AI and its uses into the current legal framework or modifying it to better accommodate this near-ubiquitous technology. So far, neither the Patent Act nor the USPTO rules themselves have been amended to directly address AI. Instead, the judiciary and the USPTO have navigated the advancements and expanding uses of AI within existing legal structures, which influences both the patentability of inventions and how practitioners conduct their practices.

Courts and the USPTO have specifically addressed AI in three key areas: (1) AI's contribution to creating patentable material, (2) the impact of AI-generated prior art on patent eligibility, and (3) the use of AI by practitioners in drafting patent applications.

## AI as an inventor

In perhaps the most noteworthy US patent decision to date related to AI, the Federal Circuit<sup>1</sup> addressed whether an AI system could be listed as an "inventor" on a US patent. The Patent Act<sup>2</sup> defines an "inventor" as "the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention." The court determined that, under the statute, an inventor must be a "natural person" (i.e., human being), and therefore not an AI system.



Jonathan B. Thielbar

Relatedly, the USPTO interpreted<sup>3</sup> the Patent Act to allow patentability of AI-assisted inventions if a natural person makes a "significant contribution" to the claimed subject matter. Such a "significant contribution" must be to the conception of the invention and contribute in a way that is not insignificant in quality when measured against the full invention. This determination will likely be the subject of future litigation. In the meantime, the USPTO referenced the Pannu<sup>4</sup> factors, which courts have traditionally used to assess whether contributions from individual joint inventors are significant. Under those factors, each individual inventor must:

- Make a significant contribution to the conception of the invention;
- Contribute in a way that is not insignificant in quality when measured against the full invention; and
- Do more than merely explain to the real inventors well-known concepts or the current state of the art.

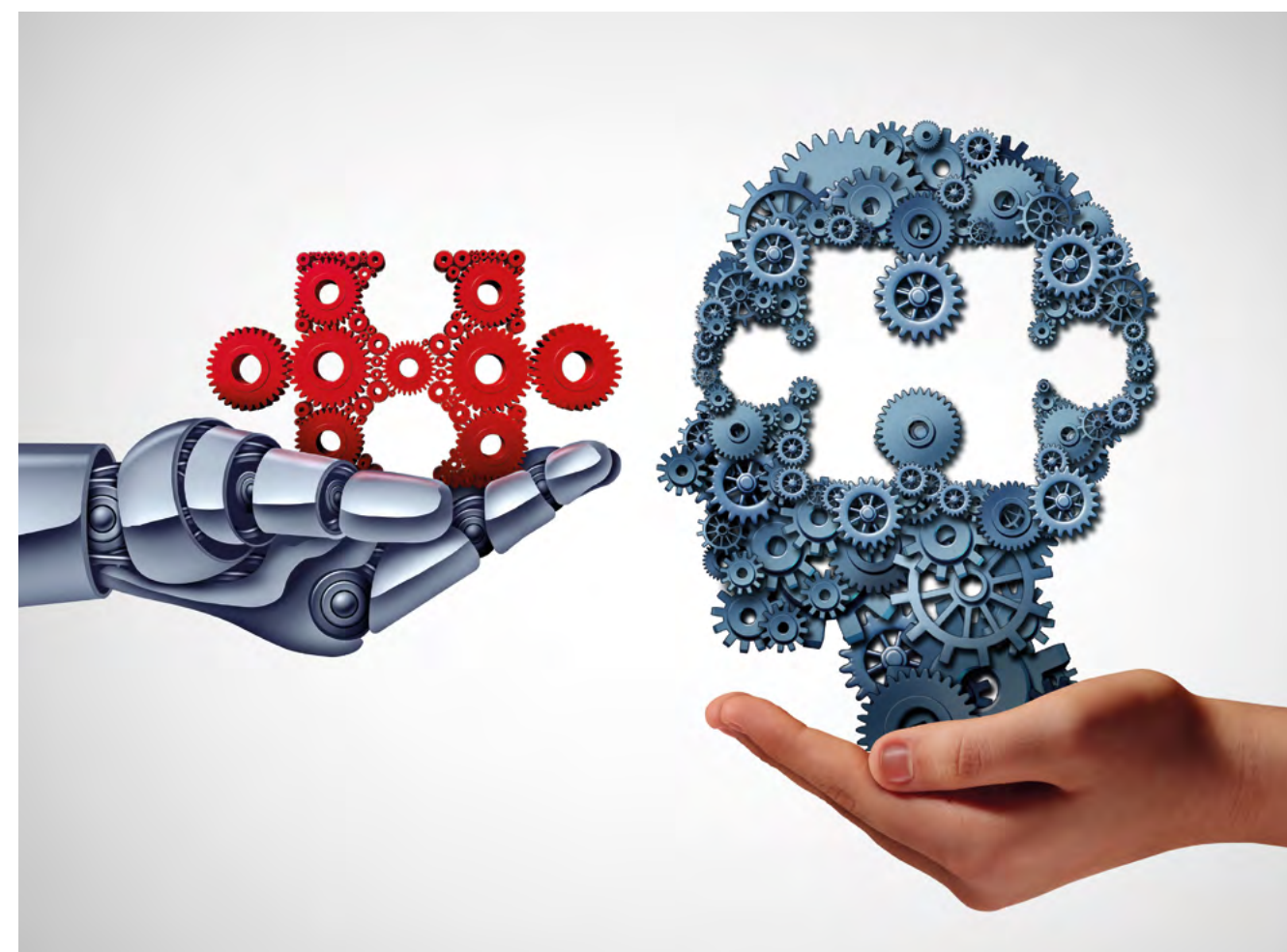
In traditional joint inventorship, contribution to a single claim suffices for inventorship. But under the USPTO's interpretation, AI tools assisting in an invention are not simply another joint human inventor. Instead, for AI-assisted inventions, a human inventor must significantly contribute to every claim in an application for those claims to be patentable. For this reason, practitioners and

<sup>1</sup> *Thaler v. Vidal*, No. 21-2347 (Fed. Cir. 2022).

<sup>2</sup> 35 USC. § 100(f).

<sup>3</sup> See *Dep't of Com., Patent and Trademark Office Inventorship Guidance for AI-Assisted Inventions*, 89 FR 10043 (2024).

<sup>4</sup> *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998).



applicants should take care to confirm that at least one named human inventor contributes "significantly" to all claims – not just independent claims.

While determining whether a human inventor has significantly contributed to an invention is a case-specific, factual assessment, the USPTO offers several guiding principles:

- Merely presenting a problem to an AI system does not qualify someone as an inventor of a solution generated by the AI. However, crafting a specific prompt to produce a targeted solution may be significant.
- Merely recognizing and appreciating the output of an AI system is not enough for invention. However, a person may qualify as an inventor if they take the output of an AI system and make a significant contribution to create an invention.
- Even if not involved in every step leading to conception, a person who develops a crucial building block for a claimed invention may still be considered an



**For AI-assisted inventions, a human inventor must significantly contribute to every claim in an application for those claims to be patentable.**



## Résumé

### Jonathan B. Thielbar, Partner

Jonathan's practice focuses on helping clients develop, protect, and monetize their technology, with an emphasis on patent procurement, strategic counseling, and patent threat assessment/defense. His engineering background provides valuable insight into his clients' innovations at all stages of development, and allows Jonathan to help grow and maintain his clients' patent portfolios in lockstep with broader business goals. Jonathan has experience in a wide range of industries, including artificial intelligence (AI), immersive virtual reality, green technology, heavy machinery, medical devices, payment systems, product manufacturing, sporting goods and equipment, computer software and security, database management, and home appliances.





inventor. Designing, building, or training an AI system in view of a specific problem to elicit a particular solution could be a significant contribution to AI-assisted invention.

Failing to verify that a named inventor's contribution to an AI-assisted invention is significant may result in a patent application's rejection or loss of rights post-issuance. For example, USPTO guidance instructs patent examiners to reject applications if evidence indicates that the inventor's contribution was not significant to the claimed invention. Moreover, courts or the Patent Trial and Appeal Board (PTAB) may invalidate an issued patent if they retrospectively deem the inventor's contribution insignificant compared to that of an AI tool. Importantly, patentees could traditionally correct inventorship for misnamed human inventors (before or after issuance). But with AI-assisted inventions, patentees cannot

name a new inventor to correct inventorship if no natural person made a significant contribution, resulting in invalidity. Accordingly, patent owners may save significant time, resources, and patent rights down the road by verifying inventors' roles in the application phase.

Undoubtedly, as inventors increasingly use AI tools in ever-growing applications and capacities, the criteria that the USPTO and courts use to determine a "significant contribution" will continue to evolve. Patent applicants and their counsel will need to understand precisely what contributions AI tools have made in conceiving inventions and weigh those against human inventor contributions.

### AI-generated prior art

In April, the USPTO sought<sup>5</sup> public feedback on how AI affects prior art and the knowledge of a person having ordinary skill in the art (PHOSITA). The guidance acknowledges the potential for AI to generate extensive databases of public disclosures without any human input or review. Despite most of such publications possibly being nonsensical or inoperable, the USPTO is questioning if such AI-generated materials should count as prior-art "printed publications" when evaluating the patentability of subsequent applications.

Even if nonsensical, a particular reference "is prior art for all that it teaches" and may be cited for anticipation or obviousness<sup>6</sup>. And because a PHOSITA is "a hypothetical person who is presumed to have known the relevant art at the relevant time,"<sup>7</sup> all relevant publications would presumably be known to them. And while prior art must be operable, that operability is presumed when the reference relied on "expressly anticipates or makes obvious all of the elements of the claimed invention." The concern is that if AI tools can mindlessly churn out and publish virtually every plausible combination of words, such publications – even if otherwise nonsensical – could potentially anticipate claims that may have been otherwise patentable. Indeed, given enough time, such AI-generated publications could conceivably anticipate virtually all claims, resulting in no additional patents.

Such an outcome could be catastrophic for the patent system, as well as those who invest time and resources in new technology and anyone that benefits from those innovations. Accordingly, the USPTO suggested that AI-generated references, particularly those created without any human input or review, should perhaps not enjoy the same presumption of operability that human-generated references are currently given. This could potentially limit the number of AI-generated prior art references available to patent examiners and challengers. However, such an approach would differentiate

between AI- and human-created prior art, which is a distinction not yet recognized by courts or the USPTO. Further, it would inevitably raise new questions about the provenance of prior art, and about who should bear the burden of proving whether a reference was indeed AI-generated. Additionally, parties would likely clash regarding when AI-generated references should be deemed operable. While courts and the USPTO would sort out such issues over time, creating a new category of AI-generated publications would introduce a period of uncertainty for patent owners and applicants.

### Using AI to prepare patent applications

Unlike some courts and other patent offices, the USPTO has not prohibited using AI tools for drafting submissions, nor does it require disclosure of their use. Instead, the USPTO's guidance<sup>8</sup> clarifies that the existing rules protect against the known risks of using AI technology in this context. For example, the USPTO reiterated that, under the existing rules of duty and candor, the practitioner signing a submission to the USPTO, whether manually or electronically, is responsible for its content. In other words, by presenting any paper to the USPTO, the presenting party certifies

“**While practitioners are not generally required to disclose the use of AI tools, its use must be disclosed to the USPTO if it is somehow material to patentability.**”

that "all statements to the party's own knowledge are true and that the party performed an inquiry reasonable under the circumstances." Further, while practitioners are not generally required to disclose the use of AI tools, its use must be disclosed to the USPTO if it is somehow material to patentability.

As for the risks the USPTO seeks to protect against, the guidance specifically identifies "the potential for generative AI systems to omit, misstate, or even 'hallucinate' or 'confabulate' information." Accordingly, as the technology advances and AI's role in preparing patent applications, office action responses, and PTAB submissions continues to grow, practitioners

<sup>5</sup> See *Dep't of Com., Request for Comments Regarding the Impact of the Proliferation of Artificial Intelligence on Prior Art, the Knowledge of a Person Having Ordinary Skill in the Art, and Determinations of Patentability Made in View of the Foregoing*, 89 FR 34217 (2024).

<sup>6</sup> See MPEP 2121.

<sup>7</sup> See MPEP 2141.

<sup>8</sup> See *Dep't of Com., Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the US Patent and Trademark Office*, 89 FR 25609 (2024).

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must diligently review and verify a submitted paper's contents and not simply rely on an AI tool's accuracy. Penalties for violating this rule range<sup>9</sup> from striking an offending paper, to referring the practitioner to a disciplinary body, or even terminating the proceeding altogether.

As practitioners increasingly rely on AI drafting tools and as those tools continue to grow in capability, they will need to be particularly diligent in discerning between inventor-contributed subject matter and AI-contributed subject matter. Patent prosecution often takes years, particularly if a patent family expands through continuation or divisional applications. It is easy to imagine a scenario in which a practitioner uses an AI tool to supplement inventor-contributed content while drafting an application. Then, perhaps years later, an entirely different practitioner could prepare amended claims that unknowingly include AI-contributed subject matter, such as in response to an office action or in a continuation application. As described above with reference to AI-assisted inventions, those claims would be invalid if the human inventor's contributions to those claims are not significant. So, even if the USPTO does not currently require practitioners to disclose the use of AI tools in preparing USPTO submissions, practitioners should adjust their practice to

“  
Such an outcome could be catastrophic for the patent system.”  
”

account for the risks associated with employing such tools.

As AI technology continues to improve and find ever-increasing uses, its influence on patent practice will continue to expand. Inventors and patent practitioners will likely incorporate AI tools into their daily work processes, potentially without even realizing it. But while AI could bring improvements in efficiency, productivity, and even broader access to the patent system, both governing authorities and patent practitioners must continue assessing its impact on the patent system to strike the right balance between those benefits and the associated risks it introduces.

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<sup>9</sup> See 37 CFR 11.18(c)



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# Navigating inventive step: technical inspiration in prior art

**Dongxi SUN, Partner at Beijing Sanyou IP Agency Ltd., presents the "three-step method" for evaluating inventive step in patent applications, while focusing on the judgment of technical inspiration in prior art.**

The provision on inventive step is the one with the highest frequency in the process of grant and confirmation of right of a patent for invention. In practice, the examiner usually uses the "three-step method" to make a detailed evaluation of the inventive step of the invention as claimed in the independent claims, namely: (1) determining the closest prior art; (2) determining the distinguishing features of the invention and the technical problem to be actually solved by the invention; (3) judging whether or not the claimed invention would have been obvious to the person skilled in the art. The above-mentioned third step of obviousness judgment has always been the focus and the Gordian knot of judgment of inventive step. In the examination practice, the examiner usually pays too much attention to the technical features of the invention *per se*, but ignores the technical solution as a whole, the technical problems to be solved and the technical effects to be achieved, etc., and it is likely to start from the perspective of the technical features only to consider that



Dongxi SUN

the prior art provides the technical inspiration to apply the distinguishing technical features to the closest prior art, and thus it is concluded that the invention does not involve an inventive step.

### Related regulations

It is further stipulated in the *Patent Examination Guidelines* that judging whether an invention has prominent substantive features is to judge whether the invention is obvious relative to the prior art to the person skilled in the art. In the course of the judgment, what is to be determined is whether

### Résumé

**Dongxi SUN** 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 18 years' experience in the IP industry, he specializes in patent drafting, patent prosecution, invalidation, reexamination, patent search, and analysis in the fields of electronics, telecommunication, semiconductor, graphics processing, coding, and decoding, etc.







or not there exists such a technical inspiration in the prior art as to apply the distinguishing technical features to the closest prior art in solving the technical problem actually solved by the invention, where such inspiration would prompt the person skilled in the art, when confronted with the technical problem, to improve the closest prior art and thus reach the claimed invention. If there exists such a technical inspiration in the prior art, the invention is obvious and thus fails to have prominent substantive features.

Similar to the above-mentioned stipulations, the *European Guidelines for Examination* stipulates that, to determine whether the claimed invention would have been obvious to the skilled person, the "could-would approach" would be applied. This means asking not whether the skilled person could have carried out the invention, but whether they would have done so in the hope of solving the underlying technical problem or in the expectation of some improvement or advantage. So the point is not whether the skilled person could have arrived at the invention by modifying the prior art, but rather whether, in expectation of the advantages actually achieved (i.e., in the light of the technical problem addressed), they would have done so because of promptings in the prior art.

**Aspects of judgments**

In the following, the author will discuss judgment on the technical inspiration in the prior art in consideration of the technical problem.

**1) Judgment on the existence of the technical problem**

The premise that the person skilled in the art would have been able to generate the motivation to improve the prior art is he or she would realize the existence of the technical problem to be actually solved by the invention. Insofar as there objectively exists a certain technical problem in the prior art, if the person skilled in the art would realize the practical requirements for solving the technical problem on the basis of the technical teachings disclosed in the prior art, and would have been able to solve the corresponding technical problem and achieve corresponding technical effects by applying the distinguishing features to the closest prior art, it means that the person skilled in the art would have been able to generate the motivation for modifying the closest prior art.

However, judging whether the person skilled in the art would be motivated to improve the prior art means that the person skilled in the art would have been able to generate the motivation to make such improvement based on the prior art before the application date, instead of considering whether there is a possibility of improving the prior art after learning the invention, which results in an *ex post facto* view being taken

“ Finding the technical problem causing a defect in the prior art or determining the reason why the defect exists would become the key to solving the technical problem. ”

of inventive activity. In some cases, finding the technical problem causing a defect in the prior art or determining the reason why the defect exists would become the key to solving the technical problem. In the examination practice, the inventiveness judgment is judging the inventive step of the invention after it has been created, which is an *ex post facto* judgment, which may cause the person skilled in the art to substitute the technical problem, technical features, and the like disclosed by the invention into the prior art on the basis of understanding the inventive concept of the invention, thereby resulting in an incorrect conclusion of inventiveness judgment.

In order to avoid the introduction of subjective factors into the process of inventiveness judgment and the occurrence of the *ex post facto* view, it should be fully considered whether the person skilled in the art could find the technical problem and the technical defect on the basis of the closest prior art, whether there exists any technical inspiration or motivation to modify the closest prior art to solve the technical problem, whether there exists any technical inspiration or motivation to search for related technical means for implementing the above inventive concept, and whether the technical inspiration or teachings for applying technical means disclosed in another prior art to the closest prior art to modify the closest prior art is provided.

As above, in the case of not learning the technical solution of the invention, if the person skilled in the art would not realize the existence of the technical problem to be actually solved by the invention, they would not have been able to realize to adopt the distinguishing technical features to solve the technical problem, which means that the person skilled in the art would not have been able to generate any motivation to improve the prior art.

**2) Judgment on opposite technical teachings in the prior art**

The author thinks that the so-called "opposite technical teachings" means that the technical disclosure in the prior art is contrary to or different from the direction of improvement of the invention or the technical means in the prior art is contrary to or different from the distinguishing technical features of the invention, so that the person skilled in the art would not have been able to generate any motivation for being directed to the improvement of the invention based on the above prior art, and would so far as to be taken away from the improvement of the invention. For judging whether or not there exist any opposite technical teachings, an objective analysis on the relevant prior art should be performed from the perspective of the person skilled in the art.

If the relevant technical feature disclosed in the prior art is not closely related to other technical features, and independently plays the same role as the distinguishing features in the invention, the person skilled in the art would have been able to eliminate any technical content irrelevant to the technical problem to be actually solved, and extract the relevant technical feature from the overall technical solution to combine it with the closest prior art. This judgment result should be subjected to a comprehensive analysis under the overall environment of the prior art to judge whether there exists an application that enables the person skilled in the art to subjectively abandon the distinguishing technical features, and if the above conclusion cannot be reached from the technical teachings of the prior art, it cannot be concluded that there exist the opposite technical teachings in the art.

In judging whether the technical contents disclosed in the prior art contain the opposite technical teachings, it is generally considered that with regard to the technical problem to be actually solved, the person skilled in the art, after learning the disclosed technical contents, could determine that the prior art as a whole provides the technical teachings that the distinguishing technical features cannot be applied to the closest prior art so as to solve the technical problem existing therein, which would prevent the person skilled in the art from obtaining the claimed solution by combining the prior art or improving the prior art. If the disclosure of providing the opposite technical teachings could be found in the prior art, it can be proved that combining the prior art or improving the prior art to arrive at the invention is not obvious, which needs inventive effort.

Here, when the technical problems to be solved by the prior art and the invention are the same, if the mechanisms based on which the prior art and the invention solve the same technical problem are different from each other and the technical means for solving the above problem are substantially different from each other, it can be concluded that the prior art cannot provide the technical inspiration for the person skilled in the art to generate the technical motivation for improving the closest prior art to obtain the claimed invention.

**3) Determining the necessity of using the distinguishable features of the invention**

In the examination process, the examiner tends to extract each technical feature from the technical solution and compare each technical feature with the prior art one by one to find out the distinguishing technical features of the invention relative to the prior art. The examiner then determines if the prior art can provide the inspiration

“ It should be fully considered whether the person skilled in the art could find the technical problem and the technical defect on the basis of the closest prior art. ”

for solving the technical problem by reason of the distinguishing technical features being disclosed by other prior art and the functions thereof being the same or determining that the distinguishing technical features as general technical means or common knowledge in the art and the technical effects that can be achieved by the distinguishing technical features are foreseeable for the person skilled in the art. Such a determination process often ignores the correlation between the technical features of the invention and ignores the overall judgment of the inventiveness of the invention by taking the technical solution as a whole and combining the technical field, the technical problem to be solved, and the technical effect that can be achieved.

Here, the author believes that in the case of the prior art has adopted any technical means to solve the technical problem to be solved by the distinguishing technical features, and it is unnecessary to adopt any other technical means to solve the technical problem, the person skilled in the art could not get any technical inspiration from the prior art for generating the motivation to apply the distinguishing technical features to the prior art to improve the prior art.

**Conclusion**

As discussed above, the author considers that, according to the understanding of the *Patent Examination Guidelines* combined with a specific practice, the person skilled in the art can judge whether there exists any technical inspiration based on the technical problem from the above three aspects of whether there existing the technical problem, whether there existing the opposite technical teachings and the necessity of using the distinguishable features. However, in the specific strategy for arguing about the technical inspiration in the prior art, other analytical concepts, such as obstacles for a technical combination of the prior art and the like, may also be adopted. In conclusion, in judging whether there exists any technical inspiration in the prior art, the point is not whether the skilled person could have arrived at the invention by adapting or modifying the closest prior art, but whether they would have done so in the hope of solving the objective technical problem or in expectation of some improvement or advantage.

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# Object and procedure: patenting and industrial design in Russia

Alena Shokolenko, Trademark Attorney at Zuykov and partners, provides an overview of the process and requirements for patenting an industrial design in Russia, emphasizing the importance of novelty and originality in determining eligibility.

The uniqueness of an object's appearance can be legally protected by registration. The design of the appearance of an industrial or handicraft product can be protected as an industrial design.

An industrial design is granted legal protection if its essential characteristics are new and original.

The essential features of an industrial design include features that determine the aesthetic features of the appearance of the product, in particular the shape, configuration, ornament, combination of colors, lines, contours of the product, and texture of the material of the product.

Features determined solely by the technical function of a product are not protectable features under an industrial design.

An industrial design is new if the totality of its essential features, reflected in images of the appearance of the product, are not known from information that became publicly available in the world before the priority date of the industrial design.

An industrial design is considered original if its essential features are a result of the creative nature of the product's features. In particular, if, based on the information that has become publicly available in the world prior to the priority date of the design, there is no known solution to the appearance of a similar product that would produce the same general impression on an informed consumer as the industrial design reflected in the images of the product's appearance.

Legal protection as an industrial design is not provided to:

- 1) Solutions, all features of which are determined solely by the technical function of the product;



Alena Shokolenko

- 2) Decisions that may mislead consumers about the product, such as decisions regarding the manufacturer, place of production, or product for which the container, packaging, or label serves, are prohibited. This includes decisions that are identical to those specified in paragraphs 4-9 of Article 1483 of the Russian Civil Code. These decisions may create a similar general impression or include the specified objects if the rights to these objects were acquired before the priority date of the design, unless legal protection for the design is sought by the person with exclusive rights to such an object.

Consequently, if the product does not meet the criteria of novelty and originality, it will be impossible to patent such an object.

In Russia, registration of industrial designs occurs with the Rospatent. To begin the procedure, you must correctly fill out the application, which must contain the following information:

- An application for a patent for an industrial design indicating the author and the applicant, as well as the place of residence or location of each of them;
- A set of product images of up to seven pieces, giving a complete picture of the essential features of the industrial design that determine the aesthetic features of the product's appearance;
- A drawing of the general appearance of the product, a confectionery card, if they



The main purpose of this examination is to verify the claimed solution against the conditions for patentability of the industrial design that has been submitted.



are necessary to reveal the essence of the industrial design;

- A description of the industrial design.

The application can be submitted to Rospatent in paper or electronic form. Electronic filing of an application reduces the filing fee by 30%.

The procedure for registering an industrial design with Rospatent consists of two main stages: formal examination and substantive examination.

The formal examination of an application for an industrial design includes duty payment verification, checking the availability of application documents, verification of documents submitted upon request of Rospatent, and consideration of an application to withdraw an application/to transform an application for an industrial design, if such an application was submitted. Formal examination is carried out on the application without analyzing the essence of the industrial design.

Regarding images submitted in an application:

in accordance with paragraph 3 of Art. 1354 of the Civil Code, protection of intellectual rights to an industrial design is provided on the basis of a patent to the extent determined by the totality of essential features of the industrial design, reflected in the images of the appearance of the product contained in the patent for the industrial design. The specified requirement for images of the appearance of the product is aimed at ensuring that the images of the appearance of the product give a clear idea of the scope of the intellectual rights that the applicant is seeking and with which they will be issued a patent.

The description of an industrial design is intended to disclose the characteristics of the appearance of the product claimed as an industrial design, presented in the images, in verbal form. The description must contain: the name of the industrial design, essential features, characteristics of the purpose and scope of application of the industrial design, information about analogues, and an indication of the classification index of the industrial design according to the International Classification of Industrial Designs (ICD).

If, as a result of the initial inspection, the necessary documents are found to be submitted and comply with the requirements of the legislation of the Russian Federation, the applicant will be sent a notification of a positive result within two months of completing the verification of payment with a positive outcome.

After the successful completion of the formal examination, the substantive examination process begins. The main purpose of this examination is to verify the claimed solution against the

## Résumé

Alena Shokolenko is a Trademark Attorney at Zuykov and partners. Alena has a status of Trademark Attorney of Russian Federation (No 2561). She specializes in trademarks and service marks, including preparation and submission of applications, trademark renewal, and carrying out the trademark search.





conditions for patentability of the industrial design that has been submitted.

The substantive examination includes the following stages<sup>1</sup>:

1. Checking compliance with the requirement of industrial design unity;
2. Checking an object declared as an industrial design for compliance with the definition of the concept "industrial design";
3. Checking an industrial design for the content of features that are contrary to public interests, and principles of humanity and morality;
4. Checking an industrial design for the content of official symbols, names, or distinctive marks;
5. Checking the industrial design for the content of features that can mislead the consumer;
6. Checking the presence in the appearance of the product of signs determined solely by the technical function of the product;
7. Checking the novelty of an industrial design;
8. Checking the originality of an industrial design.

All of the above steps are carried out through an information search process, which aims to identify information that has become publicly available before the priority date of the industrial design, and which is relevant to the declared design.

If any non-compliance with the established

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**It is advisable to pay the fees for the first five-year period at the time of payment of the filing fee, since the patent will only remain in force for two years from the filing date.**  
 ”

requirements is identified, the Rospatent expert will send a request to the applicant. The applicant has three months to respond.

A positive outcome of the substantive examination is the decision to grant a patent for the industrial design. In this case, it is necessary to pay a registration fee.

The validity period of an industrial design patent is extended during the last year of each five-year period, while the total validity period of an industrial design patent cannot exceed 25 years. Patent maintenance fees vary depending on the year of validity. For example, it is advisable to pay the fees for the first five-year period at the time of payment of the filing fee, since the patent will only remain in force for two years from the filing date.

For an efficient design registration process, we recommend conducting a design search before filing an application to determine whether your product is eligible for patentability. Thus, you can reduce the risk of refusal of your application by Rospatent.

<sup>1</sup> Guidelines for the implementation of administrative procedures and actions within the framework of the provision of public services for state registration of an industrial design and the issuance of a patent for an industrial design, its duplicate (Electronic resource). Access mode: <https://rospatent.gov.ru/ru/documents/rucov-po/download>

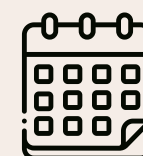
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# 2024 ANNUAL MEETING

LEVERAGING THE BOUTIQUE IP FIRM'S SWEET SPOT



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# UKIPO: 3-year strategy 2024-2027: IP for an innovative and creative UK

*The Patent Lawyer* sat down exclusively with Steph Dales, interim Strategy Director at the UKIPO, to discuss the IPO's refreshed strategy that sets out to assist with the growth of the UK economy.

#### Can you start by introducing yourself and your role at the UK intellectual property office (UKIPO)?

I'm Steph Dales and I have been the interim Strategy Director since January this year. I'm an economist by training and spent 10 years supporting policy development in analytical roles across Whitehall. I joined the IPO in 2015 and have since worked in both analytical and policy roles within the organization. Most recently, I led our organizational response to understand the impact of the Retained EU Law Bill on the IP framework and implement the subsequent legislative changes needed.

I am responsible for our planning as an organization, ensuring our governance remains effective and that our strategy and corporate plans allow us to realize our ambitions. I am also responsible for functions such as external communications, analysis, and our relationship with the minister's private offices. The connecting thread between these aspects is that they help the whole organization deliver in service of our mission and they help to frame and inform our future direction.

The diversity of my previous experience has helped me tremendously, and previous roles have afforded me an understanding of the breadth of the work across the IPO, which helps me to see decisions in context and make the linkages. My previous experience working on SME policy in government means that I see intellectual property as part of the wider set of interdependent strategic choices that businesses take daily, rather than something in isolation. One of my key areas of focus since joining the IPO is trying to demystify intellectual property, given it is a complex, sometimes legalistic topic but one that affects every major sector of our economy. This is so that citizens, users, and owners are







better informed about how best to interact with, protect, and exploit this important right.

**What is the mission behind the new strategy and what is the UKIPO hoping to achieve with its implementation?**

Our IPO strategy, *IPO 2027: IP for a creative and innovative UK* was published in May. It is a refreshed strategy, which will enable us to be clearer in our intent to meet challenges within a more rapidly changing landscape. Our new mission highlights and puts front and center the impact that IP has on the economy. **Our mission is to help people grow the UK economy by providing an IP system that encourages investment in creativity and innovation.**

As an organization, we want to continue to respond to the changing expectations of our customers, wider society, and our people. This refresh refocuses us to ensure we continue to have the desired impact for the economy and society, recognizing the importance of what we do. The work we do in granting IP protections and advising on IP policy has a direct and material impact on the UK economy. The more effective we are as an organization, the more benefit we bring to creators and innovators, and the bigger the impact we have.

We are an ambitious organization and there is so much we want to achieve. But to do this, we need to prioritize our work effectively. This strategy helps us be clear in how we do this.

**Can you detail the overarching objectives for the strategy?**

The strategy will help us to make choices over where to put our energies and be clear on the actions and culture that will help us to deliver on our mission over time. It has three pillars that will help us prioritize, plan, and perform for our customers and society.

“**Our mission is to help people grow the UK economy by providing an IP system that encourages investment in creativity and innovation.**”



Steph Dales

## Résumé

**Steph Dales** joined the IPO in 2015 and has held both analytical and policy roles within the organization. Most recently she was Deputy Director for Strategic Policy and Legislative coordination. She became interim Director of Strategy in January 2024.

Steph has worked in several Whitehall departments as an economist since 2005, including roles within private office and an independent review of the postal services sector. Her economics roles have encompassed both macro and micro perspectives covering the economics of adult skills, productivity and small and medium sized enterprises. In 2021 she completed an Executive Masters in Public Policy at the London School of Economics. She has a degree in Economics from the University of Durham and a Masters Degree in Economics and Development Economics from the University of Nottingham.

We are not aiming for a change of direction, because we are building on strong foundations, amplifying the things that are successful, but looking to improve where we can. There is a renewed focus on whether the activities we invest in provide the greatest impact and deliver the best value for money. The strategy sets out an overarching focus on helping people use IP to grow the economy. In doing so we will look to enable innovative SMEs to use IP to prosper and grow as this will boost innovation across the UK economy. Approaches that contribute to net zero outcomes and innovation will also be pivotal to our own operations, and our approach to new policy development.

We are operating in a complex and challenging environment. If we are to succeed in our mission, we must focus on where we can achieve the greatest impact – boosting investment and innovation in technologies and sectors. And where we can, we must help others to grow the economy through IP.

**Can you explain the three pillars for delivering this new mission?**

The strategy is focused on the services we provide, the policy we develop, and the people who make it happen. The three pillars support this and the use of a triangle, the strongest geometric shape, to depict the strategy within our organization is no accident.

Our three pillars each have three strategic goals beneath them within which we have focused on what we are trying to achieve, and how we will do it, but the primary focus is on having the right outcome to aim for. There is also a corporate plan for this first year of the new strategy which sets out in more detail what we will deliver.

The first pillar relates to services and the goals under it look to our transformed services and how we support businesses in using them and IP more broadly.

The second pillar relates to our policy for the IP Framework and enforcement under it. It is more pragmatic in what we are aiming for domestically and internationally.

The third pillar targets consistent high-performance through our culture, improved governance, and planning, all with sustainable finances. When you consider the impact of the three collectively, they add up to more than the sum of their parts, with strong reinforcing interdependencies and complementarities between them.

**How will the new strategy aid with the protection of IP in the AI landscape?**

Making sure the IP system adapts, so that it can provide the right incentives and the appropriate

breadth of protection for new types of technology is always challenging. This is even more true when we have the incredible rate of development that we are seeing in the newly burgeoning AI sector.

We are working across all rights areas to make sure we fully understand the implications that AI has for the IP system and the IPO, but also to ensure that the IP framework itself fully supports government ambitions.

This is a difficult and fast-moving policy area, and one that requires careful consideration and balance of competing interests. This strategy helps us navigate this difficult policy landscape by setting out a clear mission – to provide an IP system that encourages investment in creativity and innovation.

Where there are trade-offs to be made, or a balance to be struck, having such a clear overall direction of travel is invaluable when formulating policy positions and provides a consistent framework to discuss those positions with Ministers and stakeholders.

The new strategy also emphasizes the need for our staff to be adaptable. This is increasingly important as the policy work we do in rapidly developing areas like AI can require changes of direction or tackling new challenges in quite compressed timescales. We need staff who feel comfortable working in that way.

**How will the strategy assist SMEs, start-ups, and scale-ups?**

Our strategy recognizes the importance of SMEs to the UK economy because IP protection is positively associated with various indicators of business success. We want to play our part in helping more SMEs thrive and grow whether that be through their experience of using us to protect their ideas, or to assist their understanding of how they can respect the ideas of others. I think we forget when we have worked in the field for a while quite how complex intellectual property can be to understand the first time you come across it.

In terms of the pillars, we aim to provide efficient, timely, and accessible IP registration services. For SMEs, start-ups, and scale-ups, this means smoother processes for registering IP rights. Streamlining our processes and improving our services via our transformation program will reduce the costs associated with registering and protecting rights, making it easier for businesses to safeguard their intellectual assets.

We provide tools and support to empower businesses to make informed decisions about their IP strategies, helping them thrive in competitive markets.

Our policy pillar focuses on encouraging innovation in the UK. This includes ensuring that UK law incentivizes innovation and creativity,

“**We provide tools and support to empower businesses to make informed decisions about their IP strategies, helping them thrive in competitive markets.**”

which can directly benefit businesses. Clear and supportive IP policies create a favorable environment for firms to develop and commercialize their IP, as they can confidently navigate IP regulations knowing their rights are protected.

We also work to shape an international IP system that supports innovation, which will benefit SMEs, start-ups, and scale-ups with global ambitions.

This ensures that their IP rights are respected not only within the UK but also in international markets. This is crucial for businesses looking to expand globally, as it provides assurance that their innovations are protected wherever they operate.

The IPO has a network of IP attaches, experts based in priority countries around the world who are at the heart of delivering on our international objectives overseas. Our attaches support UK rightsholders seeking advice on local IP matters, and liaise with host governments and stakeholders on local and international IP regimes.

We currently have attaches operating in China, India, ASEAN, USA, Latin America, and Europe, with two attaches also based in UKMIS Geneva for the World Intellectual Property Organisation (WIPO) and the World Trade Organisation (WTO).

The combination of the support we offer to SMEs through our rights granting and other services, our work supporting those exporting overseas and looking at what we can do to help firms unlock their investment in IP, all add up to a system which aims to help SMEs make the most of the ideas and innovation they are creating.

**Can you tell us about the increased demands on services at the UKIPO and how this has shaped the 2024-2027 strategy?**

For some of our registered rights (trademarks and designs in particular), we have seen massive increases in demand for these rights since the UK left the EU. This has also led to very high volumes of work at the IPO Tribunal.

For trademarks, this year has been the second highest year on record for filings, surpassed only by 2021/22 when we exited the European Union and many European trademarks had to be transferred into UK trademarks. In the Tribunal, the number of live cases is roughly double what it was before 2016.

For patents, demand has not increased so steeply, and the picture is more complicated because UK patents can also be obtained from the European Patent Office, but requests for patent examination and grant by the IPO are at their highest level for decades.

Of course, this level of increased demand also comes against an ongoing backdrop of wider change – across society, in technology,



and the global economy. An ongoing challenge is to ensure that we, as an IP office, can continue to adapt where we need to. We need to embrace the opportunities in a way that helps our customers to flourish.

Accurate, evidence-driven forecasting is an important enabler. To continue to have enough capacity to respond to this new demand we have improved the way we forecast, recruit, and how we quality assure our products too. We are about to launch a new quality assurance method – making use of new real-time sampling methodology – the results of which will be included within our customer service standards information.

Ultimately, as our strategy sets out, it's about ensuring we take the right steps and ensure we are a high-performing organization. We believe this work will put us in a great position to make good on our mission.

To sum up, our job is to provide the best possible customer experience, adding value to our economy and society.

Our strategy sets out how we'll remain focused on achieving this, in an environment where – at the risk of sounding clichéd – the one constant is change.

**How do you feel the UKIPO is shaping up in comparison to other Intellectual Property Offices?**

Internally, one of the core strengths that makes the IPO pretty unique is that we benefit from having policy and operations for all IP rights together in one organization. This is not the case for many other offices.

So, what we have is the benefit of our collective expertise and capability across many areas, including operations, digital, legislation, and communications teams working closely together. This helps us to be agile in how we respond to our customers' needs, and co-ordinated in how we deliver a balanced and effective IP framework. It's part of what we mean by being a connected organization – a wealth of expertise across specialisms, unleashed in service of our mission.

We attach a huge amount of importance to collaboration – both internally and with our partner organizations across government, industry, law enforcement and around the world. The high regard in which we're held globally really does reflect this. I'm proud that the UK continues to be recognized as a role model for its intellectual property standards, scoring highly in the recent US Chamber of Commerce IP Index report – which highlighted the UK's sophisticated IP environment, and injunctive-style relief for rightsholders battling online infringement as particular strengths.

We invest a lot of our effort working with other IP offices to share best practice and learn from

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**To continue to have enough capacity to respond to this new demand we have improved the way we forecast, recruit, and how we quality assure our products too.**  
 ”

one another, helping build a global IP system that benefits its users. Just recently, we've supported examiner training in South Africa and China, and – as a founder member of the European Patent Organization – we also work through forums like the Vancouver group and G7.

Effective partnerships such as these enable us to play a leading role in developing a stronger IP system globally. Our team in Geneva is closely engaged in discussions at the WTO and WHO to support our IP objectives throughout the UN system, complementing our work with WIPO to support other IP offices. Our attachés and international teams, while supporting British businesses exporting to other countries, are also engaged closely with other IP Offices. All these activities help us to maximize our impact globally, and to uphold a rules-based approach to advancing and protecting IP throughout the world.

We've all experienced some pretty seismic shifts in the global economy since we published our last strategy – and at the same time we've all had to develop and adapt to new ways of working, with new technologies continuing to evolve at pace. Effective collaboration will remain crucial to continued success, and our partners ultimately share similar goals to ourselves. Working with them to help deliver our mission – and embrace the opportunities that lie ahead – is, for me, a big part of what makes the IPO – and the wider world of IP – an exciting and stimulating place to continue to want to work.

*This interview took place prior to the call for the UK General Election.*

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UK IPO

[www.gov.uk/government/organisations/intellectual-property-office](http://www.gov.uk/government/organisations/intellectual-property-office)



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