



# 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.

### KEY CONTACTS

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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

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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

#### **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.

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

22 December 2020

Music innovation offers fertile ground for patent protection.

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## Supreme Court Corner

22 December 2020

A quick look at two cases.

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## The Pharmaceutical Corner

22 December 2020

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

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## 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.

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## 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.

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## 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.

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## Supreme Court Corner

30 September 2020

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

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## The Pharmaceutical Corner

30 September 2020

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

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## A go-to firm for defending patent cases

30 June 2020

Recognition from *Law360*

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## Atlanta expands privacy capabilities

30 June 2020

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

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## 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.

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## Northern California bolsters telecom and regulatory practice

30 June 2020

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

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## Supreme Court Corner

30 June 2020

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

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## Washington, DC grows technology capabilities with two new arrivals

30 June 2020

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

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## 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.

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## 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.

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## Are you ready for CCPA class action litigation?

30 March 2020

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

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### **Supreme Court Corner**

30 March 2020

Notable cases involve trademark protectability and federal preclusion principles.

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### **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.

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### **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.

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### **Supreme Court Corner**

19 December 2019

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

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### **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.

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### **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.

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### **Intellectual Property and Technology News (Asia Pacific) May 2019**

15 MAY 2019

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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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.

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### **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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### **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's Luxembourg team enters World Trademark Review ranking**

25 February 2021

Our Luxembourg office is pleased to announce that we have been ranked as a recommended law firm in the World Trademark Review.

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### **DLA Piper advises ATI Global on GBP170 million acquisition of Groundsure**

21 January 2021

Global law firm DLA Piper has advised ATI Global on its GBP170 million acquisition of UK based location intelligence business Groundsure, a leading supplier of environmental searches, data, mapping and reports for the UK property market, from Ascential plc (Ascential) (LSE: ASCL).

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### **DLA Piper and Aldersgate DLS launch TOKO, a fast, secure and cost effective solution for buying and selling high value assets using blockchain technology**

5 November 2020

Global law firm DLA Piper in collaboration with Aldersgate DLS (Digital Ledger Solutions), has launched TOKO, a unique tokenisation engine and vital component in the digital asset ecosystem. Developed with Aldersgate DLS, TOKO provides smart

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contract functionality and digital asset creation functionality and assurance.

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### **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.

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### **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.

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### **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.

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### **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.

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### **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.

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## **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.

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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 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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