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Asia IP Symposium 2026

Tokyo, Japan / Thursday, February 26, 2026

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Navigating the Changing IPR Landscape

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Education

J.D., St. John's University 1996
magna cum laude

B.S.E.E., State University of New York at Stony Brook 1988

Admissions

District of Columbia

New York

United States Patent and Trademark Office

Virginia

Jim leads DLA's post grant review practice and regularly represents clients in patent litigation in district courts and the ITC, where he typically serves as the technical lead attorney. In these roles, Jim directs inter partes review strategy in order to achieve maximum impact in the parallel proceeding. Jim's work focuses on electrical, computer, cellular and networking technologies, including encryption technologies, conditional access television systems, computer operating system software, touchscreens, electronic train control and signaling systems, power tools, and semiconductors. He has been recognized by Patexia as being among the Best Performing and Most Active attorneys representing petitioners in inter partes review proceedings before the PTAB. He also counsels clients regarding patentability, validity and infringement issues.

Roadmap

1. Key Players and Philosophy
2. Statistics
3. Procedural Changes
4. IPR Barriers
5. Techniques for Avoiding the IPR Barriers

Key Players and Philosophy

Coke Morgan Stewart

Deputy Under Secretary of Commerce for Intellectual Property
Deputy Director of the U.S. Patent and Trademark Office

Background

- Worked at USPTO from 2011-2021
  - Acting Chief of Staff
  - Counsel to the Director
  - Senior Policy Advisor
  - Acting Deputy Solicitor

- IP Attorney at O'Melveny & Myers LLP
  - represented both patent holders and accused infringers in patent infringement cases

Howard Lutnick

Secretary of Commerce

Background

- Chairman and CEO of Cantor Fitzgerald, L.P.
- “As the inventor of over 400 patents, the U.S. Patent and Trademark Office has a special place in my heart”

US012282884B2

(12) **United States Patent**
Lutnick et al.

(10) **Patent No.: US 12,282,884 B2**
(45) **Date of Patent: *Apr. 22, 2025**

(54) **EXAMPLES OF DELIVERY AND/OR REFERRAL SERVICES**

(71) Applicant: **CFPH, LLC**, New York, NY (US)

(72) Inventors: **Howard W. Lutnick**, New York, NY (US); **Jed Kleckner**, New York, NY (US); **Colin Sims**, New York, NY (US); **Jason White**, New York, NY (US)

(73) Assignee: **CFPH, LLC**, New York, NY (US)

(51) **Int. Cl.**

G06Q 10/08	(2024.01)
G06Q 20/20	(2012.01)
G06Q 30/04	(2012.01)
G06Q 30/0601	(2023.01)
G06Q 30/08	(2012.01)

(52) **U.S. Cl.**
CPC ***G06Q 10/08*** (2013.01); ***G06Q 20/202*** (2013.01); ***G06Q 30/04*** (2013.01); ***G06Q 30/0635*** (2013.01); ***G06Q 30/08*** (2013.01)

(58) **Field of Classification Search**

John Squires

Under Secretary of Commerce for Intellectual Property
Director of the U.S. Patent and Trademark Office

Background

- Dilworth Paxson LLP
  - chair of the Emerging Companies and IP practice
- created Fortress IP
  - a multibillion-dollar patent litigation funding group
- Chief IP Counsel for Goldman Sachs (2000-2009)
  - Senate testimony: “[p]atent examination quality issues, predatory patent assertions, and litigation abuse have precluded continued progress and efficiencies in bettering the U.S. financial system.”

Philosophy

"Even extremely strong patents become unreliable when subject to serial or parallel validity challenges"

"Consider a hypothetical patent claim where 70% of experienced patent practitioners would conclude that the claim was properly granted, and 30% would oppose that conclusion. Such a patent claim seems reliable, because a substantial majority of practitioners believe it is patentable and was properly issued. However, if the patent is subjected to repeated *de novo* patentability review each time it is enforced, it will no longer be reliable. For example, a patent with a 70% chance of surviving one *de novo* patentability review has less than a 50% chance of withstanding two or more *de novo* patentability challenges. *Thus, even extremely strong patents depend on a presumption of validity for their survival."*

2025-19580 (90 FR 48335)(emphasis added)

Philosophy

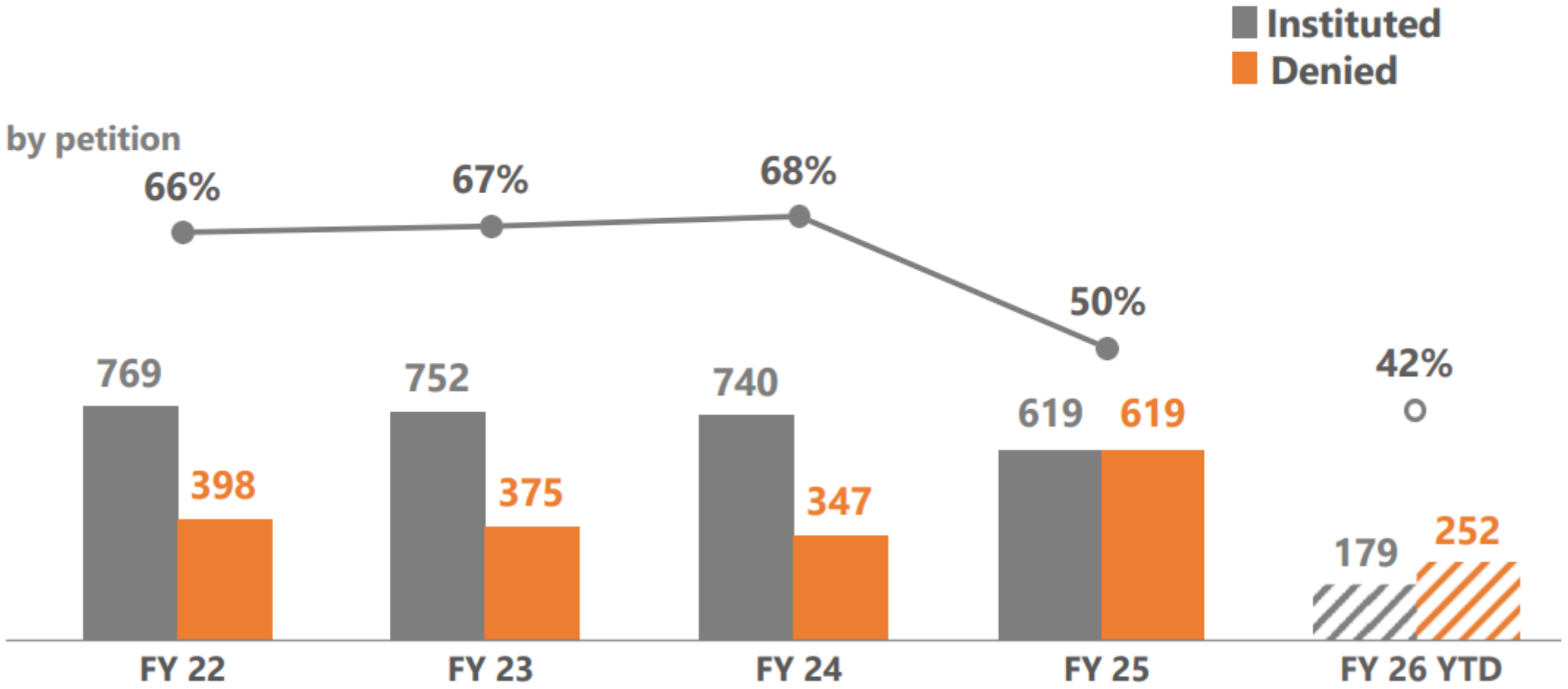
"Even extremely strong patents become unreliable when subject to serial or parallel validity challenges"

- United States District Courts are **not** *de novo* review
  - Presumption of validity
  - Clear and convincing evidence of invalidity required
- PTAB IPRs/PGRs are *de novo* review
  - No presumption of validity
  - Preponderance (<50%) evidence of invalidity required
- Solution: Limit IPRs and PGRs

Statistics

Institution rates by petition

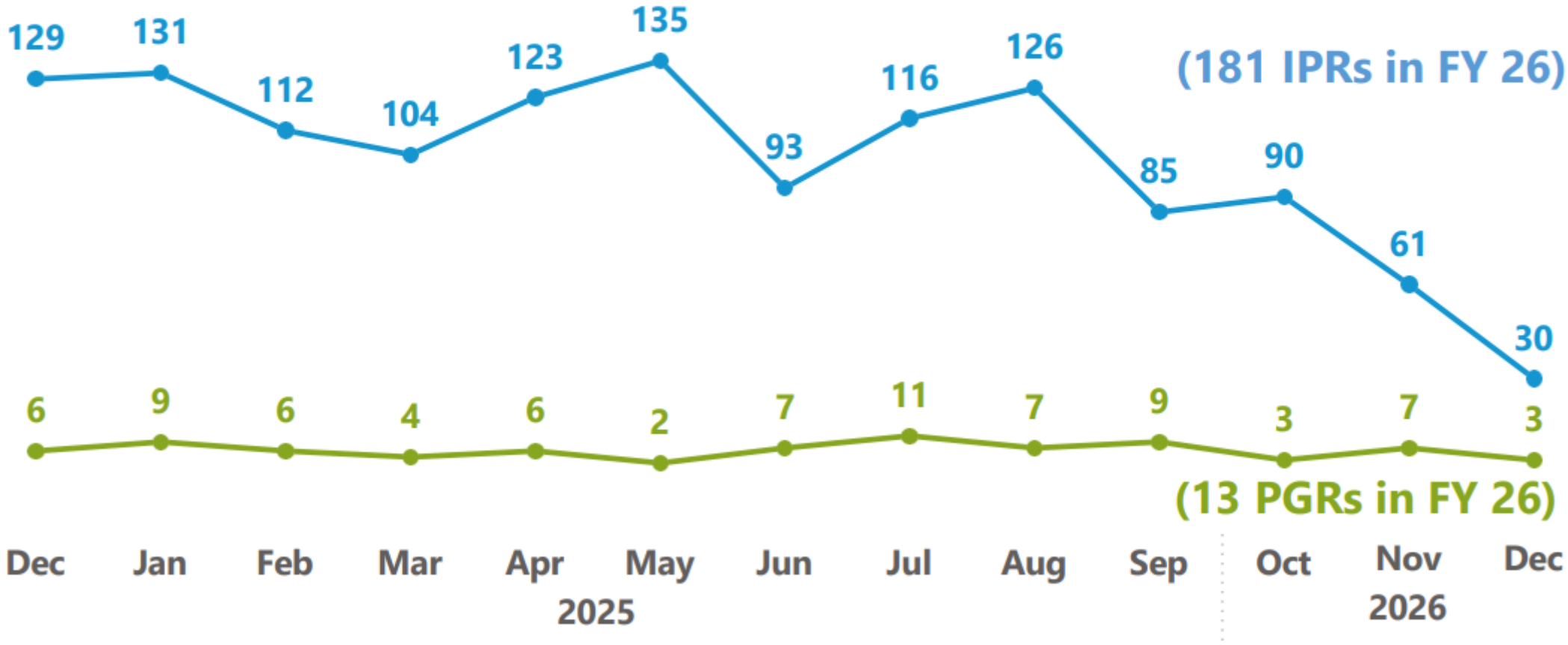
FY 22 to FY 26 through Q1: Oct. 1, 2021 to Dec. 31, 2025



PTAB Trial Statistics, December 2025, Patent Trial and Appeal Board, *available at* https://www.uspto.gov/sites/default/files/documents/trial_stats_december_2025.pdf

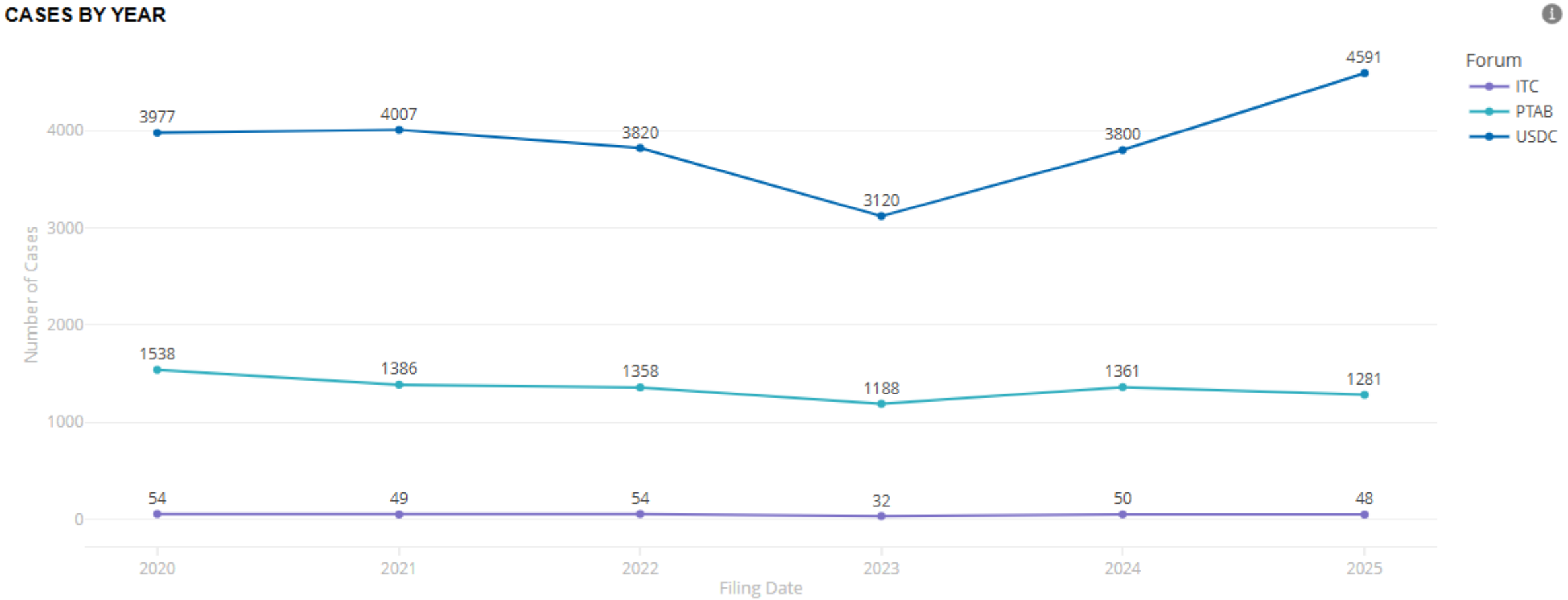
Petitions filed by month

FY 25 to FY 26 through Q1: Dec. 1, 2024 to Dec. 31, 2025



PTAB Trial Statistics, December 2025, Patent Trial and Appeal Board, *available at* https://www.uspto.gov/sites/default/files/documents/trial_stats_december_2025.pdf

Patent Litigation Filings Are Up



DocketNavigator

More Statistics

Institution rate

- 37% from 1 Oct. 2025, through 30 Nov. 2025
- 64% from 1 Oct. 2024, through 30 Nov. 2024

Number of IPRs/PGRs filed

- 240 IPRs and PGRs were filed from 1 Oct. 2025, through 2 Feb. 2026
- 482 IPRs and PGRs were filed from 1 Oct. 2024, through 2 Feb. 2025.

- 66% increase in reexam requests
  - 726 in 2025
  - 437 in 2024

More Statistics

Institution rate

- 37% from 1 Oct. 2025, through 30 Nov. 2025
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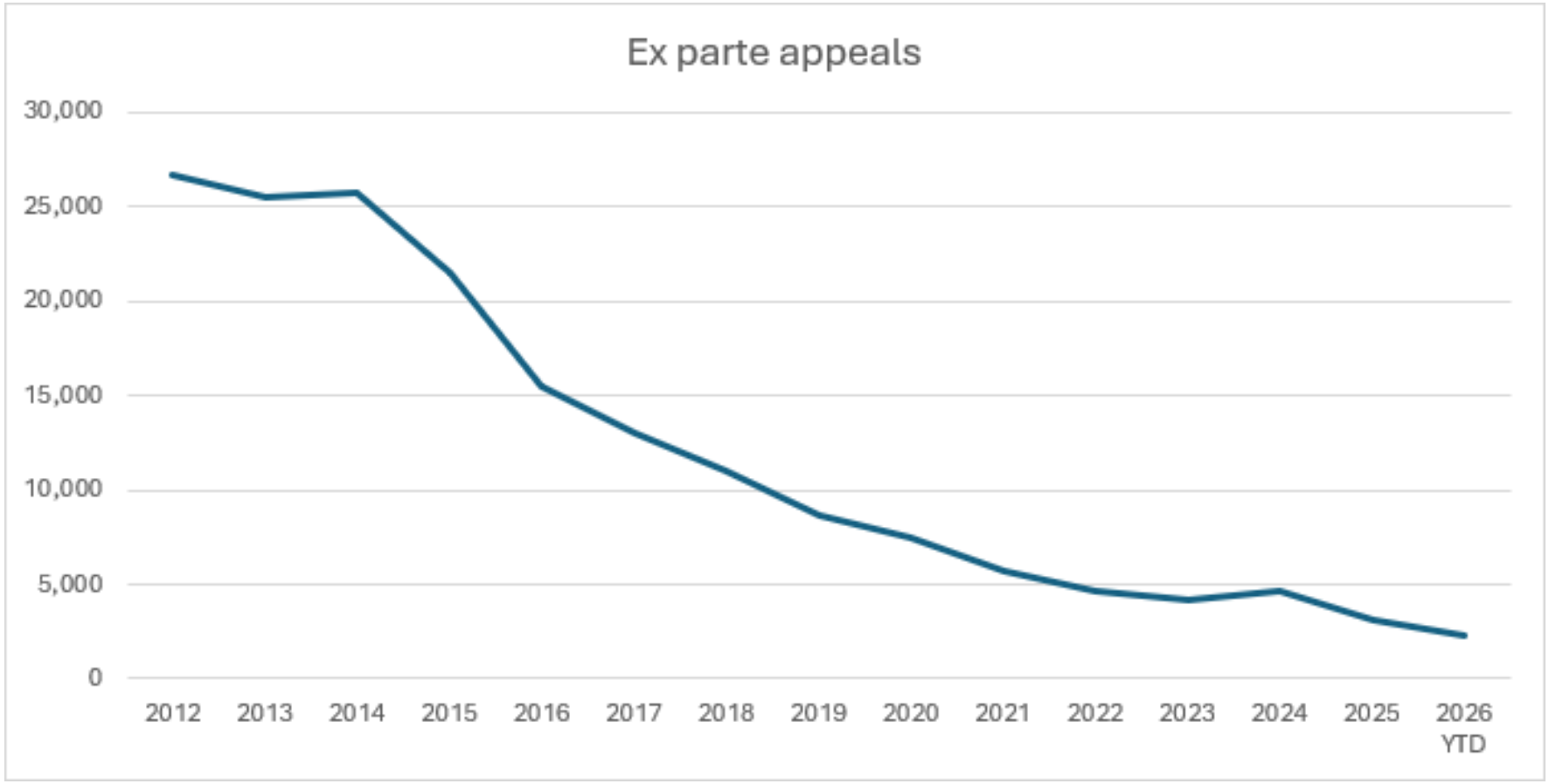
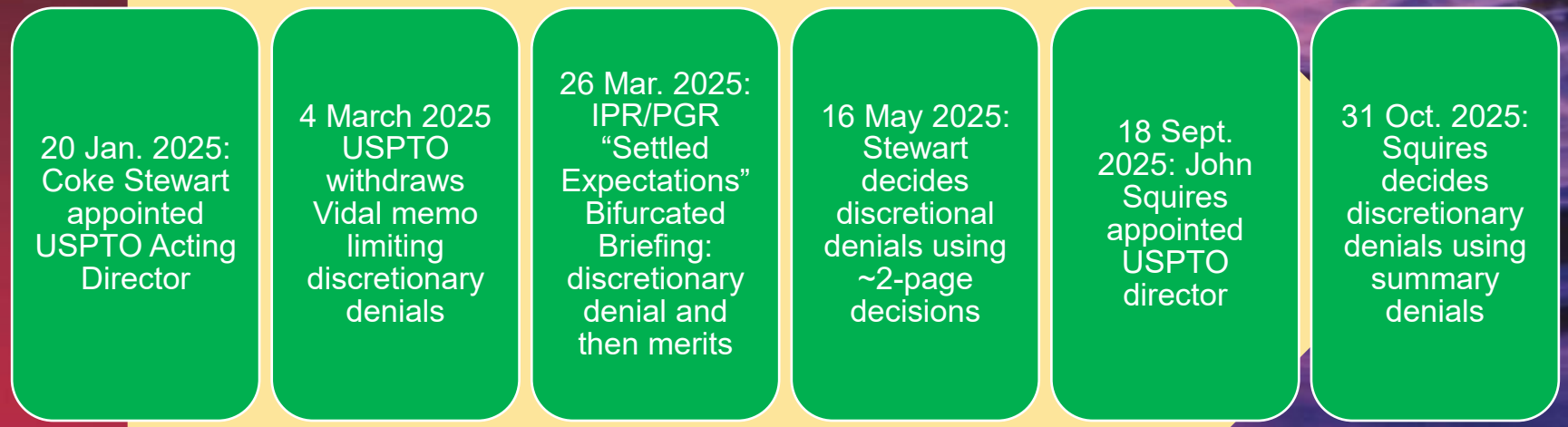
Ex Parte Appeal Backlog On Track to End This Year



What effect will this have on APJ staffing levels?

2025 Procedural Changes

Discretionary Denial Procedural Change History 2025



Discretionary and Merits Denial Decisions Bifurcated

[D]ecisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations . . . the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of institution is appropriate. If it is appropriate, the Director will issue a decision denying institution. If it is not appropriate, the Director will issue a decision regarding that determination and refer the petition to a three-member panel of the PTAB [which] will then handle the case in the normal course including by issuing a decision on institution addressing the merits and other non-discretionary statutory considerations.

https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf

IPR Barriers

Fintiv Is Again a Significant Hurdle

- *Sotera* stipulations no longer automatically precludes discretionary *Fintiv* denials
- Compelling merits no longer automatically preclude discretionary *Fintiv* denials
- "Holistic assessment" based on six factors
  - District Court trial date is predominant factor
- ITC investigations are again considered in Fintiv analysis

Dabico Airport Sols. Inc. v. AXA Power ApS, IPR2025-00408, Paper 21 at 2-3 (PTAB 18 June 2025) (designated informative 9 Jan. 2026

“Settled Expectations” typically preclude IPRs

Although there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be. Moreover, patent applications (after 18 months) and issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests. Interested parties may find published patents and patent applications using the Office’s automated search systems as well as publicly available resources on the Internet. As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations.

Dabico Airport Sols. Inc. v. AXA Power ApS, IPR2025-00408, Paper 21 at 2-3 (PTAB 18 June 2025) (designated informative 9 Jan. 2026

Settled Expectations - Six Years After Patent Issuance

The patents challenged in IPR2025-00601 and IPR2025-00602 present different circumstances. In particular, the challenged patents have been in force for seven and six years, respectively, creating strong settled expectations for Patent Owner, and Petitioner does not provide persuasive reasoning why an inter partes review is an appropriate use of Board resources.

Amgen Inc. v. Bristol-Myers Squibb Co., IPR2025-00601, -00602, -00603, Paper 9 at 3 (PTAB 24 July 2025) (designated informative 9 Jan. 2026)

Settled Expectations Can Arise Earlier than Six Years

[T]he patent challenged in IPR2025-00603 has not been in force for a significant amount of time (issued in 2022). Although there may be good reasons why a patent owner has strong settled expectations in a patent that has only been in force for three years, for example an explanation of how an extraordinary amount of investment, time, and resources dedicated to research, development, trials, and regulatory approval correlates to settled expectations, Patent Owner has not sufficiently articulated such reasons in these proceedings.

Amgen Inc. v. Bristol-Myers Squibb Co., IPR2025-00601, -00602, -00603, Paper 9 at 2 (PTAB 24 July 2025) (designated informative 9 Jan. 2026)

Time-Barred Petitions Proceed Only in Exceptional Circumstances

Although § 315(b) permits time-barred parties to file a petition when seeking joinder under § 315(c), the Office may consider whether it is fair to permit a time-barred party to join an ongoing proceeding when determining whether to exercise discretion to deny institution under 35 U.S.C. § 314(a). Petitions filed by time-barred parties should proceed only in exceptional circumstances. Realtek does not present an exceptional circumstance here.

Realtek Semiconductor Corp. v. ParkerVision, Inc., IPR2025-00324, Paper 11 at 3 (PTAB 25 June 2025) (designated precedential 9 Jan. 2026) (internal citations omitted)

Inconsistent Claim Constructions in IPR and District Court Will Likely Result in Discretionary Denial

[I]t is likely that a final written decision in this proceeding will issue before a district court trial occurs . . . the challenged patent has not been in force for a significant period of time (issued in 2024). Accordingly, Patent Owner has not developed strong settled expectations . . . Petitioner has taken different claim construction positions in this proceeding and the parallel district court proceeding . . . Although a party is not necessarily precluded from arguing different claim construction positions before a district court and the Board, a party should explain why different positions are warranted. For example, if a party advances a narrow construction in the district court and the district court declines to adopt the narrow construction, the party would have sufficient reason for advancing the broader, court-adopted construction in a proceeding before the Board.

Sun Pharm. Indus., Inc. v. Nivagen Pharm., Inc., IPR2025-00893, Paper 18 at 2-3 (PTAB 19 Sept. 2025) (designated informative 9 Jan. 2026)

Inconsistent Claim Constructions in IPR and District Court Will Likely Result in Discretionary Denial

Petitioner's explanation here amounts to nothing more than an assertion that a petitioner should be permitted to raise different claim constructions in the two forums when there is a chance that the district court will reject that petitioner's preferred construction. My precedential decision does not provide for conditional future outcomes, and while petitioner would no doubt like to 'wait and see,' we cannot and will not. The appropriate course of action under these circumstances is to deny institution.

Revvo Techs,Inc. v. Cerebrum Sensor Techs., Inc., IPR2025-00632, Paper 36 at 4 (Director 26 Jan. 2026)

Stipulation to drop district court construction if IPR instituted will not solve this problem

Failure to Name Real Party in Interest Bars IPRs

> [A]ny Petition corrected to disclose additional RPIs must be given a new filing date . . . Here, a new filing date necessarily would be more than one year after the date on which Petitioner was served with a complaint alleging infringement of the challenged patents, making the Petitions time-barred under 35 U.S.C. § 315(b). Because we cannot consider the Petitions, and should not have considered them at the time of institution, the appropriate remedy is to grant Patent Owner's Motions to Dismiss, terminate the instant proceedings, and vacate our Decisions on Institution.

Corning Optical Comm. v. PPC Broadband Inc., IPR2014-00440, Paper 68 at 23, 25 (PTAB 18 Aug. 2015) (designated precedential 28 Oct. 2025).

Petitioner Must Resolve RPI Dispute

Petitioner's failure to provide clarity as to its actual identity is fatal to its petitions . . . Patent Owner submitted evidence suggesting that Petitioner's parent corporation . . . is wholly owned by state-owned enterprises . . . Regardless of whether the foreign government here is in fact an RPI, this evidence was sufficient to put into dispute whether the Petitions identified all RPIs . . . Where, as here, a petitioner does not sufficiently fulfill its statutory duty to identify all RPIs, the USPTO's mandate to protect the public interest is especially compelling . . . With its identification of RPIs in dispute, it was Petitioner's burden to bring forth evidence or arguments demonstrating that it named all RPIs . . . Accordingly, the Decisions granting institution are vacated, the Petitions are denied, and these proceedings are terminated.

Yangtze Memory Technologies Company, Ltd. v. Micron Technology, Inc., IPR2025-00098, Paper 38 at 6-9 (PTAB 15 Jan. 2026) (designated informative 16 Jan. 2026)

Whether an RPI Can Be a Foreign Governments Remains Undecided

In *Return Mail*, the Supreme Court held that a U.S. "federal agency is not a 'person' who may petition for post-issuance review under the AIA." *Return Mail*, 587 U.S. at 637. The Court, however, did not address, and has not addressed, whether this statutory prohibition extends to a foreign government.[3]

[3] While not the basis of today's decision, I note that inter partes review may be discretionarily denied on the basis that a petitioner is a sovereign. *See, e.g., Saint Regis Mohawk Tribe v. Mylan Pharms. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018) ("The Director bears the political responsibility of determining which cases should proceed. While he has the authority not to institute review on the merits of the petition, he could deny review for other reasons such as administrative efficiency or based on a party's status as a sovereign.").

Yangtze Memory, IPR2025-00098, Paper 38 at 2-3, n.4 (PTAB 15 Jan. 2026)

Proposed New Barriers

- Must stipulate not to raise **any** prior art defense in court/ITC
  - Even system prior art defense that cannot be raised in IPR
- No IPR once claim has been found valid in other contested proceeding
- No IPR if trial, ITC determination or PTAB final written decisions occurs first absent "extraordinary circumstances"

Yangtze Memory, IPR2025-00098, Paper 38 at 2-3 (PTAB 15 Jan. 2026) 2025-19580 (90 FR 48335)

Techniques for Avoiding the IPR Barriers

PGR Petitions are Heavily Favored

> [I]t is unlikely that a final written decision in this proceeding will issue before the Texas district court trial occurs . . . Petitions for post-grant review are favored because they must be filed no later than nine months from the grant of the patent (35 U.S.C. § 321(c)), are close in time to examination, and occur before expectations in the patent rights are strongly settled . . . the Petition is referred to the Board. . . .

Multi-Color Corp. v. Brook & Whittle Ltd., PGR2025-00025, Paper 10 at 2-3 (PTAB 16 July 2025) (designated precedential 9 Jan. 2026)

Complicated District Court Case Can Avoid Discretionary Denial (Typically 9 or More Patents)

Petitioner's arguments regarding the complex and diverse litigation proceeding tip the balance against discretionary denial. Petitioner explains that the district court proceeding involves eleven patents spanning nine different families that involve a diverse range of subject matter. The large number and vast scope of the patents asserted in the district court litigation weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.

Tesla, Inc. v. Intellectual Ventures II LLC, IPR2025-00217, Paper 9 at 2-3 (PTAB 13 June 2025) (designated informative 9 Jan. 2026) (internal citations omitted)

Examiner Material Error May Thwart Discretionary Denial

[T]hese proceedings raise similar issues to those previously adjudicated [where] the Board determined the challenged claims are unpatentable . . . the patent examiner's conclusion [on effective priority date of the challenged patents] directly contradicts the Board's determination and raises concerns of material error such that review of the challenged patents is an appropriate use of Office resources. Ordinarily, a scheduled district court trial date that precedes the date projected for a Board final written decision weighs in favor of exercising discretion to deny the Petition. Here, however, the Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error.

Padagis US LLC v. Neurelis, Inc., IPR2025-00464, -00465, -00466, Paper 12 at 2-3 (PTAB 16 July 2025) (designated informative 9 Jan. 2026)

Significant Change in the Law May Avoid Discretionary Denial

Petitioner contends that the United States Court of Appeals for the Federal Circuit "fundamentally changed the obviousness standard for design patents" in *LKQ Corp. v. GM Global Tech. Operations LLC*, 102 F.4th 1280, 1293 (Fed. Cir. 2024), which impacts the validity of the challenged patent. Petitioner's argument is persuasive. The challenged patent was examined and issued under an obviousness standard for design patents that the Federal Circuit has since abrogated, and it is an appropriate use of Office resources to consider the merits of Petitioner's challenge despite any settled expectations Patent Owner may have.

Top Glory Trading Group Inc. v. Cole Haan LLC, IPR2025-01395, Paper 18 at 2 (PTAB 12 Jan. 2026) (designated informative 12 Jan. 2026) (internal citations omitted)

Avoiding Settled Expectations Based on Differences With Patent Owner's Prior Targeted Industry

[I]t is unlikely that a final written decision in this proceeding will issue before district court trial occurs . . . the challenged patent has been in force for over twelve years, creating strong settled expectations . . . Petitioner argues with respect to settled expectations that the challenged patent has not been commercialized, asserted, marked, licensed, or otherwise applied in its technology space. Petitioner argues that Patent Owner only previously targeted smartphones, tablets, and watches, whereas Petitioner, Home Depot, is the proprietor of a chain of hardware stores and did not have reason to anticipate assertion of the patent against it. Petitioner's arguments are persuasive.

Home Depot U.S.A., Inc. v. H2 Intellect LLC, IPR2025-00480, Paper 11 at 2-3 (PTAB 4 Sept. 2025) (designated informative 9 Jan. 2026) (internal citations omitted)

Avoiding Settled Expectations Based on a Laches-Type Argument

[I]t is unlikely that a final written decision in these proceedings will issue before district court trial occurs . . . the district court has issued a *Markman* order . . . the challenged patent . . . has been in force for thirteen years, creating strong settled expectations for Patent Owner. Petitioner . . . was aware of the challenged patent . . . in 2012, when Patent Owner first contacted Petitioner about the challenged patent in a letter. Petitioner . . . contends that it "did not expect enforcement" of the patent . . . because it concluded that it did not require a license . . . and advised Patent Owner of its position, and . . . Patent Owner did not assert the challenged patent against Petitioner until eleven years after [when they were] expired.

Apple Inc. v. Ferid Allani, IPR2025-00856, Paper 11 at 2-3 (PTAB 5 Sept. 2025) (designated informative 9 Jan. 2026)

Guidance

- File PGRs
- File early to avoid *Fintiv*
- Look for technique to avoid IPR barrier
- Consider *ex parte* reexamination

Question & Answers

Thank You

CLE Code 72415

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IP Asia Symposium 2026

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US Patent Case Damages War Stories

Paul Steadman
Erin Gibson

DLA PIPER

Asia IP Symposium 2026

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Lunch Roundtable: US Administration Update

Lord David Cameron, Senator Richard Burr, Senator Saxby Chambliss, Frank Ryan

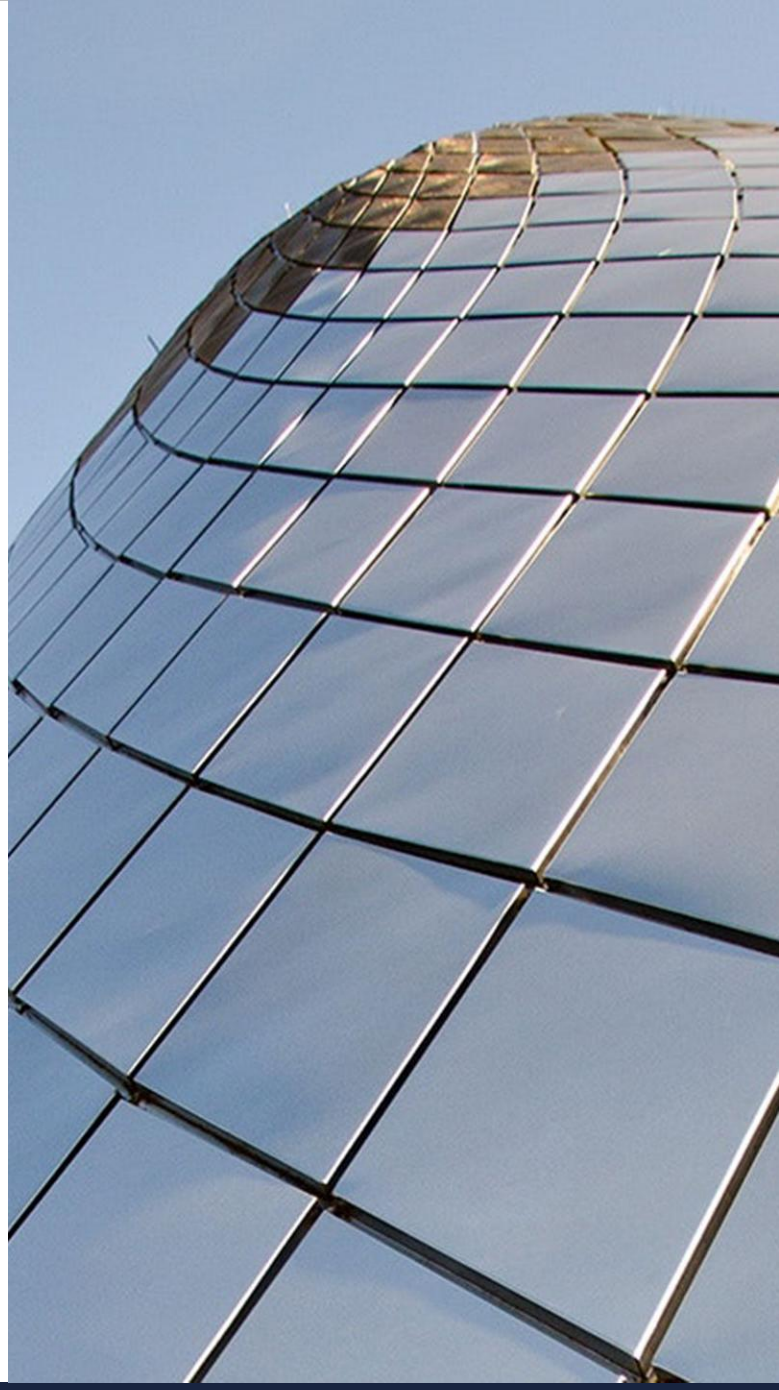
Moderated by Matt Satchwell

The U.S. Patent Damages EcoCulture is Changing *Fast*

Optional subtitle

The Federal Circuit Is Reshaping Damages in Patent Cases

- *Cal. Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022) ("two-tiered" reasonable royalty theory for same infringing chips was legally unsupportable)
- *Apple Inc. v. Wi-LAN Inc.*, 25 F.4th 960 (Fed. Cir. 2022) (expert must adequately apportion comparable licenses or account for differences to isolate value attributable to patented invention)
- *EcoFactor, Inc. v. Google LLC*, 137 F.4th 1333 (Fed. Cir. 2025) (*en banc*) (damages expert's testimony deriving specific per-unit royalty rate from lump-sum settlement licenses was unreliable and inadmissible)
- *Jiaxing Super Lighting v. CH Lighting Tech*, No. 2023-1715 (Fed. Cir. 2025) (vacating damages award and remanding for consideration of whether expert adequately apportioned value from prior portfolio license agreements rather than using unsupported blanket upward/downward adjustments based on competition or market factors)
- *Rex Medical, L.P. v. Intuitive Surgical, Inc.* (Fed. Cir. 2025) (affirming verdict of nominal damages ($1) when expert testimony failed to apportion multi-patent license that formed basis of jury's damages award)



A Closer Look

Optional subtitle

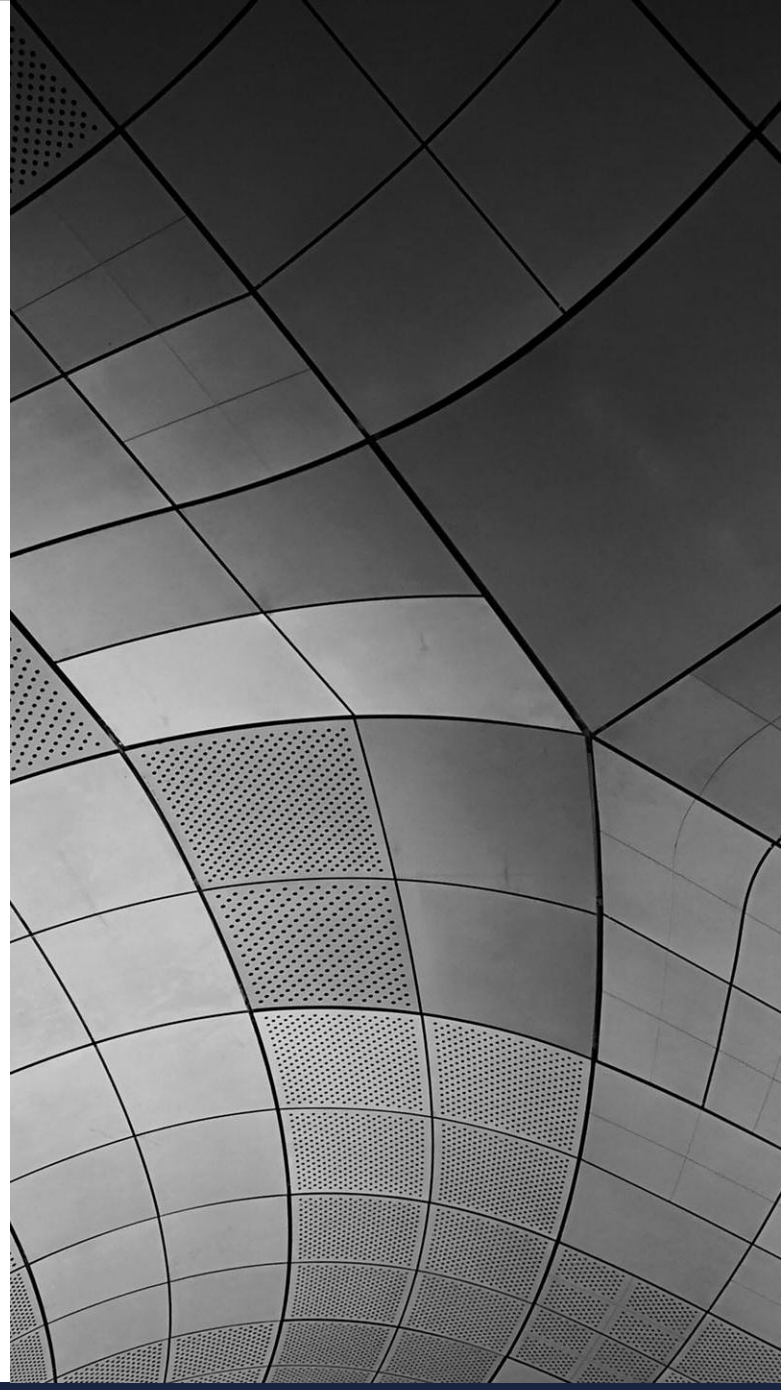
Caltech. v. Broadcom

25 F.4th 976 (Fed. Cir. 2022)

- Caltech sued Broadcom and phone maker asserting three patents covering low-density parity-check (LDPC) error-correcting codes used in high-speed Wi-Fi data transmission
- Caltech accused Broadcom's Wi-Fi chips (manufacture/sale) and downstream products (e.g., phones) that incorporated those chips (use)
- Caltech's expert used a "two-tiered" reasonable royalty model involving two separate hypothetical negotiations for the same infringing chips — one at the component (chip) level and one at the end-product (device) level
- The model applied a lower per-unit royalty to Broadcom's chip sales and a significantly higher effective royalty to downstream products containing the same chips. The jury awarded $1.1 billion total damages

Federal Circuit Holding:

- Vacated the entire damages award and remanded for a new trial on damages
- Two-tiered approach was "legally unsupportable on this record" because it impermissibly applied two separate hypothetical negotiations for same chips
- "The mere fact that Broadcom and [phone maker] are separate infringers alone does not support treating the same chips differently at different stages in the supply chain"



Apple v. WiLan

25 F.4th 960 (Fed. Cir. 2022)

- Wi-LAN sued Apple for infringing patents on methods for allocating bandwidth and selecting variable data rates in wireless (LTE) communication systems.
- First trial's $145M verdict was vacated by the district court for flawed apportionment, leading to retrial after Wi-LAN rejected a $10M remittitur
- Second trial theory: Reasonable royalty based on three comparable Wi-LAN portfolio licenses to other phone manufacturers (Vertu, Doro, Unnecto)
- Expert identified the two asserted patents as the "key" patents ("wheat") driving value, while treating the rest of the portfolio as "chaff"; applied a flat 25% royalty rate reduction to apportion for the additional patents

Federal Circuit Holding:

- Vacated the damages award and remanded for a new trial on damages; the district court abused its discretion by admitting the expert's testimony
- Expert's "key patent" determination and 25% apportionment adjustment were "untethered to the facts of this case"—the licenses did not treat the asserted patents as uniquely valuable, and the expert failed to adequately account for differences or justify the adjustment with license-specific evidence
- Expert must reliably apportion value to isolate the asserted patents and tie any adjustments to the specific technologies, negotiations, and economic circumstances of the licenses

EcoFactor v. Google

EcoFactor, Inc. v. Google LLC, 137 F.4th 1333 (Fed. Cir. 2025) (en banc)

- EcoFactor sued Google for asserting patent on smart thermostat technology for optimizing HVAC systems based on sensor data and user preferences
- Jury found infringement and awarded >$20 million in lump-sum damages. Fed. Cir. panel affirmed, but court granted en banc rehearing on expert admissibility
- Expert's theory was reasonable royalty (lump-sum) based on three prior lump-sum settlement licenses granted to third-party smart thermostat manufacturers
- Expert derived a specific per-unit royalty rate ($X) by converting the lump-sum amounts, assuming they reflected application of that rate to estimated past/projected sales of the licensees' accused products. Each license recited that EcoFactor believed $X was a reasonable royalty per unit but did not state the licensees agreed to that rate

EcoFactor v. Google (con't)

Federal Circuit En Banc Holding:

- Reversed district court's denial of new trial on damages; vacated $20M+ award and remanded for new damages trial because expert testimony inadmissible under FRE 702 / Daubert
- Expert's opinion that licenses reflected industry acceptance of $X per-unit rate lacked sufficient facts/data support—licenses themselves did not show licensees agreed to/used that rate
- Expert improperly relied on EcoFactor's unilateral belief and unsupported assumptions about lump-sum calculations
- District courts must rigorously gate-keep damages expert testimony; opinions deriving specific royalty rates from lump-sum licenses require reliable, record-tied evidence (not speculation or patentee assertions)
- Heightened scrutiny for converting lump-sum/settlement licenses to per-unit rates in reasonable royalty analyses; strict Daubert application to prevent unreliable damages evidence

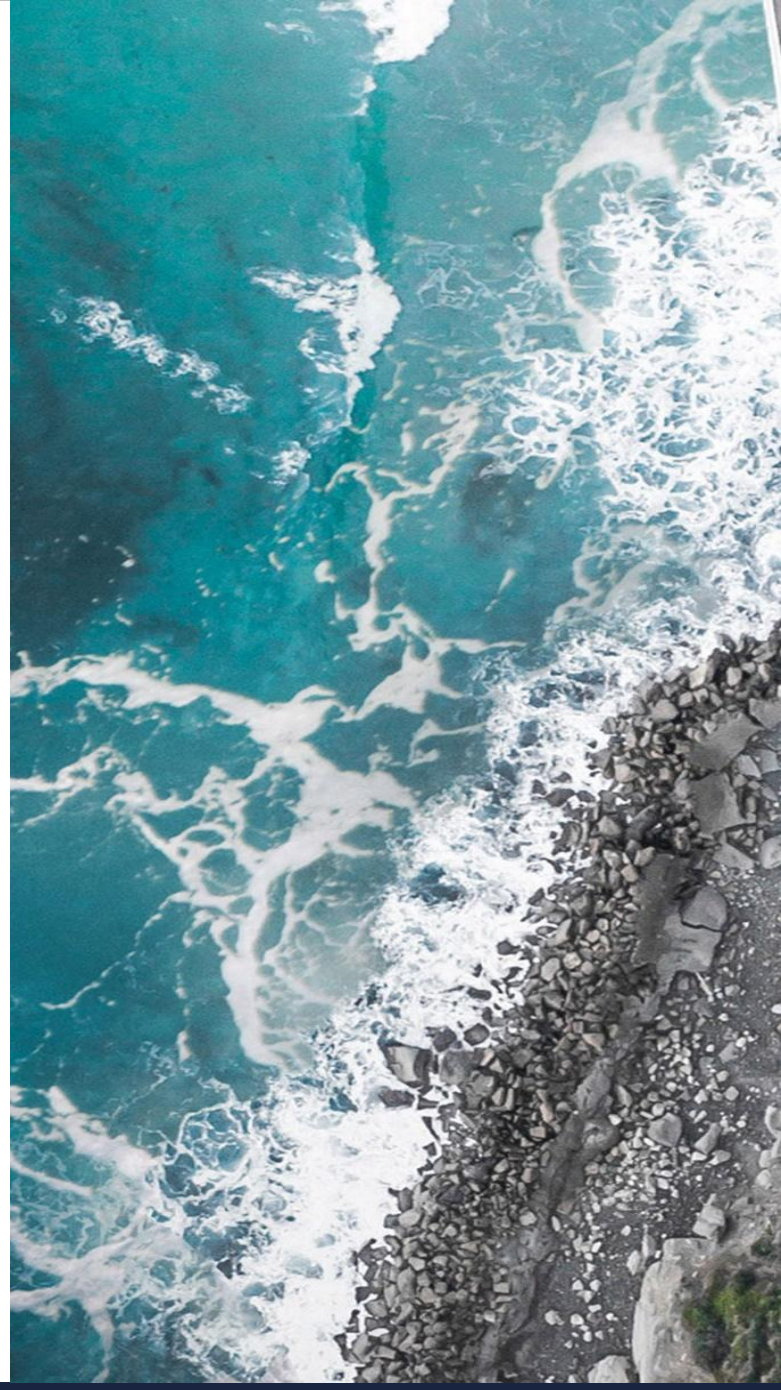
Super Lighting v. CH Lighting

Jiaxing Super Lighting Electric Appliance Co. v. CH Lighting Technology Co., Ltd., No. 23-1715 (Fed. Cir. 2025)

- Super Lighting sued CH Lighting for infringing three LED tube lamp patents
- Jury awarded ~$13.87 million (lump-sum) for all three patents; district court enhanced by doubling to ~$27.7 million under § 284
- Expert relied on prior portfolio license agreements to derive reasonable royalty; CH Lighting challenged via Daubert motion for inadequate apportionment among asserted vs. non-asserted patents in the licenses
- District court denied CH Lighting's motion to exclude expert without any reasoned explanation or analysis

Federal Circuit Holding:

- Vacated entire damages award and remanded for new trial on damages for all three patents; district court abused discretion by failing to provide reviewable reasoning on Daubert motion
- Extended EcoFactor v. Google framework—district courts must rigorously gate-keep under FRE 702, provide reasoned analysis on reliability (especially apportionment in portfolio licenses), and ensure testimony is based on sufficient facts/data; absence of reasoning can warrant reversal



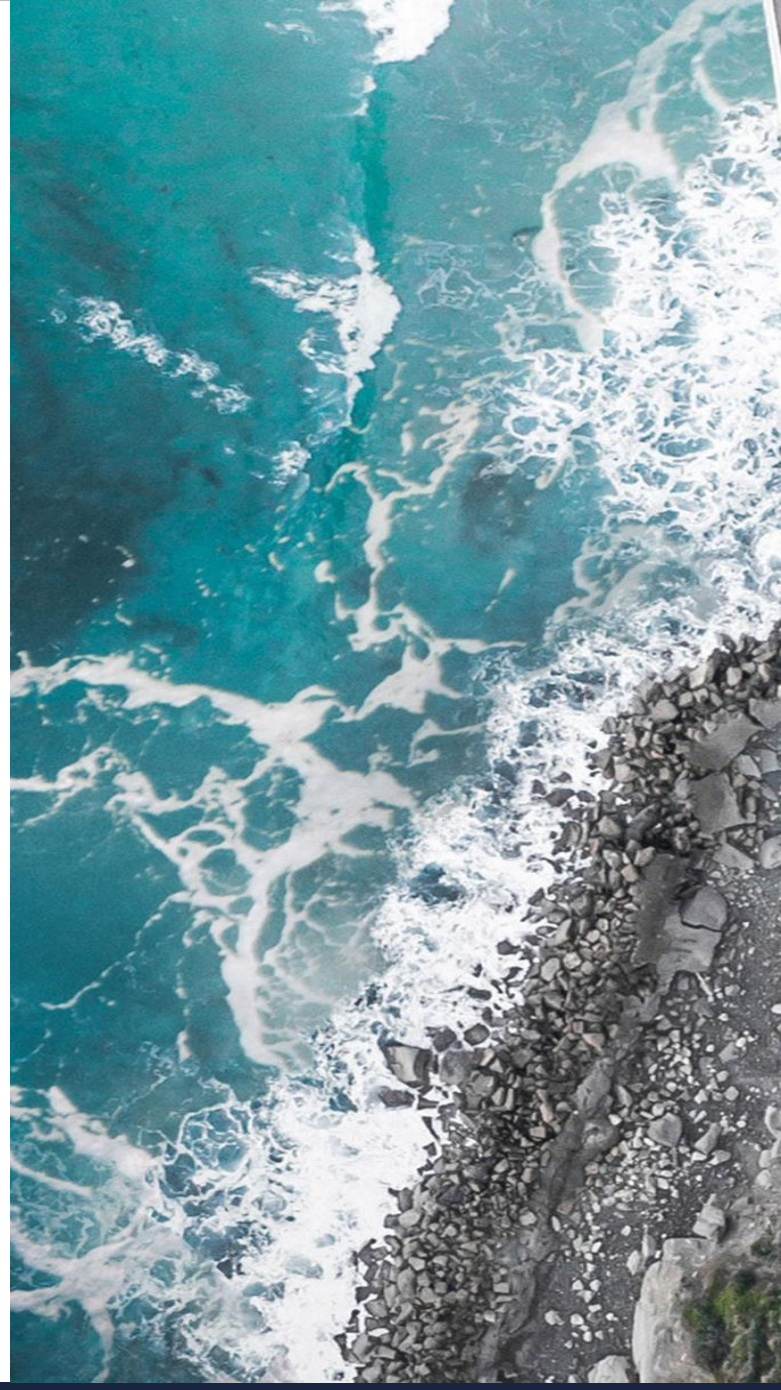
Rex Medical

Rex Medical, L.P. v. Intuitive Surgical, Inc., No. 24-1072 (Fed. Cir. 2025)

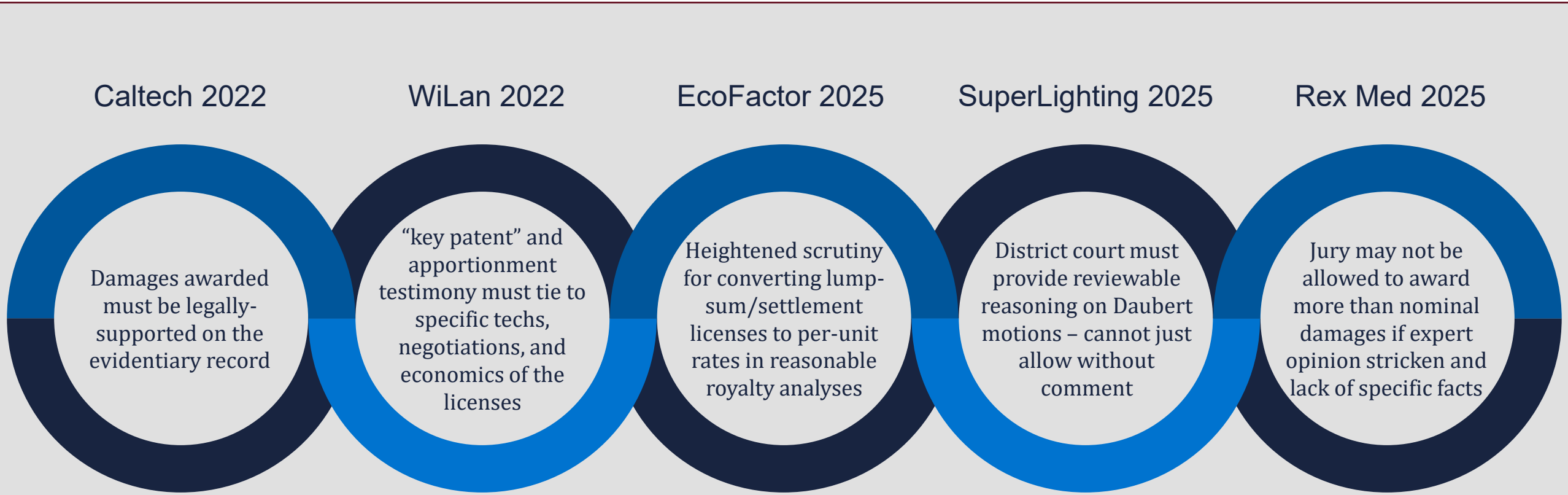
- Rex Medical asserted patent on a surgical stapling system
- Damages theory was reasonable royalty (hypothetical negotiation) based primarily on a prior $10 million lump-sum settlement license from Rex to Covidien covering a broad portfolio. Rex's expert opined a $20 million lump-sum royalty for Intuitive, relying on Covidien license; apportioned by claiming "most, if not all" value tied to asserted patent
- District court excluded expert's testimony on Covidien license for failure to reliably apportion value to asserted patent alone (methodology unreliable under Daubert/FRE 702). No damages experts testified
- Jury awarded Rex $10 million based on infringement finding and limited lay testimony about Covidien license factors
- District Court granted JMOL reducing award to $1 nominal damages (no sufficient evidence for reasonable royalty); denied new trial on damages

Federal Circuit Holding:

- Affirmed exclusion of expert and reduction to $1 nominal damages (treated as JMOL of no damages). Expert's apportionment "untethered to the facts" and jury left to speculate on allocation → impermissible; insufficient record evidence (even lay testimony failed to tie value to asserted patent alone)
- Reasonable royalty can be $1 if no patent holder presents no evidence



The Pattern


Caltech 2022
Damages awarded must be legally-supported on the evidentiary record
WiLan 2022
"key patent" and apportionment testimony must tie to specific techs, negotiations, and economics of the licenses
EcoFactor 2025
Heightened scrutiny for converting lump-sum/settlement licenses to per-unit rates in reasonable royalty analyses
SuperLighting 2025
District court must provide reviewable reasoning on Daubert motions – cannot just allow without comment
Rex Med 2025
Jury may not be allowed to award more than nominal damages if expert opinion stricken and lack of specific facts

Other Important Patent Damages Doctrines

Optional subtitle

Other Key Damages Attacks

- Failure to mark products under the patent with patent number 35 U.S.C. §287(a)
- Inclusion of accused products in royalty base not attributable to the Defendant at trial
- Inclusion of revenue for unpatented products or features (Rite-Hite)
- Failure to produce critical damages evidence during fact discovery

35 U.S.C. §287(a) – Patent Marking

"In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event ***damages may be recovered only for infringement occurring after such notice***."

35 U.S.C. § 287(a)

35 U.S.C. §287(a) – Patent Marking

"We hold an alleged infringer who challenges the patentee's compliance with § 287 bears an initial burden of production to articulate the products it believes are unmarked 'patented articles' subject to § 287.

To be clear, this is a low bar. The alleged infringer need only put the patentee on notice that he or his authorized licensees sold specific unmarked products which the alleged infringer believes practice the patent."

Arctic Cat Inc. v. Bombardier Recreational Prods. Inc., 876 F. 3d 1350, 1368 (Fed. Cir. 2017) ("*Arctic Cat I*").

35 U.S.C. §287(a) – Patent Marking

"For purposes of section 287(a), notice must be of 'the infringement,' not merely notice of the patent's existence or ownership. Actual notice requires the affirmative communication of a specific charge of infringement by a specific accused product or device."

Amsted Indust. Inc. v. Buckeye Steel Castings Co., 24 F.3d 178, 187 (Fed. Cir. 1994).

35 U.S.C. §287(a) – Patent Marking

"The statute thus prohibits a patentee from receiving *any* damages in a subsequent action for infringement after a failure to mark, rather than merely a reduced amount of damages in proportion to the amount of time the patentee was actually practicing the asserted patent."

Arctic Cat Inc. v. Bombardier Recreational Prods. Inc., 950 F.3d 860, 865 (Fed. Cir. 2020) ("*Arctic Cat II*") (emphasis original).

"[T]he Federal Circuit strictly interpreted § 287 to make clear that once a patentee (or its licensee) is non-compliant with § 287, recovery of damages is limited to either the period after marking resumes or after the alleged infringer has been given actual notice."

Team Worldwide Corp. v. Acad., Ltd., No. 219CV92 JRG-RSP, 2021 WL 1854302, at *2 (E.D. Tex. May 10, 2021), adopted sub nom. 2021 WL 1985688 (E.D. Tex. May 18, 2021).

35 U.S.C. §287(a) – Patent Marking

"The Court recognizes that this is a harsh remedy, especially in a case like this where the import [of patented articles] occurred several years after the patent was issued and only one year before suit was filed.

However, this outcome is the clear consequence of Congress's decision 'to incentivize marking of patented articles.'

…That a penalty is harsh is not a sufficient reason to ignore clear text and binding appellate authority requiring its application."

Unicorn Energy AG v. Tesla Inc., 740 F. Supp. 3d 930, 965 (N.D. Cal. 2024), *citing Team Worldwide*, 2021 WL 1854302, at *1.

Reports from the Front: Applying Trend to Win the Case

Optional subtitle

Neo Wireless Case

- 4G LTE Standards Essential Patent (SEP) case pending in E.D. Texas. Patent holder is funded by litigation funding – hard case to settle
- Narrowed asserted patents using IPRs and EPRs
- Defendants adopted a reasonable damages model early in case, designed to be defensible at trial. Sent early *Arctic Cat* letter, later combined with summary judgment motion to knock out pre-suit damages
- Patent holder adopted a six-step damages model. We attacked all six steps on Daubert and apportionment grounds:
  - Benchmark royalty inappropriately adopted from UK case
    - Different parties, products, patents, and licenses
  - Inappropriate increase in rate based on differences in price between iPhone and iPod
  - Used royalty rate from a study abstract, where the study and underlying survey never produced in discovery
  - Inappropriately allocates entire royalty only to asserted patents based on prior licenses (which do not adopt this methodology)
  - Inappropriately triples royalty rate to account for patent validity
  - Further increases royalty rates for unpatented features
- Daubert motion now pending since June 2024 without decision

Neo Wireless Case

A party's royalty rate calculation methodology cannot sidestep controlling law on patent damages merely becaus it arises from the party's historical "licensing program."

"To hold otherwise would improperly permit [the party] to h behind its generic licensing arrangement to avoid the task apportionment."

Omega Patents, LLC v. CalAmp Corp., 13 F.4th 1361, 1379 (Fed. Cir. 2021).

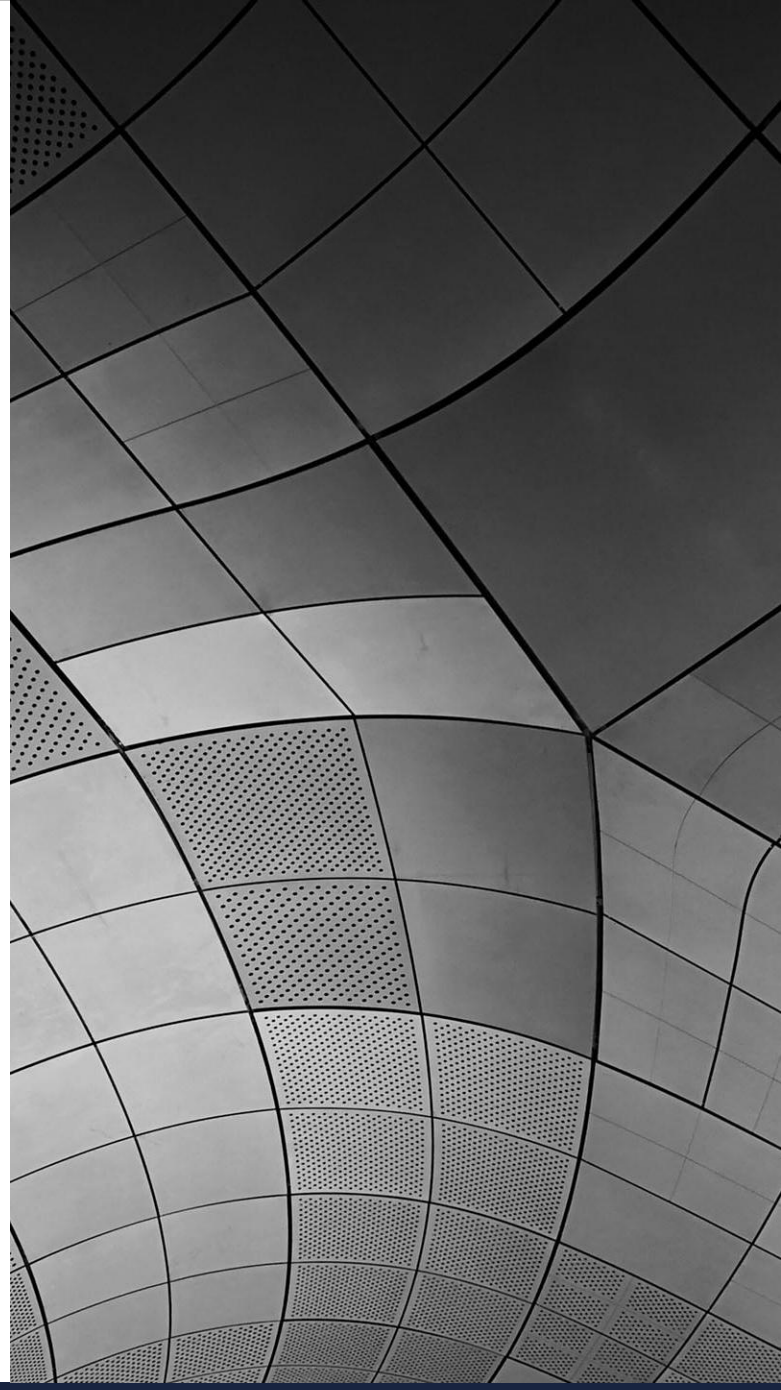
An expert's "wholesale adoption of Plaintiff's estimates, without revealing or apparently even evaluating the bases those estimates, goes beyond relying on facts or data and instead cloaks unexamined assumptions in the authority o expert analysis."

"Where an expert merely offers his client's opinion as his own, that opinion may be excluded."

Ask Chemicals, LP v. Computer Packages, Inc., 593 F. App'x 506, 510 (6th C 2014).

Android Auto Case

- Patent holder sued only overseas parent entity in order to get venue in E.D. Texas
- Overseas parent entity does not make, use, sell, offer, or import most accused models to the United States
  - Patent holder may face difficult choice of reduced damages base or amending complaint to add parties that will destroy venue
- Proper apportionment will be difficult
  - Prior licenses likely lump-sum licenses for large portfolio
  - “Profit split” and “rule of thumb” no longer allowed for patent cases. Uniloc v. Microsoft (2011) (Federal Circuit rejecting "25% Rule of Thumb" profit split)
  - What is the SSPPU?
- Proper damages analysis likely to be less than patent holder’s cost of litigation



Ryobi Case

- Chervon sued One World and Techtronic Industries for infringement of nine patents related to handle design in battery-powered lawnmowers
- In addition to reasonable royalty damages, Chervon sought extensive damages for (1) Chervon's alleged lost profits from lost sales of competing battery-powered lawnmowers; (2) Chervon's alleged lost profits from lost sales of many other types of unaccused battery-powered lawn equipment (leaf blowers, string trimmers, etc.) that run on the same 56v battery platform (a theory nicknamed "platform lost profits")
- Shortly before trial, court granted defendants' motion for summary judgment that plaintiff's "platform lost profits" theory was improper and unsupported
- Court found plaintiff had not met test for obtaining convoyed sales lost profits (profits on sales of products sold with accused products that work as a "functional unit" or "complete machine" with accused products)
- Plaintiff transferred its IP multiple times between corporate entities, causing issues with ability to demand lost profits, but pursued them anyway
- Jury did not award alleged lost profits to plaintiff, leaving plaintiff with ~$4m damages award

Other Critical Strategies

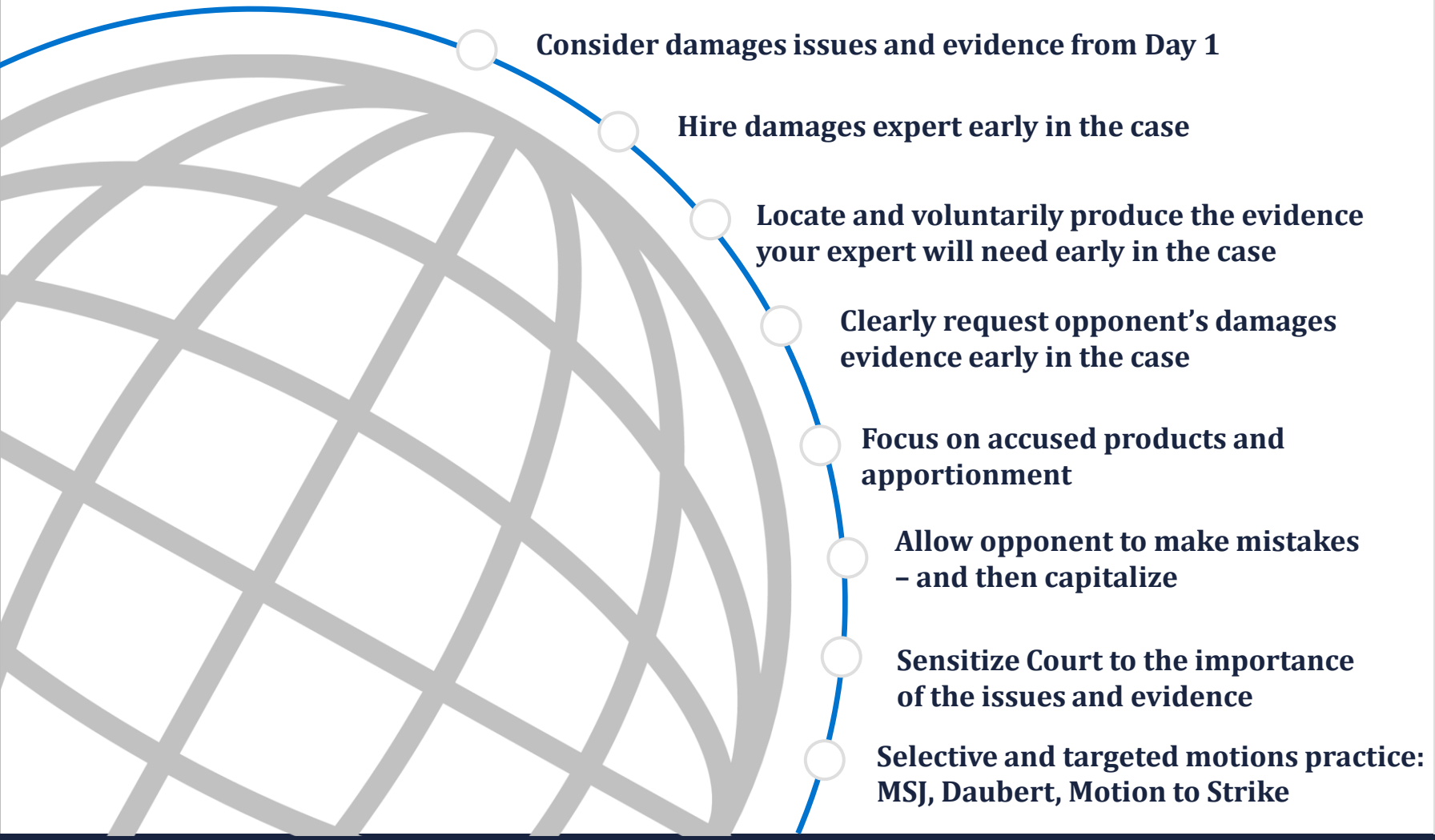
Optional subtitle

Building the Damages Case

- Demand and Obtain apportionment proof in fact discovery, such as value of unasserted patents and other rights transferred in portfolio or business agreements
- Investigate value of prior art to help value asserted patents' improvement over the prior art and footprint in the marketplace
- Defendants' own existing patents can support apportionment, but proof those patents cover accused products and features may be required
- If plaintiff is relying on value of proposed but unaccepted license agreements, third-party discovery can support value of asserted patents or lack thereof

Using the Damages Case to Alter the Outcome

Integrate the Damages Case from First Day



A minimal damages verdict may be the best possible outcome

Minimizing or cutting down damages can lead to settlement or abandonment of the case (e.g. when funded by contingency or litigation funding)

Integrate damages attacks with other attacks on the case (e.g. harmonize with prior art/invalidity, we-invented-first, reducing asserted patents, claims, or accused products)

Final Thoughts

- The Federal Circuit is clearly attempting to limit unsupported and unapportioned damages theories, and has instructed district court judges to carefully implement their roles as “gate keeper” for expert testimony
- District Court judges are often more comfortable with economics and damages issues than technical issues and often appreciate the apportionment requirement
- As plaintiff/patent holder, it is critical to work on a viable damages model early in the case and produce or take discovery that will support it – including apportionment
- Many plaintiffs, in particular NPEs, tend to ignore this part of the case until the end – or after the end – of fact discovery
- Defendants must also consider damages early in the case, work on a viable theory, and be sure to support it with whatever evidence will be required
- Defendants can and should attack unapportioned, unsupported damages theories

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Asia IP Symposium 2026

Tokyo, Japan / Thursday, February 26, 2026

Strategic Litigation in the UPC – How to Structure Your Case for Success

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English

Gualtiero Dragotti has over 25 years of experience of handling IP matters, with a focus on patents and the protection of innovation, particularly in the mechanical, chemical, fashion and sports equipment industries.

Gualtiero advises leading Italian and international clients on various non contentious and contentious IP cases, including some of the key patent litigation issues in Italy.

Gualtiero is admitted to the Supreme Court in Italy.He served as a Juridical Expert for the Anti-Counterfeiting National Council, appointed by the Ministry of the Economic Development.

Gualtiero has been teaching IP at the faculty of Chemistry - University of Milan as appointed Professor for over 10 years.

He was appointed as a member of the Research Project on Biotechnology under the patronage of the University of Modena and Luiss – Guido Carli International University, with the sponsorship of MIUR.

Gualtiero is a member of the Standing Committee on the Unitary Patent and Unified Patent Court of AIPPI - International Association for the Protection of Intellectual Property.

He regularly speaks at seminars and conferences organized by universities and IP concerned groups.

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Higher Regional Court of Cologne, Second State Examination (Law), 2014

University Hospital Cologne / University of Cologne, Second State Examination (Medicine), 2012

University of Cologne, First State Examination (Medicine), 2008

University of Cologne, First State Examination (Law), 2006

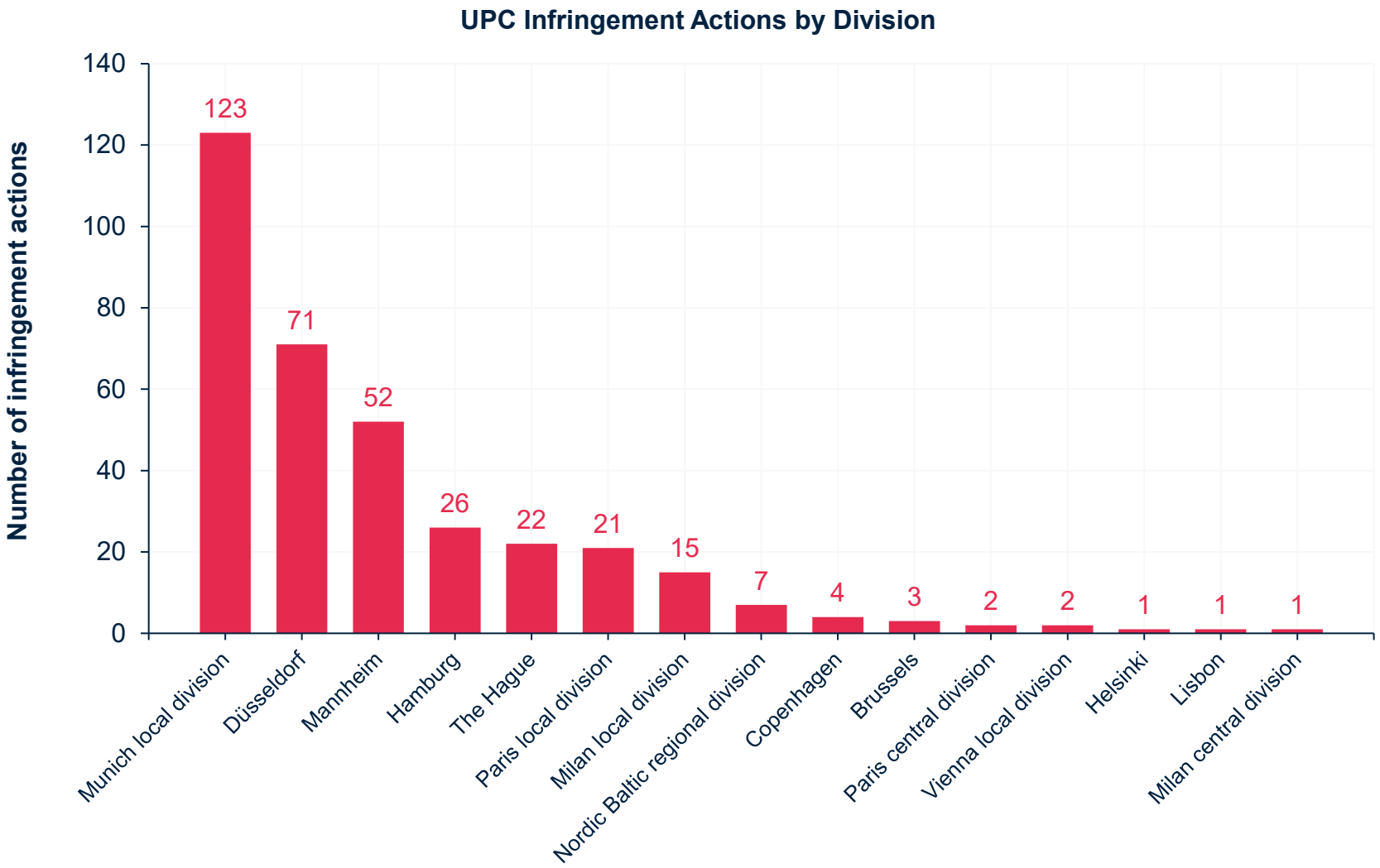
Kokularajah Paheenthararajah advises national and international clients on complex patent litigation and licensing disputes as well as regulatory matters with a heavy focus on the life sciences and healthcare sector.

He has particular experience with advanced therapies, diagnostics and biotechnologies, including cell, tissue and gene therapies, recombinant drugs, monoclonal antibodies, biotechnological tissue products, tumor vaccines, genome editing and, precision medicine. Kokularajah also regularly advises on complex regulatory and strategic topics in the life sciences and healthcare sector with a particular focus on regulatory data and market exclusivity, compliance and investigations, pricing and market access strategy, marketing, advertisement, R&D cooperation, clinical trials and digital health. His clients include some of the world's leading research-based pharmaceutical, biotechnology, diagnostics and healthcare technology companies as well as medical research institutions and private equity firms.

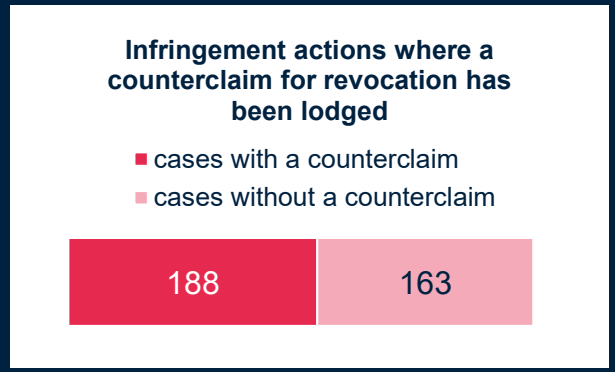
Kokularajah is dual qualified, holding both a law degree and a degree in medical. He is admitted as a lawyer as well as a physician in Germany.

UPC fact check: Court of First Instance

Case load since start of operations

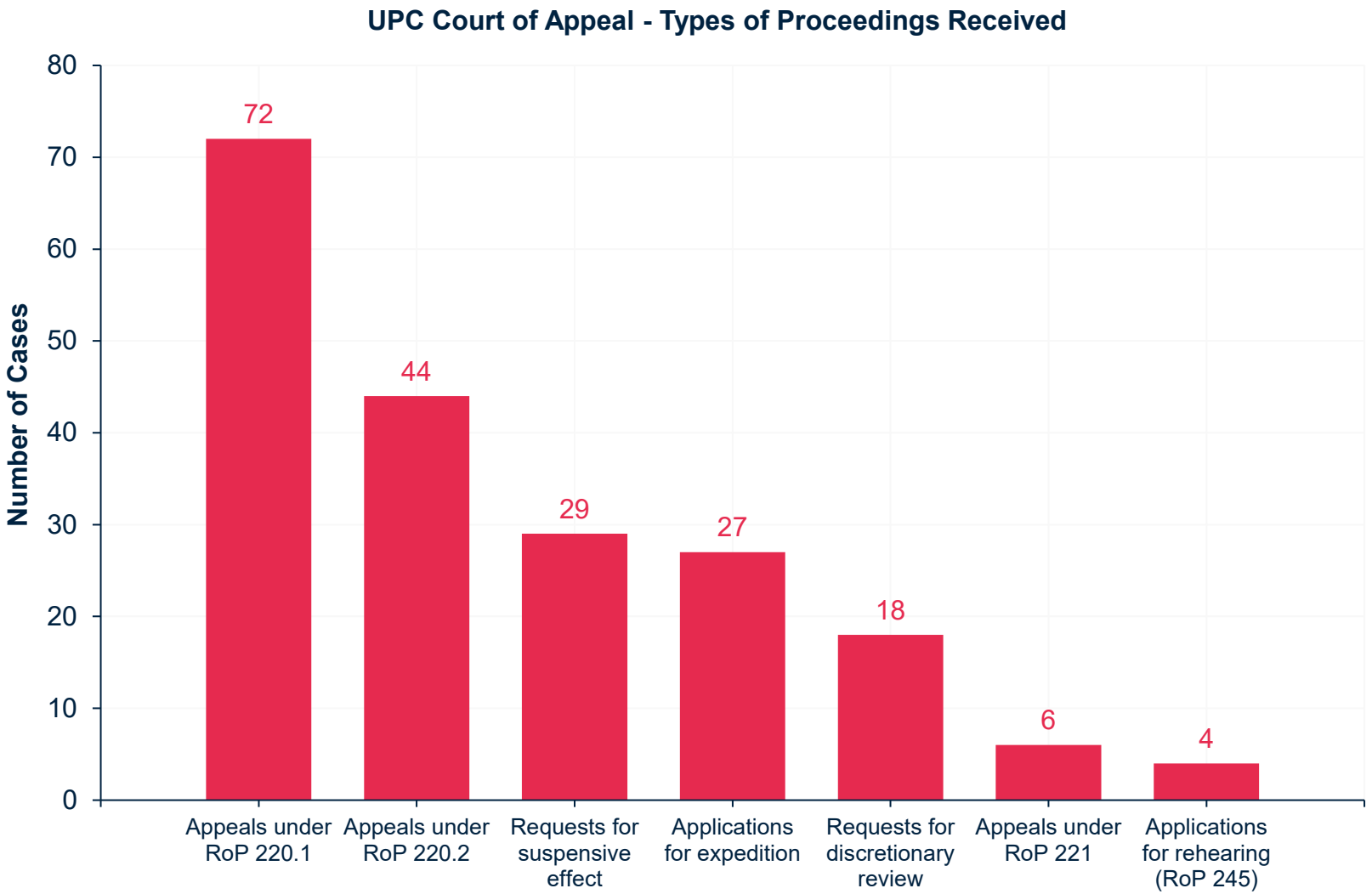


- The Court of First Instance has received a total number of **946** cases, including **351** infringement actions
- 321 counterclaims for revocation have been filed, which come from 188 individual infringement actions
- 68 stand-alone revocation actions filed



UPC fact check: Court of Appeal

Case load since start of operations



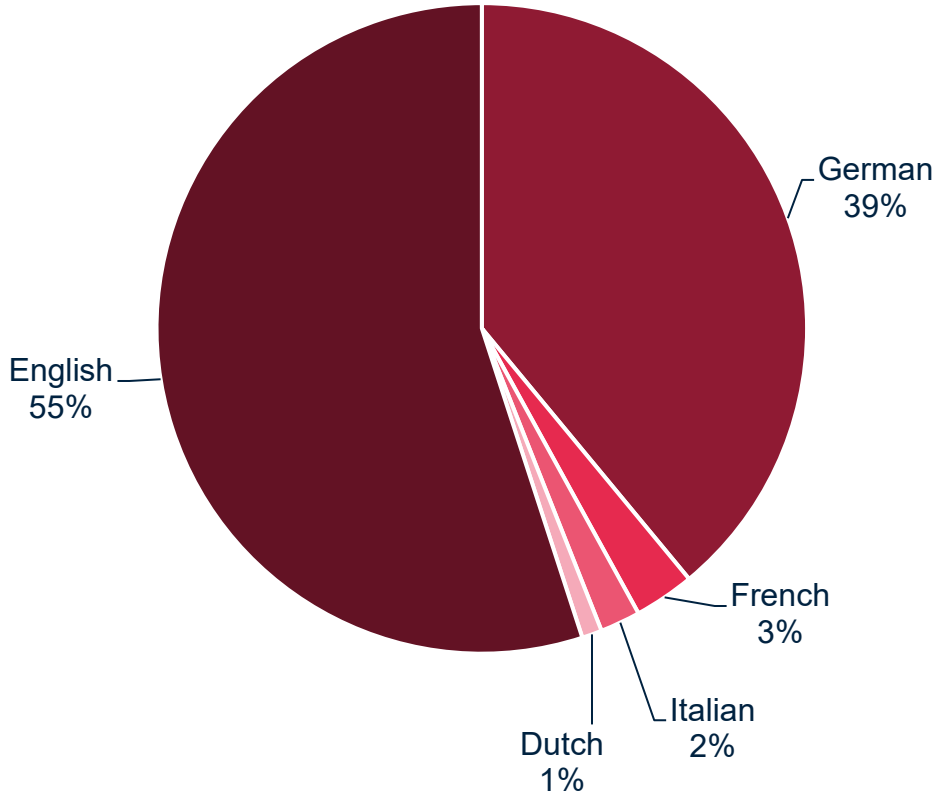
The Court of Appeal has received

- 72 appeals under RoP220.1
- 44 appeals under RoP220.2
- 6 appeals under RoP221
- 18 requests for discretionary review
- 29 for suspensive effect
- 27 applications for an order for expedition of an appeal
- 4 applications for rehearing under RoP245

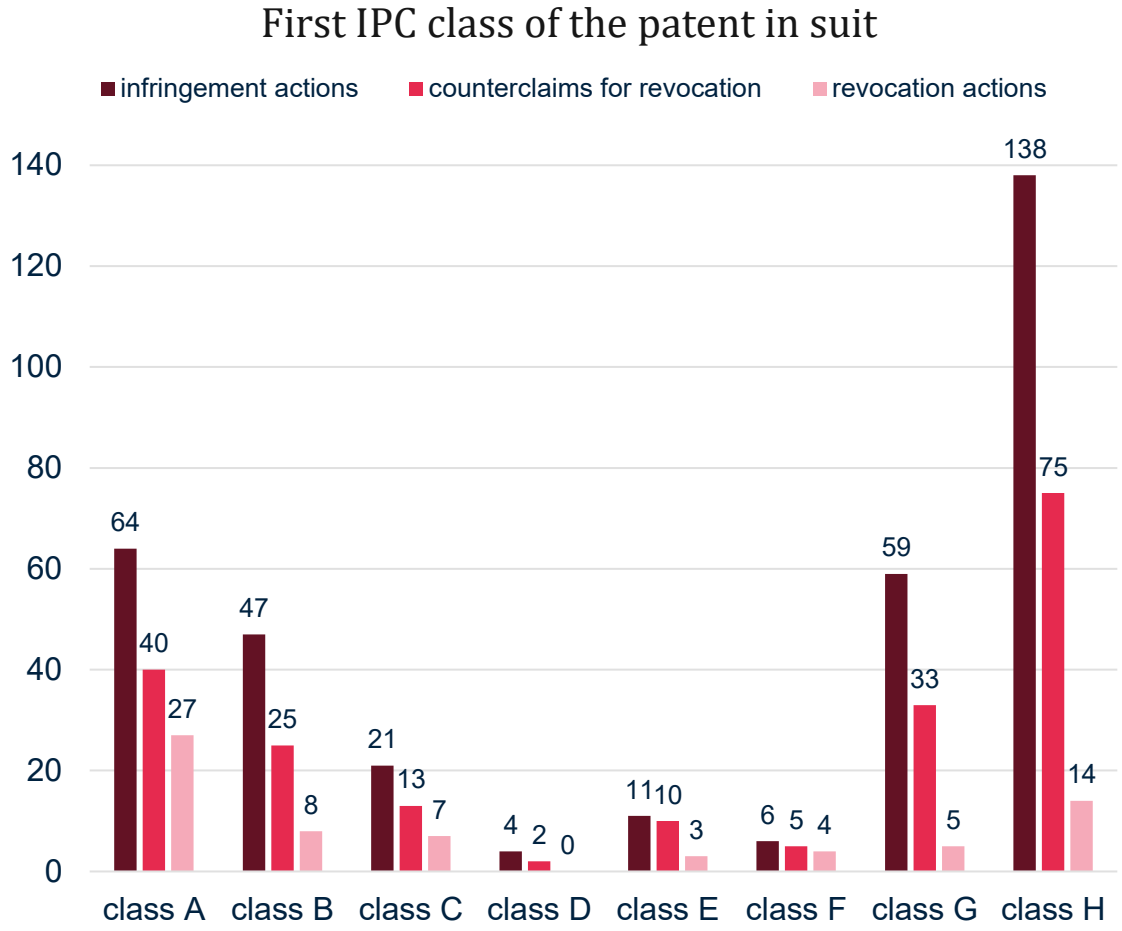
UPC fact check

Case load of the UPC since start of operations

Language of proceedings (CFI only)



IPC classes of the patents in suit (CFI only)



Long-arm jurisdiction

Brussels I bis Regulation

Article 4(1)

“Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.”

Article 24(1)

"*The following courts of a Member State shall have **exclusive jurisdiction**, regardless of the domicile of the parties:*

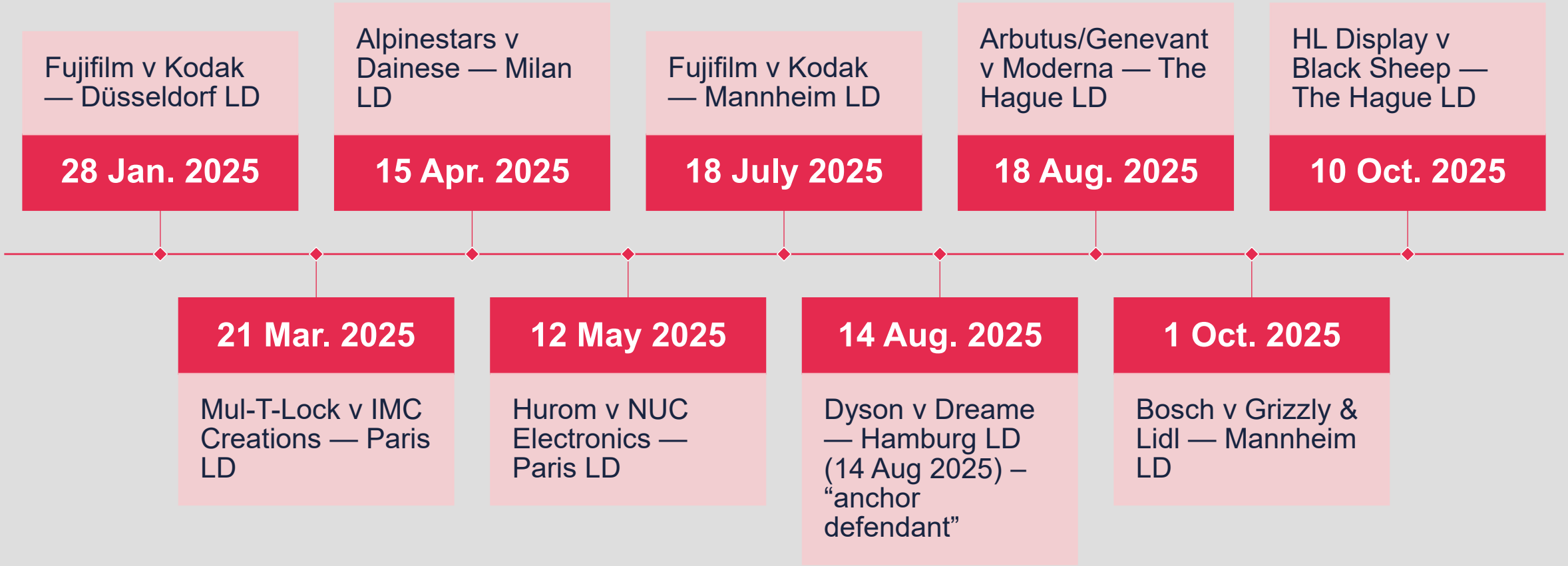
(4) in proceedings concerned with the registration or validity of patents, […] the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place.”

ECJ 25 February 2025 – BSH v. Electrolux

- Where a defendant domiciled in an EU Member State is sued for infringement of a European patent's national parts in multiple countries, the court of the defendant's domicile retains jurisdiction over the infringement claims even if the defendant raises a validity defense; exclusive jurisdiction to decide validity remains with the courts of the granting state, so the infringement court may need to stay pending validity proceedings.

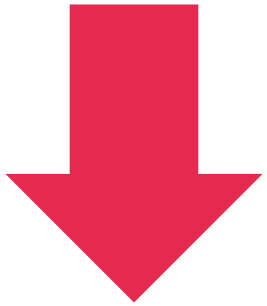
- If the action also covers a patent validated or granted in a non-EU/UPC state (eg Spain, UK, Türkiye), the EU court of the defendant's domicile can hear the infringement claim and assess validity only *incidenter tantum* (inter partes), without affecting the foreign register.

UPC Long-Arm Decisions



The "anchor defendant" principle

Article 8(1) of the Brussels Ibis Regulation allows a plaintiff to **bring proceedings against multiple defendants in the courts of a Member State where any of them** (the so-called "anchor defendant") **is domiciled if their claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings**.



Case-law: LD Hamburg in case Dyson v. Dreame held that the international jurisdiction regarding infringement in Spain can be obtained by means of Article 8(1) of the Brussels Ibis Regulation, applying the anchor defendant principle which requires a close connection with a defendant who is domiciled in the country of the Court seized (here Germany) and thus subject to the UPC's universal jurisdiction and who acted allegedly in Spain.

What's next?

LD Mannheim, UPC_CFI_162/2024, 2 Oct 2025, *Hurom v. Nuc*

Potential long-arm jurisdiction scenarios before the UPC:

- EU-UPC based Defendant for infringement outside the UPCA territory (Art. 4 Brussels Ia Reg)
- EU-non UPC based Defendant for infringement within a non-UPC EU Member State
- Non-EU based Defendant for infringement within a non-EU country

Case of LD Mannheim:

- Defendant based in Korea
- Defendant's subsidiary based in Germany
- Damages request: certain UPC countries plus **Spain, UK and Poland against all Defendants**

Relevant Laws: Art. 71b(2), Art. 7 (2) Brussels Ia Reg

- Art. 7(2) BR: "*A person domiciled in a Member State may be sued in another Member State (…) in matters relating to tort, delict or quasi-delict, **in the courts for the place where the harmful event occurred or may occur**"*

What's next?(II)

LD Mannheim, UPC_CFI_162/2024, 2 Oct 2025, *Hurom v. Nuc*

"place where the harmful event occurred or may occur"

Place where damages occurred	Place of event giving rise to such damages	Place that give rise to damages not limited to the country in which the patent is registered
"event" can be the action controlling the event, eg delivery organized in and through UPC territory into Spain, Poland and UK	In the case at hand, the Hong Kong entity relied on the German entity and distributor that both organize shipping from and through the UPC territory into Spain, UK, Poland	UPC confirmed jurisdiction for all defendants based on Art. 7(2) Brussels Ia Reg. as the "place of event giving rise to such damages" was considered as being within UPC territory

Update on recent German national courts' long-arm jurisdiction

Case Study: Recent Munich Regional Court I long-arm jurisdiction decision

Bayer/Regeneron v. Formycon - 25 September 2025, docket nos. 7 O 16055/24, 7 O 9382/25, 7 O, 9383/25 – VEGF-Antagonist I-III

- Regeneron/Bayer v Formycon is the first application of BSH v. Electrolux in national infringement proceedings
- The Court granted a sweeping injunction covering 22 European countries on grounds of a classic European "bundle" patent (in force in all states affected by the injunction) protecting Regeneron/Bayer eye drug Eylea® (decision not final)
- The Court applied foreign laws of the 22 EU countries on substantive law issues of (imminent) infringement
- The Court made a distinction between substantive law issues (governed by the laws of the protection countries) and technical, formal and/or procedural issues (governed by German procedural law as the law of the place of jurisdiction)
- Issues of urgency, necessity and validity, according to the Court, are a procedural question that are to be decided under German procedural law (the law of the place of jurisdiction) in the context of the assessment of the existence of grounds for a preliminary injunction – this also applies in cross-border matters
- A positive decision on the (limited) validity of the patent in suit from the German Federal Patent Court, according to the Court, has a strong "signal effect" as regards any alleged nullity of non-German parts of the European patent
- The finding of infringement under German substantive law has a "lighthouse character" in the other European jurisdictions – therefore, according to the Court, there is no need to obtain an opinion from independent foreign legal expert, otherwise, the effective enforcement of the patent would be undermined

What can we expect from national courts' long-arm jurisdiction in the future?

Onesta v BMW, Munich Regional Court I, docket nos. 21 O 13056/25 and 21 O 13057/25

Increasing pressure on other European countries to join the UPC?

Will national courts' long-arm jurisdiction be turned against the UPC?

Extension of the reach of long-arm jurisdiction of (German) national courts beyond the European patent system?

Recent "test case" – US patents:

- On 30 October 2025, Onesta (NPE) sued BMW over 1 EU Patent and 2 US semiconductor patents before the Munich Regional Court I (based on German procedural law – docket nos. 21 O 13056/25 and 21 O 13057/25)
- BMW filed a declaratory judgment action in the Western District of Texas seeking a temporary restraining order and an anti-suit injunction (ASI) (case ID No. 6:25-cv-00581 - W.D. Tex. 16 December 2025)
- On 16 December 2025, US Judge Alan Albright ordered an anti-suit injunction against Onesta – Onesta may not proceed with its suit at Munich Regional Court (grounds, among others, violation of BMW's right to a jury trial)
- Will Onesta seek an anti-anti-suit injunction (AASI) in Munich – likely to undermine BMW's US ASI motion?
- Onesta is free to disregard judge Albright's order and proceed with the proceedings in Germany – in other ASI proceedings, parties often ignore ASIs from the other side, but potentially severe penalties under US law for contempt of court?

UPC – Exclusive competence?

Art. 32 UPCA

Competence of the Court

1. The Court shall have **exclusive** competence in respect of:

   a) actions for actual or threatened infringements of patents and supplementary protection certificates and related defences, including counterclaims concerning licences;

   (…)

The national **courts** of the Contracting Member States shall remain competent for actions relating to patents and supplementary protection certificates which do not come within the exclusive competence of the Court.

Art. 83 UPCA

1. During a **transitional period of seven years** after the date of entry into force of this Agreement, an action for infringement or for revocation of a European patent or an action for infringement or for declaration of invalidity of a supplementary protection certificate issued for a product protected by a European patent **may still be brought before national courts or other competent national authorities**.
2. **[…]**
3. Unless an action has already been brought before the Court, a proprietor of or an applicant for a European patent granted or applied for prior to the end of the transitional period under paragraph 1 and, where applicable, paragraph 5, as well as a holder of a supplementary protection certificate issued for a product protected by a European patent, **shall have the possibility to opt out from the exclusive competence of the Court**.
4. Unless an action has already been brought before a national court, proprietors of or applicants for European patents or holders of supplementary protection certificates issued for a product protected by a European patent who made use of the opt-out in accordance with paragraph 3 shall be entitled to **withdraw their opt-out at any moment**.

Traditional interpretation v. emerging interpretation

Traditional interpretation:

- If a patent is opted-out → only national courts are competent
- If no opt-out is made → concurrent competence of UPC and national courts during the transitional period

Venice Court's interpretation:

*"It is clear from the correlation between the provisions of Article 32 and the expressions used in Article 83 ("opt- out" and "withdrawal of the opt - out") that, unless the proprietor expressly waives the jurisdiction of the UPC, EU patent cases must be brought **exclusively** before the UPC. Concurrent jurisdiction during the transitional period does not therefore mean that the proprietor can choose which court to bring a particular case before; moreover, this would lead to uncertainty and inconsistencies, both for potential defendants, who would be exposed to the discretion of the proprietor, and for those who wished to bring an EU patent case against the proprietor, since the interpretation given by the claimant does not explain how they should proceed during the transitional period in the absence of an unequivocal signal inherent in the exercise of the opt-out."* (Court of Venice, 4 December 2025, n. 4761)

UPC – Update on Preliminary Injunction ("PI") proceedings

UPC – PI data and statistics

Case load of the UPC since start of operations in June 2023

- The Court of First Instance of the UPC has received a total of 88 applications for provisional measures
- 66 applications for preliminary injunctions
- Preliminary injunctions are more routinely granted (success rate 1st instance ≈ 55%)
- No clear trend has emerged as to whether any particular divisions of the UPC are more likely to grant a preliminary injunction application than others
- No clear sector-related trends
- First substantive decision by the UPC Court of Appeal - NanoString v. 10x Genomics, UPC_CoA_335/2023

General timeline

"Ex parte" PI only in exceptional cases

- Trade fair cases
- If protective letter or bilateral correspondence exist

Short written proceedings and timelines

- Initial response within 2 weeks but extensions for prior art searches normally granted for another 1-2 weeks (ie 2-4 weeks with extension)
- One further round of briefs

Hearing within 2-3 months after PI request was filed

- Decision either at the hearing or at a later (unspecified) date
- Decision can take quite a while depending on the case load of the court

PIs under the UPC's Rules of Procedure ("RoP")

What's the test?

- Need sufficient degree of certainty that (cumulatively):
  - the applicant is entitled to commence proceedings;
  - the patent is valid; and
  - the patent is infringed (or infringement is imminent).
- Balancing of interests of the parties (necessity of PI/potential harm from PI)
- No "unreasonable delay" – urgency

Does the defendant have to be heard?

- No - can be inter partes or ex parte
- *Ex parte* requires:
  - Delay likely to cause irreparable harm
  - Defendant given notice if ordered and further hearing can then take place
- Impact of protective letters

Under what conditions?

- Court may order security (mandatory if ex parte)
- Compensation in damages may be sought if wrongly granted
- Main action must be brought if PI granted (within 1 month)

Which kind of evidence is required in PI proceedings?

"Sufficient degree of certainty" (R 211 No. 2 RoP)

Test: "Preponderant likelihood" that patent is infringed and valid (ie 50+ %)

Not applicable to: (i) the jurisdiction of the UPC, (ii) the urgency requirement and, (iii) the balancing of interests. Here the court must be fully convinced!

Doubts in some respects can be compensated by high assurance in other aspects

The more likely the patent has been infringed and is valid the more a PI is justified

Does an application for a PI need to be filed within a certain deadline?

"Undue delay" R.211.4 RoP

No "fixed deadline" for filing request for PI

LD Munich:	LD Dusseldorf:	LD Hamburg:	LD Paris:	LD The Hague:
Filing within 1 month is sufficient	Request needs to be filed within 2 months	3 months is too late	3 months is sufficient	12+ months under the circumstances of the individual case

- Court of Appeal ("CoA") has confirmed that there is no "fixed deadline"
- CoA has not definitively decided on this, but seems to accept 2-3 months
- The standard is whether the applicant's conduct as a whole justifies the conclusion that the enforcement of its patent rights is (not) urgent – no "sit and wait"

Urgency requirement – Practical implications

Applicant does not need to take risks but may collect all evidence needed in view of burden of presentation and proof, also considering that a main action needs to be filed shortly after the PI decision

Clock only starts ticking after all necessary evidence has been collected, even if collection of evidence is complex and takes some months (as it can in pharmaceutical cases)

"Unreasonable delay" if applicant has behaved in such a negligent and hesitant manner after getting knowledge of infringement that, from an objective perspective, it must be concluded that there is no interest in promptly enforcing its rights (no "sit and wait"!)

Applicant is expected to be diligent in seeking a remedy against an alleged infringer, and any unreasonable delay could lead to a dismissal of the PI

The burden is on the applicant to show that it has not delayed unnecessarily

The applicant must provide the court with the information of the moment when it became aware of the infringement

Necessity of PI and balancing of interests

Syngenta v. Sumi Agro, CoA, 3 March 2025, UPC_CoA_523/2024

Guiding principles

- Proceedings on the merits are the **standard** (default) for initiating patent infringement actions before the UPC
- Procedure for provisional measures can only be applied if a **decision on the merits cannot be awaited** under exceptional circumstances (“irreparable harm”)
- Exceptional circumstances may relate to **temporal and/or factual necessity**

Relevant "necessity"-test: Focus on competition aspects

- **Starting point**: are the parties competing with each other?
- Risk of price pressure?
- Potential long-run effects, eg price-erosion, profitability?

Balancing of interests

- Proportionality defense
- Third-party damages
- De-facto automatic injunction

Burden of proof & presentation

- The burden of proof for the necessity of a preliminary injunction lies with the applicant.
- **However**, the applicant is not required to demonstrate and **quantify** how its own product sales are impacted by the market entry of the infringing product
- If quantification were generally required, **imminent infringements** could not be prevented by the UPC
- Burden of presentation and proof of the invalidity of the patent lies with the defendant

Imminent Infringement

Boehringer v Zentiva – CoA, 13 August 2025, UPC_CoA_446/2025, UPC_CoA_520/2025

- LD Lisbon rejected PI request by Boehringer, CoA reversed decision, holding that when a potential infringer has done all the preparations in order to be able to directly start with the infringement, this could present imminent infringement.
- **"Set the Stage"-Test:**

  "…*the legal test when an infringement has not yet occurred, is whether the potential infringer has already set the stage for it to occur, so that the infringement is only a matter of starting the action because the preparations for it have been fully completed*."

- "Self-restraint" of potential infringer is the only reason why infringement has not occurred yet.
- Examples of evidence: publicly listing products, importing, or storing products in preparation for launch, receiving CE mark approval combined with competitive context and/or setting-up of EU-wide distribution channels may justify a preliminary injunction.
- Imminent infringement risk in only one UPC country can justify preliminary injunctions for all 18 UPC countries!

Strategic Considerations

Front-loaded character of proceedings

"Parties shall cooperate with the Court and set out their full case as early as possible in the proceedings." (RoP Preamble-7)

*"In proceedings at the UPC, parties shall set out their full case as early as possible. This is also referred to as the "*front-loaded character*" of UPC proceedings. The front-loaded character of UPC proceedings is aimed at ensuring that proceedings can normally be conducted in a way which allows the oral hearing to be conducted in within one year. The front-loaded character also serves the principles of fairness and equity by preventing a party (and the Court) from being confronted with and having to react to new evidence and arguments unreasonably late in the proceedings."* (UPC Munich CD, 25 July 2024, case 252/2023 and UPC CoA, 28 May 2024, case 22/2024).

Strategic points to consider (selected)

Claimant	Issue	Defendant
Value and/or strength of the patent, risk of central revocation vs flexibility to enforce the patent before the UPC and/or individual European national courts, risk of "locking-out" the patent from the UPC by third party national proceedings	Staying-in, opt-out and withdrawal from opt-out (traditional European "bundle" Patent (EP))	Monitor registry; act swiftly
Identify (anchor) defendant(s) in UPC, EU and/or EPC countries, commercial/corporate connections, specific infringing activities, supply chains, intermediaries, strategic use of forum shopping and long-arm jurisdiction	Jurisdiction	Group structure; marketing and online activities
Team-up internally and externally, implement cross-border coordination teams, communication and escalation channels, anticipate multiple validity attacks, prepare auxiliary requests, claim construction	Timing and deadlines	Emergency teams; protective letters; DJ actions; enroll experts
Consider measures in the context of a global litigation campaign, timing and strict urgency requirements in different countries ("too early" v "too late"), timing of claim construction, strategic use of forum shopping, cross-border use of evidence, identify imminent infringement risks, act quickly and decisively (no "sit and wait")	Preliminary injunctions	Delay in action; balance

Strategic points to consider (selected) - *continued*

Claimant	Issue	Defendant
Predictability, forum shopping, long-arm jurisdiction, goal(s) of litigation, central enforcement vs multiple validity attacks, bifurcated system (Germany), costs, technical judge	UPC v. national litigation	Move first; multiple bullets
Similar to PI, claim construction, inventive step, equivalence, indirect infringement, imminent infringement, evidence, damages, settlement, costs, experts	Infringement actions	Claim construction; Lab tests
Anticipate validity attacks, prepare validity defense packages and auxiliary requests early	Revocation actions	EPO oppositions; national invalidity actions
Close market and competitor surveillance, pre-market launch activities, pre-filing evidence preparation ("front-loaded" system), forum shopping, proactive strategy, 1782 U.S. Discovery, request for preservation of evidence and court-ordered evidence production	Gathering evidence	Dawn raid preparation; document segregation; confidentiality
Global settlement strategy, enroll commercial/patent valuation experts for damages calculation and modelling early on	Damages	The value of the infringed features

Costs and time

Costs

Representation costs

- Dependent on case and circumstances, proceedings tend to be more expensive than continental European national proceedings, but still substantially cheaper than US or UK proceedings

Recovery of costs (attorney fees)

- "Loser Pays" Principle
- Recoverable costs ceiling
- Dependent on value in dispute (EUR 250k – EUR 50+ million), recoverable EUR 38k up to EUR 2 million, in exceptional cases up to EUR 5 million

Court fees

- Dependent on type of procedure
  - Infringement action dependent on value in dispute EUR14,600 up to EUR444,900
  - Revocation action flat EUR36,500

Timing

General

- UPCA envisions (main) proceedings to have a hearing within 12 months
- Actual timing varies between different Local Divisions
- Busy divisions have more trouble setting hearing dates within the time frame resulting in up to 18 months until an oral hearing
- UPC generally reacts quickly in appointing new judges and creating new panels to manage work of busy Divisions
- Deadlines for briefs in revocation actions are shorter; thus, revocation actions can be slightly quicker than infringement actions

Preliminary Injunction

- Common timeframe for PIs is three months for a hearing
- For urgent matters (ex parte) PIs can and have been granted much quicker, ie within weeks or days in the case of trade fairs

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UPCA* in force

UPCA* signatory states

Other EU members states

*UPCA stands for "*Agreement on a Unified Patent Court*"

Thank You!

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Asia IP Symposium 2026

Tokyo, Japan / Thursday, February 26, 2026

Recent Developments in Global Patent Litigation Part 1

Aoife Murphy
Daniel Valencia

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Recent Developments in Global Patent Litigation- EU Perspective

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Aoife is an experienced commercial litigator with particular focus on intellectual property. She advises a wide range of indigenous and multinational clients on all aspects of intellectual property issues, patent, trademarks, copyright and design related intellectual property matters. She is particularly experienced in multi-jurisdictional patent disputes and has acted in some of the most high-profile patent cases to come before the Irish Courts in recent years. She has acted in more patent related disputes in the Commercial Court list than any other practitioner in Ireland in the last number of years. Her experience often involves Irish "firsts", such as acting in the first biologic/biosimilar litigation in Ireland, the first cross-border preliminary injunction application in Ireland and the first proceedings brought anywhere in Europe relating to a derogation sought under the SPC manufacturing waiver. She has also acted in most of the preliminary injunction applications relating to patent and SPC matters before the Commercial Court since 2018, including all of the cross-border preliminary injunctions to come before the Irish Court. She has also acted in all of the patent proceedings relating to medical devices to come before the Irish court in the past 12 years.

She has considerable experience in life science matters particularly medical devices, biosimilars and well as patents in other sectors. Aoife is involved in claims of infringement and revocation of patents and SPCs which protect pharmaceuticals, medical devices, biotechnology, electronic point-of-sale systems and drone technology. She most recently represented MSD in an appeal before the Supreme Court, securing the first reference in a Patent/SPC matter from the Irish Court to the CJEU on the core issue in the appeal namely, the appropriate interpretation and application of Art 3(a) and 3(c) of SPC Regulation.

She has acted for manufacturers and brand owners in trade mark, passing off and unfair competition litigation. She also represents clients in copyright, licencing and ownership disputes. Aoife sits on the Intellectual Property Law Committee of the Law Society of Ireland.

Summary Overview – Recent developments

- **Growth of importance of the UPC** (particularly in technology related disputes. Life Sciences patent litigation still relatively low aside from secondary patents and med-tech patents.)
- **National Courts remain central** to patent litigation particularly for **non-participating countries and "opted-out" patents** (largely attributed to companies avoiding the risk of a single, central invalidity challenge before the UPC).
- Continued cross jurisdictional **patent litigation and preliminary injunctions before National Courts** including relating to Blockbuster drugs.
- Emergence and increase in **cross jurisdictional preliminary injunctions** following CJEU Decision in *BHS v Electrolux.*
- Developments in **SPC Litigation.**
- **Technology Litigation** including SEP Licencing disputes.
- Rise in disputes involving **consumer and household technology** e.g. *Dyson v Dreame*, *Dyson v SharkNinja, Fujifilm v Kodak.*

Summary Overview – Recent developments

- **Ongoing Vaccine Patent Litigation (not just Covid-19 related)** (incl. *CureVac v BioNTech, Moderna v BioNTech/Prizer, GSK v BioNTech/Pfizer, Arbutus v Moderna).*

- **AI Patentability** (*Emotional AI Ltd v Comptroller General of Patents*)

- **EU Regulatory Developments including**:

  -European Parliament and Council of EU reached agreement on proposed **Pharma Reforms** (will affect regulatory exclusivities and extend the bolar exemption) in Dec 2025;
  -European Commission published the **EU Biotech Act;**
  -European Parliament and Council reached agreement on **compulsory patent licencing for crisis management**;
  -Draft proposals for a regulation on the **unitary SPCs** for medicinal products.

Preliminary Injunctions – Update Europe

Approach and Conditions for obtaining a PI vary across the EU

- **Main Divergences:**
  - Mini trial on the merits *vs* a cursory review at the PI stage
  - Strong **presumption of validity** *vs* none at all
  - Very strict *vs* loose "**urgency**" requirements
  - Multi-days vs 2-hour trial
  - **Level of Evidence** required varies for eg of irreparable harm
  - **Cross undertakings in damages** or **bonds?**
  - Whether **protective letters** can be filed (e.g. Germany yes, Ireland and the UK no)
  - Whether ***ex parte* PIs** will be granted
  - Speed to the hearing of the PI
- **Different legal thresholds are applied e.g.:**
  - Preserving the status quo
  - Risk of irreparable harm
  - Balance of convenience/ interests (relevant in some jurisdictions)
  - Reasonable, non-negligible chance that the patent is held invalid or not infringed etc.

Conditions for obtaining a PI - examples

In the **UK** the test for the grant of a PI are set out in ***American Cyanamid***:

- Is there a **serious issue to be tried**;
- **Damages must not be an adequate remedy**;
- The b**alance of convenience** must favour the grant of an injunction.

These are assessed as a series of hurdles. (Note some recent cases have fallen on adequacy of damages)

In **Ireland**, the test in set out in ***Merck Sharp & Dohme Corp. v Clonmel Healthcare Ltd*** **[2019]**

PIs are granted if the party seeking the injunction establishes:

- There is a **fair and serious issue to be tried** (i.e. that the case is not frivolous or vexatious); and
- The **balance of convenience** favors an injunction.

Factors that must be weighed up by the Court include: The ***status quo***, the **presumptive validity of patent/SPC rights**, whether for e.g. a generic company could have **cleared the way**, the **harm that would be suffered** pending the main trial etc. It is not necessary for a claimant to establish a *prima facie* case i.e. that on the balance of probabilities it is more likely than not that the claimant will succeed at trial.

Strategic Use of PIs in National Proceedings

- **Strike against a key link in the regulatory or distribution chain:**
  - MA holder
  - Manufacturing
  - Packaging

- **Early Triggers:**
  - SPC Waiver notifications? (See Janssen Stelara (ustekinumab) PI actions including in Ireland and US)

- **Potential Cross Border actions**:
  - Customary in NL, also potentially in France
  - Long arm Jurisdiction (see below)

Examples of recent PI Applications - national courts

- ***Biogen v Generics* (Tecfidera)**
  - Multiple proceedings and PI applications around the EU relating to EP 653 873 protecting Tecfidera that is used in the treatment of multiple sclerosis ("MS").
  - Presumption of validity in some countries.
  - Parent patent had been revoked by the Opposition Division ("OD") of the EPO and the patent in issue was a divisional.
  - Negative OD opinion did not prevent a PI being granted in Denmark.
  - Patent was subsequently revoked by the EPO Technical Board of Appeal.
- ***Novartis v Generics* (Gilenya)**
  - Multiple proceedings and PI applications across the EU relating to a patent that protected an oral treatment for MS.
- ***BMS/Pfizer v Generics* (Eliquis)**
  - Multiple PI applications around the EU relating to an SPC that protects anticoagulant medication Eliquis (apixaban)
- ***Janssen v Generics* (Stelara)** (See details below)

Other key cross-border Pharma / Biologics and Biosimilars Disputes

- ***Regeneron/Bayer v Formycon*** **(Eylea)**
  - Leading biologic used to treat retinal disease e.g. age-related macular degeneration.
  - Developed by Regeneron. Commercialised by Bayer.
  - Proceedings brought in reliance on a **formulation patent** EP 2 364 691 that potentially extends exclusivity to **June 2027** (relied on to maintain exclusivity following expiry of the key substance SPC in Nov 2025).
  - Samsung Bioepis had unsuccessfully challenged the patent before the German Federal Patent Court.
  - **Bayer subsequently sought a PI against Formycon's biosimilar** product before the Munich Regional Court relying on the doctrine of equivalents and the CJEU's *BSH v Electrolux* decision which was granted in **September 2025** across **21 jurisdictions**.
  - In **January 2026**, further PIs granted against Stada, Hexal, Celltrion and Advanz Pharma across multiple jurisdictions.

  - (Note in proceedings before the UK High Court, the Court refused to a PI application brought against Alvotech challenging reliance on SPC Manufacturing waiver.)

Contd.

- **Sanofi v Generics (Jevtana)**
  - Sanofi's blockbuster **Jevtana drug** is used to treat prostate cancer.
  - Sanofi had defended its second medical use patent EP 2 493 466 in various proceedings before national courts over a number of years.
  - Sanofi filed an infringement action at the UPC (Munich LD) against Accord, Zentiva, Stada and Dr Reddy relying on the patent in May 2024. Counterclaims for revocation were filed by the generics companies.
  - The UPC revoked the patent in **December 2025** across multiple EU countries (Austria, Belgium, Denmark, France, Germany, Italy, the Netherlands, Portugal and Sweden).
  - The Court ruled that the patent lacked inventive step and dismissed the infringement claims.
- **Boehringer v Zentiva (Ofev)**
  - The Lisbon LD of the UPC rejected a PI request by Boehringer against Zentiva.
  - In **August 2025**, the UPC Court of Appeal revered the decision, granted a PI to Boehringer against Zentiva blocking a generic version of the respiratory drug Ofev across 17 UPC states.
  - The question of "imminent infringement" was considered and how it interplays with the Bolar exemption with the court holding that when a potential infringer has done all the preparations in order to start with the infringement, this could constitute imminent infringement.
- **Novo Nordisk v Generics (Semaglutide)**
  - Novo successfully defended a crucial EP Patent (EP 3 746 111 B1) covering the tablet form of semaglutide.

Long Arm Jurisdiction

Long-Arm Jurisdiction

- The concept of long arm jurisdiction refers to a court's authority to hear and rule on the alleged infringement of foreign patents. It functions as a potential mechanism to address cross-border harms.
- For the UPC, this means determining infringement of a patent in countries that are non-EU/UPC contracting states (e.g. Spain, Poland, Ireland, the UK, Switzerland or Turkey.

Legal Basis - Brussels I Recast (Brussels I bis):

- Art. 4(1) — jurisdiction based on defendant's domicile.
- Art. 7(2) — jurisdiction where the place of infringement occurred or may occur.
- Art. 8(1) — jurisdiction via close connection among multiple defendants.
- Art. 35 — provisional measures with a real connecting link.

BSH Hausgerate v Electrolux (CJEU)(C-339/22)

- BSH sued Electrolux in Sweden claiming infringement of a patent relating to **vacuum cleaner technology** covering Germany, France, Italy, the Netherlands, Austria, Spain, Greece, the UK and Turkey. Electrolux counterclaimed for revocation of the Swedish designation of the patent and raised the invalidity of other designations outside Sweden as a defence. The dispute led to a referral of a number of questions to the CJEU.

- **The CJEU (Case C-339/22) held:**
- National courts retain jurisdiction over cross-border infringement claims even when validity of foreign national patents is contested, as long as validity is only raised inter partes.

- Courts of EU member states where the defendant is domiciled can assess validity **for the purpose of deciding infringement of a patent granted in another member state or third county**, but **their decisions do not affect the patent's legal status** or national registers in other states.

- The court hearing the dispute may at its discretion stay the proceedings where there is a "reasonable and non-negligible chance" that the national court may find the patent invalid.

Dyson v Dreame International and others

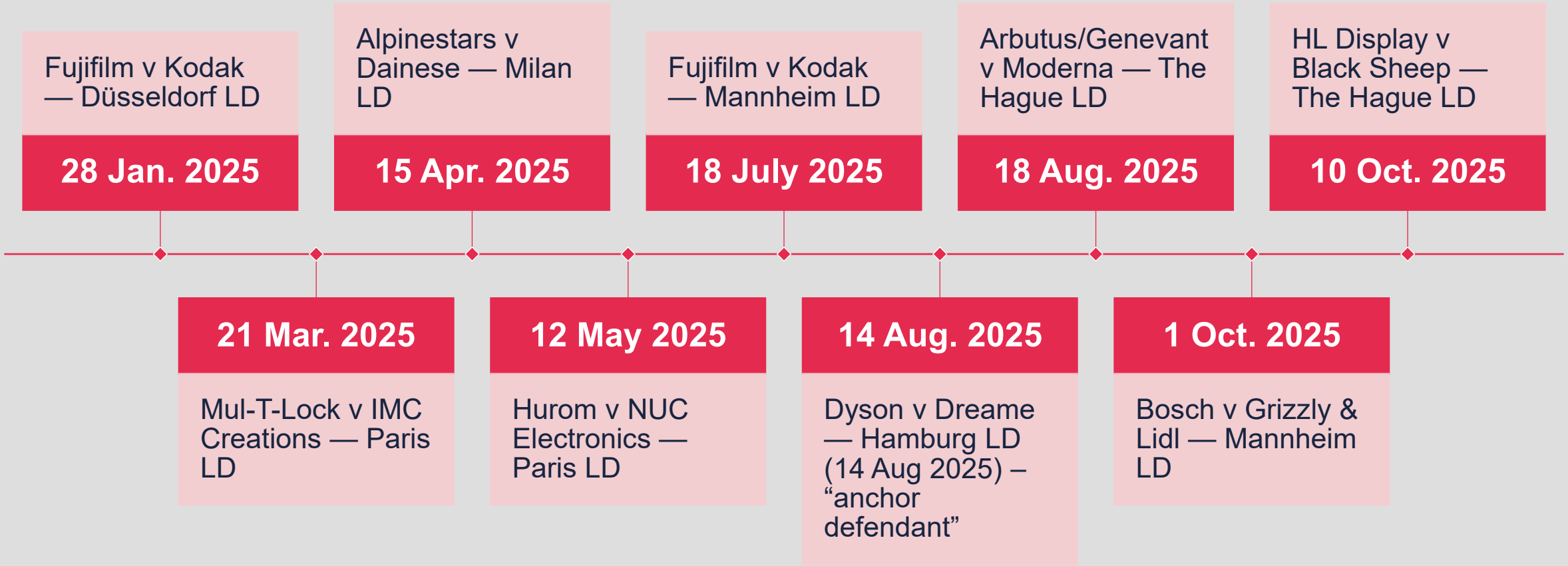
Dyson sued **Dreame** for infringement of a patent that covers an attachment for a handheld device. Proceedings were issued against four defendants including Dreame International, a Swedish subsidiary, a German Sales partner and Eurep GmbH ("Eurep"). Eurep acing as an **authorised representative** for non-EU manufacturers served as an anchor defendant.

Dyson alleged that certain Dreame hair stylers (under Dreame AirStyle and Dreame Pocket brands) infringed its patent rights which covered an attachment for a handheld hair care appliance (used in the Dyson Airwrap) arguing that Dreame's hair styling devices incorporated an attachment mechanism and airflow technology that closely mirrored the patented design and function of Dyson's Airwrap.

A PI was granted by the Hamburg Local Division in August 2025 prohibiting Dreame from selling the alleged infringing product across all 18 UPC member states as well as Spain. (Whilst not a UPC member state, the PI was extended to Spain via an anchor defendant following the *BSH v Electrolux* decision. The PI only prohibited older versions of the products, finding the main products did not infringe the patent.

The decision was appealed to the **UPC Court of Appeal by both parties. The appeal was heard in January 2026**. A decision is awaited.

UPC Long-Arm Decisions



Strategic considerations

Claimants:

- Can potentially use the UPC to obtain consolidated multi-territorial relief.

Defendants:

- Consider pre-emptive national invalidity actions (EU/Lugano) to potentially trigger stays.
- Raise foreign-law divergences early - failure can be determinative.
- Removing potential anchor defendants from UPC territories may limit jurisdiction.

General:

- The UPC has tended to adopt a generous approach towards "**Anchor Defendants**," eg citing criteria such as being the European registered representative (household appliances which require CE approval) or holding an MA for a pharmaceutical product or being responsible for batch release.
- Does long-arm jurisdiction undermine the sovereignty of EU member states that opted not to join the UPC?
- Questions remain about **compatibility with TRIPS** (e.g., Art. 28 exclusive right granted by a patent).
- It is unclear how the UPC will apply its discretion to stay infringement proceedings if a validity dispute is pending.

SPC Litigation Developments

What is an SPC?

A Supplementary Protection Certificate ("SPC") extends the exclusive patent rights for pharma products by up to 5 years after patent expiry. They take effect immediately after the patent expires. The average duration of an SPC granted in the EU is 3.5 years.

Intention is to compensate for the time it takes to get a medicine approved.

A further 6 month "pediatric extension" is potentially available.

The Test for Grant of an SPC

Regulation 469/2009

Article 3 of the SPC Regulation provides that in order to obtain an SPC in respect of a particular product, the following criteria must be satisfied:

(a) the **product** is **protected by a basic patent in force**;

(b) a valid authorisation to place the product on the market as a medicinal product has been granted in accordance with the applicable Directive;

(c) the **product has not already been the subject of a certificate**;

(d) the **authorisation referred to in point (b)** is **the first authorisation to place** the product on the market as a medicinal product.

Product is defined as meaning “the active ingredient or combination of active ingredients of a medicinal product”

The current big topics, developments and battle grounds around SPC's

1. The recent decisions of the CJEU in C-119-22 and C-149/22 in respect of **Articles 3(a) & (c) of the SPC Regulation: in relation to combination SPC's.**

- **Teva/MSD (C-119/22)** – Sitagliptin/Metformin (Finland)
- **MSD/Clonmel (C-149/22)** – Ezetimibe/Simvastatin (Ireland)

2. CJEU decision is pending Czech Referral in **Halozyme (C-456/24)** in respect of **Article 1(b) of the SPC Regulation -** whether a substance designated as an excipient in an MA can be considered an active ingredient.

3. **Whether SPC's can be granted for Pro Drugs.**

   - A Prodrug is a compound that, after administration, is metabolized in the body.
   - Diverging Court decisions from Germany, Sweden, Denmark and Switzerland relating to Takeda's Elvanse prodrug for ADHD.

4. **Multiple disputes under the SPC Manufacturing Waiver.**

The EU SPC Manufacturing Waiver

The SPC manufacturing waiver which entered into force on **1 July 2019**, introduced further exceptions to the protection conferred by an SPC that permitted:

- The obtaining of waivers by generic and biosimilar makers to allow manufacture of SPC-protected products for export to non-EU countries where intellectual property protections for those products have expired or never existed (i.e. Where there is no patent or SPC protection).
- Stockpiling of generic and biosimilars for launch in the EU during the last 6 months prior to expiry of the SPC to enable day 1 market entry.

- Requires certain conditions to be met, notification of the national patent office and the SPC holder no later than three months before the intended start of manufacture (or the first related act), labelling requirements etc.
- National patent office must publish the notification information together with the date of notification.
- The information to be notified to the national patent office includes the name and address of the manufacturer, details of whether the manufacture is for the purpose of export, storage or both export and storage; the state where the manufacture is to take place, the SPC number, the reference number of the marketing authorisation in each third country of export etc. i.e. covered real commercial activities.

SPC Manufacturing Waiver

Article 5 of Regulation (EC) No 469/2009 (as amended by Regulation (EC) No 933/2019)

Article 5(1) subject to the provisions of Article 4, the certificate shall confer the same rights as conferred by the basic patent and shall be subject to the same limitations and the same obligations.

5(2) by way of derogation from paragraph 1, the certificate referred to in paragraph 1 shall not confer protection against certain acts which would otherwise require the consent of the holder of the certificate, if the following conditions are met:

The acts comprise:

i. The making of a product, or a medical product containing that product **for the purpose of export to third countries**; or

ii. Any related act that is strictly necessary for the making in the Union, referred to in point (i), or for the actual export; or

iii. The **making, no earlier than 6 months before the expiry of the certificate, of a product or a medicinal product containing that product, for the purpose of storing it in the Member State of making, in order to place that product, or a medical product containing that product, on the market of Member States after the expiry of the corresponding certificate**

iv. Any related act that is strictly necessary for the making, in the Union, referred to in point (iii), or for the actual storing, provided that such related act is carried out no earlier than 6 months before the expiry of the certificate

(b) The maker, through appropriate and documented means, notifies the authority referred to in Article 9(1) in the Member State in which that making is to take place, and informs the certificate holder, of the information listed in paragraph 5 of this Article no later than 3 months before the start date of the making in that Member State, or no later than 3 months before the first related act, prior to that making that would otherwise be prohibited by the protection conferred by a certificate, whichever is the earlier.

Proceedings regarding EU SPC Waiver

Janssen Biotech Inc v Amgen Ireland – (IE Litigation) Stelara®	First action brought in the EU relating to a derogation sought by Amgen under Article 5(2)(a)(i)&(ii) of Regulation 469/2009 (as amended by the 2019 Regulation), for the purpose of manufacture for export to a third country (USA). Matter resolved prior to hearing.	Resolved between the parties in advance of hearing on confidential basis.
Janssen Biotech Inc v Formycon (DE Litigation) Stelara ®	Formycon announced its intention to invoke the exception rule under Article 5(2)(a)(i)&(ii) of Regulation 469/2009 by manufacturing a biosimilar of Janssen's Stelara (which is protected by SPC until July 2024), for export to third countries where the SPC is not in force. PI granted by Regional Court of Munich to Janssen. Court reached its decision due to inter alia a finding of a lack of marketing authorisation number or equivalent for the biosimilar in the country of export.	PI Granted. (20 October 2023)
Janssen Biotech Inc v Samsung Bioepis NL BV (NL Lit) Stelara ®	Samsung announced its intention to involve the exemption under the SPC Regulation by manufacturing a biosimilar of Janssen's Stelara in Denmark and Italy for the purpose of exporting to third countries (Article 5(2)(a)(i) & (ii) and also for the purpose of stockpiling and placing the product on the EU market after SPC expiry (Article 5(2)(a)(iii) & (iv)). PI was refused by the Dutch Court.	PI refused at First Instance (23 January 2024), PI Refused on Appeal (April 2025).
Amgen Inc. and Amgen Fremont v Samsung Bioepis (BE Litigation) Prolia ® Dec 2024	Samsung announced its intention to invoke the exemption under the SPC Regulation by manufacturing a biosimilar of Amgen's denosumab product for export. The Enterprise Court of Brussels followed the decision of the Dutch Court and ruled that (i) manufacturers are not obliged to provide the reference number of their marketing authorisation or to specify the third countries to which they plan to export at the time of notification and (ii) the SPC manufacturing waiver permits temporary storage of product intended for export, as long as its duration is one that is customary in the normal course of business.	PI refused at First Instance. (23 December 2024)

Proceedings regarding EU SPC Waiver

Regeneron v Sandoz (BE Litigation) Eylea®	The Brussels Enterprise Court held that manufacturers can validly notify for export without pre-existing marketing authorisation and without disclosing potential third countries of export. This decision aligns with Belgian and Dutch rulings and rejects the approach taken by the German Court.	PI refused (13 November 2025)
Regeneron v Alvotech (UK Litigation) Eylea®	The English Court held that SPC waiver notifications for export do not need to include marketing authorization reference numbers, meaning that manufacturers can start the three-month notice period without waiting for MA grant.	PI refused (24 November 2025)

Key arguments run in the Case Law

Focus of the arguments in the Cases brought to date have been on:

1. Whether a maker needs to provide a **reference number** of a **granted authorisation** in the country of intended export in the export waiver notice;
2. Whether the country of intended export needs to be **IP free**; and
3. Whether **stockpiling** of product is permitted.

German Court

The Respondent could not rely on the manufacturing waiver because it had neither provided the MA number nor disclosed the third country of intended export.
The SPC waiver is an exemption to the rights granted to the SPC holder and must be read restrictively and is not designed to allow the manufacture for export to countries in which the SPC holder holds IP rights.
The 3 month period is to allow the SPC holder to check that the product is not being exported to a country where there are IP rights in place.

Dutch Court and Belgian Courts

A reference number of the MA is not required per se: it can be added at a later date once publicly available.
The countries of intended export are not required to be patent-free and the manufacturer is not under an obligation to prove that there are no live patents in force in the countries of intended export.
Dutch and Belgian Courts held that stockpiling of medicines is allowed as long as it is strictly necessary and only for a usual period of time in regular business. What precisely is meant by strictly necessary and usual period of time in regular business was not explained/expanded upon.

Prodrug: SPC Litigation

A **prodrug** is a compound that, after administration, is metabolized in the body into a pharmacologically active drug (the “active metabolite”). The prodrug itself may have little or no pharmacological effect until it is converted into its active form.

Central issue in the **Takeda (lisdexamfetamine) prodrug SPC cases** is whether the “product” for the purpose of Art. 1(b) of the SPC Regulation is:

- **Lisdexamfetamine (prodrug)**
  or
- **Dexamfetamine (metabolite)**

If the prodrug is the active ingredient, then the MA for the prodrug can support an SPC.

If the metabolite is the active ingredient, then the MA for the prodrug is not the first MA and an SPC cannot be granted.

The distinction is important because SPCs are only granted if the MA is the first for that “product” under Article 3(d) of the SPC Regulation.

Prodrug: Diverging National Decisions

Country	Outcome	Key Reasoning of the Court	Approach to Active Ingredient
Germany (4 June 2024)	**SPC revoked** **First instance**	Lisdexamfetamine and dexamfetamine are the same active ingredient. The prodrug does not have a pharmacological effect on its own. **The MS for lisdexamfetamine is not the first MA for the active ingredient.**	Active ingredient is dexamfetaine not lisdexamfetamine
Sweden (21 Jan 2025)	**SPC upheld** **First instance**	MA/SmPC lists lisdexamfetamine as the active substance. Regulatory Authorities granted New Active Substance (“NAS”) status to Lisdexamfetamine etc. **A prodrug can be a new active ingredient**.	Active ingredient is lisdexamfetamine
Denmark (18 Feb 2025)	**SPC upheld** **First instance**	MA/SmPC lists lisdexamfetamine as the active substance. Regulatory Authorities granted NAS status to Lisdexamfetamine etc. **A prodrug can be a new active ingredient.**	Active ingredient is lisdexamfetamine
Switzerland (12 June 2025)	**SPC upheld** **First Instance**	MA/SmPC lists lisdexamfetamine as the sole active substance. Lisdexamfetmine has pharmacological effect of its own and is authorised as a new substance.	Active ingredient is lisdexamfetamine

Some Key Technology Litigation Cases in the EU

Some Key Recent technology incl. SEP Patent disputes

VoiceAge v HMD **(Munich Higher Regional Court)**

- A major standard-essential patent ("SEP") case in the mobile telecoms space relating to VoiceAge's EVS speech-coding SEPs.
- The dispute related to EVS speech-coding patent.
- The Munich Higher Regional Court held that HMD had infringed a VoiceAge Patent and confirmed that HMD (Nokia phones) was an *unwilling licensee* under FRAND principles because it refused to provide adequate security eg a bank guarantee.
- HMD were barred from distributing EVS enabled devices in Germany.
- **Leave to appeal to the German Federal Court of Justice, limited to FRAND was granted.**
- **The appeal was heard on 27 January 2026. A decision is awaited.**
-

Technology Patent Cases – Contd.

Apple v Optis **– (UK Court of Appeal)**

- A continuation of the long-running global litigation over **4G/LTE SEPs** in a portfolio licensing dispute.
- Court of Appeal overturned a key part of the High Court ruling and ordered Appeal to pay Optis a substantially higher FRAND royalty for its global 4G standard essential portfolio.
- **Apple was required to pay a lump sum of $502 million (excluding interest) for the period 2013-2027**.
- (The High Court had set royalties at just $56.43 million. The Court of Appeal seta FRAND rate of $.015 per apple device relying primarily on comparable licence agreements involving Otis, Apple and other SEP licensors eg Ericsson, Nokia and InterDigital.)
- Apple appealed the decision to the UK Supreme Court. A decision is awaited.
- **(This is the third time that the UK Court of Appeal revised a High Court FRAND determination (following Unwired Planet v Huawei and InterDigital v Lenova).**

Technology Patent Cases – Contd.

Ericsson v Lenovo **(UK Court of Appeal)**

- Part of a multi-year global **4G/5G SEP** battle across the UK and Germany.
- In February 2025, the UK Court of Appeal held that Lenovo was entitled to an interim FRAND licence, overturning the decision of the High Court.
- Held that Ericsson had breached good faith FRAND negotiation duties under ETSI Clause 6.1 by pursuing injunctions abroad while Lenovo had undertaken to accept UK determined FRAND terms.

Amazon v Nokia **(UK High Court & German Courts)**

A dispute over multiple patents covering **video streaming**, multimedia service provisioning, content recommendation, and video codes.

Amazon sought FRAND declarations in the UK while **Nokia sought injunctions from the German Courts**.

Conflicting decisions from the UK and German Courts.

- Germany (Düsseldorf & Munich): Granted injunctions against Amazon's Prime Video and streaming devices, finding infringement of Nokia's video delivery patents.
- UK High Court: Amazon sought FRAND declarations.

A global settlement was subsequently reached between the parties.

Technology Patent Cases – Contd.

InterDigital v Lenovo **(UK High Court & Court of Appeal)**

- Relates to 3G, 4G, and 5G SEPs declared essential under the ETSI framework.
- SEPs relate to foundational cellular communication technologies implemented in Lenovo smartphones since 2007.
- The UK High Court held that FRAND terms must apply to **all past sales**, even those **outside limitation periods**, because a willing licensor and licensee would have agreed to such terms. Rejected Lenovo's argument that payments should be limited to statutory damages periods.
- **The UK Court of Appeal**:
  1. **Increased total FRAND payment**
     - Adjusted per-unit rate to $0.225, increasing the payable lump sum to **$178.3m + interest**.
  2. **Confirmed FRAND applies outside limitation periods**
     - (Court expressed the view that a willing licensee would not refuse to pay licence fees on old sales, and allowing Lenovo to avoid payment would incentivise hold-out, which is contrary to FRAND principles).
  3. **Adjusted the methodology for comparable licences**
     - Criticised High Court's heavy reliance on a single comparable (LG 2017) and corrected errors in unpacking that licence.
  4. **Reaffirmed UK courts' authority to determine worldwide FRAND terms**
  5. **Permission to appeal** the decision to the UK Supreme Court was **refused.**

AI Patentability – Emotional Perception AI Ltd v Comptroller-General of Patents

Patent protection – AI technologies

Issue = excluded subject matter

Emotional Perception AI Ltd v Comptroller-General of Patents

- System for providing media file recommendations to an end user
- Uses a trained Artificial Neural Network (ANN)
- UKIPO rejected patent application – computer program as such

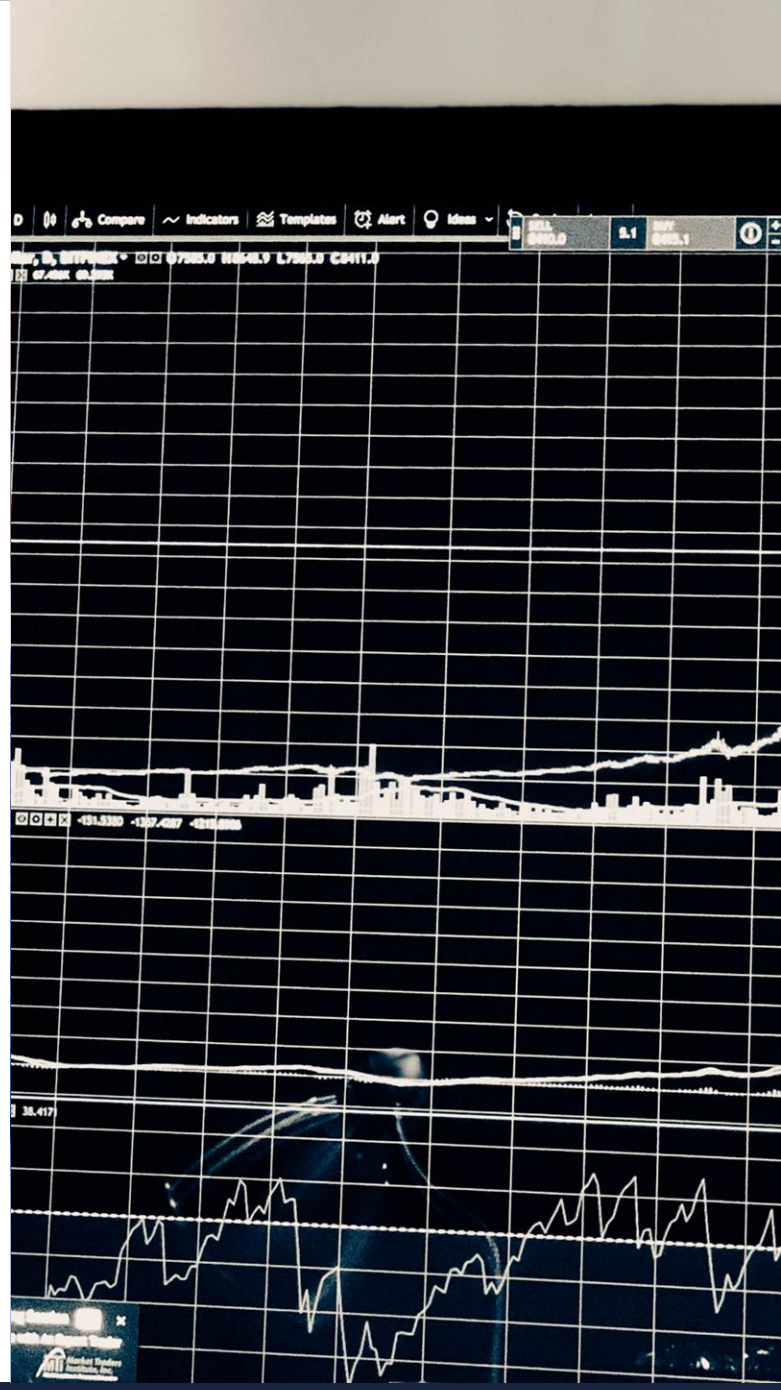
Appeal to UK High Court (December 2023)

- Questions: (1) computer program as such? (2) technical effect?
- ANN does not amount to a computer program – learn via training process, not implementing code from human. Exclusion from patentability not engaged.
- If wrong – does computer program make a technical contribution outside of itself?
- Yes: identification and movement of the media file – analysis and selection in a technical way. Subjective and cognitive nature irrelevant
- UKIPO Guidance suspended pending proper consideration

Appeal to Court of Appeal (July 2024)

- Reversed HC decision – ANN was a computer program
- Technical effect? No – recommendation based on aesthetics

Appeal to the Supreme Court – Decision delivered on 11 February 2026!



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Tokyo, Japan / Thursday, February 26, 2026

Recent Developments in Global Patent Litigation Part 1

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Education

J.D., The George Washington University Law School
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B.S., Electrical Engineering, University of Maryland

Admissions

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Languages

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Daniel Valencia is a *Chambers*-ranked trial lawyer who represents a wide range of clients in high stakes, cross-border intellectual property and trade disputes. He has tried numerous cases before judges and juries. He has also briefed and argued appeals at the Federal Circuit. Daniel combines a background in electronics with his litigation experience, to provide clients with sophisticated, creative strategies in even the most complex Internet Protocol (IP) and trade disputes.

Daniel has significant experience in Section 337 proceedings before the US International Trade Commission (ITC), having previously worked at the agency as a trial attorney, appellate counsel, and advisor to the Commissioners. He draws upon this familiarity with all levels of the ITC's decision-making to offer practical and insightful counsel to clients appearing at the ITC as both complainants and respondents. He also advises clients on Customs and Border Protection practice regarding enforcement of ITC remedial orders.

Daniel began his career as a patent examiner at the US Patent and Trademark Office after having worked in the semiconductor industry designing circuits.

Recent Developments in Patent Litigation

United States

Expert Testimony on Damages

Background

FRE 702: A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if the proponent demonstrates to the court that it is more likely than not that:

(a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue;

(b) the testimony is based on sufficient facts or data;

(c) the testimony is the product of reliable principles and methods; and

(d) the expert's opinion reflects a reliable application of the principles and methods to the facts of the case.

Advisory Committee Note (2000): Rule 702 sets forth the overarching requirement of reliability, and an analysis of the sufficiency of the expert's basis cannot be divorced from the ultimate reliability of the expert's opinion.

Damages: *EcoFactor v. Google,* 137 F.4th 1333 (Fed. Cir. 2025) (*en banc*)

En Banc Federal Circuit reins in expert testimony on damages

> An absence of reviewable reasoning may be sufficient grounds for this court to conclude the district court abused its discretion.

137 F.4th at 1338

> The plain language of the licenses does not provide a basis for Mr. Kennedy to opine that the parties agreed to an $X per unit rate in agreeing to the lump-sum payment amounts.

137 F.4th at 1341

> Where, as here, the relevant evidence is contrary to a critical fact upon which the expert relied, the district court fails to fulfill its responsibility as gatekeeper by allowing the expert to testify at trial.

137 F.4th at 1346

Invalidity Challenges: Are IPRs Still Worth Filing?

USPTO Denying Institution in Most Cases

Why?

- *Fintiv*
- Parallel proceedings and efficiency
- Settled expectations
- Procedural failures

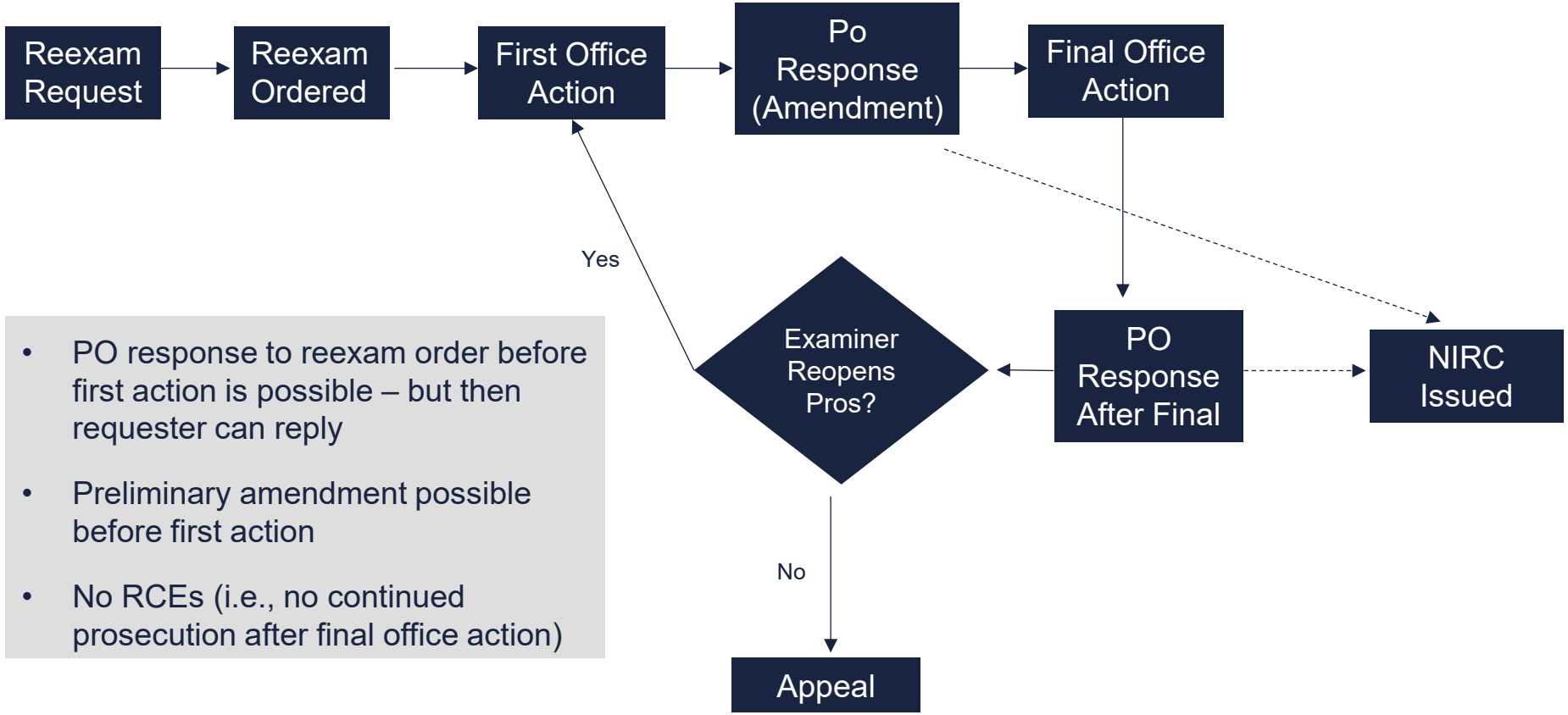
U.S. Patent and Trademark Office

Invalidity Challenges: *Inter Partes* Review or *Ex Partes* Reexamination?

Factors to consider

	IPR	EPR
Timeline	18 months	Varies (20 month median)
Success Rate	37% instituted (2026) >80% at least one claim cancelled	>90% instituted (2026) >40% at least one claim cancelled
Adjudicator	PTAB	Patent examiner
Appeal	CAFC	PTAB → CAFC
Estoppel of petitioning party	Yes	None
Estimated fees	$100,000	$450,000
Dismissal upon settlement	Yes	No

Invalidity Challenges: Ex Partes Re-examination Process



- PO response to reexam order before first action is possible – but then requester can reply
- Preliminary amendment possible before first action
- No RCEs (i.e., no continued prosecution after final office action)

ITC filings increase

- Eleven new section 337 complaints in 2026 as of February 16, 2026
  - Compared to 57 filed in all of 2025
- What's behind the increase?
  - IPR institution denials
  - Impact of *Lashify v. USITC*

ITC Domestic Industry: One Year After *Lashify*

Background

19 U.S.C. § 1337(a)(3) provides:

> For purposes of paragraph (2), an industry in the United States shall be considered to exist if there is in the United States, with respect to the articles protected by the patent, copyright, trademark, mask work, or design concerned—
>
> (A) significant investment in plant and equipment;
>
> (B) significant employment of labor or capital; or
>
> (C) substantial investment in its exploitation, including engineering, research and development, or licensing.

ITC Domestic Industry: One Year After *Lashify*

Certain Soft Projectile Launching Devices, Components Thereof, Ammunition, and Products Containing Same, Inv. No. 337-TA-1125, Commission Opinion

- No domestic industry
  - ITC credited labor expenditures on global marketing and packaging design under *Lashify*
  - ITC found some confidential expenses were not "capital" under Section 337(a)(3)(b)
    - "The Commission therefore declines to adopt Complainants' definition of 'capital.' Because all of Complainants' arguments depend upon the adoption of Complainants' definition, the Commission affirms the Final ID's finding that [REDACTED] does not count as capital." Op at 24.
  - ITC found that Complainant failed to account for foreign third-party manufacturing costs in its comparison between domestic and foreign product labor. Op. at 29.
  - ITC found "sizeable revenue does not demonstrate significant domestic labor towards the …" Op. at 32.

ITC Domestic Industry: One Year After *Lashify*

Certain Soft Projectile Launching Devices, Components Thereof, Ammunition, and Products Containing Same, Inv. No. 337-TA-1125, Commission Opinion

- ITC rejected the Complainants' quantitative analysis: "The Commission finds that Complainants' above comparisons are incomplete and not useful in determining the significance of Hasbro's investments in the United States in view of the totality of the record and the context of this industry and the DI Products." Op. at 35.
  - ITC found that "the most appropriate comparative analysis is comparing Hasbro's domestic investments to its projected revenue" but found this metric to show the investments were insignificant. Op. at 37-38.
- "Complainants' qualitative arguments are not persuasive in view of the quantitative factors discussed above." Op. at 42.

ITC Domestic Industry: One Year After *Lashify*

Certain Soft Projectile Launching Devices, Components Thereof, Ammunition, and Products Containing Same, Inv. No. 337-TA-1125, Commission Opinion

- Final ID's finding that an industry is in the process of being established:
  - Various steps that were taken occurred outside the U.S. Op. at 49.
  - Complainants failed to "explain whether such an industry would be under Prong b, Prong C, or both, or how its investments would be significant or substantial." Op. at 50.

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Recent Developments in Global Patent Litigation Part 2

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Education

The Australian National University, B.Sc, 2003

The Australian National University, LLB (Hons), 2004

The Australian National University, M.Phil (Biotechnology), 2008

Greg Bodulovic is an Australian intellectual property lawyer with postgraduate qualifications in biotechnology. He has broad experience in both the contentious and non-contentious aspects of intellectual property law.

Greg's experience includes patent infringement and revocation proceedings before the Federal Court of Australia and High Court of Australia, and patent opposition proceedings before the Australian Patent Office. He has acted also in registered design, trademark and copyright infringement proceedings and implemented and managed successful large-scale intellectual property enforcement campaigns for rights owners.

His non-contentious legal experience includes drafting and negotiating intellectual property licence agreements, research and development agreements and technology transfer agreements, as well as advising on the intellectual property and life sciences aspects of large, multi-jurisdictional corporate transactions.

Greg also advises on a broad range of regulatory issues relating to pharmaceuticals and medical devices, including in relation to market entry and product launch and marketing.

The Australian team

A locally focused team with global connections that will partner with you to deliver *exceptional results*

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Patent Litigation in Australia

- Trends in patent litigation
- New patent litigation directions
- Computer implemented inventions
- Preliminary injunctions
- Preliminary discovery

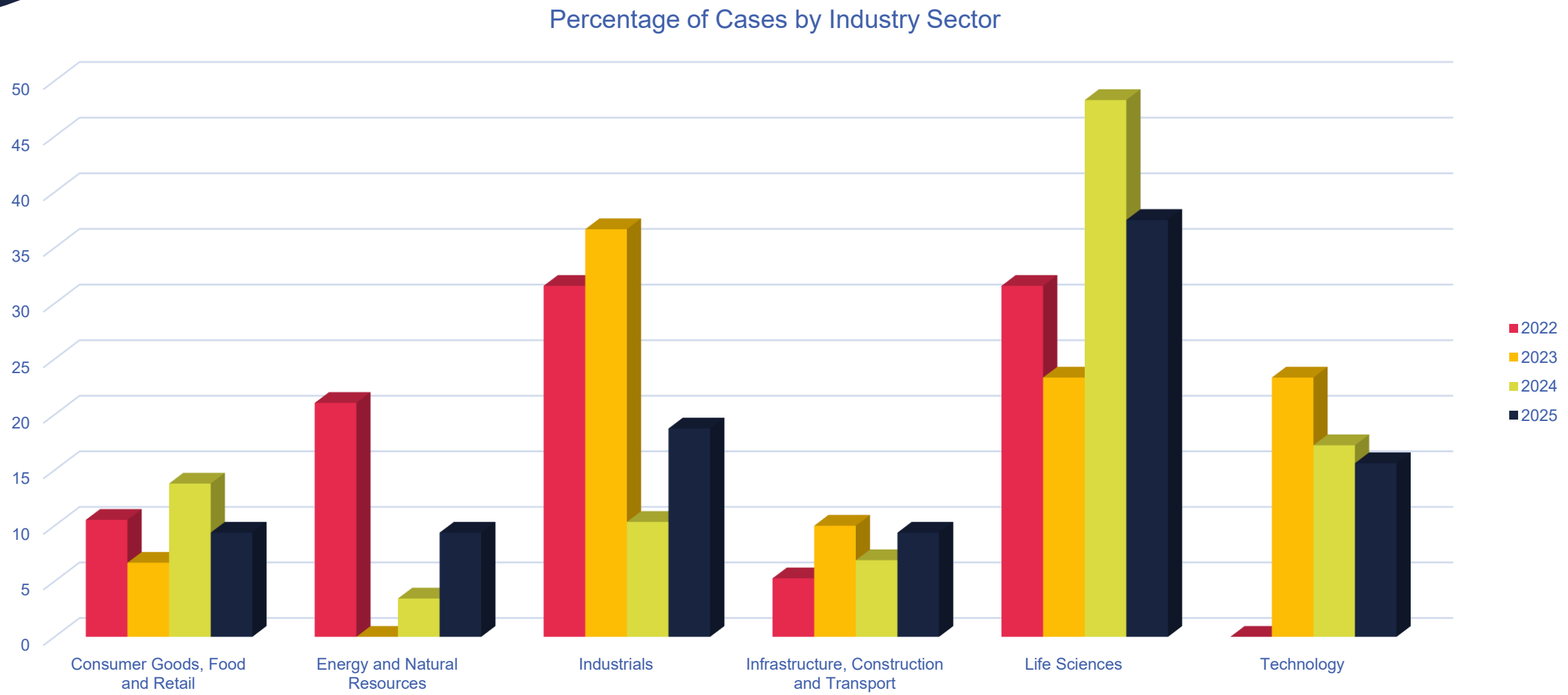
Tier 1
Intellectual Property
(worldwide)
The Legal 500, 2025

Gold
Litigation (Australia)
IAM Patent 1000,
2025

"Knowledgeable, capable and strategic with excellent client management skills."

IAM Patent 1000 2025, Gold

Growth Areas for Patent Litigation



New Patent Litigation Directions

Federal Court of Australia

- Patent litigation - Federal Court of Australia
- The Federal Court of Australia has issued new standard directions for patent litigation, which:
  - simplify court processes for patent infringement and revocation proceedings; and
  - streamline patent litigation to make it faster and less expensive.
- Trial date is set for a date 12-18 months after first case management hearing (shortly after defence filed).
- New requirement for filing infringement and invalidity position statements.
- Expert witnesses:
  - only one expert per field is permitted;
  - concurrent expert evidence (i.e. the hot-tub) – unique to Australia.

> *DLA Piper have a good understanding of the commercial pressures on their clients and factor this into their proposals.*
>
> Chambers Global 2025

> *The flourishing IP group at global juggernaut DLA Piper is perfectly positioned to handle complex multi-jurisdictional skirmishes. Its multi-talented set is highly adept at developing and implementing global patent enforcement strategies, and it dispenses shrewd strategic advice to a sector-diverse clientele.*
>
> IAM Patent 1000 2024

Computer Implemented Inventions (CIIs)

- Until late 2025, for CIIs to be patentable in Australia, an abstract scheme implemented by computer was insufficient – patentability required a specific advance in computer technology.
- This is in the process of changing as a result of a recent decision in the Full Court of the Federal Court of Australia – *Aristocrat v Commissioner of Patents*.
- Going forward:
  - claims to CIIs must be assessed as a whole;
  - CIIs must produce an artificial state of affairs and a useful result; and
  - no advance in computer technology will be required.
- US position: requires a specific technological improvement to computer functionality, not just an abstract idea on generic hardware, no specific advance in computer technology required.
- EU position: requires technical character/effect/contribution - beyond mere data processing or automation.
- The current position in Australia is now more closely aligned with the US.

Recommended International IAM Patent 1000, 2025

"The firm excels at navigating complex legal matters with precision and expertise. It is a team of seasoned attorneys that combines in-depth knowledge of the law with strategic thinking."

Chambers Asia Pacific 2025

Band 2 Intellectual Property (Asia Pacific region) Chambers Asia-Pacific, 2026

Preliminary Injunctions

- Preliminary injunctions (interlocutory injunctions) in Australia preserve the status quo pending trial.
- Test:
  - A serious question to be tried;
  - The balance of convenience favours the granting of the injunction
- Undertaking as to damages: Applicant (plaintiff) must offer to compensate “any person (whether or not that person is a party) affected by the operation of the injunction.
- Often sought by innovators in pharmaceutical patent disputes to prevent launch of competing products which infringe or threaten to infringe the innovators patent(s).
- Useful tool for patentees to temporarily block competitors entering the market pending resolution of patent infringement disputes.

Band 2
Intellectual Property
(global)
Chambers Global,
2025

“The DLA team is very thorough and seeks to think through every possible issue.”

Chambers Asia Pacific 2025

“They are particularly suited to clients with large international intellectual property portfolios. They are able to integrate and tailor their advice and provide quality representation across multiple jurisdictions.”

Legal 500 Australia Intellectual Property 2024, Tier 2

Preliminary Discovery

- Pre-litigation discovery tool available in Australia – allows pre-action access to documents.
- Requirements for preliminary discovery:
  - prospective applicant has a reasonable belief it may have a right to relief from a prospective respondent;
  - applicant has made reasonable enquiries, but has insufficient information to decide whether to commence proceedings; and
  - prospective respondent has or is likely to have documents relevant to the prospective claim.
- Primary uses are in patent or other IP disputes to obtain evidence of infringement or identify respondents.
- Documents that may be discoverable include manufacturing processes, formulation, and other product information and sales/supply information.
- Pfizer v Samsung Bioepis (key precedent): Pfizer successfully used preliminary discovery to obtain from Samsung Bioepis manufacturing process documents for a biosimilar to assess process patent infringement.

> *"DLA Piper is a highly experienced team with excellent understanding of the law. It considers complex matters from every possible angle to achieve the best result for the client."*
>
> Chambers Asia-Pacific Intellectual Property 2025, Band 2

> *"They have a strong team and are able to bring the right expertise to address the specific or unique issues or concepts as needed."*
>
> Chambers Asia Pacific 2024

Divider Slide

Optional subtitle

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Recent Developments in Global Patent Litigation Part 2

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University of Toronto, Juris Doctor

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Languages

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English

Ting is a Partner in the IPT practice of DLA Piper's Shanghai office. She heads China’s patent practice. Her practice focuses on patents, trade secrets and other technology-related matters. She specializes in licensing and technology transfer, life sciences and healthcare related regulatory work, and also handles IP enforcement and litigation matters.

Prior to her legal career, Ting worked as a research scientist in the National Key Laboratory of Chinese Academy of Sciences and a renowned research institute in Canada. Ting leverages her advanced scientific research background and deep understanding of client’s technical field to routinely advise clients from a wide variety of emerging and innovative sectors, including life sciences and healthcare, chemical, automotive, semi-conductor, information technology, artificial intelligence and new energy.

Agenda

1	China: Standard Essential Patent Litigation Update
2	Preliminary Injunction

1. China: Standard Essential Patent Litigation Update

PRC SEP Legislative Framework Overview

Law

Aug. 2007

- ***PRC Anti-Monopoly Law***
  - Specified that Anti-Monopoly Law applied to intellectual property rights abusive conducts that excluded or restricted competition
  - Provision remained unchanged over subsequent amendment in 2022

Regulatory Document and Judicial Interpretation

Dec. 2013

- ***Interim Provisions on the Administration of National Standards Involving Patents***
- Promulgated by National Standardization Administration and China National Intellectual Property Administration
- Provided rules concerning disclosure obligation and types of license commitment, and rules for SEP in compulsory national standard

Apr. 2015

- ***Provisions regarding Prohibiting the Abuse of Intellectual Property Rights to Exclude or Restrict Competition ("2015 Provisions")***
- Promulgated by State Administration for Industry and Commerce
- Specified prohibited antitrust behaviors regarding SEP
- Replaced by new provisions in 2023

Mar. 2016

- ***Interpretation (II) on Several Issues concerning the Application of Law in the Trial of Patent Infringement Dispute Cases***
- Promulgated by Supreme People's Court
- Provided judicial tests concerning SEP patent's infringement determination, injunction granting and royalty rate determination
- Provision remained unchanged over subsequent amendment in 2020

Jan. 2019

- ***Anti-Monopoly Guidelines for the Field of Intellectual Property Rights ("2019 Guidelines")***
- Promulgated by Anti-Monopoly Committee of the State Council
- Specified factors for determining dominant market position for SEP owners
- Included the abuse of judicial injunction as prohibited antitrust behaviors regarding SEP, and specified factors for its determination

June 2023

- ***Provisions on Prohibiting the Abuse of Intellectual Property Rights to Exclude or Restrict Competition***
- Promulgated by State Administration for Market Regulation and replaced the 2015 Provisions
- Incorporated the abuse of judicial injunction scenario from 2019 Guidelines
- Included setting unfairly high royalty rate as prohibited antitrust behaviors regarding SEP

Nov. 2024

- ***Anti-Monopoly Instructions on Standard Essential Patents***
- Promulgated by State Administration for Market Regulation
- Detailed instructions on determining antitrust behaviors involving SEP, e.g., disclosure, license commitments, good-faith negotiation, monopoly agreement, abuse of dominant market position, and merger control

Definitions of SEP

- “Patent essential for implementation of standard”
  - Concept adopted in standard drafting and implementation by CNIPA
    - National standard
  - Concept adopted in antitrust administration by antitrust authorities
    - Types of standard not specified
- “Essential patent explicitly specified in standard” by Supreme People’s Court for Patent Infringement
  - Concept adopted for patent litigation
    - Recommended national, industry or local standard

SEP Patent Litigation Overview

- Dispute over infringement
  - Court will not support patentee's claim of injunction if
    - Patentee intentionally violates its FRAND (i.e., Fair, Reasonable and Non-Discriminaory) commitment made during standard draft process;
    - Practitioner is not obviously at fault during negotiation; and
    - Failure to reach patent license

  During negotiation of "**license terms**"

SEP Patent Litigation Overview

- Dispute over infringement
  - Court can determine “license terms” if no agreement can be reached even through “sufficient negotiations”
    - Principle for court’s determination: FRAND
    - Factors:
      - Inventiveness of patent
      - Patent’s role in standard
      - Technical field of standard
      - Nature of standard
      - Scope
      - Other relevant license terms

Case Illustration I: SEP Patent Infringement Dispute

- Patent infringement case filed by XU, an individual (patentee) and a Ningbo Tech Company (Plaintiffs) against a Hebei Rubber Company and a Hebei Construction Company (Defendants)
  - Significance: SPC clarified FRAND obligation for SEP patent infringement dispute and its impact on damages
  - History
    - Frist instance: Shijiazhuang Intermediate Court in Hebei Province (first instance judgment issued on 13 May 2020)
    - Second instance: Supreme People's Court (SPC) (second instance judgment issued on 30 June 2022)
  - Asserted patent
    - Chinese invention patent ZL200410049491.5: A Super Large Anti-Deflection Bridge Expansion Joint Device
  - Background
    - XU was legal representative, shareholder and controller of Ningbo Tech Company
    - Plaintiffs drafted recommended industry standard "Modular Multi-Directional Displacement Comb-Type Bridge Expansion Joint Device", later issued by PRC Ministry of Transportation in 2008
      - In standard, patentee XU committed to negotiate a license under FRAND and provided contact information
    - Plaintiff sent letter to Defendant for negotiation of patent infringement damages in 2016
    - XU granted Ningbo Tech Company royalty free exclusive patent license in 2017

Case Illustration I: SEP Patent Infringement Dispute

- Patent infringement case filed by XU, an individual (patentee) and a Ningbo Tech Company (Plaintiffs) against a Hebei Rubber Company and a Hebei Construction Company (Defendants) (cont.)
  - Shijiazhuang Intermediate Court found infringement but did not support plaintiffs' injunction claim
  - SPC overturned first-instance decision and supported plaintiffs' injunction claim against Hebei Rubber Company
    - Defendant's bridge expansion joint device infringed asserted patent
    - Plaintiff did not violate FRAND obligation
      - As legal representative, shareholder and controller of Ningbo Tech Company, XU did not constitute price discrimination when granting Ningbo Tech Company royalty free exclusive patent license
      - XU presented good-faith intention for negotiation when sending letter to Defendant
    - Defendant was at fault:
      - Failure to actively seek license when concerned standard publicly provided patentee's contact information
      - Failure to negotiate with XU after receiving letter from plaintiff
      - Continued infringement after receiving letter from plaintiff

Case Illustration I: SEP Patent Infringement Dispute

- Patent infringement case filed by XU, an individual (patentee) and a Ningbo Tech Company (Plaintiffs) against a Hebei Rubber Company and a Hebei Construction Company (Defendants) (cont.)
  - Shijiazhuang Intermediate Court awarded RMB 100 thousand damages
  - SPC raised damages to **RMB 3 Million**
    - Determination of damages
      - The other co-defendant's total sales volume of infringing products
      - Royalty rate based on Plaintiff's other license agreements
      - Doubled royalty rate for Defendant in damage calculation due to its fault
        - Defendant did not actively seek license
        - Defendant continued to knowingly infringe asserted patent

2. Preliminary Injunction

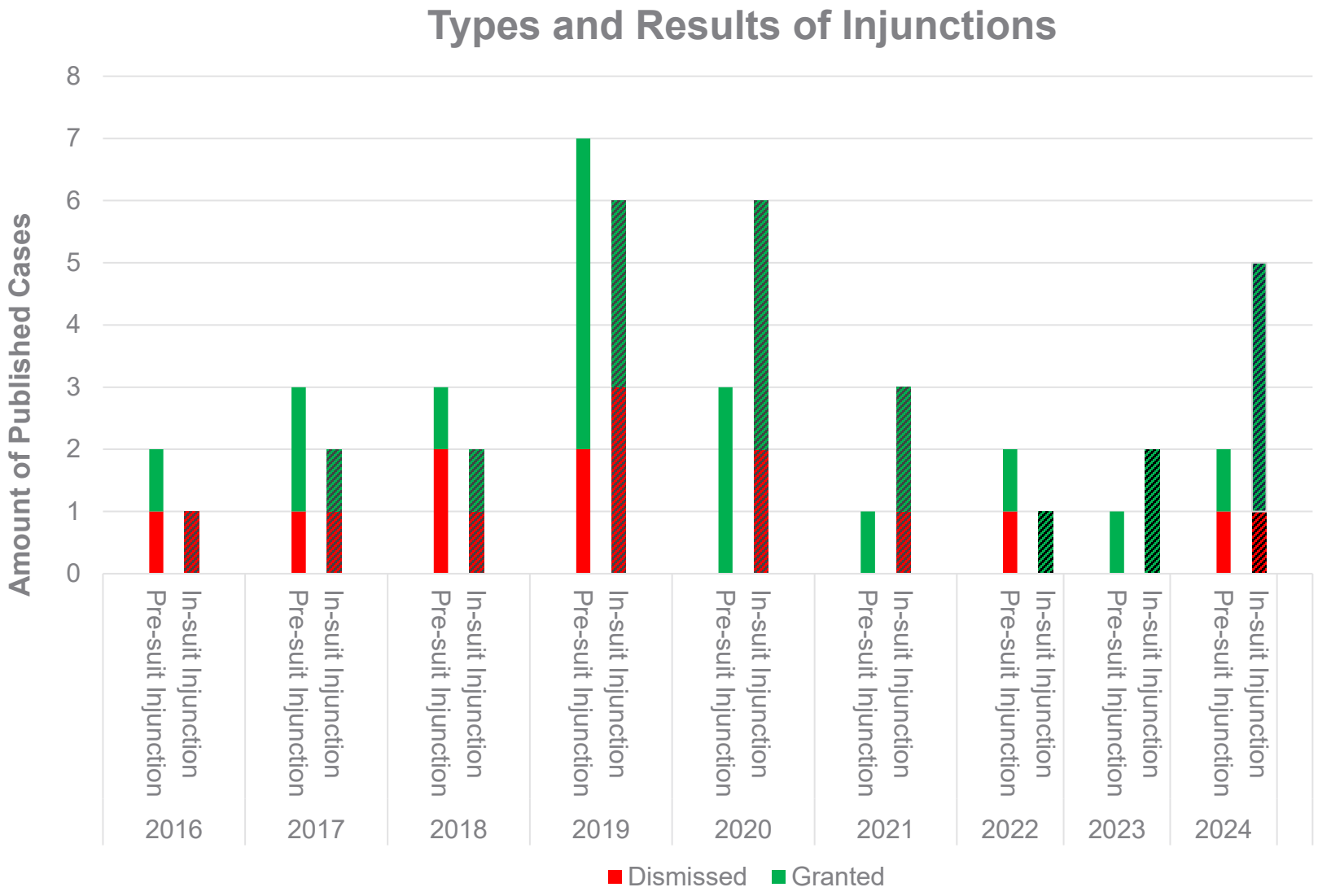
Preliminary Injunction Overview

- Factors for granting preliminary injunction
  - Likelihood of success: factual and legal basis
    - Stability of asserted patent
    - Infringing acts
    - Infringement analysis
  - Any *irreparable* harm to PI applicant
    - e.g., significant increase of infringement scale, market share decrease
  - Interest balance between applicant and respondent
  - Public interest
  - For pre-suit injunction:
    - Any urgent conditions where asserted patent being infringed or to be infringed
      - e.g., upcoming or on-going exhibition or trade shows

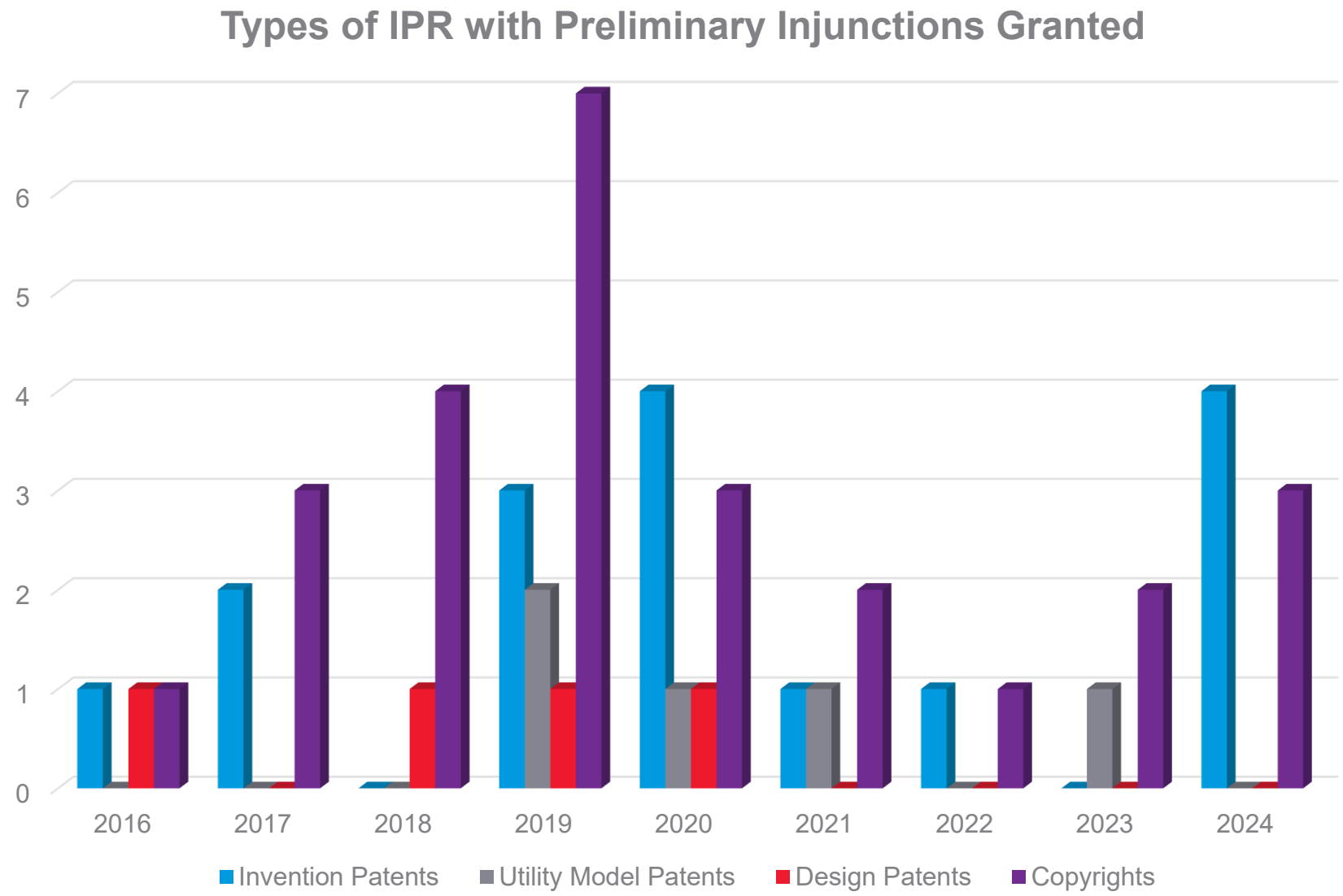
Preliminary Injunction Overview

- Timeline
  - Pre-suit injunction
    - Granted within 48 hours after court accepts application
    - May take 24 hours to several months in practice
    - *Ex parte* possible
  - In-suit injunction
    - For urgent conditions, granted within 48 hours after court accepts application
    - For non-urgent conditions, not specified under statute
    - May take 48 hours to several months in practice even for urgent conditions
- Response
  - More likely than not *ex parte* proceeding
    - Court has full discretion to decide whether to inquire both parties or hold oral hearing before issuing injunction
      - More *ex parte* cases than defended cases in the past seven years

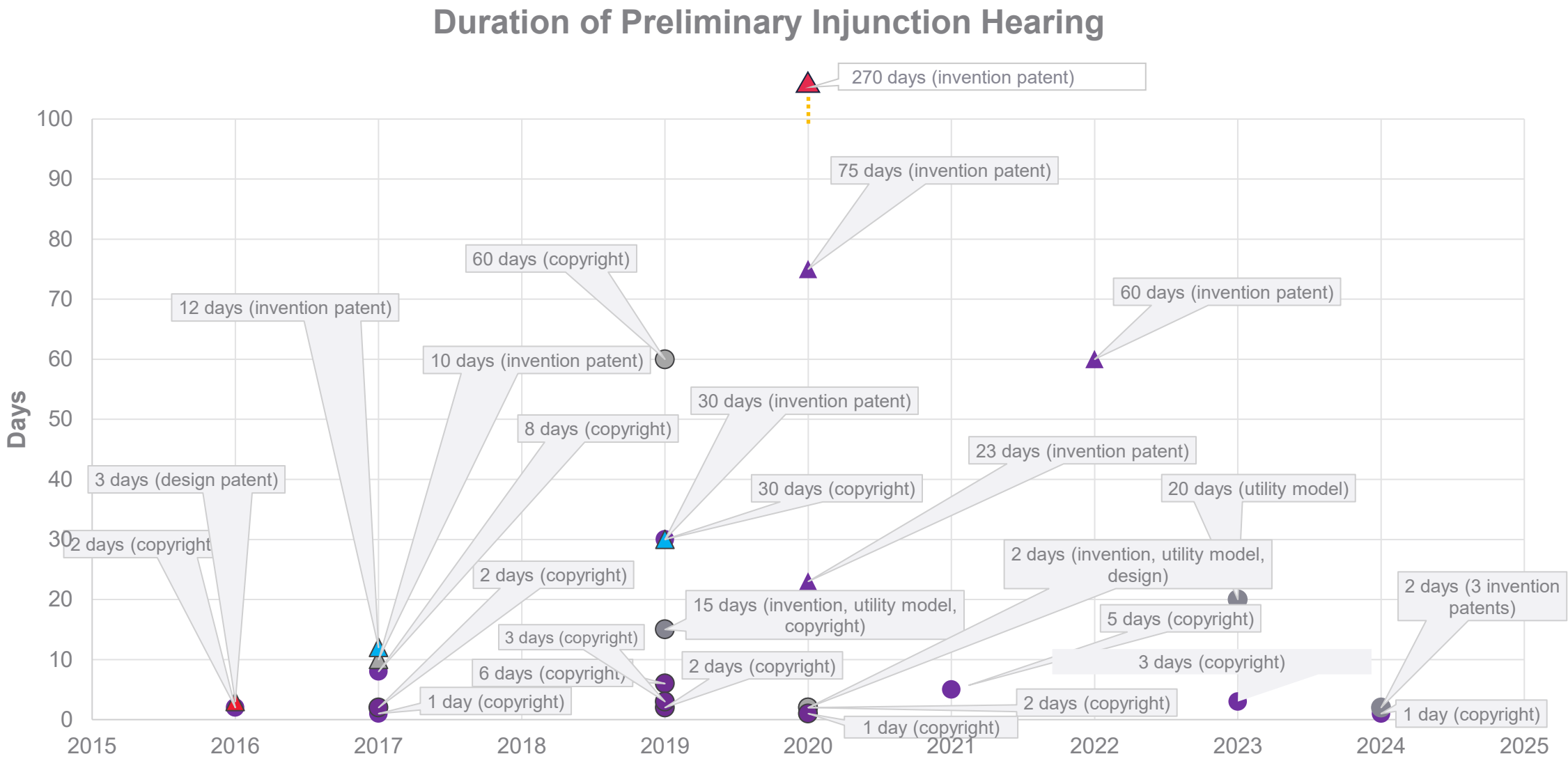
Preliminary Injunction Overview



Preliminary Injunction Overview



Preliminary Injunction Overview



Case Illustration II: Pre-suit Injunction

- Pre-suit injunction case for patent infringement filed by a Suzhou Tech Company (patentee and Plaintiff) against a Beijing Tech Company (Defendant)
  - Significance: SPC provided clear guidance on judicial tests for pre-suit injunction
  - History
    - Frist instance court: Quanzhou Intermediate Court in Fujian Province
    - Application date: June 3, 2024
    - Pre-suit injunction granted on June 5, 2024
    - Date of SPC accepting reconsideration petition: June 24, 2024
    - Date of oral hearing in SPC: June 27, 2024
    - SPC revoked first-instance pre-suit injunction decision on July 3, 2024
  - Asserted patent: Chinese invention patent ZL20211167XXXX.6 (patent name not disclosed)
  - Accused products: self-cleaning vacuum and mop robot (Model No.: P10Pro and P10SPro)
  - Background
    - Accused product P10Pro launched on Aug. 28, 2023
    - Accused product P10SPro launched on Feb. 18, 2024
    - Plaintiff initiated patent infringement suits in multiple Chinese courts against defendant's products (some including accused product P10Pro) since Dec. 19, 2023
    - Plaintiff's market share: 14.1% in 2023, and 17.4% in April 2024

Case Illustration II: Pre-suit Injunction

- Pre-suit injunction case for patent infringement filed by a Suzhou Tech Company (patentee and Plaintiff) against a Beijing Tech Company (Defendant)
  - Background (cont.)
    - Zhejiang Intellectual Property Research and Service Center issued Patent Infringement Comparison and Analysis Report, concluding accused product infringed asserted patent under doctrine of equivalents
    - Beijing Guowei Intellectual Property Appraisal and Evaluation Center Co., Ltd. issued Patent Infringement Comparison and Appraisal Opinion, concluding accused product fell into patent's scope
  - SPC opinions
    - Condition was not "urgent"
      - Accused patent infringing act would not cause extinction of patent rights or irreparable damage to patent value
      - Accused patent infringing act did not infringe plaintiff's personality rights
      - Not time-sensitive:
        - **Accused patent infringing act commenced as early as Aug. 2023, rather than imminent "618" shopping season as claimed by plaintiff/applicant**
        - Plaintiff discovered accused infringing act in Aug. 2023, but waited till June 2024 to apply for PI
        - Defendant had other sales promotions between Aug. 2023 and June 2024, but Plaintiff did not promptly apply for PI during such period
        - Plaintiff did not apply for PI (pre-suit or in-suit) in related actions against defendant in other courts

Case Illustration II: Pre-suit Injunction

- Pre-suit injunction case for patent infringement filed by a Suzhou Tech Company (patentee and Plaintiff) against a Beijing Tech Company (Defendant)
  - SPC opinions (cont.)
    - Favorable factors
      - Stability of asserted patent
        - Invention patent presumedly stable
        - Decision on invalidation petition regarding asserted patent was not issued by China National Intellectual Property Administration ("**CNIPA**") yet
      - Public interest
        - Plentiful replaceable choices in market for accused products

Case Illustration II: Pre-suit Injunction

- Pre-suit injunction case for patent infringement filed by a Suzhou Tech Company (patentee and Plaintiff) against a Beijing Tech Company (Defendant)
  - SPC opinions (cont.)
    - Unfavorable factors
      - Infringement analysis
        - *Parties had dispute over whether certain patented technical features existed in accused products*
        - Both analysis opinions were prepared by agencies hired by plaintiff *ex parte*, rather than appraisal agency commissioned by court
        - **Both analysis opinions lacked in-depth analysis, especially on disputed technical features**
        - SPC could not assess likelihood of infringement even after its on-site examination of accused products
      - Irreparable harm to plaintiff
        - Plaintiff's economic losses could be remedied by damages claim against defendant
        - Defendant expressed willing to provide counter-bond
        - Plaintiff's market share in April 2024 had increased compared to 2023
      - Interest balance between plaintiff and defendant
        - Both parties are well-know companies in industry
          - No proof that plaintiff's losses overweighed defendant's if granting pre-suit injunction

Case Illustration III: Preliminary Injunction

- In-suit injunction case for patent infringement filed by Yongkang Lianyue Industry and Commerce Co. Ltd. (Defendant and PI applicant) against Cixi Bosheng Plastic Product Co. Ltd. (patentee and Plaintiff) and Zhejiang T-mall Network Co. Ltd. (Defendant), et al.
  - Significance: first reverse preliminary injunction issued by SPC
  - Application date: 5 November 2020
  - Reinstate request: reinstate weblink for selling accused product
  - In-suit reinstatement granted on 6 November 2020 (decided within 48 hours due to imminent “11-11” shopping season)
  - Bond setting: RMB 6.32 million + 50% of sales revenue that exceeds RMB 6.32 million since weblink reinstatement
  - Asserted patent: Chinese utility model patent ZL201820084323.7 “Flat Mop Cleaning Tool with Novel Bucket Structure”
  - Accused product: mop and bucket
  - Background
    - PI applicant selling accused product on website operated by Zhejiang T-mall Network Co. Ltd.
    - Plaintiff initiated patent infringement suits against PI applicant, et al. in Ningbo Intermediate Court in Zhejiang Province on 11 Oct. 2019. In April 2020, Ningbo Court found infringement and held that PI applicant should cease infringing act, and defendant Zhejiang T-mall Network Co. Ltd. should delete weblink for selling accused product
    - Zhejiang T-mall Network Co. Ltd. deleted weblink for selling accused product in April 2020
    - PI applicant appealed first instance judgement to SPC
    - During second instance proceeding, CNIPA issued decision on 9 Sept. 2020, holding asserted patent invalid

Case Illustration III: Preliminary Injunction

- In-suit injunction case for patent infringement filed by Yongkang Lianyue Industry and Commerce Co. Ltd. (Defendant and PI applicant) against Cixi Bosheng Plastic Product Co. Ltd. (patentee and Plaintiff) and Zhejiang T-mall Network Co. Ltd. (Defendant), et al. (cont.)
  - SPC opinions
    - Stability of asserted patent
      - Utility model patent unstable in nature due to lack of substantive examination
      - Uncertainty in validity: asserted patent was determined invalid by CNIPA (even though plaintiff intended to challenge CNIPA's invalidation decision in court)
    - Other factual basis
      - A total of RMB 15.6 million in PI applicant's account had been seized, affecting PI applicant's normal operation
    - Irreparable harm to PI applicant
      - **Existence of weblink would profoundly affect sales of accused product, especially during imminent "11-11" shopping season**
    - Interest balance between PI applicant and respondent
      - Plaintiff's patented products would not be replaced after reinstating weblink given plentiful similar products in market
      - PI applicant agreed to seize certain amount and obtainable profits in its account after reinstating weblink

Case Illustration III: Preliminary Injunction

- In-suit injunction case for patent infringement filed by Yongkang Lianyue Industry and Commerce Co. Ltd. (Defendant and PI applicant) against Cixi Bosheng Plastic Product Co. Ltd. (patentee and Plaintiff) and Zhejiang T-mall Network Co. Ltd. (Defendant), et al. (cont.)
  - SPC opinions (cont.)
    - Factors for determining bond setting
      - Dynamic bond
        - PI applicant's obtainable profits would continuously increase after weblink reinstatement
      - Dynamic bond being set at 50% of sales revenue
        - To exclude costs and administrative expenses from PI applicant's sales revenue
        - To avoid unreasonable impact on PI applicant's business operation
        - Asserted patent's contribution

CLE Code 72415

DLA PIPER

Asia IP Symposium 2026

Tokyo, Japan / Thursday, February 26, 2026

Roundtable Discussion: Pragmatic Applications and Impacts of AI in IP

Maki Nakamura, Hajime Shirasaka, Shuzo Maruyama

Moderated by Mitch Nishimura

Round Table Discussion: Pragmatic Applications and Impacts of AI in IP

目次

自己紹介 Profile

中 村 麻 紀
弁 理 士

■略歴

2007- アルプス電気㈱ 知的財産部渉外グループ
2014- 渉外・商標グループマネージャー
2015- 知財戦略・渉外・商標・調査グループマネージャー
2016- 知財戦略・渉外・商標・調査・出願グループ
マネージャー
2019- アルプス電気㈱とアルパイン㈱が経営統合
2022- アルプスアルパイン㈱ 知的財産部部長
2026- コンポーネント事業担当付IPストラテジスト

IP Licensing Group, Alps Electric Co., Ltd.
Manager, Licensing and Trademarks
Manager, IP Strategy, Licensing, Trademarks and Research
Manager, Prosecution was added to the above
ALPS and ALPINE merged into ALPSALPINE
Department Manager of IP
IP Strategist

■社外活動

2008- JEITA特許専門委員会
2014- JATES（一社 科学技術と経済の会）キーパーソン
2021- 知財・無形資産ガバナンス協会（旧〃研究会）
2022- JEITA法務・知的財産部会
2023- SEP研究会（特許庁・経産省との意見交換会）
2024- JIPA常務理事　※FY2025 国際第一委員会＆
有識者連携WG: 特許政策・データ戦略・SEP

JEITA, Patent Committee
JATES (Keyperson, Japan Techno-Economics Society)
IPIAGA (IP & Intangible Assets Governance Associatio
SEP Expert Group Japan
JIPA, Managing Director, in charge of
The First International Affairs Committees I
& IP Experts Partnership Working Group

白坂 一　株式会社AI Samurai/弁理士法人白坂

博士（知識科学）
弁理士
北陸先端科学技術大学院大学　客員教授
国家試験知的財産管理技能検定委員
文部科学省アントレプレナーシップ推進大使
経済産業省Healthcare Innovation Hubアドバイザー
東証スタンダード幸和製作所　社外取締役

INTA2023 Open Innovation Challenge受賞

文部科学省
アントレプレナーシップ推進大使

経歴

2001年3月　防衛大学校 理工学部 卒業
2003年3月　横浜国立大学院環境情報学府 博士前期課程修了
（機械学習による画像処理の研究）
2003年4月　富士フイルム知的財産本部に8年間在籍
2011年4月　弁理士法人白坂を創業、2019年1月まで所長
2012年6月　**米ナスダック上場**のビッグデータ解析企業の関連会社
2015年9月～ 株式会社AI Samurai（旧ゴールドアイピー）を創業
2019年7月　**累計10億円の資金調達**を実現！
2021年3月　北陸先端科学技術大学院大学先端科学技術研究科
博士後期課程修了
（AIと人間の進歩性に関する協働に関する研究）
2025年6月　株式会社AI Samurai **M&A**　トヨタテクニカルデベロップメントの完全子会社

丸山 秀三

日本および米国イリノイ州弁護士
DLA Piper US シカゴオフィス、パートナー

経歴

1997年　慶応義塾大学経済学部卒業
1998年　司法試験合格
1999年 – 2000年　最高裁判所司法研修所
2000年 – 2003年　大阪地方裁判所判事補
2010年 – 2013年　Boston University School of Law (J,D.)
2013年 – イリノイ州司法試験合格
2014年 – 現在　DLA Piper LLP (US), Chicago Office, Patent Litigation Group

授賞

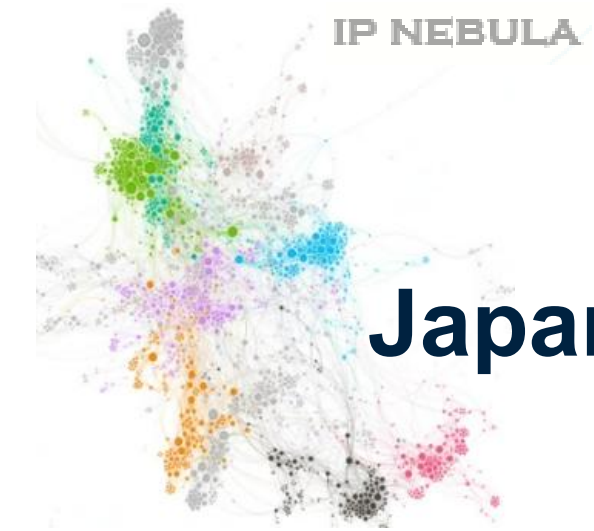
Chambers USA
Band 4, Illinois Intellectual Property (2024)

Chambers Global
Spotlight Table Foreign Expert, USA Intellectual Property (Foreign Expert for Japan) (2021 - 2025)

The Legal 500 United States
Recommended, Patents: Litigation (International Trade Commission) (2020)

中村様によるご説明

ALPS ALPINE
extends your senses



Japanese Pragmatic Applications and Impacts of AI in IP

今後の知財戦略及び実務へのAI活用について

日本企業とAI

環境　Circumstances

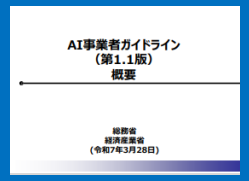
AIは友達、AIフレンドリーな日本!

Copyright Act

Article 30-4
Article 47-4
Article 47-5

HAIP

AI Guidelines for Business



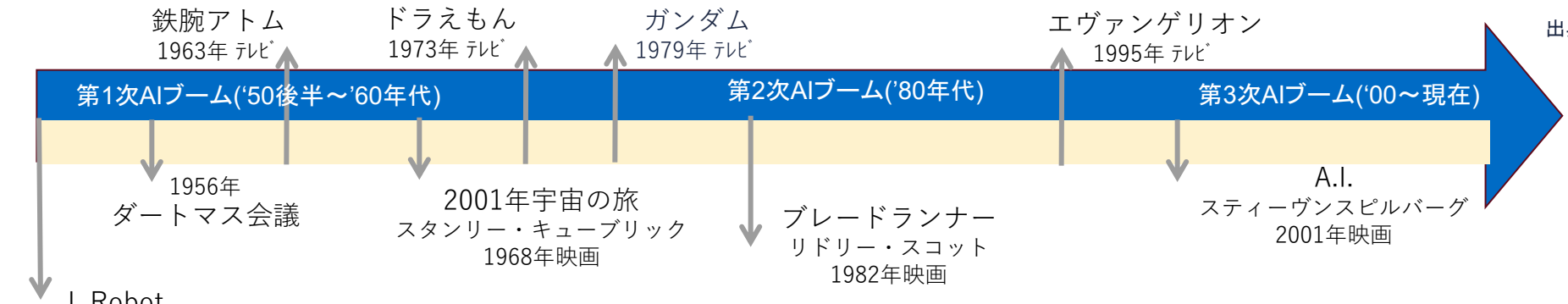
AI Act

Gen AI Principle Code (draft)

出典:　【公式】鉄腕アトム(1963) 第1話『アトム誕生』

出典:　ドラえもん (アニメ) | 無料動画・見逃し配信を見るなら | ABEMA

出典:　「ガンダム」ファースト、逆シャア、Zなどシリーズ8作品！「ABEMA」で平日毎日＆土日は一挙放送 1枚目の写真・画像 | 超！アニメディア

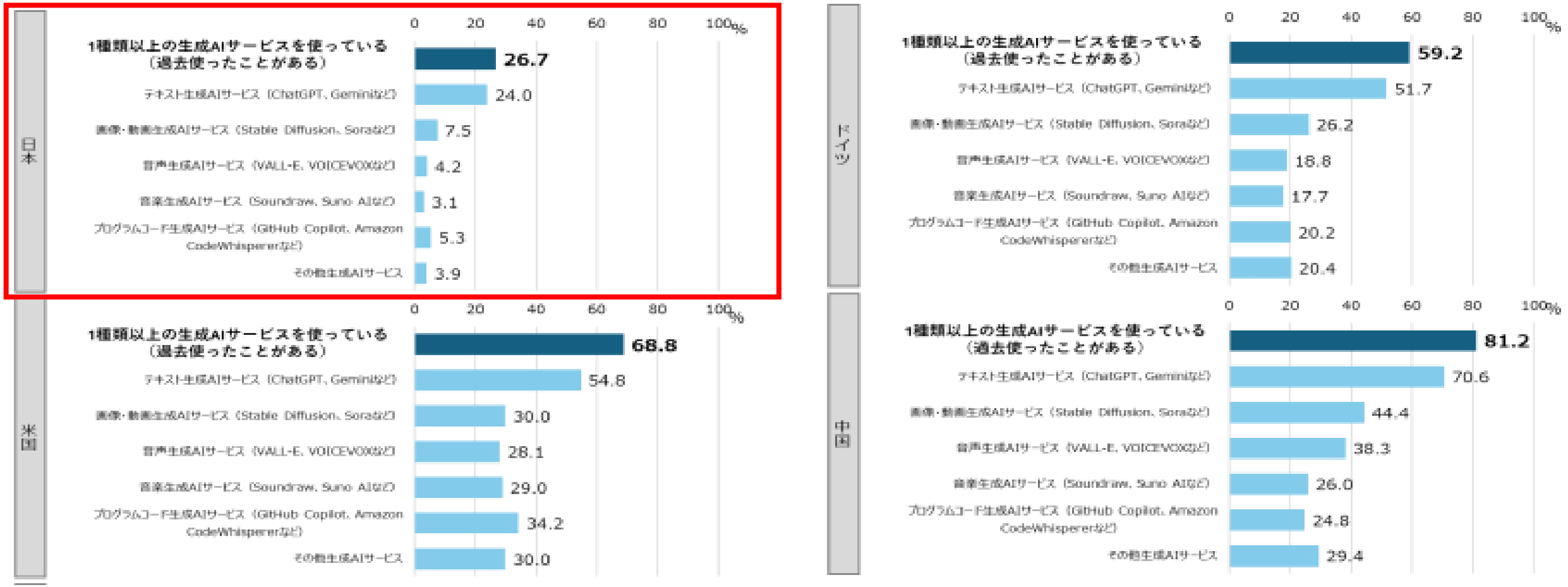


AIブーム出典:
総務省｜平成28年版 情報通信白書｜人工知能（AI）研究の歴史

生成AIサービス利用の各国比較

日本の生成AI利用は各国に比べて低め!
だが、2025年は日本の知財・DXにおける生成AI元年ともいうべき年になっている!

図表 3-64 生成 AI サービスを使っている（過去使ったことがある）割合（国別）



出典: 総務省:国内外における最新の情報通信技術の研究開発及び デジタル活用の動向に関する調査研究（2025年3月）

過去よりいろんなツールを評価・使用するも・・・生成AIへ突入

アルプスアルパインの知財活動におけるAI活用

経営戦略

視点ゲージの上げ下げが必要

事業戦略

事業戦略

事業戦略

…

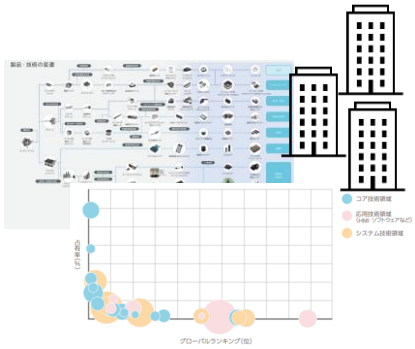
知財活動

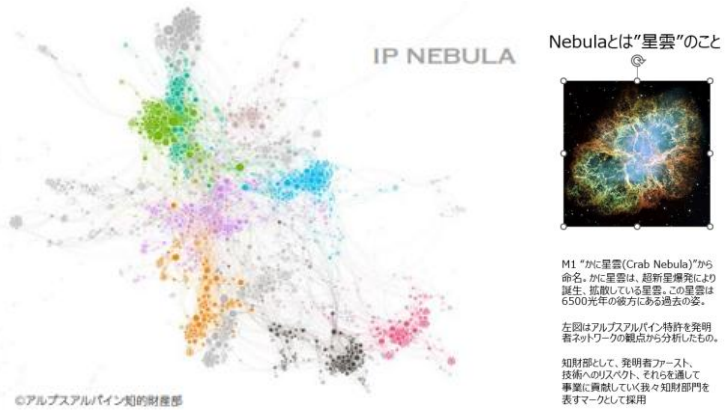
未来を創る “協創”を加速

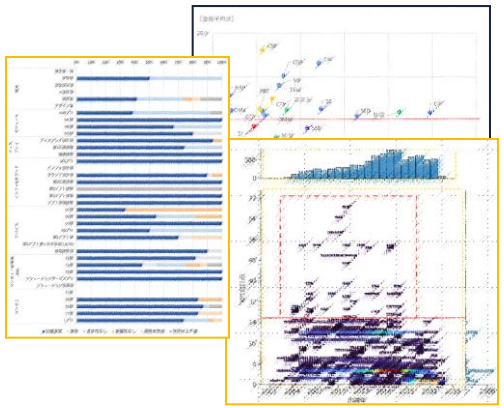
IPデータ サイエンス

ソリューション
知財価値提供
人(ヒト)

権利化 FTO 管理







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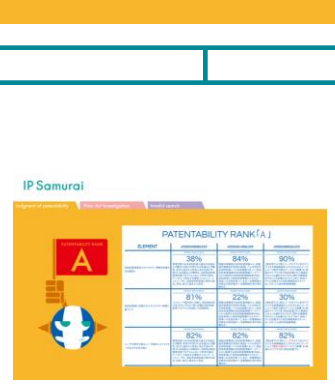
開発ヒストリー

審査シミュレーション
中国特許DB
AIコラボ検索
日米中横断調査
AI特許作成
IP LANDSCAPE検索
生成AI
GPTによる技術アドバイ
特許文書編集
拒絶理由通知対応
クリアランス調査



AI Samurai

AI審査シミュレーション

AI特許作成

AIコラボ検索

IP LANDSCAPE 特許検索

AI Samurai ONE

により発明創出を支援するシステム

AI Samurai ZERO

対話型の特許文書作成システム

R&Dを支援する発明の創出から権利 ”Patent Knowledge Cycle”

暗黙知

発明提案書

①共同化（**S**ocialization）

AI Samurai ZEROは、発明者の暗黙知をAIと共有し、特許文書・発明提案書に変換する初期段階での知識共有。

②表出化（**E**xternalization）

AI Samurai ONE 審査ｼﾐｭﾚｰｼｮﾝは、AIが発明の内容をクレームチャート化し、特許取得の可能性をA～Dで評価し技術提案。

・特許可能性
・技術提案
・拒絶理由対応

暗黙知

形式知

・改良特許
・翻訳

④内面化（**I**nternalization）

AI Samurai ONE 特許文書編集は、発明者が生成AIに指示して内容に基づき、特許文書を改良・編集。新たな知識が形式知され、知識を内面化。

③連結化（**C**ombination）

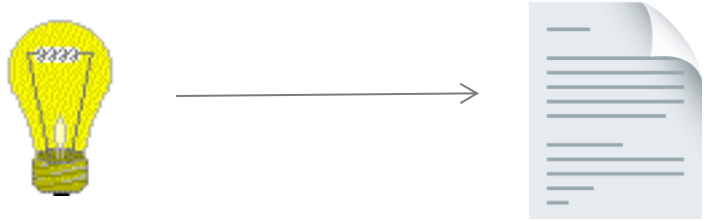
AI Samurai ONE 特許文書作成は、技術提案を元に、AIが類似特許群を参考にして最終的な特許文書を生成。

特許草案
作成

形式知

AIを使うだけの会社は不利

- 単なる生成AI利用企業は消える
- 生き残るのは「AIで特定業務を深く変革」する会社



発明提案書　　特許書類

発明提案書から特許書類を作る！
できたら**弁理士はいらない？**
発明提案書ではなく、発明者がいきなり特許書類を作る！
知財担当者はいらない？

知財だけではなく、画像処理、自然言語処理のソフトウェア分野において、
単に生成AI利用のソフトウェア企業は消える！

生き残る「AIで特定業務を深く変革」する会社とは！？

・生成AIそのものを創る会社

・生成AIの進化スピードに合わせて、ユーザの困りごとに伴走する会社

いずれの会社も生成AIに真似をされる前に
AIを活用して大量特許出願をする時代へ！
アイデアの早急な保護の時代へ

知財爆弾量産！！！

量も質も大事！

2025年 出願公開分　- データ更新日：2025年12月18日 -

順位	出願人	件数	前年順位	前年件数	2025年 特許取得件数
1位	ソフトバンクグループ株式会社	10400	47位	552	55（447位）
2位	トヨタ自動車株式会社	5378	1位	5825	4196（1位）
3位	キヤノン株式会社	5308	2位	5456	3369（2位）
4位	株式会社三共	2456	4位	2685	1245（9位）
5位	パナソニックＩＰマネジメント株式会社	2381	5位	2571	2441（3位）
6位	株式会社三洋物産	1869	3位	3305	1551（7位）
7位	セイコーエプソン株式会社	1867	6位	2009	1008（14位）
8位	株式会社東芝	1503	8位	1609	1156（12位）
9位	エルジー　エナジー　ソリューション　リミテッド	1396	12位	1276	1211（11位）
10位	株式会社半導体エネルギー研究所	1284	17位	1158	1017（13位）
11位	本田技研工業株式会社	1243	9位	1452	1265（8位）
12位	日本電気株式会社	1196	14位	1241	1736（5位）
13位	株式会社日立製作所	1174	10位	1400	934（15位）
14位	三菱電機株式会社	1166	11位	1388	1965（4位）
15位	株式会社デンソー	1076	15位	1234	1221（10位）
16位	株式会社リコー	1065	13位	1275	888（16位）
17位	シャープ株式会社	954	20位	955	652（29位）
18位	凸版印刷株式会社	921	16位	1212	641（30位）

IP Force 引用（取得日2025年12月18日）

生成AIを用いた特許書類作成：2つのアプローチ比較

アプローチ1：請求項先行（従来型）

【弁理士】請求項作成

【生成AI】請求項入力

上位概念化・ノイズ発生

【生成AI】明細書生成（ノイズ含む）

【弁理士】修正（時間がかかる）

課題：修正工数増、納品スピード低下

アプローチ2：明細書先行（推奨型）

【生成AI】明細書・図面・請求項案生成 （ドラフト作成）

【弁理士】
修正・仕上げ（効率的）

利点：修正工数減、納品スピード向上

丸山弁護士によるご説明

AI in Legal Practice

- DLA Piper is committed to the responsible and intentional use of AI, including maintaining a Clients with AI Limitations and Obligations list and advising our attorneys when to use which GenAI tool to maximize efficiency and minimize risks.

- **Legal Research**
  - All legal research should be conducted with tools grounded in and with access to primary and secondary legal materials, such as Lexis and Westlaw.
- **Legal AI Assistants**
  - Legal tasks are conducted in tools grounded in a legal domain or training set. Harvey is the Firm's general legal AI assistant. We also have AI tools, such as Relativity, for practice and unction-specific legal tasks.
- **General AI assistants**
  - No-legal tasks, such as organizing emails and formatting PowerPoint presentations, can be conducted using the Firm's general-use AI tool, Copilot.

Generative AI Tool

- **Policy**
  - Firm's Acceptable Use Policy on Generative AI
  - Only firm-approved generative AI platforms and tools may be used.
  - Always consult with the Clients with AI Limitations and Obligations list
  - Do not use GenAI for legal research.
    - GenAI tools may produce inaccurate results.
    - Only use Lexis or Westlaw for legal research.
  - Always double-check outputs for accuracy and completeness.

- **Harvey AI**
  - Harvey is generative AI legal assistant designed to support a variety of substantive task such as review and analysis and drafting support.

Harvey AI – Key Capabilities (for Litigation Practice)

- **Assistant**
  - General purpose Q&A tool with iterative chat that can summarize, analyze, ideate and draft based on uploaded documents or external knowledge sources.
  - **Assist mode:** for summarizing, Q&A, translating, extracting, brainstorming and similar tasks.
  - **Draft mode:** for generating content like emails, contract clauses, and sections of briefs.

- **Workflows**
  - Automated pre-built processes designed to simplify common tasks.
  - *Example*
    - Draft Oral Argument Outline in Support of Defendant's Motion to Dismiss.
      - Upload the relevant legal briefs, and Harvey will generate a detailed, formal outline for oral argument supporting the defendant's motion to dismiss.
    - Create Appellate Oral Argument Preparation Package and Outline.

Harvey AI – Key Capabilities

- **Vault**
  - You can store thousands of documents into a “project” workspace, enabling Harvey to perform a more sophisticated analysis than a one-time data upload, and saving time when needing to reference the same collection.
  - Once created, you can easily access a project from Assistant, and you can share your projects with other Harvey users within the Firm.


Thank you.

DLA PIPER

Asia IP Symposium 2026

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