



# Patent Prosecution and Strategic Patent Counseling

Effectively and strategically prosecuting patents is critical to business, especially for innovative companies. Success may depend on protecting unique technology and revenue streams, while at the same time advancing patents to increase the likelihood they would successfully survive litigation in the future. Our patent lawyers, working with a network of firms around the world, regularly handle patent prosecution for clients on five different continents, including major global corporations, emerging companies and innovative institutions such as manufacturers, service providers, universities and other law firms.

## Patent Prosecution

DLA Piper has extensive experience in global patent application drafting and prosecution as well as patent litigation and licensing around the world. We regularly help clients navigate the constantly shifting legal landscape, such as the reforms implemented by the America Invents Act (AIA).

We focus on strategic prosecution – the art of obtaining truly significant and enforceable claims issued at the least expense. Our services don't end, though, with the issuance of a patent. We can support you in the variety of increasingly important post-issuance proceedings available to patentees such as inter partes reviews (IPRs) and post-grant reviews (PGRs). We also coordinate closely with our patent litigation group in developing and executing both offensive and defensive strategies in the USPTO, District Courts and ITC. Our US patent lawyers are registered with the USPTO, and many possess advanced scientific degrees while others have significant industry experience. DLA Piper has deep, long relationships with a network of firms around the world with whom we coordinate strategy, filings and prosecution.

## Strategic Patent Counseling

As intellectual property becomes increasingly vital to innovative businesses, progressive companies and research institutions are beginning to take a strategic look at their IP portfolios to identify where they have strengths, weaknesses and opportunities for additional revenue. Engaging experienced counsel on strategic patent portfolio analysis has become essential to clients who want to maximize their revenue-generating opportunities.

Our highly experienced patent lawyers counsel clients ranging from emerging companies to Fortune 100 companies on how to maximize their business returns by creating and managing their patent portfolios. Many companies have identified significant

### KEY CONTACTS

#### T. Daniel Christenbury

Partner  
Philadelphia  
T: +1 215 656 3381  
dan.christenbury@dlapiper.co

#### Larissa S. Bifano

Partner  
Boston  
T: +1 617.406.6013  
larissa.bifano@dlapiper.com

### RELATED SERVICES

- Corporate
- Patent Litigation
- Technology Transactions and Strategic Sourcing

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- Energy and Natural Resources
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- Technology

untapped value and new sources of additional revenue streams. Others have identified their IP assets as growth drivers and potential cornerstones to mergers and acquisitions. As part of our counseling activities, we regularly advise on patentability, validity and freedom to operate issues, provide opinions, conduct due diligence and address other issues connected with corporate mergers and acquisitions, and handle litigation support, as representative examples. Our patent lawyers have detailed knowledge of a wide array of complex technologies – from semiconductors to stem cells - to help you make the most of your IP assets.

## CAPABILITES

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Our lawyers regularly address complex technologies such as:

- Applied materials
- Biotechnology
- Business methods
- Chemistry
- Communications
- Computer hardware
- Electrical and mechanical arts
- Electronics
- Engineering
- Image storage and processing
- Life sciences
- Medical device
- Pharmaceutical
- Semiconductors
- Software

We also routinely handle relatively less complex technologies for products and services in the retail, entertainment and consumer products industries.

## INSIGHTS

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### Publications

#### Supreme Court Corner Q1 2019

11 APR 2019

In celebration of the 10th anniversary of IPT News, we note that 10 years ago, in the first quarter of 2009, Bernard L. Bilski filed his petition in the landmark *Bilski v. Kappos*, 561 U.S. 593 (2010), forever shaping the patentability of business methods.

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#### ITC Section 337 Update

11 APR 2019

A quick look at the last 10 years.

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#### Relying on "common sense" instead of prior art in evaluating the obviousness of pharmaceutical patents

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21 DEC 2018

A one-time aberration, or the start of a trend?

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### **Supreme Court Corner Q4 2018**

20 DEC 2018

A trademark case concerning the Lanham Act's prohibition of "immoral" marks; a patent case asking whether the government is a "person" under the AIA.

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### **Global structuring and IP planning in the wake of US tax reform**

21 DEC 2018

Tax reform has imbued global structuring with a significant amount of uncertainty.

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### ***Alice* in Wonderland: navigating the strange world of patenting AI**

21 DEC 2018

Like the bottle labeled DRINK ME, certain techniques can make the trip through the AI-patent rabbit hole more scalable.

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### **32 DLA Piper lawyers in 8 countries ranked among world's top patent professionals**

27 SEP 2018

*IAM Patent 1000: The World's Leading Patent Professionals 2018* has named 32 DLA Piper lawyers to its seventh list.

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### **Pharmaceutical Trademarks 2018/2019 - Chapter: France**

5 APR 2018

Like all trademarks, pharmaceutical trademarks are subject to general trademark rules regarding validity and use. Until recently, both French and European law required a trademark to be capable of graphical representation. This requirement allowed the registration of shapes, colours and sounds, but excluded signs such as smells. The European trademark law reform, comprising EU Directive 2015/2436 and the EU Trademark Regulation (2017/1001), deleted the graphical representation requirement from trademark law. This change marks a dramatic step forward in trademark law and could make it easier to register smells and other non-traditional trademarks.

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### **Supreme Court Corner Q4 2017**

27 DEC 2017

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### **Compulsory patent license for protected active substances for individualized therapies**

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30 OCT 2017

In a recent decision ("Raltegravir"), the German Federal Court of Justice (FCJ) has for the first time confirmed a compulsory patent license granted by the German Federal Patent Court (FPC) in first instance in a preliminary injunction proceeding.

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### **Digital diagnosis - AI and machine learning in healthcare**

2 OCT 2017

In the first of a two part series, DLA Piper's lawyers consider how progress is accelerating with more opportunities for both AI systems builders and healthcare institutions every day. For both sides, 'getting the right deal' is critical if the collaboration is to be on an equal footing and deliver benefits on a win-win basis for both parties.

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### **Supreme Court Corner Q3 2017**

29 SEP 2017

The Lanham Act's disparagement clause violates the free speech clause of the First Amendment and inter partes review before the Patent Trial and Appeal Board.

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### **Trade secrets are more important, and trade secret litigation is more common**

29 SEP 2017

What do you need to be considering to protect your company in this environment?

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### **Supreme Court Corner Q2 2017**

31 JUL 2017

Three key cases

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### **IP litigation in Canada: 10 reasons to litigate north of the border**

31 JUL 2017

Considering litigation in Canada as part of a global intellectual property strategy.

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### **Intellectual Property and Technology News (North America), Issue 34, Q2 2017**

31 JUL 2017

#### **[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS SERIES](#)**

Our Intellectual Property and Technology News reports on worldwide developments in IP and technology law, offering perspectives, analysis and visionary ideas.

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### **Intellectual Property and Technology News (North America), Issue 33, Q1 2017**

30 MAR 2017

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## INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS SERIES

Our Intellectual Property and Technology News reports on worldwide developments in IP and technology law, offering perspectives, analysis and visionary ideas.

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### Intellectual Property and Technology News (North America), Issue 32, Q4 2016

20 DEC 2016

## INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS SERIES

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### US Congress may act again on patent reform

26 JUN 2014

Recent activity regarding patent trolls

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### Distributing patent rights between affiliates: guidelines to support enforcement rights around the world

16 NOV 2015

Considering a few issues at the outset when rights are distributed between Parent and Affiliate (or between multiple affiliates) may avoid difficulties in the future when a company wants to enforce patent rights.

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## NEWS

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### DLA Piper announces launch of Artificial Intelligence practice

14 MAY 2019

DLA Piper announced today the launch of its Artificial Intelligence practice, which will focus on assisting companies as they navigate the legal landscape of emerging and disruptive technologies, while helping them understand the legal and compliance risks arising from the creation and deployment of AI systems.

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### DLA Piper announces partnership promotions for 2019

1 APR 2019

DLA Piper is proud to announce that 77 lawyers have been promoted to its partnership. The promotions are effective as of April 1, 2019 in the United States and May 1, 2019 for EMEA and Asia Pacific. The promotions were made across many of the firm's practice areas in 43 different offices throughout 20 countries.

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### DLA Piper successfully defends Samsung Electronics against Dyson

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29 MAR 2019

DLA Piper acted on behalf of Samsung Electronics GmbH to lift a temporary injunction obtained by Dyson AG in January 2018 from the District Court of Düsseldorf. The injunction prohibited Samsung from making certain advertising statements for battery-powered vacuum cleaners. As some of the prohibited statements were also on the packaging this led to a de facto ban on the sale for the battery-powered vacuum cleaner.

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### **DLA Piper hosts leading business and diplomacy conference**

14 MAR 2019

DLA Piper's London office has hosted the Annual Conference of the International Diplomatic and Business Exchange (IBDE).

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### **DLA Piper announces launch of Blockchain and Digital Assets practice**

26 FEB 2019

DLA Piper announced today the launch of its Blockchain and Digital Assets practice, which will offer strategic advice on a global basis to address the needs of companies implementing blockchain technology solutions and creating and deploying digital assets.

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### **DLA Piper joins Governing Council for Hedera Hashgraph**

20 FEB 2019

DLA Piper has joined the initial group of Governing Council members for Hedera Hashgraph, a next-generation public ledger designed to have highly diversified governance and the most distributed consensus at scale. The announcement was made at Hedera Hashgraph's first annual summit in Seoul, Korea.

As part of the council, DLA Piper will help oversee changes to the software run by millions of Hedera distributed nodes over time. The governing council has been established to ensure stability and guaranteed continued decentralization to the Hedera Hashgraph distributed public ledger.

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### **DLA Piper bolsters Data Protection practice**

4 FEB 2019

DLA Piper in Germany has hired Intellectual Property & Technology of counsel Prof Dr Jürgen Taeger, who joined the firm's Cologne office with effect from 1 February 2019.

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### **DLA Piper expands new Dublin office with four-partner hire**

9 JAN 2019

DLA Piper today announces the appointment of four new partners from highly-regarded Irish firms to its newly opened Dublin office into four key practice areas of Finance and Projects (F&P), Corporate, Intellectual Property and Technology (IPT) and Employment. These hires follow the appointment of Corporate partner David Carthy as Ireland Country Managing Partner in May 2018.

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### **Technology sector poised for big data wave in finance and sales departments – DLA Piper European Tech Index**

12 DEC 2018

Harnessing big data is becoming standard practice for IT and marketing teams in technology, but DLA Piper's 2018 Tech Index reveals that a revolution may now be underway in finance and sales departments as well. Responses from 350 tech sector senior executives in Europe indicate that compared to 2016, organizations are increasingly identifying new opportunities in these additional departments, indicating a move towards widespread adoption of big data in the tech sector.

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### **DLA Piper wins Legal Adviser of the Year and recognized as UK Top Performer 2018 by Global Sourcing Association**

25 MAY 2018

DLA Piper's Global Co-Head of Technology Sector, Kit Burden, was last night named Legal Adviser of the Year at the Global Sourcing Association (GSA) UK Top Performers and Professional Awards, held at the Hilton Manchester Deansgate

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### **DLA Piper announces partnership promotions for 2018**

3 APR 2018

DLA Piper is proud to announce that 62 lawyers have been promoted to its partnership. The promotions are effective as of 1 April 2018 in the United States and 1 May 2018 for EMEA and Asia Pacific. The promotions were made across many of the firm's practice areas in 42 different offices throughout 20 countries.

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### **DLA Piper launches Intellectual Property and Technology practice in Luxembourg**

3 APR 2018

DLA Piper Luxembourg is pleased to announce the launch of its Intellectual Property and Technology (IPT) practice, with the appointment of Olivier Reisch as partner and head of the practice.

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### **DLA Piper Romania hosts a GDPR-focussed data protection conference alongside Wolters Kluwer**

28 MAR 2018

On 19 March 2018, DLA Piper in Romania hosted a "Data Protection Conference" in Bucharest, in partnership with Wolters Kluwer. The event focussed on the specific rules and practical aspects of processing personal data of customers and employees, from both a GDPR and ePrivacy perspective.

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### **Businesses still not fully aware of Data Protection issues**

31 JAN 2018

DLA Piper has released its second Data Privacy Snapshot report, finding that once again, company global privacy programs have gaps in meeting increasingly demanding global privacy principles. Significantly, it appears that many companies are falling short of data protection obligations under the General Data Protection Regulation (GDPR), which will start to apply from 25 May 2018.

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### **DLA Piper invited to participate in the GDPR conference organised by the National Supervisory Authority for Personal Data Processing in light of the forthcoming European Data Protection Day**

31 JAN 2018

DLA Piper is proud to announce that Head of Intellectual Property & Technology in Bucharest Ana-Maria Andronic, and Intellectual Property & Technology senior associate, Alexandru Campean, were invited to speak at the "General Regulation on Data Protection"

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conference held on 26th January 2018. The event was held at the Parliament Palace and was organised by the National Supervisory Authority for Personal Data Processing.

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### **DLA Piper names new global and US co-chairs for Intellectual Property and Technology practice**

8 JAN 2018

DLA Piper has named Frank Ryan co-chair of the firm's global Intellectual Property and Technology practice and Ann Ford co-chair of its US IPT practice, both effective January 1.

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### **Six months until GDPR: companies still reporting low levels of preparedness**

15 Nov 2017

For the over 200 organisations responding to DLA Piper's Data Privacy Scorebox online survey tool since the start of the year, the average alignment score with all key international data privacy principles was 31.5%, as against an 38.3% average score for respondents in the 2016 calendar year.

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### **DLA Piper launches Global Contract Laws v2.0**

7 Nov 2017

DLA Piper has launched a newly updated version of its *Global Contract Laws* online resource. *Global Contract Laws v2.0* covers laws from more than 50 countries, including the UK, the US, Australia, China, and Germany, as well as new countries in Asia and South America.

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### **DLA Piper again honored as Law Firm of the Year in three categories at Juve Awards**

27 OCT 2017

At yesterday's presentation of the JUVE Awards in the Alte Oper in Frankfurt am Main, DLA Piper celebrated winning the Law Firm of the Year award in the categories *Media and Technology*, *Trademarks and Unfair Competition*, and *Media*. In addition, DLA Piper was also shortlisted for Law Firm of the Year in the categories *Private Equity & Venture Capital* and *Intellectual Property*. Last year, the firm won three awards in the categories *Distribution/ Trade and Logistics*, *Insurance* and *Company Succession and Trusts*.

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### **DLA Piper named one of the most innovative law firms in Europe by the Financial Times Innovative Lawyers Europe Report 2017**

6 OCT 2017

DLA Piper is one of the top five most innovative law firms in Europe according to the Financial Times Innovative Lawyers Europe report 2017.

Now in its twelfth year, the FT Innovative Lawyers Report assesses lawyers on their innovation both for clients and in their own businesses. It is one of the top legal rankings in Europe and the accompanying awards are widely regarded as the best researched in the market.

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## **DLA Piper launches new platform for *Guide to Going Global* series**

20 SEP 2017

DLA Piper has launched a new platform featuring its *Guide to Going Global* series, an online resource designed to help companies operating and growing their international businesses.

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## **DLA Piper recruits patent litigator Dr Philipp Cepl as partner for Cologne office**

13 Jul 2017

DLA Piper is pleased to announce that it has successfully recruited Dr Philipp Cepl, a high-calibre patent litigator, as a new partner for its German patent practice, to the Cologne office. He joins from Allen & Overy and together with Dr med Kokularajah Paheentharajah, who joins as Senior Associate, they will take up their post at DLA Piper with effect from 1 October 2017.

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## **DLA Piper advises Link Group on £888 million (AU\$1.49 billion) acquisition of Capita Asset Services**

10 Jul 2017

DLA Piper has advised Australian company Link Group (ASX: LNK) on the acquisition of UK-based Capita Asset Services division (CAS) of Capital Plc for £888 million (AU\$1.49 billion). Link Group was selected as the successful bidder following a competitive sale process. DLA Piper also advised Link Group on the related acquisition debt financing of £485 million (AU\$815 million).

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## **DLA Piper advises Beijing BDStar Navigation Co., Ltd on the purchase of an interest in the in-tech Group**

19 Jun 2017

DLA Piper has advised BDStar as part of a bidding procedure on the acquisition of an interest in the company in-tech GmbH, a supplier for the digitization and the development in the area of automotive, machinery and transportation systems.

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## **DLA Piper berät Beijing BDStar Navigation Co., Ltd beim Erwerb von Anteilen an der in-tech Gruppe**

19 Jun 2017

DLA Piper hat die BDStar beim Erwerb einer Beteiligung an der in-tech GmbH, einem international agierenden Spezialisten für Digitalisierung und Entwicklung in den Branchen Automotive, Maschinenbau und Verkehrssysteme, beraten.

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