



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

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- 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

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.

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.

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.

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.

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.

***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?

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.

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.

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.

Valeant v. Mylan: What venues are left for Hatch-Waxman cases?

10 November 2020

The decision substantially limits the number of venues where Hatch-Waxman cases may be brought.

Edwards Lifesciences v. Meril Life Sciences: Another ripple in the Safe Harbor?

26 October 2020

Navigating the contours of the Safe Harbor provision in view of recent Federal Circuit decisions will be a complicated, uncertain process.

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.

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.

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.

Supreme Court Corner - Q4 2016

20 DEC 2016

Two patent cases, two copyright cases

Best practices in defending patent litigation

20 DEC 2016

Key issues for companies that engage in patent litigation.

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.

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.

Supreme Court Corner: Q1 2016

29 MAR 2016

Two cases to watch.

The role of evidence in inter partes review

29 MAR 2016

Explaining some evidentiary issues that have decided PTAB proceedings.

Supreme Court Corner: Q4 2015

2 DEC 2015

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

Are IPRs impacting the pharmaceutical industry?

9 JUN 2015

Choosing between IPRs and district court litigation

Supreme Court Corner: Q2 2015

9 JUN 2015

Recent decisions and cases to watch

Patent wars: can the energy industry avoid them?

10 SEP 2014

Proactively navigating the challenges of protecting energy IP

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

Supreme Court Corner - Q3 2014

10 SEP 2014

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

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](#)

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

4 SEP 2013

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

4 JUN 2013

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

10 Dec 2012

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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

5 Sep 2012

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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

26 Jun 2012

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

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

30 Mar 2012

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

20 Dec 2011

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

12 Sep 2011

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

Intellectual Property and Technology News
Issue 10, Q2 2011

28 Jun 2011

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

Intellectual Property and Technology News
Issue 9, Q1 2011

22 Mar 2011

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

Intellectual Property and Technology News
Issue 8, Q4 2010

9 Dec 2010

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

Intellectual Property and Technology News
Issue 7, Q3 2010

6 Oct 2010

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

Intellectual Property and Technology News
Issue 6, Q2 2010

18 Jun 2010

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

Intellectual Property and Technology News
Issue 5, Q1 2010

10 Mar 2010

[INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS](#)

Intellectual Property and Technology News
Issue 4, Q4 2009

3 Dec 2009

INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS

Intellectual Property and Technology News
Issue 3, Q3 2009

11 Sep 2009

INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS

Intellectual Property and Technology News
Issue 2, Q2 2009

1 Jun 2009

INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS

Intellectual Property and Technology News
Issue 1, Q1 2009

17 Feb 2009

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.

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

7 MAR 2013

INTELLECTUAL PROPERTY AND TECHNOLOGY NEWS

[Events](#)

[Previous](#)

Planning for an Uncertain World

16 November 2020
TechLaw Event Series
Webinar

TechLaw

31 July 2020
TechLaw Event Series
Webinar

NEWS

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.

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.

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.

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.

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.

25 DLA Piper lawyers in 9 countries recognized as world's leading patent professionals

15 October 2020

IAM Patent 1000: The World's Leading Patent Professionals 2020 has named 25 DLA Piper lawyers in nine countries to its list of top patent professionals.
