



# 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.

### CONTACTPERSONEN

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- Corporate
- Patent Litigation
- Technology Transactions and Strategic Sourcing
- Energie
- Biowetenschappen
- Media, sport en entertainment
- Technologie

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.

## ACHTERGROND

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### Publicaties

#### The CRISPR patent wars

16 November 2022

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

As you seek to protect the IP you are developing around CRISPR technologies, here are some issues to keep in mind.

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#### Episode 6 - The UPC's long arm jurisdiction

26 October 2022

#### [UPC ON THE GO – PRACTICAL ADVICE ON THE UNIFIED PATENT COURT](#)

In the last episode of our series, Deborah Bould, London-based Patent Partner and Alejandro González Vega, Associate from

Luxembourg, discuss how the UPC's "long arm" jurisdiction might be exercised by the court when it launches next year and the impact it might have on patent owners looking to enforce their rights internationally.

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### Episode 5 - Remedies

7 October 2022

#### [UPC ON THE GO – PRACTICAL ADVICE ON THE UNIFIED PATENT COURT](#)

In this episode, Paul Reeskamp, a senior patent litigator in our Dutch team, looks at the remedies available under the UPC system, including the crown jewel of remedies – the injunction.

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### Episode 4 - Enforcement of UPC decisions

23 September 2022

#### [UPC ON THE GO – PRACTICAL ADVICE ON THE UNIFIED PATENT COURT](#)

Frank Valentin leads the DLA Piper Intellectual Property practice in France and has significant experience in the Tech and Life Sciences sectors. In this episode, Frank continues his conversation with Cédric Meiller, a senior IP lawyer also based in our Paris office, to discuss how judgments will be enforced in the UPC.

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### ***Karyopharm* highlights practical considerations for life sciences companies' disclosures about products in development**

20 September 2022

The decision provides some practical guidance for life sciences companies' decisions regarding statements about products in development.

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### Episode 3 - How to choose the right court

26 August 2022

#### [UPC ON THE GO – PRACTICAL ADVICE ON THE UNIFIED PATENT COURT](#)

Frank Valentin leads the DLA Piper Intellectual Property practice in France and has significant experience in the Tech and Life Sciences sectors. In this episode, Frank is joined by Cédric Meiller, a senior IP lawyer who is also based in our Paris office, to discuss how to choose the right court for your dispute in the new system.

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### Episode 2 - The language issue

12 August 2022

#### [UPC ON THE GO – PRACTICAL ADVICE ON THE UNIFIED PATENT COURT](#)

Gualtiero Dragotti, a partner in our Milan office and Co-Chair of DLA Piper's global patent group who specialises in Life Sciences, looks at the controversial topic of language in the new system.

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## Episode 1 - The basics

28 July 2022

### [UPC ON THE GO – PRACTICAL ADVICE ON THE UNIFIED PATENT COURT](#)

Markus Gampp, head of the firm's German patent practice and Co-Chair of DLA Piper's global patent group, who has a special interest in the Tech sector, begins our podcast series by introducing the concept of the UPC and explaining why you should care about it.

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## Trade dress protects your automobile's design

11 July 2022

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

Trade dress may be used to protect the unique, non-functional aspects of a car.

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## Exploring the metaverse: What laws will apply?

22 June 2022

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

For those intrigued by the metaverse, and for creators building metaverse projects, here are practical considerations.

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## Protecting your IP in Russia: Best practices, action steps

18 May 2022

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

US companies may take action in Russia to protect their IP rights, notwithstanding US economic and trade sanctions.

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## 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.

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## Understanding AI and its use in drug discovery

6 October 2021

### [AT THE INTERSECTION OF SCIENCE AND LAW PODCAST SERIES](#)

DLA Piper partners Ellen Scordino and Susan Krumplitsch are joined by Duane Valz, General Counsel of Insitro, to discuss how machine learning is being used to generate and leverage data for the development of better medicines.

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## 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.

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### Supreme Court Corner

September 2021

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

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### The Pharmaceutical Corner

September 2021

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

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### 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).

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### 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.

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### 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.

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### 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.

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### The Pharmaceutical Corner

June 2021

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

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### **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.

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### ***United States v. Arthrex*: Where does the Supreme Court's decision leave the PTAB?**

23 June 2021

If the APJs' appointment is unconstitutional, what is the appropriate remedy?

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### **S 415, narrowing the scope of new chemical entities, is now law: Implications for innovator companies**

29 April 2021

The new law, signed by the President on April 23, narrows the scope of drug compounds that qualify as an NCE.

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### **Patent eligibility in bioinformatics: Federal Circuit affirms rejection of computerized haplotype phasing claims**

31 March 2021

Yet another hurdle for inventors in the growing field of bioinformatics and computational biology.

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### **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*.

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### **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.

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### **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.

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### **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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### **Patent venue: a significant shift may be coming**

30 MAR 2017

A case before the Supreme Court has the potential to change forum shopping in patent cases in an immediate and dramatic way.

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### **Women in IP Law: panel examines divided infringement, cyber-risk**

20 DEC 2016

High points from a CLE panel discussion about cutting-edge issues in the IPT space.

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### **Supreme Court Corner - Q4 2016**

20 DEC 2016

Two patent cases, two copyright cases

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### **Best practices in defending patent litigation**

20 DEC 2016

Key issues for companies that engage in patent litigation.

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## **Precarious steps: patent eligibility for healthcare IT**

26 SEP 2016

Three recent Federal Circuit decisions, along with new updates from the USPTO, offer guidance on which steps to take in patenting healthcare IT-related inventions.

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## **Stop them in their tracks: key points in seeking a preliminary injunction against medical device infringers**

22 SEP 2016

Three considerations to bear in mind when bringing or defending a preliminary injunction motion in a medical device infringement case.

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## **Supreme Court Corner: Q1 2016**

29 MAR 2016

Two cases to watch.

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## **The role of evidence in inter partes review**

29 MAR 2016

Explaining some evidentiary issues that have decided PTAB proceedings.

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## **Supreme Court Corner: Q4 2015**

2 DEC 2015

A recent fair use decision, plus three significant cases to watch

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## **Are IPRs impacting the pharmaceutical industry?**

9 JUN 2015

Choosing between IPRs and district court litigation

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## **Supreme Court Corner: Q2 2015**

9 JUN 2015

Recent decisions and cases to watch

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## **Patent wars: can the energy industry avoid them?**

10 SEP 2014



Proactively navigating the challenges of protecting energy IP

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### **Substitution allowed? State biosimilars laws are evolving**

10 SEP 2014

Biosimilar products have not yet reached the US market, but debates on the laws and regulations that will govern them have been raging for some time

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### **Supreme Court Corner - Q3 2014**

10 SEP 2014

A review of cases relevant to IPT decided or argued before the Court during Q3

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### **US Congress may act again on patent reform**

26 JUN 2014

Recent activity regarding patent trolls

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

5 DEC 2013

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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### **Intellectual Property and Technology News (United States) Issue 19, Q3 2013**

4 SEP 2013

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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### **Intellectual Property and Technology News (United States) Issue 18, Q2 2013**

4 JUN 2013

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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### **Intellectual Property and Technology News (United States) Issue 16, Q4 2012**

10 Dec 2012

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News (United States)**  
Issue 15, Q3 2012

5 Sep 2012

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News (United States)**  
Issue 14, Q2 2012

26 Jun 2012

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News (United States)**  
Issue 13, Q1 2012

30 Mar 2012

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News (United States)**  
Issue 12, Q4 2011

20 Dec 2011

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News (United States)**  
Issue 11, Q3 2011

12 Sep 2011

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
Issue 10, Q2 2011

28 Jun 2011

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
Issue 9, Q1 2011

22 Mar 2011

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
**Issue 8, Q4 2010**

9 Dec 2010

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
**Issue 7, Q3 2010**

6 Oct 2010

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
**Issue 6, Q2 2010**

18 Jun 2010

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
**Issue 5, Q1 2010**

10 Mar 2010

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
**Issue 4, Q4 2009**

3 Dec 2009

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
**Issue 3, Q3 2009**

11 Sep 2009

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
**Issue 2, Q2 2009**

1 Jun 2009

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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**Intellectual Property and Technology News**  
**Issue 1, Q1 2009**

17 Feb 2009

**INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS**

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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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**Intellectual Property and Technology News (United States)**  
**Issue 17, Q1 2013**

7 MAR 2013

**INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS**

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**NIEUWS**

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**DLA Piper advises Philip Morris International Inc. on the completion of its US\$16 billion acquisition of Swedish Match**

14 November 2022

DLA Piper advised Philip Morris Holland Holdings B.V., an affiliate of Philip Morris International Inc. (PMI), on the completion of its recommended public offer to the shareholders of Swedish Match AB.

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**DLA Piper expands its Intellectual Property & Technology practice with the addition of Melissa Harwood, Ph.D. in Seattle**

4 May 2022

DLA Piper is expanding its Intellectual Property & Technology practice with the arrival of Melissa Harwood as partner in the firm's Seattle office. Harwood will be part of the Intellectual Property & Technology practice's Patent Prosecution subgroup.

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**Christopher Halliday joins DLA Piper's Patent Prosecution practice and Life Sciences sector in Philadelphia**

18 January 2022

DLA Piper announced today that Christopher Halliday has joined the firm's Patent Prosecution practice and Life Sciences sector as a partner in Philadelphia.

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### **William Mulholland joins DLA Piper's Patent Prosecution practice in Phoenix**

15 November 2021

DLA Piper announced today that William Mulholland has joined the firm's Patent Prosecution practice and Life Sciences sector as a partner in Phoenix.

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### **DLA Piper lawyers and practices ranked in latest edition of *The Legal 500***

17 June 2021

DLA Piper announced today that the firm received 42 individual lawyer rankings and 49 firm rankings in *The Legal 500 United States* 2021 guide.

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### **Nine DLA Piper lawyers recognized by BTI Consulting Group for superior client service**

10 December 2020

DLA Piper is pleased to announce that BTI Consulting Group has recognized nine of its lawyers for providing superior service to clients.

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