



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.

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RELATED SERVICES

- Corporate
- Patent Litigation
- Technology Transactions and Strategic Sourcing

RELATED SECTORS

- Energy and Natural Resources
- Life Sciences
- Media, Sport and Entertainment
- Technology

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 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

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

Publications

Supreme Court Corner

30 March 2021

Numerous amici in *American Axle* urge the Supreme Court to take the case; update on *USPTO v. Booking.com*.

The Pharmaceutical Corner

30 March 2021

The opinion may render functional claiming more difficult, but functional claims that follow its guidance may still have an important role to play in pharmaceutical patents.

Understanding the USPTO guidance on patenting AI technologies

30 March 2021

The USPTO guidance opens the door for applicants to obtain patent protection for their AI technologies.

Eligibility guidance in the wake of *Alice*: Clarity at the examiner stage, uncertainty in the Federal Circuit

22 December 2020

Competing approaches to patent-eligible subject matter at the Federal Circuit and the USPTO.

Inventions behind the music: From Eddie Van Halen to Michael Jackson and beyond

22 December 2020

Music innovation offers fertile ground for patent protection.

Supreme Court Corner

22 December 2020

A quick look at two cases.

The Pharmaceutical Corner

22 December 2020

A precedential decision with potentially far-reaching impacts for future Hatch-Waxman litigation and generic-product launches.

Calidad v Seiko – the High Court has spoken: the doctrine of patent exhaustion applies in Australia

17 November 2020

On 12 November 2020 the High Court of Australia handed down the much anticipated decision in *Calidad Pty Ltd v Seiko Epson Corporation* [2020] HCA 41. In a majority decision, the High Court confirmed that all rights of the patentee (use, sell, dispose of, repair etc) except the right to make the patented article are exhausted at the time of sale, in respect of a product which embodies that patent.

Sale of a product exhausts patent rights

12 November 2020

On 12 November 2020, High Court of Australia handed down the much anticipated decision in the *Calidad v Seiko* dispute.

This landmark decision overturns over 100 years of law and puts Australia in line with the US, where there is well established law on patent exhaustion.

Constitutional challenges to inter partes review – *Arthrex, Inc. v. Smith & Nephew, Inc.*

30 September 2020

This Appointments Clause challenge to the IPR process appears to have staying power.

Coronavirus Resource Center: Our global repository of insights and events

30 September 2020

A central repository for our reports and commentary on the legal and regulatory concerns arising from the pandemic.

Inventiveness+? Divergent theories of the "inventive concept" in patent-eligible subject matter

30 September 2020

What qualifies as an inventive concept? Even the Federal Circuit doesn't know for sure.

Supreme Court Corner

30 September 2020

A quick look at two cases - *USPTO v. Booking.com* and *American Axle & Manufacturing v. Neapco Holdings*.

The Pharmaceutical Corner

30 September 2020

In this inaugural column, we look at the implications of IPR and PGR proceedings in Hatch Waxman litigation.

A go-to firm for defending patent cases

30 June 2020

Recognition from *Law360*

Atlanta expands privacy capabilities

30 June 2020

Lael Bellamy's arrival bolsters our data protection, privacy and security capabilities throughout the firm.

Intellectual property rights are a renewed focus as the world looks beyond a global viral outbreak

30 June 2020

A few key IP-related considerations for companies, whether they are seeking to expand into new markets or looking to preserve their place in an existing market.

Northern California bolsters telecom and regulatory practice

30 June 2020

Regulatory and telecom attorney Kristin Jacobson has joined our Northern California office in Sacramento.

Supreme Court Corner

30 June 2020

A quick look at three cases: *Thryv, Inc.*; *Lucky Brands*; and *Romag Fasteners*.

Washington, DC grows technology capabilities with two new arrivals

30 June 2020

Marius Domokos and Justin Ilhwan Park have joined our Washington, DC practice.

A balance between the government, the private sector and the needs of the people: Invocation of rarely used provisions to ensure public safety during the COVID-19 pandemic

6 April 2020

The Defense Production Act, compulsory licensing and march-in rights are means for authorizing the government to step in and assert rights against private companies.

The CARES Act and USPTO patent practitioner deadlines

6 April 2020

While the USPTO remains open for filing of documents and fees, Director Iancu announced that parties may be eligible for extensions of certain deadlines if their inability to meet a current deadline is due to the COVID-19 pandemic.

Are you ready for CCPA class action litigation?

30 March 2020

Many businesses may not have fully contemplated the major data breach class action litigation risk created by the California Consumer Privacy Act.

Supreme Court Corner

30 March 2020

Notable cases involve trademark protectability and federal preclusion principles.

The almost free US-Japan Trade Agreement is now in effect

9 January 2020

This trade agreement reduces or eliminates US customs duties on numerous goods.

CCPA Rescue Kit arrives amid new privacy law change

19 December 2019

A series of integrated compliance offerings to help businesses begin the journey of compliance with this important new privacy bill.

Supreme Court Corner

19 December 2019

We are watching two key cases – *Romag Fasteners v. Fossil* and *Thryv, Inc. v. Click-to-Call Technologies*.

Printer cartridge wars: what they mean for the sale of re-purposed, re-manufactured or re-used products in Australia

18 November 2019

There has been a new development in *Calidad Pty Ltd v Seiko Epson Corporation* [2019] FCAFC 115 (**Calidad v Seiko**) relating to remanufactured printer cartridges. Australian businesses dealing in products with re-purposed, re-manufactured or re-used parts should keep aware of developments in the law in this area.

If your business uses re-manufactured or re-purposed products or parts of the law in Australia is still unclear, you need to be aware of this case.

Therapeutic Goods Administration cracks down on prohibited advertising

3 October 2019

A series of recent enforcement actions and announcements by the Therapeutic Goods Administration (**TGA**) indicate that the regulator is actively monitoring and prosecuting businesses for breaches of the *Therapeutic Goods Advertising Code (No. 2) 2018* (**TG Advertising Code**) and *Therapeutic Goods Act 1989* (**TG Act**).

The Russian Supreme Court clarifies intellectual property legislation

30 Sep 2019

Clarifications from the Supreme Court have a significant impact on the further development of court practice in Russia.

Don't get caught out: Intellectual property arrangements will be susceptible to prosecution for anti-competitive conduct from 13 September 2019

12 September 2019

From 13 September 2019, commercial arrangements relating to IP rights - including licences, assignments, litigation settlement agreements and other contracts, arrangements or understandings between businesses - will no longer be exempt from the anti-competitive conduct provisions of the Competition and Consumer Act 2010 (Cth) (CCA).

Slow death of the innovation patent

29 July 2019

Those with a keen interest in the fate of Australia's innovation patent will recall its last minute reprieve, when legislation abolishing the innovation patent was removed from the Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018 (Cth).

***Alice* uncertainty: curiouser and curiouser**

24 July 2019

The Federal Circuit declines to follow USPTO guidance on subject matter eligibility, instead following its own precedent.

Intellectual Property and Technology News (Asia Pacific) May 2019

15 MAY 2019

INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS

Intellectual Property and Technology News (Asia Pacific) is our biannual publication designed to report on worldwide development in intellectual property and technology law, offering perspectives, analysis and visionary ideas.

US Congress may act again on patent reform

26 JUN 2014

Recent activity regarding patent trolls

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.

Events

Previous

Planning for an Uncertain World

16 November 2020
TechLaw Event Series
Webinar

TechLaw

31 July 2020
TechLaw Event Series
Webinar

TechLaw

5 March 2020
TechLaw Event Series
Sydney

TechLaw

3 March 2020
TechLaw Event Series
Melbourne
