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The Unitary Patent era is about to begin: what to expect?

AMERICAS & CARIBBEAN Law firm RANKINGS

Marisol Cardoso, Patent Consultant at Inventa, informs us of the expectations for the implementation of the Unitary Patent across the EU member states with crucial advice for filing.

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CTC Legal Media

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Editor's welcome

Having initially been agreed in 2012, the European Unitary Patent is finally expected to enter into force later this year. Our cover story this issue brings a welcomed evaluation of what to expect in the Unitary Patent era, covering framework, coverage, and the transition period as well as some anticipated pros and cons.

Our guest interview this issue is with Ed White, Chief Analyst and VP of IP and Innovation Research at Clarivate, discussing the process, greatest growth area, and Ed's key takeaway from the Top 100 Global Innovators™ 2022 report.

> **"A welcomed evaluation of what to expect in the Unitary Patent era."**

Plus, an update on the position of AI systems eligibility for patents, a strategic analysis of accelerated examination in the US, a review of patenting in the metaverse, and tips for avoiding PR disasters when drafting patents.

Further, in an interview with Two IP's Co-Founder, we discuss a new alternative to private practice for experienced attorneys.

This, and so much more!

We would like to give special thanks to this issue's *Women in IP Leadership* sponsor, Fenix Legal, for facilitating the continuation of the segment and encouraging the empowerment of women in the sector.

Plus, don't miss the final chapter of our six part diversity, equity, and inclusion series; chapter 6: tips for awareness and self-improvement. If you've missed the series you can catch up via our website for fantastic insight and learning.

Enjoy the issue!

Faye Waterford, Editor

Mission statement

The Patent Lawyer educates and informs professionals working in the industry by disseminating and expanding knowledge globally. It features articles written by people at the top of their fields of expertise, which contain not just the facts but analysis and opinion. Important judgments are examined in case studies and topical issues are reviewed in longer feature articles. All of this and the top news stories are brought to your desk via the printed magazine or the website *www.patentlawyermagazine.com*

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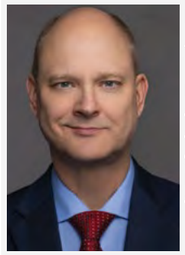
In a career spanning over four decades, Pravin has emerged as an IP trailblazer having strengthened India's IP jurisprudence with a practice encompassing all areas of IP litigation including patents, copyright, design, trademarks, enforcement and dispute resolution.



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Mark's primary areas of expertise are the IP and data-use aspects of academic technology transfer, government funding of basic research, public-private partnerships, and human and animal medical research.

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The Patent Lawyer **would like to thank the Editorial Board for their time and support.**

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Osamu is a patent attorney specializing in the fields of biotechnology, pharmaceuticals and diagnostics. Osamu is extensively experienced in all aspect of patent issues in these technical fields.

The Unitary Patent era is about to begin: what to expect?

Marisol Cardoso, Patent Consultant at Inventa, informs us of the expectations for the implementation of the Unitary Patent across the EU member states with crucial advice for filing.

In December 2012, the European countries and the European Parliament agreed on a legislative initiative that laid the ground for the creation of the unitary patent protection in the European Union (EU). Now, the implementation of a much simpler and less expensive European patent system is highly expected for the second half of 2022.

The Unitary Patents will allow inventors (individuals, companies, universities, and research organizations) to obtain uniform patent protection across all participating EU member states by submitting a single application to the European Patent Office (EPO), which will be searched and examined under the rules of the European Patent Convention (EPC).

As regards infringement and validity issues, the Unified Patent Court (UPC) will offer a single, specialized patent jurisdiction in all Member States that have ratified the Agreement on a Unified Patent Court (UPC Agreement), therefore, ending the need for litigation in different countries.

Résumé

Marisol Cardoso

Marisol Cardoso is a Patent Consultant at Inventa, with complete and dynamic knowledge of the entire process involving patents (prior art searches, patent drafting, patent filing, and responses to actions of patent offices), in the pharmaceutical and biotechnology sectors.

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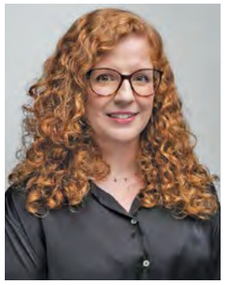

Marisol Cardoso

> **The Applicant must first obtain a European patent. Once granted, the patent owner must file a "request for unitary effect".**

EU regulations on the Unitary Patent

The two EU regulations nos. 1257/2012 and 1260/2012 establish the Unitary Patent system and entered into force on 20 January 2013. However, the Unitary Patent system is inextricably linked to the creation of the UPC, and the EU regulations will only apply as from the date of entry into force of the UPC Agreement.

The UPC Agreement was signed as an intergovernmental treaty in February 2013 by 25 states (all EU member states except Spain, Poland, and Croatia). However, for it to enter into force, one last condition must be satisfied: the three EU states with the most European patents in effect in 2012 must ratify the Agreement - and Germany still have not deposited its instrument of ratification.

It is expected that Germany will wait until the UPC administration is in operation (at this moment, the UPC is in a provisional application phase) and the Unitary Patent will, then, enter into force on the first day of the fourth month counted after the deposit of the German's instrument.

Meanwhile, all EU member states (except Croatia and Spain) are participating in the enhanced co-operation on the Unitary Patent protection.

Secondary legislations related to the establishment of a Unitary Patent Division at the EPO, the fees and methods of payment thereof, the compensation for translation costs, and management of the income and costs related to Unitary Patents further implement the Unitary Patent protection system.

The Unitary Patent framework

The Unitary Patent will be based on a European patent granted by EPO, on or after the date of entry into force of the UPC Agreement, under the rules and the procedures of the EPC. Therefore, the pre-grant procedures, such as the high standards of search and examination applied to the European patents granted by the EPO, will be maintained.

Therefore, before a Unitary Patent can be registered by the EPO, the Applicant must first obtain a European patent. Once granted, the patent owner must file a "request for unitary effect" (free of charge) preferably online at the EPO platform to obtain a Unitary Patent.

To be eligible, the European patent must have been granted with the same set of claims in respect of all the participating Member States and the request must be filed no later than one month after the date of publication of the mention of the grant in the European Patent Bulletin. The Unitary Patents will only be registered if the requirements are fulfilled.

The EPO will provide a new Register for Unitary Patent Protection with all relevant legal status information related to licensing, transfer, limitation, revocation, and lapse of the Unitary Patent.

Coverage

When the UPC Agreement enters into force, the Unitary Patents will cover the member states which have already deposited their instrument of ratification. Up to the moment, the 17 member states which will participate in the Unitary Patent when it starts are: Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia and Sweden.

It is expected that outstanding ratifications take place successively for the members participating in the enhanced co-operation, namely, Cyprus, Czech Republic, Greece, Hungary, Ireland, Poland, Romania and Slovakia.

Spain decided not to join the Unitary Patent system because of discrepancies with the linguistic regime adopted and the doubts about legal certainty raised by the system. As regards Croatia, the country joined the EU in 2013, i.e., after the UPC Agreement was signed and its entrance in the system is expected to occur shortly.

Therefore, Unitary Patents with different territorial coverage are likely to occur, and such coverage will remain the same for the entire patent lifetime, irrespective of any subsequent ratifications of the UPC Agreement after the date of registration of the unitary effect.

> **Unitary Patents with different territorial coverage are likely to occur, and such coverage will remain the same for the entire patent lifetime.**

Transitional period

In the moment the Unitary Patent system enters into force, two transitional measures are predicted for the European patent applications which have reached the final phase of the grant procedure.

The first transitional measure will enable Applicants to file early requests for unitary effect already before the start of the Unitary Patent system, i.e., as soon as Germany deposits its instrument of ratification of the UPC Agreement.

In this case, the unitary effect will be registered when the Unitary Patent system starts, provided that all corresponding requirements for registration are met. Otherwise, EPO will invite the patent owner to correct deficiencies, if applicable, or reject the request. A communication concerning the result of the request for unitary effect will be issued a few days after the publication of the mention of the grant of the European patent in the European Patent Bulletin.

The second transitional measure will provide the possibility for the Applicant to request a delay in issuing the decision to grant a European patent by the Office and before approving the text intended for grant. Since the Unitary Patent protection can only be requested to European patents granted by EPO on or after the date of entry into force of the UPC Agreement, this measure will make it possible to postpone the granting date of the European patent to make it eligible for Unitary Patent protection.

The EPO will allow requests for a delay in issuing the grant as of the date Germany deposits its instrument of ratification of the UPC Agreement and until the start date of the Unitary Patent system. The request will only be considered valid if the Applicant has not yet approved the text intended for grant.

As regards litigation involving "classic" European patents, for a transitional period of seven years (which can be extended to up to seven more years), actions for infringement or for revocation may still be brought before national courts and the patent owner will be able to opt-out of the UPC's jurisdiction for the entire lifetime of the patent.

Such possibility, however, is not available for Unitary Patents.

> **Thus, there will be only one procedure, one currency (euros), and one deadline to be met.**

Pros

Today, an inventor can protect an invention in Europe via a direct filing in the country of interest (national patent application using the Paris Convention) or via a regional filing in EPO (European patent).

Even though EPO examines applications for European patents centrally, granted European patents must be validated and maintained individually in each country where they take effect, in a complex and costly process.

One of the major benefits of the Unitary Patents is that the national validation processes will be no longer needed, since all post-grant administration will be handled by the EPO, further reducing costs and the administrative workload.

As regards translations, the official languages accepted by EPO are English, French and German. After a transitional period of six years (which can be extended up to 12 years), no translations will be needed when opting for a Unitary Patent.

During the transitional period, a full translation of the European patent is required to be filed, together with the request for unitary effect, in the following cases:

- If the language of the proceedings before the EPO was French or German, a full translation of the European patent into English is required.
- If the language of the proceedings before the EPO was English, a full translation of the European patent into any other official language of an EU member state is required.

However, the translation is for information only and has no legal effect.

Also, a compensation scheme will cover the costs of translating the application in the pre-grant phase for EU-based SMEs, natural persons, non-profit organizations, universities and public research organizations, when the European patent application or Euro-PCT application leading to the Unitary Patent was filed in an official EU language other than English, French or German. The request for compensation must be filed together with the request for unitary effect.

As regards costs, the Unitary Patent owners will pay one single (and cost attractive) renewal fee to the EPO without the need of a representative. Thus, there will be only one procedure, one currency (euros), and one deadline to be met.

As regards infringement and validity issues, the UPC will have exclusive competence in the contracting member states in respect of European patents with unitary effect. This centralized legal area will be particularly advantageous to patent owners when there is a need to enforce a patent in different European countries by allowing greater objectivity.

Cons

Despite the fact that the Unitary Patent system provides a user-friendly, simpler, and cheaper way to protect inventions, patent experts and large enterprises point out some weaknesses that need to be considered.

The first point addresses to the fact that all the search and examination processes will be performed under the rules and the procedures of the EPC. EPO practice is known to be strict on the assessment of a patent application and, to be admissible by the EPO, the EPO rules and guidelines must be followed rigorously.

A second point relates to the fact that, in countries where the mother language is not an official language of the EPO, Unitary Patents would not need to be translated to produce effects.

Since patent applications contain detailed technical information on all fields of technology and are considered a valuable source of specific knowledge, not translating the patent document would raise doubts on whether interested parties would benefit from the disclosures thereof.

> **Lastly, as regards proceedings before the UPC, patent owners must also accept the risk of losing the protection in all states at the same time in case the Unitary Patent is successfully challenged.**

The linguistic regime is also called into question when it relates to invalidity and non-infringement declaratory proceedings before the UPC. Local companies would have to bear the costs of the relevant translations to guarantee that there is no infringement of rights and, in case it is forced to plead, the proceedings will take place in English, French or German, even if the company is sued for infringement locally.

Lastly, as regards proceedings before the UPC, patent owners must also accept the risk of losing the protection in all states at the same time in case the Unitary Patent is successfully challenged.

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Top 100 Global Innovators™ 2022 from Clarivate: an interview with Ed White, Chief Analyst and VP of IP and Innovation Research

Ed White sits down with *The Patent Lawyer* to discuss the findings of the recently released Top 100 Global Innovators™ 2022 report.

Can you start by telling us about yourself and your position at Clarivate?
I am Chief Analyst for IP and Innovation research at Clarivate, and I focus on the use of innovation datasets to guide and inform customers' research, protection, and commercialization strategies. One of my responsibilities is leading our Top 100 Global Innovators™ program. I have been with Clarivate for over 20 years, joining as a graduate in our patent editorial division, becoming a member and later leader of our patent analysis research services group. Today, the team and I focus on extending the reach of innovation data and the way it can be structured and measured to understand the state of the lifecycle across different technology development fronts.

Can you tell us about the intentions behind Top 100 Global Innovators™ and why you think it is important?
Top 100 Global Innovators' purpose is to shine a light on those organizations that sit at the very top of the innovation ecosystem; that push furthest against current technical boundaries with their work and ideation. It leans on the methods and metrics we use every day to guide our customers in their decision making, and that measures not just scale, but strength, importance and quality. Top 100 Global Innovators has been produced by Clarivate every year since 2012, with our 2022 report being our 11th edition.

What process is used to identify the Top 100 Global Innovators?
Our starting point is Clarivate global invention data[1]. Structuring patent information around patented ideas, this serves as a base content set for us to extend into normalized measures of commercial and technical reach and impact. This year, for the first time, we made a significant change to the way the list is calculated, bringing the process up to date with the methodologies we use commercially.

In essence, Top 100 Global Innovators uses two tracks of analysis that come together at the end to generate a ranking. Track one identifies organizations that qualify, filtering for invention volume and international activity. The second track measures the external downstream influence of each invention in our datasets, the economic footprint of patent assets generated from each invention, the global ambition of the applicant behind each invention, and the rarity of the technology mix within each invention.

These combine to create a normalized strength score for every one of the 51 million patented ideas we track.

This is then combined with the qualifying organizations in track one with the median strength score of their inventions in the 2022 measurement window. From that process, we identify the 100 innovating organizations at the very top.

What jurisdiction saw the greatest innovational growth for 2022?
With the revision to the methodology, we saw an influx of Japanese firms into the Top 100 Global Innovators this year, and in particular, electronics companies: entities such as Kioxia and Screen Holdings. We also saw an increase in European recipients, with seven new entrants such as Rolls Royce, Volkswagen, Evonik and Signify. A particular data point in Europe was an upswing in transportation innovators: aerospace and automotive.

Ed White

> **In essence, Top 100 Global Innovators uses two tracks of analysis that come together at the end to generate a ranking.**

[1] The Derwent World Patents Index™

What sector saw the greatest growth for 2022, and why do you think that is?
The largest increase in sector recipients was in the electronics and semiconductor segments, and then particularly in Mainland China, Taiwan and Japan regions, reflecting the continued acceleration of strong ideation in that area. For me, the really interesting expansion was in the automotive sector. This isn't tied to a specific geography – it is a global increase, and reflects the very strong technology convergence and disruption forces that are affecting that industry. We are seeing fantastic levels of new, strong, high-quality technologies, at scale, emanating from both traditional automotive manufacturers, as well as their suppliers – companies like Valeo, Continental, Bosch, Denso, etc. It is clear that the revolution in the way we move through the world – electrification, autonomy, connectivity, etc. – is seeing a response in the research output of players in the industry.

Where do you expect the direction of innovation to head in the coming years?
From our models, two sectors emerge as likely candidates for improved performance in our rankings, matching closely with more general megatrends: telecommunications and industrial systems. When I look at the largescale technology development fronts – connectivity, automation, sustainability, mobility and wellbeing – these sector-specific forecasts map well into that

Résumé

Ed White, Chief Analyst and VP of IP and Innovation Research at Clarivate, is a thought leader in innovation measurement and forecasting. A 20-year veteran of Clarivate, Ed has spent most of his career developing new methods of analyzing innovation ecosystems and has advised hundreds of corporations, institutions, and governments with technology data investigations. His active research interests include broadening advanced patent data analysis methods to other intellectual property assets classes. Ed is the head author of the Top 100 Global Innovators™ program and a regular contributor in press articles, podcasts, guest lectures, and webinars. He is a graduate of the University of Nottingham, with a background in Electronic Engineering.

> **For me, the really interesting expansion was in the automotive sector. This isn't tied to a specific geography – it is a global increase, and reflects the very strong technology convergence and disruption forces that are affecting that industry.**

structure. It gets labelled the "internet of things", but in our data it shows a clear specificity – the use of data connectivity in industrial automation and manufacturing settings.

I also feel that the wider pressure surrounding convergence – the cross application of enabling technologies disrupting and empowering innovation elsewhere – will very much continue.

Lastly, the acceleration in patented ideas generally is enormous, and with a strong Mainland China pressure behind that – it will continue to be a topic of debate and interest to patent practitioners.

What aspect did you find most surprising in 2022?

It was the ability of the Top 100 process to identify the very strong research and innovation activity occurring inside industries – the supply chain, the specialist innovators. Top 100 Global Innovators deliberately does not look at financial performance as part of its scoring process (though scale of activity does somewhat correlate here) because we are measuring something deeper and earlier than revenues and profitability – idea generation capability. When I look at the 2022 recipients as a whole, it is TSMC, Alstom, ABB, Evonik, Nitto Denko and others that jump out at me. These are B2B entities that are really moving the needle of technical capability.

What are your key takeaways from Top 100 Global Innovators 2022?

There are two critical takeaways that I focus on for the patent practitioner. One is the forecast of a historically high-volume period in patent filing over the next four years – largely driven by entities in Mainland China. We have known and tracked this data point for a decade or more, but it is accelerating. Within that, we looked at the proportion of activity by region as a whole, versus that emanating from entities in the Top 1,000 in the measurement process. For Europe and the US, it is just under 50% – half of patent activity is coming from entities in the Top 1,000. For Japan, Korea and Taiwan, it is over 90% – their patent activity is concentrated in the top of the global ecosystem. For Mainland China it was 8% – a big outlier, showing the depth of the potential innovation pool there.

Second, it is the requirement for IP professionals to add the tools of mathematics and statistical measure so that they and their stakeholders can navigate these historic volumes. We need metrics to be able to discern importance and prioritization, and to guide as advisors. At a very simple level, which documents do you read first? Those that meet a search criteria (which is going to increase), or those that also are tracking higher in influence and expenditure measures?

Do you anticipate changes in methodology for Top 100 Global Innovators as innovation becomes more diverse and complex?

This question was the reason for the re-platform of Top 100 Global Innovators 2022 onto our Derwent Strength Index[2] measure as its method of differentiation. The complexity and scale of innovation in the 2020s does need a greater level of resolution and baseline comparison. Intriguing to me is that there is an interesting contrast in patent data today – never have we had so much information to discern meaning from, which makes it more difficult to hear signal. Equally, never has there been so much data on which to assess over- and underperformance, from which we can create normalized baselines and create a signal filter.

The Top 100 Global Innovators 2022 process has been brought forward to our current commercial measures and metrics, which will act as a foundation for future years, creating clarity that scales alongside the increasing complexity dynamic of innovation ecosystems.

What technology or invention are you looking forward to becoming mainstream?

A great question. I would look for technology pathways that actively target reduced harm and greater capability, and that have wide applicability. For me, that is alternate battery technologies. As we shift our energy sources to renewables there is a significant need for large-scale energy storage, and as we de-carbon our transportation systems we need faster charging, lighter electrical storage. With our current battery designs being resource intensive and with high-impact from an extraction perspective, candidate technologies such as Aluminum-ion and similar really fit the bill of increased capability, harm reduction and broad potential.

Contact
https://clarivate.com/top-100-innovators/

[2] The combined metric on a Derwent World Patents Index invention record, that combines the measures of influence, success, globalization and technical distinctiveness.

Should AI systems be eligible for patents?

Ben Stasa, Patent Attorney at Brooks Kushman, evaluates the current status of AI inventors across the globe and what may need to change for patent law policy in this rapidly evolving division.

The line between artificial intelligence ("AI") and pure human innovation has blurred as technology continues to evolve at a rapid pace. Technological advances and the parallel progress of AI has resulted in several key innovations: robots can double as radiologists and have the ability to interpret CT scans and other imaging, vehicles can drive themselves with automated technology, and algorithms have the ability to create written and artistic bodies of work.

AI advances have been front and center during the COVID-19 pandemic. Algorithms were established to determine which patients could be discharged from the hospital, unique symptoms like loss of smell were identified as a distinguishing factor from the flu, and future outbreaks could be predicted using AI. A human vaccine was exclusively generated by an AI program called SAM, and clinical trials recently began in the United States.

As technology continues its relentless advance, AI continues to evolve from a mere tool that facilitates the creation of innovative outputs to creating outputs itself—a painter not just a paintbrush. In 1950, Alan Turing posed the question: "Can machines think?" We must now also consider: "Can machines invent?"

The intersection of AI and the law creates interesting inquiries: should AI be treated like a technological tool or like a human? This issue has been addressed in the academic literature in the context of liability, contracts, and criminal law. Today, these issues are also at the forefront of intellectual property law.

The United States Patent and Trademark Office (USPTO) states that "in the 16 years from 2002 to 2018, annual AI patent applications increased by more than 100%, rising from 30,000 to more than 60,000 annually. Over the same period, the share of all patent applications that contain AI grew from 9% to nearly 16%."[1]

The U.S. National Institute of Standards and Technology define AI technologies and systems to "comprise software and/or hardware that can learn to solve complex problems, make predictions or undertake tasks that require human-like sensing (such as vision, speech, and touch), perception, cognition, planning, learning, communication, or physical action." The USPTO, which finds this definition "carefully constructed" but "not specific enough for a patent level analysis" defines AI as comprising one or more of the following component technologies: (i) vision, (ii) planning/control, (iii) knowledge processing, (iv) speech, (v) AI hardware, (vi) evolutionary computation, (vii) natural language processing, and (viii) machine learning.[2]

> **A human vaccine was exclusively generated by an AI program called SAM, and clinical trials recently began in the United States.**

One of today's big questions in IP is whether AI can be named as the inventor in a patent application. As discussed below, while the United States, Europe and the United Kingdom say no, South Africa and Australia say yes.

DABUS and its implications around the globe

In 2018 and 2019, Dr. Stephen Thaler filed a patent application naming Device for Autonomous Bootstrapping of Unified Sentience, known as "DABUS," as the inventor of the resulting inventions. The application was filed in the European Union, United States, and United Kingdom patent offices, and all three entities denied the patent application on the basis of one key point: only human inventors can be issued a patent.

In the United States, the Patent Act provides the statutory support for the conclusion that inventors must be humans. Section 101 of the Patent Act provides, "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor…." Section 102 adds that a "person shall be entitled…."

South Africa and Australia are not following the trend of their European and American counterparts. In both South Africa and Australia, a patent application was granted to DABUS with Dr. Thaler as the owner of the patent. However, this blanket approval appears to be vulnerable. In South Africa, patent applications are granted if the minimum formalities are met; it appears there wasn't an examination of the substantive portion of the application. A third party could file to revoke the patent based on lack of novelty and inventiveness, and also allege that Dr. Thaler wasn't entitled to apply for the patent.

In Australia, the court expanded the definition of inventor. It ruled that for a patent the ordinary meaning of inventor doesn't exclude nonhumans. The reasoning behind this decision is that several individuals could contribute to the AI, and naming the AI as the inventor avoids the uncertainty of who should be recognized for the inventive process.

The future of AI through the lens of intellectual property and policy

As AI becomes more sophisticated, intellectual property law will almost certainly need to evolve to address the role of AI in creating patentable inventions. These issues are being discussed and debated among academics, regulatory bodies, and the broader legal community.

Ben Stasa

Résumé

Ben Stasa, Patent Attorney

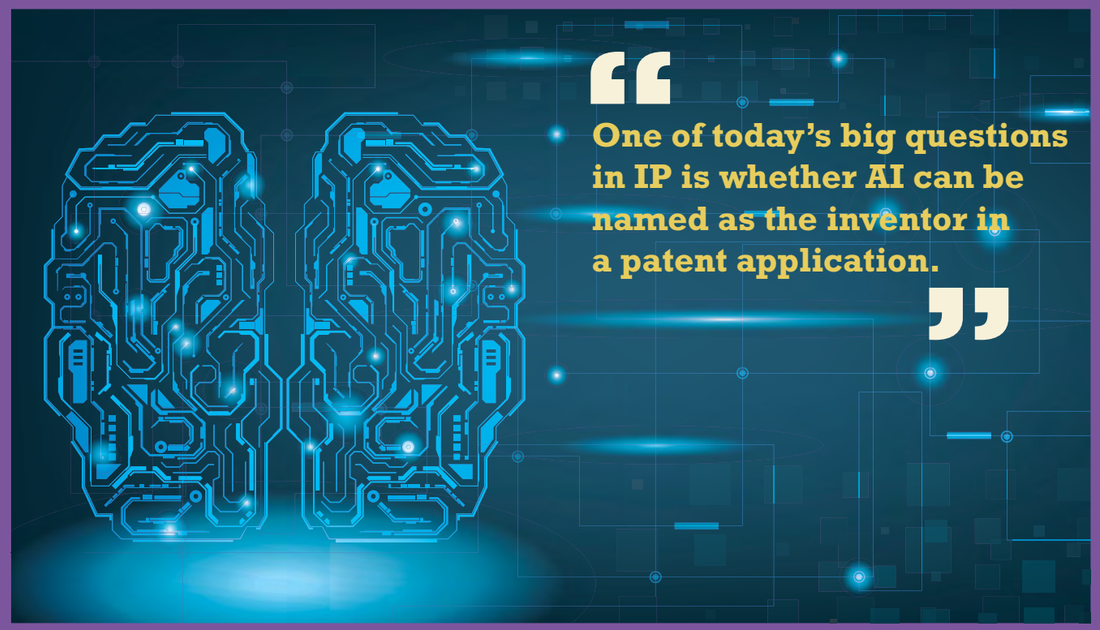
Ben guides the development of medium to large-scale patent portfolios and manages teams of attorneys tasked with supporting the same. Given his lead role, he is often called upon to handle complex patent issues, as well as opine on matters concerning infringement, patentability, and validity. Ben, as a result, has developed expertise in handling difficult legal circumstances for a wide array of technologies.

As a Ph.D. Candidate in electrical and computer engineering, Ben's research interests include artificial intelligence, blockchain, communications, microelectronics, power transmission, quantum computing, and signal processing. He is currently investigating application of machine learning to wireless communications, and deep learning to vocal pitch tracking.

> **In 1950, Alan Turing posed the question: "Can machines think?" We must now also consider: "Can machines invent?"**

[1] https://www.uspto.gov/sites/default/files/documents/OCE-DH-AI.pdf, page 2

[2] https://www.uspto.gov/sites/default/files/documents/OCE-DH-AI.pdf, page 3a



The importance of the future role of AI in IP was reflected in a request for comments on questions concerning patent law as applied to AI inventions by the USPTO in 2019. Among the questions posed by the USPTO was: "Do current patent laws and regulations regarding inventorship need to be revised to take into account inventions where an entity or entities other than a natural person contributed to the conception of an invention?"[3]

The more difficult questions are: (1) whether an invention *created* by AI, as opposed to one that AI *contributed* to, is patent-eligible, and (2) if so, who should be awarded inventorship for the invention created by a machine?

There are a host of issues that must be explored to answer these questions. Some are philosophical, such as whether AI systems, particularly those that embody more human-like characteristics, should be treated as mere technological tools or as human-like social agents?

Other questions are more practical. One of the most important policy issues at the heart of this debate concerns whether innovation will be stifled if patent protection is not granted to AI. Advocates for reform argue that without such protection, future AI-generated inventions will simply enter the public domain. If that happens, and there is no profit motive for AI inventions, there will be no incentive for humans to create more advanced AI systems.

In his book, *The Reasonable Robot*, law professor Ryan Abbott, who is also a member of the Artificial Inventor Project, argues that making patent protection available to AI "would make inventive AI more valuable and incentivize AI development, which would translate to rewards for effort upstream from the stage of invention and ultimately result in more innovation." On the other hand, critics argue that granting patents to AI may suppress human creativity.

There are no easy answers to these questions. A white paper released by the World Economic Forum titled "Artificial Intelligence Collides with Patent Law" (the "White Paper") asserts that the path forward must "identify possible 'middle grounds' to help balance the competing objectives and factors."[4]

Regarding issues of patent-eligibility, the White Paper proposes possible middle ground solutions, including:

- "[R]aising the patentability standard (*e.g.* on nonobviousness) for inventions created solely by AI, which would level the playing field to some extent between human inventors and AI."[5]
- "[G]ranting different patent periods based on the level of human involvement in the inventive process."[6]
- "[R]aising the bar for utility just for AI-generated inventions, so that only the truly 'useful' inventions by AI would be eligible for patent rights."[7]

As noted above, if it is determined that inventions created by AI systems are eligible for patent protection, the next question becomes who should be listed as the inventor. This question also requires an analysis of incentives and a balancing of interests. The White Paper notes that while legislatures may have the power to grant legal personhood and inventorship status to AI systems, doing so may not serve the fundamental purpose of intellectual property policy which is incentivizing innovation.

According to the White Paper, "Would there be any meaningful benefits in recognizing AI as inventors beyond those provided by allowing AI-created inventions to be patentable?"[8] In other words, computers that lack consciousness would not be any more motivated to be inventive by the possibility of being granted a patent.

Another option addressed by the White Paper is "not listing any inventor" when granting a patent for an invention created by an AI.[9] As the White Paper notes, current law would need to be updated to establish patents for inventions created by AI without listing an inventor. This would obviate the need to grant legal personhood to machines.

However, in order to spur innovation, "sufficient incentives must be provided to the people involved in creating and maintaining the AI that generates inventive ideas, so that they will be motivated to continue developing such inventive AI."[10] To address this problem, the White Paper suggests that "a new category may need to be created for developers so that their contributions are acknowledged on the face of the patent."[10]

"However, this blanket approval appears to be vulnerable."

What comes next for AI and patent law policy?

The only thing we know for sure is that machines will continue to become more advanced and technological innovation will continue to accelerate. IP law must find a middle ground in order to foster a partnership between machines and humans that furthers fundamental patent law policy objectives of promoting innovation and investment in new technologies.

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3 Request for Comments on Patenting Artificial Intelligence Inventions, 84 Fed. Reg. 44889 (2019).
4 https://www3.weforum.org/docs/WEF_48540_WP_End_of_Innovation_Protecting_Patent_Law.pdf
5 Id. page 10, citing Cf. Yanisky-Ravid, supra note 146, at 3 (discussing the "non-obviousness standard used by other scholars to afford patent protection to inventions by AI systems")
6 Id., citing Erica Fraser, "Computers as Inventors – Legal and Policy Implications of Artificial Intelligence on Patent Law", SCRIPTed 13(3), 305 (2016)
7 *Id.*
8 *Id.*
9 *Id.*
10 *Id.*
11 *Id.*

Four tips for avoiding PR disasters with drafting patents

Kirk Sigmon, Shareholder at Banner Witcoff, provides useful tips for drafting reputable patents in light of Sony's 2013 PR nightmare over U.S. Pat. No. 8,246,454 to Zalewski.

Kirk Sigmon

> **The Zalewski patent is a great example of how drafting mistakes can result in massive public relations blowback.**

Back in 2013, a normal Sony patent became a public relations nightmare. The patent, U.S. Pat. No. 8,246,454 to Zalewski, described a system for "embedding advertising within television programming." On first inspection, the patent is far from anything particularly offensive: it describes a variety of ways to add interactivity to advertisements, ostensibly to make advertisements less boring. But, likely to the chagrin of Sony, Zalewski included a now-infamous figure, Figure 9 (right), intended to depict "a user interacting verbally with a commercial":

This figure became the target of online scorn from many Internet publications: Fortune called the figure "hilarious" and "terrifying," Fast Company called it "horrid," and Tech Dirt used the figure as an example of the "Dystopian Future of Ads."

The Zalewski patent is a great example of how drafting mistakes can result in massive public relations blowback. Needless to say, it seems unlikely that Sony, inventor Zalewski, or Sony's patent attorneys intended for the Zalewski patent to become the harbinger of the dystopian future of advertising. That said, it nonetheless happened (at least in the mind of journalists).

So how do you avoid blowback like this for your clients? Here are four tips.

Tip 1: create a "bad words list"

Words matter in a patent application: don't use ones that a bored journalist could easily search for in pursuit of a story.

Virtually all industries have certain words and phrases that are associated with negative topics. For example, in the video game industry, words like "microtransactions," "pay-to-win," and "hacking" are generally associated with negative business practices. As another example, for the food

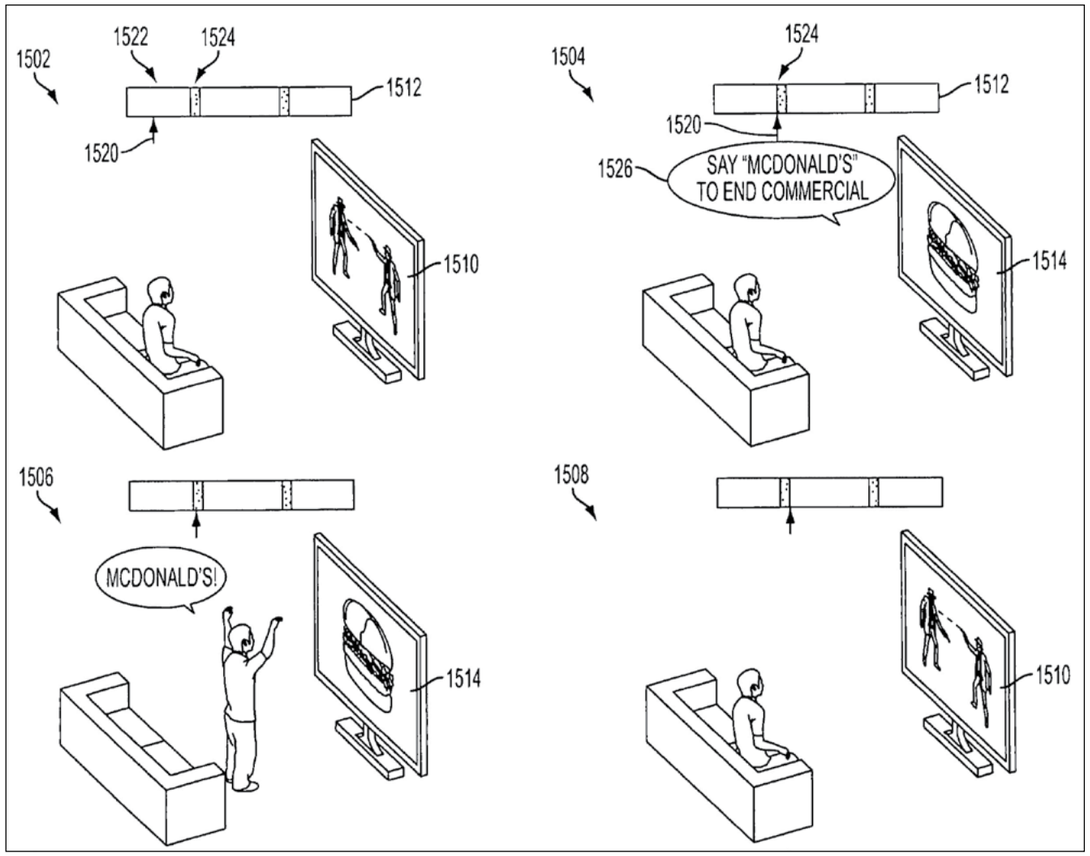

Figure 9

industry, strong negative implications are attached to words like "food poisoning," "rotten" and "spoilage." Using any such words in a patent application is generally a bad idea, even when such words are used in passing. Particularly, use of these words and phrases might cause the public to infer nefarious intent on the part of the inventors or patent assignees. For example, if a video game company uses the term "pay-to-win" in one of their patent applications, a commentator might misconstrue that use to suggest that the game company is designing their games to intentionally require users to pay to win, even if that's not even remotely the case. There's also a more practical reason to avoid "bad" words: journalists might use those terms to search patent databases to find easy targets for negative articles.

Instead of using those "bad" words and phrases, explore ways to broadly describe the topic at hand. For example, rather than using loaded terms like "pay-to-win," describe how different user activity levels (*e.g.*, time spent in a video game, skill in that video game, and–of course–payments in that video game) might modify how easy the game is for them. As another example, rather than discussing "theft" in the context of online banking accounts, broadly aver to the possibility of authorized and unauthorized activity with respect to those online banking accounts. While you might end up describing the same fundamental concepts,

> **Read your drafts critically, with an eye for content that the averagenon-engineer might misconstrue.**

Résumé

Kirk Sigmon, Shareholderss

Kirk is a Shareholder in the Washington, D.C. office of Banner Witcoff, an intellectual property law firm. Kirk began his legal career in Tokyo, and routinely works with U.S., Japanese, Korean, Chinese, and European intellectual property matters. One of Managing IP's Rising Stars, Kirk has successfully represented both plaintiffs and defendants in multimillion-dollar patent infringement trials in federal court. He has counseled Fortune 500 companies on topics including patent portfolio management and intellectual property enforcement.

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"To avoid this bias, as part of reviewing draft applications, review those applications like a person not of skill in the art, if only to see how those applications might be misconstrued."

you can at least do so in a way that avoids unreasonable inferences and search queries.

Tip 2: add a prosocial spin

It is not uncommon for laymen (e.g., journalists, activists, angry online forum posters) to read patents to find things to complain about. Read your drafts critically, with an eye for content that the average non-engineer might misconstrue. In turn, where possible, draft patents in a way that sounds as good to a layman as it does to an inventor or assignee.

Say, for example, that you are working on the Zalewski patent application, which broadly relates to adding interactivity to advertisements. Rather than describing the invention from the perspective of squeezing money out of customers (*e.g.*, "This method may be useful to force users to engage with advertisements so that they buy products"), it may be better to describe the invention from the perspective of the enjoyment of end users (*e.g.*, "This method may be useful to allow users to skip advertisements and/or make advertisements less boring"). In this way, the same underlying concept (interactive advertisements) can be described in a manner that seems less controversial to a layman.

One easy way to ensure that patent application content has a prosocial spin is to avoid (to the extent possible) discussing business benefits. Rather than characterizing an invention as beneficial because it makes and/or saves a company money, focus on why the invention does so: for example, because it allows for speedier manufacturing, fewer errors, better products, or the like. In the same vein, rather than characterizing users as a target of marketing or persuasion (e.g., "consumers will buy this because it looks expensive but really isn't"), focus on why such users might like your invention: because it's fun, easy to use, safe, or the like.

Tip 3: avoid brands

Putting known brand names and trademarks in U.S. patent applications can be cumbersome from a drafting perspective thanks to MPEP §608.01(v), but it can also give patent applications an undesirably corporate feeling. As such, it's often best to avoid using brand names and trademarks.

Assume again that you are working on the Zalewski patent application. As indicated above, Figure 9 of Zalewski explicitly references McDonalds. This decision gives the Zalewski patent a slightly more corporate feel than might otherwise be desired, which might inadvertently make a reader conclude that the entire patent is some sort of nefarious corporatist cash grab. But Figure 9 could easily have been revised to feel much less villainous. For example, Figure 9 could have been entirely improved by replacing the hamburger with some arbitrary image (*e.g.*, an image of a dumbbell) and the user saying some arbitrary, non-brand phrase (*e.g.*, "Exercise time!"). In such an example, what was originally a very unhealthy and corporate image (a user being encouraged to stand up and shout a fast food brand name) can be easily replaced with something more generic and healthier (a user being encouraged to stand up for their health).

There is, however, one significant exception to this rule: adding brand names and trademarks can be particularly helpful to add breadth to your application when used in a targeted manner. Say, for example, that you are drafting a virtual reality-related patent application, which includes "VR Device 203." In such an example, it might be beneficial to list off different devices that "VR Device 203" could be, including virtual reality goggles (e.g., the Oculus Quest 2), augmented reality glasses (e.g., Google Glass), cardboard holders (e.g., Google Cardboard), and the like. In this manner, during litigation, the "VR Device 203" can't easily be construed to exclusively relate to virtual reality goggles like the Oculus Quest 2, as the application will have provided specific, real-world examples of devices (such as Google Cardboard) that aren't virtual reality goggles.

Tip 4: defensively draft figures

While patent application text is often fairly convoluted and unintuitive for the layman, patent figures are often far more easily digested. After all, few articles talking about the Zalewski patent discussed its content: rather, most focused on FIG. 9 of Zalewski alone. As such, draft figures defensively: after all, they're arguably the easiest thing to share on social media or copy over into a negative news article.

Say, for example, that you are tasked with drafting an application directed to something particularly emotionally sensitive, such as a human cremation furnace. Depiction of certain aspects of that invention (*e.g.*, an outline of a corpse in the furnace) in a patent application figure might be disturbing or offensive to some readers. Moreover, such a figure might look bad if/when copied over into a news article, social media post, or the like. As such, while inventors might freely feel comfortable describing such content in their invention disclosure documents, and while you might discuss the topic in detail in the written description of a patent application, it might be a bad idea to depict such content in figures of that patent application. Where possible, simply omit that content and discuss it (if at all) in text.

In conclusion: review like a layman

One consistent theme repeated in the above tips is that inventors and patent attorneys might be comfortable with (and/or unaware of) issues that ordinary readers might find problematic. For example, while a web developer might be entirely comfortable with the idea of tracking users' web browsing activity, laymen and/or journalists might find that concept fundamentally invasive.

To avoid this bias, as part of reviewing draft applications, review those applications like a person not of skill in the art, if only to see how those applications might be misconstrued. In other words, review those applications like an angry journalist, not an understanding engineer. This sort of review is a good idea anyway, as it can allow you to spot areas where excessive simplicity (e.g., a figure depicting a user standing up and shouting "McDonald's!" at a television) can be revised to include much broader concepts (e.g., multiple figures depicting the various different ways a user could engage with interactive content on a television screen).

More broadly, it can be helpful to remember that, while patents are often drafted from the perspective of a person of ordinary skill in the art, that does not mean that patents are exclusively read by those individuals. Now, more than ever, the public can quickly access and read patent documents for themselves. In turn, those documents should be drafted with the understanding that the public might ultimately review them for many different reasons. After all, even the most innocuous patent application might be called the next alleged harbinger of a "dystopian future."

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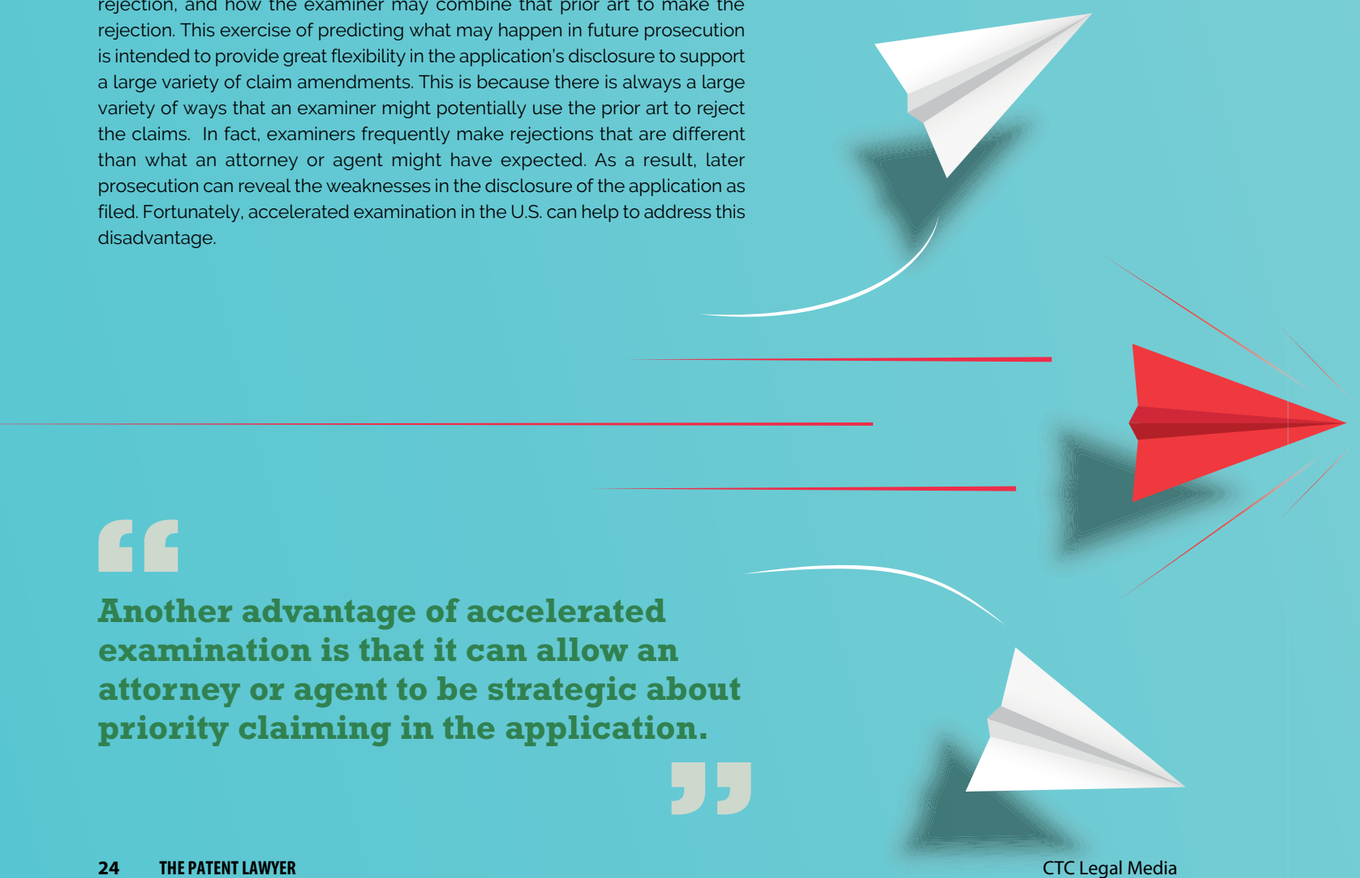
"As such, draft figures defensively: after all, they're arguably the easiest thing to share on social media or copy over into a negative news article."

Strategic and Practical Considerations for Accelerated Examination in the United States

Dr. Brent Johnson and Dr. Jennifer Zhou of Maschoff Brennan review the benefits and strategic advantages Track I and applicant's age accelerated examination can lend to patent prosecutors in the US.

Drafting a patent application usually requires that the patent attorney or agent predict what prior art the examiner may cite, and what prior art might destroy the novelty of the claims as filed. The practitioner also needs to be able to predict what prior art may be cited in an obviousness rejection, and how the examiner may combine that prior art to make the rejection. This exercise of predicting what may happen in future prosecution is intended to provide great flexibility in the application's disclosure to support a large variety of claim amendments. This is because there is always a large variety of ways that an examiner might potentially use the prior art to reject the claims. In fact, examiners frequently make rejections that are different than what an attorney or agent might have expected. As a result, later prosecution can reveal the weaknesses in the disclosure of the application as filed. Fortunately, accelerated examination in the U.S. can help to address this disadvantage.



Another advantage of accelerated examination is that it can allow an attorney or agent to be strategic about priority claiming in the application.

One of the biggest problems a patent applicant faces is that the publication of their own application ("Application 1") may prevent the applicant from having any remedy for the gaps in disclosure. Most countries do not consider unpublished applications to be prior art for obviousness or inventive step purposes. Thus, a patent applicant can file a new patent application ("Application 2") before publication of Application 1 with addition of new disclosure that supports new claim limitations. This may be very useful for Application 2 to avoid the prior art cited against Application 1 for the purposes of obviousness or inventive step. It also allows the patent applicant to add new claim limitations in Application 2, which are novel but probably not inventive or obvious over Application 1.

Most of the time, although it is not guaranteed, the first Office Action is normally received within three months of filing an application under accelerated examination in the United States. This means that if Application 1 is filed at or before the 12-month priority claiming deadline (for an earlier U.S. Provisional Application or an earlier priority application originating outside of the U.S.), the first Office Action will likely be received several months before Application 1 publishes.

As a result, the applicant has an opportunity (before 18 months from the priority date) to see what rejections are made against the claims of Application 1 in the first Office Action, and based on that to decide whether it is necessary to file Application 2 before Application 1 is published. The pre-publication filing of Application 2 avoids Application 1 as prior art for the purposes of obviousness or inventive step, while still allowing the applicant to add new subject matter, and/or revise or add new disclosure to support amendment around the problematic prior art raised in the Office Action in Application 1.

Another advantage of accelerated examination is that it can allow an attorney or agent to be strategic about priority claiming in the application. For example, sometimes it is useful to see whether making a priority claim is worth the loss of the patent term that accompanies the earlier priority date. In the U.S., a priority claim can be added up to the later of four months from the filing date and twelve months from the earliest priority date. (37 CFR 1.55d(1).) After this deadline, the applicant must pay a fee and file a petition to accept an unintentionally delayed claim for priority. (MPEP 214.02) This petition requires a "statement that the entire delay between the date the claim was due and the date the claim was filed was unintentional." (*Id.*) Thus, if a priority claim is added prior to the deadline, e.g., within four months of filing, there is no need to make a statement that the delay was unintentional.

Sometimes, a patent practitioner may be unsure about whether to claim priority to a particular earlier application. If a priority claim is included, and then removed, it may raise questions about what is supported by the earlier application. Additionally, removing the priority claim may attract unwanted attention from those who may challenge either the priority application or later applications. Since, as mentioned above, the first Office Action is usually within three months of filing for an application under accelerated examination, the applicant can potentially wait to see what the examiner cited references and rejections are in the first Office Action before deciding whether to make changes to a priority claim in question.

Another significant advantage of accelerated examination is that a thorough US prosecution is completed prior to the 30-month national stage filing deadline, which can help the applicant to make an informed decision on which countries to file a national phase application. This can potentially be useful in saving tens of thousands of dollars, or more, in international patent prosecution.

Dr. Brent Johnson

Dr. Jennifer Zhou

Résumés

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The applicant can potentially wait to see what the examiner cited references and rejections are in the first Office Action before deciding whether to make changes to a priority claim in question.

There are a number of ways that patent prosecution in the U.S. can be accelerated. These include the USPTO prioritized patent examination program (more commonly referred to as "Track One" or "Track I"), and a petition to make special based upon: the applicant's age or health, that the invention will materially enhance the quality of the environment, contribute to the development or conservation of energy resources, or contribute to countering terrorism. Recently, the USPTO had a program to petition to make an application special if it related to treatment of Covid-19. As with many other countries, the Patent Prosecution Highway is another way to accelerate examination in the United States. In this article, we will focus on the two types of accelerated examination that we have found particularly useful: Track I and a petition to make an application special based upon applicant's age.

Track I

Track I is a procedure for expedited review of a patent application for an additional fee. The Track I program provides for final disposition of a U.S. utility or plant patent application within 12 months, on average, from the date on which the Track I request is granted.

Track I examination is requested under 37 CFR § 1.102 (e), Track I may be requested as often as needed. Currently there is a limit of 15,000 granted requests for prioritized examination for a fiscal year. If this limit is reached, the USPTO will turn off the ability to file a request for prioritized examination in EFS-Web. However, we have filed hundreds of Track I patent applications since the beginning of this program, and have never had an application denied prioritized examination because the limit was reached. In fact, many of these Track I applications were filed in the month of December. Therefore, the likelihood of a Track I patent application being denied because the limit has been met is, at least for now, fairly low. Currently there is a **Track I filing fee** of $4200 for large entity ($2100 for small entity) in addition to the normal filing fee, search fee, examination fee, processing fee, publication fee, and any excess claim or page fees.

Additionally, the following requirements must be met for filing a Track I patent application:

(1) There can be no more than four independent claims;
(2) There can be no more than 30 total claims; and
(3) There can be no multiple dependent claims.

Furthermore, for filing a Track I U.S. patent application, in addition to the normal filing documents for a regular track patent application, you also need submit **Track I Request form** (Doc Code: TRACK1.REQ). We strongly recommend using the USPTO's certification and request form PTO/AIA/424 to request prioritized examination. The form is available on EFS-Web and on the USPTO's Internet Web site at http://www.uspto.gov/forms/index.jsp.

> **Track I is a procedure for expedited review of a patent application for an additional fee.**

When filing a Track I patent application, the applicant needs to be mindful of the following rules.

The Track I prioritized examination program grants special status until one of the following occurs:

a) the applicant files a petition for extension of time to extend the time period for filing a reply;
b) the applicant amends the application to contain more than four independent claims, more than thirty total claims, or a multiple dependent claim;
c) the applicant files a request for continued examination (RCE);
d) applicant files a notice of appeal;
e) applicant files a request for suspension of action;
f) a notice of allowance is mailed;
g) a final Office action is mailed;
h) the application is abandoned; or
i) examination is completed as defined in 37 CFR 41.102.

Track I Patent Application filing checklist

Requirement	Attorney/Agent initials
Separate Authorization to Pay Fees (transmittal letter)	
Track I Request Form	
Oath/Declaration	
Power of Attorney	
Application Data Sheet (with correct priority claims)	
Patent Application (Specification, Claims & Abstract)	
Drawings	
Basic Filing Fee	
Search Fee	
Examination Fee	
Track I Fee	
Excess Page Fee	
Excess Claim Fee (independent & dependent claims)	
Processing Fee: $70	
Publication Fee: $0 (click the box)	
No more than four independent claims	
No more than 30 total claims	
No multiple dependent claims	
Sequence Listings (if any)	

Because simple mistakes may result in the Track I prioritized status being denied, we recommend having a check list, such as the one shown to the left, when preparing and reviewing a Track I patent application for submission to USPTO.

Petition to make special based upon applicant's age

It is fairly common for a patent application to have at least one inventor who is 65 years of age or older. Thus, a petition to make special based upon applicant's age is often a way to accelerate examination without having to pay the fee associated with Track I or adhere to the more stringent filing requirements of Track I. The only requirement for a petition to make special based upon applicant's age is: a statement by one named inventor in the application that they are 65 years of age or more; or certification by a registered attorney/agent having evidence such as a birth certificate, passport, driver's license, etc. showing one named inventor in the application who is 65 years of age, or more. Like Track I prioritized examination, it is our experience that the first Office Action is usually also issued within three months of the filing date of the application that is granted special based on applicant's age.

> **Like Track I prioritized examination, it is our experience that the first Office Action is usually also issued within three months of the filing date of the application that is granted special based on applicant's age.**

In summary, accelerated examination in the United States is a valuable tool for the patent prosecutor. Not only does it allow a patent practitioner to get patents quickly for their client, but it also provides strategic advantages for the client during prosecution. There are a number of routes to accelerated examination available in the US, and a suitable one can be found for most clients to use.

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Patenting the Metaverse

Dr. Manuel Lopez, Associate at Uhthoff, Gomez-Vega & Uhthoff, reviews the latest developments in the metaverse and what it means for the development of technology and patent protection.

Like Alice falling through a rabbit hole into a fantasy world of anthropomorphic creatures, in *Alice's Adventures in Wonderland*, many of us have dreamed more than once of parallel worlds, or universes that lie beyond the barrier of reality, just as in the stories and adventures written by Lewis Carroll. Today, the technology around us, the multimedia universe and online platforms, have made possible the development of parallel universes and distant worlds, which most of us can have in the palm of our hand whether on a mobile device, on a cell phone, or on a computer, and all this development has had an enormous impact on the way new technologies are marketed and triumph among all netizens and lovers of parallel universes.

A clear example of all this maelstrom of creations beyond reality, in which we are now witnesses, is the birth, commercialization and increasing acceptance of metaverses. These kinds of digital universes and multimedia worlds in which all of us can count on a double life,

Dr. Manuel Lopez

either through an avatar immersing ourselves in fictitious situations, or through adventures and fantasies that exist thanks to the computing power, codes and technical characteristics of online platforms and related services, are increasingly common. Although they exist in a primitive way nowadays in digital games, consoles, and video games for children and young people, they are increasingly delving into disciplines and activities of human endeavor that have to do with activities as distant and complex as face recognition, voice recognition, banking security, international trade, associated technology encryption, Non-Fungible Tokens (NFTs) exchange, as well as the digital transfer of any type of assets and services related to tangible goods and commercial possessions worldwide.

It has been possible to protect part of this technology over the last few years with the help of patents thanks to the Practice evolution of Patent Offices around the world. And, above all, thanks to the adaptation of claims that reflect the inventive and novel part of systems and computer implemented methods that understand the elements and steps of a method that, transforming matter and energy in a novel way, can offer not only a technical solution to some existing problems, but also a universe of possibilities that help to solve personal, commercial and technological issues. Issues which have never been solved before, perhaps in a real world, but which today exist and are based on fictional worlds or parallel universes, that feed on creatures, situations, and scenarios, which could only exist under the shelter and computer bubble of a metaverse.

But what is the Metaverse?

The metaverse or meta-universe (acronym for "meta-" 'beyond' and 'universe') is a concept that denotes the next generation of the internet, which describes an immersive and multisensory experience in the applied use of various devices and technological developments on the internet. The term comes from the science fiction novel *Snow Crash*, written by Neal Stephenson. The metaverse is usually composed of multiple three-dimensional virtual spaces, shared and persistent, linked to a perceived virtual universe. In a broader sense, the metaverse can refer not only to virtual worlds, but to the multidimensional experiences of using and applying the internet as a whole, especially the spectrum that combines web 2.0, augmented reality, third-dimensional technology, and virtual reality.

Metaverses are environments where humans interact socially and economically as avatars, through a software in cyberspace, which acts as a metaphor for the real world but without the physical or economic limitations imposed there.

So far, applied uses of metaverses have been identified in the field of entertainment, tele-education, tele-health and especially in the field of the digital economy, where new forms of value such as NFTs have begun to emerge.

Metaverse protection

Nowadays, many believe that the precise definition of the Metaverse is still being worked out, most experts think it will look a lot like the movie *Ready Player One*. In this particular version of the future, people escape from their lives by logging into a complex virtual reality experience where they can "live", interact with one another and participate in hyper-realistic 3D adventures.

At this point, anyone who has used an Oculus Quest or a PlayStation VR will know exactly what this is like since these two systems and many other console combos are already bringing immersive virtual reality experiences to users. Users are also getting their first tastes and great experiences of augmented reality. Today, many are using and enjoying these capabilities to understand their living space and daily activities better if they were to add new furniture, equipment, or accessories to their homes and what they could look like with a makeover with new clothing or jewelry.

Talking about accessories, people around the world are beginning to warm up to the idea of gaining their own heads-up displays courtesy of functional glassware joined to their smart mobile devices. In this particular field of technology, it is worth noting that there are more than 100,000 inventions with patent documents associated with them for each of the Metaverse areas mentioned. Between the top 10 invention owners and related patent documents we can find companies like Samsung, Sony, Microsoft, Facebook and Google among others. Japanese company Sony, the owner of the PlayStation VR, has the highest number of inventions in this emerging technology universe, followed by Microsoft, owner of the Xbox system.

For most of our readers, it is not difficult to guess that two of the largest Metaverse patent holders are also responsible for the two largest gaming platforms, PlayStation and Xbox. It is not a secret that inside the top 10, Facebook appears in the fifth position, just behind Samsung and Google overall. Nevertheless, for this technology race please also consider that competitors like Canon, IBM, and LG are also found in the top 10 companies, and please do not forget Apple and Magic Leap which are also growing. We have an interesting example of Metaverse inversion expansion with Facebook, which seems to be investing in all related technologies which is resulting in the primal creations of the Metaverse.

For example, the purchase of Oculus by Facebook occurred in 2014 and many were curious about the real impact of such transaction, with them only being involved in the video games

Résumé

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Manuel has more than 16 years of experience in intellectual property matters, including patent drafting and PPH filing, novelty and patent landscape searching, FTO & clearance searching, infringement and validity advice in the areas of Designs, Mechanical and Electrical Inventions.

He has particular expertise in Information Technology (IT), nowadays related to several industry fields, such as computer hardware, software, electronics, semiconductors, internet, telecom equipment, e-commerce, computer services, etc.

Manuel has a BSc (Physics), a MSc (Nuclear Physics) and a PhD (Electrical Engineering), from National Autonomous University of Mexico (UNAM). Before entering the patent profession, Manuel was a scientist in the field of Nuclear Physics. He is a member of the Mexican Association for Industrial Property Protection (AMPPI) and the American Intellectual Property Law Association (AIPLA).

> **"Japanese company Sony, the owner of the PlayStation VR, has the highest number of inventions in this emerging technology universe, followed by Microsoft, owner of the Xbox system."**

world. Consequently, the foundational IP from Oculus has become a launching pad for the company's dream to compete in the Metaverse. In addition, Sony and Microsoft have seen their inventive output decline for 2020 compared to their previous publications. It is important to mention that the challenge that Facebook has thrown is likely to spur them both to more significant efforts but for the time being, nevertheless, at this moment, Facebook is heading Metaverse inventions. In this patent race, we should not forget Apple and Magic Leap since they both have shown a growth in new inventions over the past five years and in 2020 nearly reached the same number of inventions as Microsoft and Sony. We have an interesting case with Apple, which has been perfecting its augmented reality capabilities, including its optimized chipsets to win an important podium in the Metaverse. Apple will probably release its headset and eyewear with build-in Metaverse functionality and own related software. Taking into account their success with consumer devices over the last 20 years, they could be a great competitor in the Metaverse commercial devices, maybe integrating compatibility features.

The Metaverse arrived from developing and enhancing many current technologies to take them to the next level, and many companies around the world are nowadays beginning to make plans for incorporating VR and AR technologies into their company workflows, systems, client services and products. As a matter of fact, Facebook has openly made the first big announcement about their Metaverse intentions and is developing a strong patent portfolio for materializing such ambitions.

Future trends

It is not a secret that the company formerly known as Facebook, now called Meta, has made a great effort for filing patents to bring true its Metaverse dreams. Meta has obtained many patents in the past few months for increasing the realism of its planned interactive virtual universe. Thanks to the new technology patented by Meta, a user's avatar will be able to pick up and put down objects, and to wear clothes that really wrinkle as it moves. Considering these kinds of patents, it is easy to deduce that the capabilities and personal features of Metaverse avatars will have endless powers, like in any videogame adventure. Meta CEO, Mark Zuckerberg, has predicted that the Metaverse will be mainstream in five to 10 years from now.

Nevertheless, many experts coincide in that the road to the Holy Grail of the Metaverse is full of challenges and unavoidable barriers. We can share some of them here, for example, uncomfortable headwear, lack of features to actually do in the virtual world, and technology that is not advancing quickly enough, however, after many companies have discovered the delights and promises of the Metaverse, the technology race could enter to a new boost-change. "This is the future I want and I'm going to push to make it happen," Mark Zuckerberg said in October at the opening of Connect 2021, a VR/AR conference.

What we know now about Metaverse patents and future trend protection in connection with patents is that they could be closely related to experiences, sensations, and virtual adventures, just like the universe of Alice in Wonderland. A taste of this virtual world and its protection through patents could occur in experiences such as throwing things at people, and this is for real since many Meta patents show that the company wants users to be able to interact with objects realistically in the metaverse, which would render in real time. At this point, Meta seems to want to make it easy for people to throw, pinch, or maybe engage with objects that exist in a metaverse scenario, a characteristic called "gesture-based casting and manipulation of virtual content."

An additional patented technology could give players the "power" to bring a real-life object into the metaverse. Let's imagine for a second, experiencing a Zoom call with your laptop while remaining in the virtual world with your colleagues.

And the list of Metaverse patents is still growing, for example, one patent is for "generating accurate and realistic clothing" that really wrinkles as your avatar moves, using patented sensors for detecting complex body movement to achieve said goal. An interesting patent is designed to create "avatar fidelity and personalization," which could be related to the avatar's capabilities in the metaverse for closely resembling their real-life counterparts. One powerful patent gives something called "spectator images." With this feature, you could invite someone to share your view of some specific scenario, like a classroom presentation, a job meeting, or a live concert, even though they aren't there in person.

And now match those virtual quirks with "pupil-steering," which would track your eye movements and will use all this information and data features for steering you around in the virtual world, and we have more surprises, "notification triggers", that is, notifications you can throw to the trash just by looking at them, and your eyes have this useful power in the metaverse. Now, and after imagining the enormous list of virtual powers you will enjoy in the Metaverse, it is not difficult to guess that all this power creation might require sharing even more personal data than you do now, and as a natural consequence, many Metaverse patents will be designed for tracking every single movement and every feature from your eyes to your complete and complex body movements and all data that Meta would then have access to, which obviously will open an interesting door to the universe of privacy data protection.

> **"Meta CEO, Mark Zuckerberg, has predicted that the Metaverse will be mainstream in five to 10 years from now."**

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Negative limitations and the written description requirement

A negative limitation refers to a claim limitation that expressly excludes a feature from the claim scope. David McCombs, Eugene Goryunov, Alan Wang, and Li Yang of Haynes & Boone examine the current state of the law on the written description requirement for negative limitations in view of the latest opinion from the U.S. Court of Appeals for the Federal Circuit in *Novartis Pharmaceuticals v. Accord Healthcare Inc.*, No. 2021-1070 (Fed. Cir. Jan. 3, 2022).

Résumés

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Negative limitations must be supported by sufficient written description

The specification of a patent must contain a sufficient written description for all claim limitations, including negative limitations.[1] The Manual of Patent Examining Procedure ("MPEP") guides that silence alone is insufficient to provide written description for negative limitations.[2] As a result, the question for practitioners is how much disclosure is sufficient.

There is no "new and heightened standard for negative claim limitations" besides what is required of other claim limitations.[3] If an exclusion of the relevant limitation is expressly disclosed, the written description requirement is likely met. Absent express exclusion, a disclosure may also meet the written description requirement if the disclosure describes "a reason to exclude the relevant limitation."[4] The reason can be any disadvantage of the relevant limitation.[5] Further, "properly described, alternative features are sufficient to satisfy the written description standard of § 112, paragraph 1 for negative claim limitations."[6] Furthermore, "a patentee can choose to claim any particular embodiments identified in the specification and exclude others, without explanation, as long as the claim does not indicate to persons of skill that it covers embodiments inconsistent with, and therefore unsupported by, the disclosure."[7]

But what happens if a disclosure is totally silent about the excluded feature? For example, how does one interpret a negative limitation that first appears during prosecution?

In its first 2022 precedential opinion, the Federal Circuit clarifies that silence in the specification about an excluded feature may still meet the written description requirement if a skilled artisan would read and understand the disclosure as describing the exclusion, albeit *implicitly*.[8]

The dispute in Novartis

The dispute in Novartis involves U.S. Patent No. 9,187,405 ("the '405 patent"). Each independent claim recites "orally administering to said subject 2-amino-2-[2-(4-octylphenyl)ethyl] propane-1,3-diol, in free form or in a pharmaceutically acceptable salt form, at a daily dosage of 0.5 mg, *absent an immediately preceding loading dose regimen*."[9]

The no-loading-dose limitation was added during prosecution of the '405 patent's parent application.[10] "A loading dose is a higher than daily dose usually given as the first dose."[11] The '405 patent does not mention any loading dose. Rather, it describes a prophetic human clinical trial ("Prophetic Trial") where patients receive the claimed compound "at a daily dosage of 0.5, 1.25 or 2.5 mg [orally]."[12] It also describes an Experimental Autoimmune Encephalomyelitis ("EAE") model that does not recite a loading dose.[13]

The district court found that the '405 patent's EAE model and Prophetic Trial indicate to a skilled artisan that the claimed invention did not include the administration of a loading dose. As a result, the no-loading-dose limitation was adequately supported by the '405 patent.[14] HEC appealed this finding, among others.

On appeal, the majority of the Federal Circuit affirmed the district court's conclusion.

Majority opinion

The majority held that a disclosure need not describe a limitation – any limitation – in *haec verba* and "may take any form, so long as a skilled artisan would read the disclosure as describing the claimed invention."[15] Silence "alone is insufficient" to support a limitation; it may, however, serve as a basis for a negative limitation.[16] Specifically, the written description for a negative limitation can be implicit in a disclosure.[17] "[I]t is how a skilled artisan reads a disclosure that matters."[18] One should consider the context, the knowledge of the skilled artisan, and common sense when assessing the written description.[19]

The majority discerned no clear error in the district court's analysis of the record evidence or conclusion of law.[20] Specifically, the record evidence included testimony of both parties' expert witnesses. HEC's own expert witness agreed that a loading dose is a higher-than-therapeutic level dose, usually given as the first dose.[21] Novartis's expert witnesses testified from the perspective of a skilled artisan that, if the Prophetic Trial included a loading dose, the '405 patent would explicitly specify as such.[22] Similarly, multiple expert witnesses testified that the '405 patent's EAE model did not include a loading dose.[23]

Thus, the majority found no clear error in the district court's conclusion that the "EAE model and the Prophetic Trial . . . both indicate to a person of ordinary skill that the claimed invention did not include the administration of a loading dose."[24]

Dissenting opinion

Chief Judge Moore dissented. She stressed that "[s]ilence is not disclosure"[25] and that a skilled artisan's knowledge cannot speak for a mute specification.[26] She would require that the '405 patent provides "some discussion of loading doses in order to show that the inventors in fact invented the treatment that is not just ambivalent to, but expressly excludes, a loading dose."[27]

Conclusion

The majority's opinion in *Novartis* seems to be consistent with the Federal Circuit's precedents, i.e., the critical test for written description requirement is how a skilled person would read the disclosure – not the exact words used. It further clarifies that a specification may - disclose an exclusion if a skilled person would expect to see the excluded feature in the disclosure if it were not excluded.

> **The distinction can be a fine line and is certainly fact dependent.**

One should not equate an implicit disclosure, such as in *Novartis*, with a disclosure that fails to teach a limitation and only renders the limitation obvious, such as in *ICU medical and Rivera*.[28] While the former meets the written description requirement, the latter does not. However, the distinction can be a fine line and is certainly fact dependent.

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1 "The specification shall contain a written description of the invention, and of the manner and process of making and using it . . ." 35 U.S.C. § 112(a).
2 "The mere absence of a positive recitation is not a basis for an exclusion." MPEP § 2173.05(i).
3 *Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1356 (Fed. Cir. 2015).
4 *Santarus, Inc. v. Par Pharmaceutical, Inc.*, 694 F.3d 1344, 1350-51 (Fed. Cir. 2012).
5 *Id.*
6 *Inphi*, 805 F.3d at 1357.
7 *Erfindergemeinschaft Uropep GBR v. Eli Lilly & Co.*, 276 F. Supp. 3d 629, 657–58 (E.D. Tex. 2017), *aff'd*, 739 F. App'x 643 (Fed. Cir. 2018).
8 *Novartis*, No. 2021-1070 (Fed. Cir. Jan. 3, 2022).
9 The '405 patent, 12:48-13:9.
10 *See* the prosecution history of US 8,741,963, Response filed Feb. 18, 2013.
11 *Novartis*, No. 2021-1070 at 3 (Fed. Cir. Jan. 3, 2022) (internal quotation marks omitted).
12 The '405 patent, 11:8-9.
13 The '405 patent, 10:32-11:2.
14 *Novartis*, No. 2021-1070 at 6-8 (Fed. Cir. Jan. 3, 2022).
15 *Id.* at 17.
16 *Id.* at 16-17.
17 *Id.* at 18 (quoting MPEP §2163 ("newly added claims or claim limitations must be supported in the specification through express, implicit, or inherent disclosure.")).
18 *Id.* at 17.
19 *Id.*
20 *Id.* at 19.
21 *Id.* at 20.
22 *Id.* at 19-20.
23 *Id.* at 20-21.
24 *Id.* at 21.
25 *Novartis*, No. 2021-1070 at 26 (Fed. Cir. Jan. 3, 2022) (Moore, C.J., dissenting).
26 *Id.* at 29 (citing *Rivera v. Int'l Trade Comm'n*, 857 F.3d 1315, 1322 (Fed. Cir. 2017)).
27 *Id.* at 29.
28 See *ICU medical, Inc. v. Alaris Medical Sys., Inc.*, 558 F.3d 1368, 1377 (Fed. Cir. 2009) (a skilled person would not understand a specification that only describes medical valves with spikes as teaching spikeless valves, even though it would have been obvious that the slits originally made by the spikes could also have been made by compression of a (disclosed) preslit seal); *see also Rivera v. Int'l Trade Comm'n*, 857 F.3d 1315, 1322 (Fed. Cir. 2017) ("The knowledge of ordinary artisans may be used to inform what is actually in the specification, but not to teach limitations that are not in the specification, even if those limitations would be rendered obvious by the disclosure.").

Results achieved in the intellectual property protection as part of an accelerated review of applications related to COVID-19 by Rospatent

Ludmila Lisovskaya, Patent and Chemical Specialist with Zuykov and partners, evaluates the development of inventions in response to the coronavirus pandemic and the resulting applications and grants for protection.

Résumé

Ludmila Lisovskaya has worked as a Patent Specialist and a Chemical Specialist with Zuykov and partners LLC since 2017. Ms. Lisovskaya specializes in Patent search on inventions in the sphere of Biotechnology, Pharmaceuticals, and Chemistry and utility models; Preparation and filing of patent applications on inventions in the sphere of Biotechnology (especially vaccines, peptide therapeutics, and cell therapies), Pharmaceuticals, and Chemistry (especially organic chemistry, including polymers and low molecular weight compounds), utility models, software and database. Her previous professional experience also includes working as a Head of Department in the preparation and implementation of new technologies, at JSC "Togliatti Institute of nitrogen industry".
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Ludmila Lisovskaya

To combat the spread of the new coronavirus infection (COVID-19), at the beginning of 2020, Rospatent introduced a mechanism for expedited review of applications for inventions and utility models on the relevant topic, according to which the average duration of the first substantive examination action is 27 days. The average application review duration as a whole takes about 3.8 months.

As a result of this mechanism, about 1000 applications have been submitted for technical solutions (vaccines, pharmaceuticals, methods of treating and preventing both the disease itself and its consequences, testing methods, test systems, protective equipment, and medical equipment) related to coronavirus. Since the pandemic's beginning, more than 400 patents have already been issued in the Russian Federation.

In addition, the world's first patent for a vaccine against COVID-19 was issued in the Russian Federation.

The Federal State Budgetary Institution **"National Research Center of Epidemiology and Microbiology**

named after Honorary Academician N. F. Gamaleya" of the Ministry of Health of the Russian Federation used a comprehensive approach to patenting and protected variants of immuno-biological agents with many related patents:

- RU 2723008 "Method for obtaining a strain of Chinese hamster ovary cells, producer of recombinant protein RBD of SARS-CoV-2 virus, a strain of Chinese hamster ovary cells, producer of recombinant protein RBD of SARS-CoV-2 virus. CoV-2, a method for obtaining recombinant protein RBD of the SARS-CoV-2 virus, a test system for enzyme-linked immunosorbent assay of human serum or plasma and its application",
- RU 2720614 "Immunobiological agent and method for its use for induction of specific immunity against the SARS-CoV-2 severe acute respiratory syndrome virus (variants)", an updated description of which was published on 09.02.2021.

In addition, further inventions were developed, more patents were obtained:

- RU 2743962 "Means for induction of specific immunity against the severe acute respiratory syndrome virus acute respiratory syndrome SARS-CoV-2 in a freeze-dried laboratory", RU 2743963" Means for inducing specific immunity against the SARS-CoV-2 severe acute respiratory syndrome virus in liquid form (variants)", published on 01.03.2021
- RU 2744442" application of a means for inducing specific immunity against the SARS-CoV-2 severe acute respiratory syndrome virus in persons over 60 years of age and/or with chronic diseases (variants)", RU 2744444" application of a means for inducing specific immunity against the SARS-CoV-2 severe acute respiratory syndrome virus acute respiratory syndrome SARS-CoV-2 for revaccination of the population (options), published on 09.03.2021.
- And most recently, on 05.10.2021, patent RU 2731356 was obtained for an expression vector for creating an immunobiological agent for inducing specific immunity against the SARS-CoV-2 severe acute respiratory syndrome virus (variants).

The research center comprehensively patented and registered the vaccine for the coronavirus infection prevention "Sputnik V "and the one-component vaccine" Sputnik Light." It started

> **A vaccine was developed to prevent coronavirus infection using codon-optimized nucleic acid.**

with the isolated strain of Chinese hamster ovary cells, ending with the current immuno-biological means of diagnosis, prevention, and treatment of this disease and methods of their application.

The **Russian biotech company BIOCAD**, which received the patent RU 2760301 for a vaccine against coronavirus in November 2021, is also keeping up with the Gamaleya Research Center. A vaccine was developed to prevent coronavirus infection using codon-optimized nucleic acid. It is also vector-based and is based on the AAV5 adenovirus to induce specific immunity.

The **State Scientific Center of Virology and Biotechnology "Vector"** of the Federal Service for Supervision of Consumer Rights Protection and Human Welfare has developed vaccines containing artificially synthesized fragments of viral proteins. Specialists can get acquainted with the details, for example, from the description of one of the four received patents RU 2743595 "Vaccine composition against coronavirus infection COVID-19", which was published on 20.02.2021, and discloses the preparation of a vaccine composition, known to us as "EpiVacCorona," using peptide immunogens and a carrier protein that carry the minimum necessary antigenic determinants for the formation of a specific immune response and induce protective immunity.

Patent RU 2747762 "Vaccine for the prevention or treatment of coronavirus infection based on a genetic construct", published on 13.05.2021, the patent holder of which is the ATG Service Gen founder Ilya Dukhovlinov protects another vector vaccine, which is a polynucleotide for expression in cells of the target organism that encodes a hybrid protein that includes fragments of coronavirus M, S, N, and E proteins connected by flexible bridges.

In addition to vector and peptide vaccines **"FSBSI IEM"** under the leadership of Alexander Suvorov developed a live vaccine protected by patent RU 2745626 "Method for creating a live vaccine against coronavirus infection COVID-19 based on the probiotic strain Enterococcus faecium L3 and live vaccine Enterococcus faecium L3-pentF-covid-19", published on 29.03.2021. The patent presents a live vaccine Enterococcus faecium L3-pentF-covid-19 containing a clone of enterococci COVID 19+ with a DNA region inserted into its genome. Oral administration of the Enterococcus faecium pentF-covid-19 vaccine stimulates the development of a specific systemic and local immune response, which is manifested by the production of specific immunoglobulins of classes G and A, as well as increased production of interferon gamma in vaccinated patients.

Another vaccine patent is patent RU 2759227,

published on 11.11.2021, as its patent holders are residents of the UK – the company **"Geneticist Diagnostics and Therapy 21 Ltd."** and Russia-LLC **"RECOMBITECH"**, who jointly developed a DNA vaccine against the virus SARS-CoV-2 based on the gene therapy DNA vector GDTT1. 8NAS12, consisting of a composition of the gene therapy DNA vectors GDTT1. 8NAS12-S, GDTT1. 8NAS12-M and GDTT1. 8NAS12-N encoding immunogenic epitopes of the S, M, N proteins of the virus SARS-CoV-2.

In addition, special attention should be paid in the shortest possible time to patented inventions related to pharmaceutical drugs that are currently actively used in methods of treatment for COVID-19 approved by the Ministry of Health.

An antiviral agent containing favipiravir, made in the form of film-coated tablets, is protected by **Kromis LLC** with patent RU 2731932 "Anti-COVID-19 (SARS-CoV-2) viral pharmaceutical composition", patent published on 09.09.2020. The proposed composition includes: 43-44% micronized favipiravir with a particle size of 40-50 microns, 5.5-6.0% croscarmellose sodium, 4.8-5.0% povidone, 0.6-0.8% magnesium stearate, 0.5-0.7% colloidal silicon dioxide, 2.5-2.7% film shell and the rest-microcrystalline cellulose. The above formulation provides rapid release of favipiravir from tablets.

By the patent holder of the patent RU 2746362, published on 12.04.2021, State Scientific Center **"SSC Institute of Immunology"** of the FMBA of Russia, presented a combined drug that has an antiviral effect against coronavirus has been presented SARS-CoV-2 and related viruses, provided that the genetic target against which the specific component of this drug is directed is identical, containing: the effective number of siRNA molecules produced against the virus

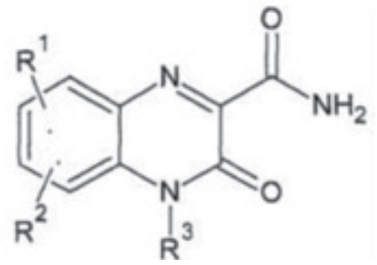
> **The invention provides effective treatment of COVID-19 infection in patients of different age groups with minimal side effects.**

genome SARS-CoV-2 two complementary chains, where the modified nucleotides in the sense and antisense chains are represented by a modification of LNA, a dendrimeric cationic peptide with transfection activity, and a pharmaceutically acceptable auxiliary solvent.

Representatives of a Russian company LLC **"Aviron"** and the American company **"ASAVI LLS"** with Alexander Ivashchenko, Andrey Ivashchenko, Nikolay Savchuk, Alena Ivashchenko, Vladimir Loginov, and Mikhail Topr received several patents of the Russian Federation at once:

- RU 2738885 "Anti-SARS-CoV-2 viral agent Antiprovir", published on 18.12.2020, from which a pharmaceutical composition is known for the treatment and prevention of COVID-19, providing high antiviral activity, which is a pharmaceutical composition containing aprotinin as an active component and excipients, as an antiviral agent;
- RU 2745986 "Anti-coronavirus agent for combination therapy of COVID - 19 (SARS - CoV-2) and method of treatment", published on 05.04.2021, which discloses a combined method of treatment of COVID - 19, including sequential or simultaneous administration to a patient in therapeutically effective amounts and ratios of two drugs, one of which includes aprotinin, and the other-the SARS-CoV-2 replication inhibitor favipiravir;
- RU 2744429 "Anti - RNA viral, including anti-coronavirus agent-substituted quinoxalin, pharmaceutical composition and applications", published on

09.03.2021, from which a pharmaceutical composition is known that has the property of an inhibitor of RNA-dependent RNA polymerase (RdRp) Viral RNA, based on the specified compound formula:



where R1 and R2 are not necessarily identical hydrogen or halogen atoms, R3 is a hydrogen atom, provided that R1, R2, and R3 do not simultaneously mean hydrogen, or both R1 and R2 do not mean 6,7-dichloro, or if R1 means hydrogen, then R2 does not mean 7-chlorine.

Patents RU 2740657 and RU 2740660 "Antiviral composition", published on 19.01.2021, the patent holder of **PROMOMED RUS LLC** protected a pharmaceutical composition and a method for treating a disease caused by exposure to a virus whose genome is encoded by a single-stranded RNA strand and which uses viral RNA-dependent RNA polymerase for its replication. The proposed composition according to patent RU 2740657 contains favipiravir and darunavir at a mass ratio of favipiravir: darunavir, a component of 1:1. The combined use of darunavir and favipiravir in the indicated ratio leads to a significant increase in the mutual effect against viruses in the absence of additional side effects. The pharmaceutical composition, according to patent RU 2740660, is designed to alleviate the clinical symptoms, course, and/or cure of a disease caused by exposure to a virus whose genome is encoded by a single-stranded RNA strand and which uses viral RNA-dependent RNA polymerase for its replication contains an effective amount of favipiravir and an effective amount of a zinc compound selected from zinc sulfate, zinc acetate, zinc lactate, zinc-diethyl-bis (N-4-methylthiosemicarbazone), zinc dithiocarbamate, in the mass ratio of favipiravir to zinc salt 1: 1-10:1, where the effective amount of favipiravir is 50-800 mg, the effective amount of zinc salt is 15-250 mg.

A group of authors from the **Republic of Belarus**, who are also the patent holders of patent RU 2745774 "Method for treating patients with a new coronavirus infection (COVID-19)", published on 31.03.2021, Alexey Marochkov, Artur Lipnitsky, Dmitry Tsopov, Olga Dozortseva proposed a method that includes the diagnosis of infection by obtaining a positive test for the presence of RNA or IgM to SARS-CoV-2 or a typical x-ray picture on computed tomography of the chest organs. The patient is additionally assigned acetylsalicylic acid 300 mg on the first day and 150 mg on days 2-21 of the disease, clopidogrel 300 mg on the first day and 75 mg on days 2-21, and rivaroxaban 20 mg on days 1-21. The invention provides effective treatment of COVID-19 infection in patients of different age groups with minimal side effects.

The author and patent holder of patent RU 2751488 "Method for the treatment of coronavirus infection", published on 14.07.2021, Vsevolod Kiselev, presents a method for the treatment of mild and moderate coronavirus infection using a drug containing 3,3' - diindolylmethane, fish oil type A and polysorbate 80 at a mass ratio of 15:2:58 components. The drug is administered in doses of 3,3' - diindolylmethane from 1200 to 2400 mg/day. In the first two-three days, then 600-900 mg/day for four-ten days. The drug is administered as monotherapy or in combination with an antiviral drug based on favipirovir. The use of the invention makes it possible to achieve faster positive dynamics in the clinical picture and laboratory parameters, to prevent the development of acute respiratory distress syndrome by stabilizing the concentration of interleukin-6 with the introduction of 3,3' - diindolylmethane.

Summing up the review of patent documents presented above, we would like to hope that the developed vaccines and pharmaceuticals patented in a short time in the Russian Federation, thanks to the accelerated review mechanism, will prevent the further spread of COVID-19 not only in the Russian Federation, but also in many other countries of the world.

> **Rospatent introduced a mechanism for expedited review of applications for inventions and utility models on the relevant topic.**

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Issues in Hungarian regulation on public health compulsory licences

Dr. Ádám György, Partner and Attorney-at-Law at SBGK Attorneys at Law and Patent Attorneys, evaluates the state of compulsory licensing in Hungary, revolutionized due to pressure from the pandemic.

The public health compulsory licence is a legislative curiosity in Hungarian current legislation, which was specifically designed to address the difficulties posed by the COVID-19 pandemic. The purpose of this special type of compulsory patent licence was to ensure that products based on patented or SPC (Supplementary protection certificate) protected medical inventions are available in sufficient quantities in Hungary, especially in view of the health crisis.

Hungarian regulation of the compulsory public health licence

In Hungary, the regulation of the compulsory public health licence for *satisfying the needs arising in Hungary* in connection with the health crisis was first introduced by a Government Decree in May 2020. It is noteworthy that the Hungarian legislator reacted to the health crisis with outstanding speed in this respect, as it adopted a regulation on the issue in the spring of 2020, after the first wave had already broken out.

On 18 July 2020 an amendment to the Hungarian Patent Act entered in to force, which provides the possibility to apply for a compulsory licence for the use of health products (e.g. vaccines), diagnostic tools (e.g. Covid tests) and medical devices (e.g. ventilators), as well as protected processes for the manufacture of health products. This specific type of compulsory licence is the so-called 'public health compulsory licence', the explicit aim of which is to facilitate the management of a health crisis by temporarily suspending the enforcement of intellectual property rights at the legislative level under strict conditions. The licence can be applied for specifically to address the current health crisis by meeting domestic needs and, in a limited number of cases for export, to assist countries with no manufacturing capacity for the treatment of a public health problem arising.

> **The licence can be applied for specifically to address the current health crisis by meeting domestic needs and, in a limited number of cases for export.**

The Hungarian Intellectual Property Office (HIPO) shall decide on the granting of a public health compulsory licence upon request, at the same time determining adequate remuneration payable to the patent holder and the duration of the licence, which shall be for a minimum period of six months. The remuneration shall reflect the economic value of the public health compulsory licence and, in particular, it shall be commensurate with the royalty that the public health compulsory licence holder would have to pay under a licensing contract concluded with the patent holder, having regard to the licensing conditions that are common in the technological field of the subject matter of the invention. Healthcare products produced under a public health compulsory licence shall be distinguished by unique marking from the products produced by the patent holder.

A licence granted in this way covers all ways of exploiting the patent domestically, e.g. manufacturing, offer for sale, sale of products. The licence does not grant an exclusive right of exploitation, its scope and duration should be limited to the extent necessary, and the HIPO should take these aspects into account when determining the duration of the licence. The holder of a compulsory licence may not grant a further licence on the basis of the compulsory licence.

Public health compulsory licensing in practice

In practice, temporary authorization for the use of patents for these specific purposes has only been used in a few cases so far. According to report, only three applications for compulsory public health licences had been received by 31 December 2020. The question of the extent to which the introduction of compulsory public health licensing being a necessary step in the fight against the coronavirus is still debated, given that, in

practice, the lack of medical products for epidemic management is less due to difficulties in obtaining authorisation and more to the low production capacity of pharmaceutical companies. In the many professional debates that have erupted since the entry into force of the legislation, it has been argued that the validity of the new type of compulsory licence is called into question by the fact that there has been no mass application for the licence.

The first dispute arising from one of the public health licensing procedures to be settled in court raised interesting substantive and procedural issues. In November 2020, the HIPO granted a compulsory public health licence to Richter Gedeon Plc. For the use of the active substance remdesivir (and the medicine containing it, Veklury). Veklury, containing the active ingredient remdesivir, is the first product to be approved by the European Medicines Agency for the treatment of adults and adolescents with coronavirus disease requiring supplemental oxygen therapy. The product is protected by a European patent and falls within the scope of two other patents to which Richter has also extended its application for a compulsory licence. The patentee, Gilead Sciences, has challenged the Office's decision to grant a compulsory public health licence by filing a request for a variation. The Court of Appeal ruled on the procedural and substantive issues of compulsory public health licensing in a legal dispute, which can be considered a legal historical curiosity, just half a year ago, in the autumn of 2021.

Dr. Ádám György

Résumé

Dr. Ádám György LL.M. Partner, Attorney-at-Law

Ádám György is a partner and attorney at law at SBGK who has been involved in numerous complex IP cases and represented clients before the Court of Justice of the European Union. As a result, Dr György has acquired unique expertise in designs and trademarks.

Dr György holds a law degree from Eötvös Loránd University and an LLM in IP and competition law from the Munich Intellectual Property Law Centre. After gaining professional experience at several foreign law firms, he returned to Budapest and started his Hungarian legal career as an attorney. He is currently a PhD candidate at ELTE University.

The *Legal 500, WTR 1000* and *IAM Patent 1000* have each recognized his legal talents, and *IFLR* named him as a Rising Star Europe in 2020 in the trademark category. Dr György publishes extensively and he is a regular speaker at national and international conferences from Munich through Alicante to Lima. He is also an active member of the legal profession and, as a mentor, he helps young designers and start-ups.

In 2018 he was elected to the New Membership Committee of the Budapest Bar Association. He is also a mentor of the Hungarian Fashion and Design Agency and the leader of the Legal Committee of Young Entrepreneurs Association Hungary.

In addition, Dr. György is a member of the Council of Experts on Industrial Property and the Council of Copyright Experts in Hungary and plays an active role in several prominent international IP organizations, including INTA, the ECTA Organising Committee, the Union Design Committee, and the Design Committee of the International Association for the Protection of Intellectual Property.

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A dispute concerning the decision of HIPO to grant a compulsory public health licence

The court's assessment of the case highlighted the specific features of the new legislation that distinguish it from the previous compulsory patent licensing. Gilead Sc., as the proprietor of the patents, challenged the Office's decision to grant a compulsory licence both on procedural grounds and on the merits of the decision. Relying on the procedural principles of the Administrative Procedure Code applicable as the procedural law underlying the Patent Act and its procedural rules, he complained that the Office had conducted the proceedings *de facto ex parte*, i.e., without hearing the applicant. Gilead Sc. considered it an unlawful procedural solution that it, as the patent holder, was not allowed to participate as a party in the procedure for granting the compulsory licence, and had no opportunity to comment or make a statement on the granting of the compulsory licence for its own patent. On this issue, both the court of first instance and the court of appeal held that the rules of the compulsory public health licence are to be interpreted as an explicit derogation from the general compulsory licensing procedure, i.e., unlike the basic procedure, in the special procedure the Office only notifies the patent proprietor of the receipt of the application and informs him of the decision, but the procedure is not adversarial, the Office decides to grant the licence without holding a hearing and the patent proprietor has neither the status of a party nor the rights deriving from it. In the context of compulsory public health licensing, only the applicant for a compulsory licence is considered a party. In the court's view, the right to appeal is also guaranteed by the fact that the patent proprietor can file an independent petition for alteration in his own right.

Gilead Sc. also challenged the decision of the Office from a substantive point of view, finding it unlawful on the merits, as in its view the Office had failed to clarify the circumstances of the needs in Hungary. The company complained that the Office had not carried out an analysis as to whether the resources of the patent holder alone would be sufficient to meet the domestic needs during the pandemic. The dispute thus went all the way back to the assessment of the legislative intent, as it raised the question of

whether the existence of an unmet need is in fact a legal condition for the granting of a compulsory public health licence, or whether the existence of a crisis situation and the fact that the patent holder has not yet satisfied the entire domestic need are sufficient to grant the license. In this context, the legislation expects the applicant to submit a certificate from the State Agency for Pharmaceuticals (OGYÉI) certifying that the applicant is applying for a licence for a product suitable and necessary to meet domestic needs related to a health crisis. The court held that it is not required, as a condition for granting a licence, an examination of whether the patentee has sufficient capacity to satisfy domestic demand on its own. Only the assessment of the domestic need that has arisen and the quantity of health products required to satisfy that need is mandatory. If the applicant has sufficient capacity for this quantity, the fact that the original patentee also has the necessary capacity does not affect the granting of the licence.

Evaluation and summary of the relevant procedural and substantive issues

Through these points examined, the court also provides a comprehensive interpretation of the new regulation of the licence under examination in this article. Many of the principles and practices that would otherwise apply to compulsory licensing are not applied in the context of compulsory public health licensing, and the reason for this lies in the specific purpose of this new type of compulsory licensing. The granting of a compulsory patent licence, which was also previously present in Hungarian law, is decided by the court as a result of an adversarial procedure, where the patent holder participates as a party in the proceedings. In this case, a compulsory patent licence resolves a conflict of private interests, whereas the fundamental difference with a compulsory public health licence is that its grant is in the public interest. Because of its specific purpose of protecting the public interest, namely to avert a health crisis, the granting of a compulsory public health licence is subject to an administrative procedure, decided by the Office, with no hearing, no adverse parties and the aim of ensuring that the grant of a compulsory licence in the public interest is rapid and effective. The same purpose is served by further detailed rules, such as the fact that the Office does not gather evidences, has no discretion beyond the determination of license fee and is obliged to decide on such cases in expedited manner. As the court stated, the compelling reason in the public interest for the introduction of a compulsory public health licence is the health crisis itself. The Office is therefore not in a position to review the content of the Pharmaceutical Institute's certificate on the merits, nor can it consider whether the patent holder would otherwise be able and willing to meet the needs of the market on the basis of the patent.

> **"As the court stated, the compelling reason in the public interest for the introduction of a compulsory public health licence is the health crisis itself."**

According to the reasoning of the decision of the Court of Appeal, "in a situation where the public interest is threatened, it is justified to conduct the proceedings *ex parte* in a way that ensures the fastest possible procedure, even at the cost of the private interests of the patentee." In the court's view, this is in line with the internationally agreed objective of temporarily suspending, where appropriate and necessary, the enforcement of relevant intellectual property rights in the fight against coronavirus.

Moreover, given that in the case at hand, the time limit of the public health compulsory licence has recently expired, it may raise further questions in the context of the assessment of the legislation the possible analysis of the extent to which the manufacturing activities of the holder of the compulsory licence actually contributed to the rapid resolution of the crisis situation in question.

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Indian government initiatives to encourage women to participate in innovation and entrepreneurship

Dr. Joshita Davar Khemani, Managing Partner & Principal Attorney at Law at L.S. Davar & Co., evaluates the current situation for women in STEM and addresses what needs to change.

It is encouraging to note that about 43% of science, technology engineering, and mathematics graduates (STEM) in India could be women which is the highest in the world, however, women's share in such jobs in India is meager at 14%. The poor conversion rate is attributed to the reason that most of the STM graduates pursue another career or don't work at all. This indeed is a waste of talent. It is imperative that this ratio is bettered since women hold the key to the door to progress. For instance, in Sweden, women's share in STEM degrees and jobs are 34-35% respectively suggesting India needs to employ all the STEM graduates they generate every year to rise up the innovation index.

Dr. Joshita Davar Khemani

Indian Prime Minister Narendra Modi, since assuming office, has shown his commitment towards supporting the greater participation of women scientists. He has been working on a vision "Science for masses" where women scientists have a greater role. The department of science and technology (DST) has come with various programs such as Vigyan Jyoti, KIRAN, CURIE, and SERB aimed at increasing female presence in science, technology, and innovation while taking care of disruption of the career of women scientists due to situational changes. SERB, for instance, intends to introduce more women scientists in the R&D ecosystem. The fellowship and grants under the scheme intend to cultivate a woman-friendly culture in the academic and research institutes and ensure more women in leadership positions in the decision-making process.

In a first, the Atal ranking of institutions on innovation achievement (ARIIA) 2020 ranked women institutes separately under a special category. Although there was not much participation in its first year of launch, seeing some institutes featuring at the top of the ranking will certainly motivate others to participate and will provide much-needed encouragement to women in the field of innovation. The introduction of this special category may improve the ecosystem and young girls will have more role models. This is important since women prefer STEM less due to a lack of role models.

Looking at the gender gap in intellectual property, preliminary WIPO statistics reveal that in 2019 less than one-fifth of inventors named in international patent applications were women. It has taken 25 years for this share to almost double from 9.5% in 1995 to 18.7% in 2019. While numbers are going in the right direction, at the current pace parity among PCT-listed inventors will only be reached in 2044. It is also interesting to see that countries such as Togo, Uganda and Latvia are some of the countries with the most female inventors who comfortably top the most innovative countries such as the USA in this department. The Department for Promotion of Industry and Internal Trade (DPIIT), the parent organization of the Indian patent office, also took an initiative in this direction to close the gender gap in intellectual property and particularly patents. Now, a patent application filed by a female innovator can be examined expeditiously with a view to promoting women entrepreneurship in the country. As per the revised rules, if the applicant or at least one of the applicants in a group seeking a patent is a female, that application would get an expedited examination by the Indian Patent Office.

While, as a global IP community, we are in the early stages of addressing the IP gender gap, the challenges are generally known, if not as well understood as they should be owing to a lack of data. Based on what has been tried so far, policymakers can consider enacting their own versions of others' programs and policies.

The poor participation of women in entrepreneurship and innovation is not only about gender inequality. It also affects families, communities, and societies at large. It also impacts job creation. The Indian government is working on multiple fronts to provide women innovators, access to capital, resources, market knowledge, support networks, mentorship, jobs, commercialization support, and other incentives. These initiatives among others help women innovators build professional industry contacts increasing their ability to participate in innovation. Also, support to commercialize the patents will give the women innovators a strong reason to participate in innovation and entrepreneurship.

> **"These initiatives among others help women innovators build professional industry contacts increasing their ability to participate in innovation."**

If women are left out of these 21st-century revolutions, we will not achieve sustainable innovation for a prosperous future. On the policy front, we need to work harder to close the entrenched gender gap in innovation, entrepreneurship, and IP. With the initiatives taken by the Indian government, we are hopeful that we will not only close the IP and innovation gender gap but successfully better the ratio of participation of women in STEM degrees and jobs in the next few decades if not more.

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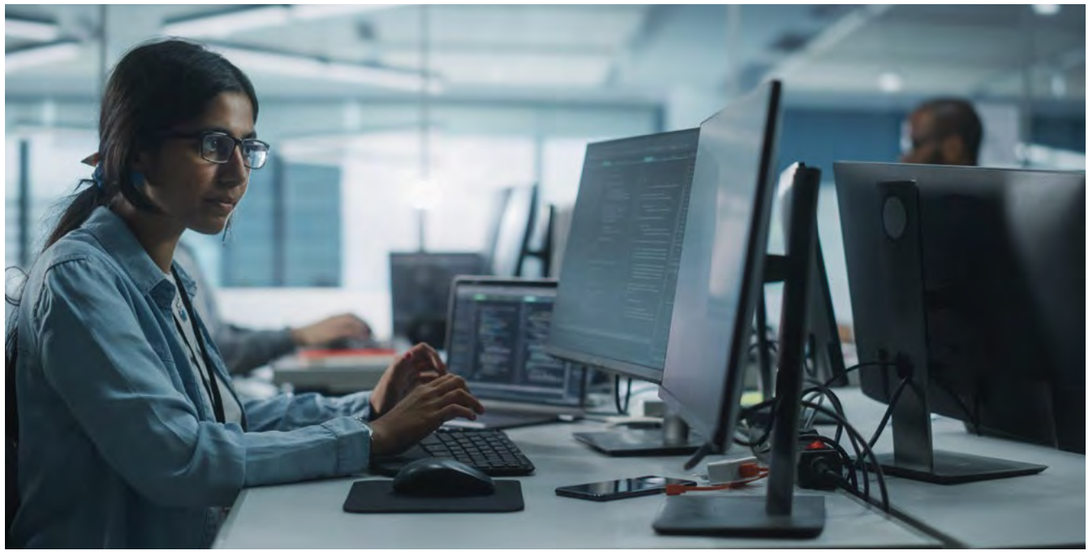

Résumé

Dr. Joshita Davar Khemani, Managing Partner and Principal Attorney at Law at L.S. DAVAR & CO.

Skilled in Client relationships, Litigation, Management, Intellectual Property, and Trademarks, Dr. Joshita Davar Khemani has dominated the Indian legal space for more than 34 years. With zonal offices in Delhi and Bengaluru and associates in over 145 countries, Dr. Joshita Davar Khemani significantly increased its legal services wings.

Under her leadership, the firm has received several accolades, awards, and has been recognition by prestigious and globally recognized organizations at various international platforms.

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Women in IP Leadership

Celebrating achievements and continuing the empowerment of women

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We give special thanks to Fenix Legal KB for their dedication and support in continuing the empowerment of women in IP by facilitating this opportunity.

This segment is dedicated to women working in the IP industry, providing a platform to share real accounts from rising women around the globe. In these interviews we will be discussing experiences, celebrating milestones and achievements, and putting forward ideas for advancing equality and diversity.

By providing a platform to share personal experiences we aim to continue the empowerment of women in the world of IP.

This segment is sponsored by Fenix Legal KB, who, like *The Patent Lawyer*, are passionate to continue the empowerment of women. Fenix Legal KB sponsorship enables us to remove the boundaries and offer this opportunity to all women in the sector. We give special thanks to Fenix Legal KB for supporting this project and creating the opportunity for women to share their experiences, allowing us to learn from each other, to take inspiration, and for continuing the liberation of women in IP.

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IP for IP = Intellectual property for an international planet.

Intellectual property development and protection is the necessary base for creating innovative solutions in our daily life. It is well-known during the history that innovative minds are equally presented independent of gender, nationality or age. As WIPO phrase it: "Human innovation and creativity are the engines of progress". In this respect, we all need to educate politicians and legislators of the importance of a gender-equal working environment and legislation that gives all talents the equal possibilities to use their creative minds to solve problems and create new opportunities for today and for the next generation.

Maria Zamkova, CEO of Fenix Legal KB

If you would like the opportunity to share your experiences with *Women in IP Leadership*, would like to nominate an individual to be involved, or would like to learn more about sponsorship, please contact our Editor.

CTC Legal Media

Tima Hachem: Senior Manager, Alyafi IP

An interview: inspirations, experiences, and ideas for equality.

Tima is currently Deputy GM at Alyafi IP group, with over 17 years of experience in IP management, experienced in a wide range of intellectual property-related work, with a particular focus on trademarks and patents in the MENA region and GCC.

Tima assists clients in all aspects of local and International Trademark protection, non-contentious IP matters; Legal opinions; legal contracts and agreement; Trademark opposition and cancellation proceedings; and Anti-counterfeiting cases.

> **"I saw an opportunity, a future, and an avenue to make a difference..."**

Tima helps inventors, companies, and universities to navigate the path of obtaining a patent, and advises clients on Patent infringement, commercialization assessment and process, and other areas surrounding intellectual property rights.

Acquired experience in business planning and technology-driven start-up management, technology transfer while working as IP advisor and trainer for incubators and universities in the MENA region and GCC.

CTC Legal Media

What inspired your career?

There are so many factors that have influenced my career trajectory and have shaped the way I am today but it all started from my love of community work and our family values of being pro-active. I was brought up in a family that values social work and community building. So ever since I was a child I was exposed to all the social challenges going on around me.

So, when tasked with choosing what to major in at university it was a no brainer for me to choose Law and specifically concentrate on how the law can be used to assist and alleviate social causes.

During my second year at university, I took up a part-time job at an NGO which teaches children who dropped out of school between the ages of nine to 12, and this experience was so transformative and impactful that it changed my perspective of the world and my take on life.

When growing up I was exposed to challenges, but nothing was as detrimental as what I saw during this part-time job. This experience while very tough, further exposed me to the injustice of the world where children would come from 10-person families that have less than one dollar to spend on daily essentials.

I found that year to be brutal, it tried my faith, strength and confidence in the justice system, as everything I saw was unjust and since then I took a vow to always work hard to update the law and ensure it is effectively enforced and protects all people not just one class of people.

So, while this year was tough, corporate law was out for me, criminal law was also out as it

There was a tremendous lack of knowledge, regulations, and law related to IP in the MENA region and GCC which was one of the biggest challenges we faced during our journey.

entails back room dealing in a country with a lot of corruption which is contrary to the straight-shooting personality I have! A year into teaching, a friend of mine approached me with an opportunity to work as an intern for the founder of Alyafi IP Group. I knew nothing about IP and I was looking for more administrative jobs that would allow me to pay my tuition.

That is where my journey in intellectual property started, alongside an extraordinary woman who was the founder of Alyafi IP Group, Mrs. Mayssam Sijaan. I was mesmerized by her personality, her courageousness and her love of community. She was a wife, a working mom of three kids and at the age of 50, she decided to get a new BA in Law. Working alongside her was as though I was attending afternoon classes. She taught me everything relating to IP and her love for it transferred to me and I saw an opportunity, a future, and an avenue to make a difference in the world through this field.

In addition to my Law background, I am obsessed with technology, just like my husband and probably because of him, so this drew me further into the crossover between technology, law, innovation, and IP.

Last but not least, my father is my inspiration and compass, he is a very hard-working man but always had time for his family, so he is who I look up to to make sure all the important and valuable aspects of my life are well balanced.

How have you found the pathway to your current position? And can you offer advice from your experience?

I have been working with the firm for more than 17 years, I am a mother to a lovely five-year-old boy, and I am on route to leading the firm as a General Manager. All of these are achievements I am very proud of, but I cannot say they were easy and could not have been accomplished without an enabling community and support system. The firm environment, my family, friends, and colleagues supported me in these achievements. The support for working moms helped me grow and be who I am now.

Looking back at all of the work I did, I cannot say my path was easy or straightforward. On top of the usual career bumps people go through I was working in an entrepreneurial venture with all of its fluctuations, and in a region where intellectual property was only superficially understood. There was a tremendous lack of knowledge, regulations, and law related to IP in the MENA region and GCC which was one of the biggest challenges we faced during our journey.

We wanted to provide our clients with high standard service, accurate responses, and guidance, however the lack of structure, law, and understanding put us in a very awkward and unusual situation. Therefore, we took it on ourselves to create structure when there was none, and to help governments and agencies create the structure and build up their capacity in it.

The persistence, the continuous learning, and support I had from the firm was the biggest motivation I got, have, and will pass on. The firm was never hesitant to invest in our learning through conferences, educational events, or professional events that will grow us professionally and allow us to be pioneers in this filed in the MENA and GCC countries.

I think the best advice I can give is to be adaptable to all changes. The firm passed through different phases and challenges and the region we service is quite risky, challenging, and booming at the same time. I can say that my character is very adaptable and I always look to the future and the outcome from the change and like to have new challenges in life.

People tend to resist changes, but for me, I like changes and challenges and this helped me in my career growth and development.

Adaptability and resilience are the key...

What challenges have you faced? And how have you overcome them?

I can say working in the Middle East with all that's happening around us is a challenge by itself.

In addition to the above, and as previously mentioned, there is a big lack of awareness in terms of IP rights (especially Patents and other rights) in the MENA region and GCC countries.

So even IP owners 10 or 15 years ago did not know what their rights were, and how to protect them, and this was making our mission to promote the service very hard - even impossible.

Therefore, I lead an initive at the firm to raise awareness about IP rights in all the Middle East and GCC countries and we start giving training, and building capacity sessions for free in the Syndicates, Research centers, Universities, and Incubation centers. We delivered training about all IP rights and more specifically about Patents.

I have also led the initiative of capacity building events for government authorities around the region, training judges, customs agents and linking and introducing them to the international community in order to uplift their know how and transform our regional IP eco-system. While not there yet, the changes that are happening in the GCC, Jordan, Egypt and Iraq are worth every second we spent on these initiatives and capacity building events.

What would you consider to be your greatest achievement in your career so far?

This year I am currently working as acting General Manager for Alyafi IP Group, an Innovation Boutique operating in the MENA Middle East and North Africa including the GCC region. The firm will focus on providing well rounded Innovation services, and tackling IP from a legal, commercial, and technological aspect. For the firm to trust in my capability is a great honor by itself.

Leading during the time of COVID was not challenge free; while remote working is second nature to us due to the different offices we work with, managing, motivating and providing support to your teams during times of extreme uncertainty especially during the early phases of COVID was not easy. A lot of our team members and I are working moms, and I can assure you this was one of the toughest, trying experiences we have had so far, and being able to get through it with growth, and an extremely motivated team, while taking care of my family is an achievement that I do not take lightly.

What are your future career aspirations? And how will you work to achieve them?

I love this question, and will try to answer it with a few words, but with my big aspirations I am not sure how to limit the wording! As background information, historically, the Intellectual Property Legal systems in the Arab countries was semi working. There were laws, judgments, but to say that it was a reliable jurisdiction to go to court and ensure that your rights are protected would be misleading. However, we have recently seen so many changes in laws, processes, appointments and leaderships in some of the biggest markets regionally, from Saudi Arabia, Egypt, UAE and Iraq. While understanding the change and coping with it is challenging, it is also an opportunity I, personally, and the firm would like to seize, by elevating the level of the judicial system and ensuring IP rights and legal decisions are reflective of a transparent equitable system. Where I fit in that is I would like to be recognized as one of the regions leading lawyers in shaping the IP legal system, assisting clients with enforcing, protecting, and commercializing their brands regionally.

Previously we were hesitant to advise our clients to go to court because of the lack of knowledge at the courts and lack of regulations. However, with all the changes going on, our understanding of the legal and cultural landscape and deep understanding of Intellectual property laws, I am confident that I, along with the firm, will be responsible for a couple of key judicial decisions that will change the entire IP landscape, they will be referring to them as landmark decisions and success stories in several Arab countries mainly Saudi Arabia, United Arab Emirates, Bahrain...

In parallel to the strong legal system that protects IP rights, I would also like to work with Universities, Research and Development (R&D), students and incubators to create an optimal ecosystem that encourages innovation and development.

I have many more aspirations, but another one I would like to mention is how we are aspiring to build a network of strong hard working, innovative, and motivated females. One of my goals and career aspirations is to create a formal professional network of women innovators, executives, researchers and technologists to create and invest in more technologies made for and by women. I would like this network or organization to inspire all females in our region to get into STEM fields, work on their career and never give up on their professional dreams and ambitions.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years?

Alyafi IP group is the only Majority Women-Owned and Operated IP Boutique in the Middle East, the mentality is part of our growth strategy and we are focusing on giving women equal opportunities and chances in the world of IP.

I think all IP firms need to ensure gender equality and provide equal access to the same opportunity in terms of career growth, salaries, gender, color, religion and beliefs should never be a barrier to growth for anyone.

Giving equal opportunity should not stay a slogan, companies should implement regulations and policies that take into consideration women's lives, such as working from home, flexible working hours for mothers, less working hours for new mothers, and other rules that give incentives to women to keep focusing on their career and never give up due to family or personal circumstances.

How do you think the empowerment of women can be continued and expanded in the IP sector?

Women can inspire the new generation; all studies prove that being a working mom has a great positive impact on the kids, most of working mom's kids have higher academic outcomes, also the work environment impact their behavioural conduct and social adjustment, and the higher sense of competence and effectiveness, especially for daughters. It teaches the new generation dedication, hardwork, and, most important, balance between professional and personal life.

Women have great impact on the evolution and the development of any sector including countries, and giving more ladies the chance to shine in the IP sector will have a massive positive impact on this sector, and I say that since I have a real example at the firm and I can see the dedication and the enthusiasm that our female team works with and this is really inspiring for us and for all our clients.

A lot of our team members and I are working moms, and I can assure you this was one of the toughest, trying experiences we have had so far.

Karen Abraham: Head of the Intellectual Property, Messrs Shearn Delamore & Co.

An interview: inspirations, experiences, and ideas for equality.

Karen Abraham is the Head of the Intellectual Property department of Messrs Shearn Delamore & Co. Her practice covers all aspects of IP, Technology, Media & Telecommunications, Data Protection, and Competition Law. She has more than 30 years of litigation experience in IP matters, appearing in the Apex Courts in Malaysia. The Malaysian law journals bear testimony of how she has been instrumental in setting precedent in IP jurisprudence thereby establishing and evolving IP infrastructure in Malaysia. Karen is experienced in all aspects of IT, e-commerce, and telecommunications-related matters and cyber laws.

Karen is the first woman in Malaysia to hold a position as Board Member for INTA. Karen was the Assistant Secretary General at AIPPI and the first Malaysian to sit on the AIPPI Bureau. She also sits as a Council member of ASEAN IP Association (AIPA) and in 2021, was appointed the Asia Pacific Regional Forum Liaison Officer, IBA Intellectual Property and Entertainment Law Committee. Karen is an active member of the Emerging Rights Committee at APAA, the co-chair of the TK/TCE committee of AIPPI, and a member of the anticounterfeiting committee of both INTA and Marques.

What inspired your career?

I have always been an argumentative child. I always questioned why things had to be done a certain way and why alternative approaches could not be explored, which prompted family members to summarily conclude, "this one is going to be a lawyer!". I wouldn't take anything for granted, I always wanted to know where rules came from, who set the boundaries, and what the rationale was. There were hardly any TV shows or movies featuring women as litigators when I was growing up, but I was consumed watching programs that surrounded courtroom advocacy and anything oratory.

> **"There needs to be a long-term plan, I always had that deep down in me, and I knew that it was going to be a rough journey but I could make it if I stuck to it."**

At school I was always selected to represent the Oratory competitions and won most of them. I loved public speaking, performing in theatre, singing in public, and so I very soon understood that I was born to be on stage and if it was not in a TV drama, or at a Jazz bar, it had to be in a Courtroom!

Well on a more serious note, and to be honest, what struck me deep in my heart and appealed to me most was the power this profession had to make change (and the fact that lawyers get paid for it was a welcome incentive!). That is what's so wonderful about law in general, but IP, in particular has been so exciting as it has been an evolving subject since the beginning of time and so the law has had to continuously evolve in parallel. Being at the cusp of law reform and changing legal landscape was just thrilling. There is something new to learn every day that has been invented, discovered, or created. So I wake up each morning, in great anticipation of what the world is serving up. I have thrived being part of that daily opportunity to be involved in the change and making a difference by protecting, preserving, and enforcing IP rights in this ever changing world we live in. What an exciting life!

How have you found the pathway to your current position? And can you offer advice from your experience?

It took me 10 working years before I became a partner and five years after that to be Head of the IP department.

The journey was not an easy one. Starting out 30 years ago, I was the first woman in the IP department of my firm which created a series of firsts and although I did struggle, I always reminded myself that I was always embarking on a career path that would be ground breaking. I needed to keep my eye on the prize.

I believe much of my perseverance and determination stemmed not only from my upbringing, but from my education in Australia. I watched women take leading roles in all sectors of the community always championing the advocacy of women. The liberal and practical approach to the law gave birth to jurisprudence that resonated with me. This empowered me to break barriers, consider, and explore alternative approaches to the way things were done when it came to the role and expectation of women in my society.

I was in a part of the world where women's rights were recognized and applauded so when I came back to Malaysia to practice, I was full of hope that I could be a part of the changes in my country too.

Aspirations and visions are the starting point, but change doesn't happen overnight and without hard work and tears. I don't think you can achieve anything without investing your heart, soul, and mind and that means sacrifice, time and effort. To be a leader one must understand and practice humility and have ability to uplift the people around you. To embrace the strengths as well as the weaknesses of those around you and balancing this whilst maintaining the position of neutrality and authority you hold. This is not easy. I pray for wisdom and humility everyday and this has kept me in check (although LinkedIn posts are still something I am grappling with!!).

My children are now 24 and 22 so I understand this current generation entering the work force. They are in a different world however they are ready and willing to embrace the work force but we need to play our part as mentors and sponsors to help them navigate this journey. We need to start listening to fully understand their vision for the future in this career.

My advice is that once we have done that, we can lay down our expectations, and guide them to be prepared for the long run in this profession.

There needs to be a long-term plan, I always had that deep down in me, and I knew that it was going to be a rough journey but I could make it if I stuck to it.

What challenges have you faced? And how have you overcome them?

Starting out as the only woman in the IP department, I felt challenged to prove that I had just as much time, energy, commitment, stamina, and confidence to do the job as any other colleague. Circumstances are different now, but when I first started, I always felt there was a presumption that women were not able to perform equal to men in the profession. Overcoming these presumptions was a large hurdle. Being feminine whilst gearing up to be a warrior in Court or in negotiations is not an easy feat.

Karen Abraham

One of the earliest revelations was how visibly absent the publication of the achievement of women were when successfully winning a case or carrying out a brilliant cross examination. A senior female counsel once said to me that when women go to court and win a case, they don't go straight to the pub and beat their chests to say, 'I thrashed my opponent and 'I put him in the corner' or 'I had that witness eating out of my hand'. 30 years ago how were women to boast about their accomplishments so others would know of their wins?

Today social media has sorted that problem out. In the legal profession it has had a positive impact when it comes to visibility of ones achievements. For example we can vocalize our successes on LinkedIn. Today my firm regularly posts every accolade achieved on LinkedIn and I can share it. I think this is really important, even if we feel uncomfortable doing it, otherwise what is the point in achieving these accolades?! These success stories must be told to empower and encourage the next generation of men and women alike.

> **"When I first started, I always felt there was a presumption that women were not able to perform equal to men in the profession."**

We've got to make sure that we measure up to the equality we want to assert, and that's something I had to keep doing in my early career. That was challenging because I was in my early 20s, just graduated from university - how do you address your mind to these things when you want to have fun, live your new life and enjoy your first few years as a lawyer? But these are critical years where you're being evaluated and assessed. I would advise young lawyers to invest in what they want early, to keep their eye on the prize, and not get distracted. It's a balancing act .

I think having a plan of action for what you want to achieve is important. We're noticing that more and more young lawyers are giving up on the legal profession after a year or so. We need to look at why people are exiting the profession and I think it's because young professionals aren't sitting down to think about what they really want to do with the education they have been gifted with. The danger is to be focused on quick gratification or less hours in the office. What is the long term goal?

I think the question of value is too infrequently raised when discussing a legal career, the service paid to the public and your country. This is such an honorable profession. There needs to be emphasis placed on the role to the public and society.

"I would advise young lawyers to invest in what they want early, to keep their eye on the prize, and not get distracted."

There is also the fact that when you are young embarking upon your career; you get into a relationship or you're a young wife or mother, as you develop in your career whilst increasing your roles, those challenges get greater. Your career is not the only thing that you have to contend with. Life's demands increase and this often happens in the first five to 10 years of your career. Communication is imperative; I would advise communicating with your partner about how your career is going to evolve, what you want from your career, how ambitious you are to take leadership roles and to make changes and discuss the time implications with your family.

What would you consider to be your greatest achievement in your career so far?

I've been the first for many things, but I have to say that, to me, my greatest achievement is leading the IP department in my firm, which is a top tier practice in the country right now. I have an amazing team of lawyers, paralegals and support staff that work really hard to ensure we are at the top of our game. The endless annual accolades bear testimony to this.

So, to me that's my greatest achievement, to be at the helm of this group of people for the past 16 years.

What are your future career aspirations? And how will you work to achieve them?

I've done everything under the sun in IP in terms of litigation, appearing in the Apex Courts, transactional, enforcement, and advisory work. My future aspirations are to look at areas of IP Law in which Malaysia has room for development and growth. Two areas that I've earmarked, which I've already started working on locally, regionally, and internationally, are the protection of Traditional knowledge (TK) and Cultural Expressions (TCE) and the mediation and arbitration of IP disputes in Malaysia. These are two of my pet projects, they bear no revenue whatsoever to me or my practice right now and take up a lot of my time but it's something that I want to see come to fruition before I see the end of my work life.

I have been involved with international bodies like ASEAN IPA, AIPPI and WIPO to run a series of awareness programs through webinars locally, regionally, and internationally, planting the seeds to disseminate the need for recognition of TK through IP rights for indigenous communities. This is not just protecting the rights of the indigenous community, but also representing the human rights aspects by reaching out to communities to see what we can do for them. We are entrenched in our profession, but we need to extend that to commit time and get involved in *pro bono* projects that serve the indigenous community by educating and helping them protect their IP.

I'm doing this hand-in-hand with the relevant Malaysian Government bodies, trying to instil and harness the need for recognition and infrastructure, which will hopefully self-fund the community eventually. I've started this adventure and have been enjoying working with the local and international advocates in our mission to roll out a program in the future.

The second project is getting Mediation of IP disputes on the Malaysian Alternative Dispute Resolution map.

Almost all IP disputes in Malaysia land up in Court. Everything is being litigated unlike in a lot of other jurisdictions where there are provisions and directions that mediation must be explored before a matter goes to trial. There is precedent around the globe testifying to the fact that Mediation has been extremely successful in resolving IP disputes and achieving a 'win-win' position for all parties to litigation.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years?

In my department we have four female partners and two male partners, we have 10 female lawyers and six male lawyers. The women are presiding in abundance and that shows that women are very much involved in IP practice in my firm. In fact, in my firm which is a full-service firm, out of seven heads of departments five are women and two men. Women are rising to the top and we must in turn take responsibility and encourage women to reach for these positions.

There seems to be a fair opportunity for women to rise to top positions in IP in private practice, but I would say that that's not necessarily reflected in the other sectors. For example, in the government sectors we have never had a Female Minister in the Ministry dealing with IP matters or a woman Director General for IP - it would be great to have women presiding in these positions. There are many smart young women at the Ministry, and I hope that they will persevere and rise because we look forward to their leadership.

How do you think the empowerment of women can be continued and expanded in the IP sector?

I think the support for women by women is still lacking. In my early career I didn't have any female mentors until I started meeting women in leadership at international forums. They were empowering and uplifting. Generous and honest in their sharing, opening doors for women like me.

I have since started a women's group formed from a ladies' network and we have met over years at international conferences including INTA, AIPPI, Marques, APPA, etc.. We have been a support group for each other and are there for other women. During the pandemic, I brought these women together and set up a community to share and network online to empower women and encourage a mentoring and sponsorship system. A lot of the women in my group are leading professionals from over 40 countries all over the world. Our aim is to plant projects to help and encourage younger women in the profession. It's more than our professional training. It's about sharing the bad times we've had and not being afraid to share them because these shared experiences will help others overcome their struggles.

A structured mentoring scheme would be incredibly valuable. For example, with the system that I have in mind, we could have a lawyer in Ecuador mentoring one of my female lawyers here in Malaysia.

I've worked with the women in this group for many years, we know each other well and we have shared our stories. The women in this group have all shared similar experiences, for example about how difficult it can be being away from home at an international business meeting or conference, dealing with the issues of leaving your children or family at home. We have all shared our experiences at these meetings, and there is comfort in knowing that these struggles are not singular or specific to geographic or demographic. I think sharing is extremely important and can be so empowering.

We also need to look at areas in the IP sector where women may be scarce. Women who are already in this industry could start doing more work with associations to start programs in schools to talk to children about what they can do, to show that there are female scientists and inventors. It's important to provide role models to plant that seed. There are many emerging areas so we need to think about how we can encourage more women to get involved.

We should offer training to young lawyers to raise their confidence. It's easy to have the confidence to sit behind a desk and draft a beautiful transactional document but having the confidence to negotiate the terms you want, stand up in court and deal with an opponent challenging you is very different. I think advocacy is very important and encouraging young lawyers to go for more workshops, particularly with female litigators sharing their tips and experiences, could be very valuable.

"I think advocacy is very important and encouraging young lawyers to go for more workshops, particularly with female litigators sharing their tips and experiences, could be very valuable."

The Patent Lawyer
GLOBAL REACH, LOCAL KNOWLEDGE
www.patentlawyermagazine.com

LAW FIRM RANKINGS 2022

The Americas and The Caribbean

A comprehensive list of the 10 most well-respected law firms from the Americas and the Caribbean

The Patent Lawyer Magazine
GLOBAL REACH, LOCAL KNOWLEDGE

Throughout the next few pages, you will view a comprehensive list of the 10 most well-respected law firms from the Amercias and the Caribbean, in alphabetical country and company order. Our focused list is derived from a multifaceted methodology, which uses months of industry research and feedback from our readers, clients, and esteemed connections around the world. All firms are ranked top 10 in their jurisdiction but are displayed alphabetically to avoid bias.

Canada

Bennett Jones
Bereskin & Parr
Borden Ladner Gervais
Fasken
Gowling WLG
Norton Rose Fulbright
Olser, Hoskin & Harcourt
ROBIC
Smart & Biggar
Torys

Costa Rica

Arias
BLP
Central Law
Dentons Muñoz
Divimark Abogados
ECIJA
Eproint
Facio & Cañas
Lexincorp
Zurcher, Odio & Raven

Guatemala

Arias
BLP
Bufelco Bufete López Cordero Abogados
Carrillo & Asociados
Central Law
Dentons Muñoz
Lexincorp
Mayora IP
Novales Abogados
Palomo Abogados

El Salvador

Arias
Central Law
Consortium Legal
De La Gasca & Cía
Dentons Muñoz
EY Law
García & Bodán
LatinAlliance
Lexincorp
Romero Pineda & Asociados

Nicaragua

Alvarado y Asociados
Arias
Bendaña & Bendaña Abogados
BLP
Central Law
Consortium Legal
Delaney Silva
Dentons Muñoz
García & Bodán
LatinAlliance

Honduras

- Aguilar Castillo Love
- Arias
- BLP
- Bufete Casco
- Bufete Durón
- Bufete Mejía & Asociados
- Casco & Casco
- Dentons Muñoz Zacapa
- García & Bodán
- Melara y Asociados

Mexico

- Arochi & Lindner
- Basham, Ringe y Correa
- Becerril, Coca & Becerril (BC&B)
- Calderón & De La Sierra
- Dumont
- Goodrich, Riquelme y Asociados
- OLIVARES
- Panamericana de Patentes y Marca
- Santamarina + Steta
- Uhthoff, Gómez Vega & Uhthoff

USA North America - South

- Alston & Bird
- Bradley Arant Boult Cummings
- Burr & Forman
- Cooley
- Dinsmore & Shohl
- Finnegan Henderson Farabow Garrett and Dunner
- Haynes and Boone
- Kilpatrick Townsend & Stockton
- King & Spalding
- Stites & Harbison

Panama

- Alfaro, Ferrer & Ramírez
- Arias, Fábrega & Fábrega
- Cedeño & Médndez
- CLD Legal
- Estudio Benedetti
- Fabrega Molino
- Guinard & Noriega
- Icaza, González-Ruiz & Alemán
- Jimenez, Molino & Moreno
- Morgan & Morgan

USA North America - Mid West

- Brooks Kushman
- Crowell & Moring
- Foley & Lardner
- Harness IP
- Honigman
- Kirkland & Ellis
- McAndrews Held & Malloy
- Polsinelli
- Quarles & Brady
- Sidley Austin

USA North America - West Coast

- Davis Wright Tremaine
- Dorsey & Whitney
- Holland & Hart
- Jones Day
- Kilpatrick Townsend & Stockton
- Knobbe Martens
- Lewis Roca
- Morrison & Foerster
- Perkins Coie
- Torrey Pines Law Group, PC

The Caribbean

Clarke Gittens Farmer
DunnCox
Ferraiuoli
Foga Daley
Guzmán Ariza
HSM IP
JD Sellier + Co
Miniño Abogados
Mosko & Associates
Thornton Smith

USA North America - East Coast

Arnold & Porter
Ballard Spahr
Cantor Colburn
Choate Hall & Stewart
Duane Morris
Fish & Richardson
Goodwin Procter
McCarter & English
Morgan Lewis & Bockius
Venable

On the culture of time-slots in litigation

Pravin Anand, Managing Partner & Head of Litigation at Anand & Anand, evaluates the benefits that the implementation of a time-slot culture would bring to the Indian IP litigation system by drawing on industry and jurisdictional comparisons.

The following article is concerned with the advantages of time-slots in Indian litigation, particularly litigation relating to Intellectual Property. Some of the suggestions may appear to be too radical for the present time, but given the huge benefits of such a system, the sooner we migrate to a time-slot culture, the better.

When the Commercial Courts Act, 2015 was enacted, or the IPAB abolished in India, or the Intellectual Property Division established at the High Courts, these were all radical ideas but, they have been adopted, absorbed, and implemented to a stunning degree of success. Hence, no matter how radical, if it is a good idea it needs a serious and immediate look.

This article seeks to start a dialogue on the need for time-slot culture in Indian litigation, and will particularly look at the following:

1. The Objectives of the Exercise.
2. Practices of other disciplines such as medical, sports, and social.
3. The process involved:
   - A pre-determined time-schedule
   - Different methods for implementing time-slots in real life.
4. The international practice.
5. Conclusion highlighting the advantages of such a system.

1. Objective

The objective is to get Lawyers involved in dispute resolution to pre-commit on the basis of their best estimate and on the basis of a pre-determined schedule, the likely time they would take for a hearing and for the Court to not allow an unreasonable extension of the same so that there is greater certainty as to when matters would conclude.

2. Learning from other industries

Though this is a novel proposal for the legal field in India, advance scheduling has been the critical lifeline of many industries. Examples include:

(a) **The medical industry** – From basic health check-ups, to planning complex surgeries involving many experts, all such activities are scheduled days if not weeks in advance. Usually, clinic time is divided into slots of 15 or 30 minutes each, at least four weeks in advance[1]

(b) **The sports industry** – Mega tournaments such as the Olympics or the FIFA World Cup involve scheduling games and matches months in advance. Adhering to time is critical, as the completion of one game alone kickstarts the next. Respect for time is often exemplified by penalizing teams or players that don't honor it.

(c) **Marriage registration facilities** – Weddings, especially Indian weddings, are notorious for busting time. However, judicial, marriage registration centers work smoothly under time limitations. Each couple is provided a fixed time-slot weeks in advance. Within this short span, one sees paperwork being prepared, executed, small ceremonies, but not at the cost of intruding on another time slot.

Pravin Anand

> **The sooner we migrate to a time-slot culture, the better.**

[1] Appointment scheduling in health care: Challenges and opportunities (2008), Diwakar Gupta and Brian Denton

3. The Process

- **Pre-determined time slots**

(a) The schedule would have elements such as:

(i) Time would have to be converted into units, which by way of example only, is currently suggested as 1 Unit for 15 minutes. The schedule would run as follows:

Arguments on an Injunction Application	30 minutes to one hour (2-4 Units) for each side with 30 minutes for rejoinder (2 Units).
Arguments on Miscellaneous Applications	15-30 minutes (1-2 Units) for each side.
Final arguments	Thee-five hours (12-20 Units) each side with three hours in rejoinder (12 Units).
Cross-examination	One-five hours each witness (4-20 Units)

(ii) The aforesaid time computation is a rough and ready figure which may be discussed and set based on widespread experience.

(b) Hearings in all cases will only be as per the pre-determined time slots.

o An example of such pre-determined slots for oral arguments is already implemented by the 18th Judicial Circuit Courts, USA in the form of their "Judicial Automated Calendaring System (JACS)". This system requires both parties to agree on dates and time-slots at least two months in advance. Each slot is for 15 minutes. Time slots need to be booked on the website of the JACS, much like booking flights on the internet. An extract from the website of the JACS is provided as **Annexure 1** (overleaf) to this article.

(c) If a party wants more time, they may apply and the application would be listed before an Administrative Officer like the Joint Registrar. The Joint Registrar would hear the reasons for the extension when the party would be called upon to justify in a 10-minute argument. The reasons, if convincing, may lead to an increase in the number of time slots. If not, the request would be rejected.

(d) Once decided by the Administrative Officer, there will be an order which will specify:

"IA No. ..... for disposal on ..... (date) before the Court – 4 Units each side and 2 Units for rejoinder."

(e) The Court hearing the matter, either of an interim application or final, or any other tasks covered by the schedule, will stick to the time schedule or to the pre-agreed extension allowed by the Administrative Officer.

(f) It is only in an exceptional case where the Court may extend the time by recording a short reason for doing so.

Résumé

Pravin Anand, Managing Partner & Head of Litigation

Pravin Anand is the Managing Partner and Head of Litigation at Anand and Anand. Awarded the AIPPI Award of Merit, INTA's President's Award and recognized as the "Most Innovative Lawyer" for Asia Pacific by Financial Times, Pravin has appeared in 2500 plus cases in over 42 years of practice as an IP lawyer.

Some landmarks:

(i) Patent lawsuits transforming Indian pharmaceutical and bio-technology enforcement regime – *Merck Vs. Glenmark; Roche Vs. Cipla;* the Monsanto case; large number of suits on behalf of Pfizer, BMS, AstraZeneca, etc.

(ii) India's 1st Anti-anti-suit injunction *(InterDigital v Xiaomi)*; Software Patent lawsuit (Ferid Allani case); development of damages culture in cases recognizing compensatory, exemplary and aggravated damages (*Philips Vs. AmazeStore*); India's first post-trial SEP judgment; unique remedies such as "Tree Planting Order" (Merck case); and order benefitting adolescent girls (Hermes case).

Awards:

INTA President's Award 2021

- Ranked amongst Top 15 IP lawyers in Asia by Thomson Reuters Asian Legal Business
- Managing Partner of the Year - Asian Legal Business India Law Awards 2021
- Managing Intellectual Property IP Star - Patent 2017-21
- Chambers and Partners Top Ranked lawyer in IP Litigation and Life Sciences - 2017-22
- Benchmark Litigation Asia Pacific Dispute Resolution Star 2021
- World's Leading IP Practitioner and Strategist - IAM (2016-21)

Professional Associations:

- Ex-Member-INTA Board of Directors
- Past President AIPPI, APAA and FICPI (Indian Groups)
- Member-INTA Enforcement Committee

Spreading Message of IP:

- Raj Anand Moot Court Competition since 1997;
- 'Anaryst'-IP Board Game;
- 'Brainchild-First IP-themed play;
- 'Adventures of Mr. IP'–IP Comic
- Coffee Table Book 'IPONOMICS'

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(g) The Court, in order to understand some technical points, may certainly take the technical assistance from independent experts so as to achieve the time objectives.

(h) The culture of leaving the detailed unelaborated arguments into a written note would be encouraged.

(i) In order to assist the Court even further, apart from the written note and technical assistance, draft orders can also be jointly prepared by the parties clearly indicating the areas of disagreement, but covering in the joint note facts that are admitted and agreed upon. The Plaintiff may be given the initiative to prepare the note in the first instance.

(j) Alternatively, the written Note of Arguments of each party could be cast as an order of the Court.

Medical industry examples that could be experimented with in the legal field

Category	Application in the Medical Field	Suggestions for the Legal Field
Wave Scheduling	Three or four patients every 30 minutes. The doctor sees them in no particular order. Works for doctors whose practice involves consulting a large number of patients.	Divide the day into five layers of one hour each All matters within each layer can be heard on a rolling basis. Whichever side is present or ready can commence arguments. Requests for a Passover, i.e., same-day recess to be entertained only within that layer, and not as per the current practice of taking them up at the end of the day. Thus, even if one has to wait for one's turn, it is limited to a particular layer of one hour.
Cluster Scheduling	All cases of a similar nature are grouped together and consulted in one batch. E.g., general checkup first; then mental health, then ENT etc.	All cases on the nuanced point of law can be clubbed and scheduled for hearing within a particular session of the day. This is helpful for those Judges who like to keep their minds focussed on a particular type of work, before moving to the next type.
Integrated or Long-Short Scheduling	Long examinations or operations in the first half. Short consultations in the second half (or *vice versa*)	Judges can maximize efficiency by breaking up their day into categories, such as - New or urgent applications between 10.30 AM and 1.30 PM. - Fixed date, but short arguments – 2.30 PM to 3.30 PM - Final arguments - 3.30 PM to 4.30 PM

- **Different methods for implementing time-slots in real life**

(k) One may be tempted to argue that conducting the business of law in a fixed, time-slotted manner looks good in theory, but would fail in practice. However, one need only glance at the medical industry, which can't help but conduct its business (no matter how large or small) in a regulated, time-controlled manner.

(l) Not only does the medical industry work on fixed time slots, but it implements a variety of time management techniques, which help improve the entire system's efficiency while improving the experience of patients. There are various methods of scheduling appointments in the medical industry, which can be experimented with within the legal field. Examples in the table to the left:

4. International Practice

(a) If one has a look at the England and Wales High Court (Patents Court) alone, for the last six years (2016 to 2021), on average, around 170 decisions have been handed down in patent matters. As opposed to this figure, all Courts in India have collectively passed decisions in only 65 patent cases in the same period.

(b) Similarly, the Indian Supreme Court has decided only 11 patent cases in its entire history, starting from 1950. On the other hand, the UK Supreme Court, which started operating independently only in the year 2009, has already decided seven patent cases.

(c) This clearly demonstrates the need for many more decisions in the patent law at the topmost level.

(d) Regarding time slots, some learnings from international practice are as follows:

(i) **Australia**

The High Court of Australia grants a fixed time of 20 minutes to each side to present oral arguments, followed by five minutes for a rejoinder, which is available only to the applicant. These strict time limits are prescribed under Rule 41.08 of the official "High court Rules, 2004".

(ii) **France**

Though it is not officially notified, publications and reports from practitioners in French commercial courts suggest that the conventional monologue style of arguments has been replaced by the Q&A format, where the Judge seeks answers to the most pressing questions about a case.

On average, hearings in such Q&A format are said to rarely exceed 30 minutes.[2]

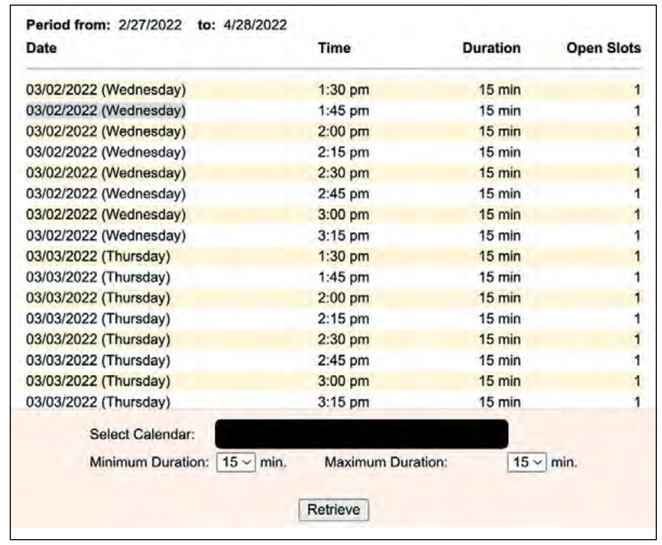
(iii) **United States of America**

The US Supreme Court allows only 30 minutes for each side to present its case. This is codified in the form of Rule 28 (3) of the Rules of the Supreme Court of the United States.

A request for extension of time has to be made before the hearing and must be backed by clear, concise reasons.

The Rules specifically state that additional time is rarely accorded, and in fact, cites examples of numerous cases, which concluded oral arguments in much less time, such as seven minutes, 10 minutes, etc.

(e) With oral arguments being strictly controlled for time and yet not compromising the quality of jurisprudence that emanates from the abovementioned jurisdictions, it is time that Indian courts start considering infusing time-limits in the adjudicatory process.



Annexure 1
A screenshot from the website of the Judicial Automated Calendaring System (JACS), which allows parties to book time-slots months in advance.

> **Though this is a novel proposal for the legal field in India, advance scheduling has been the critical lifeline of many industries.**

5. Conclusions

There are several foreseeable advantages of the Indian judiciary taking steps towards bringing in the culture of time-slots. Some of these are:

(a) Court time is public time. With the introduction of time-slots in oral hearings,

[2] Debevoise & Plimpton LLP "10 Things U.S. Litigators Should Know About Court Litigation in France" , 2017

judicial time, which is a **public asset**, will be **evenly distributed** amongst parties from all ends of the spectrum.

(b) It is estimated that with the growing pressure of filing, at least in the Intellectual Property Division due to increased inflow of work from the abolished IPAB (Intellectual Property Appellate Board) and direct appeals and revocations which were earlier being filed before IPAB, it would be impossible for the Court to comfortably handle the volume unless some drastic steps are taken towards restricting the time for matters.

With the implementation of time slots, not only will there be **greater predictability** as to when matters will finish, but **a greater number of matters can be taken up for arguments**, leading to more diverse opportunities to counsel.

(c) **Arguments will be more clean, crisp, and comprehensive** – Armed with the knowledge of making one's case within 15 minutes, counsel will work harder to sharpen their argument, which would only improve the quality of advocacy.

(d) There will be a huge **boost to the quality of lives** of all players in the legal system, from Counsels to Judges. With greater certainty of the time of day in which one's case is likely to be heard, counsel can use the free time that remains to honor other work or personal commitments. Often, lawyers in India slate all their personal work (even important tasks such as health check-ups, visits to the bank, home-related errands) to the weekend due to the uncertainty of their cases being called out for arguments anytime in the working hours of the court on a given day.

(e) Likewise, hearing cases on the basis of pre-fixed time slots will allow **Judges to dedicate free slots to important tasks such as authoring decisions** or **deliberating with other judges** about an important case. In the present system, Judges are chair-bound till the very last second of working hours, and it is only after finishing a long, exhausting day of hearing arguments, that they can consider authoring decisions.

Complex subjects, like patent law particularly, require more and more judgments to develop the law further.

> **Armed with the knowledge of making one's case within 15 minutes, counsel will work harder to sharpen their argument, which would only improve the quality of advocacy.**

(f) Greater time to deliberate and author judgments will also help free up the overflowing dockets of the judiciary, which has been the need of the hour for many decades.

(g) More decisions on interim aspects of a case will actually **increase the number of cases that reach the trial stage and final arguments** stage in India. Adherence to time slots will help dispel the notion that Intellectual Property disputes in India are only a game of winning the interim injunction stage.

(h) Currently, it definitely is unfair, or at least appears to be, if one matter hogs up half a day of the Court's time unless of course it is so impactful as to have industry-wise or country-wise repercussions. Under normal circumstances, if there are tasks - *such as extension of time to file pleadings, request for adjournment, filing of additional documents, addition or deletion of parties, witness substitution, amendment of pleadings, devolution of title and interest, etc.*, - these tasks should not take more than a certain pre-determined estimate based on an average of the time usually taken for such tasks.

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Unity of invention in the light of PCT, EAPC and Russian Law

Sergey Kalachev, Deputy Head of the Chemical & Life Sciences Department at Gorodissky & Partners, reviews the differing regulations of the PCT, Eurasian and Russian law to provide an overview of which lends best to which type of application.

The Patent Cooperation Treaty (PCT) and the Regulations is a flexible structure, providing vast opportunities to applicants for obtaining legal protection for inventions in many countries via a most convenient, economical, and efficient way.

According to Article 27 of the PCT, no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those provided by the PCT and the Regulations. At the same time, if the national law in respect of the form or contents of national applications is more favorable than the PCT requirements from the viewpoint of applicants, the national competent body may apply the national requirements, instead of the PCT requirements, to international applications. However, the applicant may insist on using the PCT requirements.

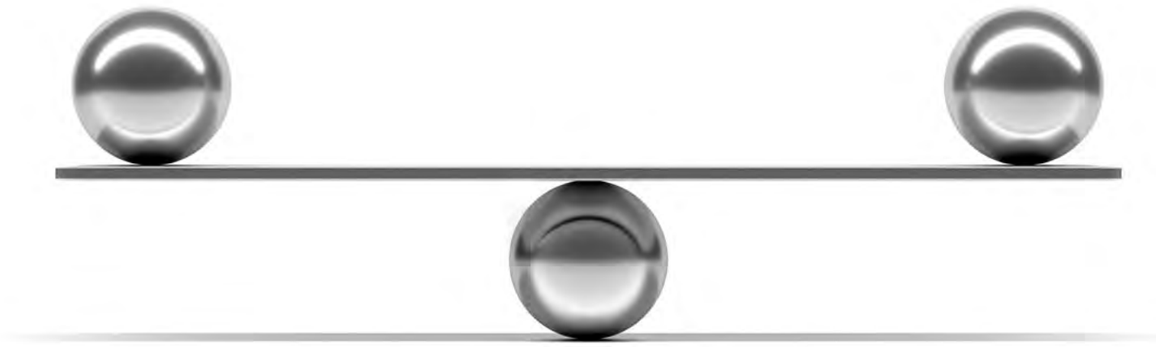
The unity of invention is one of the matters allowing applicants to use alternative criteria for assessing fulfilment of the requirement either under the PCT Regulations or the national legislation, which differ to some extent.

> **This fact is undoubtedly sufficient for considering such features as special ones.**

According to Rule 13.2 of the PCT Regulations, in case of a group of inventions, the requirement of unity of invention is fulfilled only when there is technical relationship between the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

According to the Russian patent regulations, the unity of invention requirement is considered to be complied with in respect to a claimed group of inventions if a set of claims characterizes a group of inventions interrelated to each other as follows:

- one of which is intended to obtain (produce) another one;
- one of which is intended for implementing another one;



- one of which is intended for the use of another one (in another one);
- claimed inventions relate to subject matters of one type, identical purpose, ensuring the attainment of one and the same technical result (variants).

PCT and Russian approaches have their own advantages and may be favorable for applicants in different circumstances.

For instance, lack of compliance of technical solutions in a claimed group of inventions with the unity of invention requirement in the PCT Regulations may be revealed at the international stage, though these inventions may comply with the unity requirement in the national law.

In particular, it relates to cases where different variants of one and the same subject-matter are claimed in an international application. Such variants usually have no common features, except a purpose, which cannot be regarded as a feature over the prior art, i.e., it cannot be considered as a special technical feature ensuring the unity of invention requirement as required by the PCT Regulations. It may be very difficult to prove features of different variants, making input over prior art correspond to each other. Thus, compliance of such group of inventions with the unity of invention according to the PCT Regulations would unlikely be recognized.

However, those variants may comply with the unity of invention requirement according to the Russian law. Moreover, processes intended for producing such variants may be claimed in the same invention group according to the national law, the processes may have no common technical features which is not admitted by the PCT Regulations. Hence, the national law provides benefits to the applicants in case of protecting a group of such kind of inventions.

At the same time, since the list of cases defining the group of inventions complying with the requirement of unity of invention in the Russian law is limited, the opposite situation is also possible, i.e., there may be a case where the use of the unity of invention criterion in the PCT Regulations is more favorable.

For instance, means of one type, having common features defining a contribution over the prior art where each has its own purpose would unlikely be recognized as complying with the unity of invention requirement in the Russian law, however they comply with the unity of invention criterion in the PCT Regulations.

Thus, selecting a more favorable criterion for assessing the unity of invention depends upon the claimed group of inventions, and which inventions in the group interest applicants most notably.

Nonetheless, when insisting on using the PCT requirements, applicants may face problems with recognizing the unity of invention. It is caused by the fact that Russian examiners have no uniform understanding of the term "special technical feature". Nor Rospatent has set any common approach concerning this mater.

> **Thus, the Eurasian rules expand the list of possible combinations of inventions that may be recognized as complying with the unity of invention requirement over the PCT and Russian Regulations.**

In these circumstances, Rospatent examiners often believe that features defining a contribution, which the claimed inventions make over the prior art, should not be known from the state of the art *per se*. In this regard, they rely on the criterion provided by Rule 13.2 of the PCT Regulations and conclude that a claimed group of inventions does not meet the unity of invention requirement in cases where they reveal documents disclosing features common for all inventions of a claimed group, or have doubts about novelty of one or some of the claimed inventions (in the latter case Rospatent examiners consider the whole invention as a special technical feature).

However, such interpretation of the term "special technical features" seems to be incorrect.

Definition given in Rule 13.2 of the PCT Regulations does not stipulate that such features shall not be known from the prior art at all. They shall define a contribution over the prior art. The contribution cannot be considered without taking into account the effect produced by the features. For instance, known features may produce a new technical result or serve for a new purpose, which were not previously known and can be achieved due to these features. This fact is undoubtedly sufficient for considering such features as special ones.

Furthermore, in the course of assessing novelty of inventions, the law of any country does not take into account the achieved technical result. Therefore, it is incorrect to draw a conclusion about compliance or non-compliance of the claimed group of inventions with the unity of invention requirement based on information obtained in the course of assessing compliance of inventions with the "novelty" criterion. This is also confirmed by the Russian patent regulations.

Despite the obvious incorrectness of such approach, it may be difficult to convince Rospatent examiners that the claimed group of inventions complies with the requirement of unity in the said circumstances. It is one of the main disadvantages of using the criterion provided by the PCT Regulations when assessing the unity of invention in the course of prosecution of international applications at the national stage.

Even in cases where Rospatent examiners take into account special technical features in accordance with the definition given in Rule 13.2 of the PCT Regulations, i.e., in connection with the contribution they provide over the prior art, or where the examiners agreed to take such contribution into account upon assessing the unity of invention, problems still may arise.

Specifically, Rospatent examiners often consider special technical features of the claimed inventions and a contribution they provide over the prior art in isolation from other features, despite the fact that Rule 13.2 of the PCT Regulations explicitly states that when considering a contribution, which each of the claimed inventions makes over the prior art, each of the inventions shall be considered as a whole. This means that the whole combination of its essential features will be taken into account. In such cases, Rospatent examiners conclude that the claimed group of inventions fails to comply with the unity of invention requirement as set forth in the PCT Regulations, if they find a piece of information in the prior art that reveals special technical features of the claimed inventions and their impact on the results indicated in the application materials. This is true even if such information is related to a different field. At the same time, it may be noted that Rospatent examiners sometimes do not take into account other features of the claimed invention that could affect attaining these results.

It appears this problem results from the fact that in such cases Rospatent examiners apply the procedure foreseen by the Russian regulations for assessing the inventive step of inventions, when they assess the unity of invention. However, the unity of invention has nothing to do with the inventive step. Therefore, it seems unacceptable to apply the procedure for assessing the inventive step, when assessing the unity of invention. With all that, it may be very difficult to convince examiners to adopt this view.

As to the provisions of the Eurasian legislation, which are applicable upon entering international application into the regional Eurasian stage, they combine benefits provided by the PCT Regulations and the Russian patent law.

The Eurasian rules, when they define cases where the unity of invention requirement shall be fulfilled, almost completely correspond to those provided in the PCT Regulations. According to Rule 4 of the Patent Regulations under the Eurasian Patent Convention, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features, i.e., those technical features that define a contribution which each of the claimed inventions makes over the prior art.

At the same time, according to Clause 5.3 of the Eurasian Rules for compiling, filing and prosecuting applications variants also comply with the unity of invention requirement, if the technical result is attained by the claimed inventions based on the same principle.

Thus, the Eurasian rules expand the list of possible combinations of inventions that may be recognized as complying with the unity of invention requirement over the PCT and Russian Regulations.

It should be noted that sometimes the Eurasian examiners as well as their Russian colleagues consider special technical features of the claimed inventions and a contribution they provide over the prior art in isolation from other features. It appears that these problems may be caused by the absence of any indication to the necessity of considering an invention as a whole upon revealing the contribution according to Rule 4 of the Eurasian Patent Regulations. However, said Rule stipulates the contribution made by the invention, not by the features. Thus, such approach also seems to be incorrect in view of the Eurasian patent regulations. However, it may be almost impossible to persuade the Eurasian examiners to the contrary in view of absence of a common approach to this matter.

Thus, despite wide opportunities for claiming different combinations of invention in a single application, further steps are needed to harmonize the Russian and Eurasian legislation with the existing international legal systems.

Résumé

Sergey Kalachev, Deputy Head of the Chemical & Life Sciences Department, Russian & Eurasian Patent Attorney

Sergey graduated from the Dmitry Mendeleyev University of Chemical Technology and the Russian State Academy of Intellectual Property. Sergey has been with Gorodissky & Partners since 2012, where he deals with representation of Russian and foreign chemical, petrochemical, metallurgical companies before Russian and Eurasian PTOs, advises on patenting strategy in Russia and Eurasia. His areas of particular experience include: general and non-organic chemistry and technology, physical chemistry, electro chemistry, chemistry of steel and alloy, oil chemistry, crystallography. Sergey represents clients before the Russian and Eurasian PTOs in objection cases against patent grants.

Sergey Kalachev

> **However, the unity of invention has nothing to do with the inventive step.**

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New Patent Suit rules to demystify patent litigation in India

Rachna Bakhru, Partner with RNA, Technology and IP Attorneys, previews the new Patent Suit rules implemented in Indian litigation that has introduced elements such as video conferencing, hot-tubbing, and confidentiality clubs to act as a step-by-step manual aiming to provide clarity for enforcement.

In the last two decades, India has seen a rising number of patent disputes in several technology fields, including pharmaceuticals, electronics, biotechnology, and telecommunications. In the absence of special IP courts, it is challenging for the Judges to adjudicate technical matters that require expertise in the respective domain. While the Judges are experienced in applying the provisions of the Civil Procedure Code (CPC) and Intellectual Property Rights, the Patent disputes require a deeper understanding of the technology and the Patent claims to assess disputes arising out of them. Further, there is limited jurisprudence in Patent litigation in India and a lack of consistency in drafting legal claims, making it even more difficult for the courts to unwrap the actual conflict.

Rachna Bakhru

Therefore, to streamline patent litigation in India, the Delhi High court has recently framed "High court of Delhi rules governing Patent suits, 2022" to lay down specific procedural steps to bring uniformity in presenting the infringement

CTC Legal Media

Résumé

Rachna Bakhru , Partner

Rachna Bakhru is a Partner with RNA, Technology and IP Attorneys, an IP specialist law firm. She qualified as an Electronics graduate from Delhi University, followed by a diploma in Business Administration and a degree in Law. She is a registered Patent Agent and a member of the Bar Council of India.

Rachna currently heads the Dispute Resolution team of the firm, dealing with IP enforcement and advisory. She has over 25 years of extensive experience in managing non-contentious and contentious IP matters, IT and Technology issues. Her expertise includes risk assessment, IP clearance, regulatory issues, litigation, and alternate dispute resolution. She has worked on portfolios of large international companies and her industry expertise includes Pharmaceuticals and Information technology. She advises her clients on issues related to IP infringement, Information Technology, trade secrets, data protection, and geographical indications.

> The rules have included provisions to simplify the suit proceedings, provide flexibility and necessary tools to expedite litigation, and save judicial time.

claims in a Patent lawsuit. Currently, the patent suits are governed by the Patents Act, 1970, and the Civil Procedure Code of India, 1908 (CPC) as amended by the Commercial Courts Act, 2015. The Delhi High court had earlier notified the Delhi High court (original side) rules in 2018, which apply to all civil lawsuits filed before the said Court, including intellectual property rights. However, given the technical nature of disputes arising out of infringement of Patents, there was a need for additional provisions specific to patents. Hopefully, the new rules will help fill the gap and provide guidance and tools for effective and efficient case management.

The rules have included provisions to simplify the suit proceedings, provide flexibility and necessary tools to expedite litigation, and save judicial time. The article discusses fundamental changes introduced, focusing on the techniques that will likely significantly change India's overall governance of patent litigation. A few highlights are:

1. Clear and concise case briefs

The rules lay down the Court's expectations from the complaint/infringement claim to contain a) the brief background of technology, b) details of patent ownership, c) other patent applications which are filed, d) brief prosecution history, e) relevant facts to show the validity, and f) other similar and relevant details including infringement analysis.

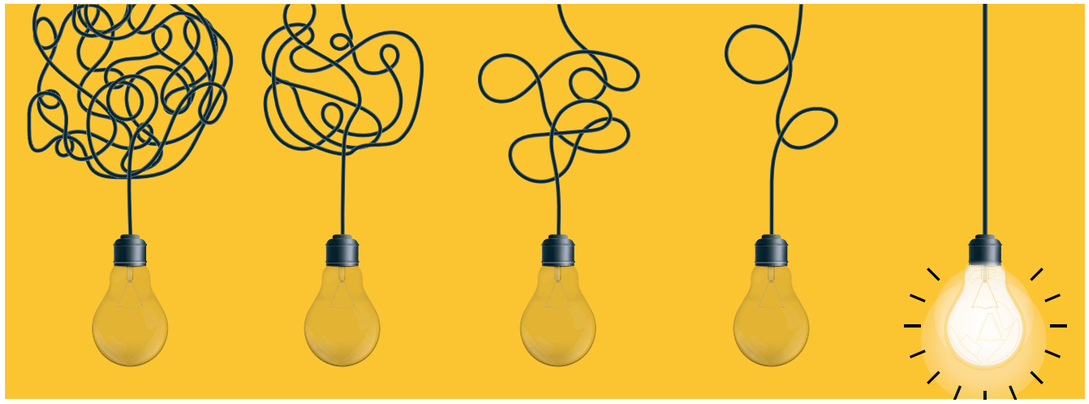
Similarly, a written statement/response from the contesting party should contain defenses of non-infringement, the grounds seeking revocation, technical analysis, and most importantly, the details and the exact description of products alleged as infringed.

The rules also provide a list of documents to be filed along with the plaint, written statement, counterclaim, and other relevant documents to avoid ambiguity and save the court's and litigant's time lost due to unnecessary adjournments. On the same lines, the rules direct the litigating parties on the Infringement brief to be filed comparing the elements of each of the claims and the way the Defendant's product/process infringes the claims relied upon and similarly non-infringement brief or claim mapping to be filed by the Defendant explaining how his product/process does not infringe the Plaintiff's claims.

2. Case management: After the pleadings are complete, the rules laid out a clear roadmap for the first, second and third case management hearings. Under each heading, there are clear guidelines on the expectations from the parties to the suit and various steps of the litigation process.

3. Appointment of Scientific advisors: The rules empower the courts to prepare a list of scientific advisors that will assist the Court in adjudicating the patent suits. The list will be subjected to periodical review. Hopefully, this will help fill any technical gaps in the Court's understanding of the Patent and respective infringement claims. It is not clear if the fees of the scientific advisors will be borne by the litigating parties or funded by the High Court.

4. Compulsory Mediation: The rules also include provisions for specific techniques that may help expedite the conclusion of the conflicts, including mandatory mediation and Early Neutral Evaluation (ENE). A specific Rule is introduced (Rule 12) that provides at any stage of the proceedings if the Court believes that the parties ought to explore mediation. It can appoint a mediator or a panel of mediators and technical experts to study amicable dispute resolution. The Court need not seek the consent of the litigating parties for appointing a Mediator or ENE if it believes that an evaluation or mediation will help early resolution of the matter. Mediation/ENE may occur simultaneously with the legal proceedings to avoid any delays if the



mediation/ENE is unsuccessful. Overall, the objective of compulsory mediation is to expedite the resolution of the cases.

5. Video recording of the evidence: The Court may direct on its own or request any parties for video recording of the evidence. Further, that any video or audio recordings of the evidence will be preserved electronically in a manner that the same is not editable and cannot be tempered with.

6. Hot-Tubbing: Rule 9(iii) of the High Court of Delhi Governing Patent Suits, 2021 provides that the expert testimony may be directed by the Court on its motion or on the request of the parties to be recorded by Hot-tubbing technique under Delhi High Court (Original Side) Rules, 2018 which provide a detailed protocol for Hot tubbing.

The technique involves recording experts' evidence in each other's presence and before the judge who asks the same questions. This process helps focus on the issues of the dispute. The discussion provides more clarity and helps the judge better understand the facts and technology. However, the experts must be fully prepared to explain their evidence better and counter the evidence produced by the opposite party.

As per Rule 8 of the draft rules, the Court may employ hot-tubbing even at the beginning of the trial, i.e., even before framing the issues, and need not wait for the stage of evidence and witness cross-examination. This may help the judges frame trial issues and skip those that do not require leading of the evidence.

The concept of hot-tubbing was first discussed in India in the case of *Micromax Informatics Ltd. v Telefonaktiebolaget LM Ericsson*. This case was filed under the Indian Competition Act. Micromax is a major mobile handset manufacturer and owns several patents, including several Standard Essential Patents (SEP). While disposing-off the Appeal, the Delhi High Court made certain observations regarding the concept

> The Court also discussed the nature and scope of 'Hot-tubbing' where it stated that such a procedure can be used to make faster and smoother dispute resolution.

of 'Hot-tubbing'. It recommended the 'Hot-tubbing' procedure upon acceptance of the parties involved. The Court also discussed the nature and scope of 'Hot-tubbing' where it stated that such a procedure can be used to make faster and smoother dispute resolution. It also stated that in patent disputes where the involvement of an expert is a must, adopting the hot-tubbing procedure will be helpful.

7. Confidentiality Club: So far in India, the concept of Confidentiality Clubs has been adopted in two cases, *Telefonaktiebolaget LM Ericsson (PUBL) v Xiomi Technology & others*, and *Pfizer Inc v Unimark Remedies Limited*. In *Telefonaktiebolaget LM Ericsson (PUBL) v Xiaomi Technology & others*, the Delhi High Court allowed the set-up of 'confidentiality club' and an EEO (External Eyes Only) where the parties were able to access the documents only through this club. In *Pfizer Inc. v Unimark Remedies Ltd.,* the Bombay High Court also allowed the set-up of 'confidentiality club' and further ordered that these proceedings shall be held 'in-camera'. These clubs consisted of the parties, the counsels, the experts, and the judge.

Observing the need for confidentiality clubs, the new rules (Rule 11) provide for a provision for the same and redaction of the confidential information on request by the parties. Generally, the infringement proceedings are held in open Court, and all the parties involved in the suit can access the documents and evidence. As per Rule 11, the Court may constitute a confidentiality club to preserve and exchange confidential information filed before the Court at any stage of the suit. A Confidentiality Club consists of specified counsel, technical experts, and the concerned parties only. The arguments of the suits are not disclosed to any other person. To maintain such confidentiality, the involved persons may sign an undertaking not to disclose the information.

8. Summary judgment: Under Rule 16, In addition to the provisions in the Commercial

Courts Act, 2015 for Summary judgment, Summary Adjudication of Patent suits can be undertaken in the following conditions.

(a) Where the remaining term of the Patent is five years or less;
(b) A certificate of validity of the said Patent has already been issued or upheld by the erstwhile Intellectual Property Appellate Board, High Court, or the Supreme Court;
(c) If the Defendant is a repeat infringer of the same or related Patent;
(d) If the Patent's validity is admitted and only infringement is denied.

Conclusion

The new rules implemented by the Delhi High court to govern patent litigation seemed promising and were the need of the hour. Currently, due to the technical nature of the patent suits, there are challenges in interpreting the Patent, related infringement claims, and several other related issues resulting in delays for the cases to conclude satisfactorily. The detailed outline in the rules on the pleadings, list of documents, infringement brief, invalidity brief, etc., will help avoid any confusion and reduce unnecessary adjournment to obtain the requisite information from the litigants. Hopefully, these will help simplify patent litigation, reduce delays, and overall efficient management of cases. In addition, the formal introduction of video conferencing, hot-tubbing, appointment of scientific advisors, confidentiality club, and compulsory mediation will help streamline the trial process. Overall, the rules are nothing short of a step-by-step manual for filing patent litigation in India. Hopefully, these will give the patent owners clarity and confidence to enforce their rights in India and build trust in India's commitment to protecting Intellectual Property.

> **Hopefully, these will help simplify patent litigation, reduce delays, and overall efficient management of cases.**

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Are the trends about to change for patent application filing in Poland?

Agata Granis-Rafferty, Polish and European Patent Attorney at Patpol, predicts the impact that the unitary patent will have on filing trends at the Polish Patent Office.

The unitary patent in Europe will commence by the end of 2022. Unitary patents will enable the obtention of patent protection in up to 25 EPC Member States by submitting a single request to the EPO. The unitary patent is aimed at removing the necessity of national validation procedures in the contracting states. Infringement and validity of Unitary Patents, as well as European patents, will be concluded by a special Unified Patent Court. Although 25 EU Member States are currently participating in the Unitary Patent scheme, unitary patents registered at the outset will not cover all 25 territories because some states have not yet ratified the Unified Patent Court Agreement (UPCA). Poland signed Protocol on enhanced cooperation, but is not a party to UPCA. This means that Poland is not among member states in which the unitary patent will have a legal effect. This does not prevent Polish companies from applying for a unitary patent, but if any applicant or patent proprietor wishes to have protection in Poland they will need to achieve this through validation of a classic European patent, by filing a national patent application or by entering a PCT application into the national phase in Poland.

A European patent is definitely the preferred option for obtaining patent protection in Poland. Since Poland's accession to the European Patent Convention (EPC), the number of European patents in force in Poland has grown significantly from 12 European patents in 2005 to 83,800 European patents in 2020. Never before has

Poland had such a high number of patents in force. The validated European patents outnumber the patents granted directly with the Polish Patent Office, whose number in 2020 amounted only to 18,731. These high numbers of validated European patents not only correspond to an increasing number of European patents granted every year by the EPO, but also show that many patent proprietors want to protect their inventions in Poland and are willing to invest in EP patent translations, which are necessary for patent validation in Poland.

How will the introduction of the unitary patent in Europe impact patent filing numbers before the Polish Patent Office?

For the answer to this question, we will have to wait a few years. Will a number of unitary European patents in force in Poland increase in a corresponding manner as after Poland's accession to the EPC? It will depend on how many patent proprietors will be interested in obtaining unitary patents and how many will decide to obtain protection with classic European patent or a combination of both (i.e., in addition to a unitary patent there is still a possibility to validate the EP patents in the countries which are not participating in the unitary patent). The unitary patent system provides an option enabling the patent proprietor of a unitary patent to obtain protection in all other EPC member states (or extension states) by way of national validation, in the same manner as in the past. In other words, one and the same granted European patents can have unitary effect in all UPC participating states and be validated in some or even all remaining EPC member states by way of national validation.

If no request for the unitary effect is filed within one month from the grant of the European patent, the European patent will be a classic traditional European (bundle) patent, which becomes effective only in those EPC countries where the requirements for validation, if any, have been fulfilled.

Classic European patent validation will still be available for those proprietors who wish to be present on the Polish market. Poland is not a party to the London Agreement, which is an agreement that simplifies the validation procedure and reduces translation-related costs. Therefore, in order to validate European patents in Poland, translation of the entire text of granted EP patent into Polish needs to be filed with the Polish Patent Office within three months from the European patent grant date.

What needs to be underlined is the fact that provisions of the unitary patent introduce a transition period of seven years for unitary patent proprietors to opt out from sole jurisdiction of UPC provided that there is no action filed against it. Users of the unitary patent system will have seven years to test the new product during which time they may decide whether they are satisfied with it or not. Why would they be unsatisfied? Proprietors of a unitary patent will be subject to infringement and revocation proceedings held by UPC upon receiving an action, UPC will decide on revocation of a unitary patent in all countries at the same time. Thus, if the patent proprietor suspects that there is any risk of receiving a motion for revocation of the patent, they may wish to minimize the area on which patent revocation could possibly take place and save the markets of interest. This can be done by opting out from the sole jurisdiction of UPC. What needs to be taken into account is that if the patent proprietor decides on litigation in Poland then invalidation of a patent takes place before the Polish Patent Office and infringement cases are dealt with by the specialized Polish patent court. This specialized patent court is fairly new. It is located in Warsaw and deals with technical patent litigation cases since 2020. Patent holders thus have a fair option to defend their rights with patent court similar to UPC. How many patent proprietors will decide to opt out within the first seven years? Again, for the answer to this question we will have to wait a few years. During this transition period the trend in patent filing numbers in Poland is not expected to change drastically, as UPC jurisdiction does not cover Poland.

Agata Granis-Rafferty

Résumé

Agata Granis-Rafferty is an experienced patent attorney specializing in the field of Chemistry, Biotechnology and Pharmacy. She is a member of AIPPI, PIRP and EPI.

> During this transition period the trend in patent filing numbers in Poland is not expected to change drastically, as UPC jurisdiction does not cover Poland.

What else might the introduction of the unitary patent in Europe change for patent filing numbers before the Polish Patent Office?

It seems that a number of national filings or PCT entries into the national phase will not be affected by the introduction of the unitary patent in 25 EU countries. In 2019, the share of patent and utility model applications filed by foreign entities amounted to only about 3.5% of all filings and a slight decrease of filings within the years 2014-2018 was observed. This trend is expected to be stable as validation of classic European patents is preferred by the patent proprietors, however patent proprietors and patent applicants should be aware of the following improvements that have been introduced into the Polish patent system.

In 2020 the Polish Patent Office launched a PUEUP special system solely dedicated to communication with the Office. Digitalization of filings accelerates time in which a patent can be granted.

Also, the time frame for processing patent applications has been reduced. In 2019 the average timescale for processing patent applications by the Polish Patent Office, calculated from filing the application up to issuing the decision, was 32.6 months and was 1.5 months shorter than in 2018.

Since 2019 the Polish Patent Office has started conducting formal and legal examinations of filed applications by preparing the so-called preliminary opinion on a patent application issued before the publication of the application in the "Bulletin of the Patent Office". Issuing preliminary opinion is a real change in the approach of the Polish Patent Office. Applicants receive feedback on the obstacles found in the patent application before making a decision on whether to enter with the invention into another market/s. Unfortunately, not all patent applications are given such a preliminary opinion. Sometimes information that a patent search cannot be performed due to a problem with clarity of claims is issued. With preliminary opinion, the applicant may redraft the application accordingly before filing an EP or PCT or any other national application. Such a redrafted application, which includes the examiner's comments from the preliminary opinion, may significantly accelerate granting of a patent for an invention or a right of protection for a utility model.

Additionally in 2020, the President of the Polish Patent Office issued general guidelines that serve as interpretative directives which are to be considered by examiners in their decisions. However, these guidelines neither generally or internally constitute a binding source of law. Guidelines are binding only for examiners while deciding on the case and cannot be cited as a legal grounds for a decision or resolution, but have an interpretative role – as indicated in the relevant literature – and serve as a manual on how to apply the law.

> With preliminary opinion, the applicant may redraft the application accordingly before filing an EP or PCT or any other national application.

How will the unitary patent change the number of EP filings filed by domestic companies?

The number of EP filings by domestic applicants is expected to increase. It can be observed from data provided by the Polish Patent Office that a number of EP filings filed by Polish domestic entities amounts to about 500 per year with a maximum of 566 in 2015 and minimum of 393 in 2016. In 2019 there was 469 EP applications filed by the Polish companies. Unitary patents may attract Polish companies to file the EP application.

Will the unitary patent change the number of domestic filings by local companies?

It is rather unlikely that national filings by Polish companies will be affected by the unitary patent. Based on the data revealed by the Polish Patent Office we can observe that for the past six years about 4,000 national filings a year were made by domestic entities, with a maximum of 4,679 in 2015 and minimum of 3,923 in 2018. In the past few years, there was a high number of filings from universities and research centers. It is still high, but nowadays the business sector is the leader in the national filings. In 2019, 55% of national filings were done by the business sector and in 2020 this number increased to about 60%. This trend can also be noticed in the numbers of granted patents.

In 2019, the Polish Patent Office started publishing data with respect to profiles of companies who file patent applications, as well as their size. The business entities that filed patent and utility model applications with the Polish Patent Office in 2019 were mainly small and medium-sized enterprises with less than 250 employees. A majority of the applicants hired less than nine workers. The biggest companies covered nearly 12% of applications from the whole sector.

No big change in the fields of technology of granted patents can be observed. Since the Patent Office started publishing data about classification of granted patents in 2011, the top 10 fields are chemistry (organic fine chemistry, basic materials chemistry and chemical engineering).

To sum up, it seems that trends in national patent filing numbers will not change, but there is no clear prediction of how the introduction of the unitary patent will change the number of European Patent validations.

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Patent examiners as moral gatekeepers

DPS Parmar, Special Counsel at LexOrbis, explains the implications of morality in the patent examination process, identifying aspects that will prevent successful grant.

All inventions which come from nature are pious and it is only their commercial use that makes them immoral to the public order or injurious to the environment. Inventions of all kinds knock at the doors of the patent office to obtain exclusivity for 20 years, millions of such inventive ideas are waiting at the patent office to get a nod to enter the exclusive patent club. Examination of every patent application at the patent offices of nearly all the jurisdictions is subjected to statutory binding national patent laws and non-binding, but persuasive, guidelines issued by the intellectual authorities from time to time. Examiners of the patent applications are the vigilant gatekeepers of the public interest to allow only those inventions which are not frivolous or injurious to the well-being, good policy, or sound morals of society apart from judging its patentability based on novelty, inventive step, and industrial application. There are various well recognized and settled grounds for exceptions from patentability in Indian law and laws of other jurisdictions. In some countries like the US, such exceptions are based on court precedents. More particularly, the patent office invariably considers the morality of the inventions that seem to be controversial. Section 3(b) of the Patent Act gives statutory sanction to examiners to evaluate the morality of patent applications and reject patents on this basis. For example, a patent application relating to an Electro-Mechanical sexual stimulating device and its intended use or commercial exploitation was found contrary to public order and morality and the patent application was rejected under Section 3(b). [4668/DELNP/2007].

DPS Parmar

> **All inventions which come from nature are pious and it is only their commercial use that makes them immoral to the public order or injurious to the environment.**

Looking back at morality exclusions

The first English patent law, the 1623 Statute of Monopolies, had moral standards with expressed prohibitions on patents that were "contrary to law," "mischievous to the state," and "generally inconvenient." In the European Patent Convention 1977, the concept of "*ordre public*" was accepted to ensure public security and the physical integrity of individuals as a part of society, including the protection of the environment. This interpretation appears to be like the

Résumé

DPS Parmar, Special Counsel

Mr. D.P.S Parmar heads the Intellectual Property Appellate Board (IPAB) practice group at LexOrbis. After joining the IPAB as Technical Member (Patents) in 2011, he has been instrumental in writing some path breaking and insightful decisions on Indian patent law issues. These include establishing legal positions on excluded subject matter under Section 3(d), 3(i) and 3(k), divisional applications, disclosure requirements under Section 8, working statements and compulsory license, to name a few. Before joining IPAB, Parmar worked with the Indian Patent Office (IPO) for over 27 years and had played a vital role both at the administrative and policy levels. He represented India at various rounds of discussions organized by the World Intellectual Property Organization (WIPO) and attended follow-on programs at the European and Japanese Patent Offices. He was instrumental in the recognition of IPO as the 15th ISA and IPEA under the Patent Cooperation Treaty (PCT). He also served as the head of the Intellectual Property Training Institute (IPTI) in Nagpur, which was responsible for providing training to new examiners at the IPO.

It is not surprising to find that most countries around the world introduce the concept of morality into their patent laws including India, particularly after the signing of the TRIPS agreement.

express provision in Section 3(b) of Indian patent law which states- *"or which causes serious prejudice to human, animal or plant life or health or to the environment"*. The provisions relating to the refusal of patent or design of which the use, in the opinion on of the controller, is contrary to law or morality was contained in Section 69 of Indian Patents and Designs Act, 1911. As per the instruction of the patent office, an apparatus for gambling, an appliance for burgling houses or a method of adulterating food would be regarded as an invention contrary to law or morality and it would not qualify as a proper subject matter for a patent. Grant of a patent is not a guarantee to the commercial success of any patent.

Position in the US

In contrast, the US has dealt with such rejection of patents through evolving case law as there was no statutory provision in the patent law to bar such subject matters. Examiners were allowed to use their discretion to adopt morality standards which will vary according to changes in social attitudes. In the absence of clear statutory guidance, a judicially created "moral utility doctrine" *[Lowell v. Lewis, 15 Fed. Cas. 1018 (1817)]* served as a gatekeeper of patent subject matter eligibility. For example, the morally controversial subject matter like artificially spotted tobacco leaves *[Rickard v. Du Bon, 103 F. 868 (2d Cir. 1900)]*, faux-seamed women's hosiery [*Scott & Williams, Inc. v. Aristo Hosiery Co., 7 F.2d 1003 (2d Cir. 1925)]* and gambling devices *[National Automatic Device Corp. v. Lloyd, 40 F. 89, 90 (C.C.N.D. Ill. 1889)]*, were found to be injurious to the morals of society and inventions with a mischievous tendency to deceive the public. Moreover, other similar inventions like the card-playing slot machine [*Reliance Novelty Co. v. Dworzek, 80 F. 902, 904 (C.C.N.D. Cal. 1897)]*, a coin return device for slot machines [*Schultze v. Holtz, 82 F. 448, 449 (C.C.N.D. Cal. 1897)]* and a lottery vending machine [*Brewer v. Lichtenstein, 278 F. 512, 514 (7th Cir. 1922)]* patents were denied by courts by applying the moral utility doctrine. These inventions were denied patent protection by the USPTO and the US courts under the premise that patents on such inventions were not useful, treating usefulness as the one in which the use implies sound morals and policy do not discountenance or prohibit. The 1977 decision by the Board of Appeals in *Ex parte* Murphy [200 U.S.P.Q. (BNA) 801 (Bd. Pat App. & Int. 1977)] gave a blow to the moral utility argument when the Board ruled that an invention used solely for gambling could be patentable noting that while gambling could be considered injurious to public morals, there was no justification for denying a patent on a gambling device based on lack of utility and stating that the PTO should not dictate a morality standard through the utility requirement. No court has relied upon Lowell for the moral utility principle during the latter half of the 20th century. However, the USPTO states that inventions that are offensive to public morality cannot be patented. In recent times, the principle that inventions are invalid if they are principally designed to serve immoral or illegal purposes has not been applied broadly by the USPTO.

Position in EPO

In 1977, when USPTO had almost shed its moral utility doctrine, the issue of bioethics propped up in relation to emerging biotech inventions. It was the time when the draft of the European Patent Convention was discussed and incidentally the issue of public order and morality exceptions to patentability were also debated. These deliberations resulted in the inclusion of Article 53(a) with a broadly agreed draft that European patents shall not be granted in respect of:

"*Inventions the commercial exploitation of which would be contrary to "ordre public" or morality; such exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;"*

To meet the requirement of Article 53(a) relating to the exclusion of certain biotechnological inventions and in order to give "*ordre public or morality"* a meaning, Rule 28 was introduced to clarify which categories of biotechnological inventions will fall under these exceptions:

> *"(1) Under Article 53(a), European patents shall not be granted in respect of biotechnological inventions which, in particular, concern the following:*
>
> *(a) processes for cloning human beings;*
> *(b) processes for modifying the germ line genetic identity of human beings;*
> *(c) uses of human embryos for industrial or commercial purposes;*
> *(d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes."*

It is interesting to note that no patent application was denied invoking Article 53(a). In July 1989, when the EPO Examination division refused a patent on *OncoMouse* on the ground that the EPC did not permit the patenting of animals *per se*, this case was remitted to the examination division by the Technical Board of Appeal on 13 October 1990, which found that the EPC ruled out patents only for certain categories of animals, not for animals as such. Surprisingly, the Board also added that the examination division should also consider whether the invention was contrary to public order and morality within the meaning of Article 53(a). In particular, the suffering inflicted on the animals and the possible risks to the environment had to be weighed against the invention's usefulness to humanity. Eventually, the patent was granted to *OncoMouse.* In this case, the Examination division weighed possible detrimental effects and risks and balanced them against the merits and advantages in the review and concluded that the invention cannot be considered immoral or contrary to public order. The Examination division also stressed that this consideration is only case-specific and other cases are conceivable for which a different conclusion might be reached to apply Article 53(a).

Indian position

It is not surprising to find that most countries around the world introduce the concept of morality into their patent laws including India, particularly after the signing of the TRIPS agreement. The exclusion of patent on grounds of morality/contrary to public order/ injurious to health or environment are contained in Section 3(b) which reads:-

> *"An invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality* ***or which causes serious prejudice to human, animal or plant life or health or to the environment."***

In this section, the phrase "*or which causes serious prejudice to human, animal or plant life or health or the environment"* was added with effect from May 2003. Before this, *"an invention the primary or intended use or commercial exploitation of which could be contrary to law or morality or injurious to public health*", was considered non-patentable. The latter phrase was intended to clarify and specify the coverage of the meaning of the words 'morality or injurious to public health'. A closer look at the later phrase reveals that this clause takes its language from Article 27(2) of the TRIPS agreement. Further, this position on public order or morality appears similar to Article 53(a) of the European Patent Convention which came into existence only in 1977.

Judicial understanding of morality

In absence of any judicial ruling in patent applications in India or elsewhere, it would be

The outrage or censure must be amongst an identifiable section of the public.

Nick Beer / Shutterstock.com

> **It is expected that on no account the examiners should allow their personal beliefs to color their judgment on such matters.**

useful to resolve the morality and public order issues by following what is aptly stated by Thorley Q.C. in a trademarks case ([2002] E.T.M.R. 57):

> *"31 In my judgment the matter should be approached thus. Each case must be decided with on its own facts. The dividing line is to be drawn between offence which amounts only to distaste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values. The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice."*

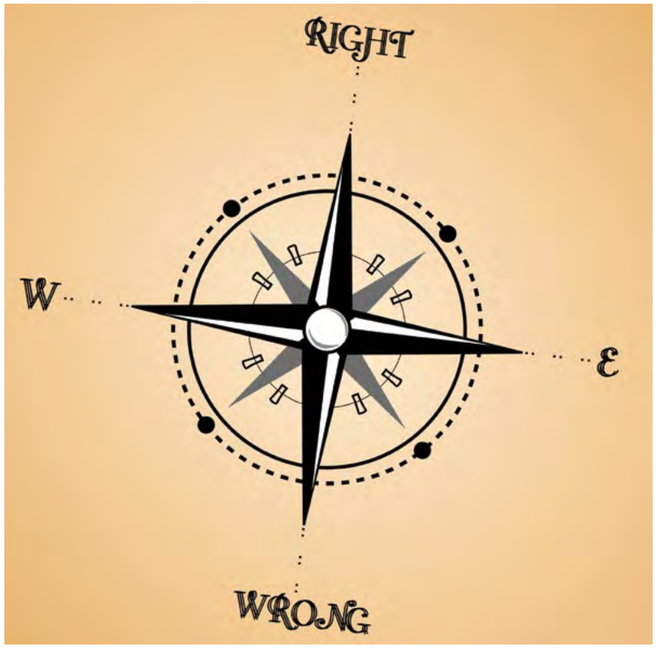
The examiner may look to invoke the concept of right-thinking members of the public as done by Aldous J. in Masterman's Design Application ([1991] RPC 89). These approaches could be helpful. A right-thinking member may themselves not be outraged but will be able, objectively, to assess whether or not the subject matter of the patent in question is calculated to cause the "outrage" or "censure" amongst a relevant section of the public. The matter must be approached objectively. The objective test referred to here makes it clear that mere distaste or offence is insufficient. The outrage or censure must be amongst an identifiable section of the public and in words of Aldous J:

> *"A higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice."*

Since the language of present Section 3(b) speaks about intended or commercial exploitation, we can infer that if its exploitation, in general, would be expected to encourage offensive, immoral, or antisocial behavior then the provision of non-patentability would apply. This test is flexible as public morality is affected by time, place, and social values. This test should be applied by subjecting the matter through the eyes of the "right-thinking" member of the public. It is expected that on no account the examiners should allow their personal beliefs to color their judgment on such matters.

Conclusion

Indian patent law was designed more than 100 years ago to meet the simpler needs of the growing industrial reach and uses for the consumers. As a safeguard, an undifferentiated and one-size-fits-all approach was adopted to keep invention contrary to public policy or morality away from the monopoly net. The purpose of these provisions was to prevent the grant of patent rights for inventions for which the general public would regard as abhorrent or from which the public need protection. It means it provides for the applicability of a reasonably objective test that must be applied to each invention based on its set of facts and circumstances. There seems to be no difficulty in adopting the statutory route to exclude such categories of a patent outside the patentability net as done by India, the UK, EPO and many other countries but the legislature should restrict subject matter eligibility by explicitly promulgating a fast-track process for challenging patents on moral grounds. This would save the examiner from using his discretion arbitrarily and avoid unnecessary criticism. This would also save the examiner from being subjected to criticism of possible misuse of invoking Section 3(b) on moral or ethical grounds. The doctrine as decisions of IPO would be then based on contested and subjective moral harms. After all, what constitutes moral harm in India is not delineated in large part due to the sparseness of legislative guidance on the matter. The Indian provision under Section 3(b) in any case does not look to the degree of utility it simply requires that the intended use is such as sound morals and policy do not discountenance or prohibit. The only question albeit a bit difficult one to answer remains, shall we allow the market to dictate how much use an invention would get and shall patent law's role be limited to screen out inventions that could be used immorally to harm the public or damage public health or environment? In Europe, this exception applies to only biotech inventions but in the Indian context, it applies to all other inventions including biotechnology. The Indian approach is a convenient mix of the US approach and European approach which interprets Section 3(b) to have wider coverage than a possible narrow legislative intent. It is expected that on no account examiners should allow their personal beliefs to color their judgment on such matters. This raises concern about the expanse of these terms and the goal of a morality clause like addressing public health and safety, animal welfare, environmental protection, the preservation of genetic diversity, and so on. Since the language of present Section 3(b) speaks about the intended or commercial exploitation, we can infer that if its exploitation, in general, would be expected to encourage offensive, immoral, or antisocial behavior, provision of non-patentability would apply. This test is flexible as public morality is affected by time, place and social values. This test should be applied by subjecting the matter through the eyes of the "right-thinking" members of the public. In absence of clear guidelines, all inventions are seen with the lens of morality and objection are raised to their patentability under Section 3(b). Legislative intent on morality exception to patentability appears to be related in exceptional cases. An expert opinion would be helpful to deal with such objections raised by IPO as morality would remain an important consideration of the examiner who acts as the moral gatekeeper of the patent system.



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> **The purpose of these provisions was to prevent the grant of patent rights for inventions for which the general public would regard as abhorrent or from which the public need protection.**

An interview with Anna Molony: UK & European Patent Attorney, Founder and Director of Two IP

Anna sits down with *The Patent Lawyer* to discuss the new breed consultancy model that is Two IP and the benefits this alternative model brings to attorneys under the ecosystem and clients alike.

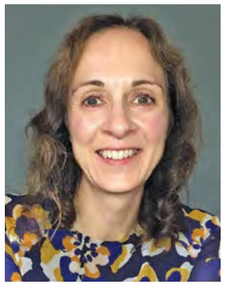
Can you start by telling us about yourself and your career so far?

I grew up in Edinburgh, then I came down South to go to university at Birmingham University where I did my physics degree. I had a year back in Scotland in St. Andrews to do my Master's degree and then back down to Birmingham, across town to Aston University, where I did my PhD. I've been in the Midlands ever since, in Derbyshire and now in Warwickshire.

When I'm not working, you can usually find me playing flat green bowls! In addition to running a business I'm actually also the Senior Independent Director of Bowls England, which is the national governing body for lawn bowls in England.

I joined the profession in 1996 and I trained in private practice in the Midlands. Then I became in-house IP counsel at a university spin out, actually from my old research group at Aston University. I did that for a couple of years and then the company was bought by one of our customers and I was made redundant. I took that opportunity to set up my first patent firm, Chapman Molony with Helga Chapman. We grew the firm pretty fast. We went from just the two of us to 10 attorneys, support staff, secretaries and personnel in about seven-or-eight-years. It was hard work growing that fast, with long hours, lots of stress, the traditional high billing targets and then some, and, to be honest, after about nine years I'd had enough.

So, I sold my shareholding and I started again. I knew that this time around I wanted to do things differently. I only wanted to work for a small number of clients. Basically, I wanted to have a life as well as work because before then it really had mainly just been work!



Anna Molony

> **It's better for the attorneys but we also feel that it's better for the clients.**

Can you tell us about Two IP and the vision behind the company?

It comes from having set up on my own and going through that pain of working out how to have a life as well as work. Various people have said to me since that it looks like I've got the whole work/life balance thing sorted and that they'd like my life… at which point I do normally chuckle and tell them that there was a whole lot of pain getting to this point and that they may not have wanted my previous life!

But one time it struck me that there must be other patent attorneys who have also had enough of the stress and the long hours of work at a traditional firm, but who don't have the experience to set up on their own. I guess I had a lightbulb moment that I could use my experience of setting up and growing two patent firms to provide somewhere that enables other attorneys to live and work like I do.

Two IP is a new breed consultancy model patent and trademark firm. We believe in thinking differently so we've designed what we believe is a better way of working that gives patent and trademark attorneys that ability to have a real work/life balance - and by work/life balance I mean more life, less work. We do that by enabling attorneys to work for themselves, but they don't do it by themselves. Our consultants are self-employed, but they operate within the Two IP ecosystem and under our brand. They work for their own clients while benefiting from the experience of our team and the support of the Two IP ecosystem. We have all the traditional back-office formalities, everything you'd expect, plus we provide consultants with ongoing business development advice and support.

So, I guess I'd say the vision would be to provide somewhere where other attorneys can achieve that lifestyle of more life and less work - to set them free from the traditional model.

> **At Two IP, consultants work whatever hours they want, where they want, for the clients they want.**

What makes your services different from other full-service IP Firms?

Firstly, I'm glad that you realized that we are a full-service IP firm - we absolutely are! As far as the clients are concerned, they get everything that they would expect from any full-service firm. In fact, the service that clients receive benefits from the way that we're structured by enabling attorneys to have much more time, all the time they really need, to get to know their clients: what the client wants to achieve, what's important to them, what the client requires from them as an attorney. The attorneys have more time to plot the best course of action for their clients, do all the thinking, consider all the possibilities and all of the arguments. They can work out how best to protect the innovations and the brands, in a way that benefits the clients the most.

We make this extra time available to the attorneys by taking away all the usual management and supervision distractions that they would have in a traditional firm. So, their core responsibility is to their client's best interest. There are no partners to answer to, there's no trainees to pass work to, to develop, and to be responsible for and our fee-sharing model means they have more time available with each of their clients. We believe that this enables attorneys both to do their best work, the work that they love, for the clients that they want to work for and to develop long-term, strong, mutually beneficial relationships with those clients.

So it's better for the attorneys but we also feel that it's better for the clients.

Who is Two IP for?

Attorney wise, we are a firm for fully qualified, client focused, experienced patent and trademark attorneys. They would enjoy building their client relationships and be driven by a genuine desire to do their best work for the clients that they want to work with. They would want to get rid of all the managerial responsibility and have minimal admin in their lives. Really, if they know that they want complete control of their work life then Two IP is for them. But Two IP is not for everyone. It is for attorneys who realize that in order to have something different they're going to have to take a chance on a firm that does things differently. They can stay in the traditional firm if they want but if you keep on doing what you've always done, you'll get what you've always got.

From a client perspective, Two IP is very much focused on working with clients and companies that understand the value that IP adds to their business and who want to work with the very best people so that they can establish that mutually beneficial long-term relationship with attorneys who take IP just as seriously as they do. I've worked with a whole range of clients over the years and the ones that I think attorneys enjoy working with the most are the ones who really get what IP is for, what it can bring to their business. Those are our ideal clients.

Can you tell us about Two IP's back-office service?

We provide our consultants with everything that you'd expect from a tech-loving, forward-thinking firm. We have a tried and tested, market-leading case management system. I've used quite a number of systems over the years and what we use is the absolute best, developed by patent attorneys for patent attorneys. I love it!

We have a team of qualified, experienced patent and trademark formalities people to support the attorneys and work with the case management system, office 365 IT systems, everything you'd expect when you're joining a new firm! An accounts team; professional indemnity insurance; marketing team.

But what makes us different to a traditional firm is the mentoring and business development support that we give consultants. We know, back to that point, not everybody has mine or our non-executive director or our COO Danielle's experience of developing and growing businesses. So, we take all of that experience of business development from growing previous firms and part of our role is to share that with the consultants to give them the benefit of that experience. We help them create and implement a business growth plan for their own Two IP patent and trademark practice. We provide them with a sounding board so, they can talk to any of us about any aspect of business development but we're also here as mentors from a general business perspective because most of the consultants won't have run their own business before. We'll help them set up their business, we've got friendly accountants who will do all of that, but additionally, we help them actually run their business, if you haven't done it before, it's nice, and I speak from experience, to have somebody who's done it before who you can just drop in to and ask anything about anything when you just need an experienced business

We very much believe in thinking differently. And, as I've said a number of times, we strongly believe that work/life balance means more life, less work.

head. So, as I said before, they're in business for themselves building their own practices in our ecosystem and under our brand, but they're far from being out there on their own. We're here with them, we're supporting, encouraging, enabling them to achieve that work/life lifestyle balance that they've dreamed about before they took what is a reasonably large step for most people to take.

How is the flexibility you offer different to that of traditional firms?

Traditional firms only really offer limited flexibility - you can work part-time hours but still with the constraints of a standard working day. Some now are doing hybrid working, which has been imposed on them and I suspect that most wouldn't have gone that route without the COVID-19 pandemic driving them, by offering a couple of days a week to work from home so attorneys don't have to commute every day. That is all well and good, but you're still doing, generally, a full-time job with a 900+ annual hours billing target, and yes you can flex your start time and your finish time and maybe take a break during the day to squeeze your life in around your work, but that's not real flexibility.

At Two IP, consultants work whatever hours they want, where they want, for the clients they want. Target wise, they decide how much they want to earn and set their target accordingly. It's important to understand, because we operate a fee share model, that consultants keep up to 80% of their hourly billing. This is compared to around a third in traditional firms. This means they can continue to earn the same level of income as they did in their previous traditional firm while working considerably fewer hours, which means they need considerably fewer clients to start with. Or they can choose to earn a lot more money and continue doing the same hours. Consultants can build their Two IP practice as big as they want, but I suspect that most people will settle somewhere in between – less work, more income.

I'd say that flexibility is the wrong word for us; what we offer is complete freedom.

What is the greatest challenge you have faced and how have you overcome it?

I hate these kinds of questions as I'm really not a backward-looking person!

One of the greatest challenges that I've had, the most difficult period of my life, was the last two years of Chapman Molony. I was working such long hours and I was under so much stress for such a long period of time that I basically made myself ill - and I think my partner would probably have said that I wasn't very pleasant to live with at times! But what was going to change? I was a Founding Director of a fast-growing, successful patent and trademark firm, but I didn't want to carry on as I had been - having no life - and eventually I realized that I would have to walk away from it. That was such a hard decision, but it was definitely the right decision. That was probably the biggest challenge I've had to deal with.

What is your greatest achievement so far?

Playing lawn bowls for Warwickshire!

But seriously, building a business that enables me to have a life so that I can do other things like playing lawn bowls for Warwickshire and being on the Bowls England board.

What are Two IP's core values?

We very much believe in thinking differently. And, as I've said a number of times, we strongly believe that work/life balance means more life, less work.

But at the heart of it all is empowerment. We're here to empower consultants to achieve their ideal work/life balance, whatever their ideal looks like to them. I've done it and I want to help others do it as well.

Where does Two IP hope to be in five years?

We are aiming to have a team of successful attorneys, all with their own successful patent and trademark practices, ideally all living their dream lives whilst we continue to be there to support them, empower them and cheer them on.

two ip
INTELLECTUAL PROPERTY

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Diversity, equity, and inclusion with Suzanne Wertheim. Chapter 6: tips for awareness and self-improvement

In this six-part series Dr. Suzanne Wertheim, of Worthwhile Research & Consulting, talks to *The Patent Lawyer* about diversity, equity, and inclusion: what it means; the current challenges; DEI in law; gender bias; and what we can all do to improve.

Often people are unaware that they are being discriminatory or biased. What measures can be put in place to help overcome this? What can be done?

I like to help organizations create what I call bias interrupters. You can't trust your brain when it's making a quick decision - even if it's a decision about safety. We've been trained to think of some people as way more dangerous than they are. Let me give you an example. I live in a very diverse city, and one time a friend of mine called me right after she left my house. She's Black, and she called me from her car and said, "Girl, your neighbor just clutched at her purse as I walked by her."

She's my friend, she looks like many of my neighbors, she was raised in a middle-class home, and she's got two Master's degrees. The last thing she's thinking about is mugging my neighbor. And she has every right to be walking down my street. She belongs here in every possible way.

So even our judgments about our physical safety can be off because of the skewed data that our brains have received over the years. I imagine my neighbor has seen countless hours on the news and tv and movies where Black people were presented as criminals, and very few hours where they were presented as people just like her. And that she doesn't have Black friends, since American friendship groups are generally very segregated. So she clutched at her purse in fear. And my friend laughed it off, but I'm sure it bothered her. She can't even visit a friend's house without someone telling her she's less than, that she's scary, that she's probably a criminal. For many of us, that simply isn't part of our day.

Dr. Suzanne Wertheim

Checklists and protocols can help you stay safe and shut down bias as it appears.

When it comes to bias interrupters, I like to use the analogy of pilots and airplane safety. When pilots are preparing to fly a plane, they use a safety checklist for every single flight. It is thorough, and if the plane doesn't pass every required point on the checklist, it doesn't take off.

We need safety checklists at work in the form of bias interrupters. There needs to be a bias interrupter for writing your job ad, for evaluating candidates, for allocating work, for promotions, for running meetings, and more. We can't trust our instincts, because our instincts are usually biased. So we need a safety checklist to make sure we're finding the bias and interrupting it. For example, there is an excellent chance that your female readers and their female colleagues are being talked over or frequently interrupted in meetings. If you have a bias interrupter that gives you best practices and tools to shut down those interruptions and get those women the conversational floor once more, well then, you've made the workplace more equitable and shut down a super common form of bias that consistently harms women's careers. You can't assume the equivalent of, "I know how to fly a plane, and everything looks all right - let's take off!" A pilot wouldn't do it, and you shouldn't either. Instead, checklists and protocols can help you stay safe and shut down bias as it appears.

What tips would you give to recruiters and companies for encouraging inclusion from the point of application?

The first thing is to watch your language. I have an e-learning course on LinkedIn Learning and

"We need safety checklists at work in the form of bias interrupters. There needs to be a bias interrupter for writing your job ad, for evaluating candidates, for allocating work, for promotions, for running meetings, and more."

Cornerstone on Demand. In this course, which is based on courses I developed for clients looking to diversify their hiring, I explain the importance of inclusive language and why you should care. I point out the real-world negative consequences that come if you don't use inclusive language. I give the six principles of inclusive language and some high-impact substitutions. Finally, I go through some words and phrases you really should avoid at work, and some easy and more inclusive substitutes to use in their place. This course can be applied directly to recruiting and hiring and starts with the language of your job listings. Just reading a brief job ad can tell people from underrepresented groups if your organization is a place where they're going to be safe and thrive.

For example, if you put too many requirements in your job posting, women will often not apply. Multiple studies have shown that women will apply for a role when they feel they are 100% qualified (and sometimes not even then), while men will apply when they're about 60% qualified. So the longer your list of requirements, the lower the chance that you'll get female applicants. Or if the job posting uses words like 'rock star' or 'ninja,' that job codes as masculine and also suggests an aggressive environment. So again, you will lose a whole set of qualified applicants.

And even to this day, I see job ads where they will use masculine pronouns as if they are universal. So a posting might say, "We're looking for an engineering director. *He'll* have to supervise around five guys…" Guess who's not going to apply for that job? People who don't identify as male. Because they know that they aren't even being conceptualized as someone who can and should fill that role.

When it comes to DEI statements and website materials, I recommend that companies be transparent about where they are when it comes to Diversity, Equity, and Inclusion. People are reading your entire website with a critical eye, and if they see a statement about how important diversity is and then the rest of the website is pretty much white men, especially at the top, you've lost their trust. Instead, it's helpful to have something realistic on your website. It can say something like: DEI is a genuine priority for us, and although we're not yet where we want to be, we have a plan. We're working on training; we're working on action plans; we have goals, and we're happy to talk about them with you. We're actively looking for people from underrepresented groups, and we want to make this a place where you can thrive.

But it has to be true. If people are taking the time to apply, they are doing their due diligence and checking you out! I have seen some very highly sought-after people in tech, especially women of color, tweet openly about their job search process. They'll say things like, "Well, the recruiter reached out to me about this firm and I'm looking at their website and I'm like, 'absolutely not!'" And then, without naming the company, they list all the red flags visible on the website that let them know – this is absolutely not a place for me. A company may claim to want women of color, but then is clearly not setting them up for success. So, find out what the red flags are for the kinds of people who are currently underrepresented at your organization and work to fix them.

What three tips would you give to everyone to help encourage equity and inclusion?

1) Educate yourself. Don't overburden people who are already burdened by bias to also educate you and not make you feel bad while you're getting educated. This is incredibly common and makes life even harder for people who are the targets of bias. Take responsibility for your own education. There are lots and lots of books out there, not to mention videos, movies, and podcasts.
   As you educate yourself, take responsibility for your own emotions. As you start to see the world more clearly, as you acquire the X-ray vision I talked about earlier, you might start to feel really bad. Because unfairness is rampant and miserable outcomes are everywhere. You might get in touch with the pain of the world and be like, "This is so rough." It's fine to feel sad as you feel the weight of the injustice around you. But, as you're educating yourself, don't lay that new-found pain on people you know who are targets of bias. Don't call them and say, "Oh my God, I just learned about this, it's so terrible!" The person you called might just be living their day and now you've dumped all this trauma and pain on them. Trauma and pain that affects their everyday life way more than it affects yours. So you've got to be responsible for both your own education and your own emotions.

2) Diversify your social media. This is such a light lift! It gives great results, and it's so painless. It's like eavesdropping on people. You can get so much information without really intruding on anyone. Look at the various social media platforms you're using and think about identity categories. You can even make a list of the kinds of people who are missing - and then go find them and add them to your feeds. This can also work on streaming content platforms with television shows and movies. Whose perspectives are you missing? Watch movies and shows made by those people. And it doesn't have to be heavy and traumatic stuff – feel free to go for a sitcom (if there is one).
   Social media has been really useful for me as a source of data. I am often surprised by the perspectives that I see there – people point out things or have opinions that aren't at all what I would have predicted. It's a great reminder that my perspectives are inherently limited. I follow people who are activists in different communities, for example, people that write a lot about disability. For some reason, disability is an identity category that I am less attuned to than others. So it's genuinely helpful for me to go on Twitter and see people say something I hadn't considered or had forgotten about. Not to mention, some people are just producing really fun stuff.
   You can also spend a month doing a deep dive and reading fiction specifically about a group – and it should have been written by members of that group. For example, read novels where the main characters are all part of the South Asian diaspora. You can even cook recipes specifically from a certain culture and it makes it fun to learn more.

"Let's say you devote an hour a week to educating yourself and practicing something new. By the end of the year, you'll have a lot more knowledge."

3) Create your own bias interrupters. This is more work than the first two, and you'll want to be careful. For example, let's think about pronouns. Say somebody in your workplace comes out as non-binary or somebody gets hired and they're non-binary. Wouldn't it be great if you had already practiced? And you were already comfortable saying *they* and *them* to refer to someone? One way you can do this is by telling stories about a non-binary celebrity and having someone check up and make sure you're consistently using they/them.

It doesn't have to take lots of time to implement these tips. Let's say you devote an hour a week to educating yourself and practicing something new. By the end of the year, you'll have a lot more knowledge. Especially if you've been complementing your self-education with a more diverse social media feed, more diverse film and tv consumption, and more diverse books. Then you just keep on going with these new practices, because this is a lifelong journey. New categories and new language will emerge, and you will want to keep up to date so you can say and do the right thing.

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SIPI Law Associates is a boutique commercial law practice in Uganda, with a bias to Intellectual Property Law. Our IP advisory services cover all transactional aspects of Patents, Trademarks, Copyright, Industrial designs, Trade Secrets and licensing aspects. The firm philosophy is based on providing first class legal services based on the integrity of our staff, giving our clients sound legal and timely advice, as well as holding our clients' information in the utmost confidentiality.

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UKRAINE

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Pakharenko & Partners provides full IP service coverage in Ukraine, CIS countries and Baltic states and has offices in Kyiv and London. We pride ourselves on an exclusive expertise and experience in the fields of IP law, anti-counterfeiting and anti-piracy, pharmaceutical law, competition law, advertising and media law, corporate law, litigation and dispute resolution.

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VIETNAM

Annam IP & Law

ANNAM IP & LAW is one of the most professional Intellectual Property & Law Firms in Vietnam, member of APAA, INTA and VIPA. We provide our clients with a full range of IP services to protect their inventions, trademarks, industrial designs and related matters not only in Vietnam, but also in Laos, Cambodia, Myanmar and other jurisdictions. We also provide our clients with legal advices on Finance and Corporate and Business Law.

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Established in 1991, staffed by 110 professionals including 14 lawyers and 34 IP attorneys, Pham & Associates is a leading IP law firm in Vietnam. The firm has been being the biggest filers of patents, trademarks, industrial designs and GIs each year and renowned for appeals, oppositions, court actions, out-of-court agreements and handling IP infringements. The firm also advises clients in all aspects of copyright and other matters related to IP.

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Tri Viet & Associates

Tri Viet & Associates is a registered and fully licensed IP & LAW FIRM based in Hanoi, Vietnam. The firm provides a full range of IP services, strongly focuses on PATENT and PCT services, in a wide range of industries and modern technologies, in Vietnam, Laos, Cambodia, Myanmar, and other jurisdictions upon client's inquiries.

Tri Viet & Associates is a member of AIPPI, INTA, APAA, VBF, HBA, VIPA.

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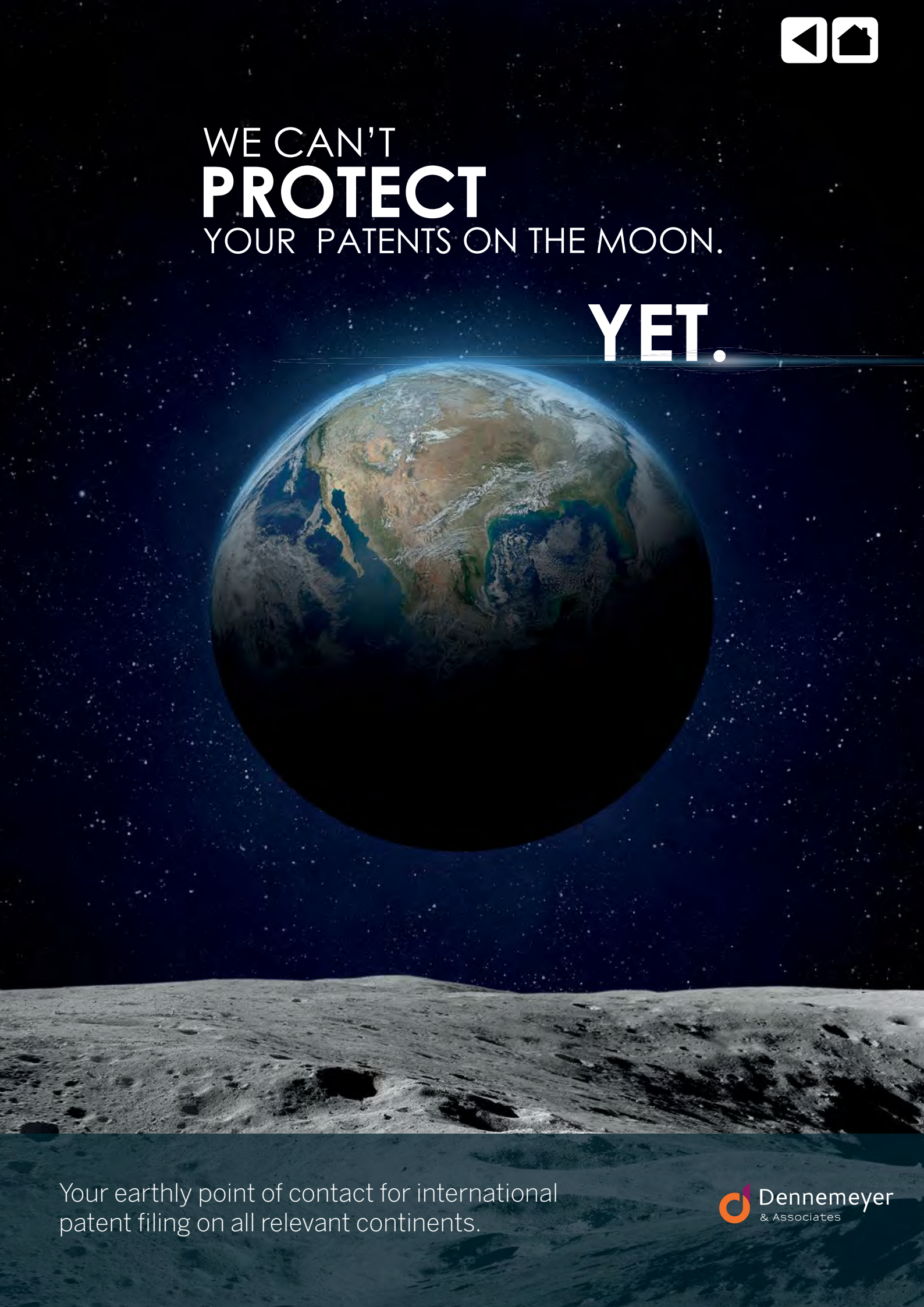
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