



# 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

### KEY CONTACTS

#### Larissa S. Bifano

Partner

Boston

T: +1 617 406 6013

larissa.bifano@dlapiper.com

- Corporate
- Patent Litigation
- Technology Transactions and Strategic Sourcing
  
- Energy and Natural Resources
- Life Sciences
- Media, Sport and Entertainment
- Technology

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

#### How will the Unified Patent Court decide your case?

23 February 2022

The unitary patent and the Unified Patent Court (UPC) have moved another step closer since Austria's deposit of its ratification instrument triggered the start of the Provisional Application Period (PAP) on 19 January 2022.

---

#### Can an AI system be named the inventor? In wake of EDVA decision, questions remain

23 September 2021

### AI OUTLOOK

Artificial intelligence is notable among the new technologies posing fundamental questions about the viability of the inventor's oath.

---

## Supreme Court Corner

September 2021

The Court chose to enhance the Director's power to review PTAB decisions directly.

---

## The Pharmaceutical Corner

September 2021

*Teva v. Amicus* is the first lawsuit to test the reach of the CREATES Act. Expect more.

---

## Framing patents as essential facilities in Chinese antitrust: *Ningbo Ketian Magnet Co., Ltd. v. Hitachi Metals*

7 September 2021

### ANTITRUST MATTERS

A Chinese court recently ruled in *Ningbo Ketian Magnet Co., Ltd. v. Hitachi Metals, Ltd.* that a patent-holder's refusal to license patents for producing rare-earth magnets to competitors constituted an abuse of dominance in violation of China's Antimonopoly Law (AML).

---

## Blockchain and Digital Assets News and Trends

23 August 2021

### BLOCKCHAIN AND DIGITAL ASSETS NEWS AND TRENDS

New information reporting requirements for cryptocurrency transactions; CFPB involvement in cryptocurrency oversight; NCUA seeks comments on use of DLT and DeFi by credit unions.

---

## Blockchain and Digital Assets News and Trends

19 July 2021

### BLOCKCHAIN AND DIGITAL ASSETS NEWS AND TRENDS

IRS says tax-deferred like-kind exchange is not available for cryptocurrency trades; copyright issues plague NFTs; crypto venture investments continue to accelerate.

---

## Supreme Court Corner

June 2021

The issue at hand in *Unicolors v. H&M* turns on a question of inaccuracies in the copyright registration certificate.

---

## The Pharmaceutical Corner

June 2021

We look at the underlying decision in *Immunex v. Sandoz* and the potential implications on pharma patent licensing strategies.

---

---

## Trial by eligibility

June 2021

In the history of the United States, every single jury trial on patent eligibility under 35 U.S.C. § 101 has resulted in a defense verdict.

---

## 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.

---

## 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.

---

## Coronavirus Resource Center: Our global repository of insights and events

30 June 2020

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

---

### **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.

---

### **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.

---