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Annual 2025

From ideas to impact: enhancing patent transfer in Chinese universities

Eddie Zheng, Partner at Corner Stone & Partners, highlights the challenges and progress in patent transfer and transformation at Chinese universities in light of the introduced policies to promote the commercialization of research.

2024 in review

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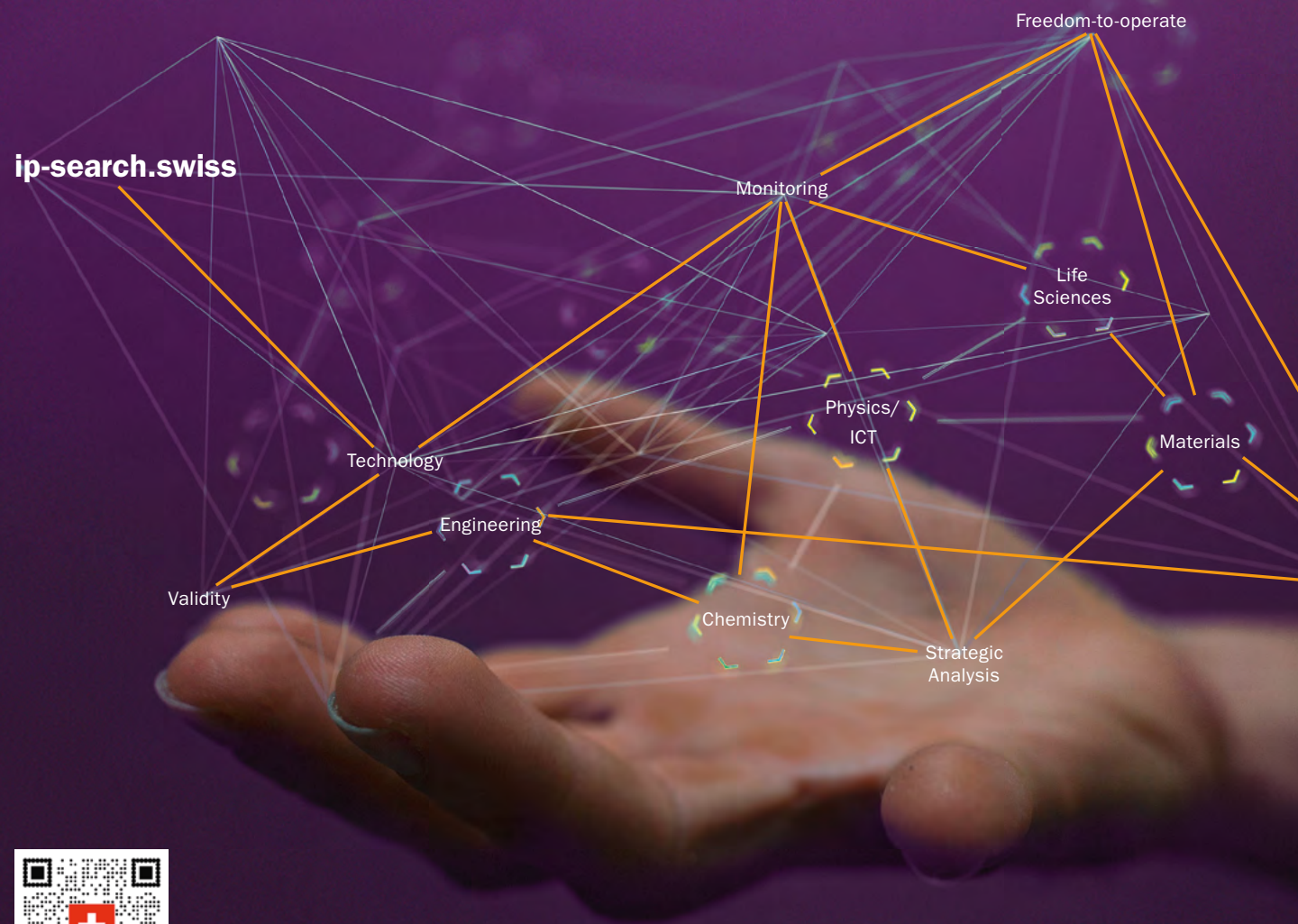
Patent protection for digital twins

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Editor's welcome



Welcome to *The Patent Lawyer Annual 2025*. We kick start this issue with reflection from our Editorial Board, whose perspectives provide a foundation for understanding the evolving IP landscape as we head into the new year.

Our cover story features an in-depth examination of the ongoing challenges and progress surrounding patent transfer in Chinese universities. With recent policies aimed at enhancing the commercialization of research, we shed light on the transformative potential of these initiatives.

“
A foundation for understanding the evolving IP landscape.
”

Further, we explore the advantages of means-plus-function claims, suggesting these claims might be poised for a resurgence in patent law; offer an evaluation of the patentability of digital twins, considering their evolution and potential impacts; present on legal standing in patent invalidation procedures; and delve into the criteria of inventive step as a cornerstone of patentability, analyzing various influences on its determination across different jurisdictions.

Our jurisdictional briefings provide essential updates covering the significant fee changes at the Russian Patent Office and the Federal Circuit's latest overhaul of the obviousness test for design patents. From here, we continue with practical guidance on applying for design patent protection in the US; provide clarity on Mexico's evolving patent law concerning divisional applications and the challenges applicants face in this shifting environment; address the recent Federal Circuit ruling that narrows the printed matter doctrine; and explore the requirements for claiming punitive damages in patent infringement within the framework of Chinese law.

Our *Women in IP Leadership* segment features Amy Gagich, Senior Manager in Product Management (IP) at Clarivate, and Konnie Love, Senior Manager of IP Administration at Kilpatrick. Special thanks to the segment sponsor, Clarivate.

Lastly, we reflect on the importance of fostering a Culture of Happiness within teams, sharing valuable insights on creating a positive and collaborative work environment.

All the very best for 2025 and beyond!

Faye Waterford
Faye Waterford, Editor

Mission statement

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

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Pravin Anand: Managing Partner, Anand & Anand. India

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



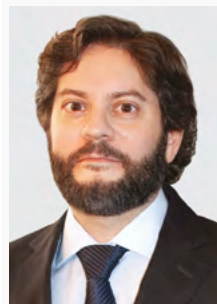
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Rafael oversees the Patent, Trademark, Copyright, Plant Breeder's Rights, Internet, and Enforcement Groups. Served in the Mexican Association for the Protection of Intellectual Property AMPPI, AIPPI Mexican group. Current Vice-Chair of AIPPI's Standing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



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



Eugene Goryunov: Partner, Haynes & Boone. United States

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



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



Stefan Schohe: Founder, SCHOHE. Germany

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



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

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



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

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



Osamu Yamamoto: Partner, Yuasa & Hara. Japan

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

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

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2024 in Review

As we enter a new year, we asked our Editorial Board to share their insights on the key takeaways from 2024 that will shape important developments in IP practice for 2025 and beyond.

The following overviews highlight significant developments in intellectual property law across various jurisdictions, showcasing the dynamic landscape of patents and trademarks:

Canada's Patent Office plans new regulations for patent term extensions starting January 1, 2025, following a court ruling against generic companies. In China, digital intelligence is transforming trademark legal services, boosting efficiency for practitioners. The German Federal Court clarified that non-infringing activities can still lead to damages claims in patent infringement cases. The European Commission expressed concerns about the Munich court's interpretation of SEP licensing negotiations, emphasizing balanced assessments regarding implementer behavior.

In India, the Delhi High Court sided with Pioneer Overseas Corporation in a plant variety infringement case, upholding breeders' rights and the importance of scientific evidence. Japan is handling a case where a plaintiff alleges infringement of a breast augmentation patent, with the Intellectual Property High Court set to rule on its validity and the definition of "production." The UK patent litigation market remained active in 2024, focusing on life sciences, technological advancements, and FRAND disputes, with significant rulings expected on mRNA patents and AI patentability.

Lastly, recent US Supreme Court decisions may limit the USPTO and Copyright Office's rulemaking powers, leading to more judicial scrutiny and litigation challenges.

We would like to take this opportunity to thank our Editorial Board for their continued support and hard work throughout the year. Please visit page 6 to familiarize yourself with each member's profile.

If you would like to learn more about our Editorial Board or apply for 2026, please visit www.patentlawyermagazine.com/editorial-board-applications/

A review from Canada

Noel Courage, Smart & Bigger

In the renegotiated free trade agreement between Canada, the US and Mexico (2018), there was a requirement to create patent term extension for patent office examination and processing delays. This is a benefit to patent owners. Such patent term extensions have existed in US patent law for many years, but are totally new in Canada. In May 2024, the Canadian Patent Office published proposed regulations for patent term extension due to patent office delays. Prior patent Act amendments had set out the framework and now these draft regulations fill in proposed details.

The regulations provide process and fee amounts for applying for an additional term. They also set out rights to apply for reconsideration of an additional term, and for maintaining the patent during the additional term. The proposed amendments are expected to come into force on January 1, 2025, and the date the first eligible patents may receive an additional term is December 2, 2025. Typically, CIPO has been making very little amendments to published draft Patent Act regulations, so it is quite likely that the final regulations will be similar to those published.

In other news in favor of patent owners, the Federal Court of Appeal has dismissed two appeals finding that generic companies induced infringement of claims to a dosing regimen. The generic companies had attempted to assert that they would not infringe a patent for Janssen's paliperidone palmitate because they were not requesting approval for the patented 75 mg strength syringe.

A review from China

Gang Hu, China Patent Agent (H.K.) Ltd.

In 2024, the world is facing greater challenges and uncertainties. But life and work still need to continue. As the French writer Alexandre Dumas said, all human wisdom is contained in two words: waiting and hope. During this year, a noteworthy trend in China is that the impact of digital intelligence on trademark legal services has attracted wider attention within the industry. The so-called digital intelligence refers to the ability to use digital technology and data-driven methods to achieve intelligence, automation, and optimized decision-making. It combines technologies such as artificial intelligence, big data analysis, and machine learning to provide deeper insights and intelligent decision support for enterprises through the collection, organization, and analysis of large amounts of data. On the one hand, the application of digital intelligence has replaced many basic tasks in the trademark legal services industry, reducing human errors and improving efficiency. On the other hand, the wave of digital intelligence has also brought new formats, scenarios, and technologies to the trademark legal services industry. These matters have profoundly changed the traditional industry landscape. For example, to improve the efficiency and accuracy of trademark similarity comparison and analysis by applying new technologies such as artificial intelligence and big data; to use the tamper-proof nature of blockchain technology to track and fix evidence of trademark and copyright infringement more effectively on the Internet; to provide customers with market trend analysis and brand strategy planning services through big data analysis. It can be said that in the era of digital intelligence, the emergence of new formats and scenarios has provided more business opportunities and development space for China's trademark legal service industry. At the same time, it also urges trademark practitioners to continuously learn and master new technologies in order to actively adapt to the development needs of the industry.

A review from Germany

Stefan Schohe, Schohe

Non-infringing activities are commonly considered safe harbors regarding patent claims. As the German Federal Court of Justice (FCJ) held in two recent decisions (X ZR 30/21 of Nov 14, 2023 and X ZR 104/22 of May 7, 2024), this is not entirely true for damages. Also non-infringing activities may cause a claim for damages and the provision of related information and accounting.

In the first case, leasing agreements related to infringing machines continued beyond the lapse of the patent and the defendant provided consumable material for these machines before and after the lapse. The FCJ acknowledged a claim for the provision of information and accounting. It held that damages serve to compensate for the unlawfully seized and exploited market opportunity provided by the patent and the infringer had to return any profits for which the infringement was causal due to the specific features of the patented product. This extends to profits from a long-term lease after the lapse of the patent and to revenues from the sale of consumable materials.

In the second case, the defendant offered the installation of a patented machine in Sweden, where the patent had lapsed, from Germany. The court held that although the later installation in Sweden was not a patent infringement, the related profit was the consequence of an infringing offer and contributed to the damages as the offer was made from Germany and not in Sweden.

In both decisions, the court emphasized that only the profit due to the specific features of the patented product had to be returned, but nevertheless granted an unrestricted claim to information and accounting to enable the patentee to determine the extent of damages.

Even non-infringing activities can be the subject of damages claims if related to patent infringement, and an unrestricted claim for accounting and information will be granted if this is conceivable. Information and accounting may be a value, even if related damages turn out to be small or non-existent.



A review from Germany

Dr. Claudia Tapia, Ericsson

In *Huawei v ZTE*¹, the CJEU established a framework for license negotiations of SEPs, available on FRAND terms. The European Commission (EC), in its recent Amicus Brief for *HMD v. VoiceAge*², raised concerns that the Munich court may have misinterpreted this framework by overemphasizing the implementer's conduct when deciding on whether to grant an injunction. The EC advocates for courts to evaluate the SEP user's willingness to obtain a FRAND license³ based on their initial declaration, even if subsequent actions reflect bad faith. If this interpretation were adopted, SEP owners could more frequently find themselves negotiating in a vacuum. They would have to make FRAND offers without vital information, typically shared under an NDA in good faith negotiations. This would undermine the CJEU framework, which is designed to foster good faith licensing negotiations. In light of this, the Munich court will probably continue issuing injunctions in clear instances of bad faith regardless of the implementer's initial declaration – such as against implementers refusing to negotiate or delaying counteroffers for over a year. As the Bundesgerichtshof (Federal Court of Justice) noted in *Sisvel v Haier*, when bad faith behavior is established, the existence of a FRAND offer will typically not be decisive, as it does not impact the party deemed unwilling to negotiate.

As some implementers increasingly adopt sophisticated strategies to postpone negotiations and devalue FRAND, distinguishing between willingness and unwillingness becomes less straightforward. In these scenarios, courts are likely to consider the SEP owner's FRAND offer to the necessary extent, alongside both parties' overall conduct throughout negotiations. Such an approach would help courts determine if adjustments to the standard for assessing the implementer's behavior are necessary while ensuring a balanced outcome.

Disclaimer: Dr. Claudia Tapia, LL.M is Head of Global IPR Policy Research & Academic Relations at Ericsson and President of 4iP Council. The views expressed in this article are those of the author alone and do not necessarily represent the views or positions of Ericsson, any of its affiliates, or any employee thereof, or the views or positions of 4iP Council or any of its supporters.

¹ <https://eur-lex.europa.eu/legal-content/en/TXT/?uri=CELEX%3A62013CJ0170>

² https://competition-policy.ec.europa.eu/antitrust-and-cartels/national-courts/amicus-curiae-observations_en

³ <https://caselaw.4ipcouncil.com/guidance-national-courts>

A review from India

Pravin Anand, Anand & Anand

On Sept 20, 2024, the Delhi High Court ruled in *Pioneer Overseas Corporation v. M/s Evercrop Agro Science & Star Agrotech Pvt. Ltd.* (CS(COMM) 759/2024), a significant case addressing plant variety infringement under the Protection of Plant Varieties and Farmers' Rights Act, 2001 (PPV&FR Act). This law grants breeders exclusive rights over the registration, production, and commercialization of plant varieties. Any unauthorized use constitutes infringement, under S.64 of the Act, entitling the aggrieved party to injunctive relief, damages, and restitution.

Plaintiff, whom I represented, alleged infringement of its maize variety 'P3355' and parent lines and sought an injunction, damages, and an account of profits. Defendant No. 1 conceded Pioneer's rights and agreed to cease the infringing activities, while Defendant No. 2 disclaimed involvement. Consequently, the court ruled in favor of the plaintiff, granting injunctive relief, but Pioneer waived its claims for costs and damages.

This ruling strengthens breeders' rights under the PPV&FR Act, signaling that courts will likely grant swift interim and permanent injunctions to protect breeders' exclusive rights.

Moreover, the case may shape future jurisprudence by promoting more rigorous enforcement of breeders' rights while addressing the delicate balance between innovation and farmers' rights. Courts may more carefully delineate between permissible non-commercial use by farmers and unauthorized commercial exploitation of protected varieties.

The reliance on scientific evidence, such as DNA fingerprinting and molecular markers, is likely to play a more significant role in future plant variety infringement cases. Courts may develop a structured framework for weighing expert testimony and scientific evidence such that disputes are resolved based on solid, scientific proof of infringement.

While not a member of the UPOV Convention, India's legal framework under the PPV&FR Act is aligned with its principles; future Indian jurisprudence may increasingly follow international norms.

A review from Japan

Osamu Yamamoto, Yuasa & Hara

The procedure of calling for third-party opinions, the Japanese version of *amicus curiae*, was introduced on April 1, 2022, in patent and utility model infringement suits. In the second case, relating to cosmetic medical technology, the Intellectual Property High Court (IPHC) issued a request for opinions with a deadline of September 6, 2024.

Claim 1 of the plaintiff's patent JP No. 5186050 is "A composition for promoting subcutaneous tissue increase, characterized in that the composition comprises autologous plasma, basic fibroblast growth factor (b-FGF) and fat emulsion." Note that, currently, an invention for treating a human is not patentable subject matter, and it is therefore obligatory to try to obtain patent rights for an invention of a "product," even if it is essentially a method invention.

The plaintiff claimed that the hematopoietic breast augmentation surgery performed by the defendant at the clinic constituted patent infringement and demanded compensation for damages. One of the disputed issues at the Tokyo District Court (TDC) was whether the defendant had produced the "composition" for promoting subcutaneous tissue increase, as recited in Claim 1, which contains autologous plasma.

The TDC denied patent infringement. The plaintiff appealed to the IPHC.

The IPHC issued a request for opinions on the issues including: (1) "Should the patent be invalidated by an invalidation trial as being "an industrially inapplicable invention" under Article 29(1) of the Patent Act?" and (2) "In case the appellant uses the drug containing some of the ingredients as recited in Claim 1, and uses the drug containing the rest of the ingredient as recited in Claim 1 separately for surgery, and all of them are mixed in the body of the subject, does the surgery by the appellant constitute "production" of the "composition" of the invention?"

We expect that an IPHC decision will be issued next year. Considering the development and diversification of medical-related technologies and related businesses, it is strongly expected that the Patent Act will be amended to address the issues by expanding the scope of patentable subject matter and clarifying the exemption for physicians' acts.

A review from the UK

Sarah Taylor, Pinsent Masons

The UK patent litigation market remained buoyant in 2024, with courts delivering accessible and considered decisions, reflecting evolving socioeconomic and technological issues.

Life sciences disputes continue with increasing demands on health budgets. The courts heard battles over mRNA patents that underpin Covid vaccines, with Pfizer/BioNTech's reliance on Moderna's pledge not to enforce its rights against Covid vaccine manufacturers determined to be an unusual partial infringement defense¹. Biosimilar disputes have featured, with the High Court revoking² Janssen's European patent, allowing Samsung to launch its biosimilar ustekinumab product.

UK courts led the debate on AI patentability. While the Court of Appeal (CoA) ruled³ that that Emotional Perception's artificial neural network music recommendation tool did not make a technical contribution and was not patentable, the discussion will continue with an appeal to the Supreme Court.

The UK continues to be a busy FRAND litigation forum. The CoA's landmark ruling that Lenovo should pay royalties for all past sales, but that the trial judge's reasoning in determining the per-unit royalty rate was flawed likely due to the length of time it took to deliver the decision, has led to expectations of shorter periods from trial to judgment, particularly with a backdrop of speedy UPC decisions.

The UK courts' willingness to navigate complex international landscapes in FRAND disputes again came into focus. The CoA refused Lenovo's conditional PI application⁴, it being merely to induce Ericsson to not enforce injunctions in Brazil and Colombia, and granted Xiaomi an interim license, with Panasonic found to be using parallel UPC and German proceedings to coerce Xiaomi into accepting less favorable terms. The consequent stay of the parallel UPC proceedings highlights the interplay with UK actions. As the number of disputes with both UK and UPC proceedings increases (*Abbott v. Dexcom; Advanced Cell Diagnostics v. Molecular Imaging*), this interaction will become more important, with the UK maintaining a leading strategic role in multi-jurisdictional disputes.

¹ *Pfizer & BioNTech v. Modernatx* (2024) EWHC 1965 (Pat) & *Modernatx v. Pfizer & BioNTech* (2024) EWHC 1648 (Pat)

² *Samsung Bioepis v. Janssen Biotech* (2024) EWHC 1984 (Pat)

³ *Comptroller v. Emotional Perception* (2024) EWCA Civ 825

⁴ *InterDigital v. Lenovo* (2024) EWCA Civ 742

⁵ *Motorola & Lenovo v. Ericsson* (2024) EWCA Civ 1100

⁶ *Panasonic v. Xiaomi* (2024) EWCA Civ 1143

A review from the USA

Mark G. Bloom, CLP®, RTTP™,
NSABP Foundation, Inc.

Although not IPR cases *per se*, the US Supreme Court's decisions in *Loper Bright Enterprises v. Raimondo and Relentless, Inc. v. Dept. of Commerce*¹ could have far-reaching consequences for the administrative frameworks governing the USPTO and the US Copyright Office. In these decisions, the Court considered the limits of agency authority to statutory interpretation and rulemaking, addressing critical issues related to the separation of powers and the degree of deference afforded to administrative bodies.

The rulings potentially narrow the scope of discretion for agencies such as the USPTO and the Copyright Office, signaling a shift toward more rigorous judicial scrutiny of their rulemaking and adjudicative functions. Central to the Court's analyses was whether these agencies can extend their authority beyond clearly defined statutory boundaries, with implications for how administrative bodies interpret and apply IP law.

These rulings may prompt the USPTO to reevaluate its approach to rulemaking, particularly when navigating complex areas like patent eligibility, *inter partes* reviews, and trademark disputes. If courts adopt a more aggressive stance in reviewing agency decisions, the USPTO could face increased litigation risks and procedural challenges. The decisions also raise questions about how the office might adapt its operations to ensure that new rules and guidelines withstand judicial scrutiny.

The Copyright Office may encounter heightened legal challenges when establishing new regulations or enforcing its interpretations of copyright law. The opinions suggest that courts will closely examine the statutory basis for agency actions, potentially curbing the Office's ability to introduce flexible interpretations of the Copyright Act. This could affect initiatives such as modernizing digital copyright enforcement and expanding protections for emerging technologies.

These two cases set a precedent that limits the latitude of administrative agencies, likely leading to a more constrained, judicially overseen regulatory environment at the USPTO and Copyright Office.

¹ *Loper Bright Enterprises v. Raimondo, Secretary of Commerce, et al.*, No. 22-451 and *Relentless, Inc., et al. v. Department of Commerce, et al.*, No. 22-1219.

IP

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Bulgarian & European Trademark & Design Attorney



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A Foundation to Your Success



From ideas to impact: enhancing patent transfer in Chinese universities

Eddie Zheng, Partner at Corner Stone & Partners, highlights the challenges and progress in patent transfer and transformation at Chinese universities in light of the introduced policies to promote the commercialization of research.

The China Patent Investigation Report released by the China National Intellectual Property Administration (CNIPA) shows that the industrialization rate of China's effective invention patents is lower than in developed countries despite its steady increase, and the licensing rate of China's effective invention patents is even lower. This long-standing problem hinders China's scientific and technological innovation and economic development. The Outline for Building an Intellectual Property Powerhouse (2021-2035), issued jointly by the Central Committee of the Communist Party of China (CPC) and China's State Council, set a strategic goal of building a world-class intellectual property powerhouse with Chinese characteristics. The outline proposes to improve the operating mechanism of the intellectual property market, open up the channels of patent transfer and transformation, and bring into play high-value patents' active role in leading innovation and activating the market in the course of their transfer and transformation, to shift from the pursuit of quantity to the improvement of quality.

China's colleges and universities are important contributors to the creation of patent technologies and achievements. The data on CNIPA's website indicate that, by the end of 2023, the number of effective invention patents owned by colleges/

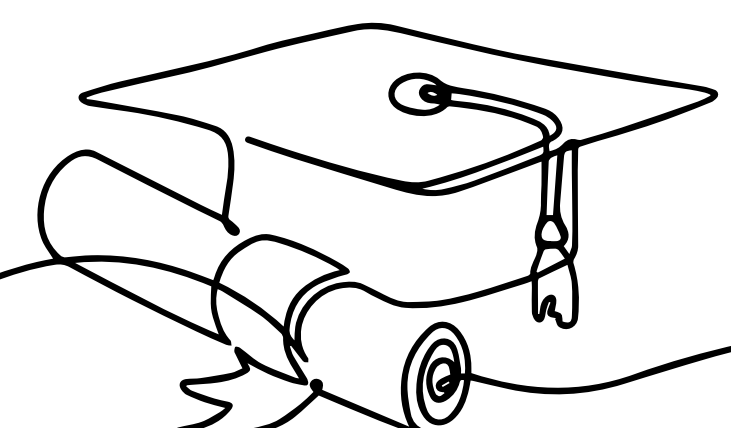


Eddie Zheng

Résumé

Eddie Zheng, Partner

Eddie is both a Patent Attorney and an Attorney-at-Law and has been working in the field of IP since 2007. He has a very strong professional background and rich experience in the field of telecommunications. Before joining Corner Stone & Partners, he previously worked as a Patent Examiner at the China Patent Office. He served as a Senior IP Manager at DaTang Telecom, IP Director at VIPKID, and Partner at the top Law Firm in China. Eddie has dealt with or participated in hundreds of important intellectual property dispute cases.





universities and research institutions in China had reached 794,000 and 229,000, respectively, accounting for a quarter of the total number of effective inventions patents in China. It is important to sort out and revitalize those valuable but idle patent technologies created by colleges and universities in China.

To accelerate the transformation of the research results developed by colleges and universities into actual productive forces, the Chinese government has successively introduced a number of policies and measures to encourage and support technology transfer in universities and research institutions. Several Opinions on Implementing the Distribution Policy Oriented to Increasing Knowledge Value issued in 2016 propose to improve the income distribution mechanism for the transfer and transformation of scientific research results to ensure that inventors or invention teams obtain reasonable economic returns. The Intellectual Property Management Standards in Colleges and Universities (2017) issued in 2017 require colleges and universities to establish and improve the intellectual property management system, strengthen patent applications

and maintenance, and encourage commercial exploitation of patent technologies in many modes. Several Opinions on the Deepening Institutional Reform and Accelerating Implementation of the Innovation-Driven Development Strategy issued in 2019 further strengthen the support for technological innovations, especially in key technology fields, aiming to enhance the overall innovation capability of China. In 2024, the Chinese government formulated another two policies, namely The Work Plan for Revitalizing Existing Patents of Universities and Research Institutions and The Implementation Plan for the Scheme to Promote the Growth of Small and Medium-sized Enterprises through Patent Industrialization, with the aim of jointly facilitating patent technologies' and research results' being transformed into real productive forces better and faster by means of the synergy between the market and the government. The introduction of these policies not only identifies the clear direction for China's colleges and universities but also creates favorable conditions for the transfer and transformation of patent technologies created by the colleges and universities.

With the support from the government and the efforts of colleges and universities themselves, the colleges and universities in China have had some achievements in patent technology transfer and transformation. According to official statistics, by the end of 2023, more than 250 colleges and universities in China had set up specific technology transfer centers or similar departments and had made more than 1.2 million technology contracts with a value of over CNY 1 trillion. Notwithstanding, a number of problems remain to be solved in terms of the actual operation of the transfer and transformation of patent technologies created by colleges and universities. First, the transformation efficiency is not high. Although colleges and universities have a large number of high-quality granted patents, many research results fail to match suitable market demands in time due to the lack of an effective engagement mechanism, which leads to low transformation efficiency. Second, investment is insufficient. A project requires great financial support, from lab research to commercialization. At present, many universities have limited investment in this area, which impedes the progress of projects. Third, legal protection is not perfect. Although relevant laws and regulations are in place, their enforcement is ambiguous sometimes, which puzzles the stakeholders concerned. Fourth, professionals are short. Technology transfer is a complex process involving many professional activities, such as

technology evaluation and market analysis. However, the professionals in this field are insufficient or inadequate in China at present.

To address the above problems, the Chinese government introduced the patent open licensing system in 2021. This is a new patent licensing system in China that aims to simplify the patent authorization process and reduce transaction costs. With this system, any eligible patentee may voluntarily make an open licensing statement before the CNIPA that they are willing to license any entity or individual to exploit their patent instead of monopolizing it, and the licensee can acquire the right to exploit the patent by simply paying the licensing fees specified. The patent open licensing system features the following: First, it simplifies the procedure. Compared with the traditional 'one-to-one' negotiation mode, the open licensing system adopts a 'one-to-many' mode, which greatly simplifies the authorization procedure and reduces the time and labor costs. Second, it increases transparency. All information concerning the patent open licensing will be published on the official platform to increase transaction transparency and facilitate a quick match between the supply and demand sides. Third, it is flexible and specific. The patentee may lay down specific licensing conditions, such as geographical scope and exploitation period, so as to better meet the needs of different licensees. Fourth, it offers incentives. For those patents that have no clear path to commercialization for the time being, open licensing may get them displayed to attract the attention of potential partners.

Since its inception in China, the patent open licensing system has played an important role in the transfer and transformation of patent technologies created by the colleges and universities of China. First, it has improved the transformation rate. Through open licensing, many patents that stood idle have been revitalized and got to be exploited. According to statistics, by the end of 2023, more than 20,000 patents had participated in the open licensing program in China, and about one-third of them had been successfully transferred or licensed. Second, it has promoted cooperation among industry, university, and research. Open licensing lowers the threshold of small and medium-sized enterprises' acquiring advanced technologies to enable more enterprises to seek cooperation with universities and jointly develop new products and work out technical solutions. For example, a patent on new material held by Tsinghua University attracted the attention of quite a few enterprises through open licensing, and finally, Tsinghua University reached a cooperation agreement with a leading manufacturer in China. Third, it has enhanced China's international influence. Some high-tech patents have attracted the attention of overseas

“ It has optimized the allocation of resources. ”



enterprises, thus promoting technical exchanges and cooperation between China and foreign countries and enhancing China's position in global scientific and technological innovations. For example, a biomedical patent held by Zhejiang University was adopted by a European pharmaceutical company through open licensing, which helps to promote in-depth cooperation in biomedical technology between China and Europe. Fourth, it has optimized the allocation of resources. Open licensing prompts colleges and universities to value patent quality rather than patent quantity and guides them to invest their limited resources in truly valuable projects, thereby improving overall scientific research efficiency. For example, Tianjin University made a number of advanced manufacturing technologies available on the market by open licensing to bring remarkable economic benefits to the enterprises exploiting them. Many key universities in China have successfully brought a number of important scientific and technological research results to the market by means of open licensing and produced considerable economic and social benefits.

To sum up, the patent open licensing system is an important initiative that the Chinese government has launched to promote the transfer and transformation of patent technologies created by colleges and universities in China. Not only does it help to address many long-standing problems, but it also adds a strong impetus to the advancement of scientific and technological research nationwide in China. Looking forward, with the continuous improvement of relevant policies and the joint efforts of all sectors, it is believed that colleges and universities in China will play an increasingly important role in global scientific and technological innovations.

“ The open licensing system adopts a ‘one-to-many’ mode which greatly simplifies the authorization procedure and reduces the time and labor costs. ”



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Means-plus-function claims: a return to relevance?

Eric L. Maschoff and Mark W. Ford of Maschoff Brennan detail the possible advantages of means-plus-function claims and suggest their possible comeback.

Some say that trends are like passengers on a carousel: they keep going around. This is particularly true with fashion, where shoes like the Nike Dunk (introduced in 1985) now line the walls of many shoe stores after years of relative retail obscurity. Like the Nike Dunk, patent claims that include at least one means-plus-function limitation also enjoyed a period of popularity before declining. In the late 1980s, more than 50% of issued patents included at least one means-plus-function limitation. Unlike the Nike Dunk, however, the popularity of means-plus-function limitations have not yet seen any sort of comeback. Today, less than 5% of issued patents include such a limitation.

While it is unclear to the authors what inspired the resurgence in popularity of a shoe that we wore in high school, a resurgence in popularity of means-plus-function limitations may be on the horizon due to the *Impact Engine, Inc. v. Google LLC* case.

History of means-plus-function claiming

In *Halliburton Oil Well Cementing Co. v. Walker*¹, the Supreme Court held that a claim that is functional at the point of novelty is, *ipso facto*, invalid. In response, Congress enacted § 112(f) of the Patent Statute², which explicitly enables patentees to express a claim limitation – even at the invention's point of novelty – by reciting a function to be performed instead of the structure that performs the recited function. These so-called "means-plus-function" (MPF) limitations, however, do not cover all structures, materials, or acts that perform the recited function. Rather, the statute specifies that the scope of a means-plus-function claim is limited to the corresponding structure, material, or acts disclosed in the patent's



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specification, and their equivalents. Thus, inventors cannot simply claim any and all possible ways of performing a function – they must describe, in the specification, the specific structures or algorithms that perform the function, and the claim will be limited to those disclosed structures and their equivalents.³

Over time, the popularity of MPF limitations declined. This decline has been primarily due to courts' tendency to (1) narrowly construe the scope of means-plus-function limitations when identifying corresponding structure, and (2) invalidate claims that include MPF limitations when the specification does not adequately identify corresponding structure.

Impact Engine, Inc. v. Google, LLC

The Federal Circuit's recent decision in *Impact Engine v. Google*⁴ has renewed interest (and some doubt) in the proper treatment of claims containing MPF limitations – including issues relating to patent eligibility and infringement. Interest has intensified in view of *Impact Engine's* subsequent petition to the Federal Circuit for *en banc* review, the outcome of which could vastly alter interest in use of MPF claim strategies.

Impact Engine sued Google alleging infringement of a family of patents that disclose systems and methods for creating, editing, sharing, and distributing media-rich web-based communications such as presentations, banner advertisements, websites, and brochures. At the heart of the dispute are claims that include a "project viewer" element, which the district court construed as a means-plus-function limitation under § 112(f). The project viewer, however, is like a multitool in that it performs several *different* functions. Indeed, different claims use different "project viewer" MPF limitations to recite four

different functions including: (1) rendering a communication; (2) sending a communication; (3) allowing users to view templates; and (4) displaying slides.

The basic approach to construing an MPF claim is to first identify the claimed function, and then identify structure within the specification that is required to perform that *specific* function. In *Impact Engine*, the district court identified over 300 lines of disclosure in the specification, which disclosed different algorithms (structures) for performing each of the different recited project viewer functions. Instead of determining which individual algorithm was needed to perform a specific project viewer function, the district court concluded that the entirety of the structure disclosed in the specification was necessary to perform *all* the various project viewer functions. In other words, if the project viewer was a multitool, the district court's construction would require the presence of all the multitool structural components (e.g., the knife, the bottle opener, and the screwdriver) regardless of whether the multitool MPF limitation recited a single function, such as "means for cutting."

After construing the claims in this manner, the district court found one set of project viewer claims ineligible under § 101 based solely on an assessment that the claimed *function* was directed to a known programming construct and without considering the corresponding structure. The court then found that the remaining project viewer claims were directed to statutory subject matter but were not infringed because *Impact Engine's* expert had not shown that the entire 300 lines of structure disclosed was present in the accused device. The expert had instead identified only the particular algorithmic structures from the 300 lines required for the subset of claimed project viewer functions in the accused product. In fact, the court never confronted the issue of whether the accused product included any of the structure – let alone equivalents – identified in the 300 lines of disclosure.

A new future for means-plus-function claims?

In a split opinion, the Federal Circuit affirmed the district court's rulings. In dissent, Judge Reyna took issue with both the majority's non-infringement and ineligibility determinations on the basis that they departed from well-established Federal Circuit precedent. He concluded that the district court's claim construction requiring over 300 lines of structure from the specification regardless of the claimed function was wrong, and this flawed construction necessarily infected the district court's ineligibility and non-infringement rulings for the "project viewer" claims.



“Prior to enactment of § 112(f) the Supreme Court held that a claim that is functional at the point of novelty is, *ipso facto*, invalid.”

Résumés

Eric L. Maschoff co-founded Maschoff Brennan in 2011. He specializes in building intellectual property portfolios that advance his clients' business strategies. Eric provides his clients with advice on the full spectrum of patent portfolio management and strategy as well as IP acquisition and enforcement.

Mark Ford is an intellectual property lawyer with broad and diverse experience encompassing both IP litigation and prosecution. This expansive experience allows Mark to not only understand and apply complex legal theories to sophisticated technologies, but also allows Mark to view these theories and technologies from a variety of different angles and perspectives.



In its petition for rehearing *en banc*, Impact Engine seeks clarification relating to the patent eligibility of MPF claims. First, it requests that MPF claims limited to specific structure described in the specification be deemed *per se* patent eligible. Second, and alternatively, that specific structure required to perform a function recited in a MPF claim limitation must be identified before assessing patent eligibility under § 101. Obviously, a Federal Circuit ruling in the affirmative on either of those issues would immediately reinvigorate the patent bar's interest in means-plus-function claim strategies. In the meantime, there is much to take away from the *Impact Engine* saga, both in terms of potential advantages of MPF claiming, as well as important practice considerations.

Functional language is often easier to understand. MPF limitations can be useful simply from a practical standpoint, particularly when an invention is complex and claiming structural elements is challenging. A MPF claim limitation can simplify complex elements by focusing on what the element does rather than detailing structural concepts by way of difficult-to-understand claim language. This can be advantageous for a non-technical audience, such as a judge or jury.

MPF limitations can be complementary to structural claims. Using MPF claims alongside structural claims creates a more comprehensive claim coverage strategy, adding another layer

“**These so-called “means-plus-function” (MPF) limitations, however, do not cover all structures, materials, or acts that perform the recited function.**”



of protection in the event of structural claims facing interpretation challenges. Claim breadth can also be maximized. When a supporting specification includes sufficient structural detail, MPF limitations can cover a range of disclosed embodiments, as well as their equivalents.

MPF limitations for software related inventions. When used in the context of software algorithms, MPF limitations can be particularly useful. When a MPF claim is supported by specific algorithms (structure) disclosed in the specification, it highlights the practical, technical implementation of the claimed function. This can show that the claim covers more than just an abstract idea – it covers the way in which the function is achieved, anchoring the claimed function to specific embodiments thereby making it easier to argue that the invention is rooted in a technical field and has a concrete application, distancing it from mere abstract ideas. Impact Engine argues that such evidence should make the claim *per se* patent-eligible, or at least must be considered before assessing patent eligibility under § 101, which could be helpful in protecting such claims from early dismissal.

MPF limitations help to navigate species restrictions. MPF limitations, by their nature, encompass multiple species or embodiments that perform the same function in different ways. This broader scope can help avoid, or help navigate, restrictions that might arise during prosecution

if each species is claimed separately with structural language. At a minimum, use of a MPF limitation might preserve the presence of a generic claim, that might later be used to rejoin restricted species and avoid the need to file divisional applications.

Coverage of “equivalent” structures. Section 112(f) mandates that MPF limitations cover any structure disclosed in the specification, as well as any “equivalents thereof.” This can increase claim breadth: if the accused structure performs the same function and does so in substantially the same way to achieve the same result, it may infringe the claim. Even if an accused structure has differences, it can still be deemed equivalent if those differences do not substantially affect the way the function is performed. This assessment requires factual analysis, technical evidence, and often expert testimony, making it suitable for determination by a jury or fact-finder in a trial setting. Because equivalence involves factual determinations, courts often find that it is not suitable for summary judgment (or dismissal at the pleading stage) if the evidence shows genuine disputes about how the accused structure performs the function or whether differences between structures are insubstantial.

Be clear on your intent to invoke (or not invoke) § 112(f). A practitioner should exhibit a clear intent to invoke § 112(f). To avoid interpretational ambiguity, use trigger language as outlined by the statute itself, specifically “means for” or “step for,” to signal that a claim element is intended to invoke § 112(f). Using these exact terms creates a presumption that the claim should be interpreted under § 112(f). Moreover, clearly articulate a distinct function, and avoid the recitation of any structure needed to perform that function within the claim itself.

Conversely, a practitioner should avoid any unintentional invocation of § 112(f) if application of the statute is not intended. For example, avoid use of the word means if § 112(f) treatment is not intended. Similarly, avoid use of any so-called “nonce” words – words that do not suggest structure such as “module,” “system,” “unit,” “device,” “software” and the like – that are often interpreted by courts as substitutes for the word “means” and, therefore, can trigger treatment under § 112(f) if only additional function is recited.

Be specific about corresponding structure and be comprehensive. Ensure that the patent specification explicitly links each claimed function to the exact structure needed to perform that function. *Impact Engine* is illustrative. There, four separate functions were claimed using the same generic claim term: “project viewer.” As such, it was difficult to discern what specific structure

“**MPF limitations can be useful simply from a practical standpoint, particularly when an invention is complex and claiming structural elements is challenging.**”



was required for a given function. A better approach is to use a separate means-for clause to recite each function, and then specifically align that language to only that structure needed to perform the recited function.

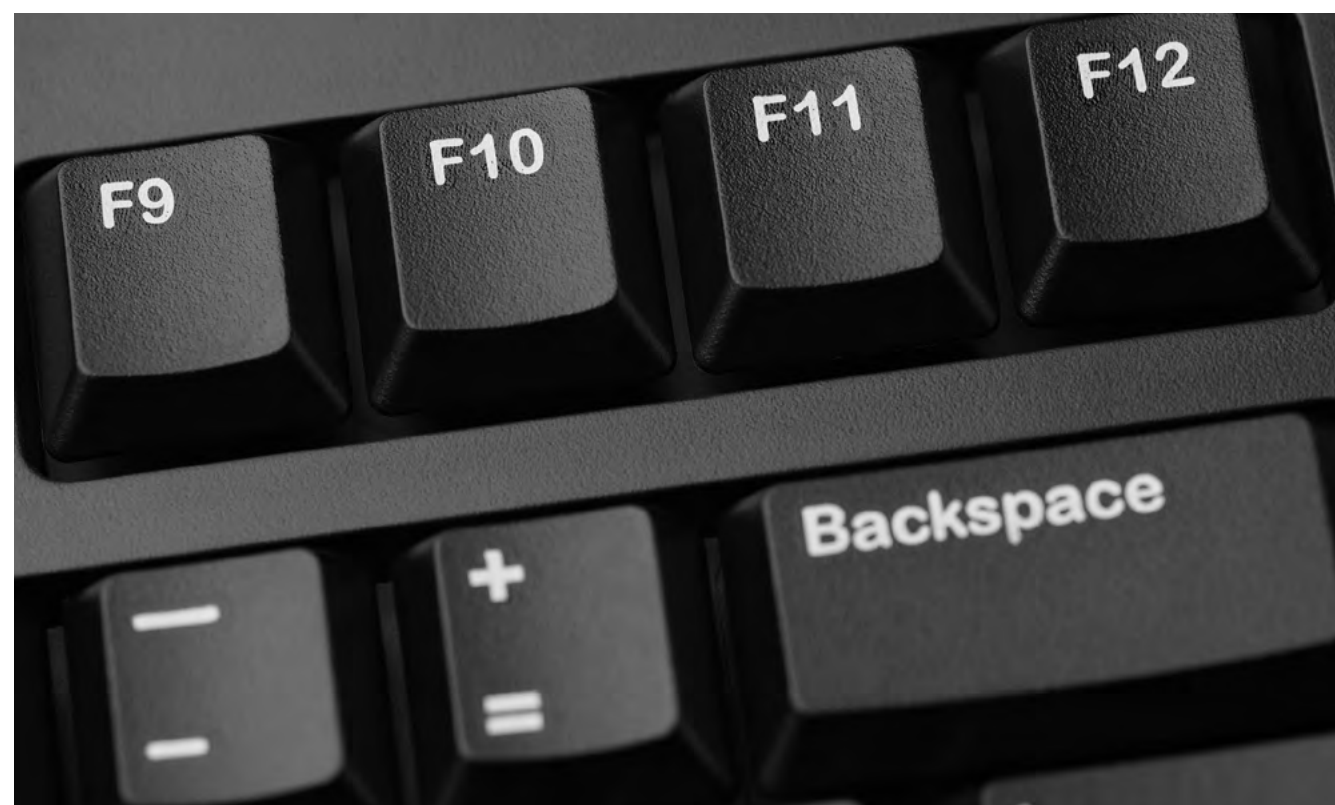
Anticipate equivalence issues. When feasible, include descriptions of known equivalents for the disclosed structures to strengthen the basis for arguing equivalence under § 112(f) during enforcement. Keep in mind the function-way-result (FWR) test when drafting the specification to ensure that disclosed structures and potential equivalents align with this standard. Consult with the inventor, as well as technical experts, to ensure that the disclosed structures are sufficiently detailed and technically accurate, and to identify any known equivalents.

While we may not all be soon wearing Nike Dunks again, there is the possibility that we again start thinking of drafting at least some claims using means-plus-function limitations. While the outcome of the *Impact Engine* will be very influential, there are other reasons to consider a possible return to that claiming strategy. Stay tuned and be prepared.

Contact info

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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Patent protection for digital twins

Massimo Galluppi, Patent Attorney at Dennemeyer & Associates, analyzes the evolution and patentability of digital twins, considering potential and virtual technical effects, with particular reference to the EPO's approach.

Digital twins are increasingly used in a wide range of industries. But to what extent can they be protected by patents?

The concept of digital twins dates back to the Apollo space missions of the 1960s, where NASA engineers first created virtual replicas of space capsules to simulate conditions and troubleshoot problems from Earth. By mirroring physical systems in a digital environment, they could model complex scenarios, enhancing mission safety and problem-solving capabilities, as during the Apollo 13 crisis¹ in 1970. This pioneering approach has since evolved, with digital twins now representing any virtual model of a physical object or system, allowing industries to study real-world behavior using actual data for accurate, safe, and efficient decision-making.

Today, digital twins are integral across sectors like manufacturing, construction, healthcare, transportation, and entertainment. As industries increasingly adopt these technologies for predictive maintenance, product design, and process optimization, their uptake is reflected in projections of rapid market growth. Hence, McKinsey estimates that the global digital twin market will grow at an annual rate of approximately 60% over the next five years, reaching \$73.5 billion USD by 2027². This evolution underscores the role of digital replicas in reshaping modern industry, working hand-in-hand with advances in the Internet of Things (IoT), artificial intelligence (AI), and data analytics.

As IBM has stated³, digital twins are a vital part of the digital reinvention of asset-intensive industries, a revolution driven by a need to integrate physical and digital views of equipment, facilities, and procedures: "The future of digital twins is nearly limitless because increasing amounts of cognitive power are constantly being devoted to their use. So, digital twins are constantly learning new skills and capabilities, which means they can continue to generate the insights needed to make products better and processes more efficient."



Massimo Galluppi

Electric reflections in the real world

Enhanced computing power, faster connectivity, and the emergence of machine- and deep learning now allow digital twins to deliver increasingly sophisticated simulations. These technologies enable cyber twins to adapt dynamically to new data and shifting conditions, providing real-time insights with remarkable accuracy.

Even in the past few months, there have been a number of examples of the power and potential of digital twins in various industries. These include:

- FarrSight-Twin⁴, which creates virtual clinical trials of new treatments using digital twins of real cancer patients. Presented by Dr. Uzma Asghar, co-founder and chief scientific officer at Concr, the approach uses biological data to predict how a patient will respond to a treatment. Early indications are that patients who receive the treatment selected by FarrSight-Twin have a much higher response rate than those who do not.

¹ <https://ntrs.nasa.gov/citations/20210023699>
² <https://www.mckinsey.com/featured-insights/mckinsey-explainers/what-is-digital-twin-technology>
³ <https://www.ibm.com/topics/what-is-a-digital-twin>
⁴ <https://www.theengineer.co.uk/content/news/digital-twins-of-cancer-patients-predict-effectiveness-of-treatments>

Résumé

Dr. Massimo Galluppi, Patent Attorney

Massimo holds a PhD in physics, focusing on the optical analysis of quantum structures for laser development. He is qualified as a European and Italian patent attorney, has a diploma in patent litigation from EPI-CEIPI in Strasbourg, and has completed an advanced IP Management course at WIPO Academy. Massimo brings extensive experience in drafting, prosecution, strategic portfolio advising, EPO oppositions, and patent litigation before Italian courts.

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- A trial by High Speed 1 and Network Rail High Speed⁵ in the United Kingdom to make rail operations – including maintenance, renewals, and inspection – more efficient and less expensive using a digital twin developed by Hexagon Consultants and Aerogility. The successful trial could have applications in other transport infrastructure, too.
- An internet network digital twin⁶, which is synchronized with a real-world connection. As described by Nokia Bell Labs, such a digital twin could improve the strategic and operational aspects of managing capacity on fiber optic networks – increasing utilization without impacting speed.
- The Destination Earth (DestinE)⁷ project, which uses two digital twins of the Earth to predict weather extremes and climate change adaptation. By adding further virtual replicas, the European Commission aims to have a complete simulation of Earth's climate by 2030.
- The influence of digital twins on Industry 5.0⁸ in enabling connectivity between cyber and physical spaces. A study by European researchers last year argued that digital twins are the most promising technological enablers of the next stage in industrial development. Rising to meet the ambitions of this nearing technological revolution would be extremely difficult without using reliable, precise, and inspectable digital simulations.

These cases are merely the tip of the iceberg. The next few years will likely see a more pervasive application of digital twins as companies invest heavily in their development and utilize their expanding capabilities. However, this rapid innovation brings up critical questions about Intellectual Property (IP) – specifically, how cyber twins and their underlying technologies can be safeguarded through patent rights.

The patent problem

At their heart, digital twins are very sophisticated computer simulations. As is well established, "programs for computers [...] as such" are one of the categories of inventions that are excluded from patentability by Article 52⁹ of the European Patent Convention (EPC).

Over the past few decades, this exception has been addressed and developed in many cases before the European Patent Office (EPO) Boards of Appeal. The settled position is that, to



“Further use must be at least implicitly specified in the patent claim.”

overcome the Article 52 exclusion, the invention for which protection is sought must have a technical character. As the EPO has ruled¹⁰: “A computer program product is not excluded from patentability under Article 52(2) and (3) EPC if, when it is run on a computer, it produces a further technical effect which goes beyond the ‘normal’ physical interactions between program (software) and computer (hardware).”

This technical effect must be something more than what is typical of executing a program, such as electrical currents.

Following the Board of Appeal decisions in T 0641/00 (Two identities/COMVIK)¹¹ and T 0258/03 (Auction method/HITACHI)¹², which have been confirmed in more recent decisions, the EPO takes a two-step approach to examining such patent applications.

- (1) In assessing whether the claimed subject matter is an invention within the meaning of Article 52, if the claim involves technical means, then it is considered an invention.

- (2) In evaluating novelty and inventive step, any features that do not contribute to the technical character of the claimed invention are disregarded.

Deciding on computer simulations

In 2021, the EPO Enlarged Board of Appeal (EBA) published a decision regarding a European Patent application filed by Bentley Systems (UK) Limited for a “computer-implemented method of modelling pedestrian crowd movement in an environment.” The invention concerned a simulation used in the process of designing a venue such as a railway station or stadium.

In its decision G 0001/19 (Pedestrian simulation)¹³, the EBA confirmed that the COMVIK approach is suitable for the assessment of computer-implemented simulations, stating: “Like any other computer-implemented inventions, numerical simulations may be patentable if an inventive step can be based on features contributing to the technical character of the claimed simulation method.”

“A potential technical effect would be considered patentable, whereas a virtual technical effect may not.”

It concluded:

1. A computer-implemented simulation of a technical system or process that is claimed as such can, for the purpose of assessing inventive step, solve a technical problem by producing a technical effect going beyond the simulation's implementation on a computer.
2. For that assessment, it is not a sufficient condition that the simulation is based, in whole or in part, on technical principles underlying the simulated system or process.
3. The answers to the first and second questions are no different if the computer-implemented simulation is claimed as part of a design process, in particular for verifying a design.

While the decision confirmed that computer-implemented simulations are patentable, it did not further elucidate what is a technical effect. In its decision, the Board said that when the COMVIK approach is applied to simulations, the boundaries formed by the underlying models may be technical or non-technical:

“In terms of the simulation itself, these boundaries are not technical. However, they may contribute to technicality if, for example, they are a reason for adapting the computer or its functioning or if they form the basis for further technical use of the outcomes of the simulation (e.g., use impacting physical reality).”

This further use must be at least implicitly specified in the patent claim.

⁵ <https://www.newcivilengineer.com/latest/ai-digital-twin-successfully-trialled-with-hs1-and-network-rail-high-speed-28-10-2024/>
⁶ <https://www.nokia.com/blog/how-digital-twins-improve-internet-speeds/>
⁷ <https://www.theparliamentmagazine.eu/news/article/a-digital-model-of-earth-can-digital-twins-transport-climate-science-to-the-future>
⁸ <https://www.sciencedirect.com/science/article/pii/S0166497224000750>
⁹ <https://www.epo.org/en/legal/epc/2020/a52.html>
¹⁰ <https://www.epo.org/en/boards-of-appeal/decisions/t971173ep1>
¹¹ <https://www.epo.org/en/boards-of-appeal/decisions/t000641ep1>
¹² <https://www.epo.org/en/boards-of-appeal/decisions/t030258ex1>
¹³ <https://www.epo.org/en/boards-of-appeal/decisions/g190001ex1>



The patent application that was the subject of this decision (EP1546948¹⁴) was refused in 2022.

Lessons for patentees

Case G 0001/19 highlights the issues that can arise regarding patent applications for simulations. While other IP offices around the world may take a different approach to patentability based on their own laws, this decision provides valuable lessons that are likely to be more widely applicable.

The EPO EBA presented arguments about the necessity of differentiating between the "potential (or tangible) technical effects" and "virtual (or calculated) technical effects" of calculated numerical data. Potential technical effects can occur when an invention is put into practice in the physical world, for example, in controlling an autonomous vehicle or manufacturing a new product. Virtual technical effects can occur in a model or simulation of the real world but may not manifest in the actual physical environment outside that model or simulation. A potential technical effect would be considered patentable, whereas a virtual technical effect may not. On the other hand, a simulated system's virtual technical effects and underlying algorithms have the potential to confer a technical character insofar as they themselves have a technical purpose.

Digital twins are made up of a multitude of technological components that could individually contain patentable innovations, such as sensors and data analytics. However, to patent an invention implemented in or as a digital twin, it is critical to demonstrate the technical effect of said application, distinguishing it from a mere software application or simulation of reality. For example, it is important to describe in express terms how the technology integrates its patent-eligible components, be they data collection, processing, analytics, or

visualization. It is worth remembering that real-world test results and measurements can be included to demonstrate a technical aspect in the form of empirical data, such as lower operating costs, reduced heat buildup, or faster performance.

Previewing the future of industry

Despite the complications, many applications are successful in obtaining patent rights for digital twin inventions. According to research¹⁵ published by GlobalData in 2024, there were more than 1,600 patent publications related to digital twins in 2023, compared to fewer than 200 in 2019. The United States ranked top in terms of digital twin patent publications, with nearly 3,000 patents from 2016 to 2023 (69% of the global total), followed by China with 681 patents published. Among the most active companies in this field were Siemens, General Electric, Honeywell, and Rockwell Automation, according to the research.

IP professionals can advise on which aspects of a digital twin invention are patentable and how patent applications should be drafted to maximize protection. Moreover, consideration should be given to other forms of IP, such as copyright or database protection (where available), which may be relevant as part of a holistic IP strategy.

The commercial use of digital twins is likely to grow enormously in the next few years, and they will have a critical role to play in making products and processes more efficient, safe, and sustainable. Patent protection will be essential to safeguarding investment in this innovation and ensuring competitive advantage, as licensing key technologies further enables broad take-up. Businesses should, therefore, carefully consider their patenting strategy in this area to ensure they can make the most of the exciting opportunities ahead.

¹⁴ <https://register.epo.org/application?number=EP03793825>

¹⁵ <https://www.verdict.co.uk/in-data-digital-twin-patents-exceeded-1600-publications-in-2023/>

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Competing interests: assessing legal standing in patent invalidation procedures

Oliver Silva Castro, Associate at Uthhoff, explores the critical role that legal standing plays in determining who has the right to challenge a patent's validity and the implications of these challenges on innovation and competition.

Given the entrance into force of the Federal Law for the Protection of Industrial Property (FLPIP) on November 5, 2020, the ability to exert invalidation (nullity) actions against a patent was extended through the incorporation of new legal provisions that were not previously foreseen in our legislation.

In this regard, and from a litigious point of view, the incorporation of these legal provisions came to bolster our IP system and, in parallel, increases the possibility of seeking the invalidation of granted patents when applicable legal formalities and requirements established in our law are met; in this sense, one of the most important requirements consists in demonstrating the plaintiff possesses sufficient **legal interest/standing** to sue.

With that in mind, and despite the fact that such legal provisions give the possibility to seek a patent invalidation, **how to properly demonstrate such legal interest** in these types of procedures carried out before the Mexican Institute of Industrial Property (MIIP) has also been the subject of discussion.

Legal interest to sue

For the enforcement of these nullity actions against granted patents, and as above-explained, it is necessary to prove a **legal interest** to bring an action of this nature, as foreseen in the following legal provision:

Article 329.- The Institute may initiate the



Oliver Silva Castro

*administrative declaration procedure ex officio or at the request of anyone with a **legal interest**.*

Any person may submit information that allows the Institute to determine the start of an administrative declaration procedure ex officio if deemed appropriate.

As seen, the above legal provision expressly demands a legal interest to initiate this type of procedure while excluding others, such as "*legitimate interest*", through which it is not necessary to have a granted or recognized right that feels vulnerated but just a legitimate interest aimed to obtain a legal benefit from a trial.

Having said the above, and in common practice, we must say that the meaning of legal interest had been understood in a broad sense since, during the proceedings, it was possible to seek the nullity of a patent *i)* not only when there was a clear affectation to a legal right or impact on the legal sphere *ii)* but also when a third party simply alleged that two entities were just competitors in the same niche of commerce, which was acceptable by the Institute to resolve a patent invalidation.

Following this idea, it was very common in practice that a third party attempted to attack a granted patent, based on the mentioned fact *ii)*, by just arguing that both parties or entities were competitors in the same sector and without the



need to necessarily prove a direct and serious affectation, which in turn, was usually objected by the patent holder in the proceeding under the argument that there was a clear lack of legal interest/standing by the plaintiff.

Nevertheless, even when such legal interest was attacked in this manner by the patent owner, the authority in most cases was inclined to admit and study these types of actions after determining that two entities competing in the same sector was sufficient to enforce and resolve a patent invalidation; which in practice, raised the question on whether this argument of competition should be enough and legal to seek the nullity of a granted patent.

Trying to fix the interpretation problem

Recently, and as a result of a litigation case resolved by our Supreme Court of Justice, it was analyzed and confirmed the interpretation that must be given to the legal interest in this type of procedures when a granted patent is attacked.

This interpretation was in accordance with the legal interest established in Article 188 of the repealed Industrial Property Law (IPL), which now is still foreseen in Article 329 of our FLPIP.

In this regard, and as background, this legal conflict came from two pharmaceutical companies, whereby one of the entities (Company A) sought the nullity of the patent owned by another entity (Company B) before the Institute under the

argument that the subject patent lacked novelty, inventive activity, and industrial application.

After the corresponding procedural stages, the Institute resolved not to study the merits of the case **due to the lack of legal standing** by Company A, since the authority considered that being a commercial competitor in the same industry was not sufficient to prove a legal interest

“
One of the most important requirements consists in demonstrating the plaintiff possesses sufficient legal interest/standing to sue.
”

Résumé

Oliver Silva Castro has been an Associate of Uthhoff in Mexico since 2012, where he is part of the Litigation Department. Oliver focuses on litigation of trademarks and copyrights and its enforcement, as well as anti-counterfeiting issues before the FGR and Mexican Customs. Also, he is active in domain name disputes and counseling multinational companies.

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or right to sue; besides the fact that Company A did not suffer an affectation from the exploitation of the patent.

In consequence, Company A filed an appeal before the Federal Court of Administrative Affairs (FCAA), which, in the end, resolved to confirm the validity of MIIP's decision under the same grounds.

Subsequently, the plaintiff filed one more appeal before the Federal Circuit Court (FCC) in order to challenge the unfavorable decision by arguing that the subject patent had been illegally granted and also that article 188 of the repealed Industrial Property Law (now article 329 of the FLPIP), was **unconstitutional**.

The above, since Company A stated that said legal provision referred to the legal interest required to sue for patent invalidation, would prevent any third party with a *legitimate interest* from requesting the nullity of a patent as provided for in other countries and international treaties.

However, the FCC resolved to deny the mentioned amparo appeal, under the same line of lack of legal standing, by stating that the legal interest established in the IP Law was indeed constitutional and necessary to maintain legal certainty in our patents system as well as aimed to protect the rights of inventors, without being a regressive provision with respect to other legal provisions or treaties.

Notwithstanding the above, and as a final and last recourse, Company A filed a revision recourse before the Supreme Court, which in these types of cases is not usually admitted. However, as this topic involved an issue of constitutionality and was deemed a transcendental case concerning the interpretation of the legal interest in our IP law, the Ministers of the Court decided to admit said recourse.

“**Attempted to attack a granted patent by simply arguing that they were just competitors in the same sector.**”

However, in the end, it was finally resolved that Company A did not prove a **legal interest** to enforce a patent invalidation action against Company B and, thus, totally denied said recourse.

In such judgment, the Ministers confirmed and reiterated at this last and superior instance that being competitors in the same industry or sector does not produce a legal interest *per se* to initiate an administrative declaration procedure or nullity action against a granted patent, given that said legal interest should be understood as a serious affectation suffered on the legal sphere as well as the possibility that individualized damage shall be remedied by the competent authority (instead of just having a presumed legitimate interest, where there is no formal affectation nor right to restore by the authority).

In conclusion, and based on the above, the legal interest previously foreseen in Article 188 of the repealed Industrial Property Law (IPL) was declared as legal and constitutional by our Supreme Court, which in the same manner applies in a progressive manner to the protection and legality of the legal interest now foreseen in Article 329 of our current FLPIP, for being such legal interest a necessary provision to maintain legal certainty in our legal system and a certain level of conditions to initiate an administrative declaration procedure at the request of whoever has a legal interest to sue aimed to restore a violated right.

Therefore, and when said legal interest is duly satisfied, it is possible to exercise the invalidation causes foreseen in our IP law, according to the specific case/hypothesis, as hereunder detailed.

Nullity and expiration of patents

As established in the FLPIP, it is possible to seek the nullity of a patent in the following cases:

Article 154- A patent may only be declared null in the following cases:

- I. When the protected matter is not considered an invention, the invention is not patentable, lacks novelty, inventive activity, or industrial application, in terms of this Law;
- II. When the invention is not disclosed in a sufficiently clear and complete manner, so that it can be carried out by a technician in the field;
- III. When the claims exceed the disclosure contained in the application, as it was initially filed before the Institute;
- IV. When it is the result of a divisional application and includes claims that correspond to matter that has been processed in contravention of the provisions of article 100 of this Law;
- V. When, as a result of a rectification or limitation procedure, provided for in articles 122 and 123 of this Law, the matter protected by the patent has been expanded;

“**When said legal interest is duly satisfied in the specific case.**”

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- VI. When by mistake or inadvertence, a right of priority has been recognized and with it the novelty or inventive activity of the matter protected by the patent was unduly determined;
- VII. When it has been granted in contravention of article 50 of this Law, and
- VIII. When it has been granted to someone who did not have the right to obtain it, in accordance with the provisions of article 38 of this Law.

The nullity actions provided for in this article may be exercised at any time, from the date on which the publication of the patent in the Gazette takes effect.

If the grounds for nullity partially affect the patent, it shall be declared partially invalid.

In the resolution that declares partial nullity, the Institute shall order a marginal annotation to be entered in the respective Title, in which the modifications to it shall be recorded, as well as the causes that originated it.



Hachette Book Group Inc. v. Internet Archive: the latest copyright book brawl

David McCombs, Eugene Goryunov, and Mallika Dargan of Haynes & Boone review the recent copyright case that brought the rights of fair use into question regarding electronic copies of books.

The recent case between Hachette Book Group Inc. and Internet Archive has sparked a crucial debate over the boundaries of copyright in the digital age.¹ The case pits traditional publishing houses against the principles of open-access digital libraries and it has captured the attention of authors, publishers, and open information advocates alike. The outcome of this case has big implications for the future of access to knowledge, the rights of authors and publishers, and the digital dissemination of information.

Background

The Internet Archive, a nonprofit organization, has long been a champion of free access to digital content. Known for its Wayback Machine, which archives snapshots of the internet, the Internet Archive has also maintained an extensive library of digitized books. Its practice of lending out these digitized versions of books operates on a model called Controlled Digital Lending (CDL). Under this model, the Internet Archive scans physical copies of books it owns, creating digital versions that it lends to users. The lending has typically been limited to one user at a time, in a manner similar to the way physical libraries lend out books.

Publishers like Hachette Book Group, however, saw the Internet Archive's digital library in a different light. In June 2020, amid the COVID-19 pandemic, Hachette, along with HarperCollins, John Wiley & Sons, and Penguin Random House, filed a lawsuit against the Internet Archive, alleging widespread copyright infringement.²



David McCombs



Eugene Goryunov



Mallika Dargan

Their argument centered on the claim that the Internet Archive's digitization and lending of books violated the exclusive rights of copyright holders, particularly the right to control reproduction and distribution of their works.

Fair use argument

Copyright law in the United States is governed primarily by the 1976 Copyright Act, which grants copyright holders exclusive rights to reproduce, distribute, perform, and display their works, as well as to create derivative works.³ However, certain exceptions, including the "fair use" doctrine, permit limited use of copyrighted material without permission under specific circumstances.⁴

The Internet Archive argued that its practices were protected by fair use. Specifically, it claimed that digitizing and lending books served an educational and societal purpose, especially during times of crisis, such as the COVID-19 pandemic, when access to physical libraries was limited. In particular, "out of concern for a potential lack of access to books due to the closure of schools and libraries, [Internet Archive] lifted its one-to-one owned-to-loaned ratio, allowing its digital books to be checked out by up to 10,000 users at a time."⁵ The Internet Archive also maintained that it was not profiting from the digital lending and that its operations were equivalent to the legal lending of physical books by traditional libraries.

The publishers, on the other hand, contended that the Internet Archive's practices went beyond fair use. They argued that digitization constituted unauthorized reproduction, which is an exclusive

right of the copyright owner, and that the lending of digital versions deprived them of potential sales or licensed distributions. Additionally, the publishers emphasized that the Internet Archive had not obtained the necessary licenses to distribute digital copies of the books.

Four-factor fair use test

In March 2023, the Southern District of New York ruled in favor of the publishers. In September 2024, the District Court ruling was affirmed by Circuit Judge Beth Robinson in the Second Circuit. The court rejected the Internet Archive's fair use defense, concluding that the nonprofit's activities did not meet the four-factor test for fair use:

- Purpose and character of use: The court determined that Internet Archive's digitization and lending of books were not transformative uses.

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.

Mallika Dargan is an associate in the Intellectual Property Practice Group in Haynes Boone's Dallas-North office. Her practice focuses on patent trials, IP counseling, technology transactions, and privacy counseling. Mallika has a background in biology and computer science.

“The publishers, on the other hand, contended that the Internet Archive's practices went beyond fair use.”

¹ *Hachette Book Grp., Inc. v. Internet Archive*, 115 F.4th 163 (2d Cir. 2024).

² *Id.* at 174.

³ See 17 U.S.C. § 106.

⁴ See 17 U.S.C. § 107.

⁵ *Hachette Book Grp., Inc.*, 115 F.4th at 176.



According to the court, the Internet Archive simply replicated the original works in a digital format without adding new meaning or expression.⁶

- Nature of the work: The court found that the works in question—both fiction and non-fiction books—were highly creative and expressive, and therefore entitled to strong protection under copyright law.⁷

- Amount and substantiality: The Internet Archive had copied entire books for digital lending, which the court deemed too extensive to qualify for fair use. Copying an entire work typically weighs against a fair use finding.⁸

- Effect on the market: Perhaps the most significant factor in the court's analysis was the impact of the Internet Archive's activities on the market for the original works. The court found that the availability of free digital versions of the books could undermine sales and licensing opportunities for the publishers.⁹

As a result, the court ordered the Internet Archive to stop lending out the publishers' books and to destroy the digital copies it had created.

⁶ Id. at 184 ("In sum, because IA's Free Digital Library primarily supplants the original Works without adding meaningfully new or different features that avoid unduly impinging on Publishers' rights to prepare derivative works, its use of the Works is not transformative.")

⁷ Id. at 187 ("Here, while the nonfiction Works undoubtedly convey factual information and ideas, they also represent the authors' original expressions of those facts and ideas—and those 'subjective descriptions and portraits' reflect 'the author's individualized expression.'")

⁸ Id. at 188-189.

⁹ Id. at 198 ("Its empirical evidence does not disprove market harm, and Publishers convincingly claim both present and future market harm.")

The ruling was a significant win for the publishers and a setback for the Internet Archive and other advocates of open access to information.

Long-term implications and key takeaways

The Hachette Book Group Inc. v. Internet Archive case is a landmark in the ongoing debate over copyright in the digital age. The ruling reaffirms the strong protection granted to copyright holders under US law, even in the face of arguments for broader public access to knowledge. It also highlights the limitations of the fair use doctrine, particularly when it comes to large-scale digital lending initiatives.

While this decision comes from the Second Circuit – and therefore has limited binding effect on other circuits – it is certainly persuasive authority. As such, the following are key takeaways for publishers and advocates, alike:

Limitations of fair use: The court's rejection of the fair use defense highlights the limitations of this doctrine, especially in cases where entire works are being copied and lent out without permission. The ruling sets a clear precedent that large-scale digital lending programs may not qualify for fair use.

Challenges for digital libraries: Digital libraries like the Internet Archive now face significant legal hurdles in their efforts to digitize and lend books. Without the ability to rely on fair use, these organizations may need to seek licenses or permission from copyright holders, which could limit the scope of their collections.

Impact on access to knowledge: While the ruling protects the commercial interests of publishers, it also raises concerns about access to information. As more content moves online, striking a balance between protecting copyright and ensuring public access to knowledge will remain a critical challenge for policymakers and the legal system at-large.

This article reflects only the present personal considerations, opinions, and/or views of the authors, which should not be attributed to any of the authors' current or prior law firm(s) or former or present clients.

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Understanding inventive step as patentability criteria

Ranjan Narula and Suvarna Pandey of RNA, Technology and IP Attorneys outline various factors influencing the determination of inventive step, including the subjective judgment of the Person Skilled in the Art (PSITA), the specific field of technology, legal frameworks across countries, and case-specific elements.

The inventive step is a crucial patentability criterion that is often debated during the process of granting a Patent. Inventive step is defined as a feature of an invention that involves a technical advance compared to existing knowledge or has economic significance, making the invention not obvious to a person skilled in the art.

Determination of inventive step

1. Subjective judgment:

The determination of the inventive step is inherently subjective, as it relies on various factors. These include the nature of prior arts related to the invention – where closer prior arts weaken the inventive step. The technical differences, and technical advantages over prior art, help to overcome the objection. The technical differences and advantages must be evaluated from the perspective of a person skilled in the art. Consequently, it is possible that one person may find the invention achievable based on prior art, while another may not. Additionally, such determination considers whether the combination of prior arts would be straightforward for a person skilled in the art to achieve the invention. This subjectivity can lead to the same patent application being granted in some countries and refused in others.

2. Field of technology:

Different fields of technology may require different approaches or tests to be followed or applied.

- The inventive step in a chemical process might be evaluated based on factors



Ranjan Narula



Suvarna Pandey

like reaction time, yield, and purity of the isolated product.

- In a software/computer related invention, the inventive step is assessed by identifying features that involve technical advancement over prior knowledge or have economic significance, and determining whether these features make the invention non-obvious to a person skilled in the art.
- A patent in a pharmaceutical field is required to demonstrate the enhanced therapeutic efficacy in the case of salts, polymorphs, and other derived forms of a pharmaceutical substance.
- In the biotechnology domain, the new recombinant DNA sequence needs to show more potency and activity as compared to its prior art.

3. Role of Person Skilled in the Art (PSITA)

The inventive step must be evaluated from the point of view of a Person Skilled in the Art (PSITA) and not a common person. The Indian Patent Act does not explicitly describe PSITA. The manual by the Patent Office, however, refers the "Person Skilled in the Art", as a competent craftsman or engineer as distinguished from a mere artisan. The PSITA's role affects the inventive step in the following ways because the assessment of inventive step of a claimed invention is to be made by a two-step process:

- Identification of feature(s), if any, that involve technical advancement over prior knowledge or having economic significance or both; and
- Determination of whether the technical advance or economic significance or both of said feature(s) makes the invention not obvious to a person skilled in the art.

4. Legal framework and precedents:

Different countries have their own legal frameworks and precedents that influence how the inventive step is assessed. For instance, the Indian patent act defines the inventive step as a feature that involves a technical advancement or economic significance, making the invention not obvious to a person skilled in the art.

5. Case-specific factors:

Numerous factors, such as the long gap between prior arts and the invention, the economic significance of the invention, and whether the prior arts teach away from the present invention can also influence the determination of the inventive step. The Delhi High Court in *Societe Des Produits Nestle Sa v. The Controller of Patents And Design [C.A.(COMM.IPD-PAT) 22/2022]* observed that when prior arts cited are more than 20 years older than the patent in question, an apparently minor development meeting a long-felt want may be shown to be non-obvious.

6. Consistency and hindsight analysis:

Courts often emphasize the importance of not using hindsight analysis when evaluating the inventive step. The inventive step must be assessed

Résumés

Ranjan Narula, Managing Partner

Ranjan founded the specialist IP law firm, RNA, in 2004, and is now its Managing Partner. Ranjan has over three decades of post qualification experience in advising companies and entrepreneurs on IP management, monetisation and Technology issues. Providing strategic advice in relation to IP clearance, acquisition, protection, exploitation, and enforcement. Handled over 500 civil and criminal actions for clients in various industries including the IT, telecom, apparel, FMCG, confectionery, beverages (alcoholic and non-alcoholic) and finance industries.

Ranjan is President of the Intellectual Property Attorneys Association (IPAA) and Former Board Member at International Trademark Association (INTA). Ranjan has been ranked as a leading IP practitioner by various publications including WTR 1000, IP Star (Managing IP), WIPR leaders, Who's Who legal, Asia IP experts and others. Ranjan is regularly invited to speak by Universities and chamber of commerce on IP issues.

Suvarna Pandey, Associate Partner

Suvarna is a registered patent agent and a law graduate. Having been in the practice for around 14 years, her specialties include patent searches, patent drafting, and providing patentability and infringement opinions. She is also involved in patent prosecution proceedings at the patent office, opposition and other invalidity proceedings. She is specialized in the development and strategic management of patent portfolios in areas that include Biotechnology, chemical, and pharmaceutical inventions. She has been advising clients on global patent strategy including PCT applications and national phases in designated countries.

Suvarna has also authored various articles and delivered training sessions in the domain of Indian Patent practice.



“ Inventive step is defined as a feature of an invention that involves a technical advance compared to existing knowledge or has economic significance. ”



based on the knowledge available at the priority date of the patent.

Technical differences and advantages

To show inventive step, it is advised to highlight the technical differences and advantages of your invention over the cited prior art. These differences should not be obvious to a person skilled in the art. Provide a) detailed explanations, diagrams, experimental results, and real-world examples, b) use secondary indicators such as long-felt but unmet needs and complexity of work to support the claim, c) define the inventive step in terms of better selectivity, accuracy, efficacy, and other technical improvements over the prior art.

Evaluation steps: court guidelines

- I. The Supreme Court decision in *M/s. Bishwanath Prasad Radhey Shyam v. M/s. Hindustan Metal Industries [AIR 1982 SUPREME COURT 1444]* is considered a pivotal case in Indian patent law for interpreting the inventive step. The Supreme Court of India held that:
 - a) "An invention should not be a mere workshop improvement but must produce a new result, a new article, or a better or cheaper article than before. The relevant excerpt states;
 - b) It is important that in order to be patentable, an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an 'inventive step';
 - c) To be patentable, the improvement or the combination must produce a new result, a new article, or a better or cheaper article than before. The combination of old known integers may be so combined that by their working interrelation, they produce a new process or improved result;
 - d) Mere collection of more than one integer or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent".
- II. The Delhi High Court has laid out a five-step process for evaluating inventive steps in the case of F.

To show inventive step, it is advised to highlight the technical differences and advantages of your invention over the cited prior art.

Hoffmann-La Roche Ltd. and Ors. v. Cipla Ltd. [IRFA (OS) 92/2012 and 103/2012]:

1. Identify an ordinary person skilled in the art;
 2. Identify the inventive concept embodied in the patent;
 3. Impute common general knowledge to a skilled person at the priority date;
 4. Identify differences between the cited matter and the alleged invention;
 5. Decide if the differences are obvious to a skilled person.
- III. The Delhi High Court in *Avery Dennison Corporation v. Controller of Patents and Designs [C.A. (COMM.IPD-PAT) 29/2021]* held that simplicity does not defeat an invention and that the inventive step must be assessed based on the date of priority of the subject patent, not after its publication. The court also emphasized the importance of not using hindsight analysis. The court noted that "a simple change resulted in unpredictable advantages which no one had thought of for a long time, the Court would tilt in favor of holding that the invention is not obvious".
- IV. The Division Bench of the Delhi High Court in *Astrazeneca Ab & Anr. v. Intas Pharmaceuticals Limited [FAO(OS) (COMM) 139/20, 140/20, 155/20, 156/20, 157/20, 158/20, 159/20, 160/20 & 161/20]* held that when the inventor is the same, the test of obviousness cannot be in the context of a "person ordinarily skilled in the art" but must be from the view of a "person in the know".
- **Inventive step in a chemical process:** The Madras High Court in its judgement dated 4th October 2024 in *Embio Limited v. Malladi Drugs & Pharmaceuticals Ltd.*, in a revocation petition, found the following reasons to consider the claimed chemical process as inventive. Resultantly, the petitioner's application to revoke the patent was rejected by the court:
 - a) "The applicant evolved a process with lesser reaction time and better results, especially a drastically

higher yield and superior optical purity of the isolated product compared to prior arts.

- b) The reaction conditions were far simpler than those followed in the prior arts.
- c) The prior arts being much earlier to the patent in question and the applicant showing some advancement over the earlier prior arts indicated that there was no obviousness in the claimed invention."

This order lays down crucial factors when evaluating inventive step for a multi-step chemical process where the challenging party cites prior art documents for individual steps to say that the claimed process is thus the combination. However, the order clarifies the aspects on which the chemical process needs to be compared, i.e., yield, purity of the resulting complex/intermediate, simpler reaction conditions.

To sum up

Determining inventive steps presents several challenges, and the challenges summarised

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below highlight the need for clear guidelines and consistent application of the inventive step criterion to ensure fair and predictable patentability assessments:

- i) The inventive step often involves subjective judgment. It requires evaluating whether a person skilled in the art would find the invention obvious based on existing information.
- ii) The assessment of the inventive step uses a qualitative yardstick compared to the more quantitative assessment of novelty. This can make the evaluation process more complex and less predictable.
- iii) Judicial interpretations can vary, adding to the complexity of determining the inventive step.
- iv) Different countries may have varying standards and approaches for evaluating the inventive step, leading to inconsistencies in patentability decisions.

"Feeling gratitude and not expressing it is like wrapping a present and not giving it."

— William Arthur Ward



For the last 20 years, RNA has been on an incredible journey of handling some of the most complex and interesting issues in the Intellectual Property landscape.

As we celebrate our 20th anniversary, we want to take a moment to express our deepest gratitude to all who have been an integral part of this incredible journey.

- To our clients (aka business partners, aka friends), thank you for your trust and continued support.
- To our friends, thank you for always being there with encouragement and guidance.
- To our dedicated staff, your hard work and commitment have been the backbone of our success.
- To our vendors, thank you for your reliable service and partnership.

Each of you has contributed to our growth and achievements over the past two decades, and for that, we are truly grateful.

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Gordon Samson, President, IP, Clarivate

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Amy Gagich: Senior Manager in Product Management, Intellectual Property, Clarivate

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

Amy is a Senior Manager in Product Management at Clarivate, where she leads two of the company's IP Management Systems (IPMS): Memotech and The IP Management System. With over 20 years of experience in intellectual property preparation and prosecution, she brings extensive knowledge to her role. Prior to joining Clarivate, Amy worked in several law firms and corporate IP departments, serving as a paralegal and IP operations manager. In these roles, she frequently developed policies and addressed various concerns across multiple IP domains, including patents, trademarks, copyrights, and domain names.

What inspired your career?

Like many people, I stumbled into the field of Intellectual Property. Initially, my aspirations were focused on Family and Probate law. After earning my associate's degree, I was eager to find a job near Ursuline College, where I planned to complete my bachelor's. I teamed up with a placement agency that informed me of a sole opportunity: a boutique Intellectual Property firm willing to hire a paralegal with no prior experience. Although I had no understanding of what Intellectual Property truly entailed, my need for employment led me to accept the position.

At first, I wasn't captivated by the work; in fact, I found myself disliking it. My dream of transitioning to family law remained strong, and I decided to endure my time in IP until I graduated and gained more experience to enhance my resume. However, as I persisted, I began to appreciate the intricate role that IP paralegals play in protecting creative ideas and innovations. My perspective shifted as I moved to another firm, where I delved deeper into the nuances of the field. Gradually, I found myself genuinely enthusiastic about the work.

A recent personal challenge – being diagnosed with Mucosal Melanoma – brought a new understanding of how Intellectual Property permeates our lives. I've always enjoyed spotting the brands I supported in stores and witnessing the technologies embedded in the products I used. But this was different. More than a decade ago, treatment options for melanoma were limited; today, thanks to innovation, I have access to various therapies. The work I do to help companies safeguard their intellectual property assets has become profoundly meaningful, to the point where it feels like it has saved my life. This journey





has deepened my appreciation for the vital role we play in fostering innovation and protecting the creativity that shapes our world.

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

My journey to my current role was fueled by a passion for intellectual property and a desire for change. I previously managed a fantastic team dedicated to protecting the assets of one of North America's largest privately held companies. While I loved my job and my team, I felt an urge to explore new opportunities. I wanted to expand my knowledge beyond just IP preparation and prosecution, but I didn't want to leave the industry I was passionate about.

With the support of my mentors at Clarivate, I was thrilled to see an opening and jumped at the chance. Joining the Product Management team was both terrifying and exciting; the opportunity to help my peers maximize their use of the Intellectual Property Management System (IPMS) was too good to pass up. With my extensive experience using various IPMS platforms, I was eager to ensure that customers received the most from their software.

My advice? Embrace new challenges, trust your instincts, and go for it!

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

My biggest challenge is saying no. I genuinely want to help everyone and ensure they have what they need to succeed in their roles; I want to be a cheerleader for all. However, it's impossible to be everything to everyone, and I've realized that I need to establish clear boundaries for myself. I've had to experience failure a few times to truly understand the importance of this.

Learning to say no has been a journey; I've come to see that a no doesn't have to be final – it can simply mean "not right now." Even so, it remains a struggle for me as a people pleaser. I've had to train myself to ask, "If I take on task A, what will I have to sacrifice? Is task A more or less important than what I'm currently doing, and will this affect my other responsibilities?"

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

I've accomplished many wonderful things, but my greatest achievement is mentoring others, particularly women, who are emerging in the field of intellectual property. I take pride in sharing my knowledge and encouraging them to reach their full potential in the industry. Helping others understand the significance of our work and its impact on everyone's success is something I'm truly passionate about.

A stronger emphasis on equality and diversity, along with everyone's capacity for creativity and innovation, is crucial for future generations.



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

I'm excited to continue growing in my product management career, learning from my amazing team and customers. Recently, I was asked to reflect on my favorite managers and the qualities that made them memorable. Two managers stood out for their genuine care and compassion for their teams, along with their willingness to share knowledge and uplift those around them.

My career aspiration is to embody those qualities for others in the IP industry. I want to be the manager or mentor that comes to mind when they are asked about impactful leaders – not because of my own accomplishments, but because I've inspired them to achieve even greater things than I ever could.

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

A stronger emphasis on equality and diversity, along with everyone's capacity for creativity and innovation, is crucial for future generations. Clarivate's Resource Groups and Women in IP Leadership offer mentorship programs specifically designed to support underrepresented groups, particularly women and minorities, as they navigate their careers in intellectual property. These initiatives raise awareness about unconscious bias and educate others on the significance of inclusion. Organizations that offer similar resources to their employees will further enhance equality and diversity in the industry.

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

Empowered women uplift other women. When I started my career, I often felt unsupported by many of my female colleagues. There seemed to be a competitive spirit that led us to undermine each other in the pursuit of success. This environment made me hesitant about my place in IP; I wanted to foster a culture of mutual support and shared success.

When I encountered women who shared my perspective, I felt a strong connection with them. Their empowerment inspired me, and together, we created a supportive network. As younger generations enter our industry, it's essential to encourage them to take on leadership roles and support their growth, rather than fearing they might overshadow us. They can learn from our experiences and knowledge, while we can gain fresh perspectives from them. By empowering the next generation, we can create a legacy of strength and support for the future.

Konnie Love: Senior Manager of IP Administration, Kilpatrick

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

With 38 years in Intellectual Property, Konnie Love is a Senior Manager of IP Administration at Kilpatrick, overseeing critical functions like Docketing, Client Transfers, Patent Tax, and Client Data Services. Starting as a legal secretary in 1986, Konnie Love rose through the ranks, driven by a passion for IP law and a commitment to excellence. She has played key roles in creating an IP Centralized Support Center, a Virtual Patent Prosecution

My greatest challenge was finding my voice and trusting my expertise among highly intelligent colleagues.



Attorney program for drafting patent applications remotely, and a flat-fee billing system. Konnie also serves as a subject matter expert in the selection and deployment of IP software tools and establishing workflow changes due to new system implementations. Dedicated to knowledge transfer and diversity, Konnie focuses on succession planning and advocating for increased opportunities for diverse talent in the IP industry.

What inspired your career?

After leaving active-duty military, I began working as a legal secretary at an IP boutique firm in Washington, D.C. During the interview, an associate asked if I knew the difference between a patent and a trademark. I didn't, but he hired me anyway – likely because we were both Army Reservists. He became an excellent mentor, teaching me every step of the prosecution process and how to research the law. Although he moved to another firm within a year, I was deeply impressed by the intelligence and dedication of IP attorneys. They had JDs, engineering degrees, PhDs, MDs, and had passed the Patent Bar. This inspired me to delve into the fascinating world of IP and help clients secure patents and trademarks.

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

Starting as an IP legal secretary in 1986, I had to learn everything on the job, as there were no formal training programs or Standard Operating Procedures at that time. My mother's saying, "If it is to be, it is up to me," guided me to be mostly self-taught, handling everything from coordinating, filing, and maintaining international patents and trademarks to tracking deadlines on a flip Rolodex docket system. As the role evolved, I pursued a Paralegal/Legal Assistant course and took on more responsibilities, eventually managing Patent and Trademark practice groups, operational budgets, and implementing strategic support systems, i.e., for docketing, workflow allocation, and outsourcing certain paralegal administrative



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tasks. My advice is to surround yourself with knowledgeable people, listen, and be open to new opportunities until you find what truly fulfills you.

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

My greatest challenge was finding my voice and trusting my expertise among highly intelligent colleagues. I hesitated to share my ideas, fearing they might not measure up. A Patent Partner advised me never to present a problem without at least one potential solution, no matter how unconventional. This advice boosted my confidence as my knowledge grew, enabling me to contribute effectively.

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

My greatest achievement is overseeing the establishment and management of an IP Centralized Support Center (IP CSC) from the ground up. This initiative involved Paralegals, Case Assistants, and Docking staff in support of attorneys across all IP practice group offices, optimizing the support staff-to-attorney ratio. By shifting certain support tasks to more cost-effective roles, the IP CSC enhanced client service quality, maximized profitability, and allowed paralegals to focus on higher-value work.

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

Throughout my 38 years in IP, I am constantly mentoring and developing others. My commitment to priming the next generation will serve as a natural succession plan for my role and other management positions – I firmly believe that it's crucial to pass on knowledge to the next generation of leaders. I am also excited to see how AI and other technological advances will open new doors for my career and others in IP. Outside of work, I enjoy traveling and the outdoors, whether it is relaxing time on the lake or adventuring in canyons, rock climbing, or hiking in various countries. When I think about my future, those passions will definitely factor in somewhere!

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

I am fortunate to work at a firm that values diversity, equity, and inclusion. Of course, in the industry overall, I hope to see an increased awareness of IP career opportunities for diverse talent, including attorneys and legal professionals. There should be more IP education and mentorship programs aimed at diverse communities and within colleges, professional schools, and law schools to foster a greater awareness of the richness of IP law and a more inclusive field.

“**Empowerment of women can be expanded by increasing the visibility of women IP attorneys early in their careers, such as at college fairs and STEM events, as well as through several highly visible organizations for women in IP.**”



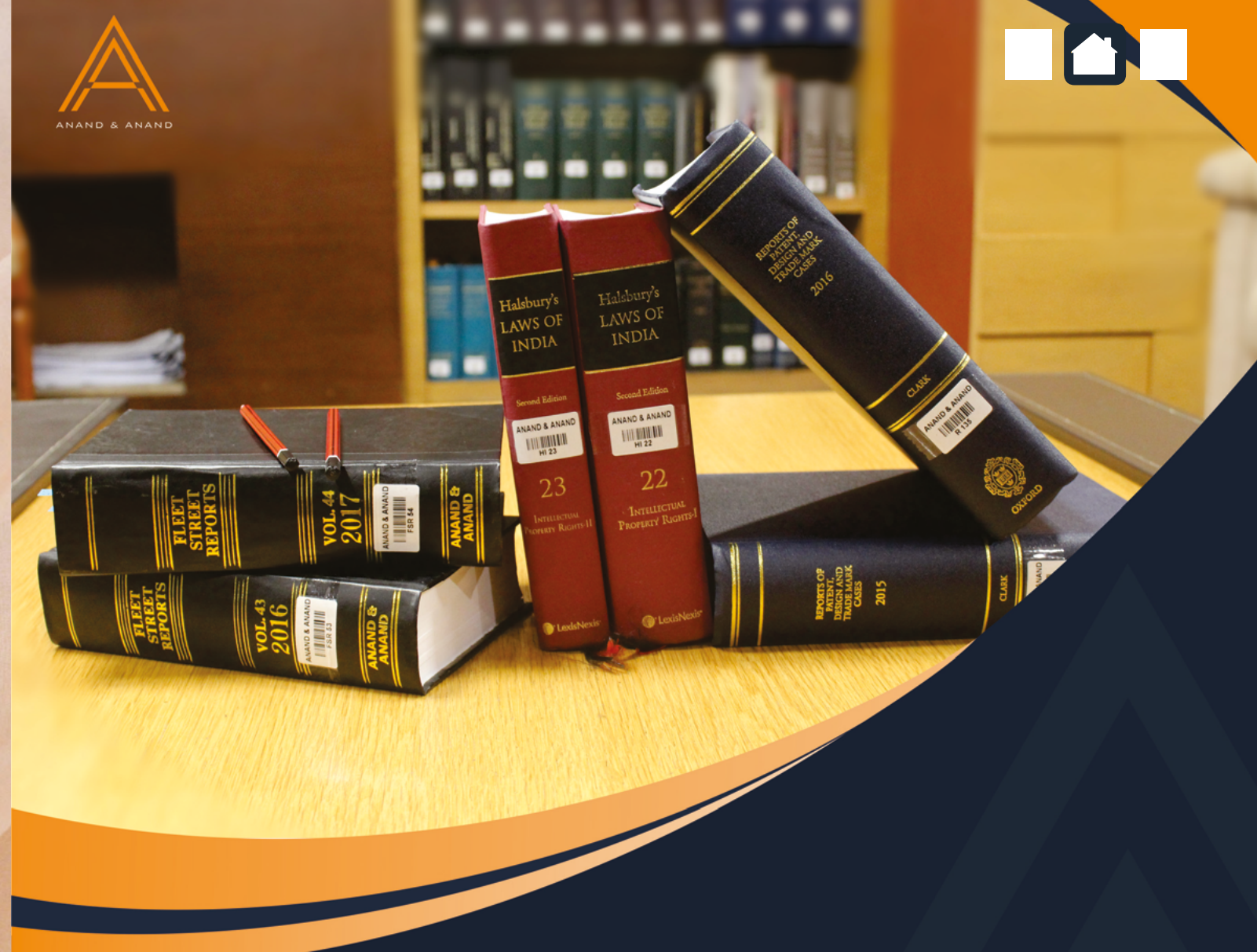
How do you think the empowerment of women can be continued and expanded in the IP sector?

Empowerment of women can be expanded by increasing the visibility of women IP attorneys early in their careers, such as at college fairs and STEM events, as well as through several highly visible organizations for women in IP. For example, our firm is an active participant and sponsor of the ChiPs Network, a global community representing more than 7,000 women in technology, law, and policy. There are also many impressive women role models within my firm, including successful partners, senior firm leaders, and our new IP Department Chair. These examples can inspire the next generation of women to pursue careers in IP, demonstrating the diverse opportunities available in the field.



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Jurisdictional Briefing, Russia: rising official fees at the Russian patent office: key changes in patent and fee regulations

Dr. Tatiana Vakhnina and Dr. Alexey Vakhnin of Vakhnina and Partners introduce the fee changes effecting registrations as of October 2024 in Russia.

As of October 5, 2024, new fees for IP objects have come into effect at Rospatent.

The general amendments are the following:

- Average fees have increased by 12–15%;
- The 30% discount for filing of applications in digital form is now non-applicable;
- New subtypes of state fees are introduced.

Key aspects:

The abolition of discounts for digital processing

Digital filing was very popular in Russia due to the 30% discount for filing of applications in digital form.

In this regard, many companies have completely turned to digital filing and processing of the applications. As of October 5, these discounts are not provided anymore, and now the fee for digital filing should be paid in full.

Grace periods are reduced

The additional period provided for payment of the state fees stipulated for the registration of an application for registration of a trademark or service mark, examination of a designation, registration of a trademark has been reduced from six months to one. The main requirement for obtaining this additional period is the payment of the fee in full (previously it was necessary to pay 50%) (item 10 of the Amendments in the Provision).

Patents for inventions, utility models, and designs

The list of legally significant actions related to the consideration of objections filed within the Rospatent was supplemented with new positions.

Serious changes have occurred in the amount of the state fee for extending the validity of an



Dr. Tatiana Vakhnina



Dr. Alexey Vakhnin

invention related to a product such as a drug, pesticide, agrochemical: the state fee has increased from 3,000 rubles to 100,000 rubles.

The rules of patent extension have also changed: it is now necessary to pay the fee for years one-five instead of the annual extension. Registration of an application for patent granting:

1. Registration of an application for an invention:

Previously the fee was 3,300 rubles + 700 rubles for each claim in excess of 10. The new fee is 4,000 rubles + 1,000 rubles for each claim in excess of 10.

2. Registration of an application for a utility model:

Previously the fee was 1,400 rubles + 700 rubles for each claim in excess of 10. The new fee is 2,000 rubles + 1,000 rubles for each claim in excess of 10.

3. Registration of an application for a design

Previously the fee was 1,700 rubles + 700 rubles for each design in excess of 1. The new fee is 2,000 rubles + 1,000 rubles for each design in excess of 1.

Making a decision on the results of application examination and registration:

Previously the fee was 12,500 rubles for invention + 9,200 rubles for each independent claim in excess of 1. After the amendments the fees for inventions are 14,000 rubles + 10,000 rubles for each independent claim in excess of 1.

Previously the fee for an utility model was 2,500 rubles, now it is 3,000 rubles.

Registration of an invention, utility model, design, publishing of information, granting of patent in a form of digital document

(New amendment – maintenance of patent validity for years one-five of patent activity):

Previously the fee was 3,000 rubles (the item did not include the term on maintenance of Russian Federation patent validity for years one-five)- now is 10,000 rubles.

Right: Table 2 : Changes of official fees for registration of a trademark/service mark:

Below: Table 1: Changes in patent official fees

Before	Now
Filing of an application for patent granting	
Invention – 3,300 rubles + 700 rubles for each claim in excess of 10.	Invention – 4,000 rubles + 1,000 rubles for each claim in excess of 10.
Utility model – 1,400 rubles + 700 rubles for each claim in excess of 10.	Utility model – 2,000 rubles + 1,000 rubles for each claim in excess of 10.
Design – 1,700 rubles + 700 rubles for each design in excess of 1.	Design – 2,000 rubles + 1,000 rubles for each design in excess of 1.
Application examination	
Invention – 12,500 rubles for invention + 9,200 rubles for each independent claim in excess of 1.	Invention – 14,000 rubles + 10,000 rubles for each independent claim in excess of 1.
Utility model – 2,500 rubles.	Utility model – 3,000 rubles.
Design – 3,000 rubles + 2,500 rubles for each design from a designs group in excess of 1.	No changes of fee for a design
Registration of an invention, utility model, design, publishing of information, granting of patent in a form of digital document, maintenance of patent validity for years one-five of patent activity	
3,000 rubles (the item did not include the term on maintenance of Russian Federation patent validity for years one-five)	10,000 rubles

Résumés

Dr. Tatiana Vakhnina is a Senior Partner and founder of Vakhnina and Partners, Eurasian Patent Attorney, Patent and Trademark Attorney of the Russian Federation with extensive experience in IP since 1970s in trademark prosecution, disputes and litigation. Tatiana is a Honorary Advocate of the Russian Federation, and an active member of a number of Russian and International IP Organizations and the professional community of Patent Attorneys in Russia.

Dr. Alexey Vakhnin is Partner and Managing Director of Vakhnina and Partners. He is a Eurasian Patent Attorney, and Patent and Trademark Attorney of the Russian Federation, with extensive experience in IP since 1990s. As of October 2024, Alexey is President of the Chamber of Russian Patent Attorneys and a member of the Eurasian Patent Attorneys Assembly (EPAA), FICPI, AIPPI, LESI, INTA, ECTA, PTMG etc. With a PhD in Medicine (Biochemistry and Immunology), working on patent matters, Alexey specializes in Medicine, Biotechnology, Biochemistry, Pharmacology, Pharmaceuticals.

Before	Now
Application filing	
3,500 rubles + 1,000 rubles for each claimed ICGS class in excess of 5.	4,000 rubles + 1,000 rubles for each claimed ICGS class in excess of 1.
Designation examination	
11,500 rubles + 2,500 rubles for each claimed ICGS class in excess of 1.	13,000 rubles + 2,500 rubles for each claimed ICGS class in excess of 1.
Registration and issuance of certificate as a digital document	
16,000 rubles + 1,000 rubles for each claimed ICGS class in excess of 5.	18,000 rubles + 2,000 rubles for each claimed ICGS class in excess of 5.
Issuance of documents on paper	
2,000 rubles.	3,000 rubles (It is planned to completely stop to issue documents on paper).
Total: 33,000 rubles.	Total: 38,000 rubles.

Trademarks, service marks

The Provision has introduced new official fees for the trademarks. For your convenience, we have summarized the main changes in Table 2. If you or your clients need advice on payment of new fees or practical use of new changes, the experts at Vakhnina and Partners will be glad to provide you with more detailed information.

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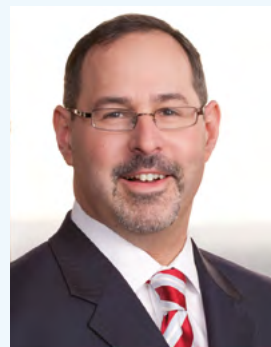
Jurisdictional Briefing, US: Federal Circuit overhauls longstanding test for non-obviousness as applied to design patents

Steven M. Coyle, Partner and Litigation Chair at Cantor Colburn, reviews the Federal Circuit's recent decision to discard the *Rosen-Durling* test, eliminating previously key factors for determining obviousness.

The Federal Circuit recently discarded the *Rosen-Durling* test, its long-established test for assessing non-obviousness as it relates to a challenged design patent and pending applications. The case, *LKQ CORPORATION, et al ("LKQ") v. GM GLOBAL TECHNOLOGY OPERATIONS LLC ("GM")*, related to a design patent owned by General Motors for the automobile fender used on the Chevrolet Equinox. The court considered whether the longstanding *Rosen-Durling* test should be overturned in light of more recent Supreme Court rulings. The court ultimately replaced the *Rosen-Durling* test with a modified version of the *Graham* multi-factor analysis long used for assessing the non-obviousness of a utility patent.

Overview

In the underlying IPR petition, LKQ challenged the claim of US Design Patent No. D797,625 (the "625 Patent") as unpatentable pursuant to 35 U.S.C. §102 as anticipated by the Lian Patent (D773,340), or under 35 U.S.C. § 103 in view of the Lian Patent, "as modified by a promotional brochure depicting the design of the front fender on the 2010 Hyundai Tucson."



Steven M. Coyle

In the IPR, the PTAB applied the two-part inquiry of the decades old *Rosen-Durling* test to assess the non-obviousness of the '625 Patent. The first part of the *Rosen-Durling* test required that the primary reference must be "basically the same" as the challenged design claim and that any secondary references must be "so related" to the primary reference that features in one would suggest application of those features to the other. As the Board explained, *Rosen's* "basically the same" test required consideration of the visual impression created by the patented design as a whole. If no "*Rosen*" primary reference was found, the analysis would stop there and there would be no analysis of secondary references. The Board found LKQ failed to establish the first part of the *Rosen-Durling* test and thus did not consider the second portion of the inquiry.

LKQ appealed the IPR decision to the Federal Circuit *en banc*, which considered the argument made by LKQ that the Supreme Court in *KSR International Co. v. Teleflex Inc.* (2007) indirectly overruled the *Rosen-Durling* test. After considering the Supreme Court's precedent and accompanying framework for analyzing non-obviousness as it relates to design patents, the Federal Circuit

found its current framework (i.e., *Rosen-Durling* test) to be "out of step" and "improperly rigid" as compared to the Supreme Court's framework utilized in utility patent non-obviousness analyses.

In place of the *Rosen-Durling* test, the Federal Circuit crafted a slightly modified version of the obviousness test established in *Graham v. John Deere Co.* of Kansas City (1966), traditionally used only to assess the validity of a utility patent based on 35 U.S.C. §103.

Under the Federal Circuit's new design patent non-obviousness analysis, a factfinder must, first, consider the following when analyzing a challenged claim of a design patent: (1) "the scope and content of the prior art" as applied to an "ordinary designer" within the relevant field; (2) differences (if any) between the prior art designs and the design claim at issue; and (3) an evaluation of the level of ordinary skill in the relevant art. Once all factors have been considered, the court will examine the obviousness or non-obviousness of the claimed design of the design patent, with a focus on the "visual impression of the claimed design as a whole." The court must also examine the primary reference and any relevant secondary references. As with the *Graham* analysis for utility patents, the court must, lastly, consider "secondary considerations as indicia of obviousness or non-obviousness," which include: "commercial success, long felt but unsolved needs, and failure of others, etc."

The new analysis eliminates the *Rosen-Durling* requirement of finding a "basically the same" primary reference and that any secondary references must be "so related" to the primary reference that features in one would suggest application of those features to the other.

Résumé

Steve M. Coyle, Partner and Litigation Practice 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.

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Practical takeaways

The Federal Circuit left "[...]it to the future cases to develop the application of this standard" in the years to come. It is clear that the new non-obviousness design patent inquiry is likely to spark more challenges to design patents at the PTAB. Since the new test is significantly more flexible than *Rosen-Durling*, design patent applicants will likely face increased difficulties securing patents on their designs based on similar prior art designs that are not "basically the same" as the patents or applied-for design.

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Applying for design patent protection in the USA

Jeremy W. Miller and Wendy M. Slade of Dowell & Dowell explore the essentials of design patent protection in the US with insights on application procedures, drawing requirements, and common pitfalls.

Design patent protection has become an increasingly important part of intellectual property portfolios in the United States, as they add another layer of protection to certain goods in the marketplace. However, the procedure and rules surrounding US design patent practice are not widely known, especially to foreign parties seeking protection.

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.

It is important to understand the pitfalls of design patent practice and how to best avoid them before filing a design application in the United States.

First, a US design patent protects the ornamental appearance of an object, which may include the shape and configuration of the object or its surface ornamentation. However, a US design patent is more than a simple registration. A design patent application undergoes examination just like a utility patent application claiming the structure of an article or a particular method of use. Unlike the utility application, which is examined in view of the claim set, a design patent application is examined in view of the drawings themselves. Therefore, the drawings of the design patent application must be considered as important as any aspect of the claims of a utility patent application.

Further, the drawings in a design patent application constitute, in most cases, the entire disclosure of the ornamental appearance to be protected. Lengthy written descriptions are not allowed in a design patent application, so the drawings must stand alone in disclosing the ornamental design. A title and short statement about the intended use of an article may provide some context, but otherwise, the drawings must clearly show every aspect of the article and ornamentation to be protected.

With that in mind, applicants should include as many views as needed in their design patent applications to show the ornamentation effectively and accurately. If a view is not shown effectively, it does not exist. If a view does not exist at the time of filing the design application, a later addition of that view would constitute impermissible

new matter. The only exception to this rule is in the case of simple mirror images. For example, if the left-side view of an article (e.g., a fork) is a mirror image of the right-side view, the left or the right-side view only may be submitted along with a statement that the views are mirror images. If one view is submitted without a statement that the two views are mirror images, adding such a statement or submitting the other side view after filing would again be impermissible new matter.

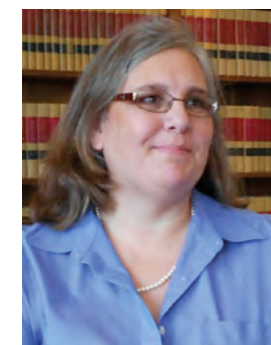
Perspective views of an article should routinely be included in the drawings of a design patent application, as they offer a good deal of information concerning the three-dimensional nature of the article and ornamentation and are used by an examiner to help determine depth and contour. Such views are particularly important to include when depicting articles where one dimension is much smaller than the other two. For example, perspective views of tiles or duvets are necessary to distinguish those articles from other objects that more closely resemble two-dimensional objects. Otherwise, the scope of prior art available to the examiner may become much wider than intended.

In other countries, drawings for design patents or industrial design registrations need only be simple line drawings, photographs, or computer-aided design (CAD) drawings without the need for many views or strict consistency between any included views. However, the United States Patent and Trademark Office (USPTO) does not accept CAD drawings in a design patent application, and color photographs are only accepted through the filing of a petition and fulfillment of other requirements. Further, simple line drawings are not sufficient in most cases to depict a design accurately and adequately. Shading and broken lines are commonly used to fully depict ornamentation.

As best practice, any drawings that are intended to be used in a US design patent application should include shading to provide character and contour of surfaces for claimed subject matter. Lack of such shading can lead to enablement issues which sometimes cannot be fixed after filing without prompting a new matter issue. Additionally, the type and form of shading used matter to show features or properties of surfaces. Straight-line shading and stippling are commonly used alone or in combination to provide depth and context to design drawings. Oblique line shading can show transparency, translucency, or reflective surfaces. Shading should not be used in unclaimed areas of drawing figures. Each type of shading used helps the examiner and, ultimately, anyone viewing the drawings to understand the claimed design more completely.



Jeremy W. Miller



Wendy M. Slade

A US design patent application should include shading to provide character and contour of surfaces for claimed subject matter.

Broken lines are used in design patent applications for a multitude of reasons. The most common reason is to show the environment around the claimed design. An example would be to use broken lines to show a chair on a porch or at a table. Another reason to use broken lines is to show portions of the article which are not claimed, such as a purse where the handles are shown in broken lines when only the bag itself is being claimed in solid lines. As part of each of these, broken lines are used to show parts of the claimed design, such as folding or stitching. They can be used to show "visible environmental structure".

While a simple claim is included in a design patent, the drawings form the substantive boundaries of the claim and are the basis of a design patent's protection. Therefore, like with utility applications, the applicant is limited to one claimed invention per application. If multiple designs are included in one application, the examiner will require the applicant to elect one design for examination in the application. Like with utility patent applications, any non-elected designs can be pursued in subsequently filed divisional applications at any point up to the issuance of the current design as a patent or abandonment of the design application.

Before filing a design patent application, it is important to remember that US patent examiners closely review the drawings to ensure that consistency of the design is maintained throughout the different views. Issues with consistency at filing can limit the scope of protection or jeopardize the allowability of the design patent application. A US patent attorney with experience in dealing with design patent prosecution can assist an applicant in properly formatting drawings, ensuring sufficient views, advising on shading and broken line usage, and consistency of views. If interested, the professionals at Dowell & Dowell, P.C. can lend their expertise to these issues.

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Current challenges in Mexican patent practice: divisional applications and double patenting

Sergio Olivares and Mauricio Samano of OLIVARES explore the evolving landscape of patent law in Mexico, with a focus on the complexities of divisional applications and the challenges faced by applicants navigating the new legal framework.

Since our current IP law (LFPPI) entered into force on November 5, 2020, we have seen several positive changes in Mexican patent practice. Our current IP law contemplates the patentability of medical uses and specifically contemplates the possibility of filing voluntary divisional applications. Another magnificent change in our IP law relates to grace periods. Article 52 of our new law still provides a 12-month grace period wherein public disclosures made by the applicant or their successor in title do not destroy novelty, provided that said disclosure was made within 12 months before the filing date or the priority date. Nevertheless, it broadens the activities that may qualify for getting the grace period, including now any disclosure made directly or indirectly by the inventor(s) or its assignees, as well as any disclosure made by any third party who obtained the information directly or indirectly from the inventor/s or its assignees. Last but not least, our current IP law contemplates for the first time the possibility of requesting patent term adjustment due to unreasonable delays that are directly attributable to the Mexican Institute of Industrial Property (hereinafter referred to as IMPI).

The benefits of our current IP law are clear; however, in practice, we are dealing with a series of erroneous interpretations of our IP law that are complicating the prosecution of patent applications in Mexico. Specifically, Examiners are misinterpreting the articles of our law pertaining to divisional applications and double patenting and raising



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objections that lack any basis in our Law. This has been possible because, at this moment, the Regulations of our current IP law are still being drafted, and the applicable Regulations to our current law are those of our previous IP law which do not contemplate any provisions on how to regulate divisional applications and double patenting. In the next paragraphs, we will describe the current challenges we are facing in Mexico and hope to provide a clearer picture for applicants seeking to protect their inventions in Mexico.

Divisional applications

Article 100 of our current IP Law is the main article regulating the filing of divisional applications in Mexico. It contemplates the possibility of filing divisional applications either voluntarily or through a requirement issued by IMPI, such as a lack of unity objection. It also defines the timeframe for filing divisional applications and specifically states that a voluntary divisional application will only be possible if it derives from its parent case. In other words, voluntary divisionals deriving from divisionals will no longer be allowed. The only possible scenario for filing cascade divisionals (divisionals from divisionals) is if the Mexican PTO requests further division through a lack of unity objection. Article 100 of our IP law also mentions that when unity of invention is objected to, any invention or group of inventions that are not included in the initial application or in the application that originated the division cannot be included again in any of said applications.

On the other hand, article 113 of our IP law states that when an application lacks unity of invention, the Examiner will consider only the main invention that is mentioned first in the claims and will evaluate the compliance of the remaining patentability requirements (novelty, inventive step, etc.) only for this invention which is mentioned in first place in the set of claims. In this case, the Mexican PTO will require the applicant to limit the claims to the main invention and, if the case is, to file the corresponding divisional(s) applications.

Article 113 has caused several problems in Mexican patent practice because Examiners are raising a series of objections based on this article, which complicates the strategy for filing divisional applications.

There have been cases in which applicants receive a lack of unity objection in a first office action, and instead of limiting the claims of the parent case to those of the first invention identified by the Examiner, they decide to limit the claims of the parent case to one of the other inventions identified by the Examiner. However, in the second office action, the Examiner states that according to article 113 of our current IP law, the applicant is obligated to limit the claims of the parent case to those of the invention which is mentioned in first place in the set of claims and cannot claim any other invention in the parent case. In some cases, the Examiner has even gone to the extent of requesting the applicant to abandon the parent case and file a divisional application directed to the invention of interest in order to comply with Article 113 of our current IP law. From our point of view, this interpretation of Article 113 of our IP Law is erroneous and does not benefit the applicant. Article 113 only mentions that when unity of invention is objected to, the Mexican PTO will evaluate the invention that is mentioned at the beginning of the set of claims and that the applicant is required to limit the claims of the parent case to those of the "main invention." However, article 113 does not specifically say that the applicant is obligated to limit the scope of the parent case to the invention that is mentioned in the first place of the set of claims and that none of the other identified inventions can be claimed in the parent case. With this interpretation, the Mexican PTO is making an arbitrary decision and forcing the applicant to claim in the parent case an invention that, at that time, may no longer be of commercial interest to him.

Another erroneous interpretation we have observed regards the timing for filing divisional applications after receiving a lack of unity objection. We have seen cases in which, based on Article 113, Examiners request the applicant to file all the divisional applications of interest when replying to the office action that raised the lack of unity objection. In other words, if in the office



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Mauricio Samano works in the patent department of our firm. His work in OLIVARES mainly focuses on prosecuting Chemical, Biotechnological, and Pharmaceutical patent applications, as well as providing technical opinions regarding patent infringement. He has experience in conducting state-of-the-art searches and drafting patents, utility models, and industrial design applications. Additionally, he is a member of the International Patent Law and Trade Committee, as well as of the Latin American Practice Committee of Intellectual Property Owners (IPO) organization.



action, the Examiner raises a lack of unity objection and identifies three inventions, the applicant is required to keep the first invention in the parent case and, at that moment, file a divisional application directed to the second invention and another divisional directed to the third invention. This interpretation is completely erroneous since neither Article 100 nor Article 113 contemplate that limitation. As drafted, our current law can perfectly contemplate the possibility of limiting the scope of the parent case to one of the inventions identified by the Examiner and filing a single divisional application containing the remaining inventions that were eliminated from the parent case as a result of the lack of unity objection. Also, this interpretation is contradictory to the paragraph of Article 100, which mentions that it is possible to file a divisional that derives from another divisional in case the Mexican PTO requests the division through a lack of unity objection. It is clear that our IP law contemplates the possibility of filing a single divisional application that contains multiple inventions, and the criteria followed by some Examiners of the Mexican PTO lacks any legal basis in our IP law.

Double patenting

It is worth mentioning that double patenting has long been an issue in Mexico and, in practice, before our current IP law entered into force, Examiners tended to raise double patenting objections when there was scope overlap between the claims of a divisional and those of its parent case. However, double patenting was not defined in our previous law, so it was feasible to argue that the only scenario in which double patenting existed was if the scope of the claims of the divisional was identical to the scope of the claims of the parent case from which said divisional derived from. This argument proved successful with IMPI.

Our current IP law does contemplate specific provisions regarding double patenting. However, these provisions are very vague, leaving a considerable grey area for interpretation. The specific articles that regulate double patenting in our current IP law are Articles 50 and 101, which mention the following: "During substantive examination and in the granting of rights, IMPI shall look out for the public domain and prevent double patenting of the same invention," (Article 50) and "No patent will be granted to matter that is already protected by another patent, or which essential technical characteristics are a non-substantial variation of the matter protected by another patent, even when the applicant is the same in both," (Article 101).

Since our current IP law does not define what should be considered as a "substantial variation,"

“**The current scenario in Mexico is positive and we are hopeful that the publication of the Regulations of our current IP Law will now be a priority.**”

Examiners are issuing double patenting objections in many divisional applications that only have a minor scope overlap with the claims that were granted in the parent case that originated said divisional and which are clearly directed to different subject matter. There is an urgent need to define what is considered as a "substantial variation" so that, when performing the substantive examination, Examiners can focus on the relevant patentability issues of a divisional application (novelty, inventive step, enablement, sufficiency, etc.) from the beginning instead of putting time and effort into searching any kind of scope overlap to justify raising a double patenting objection.

Conclusions

In closing, our new IP Law offers several benefits for patent owners, and we can say that the balance is mostly positive. However, as we have mentioned in the previous paragraphs, our IP law still has many grey areas, particularly regarding divisional applications and double patenting. It is of utmost importance that the Regulations of our current IP Law are published as soon as possible so as to provide a clear path for applicants that seek to protect their inventions in Mexico since at this moment four years have passed since our current IP law entered in force and we are still using the Regulations of our previous law to interpret our current law.

In Mexico, we have a new president who started her one-term of six years on October 1, 2024, and she recently appointed a new head of the Mexican Institute of Industrial Property, a lawyer with extensive experience in several areas of public service. Our new head of the Mexican Institute of Industrial Property has expressed an interest in working closely with the Mexican IP associations. Thus, the current scenario in Mexico is positive and we are hopeful that the publication of the Regulations of our current IP Law will now be a priority.

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Ronny started his patent law career in New York at Kenyon & Kenyon in 2004. He further developed his knowledge and expertise at various international law firms in Europe.

Ronny received his diploma in Patent Litigation in Europe from CEIPI and his Master of Laws degree in Intellectual Property Law from Munich Intellectual Property Law Center partnering with the Max Planck Institute and the George Washington University Law School. He studied biomedical engineering at University of California-San Diego.

Sample Representative Matters:

- A medical device company: image guided surgical robots.
- A medical device company: minimally invasive solutions for the aesthetic markets.
- A medical device company: intraocular lens solutions for cataract surgery.
- medical device company: anti-aging technologies.
- A medical laser and energy-based devices manufacturer.
- A global leader in providing investigative analytics software.
- A biotechnology company developing Bio-artificial Pancreas, intended to cure Type 1 diabetes.

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Federal Circuit ruling further narrows the printed matter doctrine

Peter Gao, George Chen, and Cory Smith of Bryan Cave Leighton Paisner review the recent *IOENGINE v. Ingenico* ruling which addressed whether limitations related to “encrypted communications” and “program code” are considered printed matter under federal statutes regarding prior art.

A recent precedential decision from the US Court of Appeals for the Federal Circuit addressed whether patent claim limitations pertaining to informational content are considered printed matter. In particular, *IOENGINE v. Ingenico*,¹ addresses whether “encrypted communications” and “program code” are claims limitations considered to be printed matter under the federal statutes regarding prior art.

Discussion by Federal Circuit on printed subject matter

On May 3, 2024, the Federal Circuit reversed, in part, the Patent Trial and Appeal Board’s (the “Board”) determinations of unpatentability as to some of the claims of US Patent Nos. 9,059,969 and 9,774,703 (the “’969 Patent” and the “’703 Patent”), and the Court also affirmed the Board’s determination of unpatentability of the rest of the claims in the two patents.

IOENGINE owns US Patent No. 8,539,047, as well as the ’969 Patent and the ’703 Patent (collectively, the “Challenged Patents”), which issued from a common parent application and cover a tunneling client access point.²

The dispute began on March 23, 2018, when IOENGINE sued PayPal in the US District Court for the District of Delaware for patent infringement under the Challenged Patents. As PayPal’s supplier of the alleged infringing products,³ Ingenico filed an action for declaratory judgement against IOENGINE on the same day. Then, on December 17, 2018, Ingenico filed petitions for *inter partes* review (“IPR”) of the Challenged Patents at the Board.

The Board found various claims of the Challenged Patents to be unpatentable.⁴ In doing so, the

Board applied the printed matter doctrine to invalidate the claims of the ’969 Patent and the ’703 Patent under the prior art. IOENGINE appealed the Board’s findings to the US Court of Appeals for the Federal Circuit, arguing that the Board incorrectly applied the printed matter doctrine.⁵

Case law holds that limitations deemed to be “printed matter” are given no patentable weight.⁶ The courts (and the Board) apply a two-step test to determine whether a limitation is considered “printed matter.” First, courts determine whether the limitation in question is directed toward printed matter. If the limitation is determined to be printed matter, then courts proceed with the second step of asking whether the printed matter nevertheless should be given patentable weight.⁷ Printed matter can be given patentable weight if the claimed informational content has a functional or structural relation to the substrate on which the information content is printed.⁸

Various claims in the Challenged Patent required the limitations of “encrypted communications” and “program code,” and the Board found that such limitations were not entitled patentable weight.⁹ First, the Board reasoned that “encrypted communications” is printed matter because it claims only communicative content and nothing in the claim requires anything beyond sending and receiving data, even if the data is in an encrypted form. Second, the Board found that “encrypted communications” is not entitled to patentable weight because nothing in the claims required the encrypted data to be used, manipulated, or processed, beyond just its transmission.¹⁰ Likewise, the Board determined that “program code” is printed matter because it claims the

“**The Federal Circuit ended the printed matter analysis after the first step, and did not need to proceed with the second step.**”



Résumés

Peter Gao is an Intellectual Property Attorney who focuses on domestic and international patent prosecution, litigation, and licensing matters. He provides strategic counseling from startups to Fortune 100 companies in all areas of technology, often filing applications with freedom to operate and clearance considerations to strengthen the position of the system or method against infringement. Peter's experience includes working with mobile devices, displays, augmented and virtual reality devices, semiconductors and hardware, medical devices, and complex software including AI/ML. He is often credited in successfully navigating through USPTO examiner considerations and managing office actions for 101, 102, and 103 rejections.

Cory Smith is a registered Patent Attorney whose practice focuses on intellectual property law and technology transactions, with an emphasis on computer-related technologies. As a thought leader on the intersection of patent and artificial intelligence issues, he regularly handles patent matters in the US and foreign jurisdictions across various technology areas. Cory often advises on patent preparation and prosecution, patent litigation and pre-litigation, post-grant proceedings, patent analysis and counseling, trademark preparation and prosecution, trademark counseling, trademark disputes, copyright preparation and prosecution, and copyright disputes.

George Chen is a nationally recognized, award-winning intellectual property lawyer who litigates high-stakes IP disputes and manages and prosecutes patent and trademark portfolios. As the leader of the intellectual property practice for the BCLP's Phoenix office, George partners with long-term clients to develop, protect, enforce, defend, license, and commercialize intellectual property and other business assets. His practice includes litigation, licensing, counseling, and prosecution of patents, trademarks, copyrights, trade secrets, unfair competition, Internet, cybersquatting, and other intellectual property matters.



Cory Smith



George Chen

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content of the information that is downloaded, and that “program code” is not entitled to patentable weight because the code is merely generic and has no functional relationship to the device that runs the code.¹¹

On appeal, the Federal Circuit disagreed with the Board¹² and concluded that the “encrypted communications” and “program code” limitations were not printed matter because they did not claim the content of the information. Thus, the Federal Circuit ended the printed matter analysis after the first step, and did not need to proceed with the second step. The Federal Circuit explained that the printed matter doctrine excludes only “what is communicated - the content or information being communicated - rather than the act of a communication itself.” Because no content of the printed matter was being claimed, the Federal Circuit refused to apply the printed matter doctrine to remove the limitations from the claims when analyzing validity under 35 U.S.C. §§ 102 and 103.

Accordingly, the Federal Circuit reversed in-part the Board's invalidity determinations for claims 4 and 7 of the '969 Patent and claims 61-62 and 110-11 of the '703 Patent.

Practice tips

Although the Federal Circuit has further narrowed the printed matter doctrine with this precedential opinion, patent drafters and prosecutors should still remain cautious when claiming limitations that may be deemed printed matter, especially when the claim limitations cover informational content of software code and data, and patent litigators should be aware of these potential invalidity arguments.

First, avoid claiming generic software code. From a validity perspective, it is very likely that generic software code can be found in the prior art. Also, from an infringement perspective, claiming generic software code provides additional limitations that need to be met to prove infringement. In short, claiming generic software code provides more drawbacks than benefits.

Instead of claiming generic software code, patent drafters and prosecutors can focus on claiming software code that is unique to the invention, if claiming software code is necessary in the first place. For example, the claimed software code can be organized in a specific way that improves the function of the device to avoid the printed matter doctrine. Moreover, validity challenges using the printed matter doctrine can often be avoided altogether for software inventions by drafting or amending the claims to focus on the operations performed by a processor without reciting software code at all in the claims.

Second, if claiming generic software code is necessary, patent drafters should explain in the detailed description of the patent application

how the software code has a functional or structural relation to the device using the software code. Patent prosecutors also can argue this functional or structural relation in response to an Office Action from the US Patent & Trademark Office, and patent litigators can make the same argument on behalf of the patent owner. However, this explanation and argument can be difficult to make with generic code because it is a “Catch-22” situation.

If you find yourself needing to argue that the generic code has a functional or structural relation to the device, one strategy can be to argue that the software code is not generic. In other words, patent drafters, prosecutors, and litigators can describe the software code to be organized in a specific way that improves the function or structure of the device that runs the software code. Additionally, patent drafters, prosecutors, and litigators can describe the software code to be organized in a manner that is not obvious. However, as indicated above, arguing that truly generic software code has a functional or structural relation to the device that runs the software code can be difficult because generic software code typically precludes a functional or structural relation to the device that runs the software code.

Finally, patent drafters and prosecutors can incorporate the use, manipulation, or processing of data in the patent claims. Despite the Federal Circuit reversing-in-part the Board's findings in

¹ *IOENGINE, LLC v. Ingenico Inc.*, 100 F.4th 1395 (Fed. Cir. 2024).
² *Id.* at 1400.
³ *IOENGINE, LLC v. PayPal Holdings*, Civil Action No. 18-452-WCB (D. Del. Aug. 21, 2019) at 11.
⁴ *IOENGINE*, 100 F.4th at 1400.
⁵ *Id.* at 5.
⁶ *Id.* at 9.
⁷ *Id.*
⁸ *Id.* at 10.
⁹ *Id.* at 10-12.
¹⁰ *Id.* at 10.
¹¹ *Id.* at 12.
¹² *Id.* at 10-12.
¹³ *Id.* at 10.

IOENGINE v. Ingenico, the Board's reasoning for when software code has no functional or structural relation to the device that runs the software code may still be valid.

More specifically, the Board found that “there was no functional relationship ... because nothing in the claims required ‘the data being used or manipulated’ or ‘any processing of encrypted data beyond the transmission of the same.’” Therefore, patent drafters and prosecutors can try to incorporate manipulation or processing of data in the claims to avoid a potential court ruling that the claimed software code has no functional or structural relation to the device. For a device that merely acts as a passthrough for printed matter, however, that printed matter will likely not have a functional or structural relation to the device.

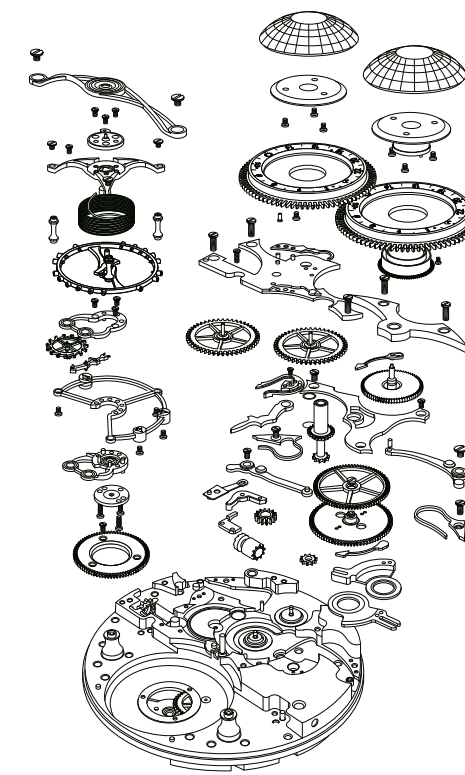
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Punitive damages in patent infringement under Chinese intellectual property law: legal framework, requirements, and practical insights

Ji Liu, Director of the patent litigation department at CCPIT Patent and Trademark Law Office, outlines the essential requirements for claiming punitive damages, focusing on the importance of timely claims and the need to demonstrate intentionality and severity in the infringement.

Introduction: evolution of punitive damages in IP law

The concept of punitive damages in Chinese Intellectual Property (IP) law was first introduced in the 2013 revision of the Trademark Law. However, the legal foundation for applying punitive damages to patent infringement was only established with the enactment of the *Civil Code* in January 2021. Subsequently, the *Fourth Amendment of the Patent Law*, which came into effect in June 2021, formally incorporated a punitive damages mechanism, allowing courts to award up to five times the amount of damages in intentional and severe infringements.

Since the introduction of punitive damages in patent law, the number of patent infringement cases seeking such damages has increased significantly. However, courts have remained



Ji Liu

Résumé

Ji Liu is Director of the Patent and Trademark Law Office at CCPIT and has worked as a patent attorney since 2001. He has a master's degree in polymer science and studied IP law at the Cardozo School of Law, and in US and German law firms. Ji has handled dozens of infringement litigations in different trial courts across China, among which was a case selected by Tianjin Municipal High Court as one of the Top 10 cases of 2018. Before switching to litigation, he handled more than 1,000 patent filings covering various technical fields.

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cautious in granting these claims, resulting in only a limited number of successful cases. This cautious approach reflects two primary factors:

1. **Judicial prudence:** courts tend to adopt a more reserved stance in patent cases compared to trademark or copyright infringement, applying punitive damages only when strictly justified;
2. **Evidentiary deficiencies:** many claims fail due to insufficient evidence to meet the stringent criteria for punitive damages. However, this issue is often avoidable with proper preparation and strategic evidence collection.

This article provides a detailed analysis of the applicable legal standards for punitive damages in patent infringement cases, with the goal of enhancing the likelihood of successful claims.

I. Timing requirements for punitive damage claims

The claim for punitive damages must be submitted before the conclusion of the hearing in the first instance trial. If a plaintiff attempts to introduce the claim during the second-instance trial, the court is likely to dismiss it as beyond the scope of the original claim.

In the case *[(2021) Supreme Court IP Civil Final 920]*, the plaintiff-appellant sought to add a punitive damages claim in the appeal stage, alleging malicious intent and severe infringement. However, the Supreme People's Court (SPC) dismissed this additional claim, emphasizing that it was not raised during the first-instance proceedings. According to the *Judicial Interpretation on Punitive Damages for IP Infringement* (hereinafter, "Punitive Damages Interpretation"), courts may allow plaintiffs to increase the damages claim during the first trial, but in the appeal stage, the matter can only proceed through voluntary mediation between the parties or separate litigation.

Thus, rights holders or interested parties should raise punitive damages claims early and explicitly during the first-instance proceedings to avoid procedural dismissal.

II. Statutory elements for punitive damages

Both the *Civil Code* and the *Patent Law*, along with the Punitive Damages Interpretation, stipulate two essential elements:

1. **Subjective element:** The infringement must be intentional.
2. **Objective element:** The infringement must be severe.

“ Even when only part of the infringing profits can be proven, patent holders should actively seek punitive damages to the fullest extent possible. ”

1. Intentional infringement

In the context of punitive damages, intent includes both direct intent and indirect intent.

- **Direct intent:** The infringer knowingly pursues the outcome of infringement.
- **Indirect intent:** The infringer is aware of the infringement and allows it to occur.

However, it does not include situations where the infringer merely might have foreseen the possibility of an infringing outcome but mistakenly believed it could be avoided.

The following circumstances give rise to a preliminary presumption of intent, according to the Punitive Damages Interpretation:

- (i) Continued infringement after notice or warning from the plaintiff or an interested party;
- (ii) Management overlap: When the defendant's legal representative or manager held a role within the plaintiff or an affiliated party;
- (iii) Pre-existing business relationships, such as employment, licensing, distribution, or cooperation agreements, that allowed the defendant access to the plaintiff's intellectual property;
- (iv) Prior business negotiations involving the disputed IP;
- (v) Counterfeiting or piracy of registered trademarks; or
- (vi) Other similar scenarios where intent is evident.

However, courts exercise caution in applying this presumption. In *[(2022) Shaanxi 01 IP Civil Initial 1401]*, the court held that merely employing former executives of the plaintiff did not constitute conclusive evidence that the defendant was aware of the specific patent in question. Plaintiffs must actively present further evidence demonstrating deliberate or knowing infringement, such as awareness of the specific patent and the high probability that their conduct infringes it.

2. Severe infringement

The Civil Code and all specialized intellectual property laws establish 'severity of circumstances' as an objective requirement for punitive damages. Severe infringement generally refers to particular factors such as the manners and frequency of infringement, the duration, geographical scope,

scale, and consequences of the infringing activities, as well as the infringer's conduct during litigation.

According to the Punitive Damages Interpretation, "severe infringement" is assessed based on factors such as:

- Repeated infringements after administrative or judicial penalties;
- Infringement as an entire business;
- Fabrication, destruction, or concealment of evidence;
- Non-compliance with court preservation orders;
- Substantial gains by the infringer or significant losses to the rights holder; or
- Threats to national security, public interest, or public health.

In *[(2021) Guangdong 73 IP Civil Initial 593]*, the court acknowledged the defendant's intent to infringe but ruled that the plaintiff failed to prove the scale of the infringing activity or the share of infringing products in the defendant's overall revenue. As a result, the court found the evidence insufficient to conclude that the infringement was severe.

III. Calculation base for punitive damages

The introduction of punitive damages demands precise calculation of damages. Since the multiplier effect amplifies the base amount, even minor calculation errors can significantly impact the final award. According to the Punitive Damages Interpretation, the damages base may be determined using:

- Actual losses of the rights holder;
- Infringer's profits from the infringement; or
- Reasonable licensing fees.

In *[(2020) Shanghai 73 IP Civil Initial 1372]*, the court found that while the infringement was both intentional and severe, it was difficult to ascertain the profits attributable to the infringing products due to the defendant's mixed business operations. As a result, the court awarded statutory damages of five million RMB, the maximum allowed under the Patent Law, instead of punitive damages.

Due to the absence of discovery procedures in China, accurately determining the damages base can be challenging. In *[(2022) Supreme Court IP Civil Final 2907]*, the SPC acknowledged

“ The punitive damages regime under China's Patent Law offers a powerful tool for deterring intentional and severe infringements. ”

that precision in calculating the damages base is not always required. Courts may estimate damages based on available evidence. In that case, the court used the illegal production volume and the plaintiff's gross margin to calculate damages, signaling some flexibility in determining the compensation base.

In another case, *[(2020) Zhejiang 01 Civil Final 5872]*, the court recognized that part of the infringing profits could be clearly established and applied punitive damages to that portion. For the remaining infringing activities, where profits could not be accurately determined, the court applied statutory damages. This case also demonstrates the flexibility of the Chinese judiciary in applying punitive damages. Even when only part of the infringing profits can be proven, patent holders should actively seek punitive damages to the fullest extent possible.

IV Multipliers for punitive damages

Although the Patent Law allows for punitive damages up to five times the base amount, courts typically award multipliers between one and three times, considering factors such as the defendant's intent and the severity of the infringement.

In *[(2019) Supreme Court IP Civil Final 562]*, the court applied a fivefold multiplier. The infringer continued its production and business operations related to the infringing products despite a related criminal conviction and a first-instance judgment confirming infringement, conducted infringement as an entire business, and refused to obey the court order to submit its illicit profits, thereby constituting an act of evidence obstruction, and distributed the infringing products across over 20 countries with sales exceeding 37 million RMB. The court emphasized the need to present comprehensive evidence to justify higher multipliers and increase the chances of success in punitive damages claims.

Conclusion

The punitive damages regime under China's Patent Law offers a powerful tool for deterring intentional and severe infringements. However, the courts' cautious approach and the relatively high evidentiary burden require plaintiffs to strategically gather and present compelling evidence. In particular, rights holders should prioritize early identification of intentional conduct and severity of infringement and actively pursue the collection of quantifiable damages data. Even when only partial evidence is available to calculate the profits gained from infringing activities, punitive damages may still be sought to supplement statutory claims. With well-documented evidence, plaintiffs improve their chances of obtaining higher multipliers and maximizing compensation for the harm suffered.

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The culture of happiness

Diane Silve, Director & Senior Trademark Counsel at Mondelez International, shares insights on fostering a positive and productive team culture through the lens of happiness and collaboration.

Have you paused, even for a short moment, to consider your team's culture and the importance it has for you and your colleagues?

Over the years, I realized that culture could have a huge impact on how a group functions. While not intending to provide HR guidance as to how the culture of IP teams should be, I would like to share some of my own reflections based on observations made throughout my experience of 25 years in the IP profession, having worked in different IP structures (IP firm, in-house), team environments, and countries.

"Team Culture" is commonly defined by various authors with a few recurrent keywords such as Values, Goals, Beliefs, Behaviours, and Work Environment, all shared by a team. Team Culture may be used in combination with terms like "high



Diane Silve

performing," "achieving," and "competitive," or even sometimes having negative connotations such as "toxic" or "culture of fear". The culture of a team will not only influence a team's performances but, first and foremost, how each member of that team may feel daily. This, to me, is of the utmost importance as it will determine how a team will eventually work as an entity. I will not discuss here what could make a "high-achieving team" or a team with a "culture of excellence." Nor will I talk about what we would not want to see in a team. Instead, I will focus on simple and affordable steps we could all take, should we want, to build and foster a happy, kind, and positive culture within IP teams, which I would refer to as the *Culture of Happiness*.

While I am very privileged to work within a team where I feel happy, cared for, valued, and heard by leaders and my colleagues, I have also experienced during my career different types of culture. Rich off these different experiences, I can appreciate the effect team culture has on how I, and my IP colleagues within each team, feel and have felt overall.

Because people spend most of their time at work, feeling happy there, or at least being in an environment that is not detrimental to their mental health, will have a major impact on their life and their wellbeing. I believe that happy and valued employees will sleep better and will have more energy to practice physical activity or, for instance, to make conscious food choices. Also, there is evidence supporting the link between employees' happiness and their performances and productivity – on their own and/or within a group – focus, and sense of commitment to their team.

I have observed that leaders that wanted to build a culture of happiness for and with their team were intentional and authentic about it. It was not enough for them to think this would be the right type of culture they wanted for their team to make it happen. I noticed the team culture

was at the top of those leaders' strategic roadmaps. They understood that a strong culture would be the cement to all the other priorities of their team. These leaders were walking the culture talk. For instance, they would not only say that caring was important, but they would actually care, asking questions and wanting to know more about their colleagues, their struggles, and happy moments. They would also have their colleagues' back when needed, which would inspire trust. For those leaders, a culture of happiness would not be just a box to tick. I could see how they would be strongly committed to their team, investing time and energy in the team's culture, but above all, they would be interested to understand their team, its members, and their needs.

As individuals, we all have different needs, preferences, or, for instance, work rhythms. With all these differences, it can be tricky to appreciate what makes a team's identity, its essence. Especially when the team is spread over different functions (e.g., Trademarks and Patents), offices, countries, and even sometimes in different parts of the world and/or with different mother tongues across team members. Compared to other fields of law, the IP world is quite particular as teams often work internationally and with colleagues across the globe. I observed over the years that leaders who wanted a culture of happiness equally appreciated the differences and the commonalities existing within their team. Building on those as strengths to bring their team together and, with everyone, to create a strong culture based on the uniqueness, shared values and sense of purpose of their team.

The culture of a team should not sit solely on

“**Knowing that everyone's contribution to the team's culture is important and equally valued irrespective of the role and the seniority of the person.**”

its leaders' shoulders. Creating and fostering a culture of happiness is the responsibility of each team member, for their own good first, for their colleagues, and broadly for the group. From the leadership team to individual contributors, everyone has an important and unique role to play.

There are so many aspects that could create a strong team culture. I will not go through all but will share what are, to me and based on my observations, the essential pillars of a culture of happiness (the different Cs of Culture), which can be nurtured by individual members and/or as a group:

- *Care* – caring for others with simple gestures such as bringing a coffee to a colleague who is not at their best, asking for news about a colleague's sick child, being especially kind and attentive when a teammate is going through hard times, or handing over a birthday card.
- *Connect* – organizing regular touch points with the team as a whole but also within smaller groups to discuss work projects or new case law, but also to share about how people are, what they are looking forward to, what makes them happy, what they find difficult and also to have fun and celebrate together.
- *Celebrate* – cheering on the greatness of the team and its members with special moments which don't need to

“**There is evidence supporting the link between employees' happiness and their performances and productivity.**”

Résumé

Diane Silve is Director & Senior Trademark Counsel at Mondelez International. She has more than 20 years' experience as an IP lawyer. She has worked both in-house and in IP firms for various industries and in different countries. Diane is also a registered Yoga teacher and qualified in personal performance coaching and naturopathy. Diane is passionate about wellbeing and generally wants to understand and promote how IP professionals could take more care of themselves.





be formal and could be as easy as taking some time at the end of a meeting to mark recent successes like a team award or a big win in a complex litigation, celebrating birthdays and work anniversaries, welcoming newcomers; gathering around a home-baked cake before a colleague's wedding or celebrating the different cultures and traditions within the team; it could also simply be sending a sincere congratulation or thank you note to a colleague who did a great job.

- *Cohesion* – promoting unity amongst team by doing/creating together beyond pure work, like undertaking a group volunteering activity, working together towards helping others, having a group pro bono project with a special IP focus, learning a new skill as a group, or just having fun together around some good pizza.
- *Communicate* – discussing with as much transparency as possible about the team's priorities and goals, coming changes, and budget; asking for feedback on what works or not for the team, what could be changed/improved/stopped, or, for instance, talking about the latest survey results and sharing insights.
- *Culture champions* – when the size of the team allows, creating accountability within the group by having dedicated and voluntary "culture stars" who will help drive the team's culture agenda and organize related activities (from training to fun events).
- *Casting* – carefully considering the team's culture in a recruitment process to anticipate what the new hire could bring to the team and/or how they would blend in.

“
As I heard recently about a great team's culture example,
“It all starts with Me.”
”

- *Contribute* – knowing that everyone's contribution to the team's culture is important and equally valued irrespective of the role and the seniority of the person and remembering that not everyone contributes in the same way, which also makes the strength of a team, making culture a team goal for everyone and recognizing all individual contributions.
- *Cost-free* – creating a culture of happiness does not require any budget, but it implies everyone's commitment and intention.

We are lucky to have different tools and technologies available to bring a team together. It could be as varied as the classic in-person team meeting/training but starting with an informal "bring your own coffee and croissant," virtual coffee chats talking about last holidays, special recognition/awards, celebration slides, online trivia, virtual tour of the other side of the world office, monthly "getting to know your colleague" interviews, having a picnic all together at lunchtime in the park nearby or quarterly newsletter. There is no limit to a team's creativity when wanting to promote a culture of happiness.

The above might help to reflect on what we value in our team culture and maybe to consider at least one thing we could do differently, at our own level – being an individual contributor, a manager, or a leader – to build, improve, or foster our team's culture. In the current turmoil of our world with all the uncertainties it carries and the various pressures we may experience as an IP professional, one can see it as a shared responsibility to try all we can to create a happy place for ourselves and for those around us, also at work. There is no magic formula that could be applied to all and any teams across the IP profession (nor generally). There may be work environments where any of the above ideas might not be applicable. However, we can all attempt to cultivate a certain sense of culture of happiness at work. And create consequently a virtuous circle. Happy teams may inspire others in the same organization or beyond. Little by little, this could lead to a broader movement, impacting our IP environment and others in different areas. In any case, it cannot hurt.

As I heard recently about a great team's culture example, "It all starts with Me."

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