



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

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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

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 USTPO 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.

Supreme Court Corner

30 March 2020

Notable cases involve trademark protectability and federal preclusion principles.

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.

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*.

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.

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.

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.

ITC Section 337 Update

11 APR 2019

A quick look at the last 10 years.

March 2019 - Key issues in brand cross-licensing in China

20 MAR 2019

In recent years, Chinese brands have been increasingly gaining global recognition, especially in the technology, ecommerce, and consumer goods sectors. In this context, an increased number of foreign businesses are considering branded partnerships with a Chinese counterparty as a way of operating in China (e.g., co-branded joint venture). In recent years, Chinese brands have been increasingly gaining global recognition, especially in the technology, ecommerce, and consumer goods sectors. In this context, an increased number of foreign businesses are considering branded partnerships with a Chinese counterparty as a way of operating in China (e.g., co-branded joint venture).

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

21 DEC 2018

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

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.

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.

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.

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.

US Congress may act again on patent reform

26 JUN 2014

Recent activity regarding patent trolls

Intellectual Property and Technology News (United States) Issue 20, Q4 2013

5 DEC 2013

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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.

[NEWS](#)

DLA Piper advises Singtel Innov8 on its investment in Chinese data service provider DataHunter

28 May 2020

DLA Piper has advised Singtel Innov8 the venture capital arm of Singtel Group focusing on investments in technology solutions, on its successful investment, through a B-Series fundraising, in Beijing-based data service provider DataHunter.

China and Hong Kong partners recognised in IP Stars 2020

14 May 2020

We are delighted to announce that IPT partners Edward Chatterton (William (Skip) Fisher, (Shanghai), and Horace Lam, (Beijing), have been recognised in IP Stars 2020 by Managing Intellectual Property.

DLA Piper announces partnership promotions for 2020

30 April 2020

DLA Piper is proud to announce that 67 lawyers have been promoted to its partnership. The promotions are effective as of April 1, 2020 in the United States and May 1, 2020 for EMEA and Asia Pacific. The promotions have been made across many of the firm's practice areas in 35 different offices throughout 13 countries.

Across the firm's practices globally, Corporate saw the largest intake of new partners with 19 promotions, followed by Litigation and Regulatory with 15. Intellectual Property and Technology and Finance and Projects had ten and eight promotions respectively, while there were six in Real Estate. Tax and Employment both had four, and there was one in Restructuring.

DLA Piper lawyers named Acritas Stars

10 March 2020

Acritas has named over 200 DLA Piper lawyers as 2020 Acritas Stars. Now in its fourth year, Acritas Stars highlights the stand-out lawyers in private practice as nominated by clients around the world. More than 3,000 senior in-house counsel feed into the nomination process to give a comprehensive view of highly recommended lawyers across the globe.

DLA Piper advises AirTrunk on new hyperscale data centre in Hong Kong

23 September 2019

Global law firm DLA Piper has advised hyperscale data centre specialist AirTrunk on the development of its state-of-the-art USD150+ million data centre in Hong Kong.

DLA Piper to advise ITW Global Leaders' Forum on blockchain-based telecoms platform

2 July 2019

DLA Piper has been appointed to advise the ITW (International Telecoms Week) Global Leaders' Forum (GLF) on the launch of a special purpose vehicle that will develop a live, blockchain-based platform.

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.

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.

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).

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.

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.

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.

DLA Piper promotes first Australians to international management roles and announces new Australian country MP

6 Dec 2018

As part of an international executive revamp DLA Piper Australia co-managing partners Melinda Upton and Jim Holding will be taking on International management responsibilities in a significant endorsement of Australia's performance within the firm.

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.
