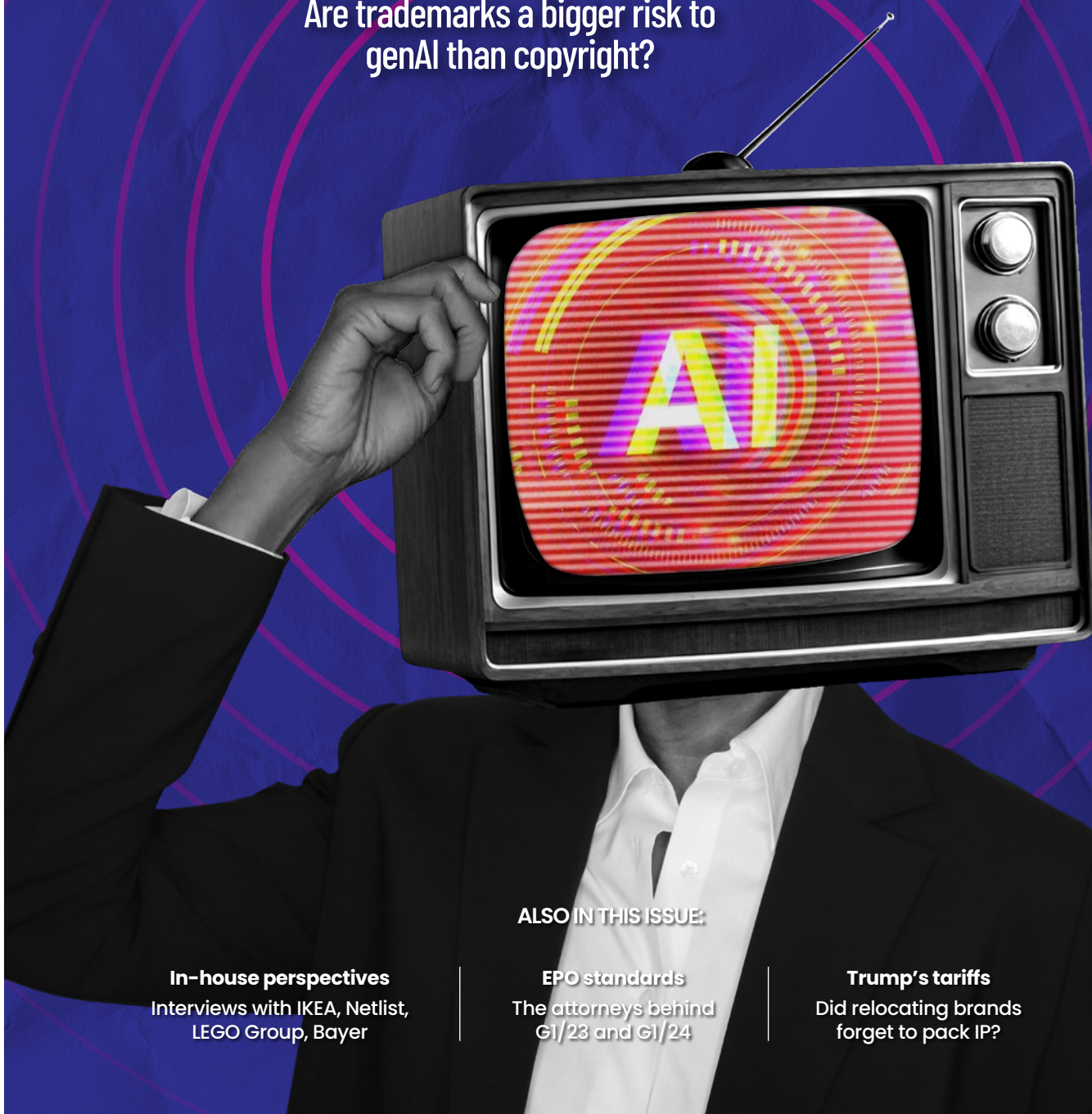


# BRAND NEW PROBLEM

Are trademarks a bigger risk to  
genAI than copyright?



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LEGO Group, Bayer

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The attorneys behind  
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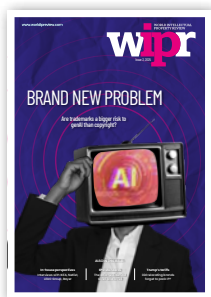


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# Human prompt



**ARE WE ENTERING AN ERA IN WHICH** greater appreciation is placed on human relationships? This is what is 'generated' in my head when I read another LinkedIn post about artificial intelligence (AI) tools eating attorneys' lunch.

Post-COVID lockdown, we saw a return to in-person meetings that has persisted. Human interactions are worth more now than ever before, with employers placing greater emphasis on people returning to the office and face-to-face meetings.

And after a few years of AI hype, there is a weariness of the hyperbole on its impact and of the necessity for everyone to care.

By contrast, I think of the in-house counsel featured in these pages. IKEA's Lara Doyle is "super honest" and manages external firms that the company has worked with for 30 years. Netlist's Rich Kim values counsel who can get their head around his company's business goals, just like he had to when he switched to in-house.

LEGO Group's Robin Smith applies her psychology background to better understand her team. Meanwhile, at Bayer, Dorian Immler is stepping into a role his predecessor held for nearly three decades.

AI tools are helping private practice to better serve its in-house clients. But it's also true that the people we speak to have unique situations and complex needs, aside from the legal work specific to their industries and jurisdictions.

The most AI-proficient law firm will miss a trick if it doesn't put a similar amount of hard work into understanding who its clients are on the human level, too. **ip**

*Tom Phillips, Group editor*

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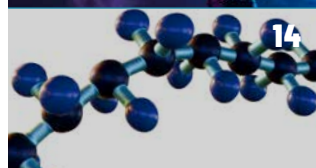
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## TRADE SECRETS

# Propel Fuels nets \$883m in secrets dispute

## PROPEL FUELS HAS BEEN AWARDED

an additional \$195 million in exemplary damages for trade secret misappropriation by a much larger rival, bringing the total sum awarded to the renewable fuels company to more than \$883 million.

Propel produces and sells renewable fuel—specifically renewable diesel fuel and an ethanol-based diesel fuel known as 'E85'. The defendant, Phillips 66, is a large, global oil company that sells fuel through a network of petrol stations.

The companies became embroiled in a bitter trade secrets dispute following a collapsed acquisition in 2018.

Propel accused Phillips 66 of misusing confidential information acquired under a non-disclosure agreement (NDA) to immediately launch a new renewable fuels business that swiftly grew into a multi-billion-dollar operation.

In October 2024, the Superior Court of California, County of Alameda found that Phillips 66 had engaged in "wilful and malicious behaviour" and was liable for a \$604.9 million award in compensatory damages, as well as pre-judgment interest. Propel then requested additional punitive damages to bring the total award to \$1.2 billion.

On July 30, Judge Michael Markman ordered Phillips 66 to pay additional exemplary damages as a result of its "reprehensible" actions against its smaller competitor.

## \$1.2bn would 'go too far'

However, he declined to award the level of punitive damages requested by Propel.

Markman wrote: "The court's \$195 million award is not what Propel wanted. The court, however, finds that Propel's proposed total award—\$1.2 billion—would go too far."

"The jury's award is enormous, but not punitive, because it forces Phillips 66 to give up the gains it made at Propel's expense."



IMAGE SHUTTERSTOCK.COM / PAPUCHAIKA - KAEIIMAGES

We hope this begins a serious discussion about corporate behaviour and ethics.

Rob Elam, founder and CEO, Propel

"The court's \$195 million figure punishes Phillips for its misconduct because it is directly tied to ... the real-world value of the benefit of the parties' bargain. It encompasses and then trebles the total value of the deal to Propel and its executive team."

Despite falling short of Propel's requested amount, the total sum awarded makes it one of the five largest trade secret judgments in US history, with the possibility of an additional award of attorneys' fees and costs to be added later.

Earlier this year, Daniel Zaheer, partner at Kobre Kim, who co-led the litigation on behalf of Propel, told *WIPR* that his client's quest for further damages following the October 2024 ruling was justified.

"The law is fairly clear. And this is the argument we presented before the judge: when the magnitude of the theft

is so large, the appropriate punishment has to be proportionate to that."

## An 'uncommon victory'

Rob Elam, founder and chief executive officer of Propel, welcomed this week's result following a "seven-year effort".

"The ability of a company of our size to persevere in a long battle against an adversary of this size is rare, and to achieve a successful result like this is even more uncommon."

"The time, money and commitment required to seek justice in these cases is extremely challenging," he said. "We hope this begins a serious discussion about corporate behaviour and ethics, and the damage being done to US competitiveness. Corporations need to be held accountable. The culture needs to be fixed."

Michael Ng, who led the trial team along with Zaheer, said: "As the order says, the story told by Phillips 66 fell apart on cross-examination. We are proud to stand with innovators, especially those like Propel who are willing to persevere through the challenges of the litigation process."

Markman anticipated that: "The total judgment is more than sufficient to cause Phillips 66, and public companies at large, to conduct due diligence fairly and to take reasonable steps to safeguard the trade secrets of their smaller potential acquisition partners." **ip**

## PATENTS

# UKIPO conjures The Beatles and Cluedo in pivotal case

**SALAMI-SLICING, TOASTERS**, songs by The Beatles, and the board game Cluedo all featured in arguments presented in Emotional Perception's hearing at the UK Supreme Court.

The two-day UK Supreme Court hearing concluded on July 22, in the high-stakes dispute between British tech startup Emotional Perception (EPAI) and the UK Intellectual Property Office (UKIPO).

The heart of the matter is whether an artificial neural network (ANN) can be patented in the UK, and much rides on the outcome in terms of its broader impact on the country's tech innovation.

"The stakes could not be higher," Alexander Korenberg, a partner at Kilburn & Strode, told *WIPR*. The case presents a "relatively rare patent law question for the UK Supreme Court", he added, "—whether an ANN falls under the UK Patents Act's 'programs for computers' exclusion, with potentially broad implications for patentability exclusions".

The invention at issue is EPAI's 'Recommendation Engine', an ANN which suggests content to a user of, say, a music streaming site. It does this by modelling "complex user interests"—for example, someone who likes both heavy metal and classical music—that may change over time.

EPAI claims that its system extracts physical properties from a highly advanced ANN, which is trained to map physical properties to semantic properties. The selection of a file achieves a narrowing of the 'semantic gap' in neural networks/AI to better align an output with how a person actually thinks.

Core arguments in the appeal are whether ANN can be defined as hardware or software, and whether mathematical methods and aesthetics should be excluded from patentability—both of which EPAI argues are irrelevant.

Presenting the UKIPO's arguments, Anna Edwards-Stuart KC posited that the invention's ability to provide semantically similar suggestions does not create



Based on the performance on the day and the Lords Justices' reactions, a clear winner of the argument seemed not apparent.

Alexander Korenberg, Kilburn & Strode

a technical effect, and that "the mere sending or receiving of existing files using standard file transfer techniques is not an interaction other than within the conventional programming of the system."

## Professor Plum in the ballroom...

To illustrate this argument, Edwards-Stuart used an imagined scenario from the board game Cluedo. Colonel Mustard in the study, Mrs Peacock in the billiard room, and Professor Plum in the ballroom, using different devices in different rooms in the house on different networks, select the same input file: The Beatles' *Lucy in the Sky with Diamonds*.

The ANN recommends to each of them two different songs that the ANN deems to be semantically similar—Pink Floyd's *Wish You Were Here* and Mozart's *Horn Concerto*—with varying rates of satisfaction from the users.

But, argues Edwards-Stuart: "All that's

happening is the existing tracks are the same. Existing files are moved using existing mechanisms in their existing file format and received in exactly the same file format."

The fact that the tracks are semantically similar "is not a technical effect".

## 'Bewildered by the arguments'

Responding to the hearing itself, Korenberg noted that the parties' submissions "were in some respects unsurprising, sticking closely to the battle lines drawn in the appealed Court of Appeal decision", but he was "at times left a bit bewildered by what arguments were actually being advanced and to what end".

"Based on the performance on the day and the Lords Justices' reactions, a clear winner of the argument seemed not apparent," he added.

Much of the debate during the hearing has concerned the four-step Aerotel test, a framework used by examiners to assess and decide upon the issue of excluded matter; and the five so-called AT&T signposts, used by examiners to assess whether a claimed invention involving a computer program makes a technical contribution.

The main contention, noted Korenberg, "seemed to revolve not around whether an ANN is a program for a computer or a mathematical method, but around whether any interaction of the alleged contribution of the invention with a non-excluded feature would take the claim outside of the exclusion, or whether it is required that the alleged contribution itself extends beyond the exclusions" (as currently required in the UK by the Aerotel test).

He added: "EPAI's counsel argued for the former, while the UKIPO's counsel pointed out that this also would require a change to the Pozzoli framework for assessing inventive step, or 'the roof would fall in'."

A decision is expected in the autumn of 2025. [ip](#)



## TRADEMARKS

# Post-sale confusion ruling welcomed by brand owners



**THE SUPREME COURT OF ENGLAND AND WALES** has weighed in on the 'double diamond' dispute between Umbro owner Iconix and Dream Pairs, ruling for the first time that post-sale confusion alone can be sufficient ground for trademark infringement in the UK.

The landmark judgment, handed down on June 24, aligns the UK with EU law—which recognises post-sale confusion—and is expected to have far-reaching implications for fashion brands.

It also stands as a "firm rebuke" to the Court of Appeal "overstepping its powers" when it reversed the High Court's decision, according to winning counsel Ewan Grist, partner at Bird & Bird.

## Court allows appeal—but not on claimant's grounds

The case concerns a trademark dispute between Iconix and Dream Pairs Europe over footwear logos.

Iconix owns the 'Umbro' trademarks (used on football boots since 1987), while Dream Pairs has sold footwear with its 'DP' logo via e-commerce sites such as Amazon and eBay since 2018.

Iconix sued Dream Pairs for trademark infringement, claiming the 'DP' sign was confusingly similar to its 'Umbro' marks. In 2023, the High Court initially dismissed Iconix's claim, finding only "very low

similarity" and no likelihood of confusion.

But the Court of Appeal reversed the decision, finding "moderately high similarity" and likelihood of confusion—particularly when viewing the 'DP' sign on football boots from above at an angle.

The Supreme Court unanimously allowed Dream Pairs' appeal—but not on the grounds it argued. Crucially, the court rejected Dream Pairs' argument that post-sale circumstances cannot be considered when assessing similarity, and only confusion affecting future purchasing decisions should be deemed as infringing.

## Post-sale confusion is legitimate

The judgment clarifies that realistic post-sale viewing circumstances can be considered when assessing both similarity and confusion, and that post-sale confusion need not affect future transactions to constitute infringement. In short, the court held that post-sale confusion is a legitimate basis for infringement but should not apply in this particular case.

Significantly, the Supreme Court found that the Court of Appeal was wrong to substitute its own assessment for the trial judge's findings because the legal test requires showing an 'identifiable flaw' like irrationality or legal error—not merely that the appellate court might have reached a different conclusion.

Grist, who led the legal team representing Dream Pairs, said that the Supreme Court's judgment will be broadly welcomed by trademark owners, but less so by startups.

"The Supreme Court held that 'real and representative' post-sale circumstances (eg, a particular viewpoint from which a sign might be encountered) can be taken into account when assessing similarity of the mark and sign, and that post-sale confusion can be a basis for a finding of infringement, even if there is no confusion at the point of sale," he explained.

These findings, he added, will give the trademark owner "more latitude to be able to allege infringement" and "make it easier to oppose new trademark applications". As a result, this outcome is "potentially good news for trademark owners, but bad news for new market entrants".

## Post-sale confusion 'legitimate'

Brandsmiths partner Andy Lee, who represented Iconix, told *WIPR* that he disagreed with the court's view that the Court of Appeal had erred, pointing out that the latter court had the benefit of specialist IP judges.

"Naturally, I still remain of the view that the first instance judge (who was not an IP judge) was wrong and specialist IP judges (Lord Justices Richard Arnold and Colin Birss) were correct."

However, he added that "the landmark judgment" would be largely welcomed by brand owners because it confirms that post-sale confusion is "a legitimate factor for courts to take into account when assessing a likelihood of confusion"—even if there would be no point of sale confusion or impact on a subsequent purchasing transaction.

"The court confirmed that trademarks have an important ongoing role and existence after sale and should be appropriately protected, recognising the value of brands and the work that goes into establishing them," said Lee. [ip](#)

## ARTIFICIAL INTELLIGENCE

# Hollywood studio issues AI 'hands off' warning

## UNIVERSAL PICTURES IS STRIKING BACK

against the trend of artificial intelligence (AI) developers using its film content to teach AI systems.

The studio has started adding explicit legal warnings in the end credits of its films, stating that the content "may not be used to train AI", in a strategic move to assert its IP rights. These notices appear in recent releases such as *How to Train Your Dragon*, *Jurassic World Rebirth*, and *The Bad Guys 2*.

Typically, the message reads: "This motion picture is protected under the laws of the US and other countries. Unauthorised duplication, distribution or exhibition may result in civil liability and criminal prosecution."

In Europe, some versions also cite Directive (EU) 2019/790, particularly Article

4(3), which allows content creators to object to their work being used for certain types of scientific or research purposes—including AI training.

The development comes as the US presidential administration unveiled a controversial new AI strategy, which sidesteps the debate over copyright licensing and has drawn sharp criticism from creators who have warned of a 'Wild West' for rights owners.

### Ignorance 'no defence'

Universal's new approach coincides with its joint lawsuit with Disney against AI image generator Midjourney over the alleged unauthorised use of their content in model training.

Filed in June, the lawsuit marks one

of the most aggressive legal moves yet by major Hollywood studios against AI developers. Universal and Disney claim that Midjourney is "a bottomless pit of plagiarism" after it allegedly scraped millions of copyrighted images from their movies, shows, promotional materials, and other protected content without permission.

The litigation coincides with other high-profile AI copyright cases such as *Getty Images v Stability AI*, and *The New York Times v OpenAI*.

Universal's anti-AI training legal warnings are widely viewed as serving explicit notice to potential infringers, with the aim of making a developer's 'ignorance' less defensible in the event of a copyright infringement lawsuit. [ip](#)

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## STANDARD-ESSENTIAL PATENTS

# UK launches SEPs consultation in bid to tackle inefficiency

**THE UK INTELLECTUAL PROPERTY OFFICE** (UKIPO) has launched a consultation on potential measures to address challenges in the UK's standard-essential patents (SEPs) ecosystem.

The 12-week consultation, launched on July 15, invites responses from businesses and stakeholders by October 7, 2025.

SEP disputes have become increasingly complex, lengthy, and costly, usually involving parallel cross-border proceedings. The UK Supreme Court's ruling in *Unwired Planet v Huawei* (2017) established the UK courts' ability to determine global FRAND licence terms for SEP portfolios.

Subsequent high-profile SEP disputes in the UK Court of Appeal and High Court include *InterDigital v Lenovo*; *Panasonic v Xiaomi and Oppo*; *Optis v Apple*; and *Tesla v Avanci and InterDigital*.

Judgments have drawn eye-watering damages, the most recent being the record £700 million verdict that Apple was ordered to pay Optis (May 2025).

## UK a premier venue for FRAND disputes

These cases have positioned the UK as a go-to jurisdiction to determine fair, reasonable and non-discriminatory (FRAND) rates, with the courts issuing substantial FRAND judgments that address factors such as past sales and interest.

The UK courts have also shown a willingness to consider interim FRAND licence terms, and there is a trend towards 'FRAND-first' approaches, where the technical trial of whether a patent is valid and infringed no longer necessarily precede the FRAND determination.

But, according to the UKIPO, there remains a lack of pricing transparency, which can result in licensees, including SMEs, overpaying for licences. For example, licensing offers made by SEP holders have exceeded court-adjudicated rates by 400-500 times—so-called “supra-FRAND rates”.

There is, in fact, no single methodology for calculating a FRAND rate, and the methodology used is not always disclosed by the SEP holder during licensing negotiations, said the office.

This “asymmetry of information on pricing and essentiality” between the SEP holder and the licensee can lead to disagreements and delays.

Evidence also suggests that only about 25-40% of all declared SEPs are truly essential to a given standard, said

smaller businesses when seeking to implement standardised technologies.

The aim of the consultation is to help ensure that the UK's SEP framework “operates more efficiently, supporting both patent holders and technology implementers”.

Proposed measures include:

- Specialist rate-determination track to provide licence rates for SEP portfolios on a case-by-case basis. This could increase consistency and transparency in SEP pricing, and could give businesses of all sizes a more efficient and cost-effective route to obtain a SEP licence rate.
- Mandatory provision of searchable information which would require patent holders to disclose standard-related patent information to the UKIPO, and help address the current lack of transparency in SEPs and licensing obligations.

**As long-standing advocates for a balanced and effective IP framework, we support measures that enhance transparency, facilitate timely and fair licensing negotiations, and promote efficient dispute resolution.**

Sarah Vaughan, IP Federation

the IPO. Further, there are variations in the practices of standard development organisations (SDOs) regarding the level of information they demand.

## SEPs are 'building blocks' of connected future

Evidence illustrated in the consultation document highlights inefficiencies in the UK's SEP ecosystem that could create barriers to innovation—particularly for

## 'A critical opportunity'

The consultation was welcomed by industry bodies. President of the IP Federation Sarah Vaughan said: “As long-standing advocates for a balanced and effective IP framework, we support measures that enhance transparency, facilitate timely and fair licensing negotiations, and promote efficient dispute resolution.”

Bobby Mukherjee, president of the Chartered Institute of Patent Attorneys (CIPA), added: “The UK patent profession is one of the most skilled and experienced in the world in the SEP arena and we welcome the IPO's energy and vision in initiating activity in a vital support area for our market-leading offering.”

Chief executive of the UKIPO Adam Williams described the consultation as “a critical opportunity for all stakeholders to help build an SEP ecosystem that works for everyone”.

The government is encouraging responses from interested parties across the SEP ecosystem. **ip**



## PATENTS

# Samsung triumphs as UPC voids wireless network patent

**THE UNIFIED PATENT COURT** (UPC) has handed a win to Samsung in its feud with licensing company Headwater Research, dismissing an infringement action against the South Korean electronics giant.

In a decision issued on August 1, 2025, the UPC's Munich Local Division partially revoked Headwater's patent in France and Germany, over wireless communication technology in mobile devices.

The patent, European Patent 2,391,947, relates to technology for managing data usage across different wireless networks on mobile devices.

Headwater had alleged that Samsung's Galaxy smartphones and tablets running Android 7 or higher infringed multiple claims of the patent.

The decision comes as Headwater continues an aggressive patent enforcement campaign, having won \$279 million against Samsung in a separate US case earlier this year and pursuing ongoing litigation against companies including Verizon, Amazon, Google, and Apple.

## Samsung mounts defence

In February 2024, Headwater filed a patent infringement lawsuit against Samsung, alleging that Samsung's mobile devices running Android 7 or higher violated its patent.

Samsung challenged the patent's validity on multiple grounds, including added subject matter, lack of novelty, and inventive step.

It also questioned Headwater's legal standing, claiming that the patent may have been improperly assigned.

Samsung argued that the original inventor's employment agreement with Qualcomm meant the patent should have automatically transferred to Qualcomm, potentially making Qualcomm a co-owner requiring consent for litigation.

A key aspect of the dispute was whether Samsung's devices implemented the claimed functionality.

Samsung argued its devices only



Samsung accused Headwater of interpreting the patent claims too broadly.

differentiate between metered and unmetered connections rather than different network types, and that the accused functionality was reactive rather than using the 'agents' claimed in the patent.

Additionally, Samsung accused Headwater of interpreting the patent claims too broadly.

Headwater countered that the accused features were present in Android's data-saving mode, which has been part of the operating system since version 7 (introduced in August 2016).

Samsung also opposed Headwater's request for injunctive relief, calling the company a non-practising entity focused on licensing expectations.

## Court rules verification feature was essential

The court's detailed decision found Headwater's patent was invalid for added subject matter. The panel, led by Presiding Judge Matthias Zigann, concluded that during prosecution, Headwater had broadened the scope of the invention by removing a key "verifiable" feature.

The original application was based on "verifiable device-assisted service policy implementation", which the court deemed an "integral and indispensable" element of the technical teaching.

However, claim 1 of the granted patent had no verification requirements.

"The skilled person would take that the policy implementation being verifiable was foreseen as an integral and indispensable part of the invention," the court said, noting that the network provider would want to retain control through verification over end-user data management options.

Beyond the verification issue, the court also found that claim 1 improperly combined features that had not been disclosed together in the original application.

"Claiming a combination of seemingly individually disclosed features, without the application providing the skilled person with any guidance to do so, boils down to artificially creating an embodiment which constitutes added matter," the court wrote.

The panel reviewed each feature group and found deficiencies, including that the application did not disclose any 'agent' capable of both detecting wireless connections and collecting user input for policy enforcement.

Headwater submitted 30 auxiliary requests attempting to save the patent, but the court found these insufficient.

With the combined value of the infringement action and Samsung's counterclaim set at €5 million (\$5.5 million), the ruling allows Samsung to recover up to €600,000 in costs. [ip](#)

# 'WE CREATED LAW': G1/24 AND THE CREATION OF THE 'DIAMOND STANDARD'

The architect of a historic change in the way patent claims are interpreted explains what it means for AI drafting, and why more harmonisation may follow, reports **Tom Phillips**.



**M**arcel Kortekaas is in a good mood. After all, it's not every day you win a case that changes patent law.

The partner at Dutch patent attorney firm EP&C has achieved something that few people can claim in their career, even those with close to 40 years of experience behind them.

Kortekaas was the lead in an opposition in G1/24, which saw the European Patent Office (EPO) clarify the method of interpreting patent claims when assessing the patentability of an invention.

The EPO ruled that, while the claims are the starting point and the basis for assessing the patentability of an invention, the description and drawings must always be consulted to interpret the claims.

In doing so, it put an end to the "primacy of the claim" that for decades had been the EPO's approach; and harmonised the EPO with Europe's national courts and the Unified Patent Court's (UPC) Court of Appeal.

**The EPO now has work to do because it has to change established examination practice in which the description was minimally used.**

## TAKEAWAYS

- G1/24 case changed patent law
- EPO's ruling ended 'primacy of the claim'
- Days of 'angora cat' may now be over

The landmark ruling also aims to end the 'angora cat' problem, where patentees can present their invention broadly when arguing for infringement, but narrowly when arguing against prior art to establish novelty.

## Vape patent feels the heat

The historic ruling arrived off the back of an opposition filed by Yunnan Tobacco, against a Philip Morris patent for a heating device used in a vape. In particular, a dispute over claim 1 of the patent, containing the feature that the material is a "gathered sheet".

Philip Morris argued that if this term is assigned its usual meaning in the art, claim 1 is to be regarded as novel.

The opponent, led by Kortekaas, argued that if "gathered sheet" is interpreted in the light of the description, including the definition given, then it would have a broader and still technically sensible meaning—an interpretation that would lead to a lack of novelty.

This resulted in a referral by the

Technical Board of Appeal to the Enlarged Board of Appeal (EBA), seeking clarity on three points.

The EBA answered two questions, but not the third, leaving plenty for attorneys to chew over.

Kortekaas describes it in simple terms: "The competitor had a patent, and the patent was blocking what my client wanted to do.

"I looked at the patent and came to the conclusion that the scope, if interpreted from the perspective of a court, would be very broad, because there was a definition in the text that broadened one of the expressions used in the claim. Moreover, I found prior art that overlapped with that broad scope."

The Technical Board of Appeal agreed, but concluded there is no such clear message whether this claim interpretation also applies to the patent office in the EPC, so it referred the issue to the EBA.

Claims are interpreted differently from country to country, and European patent attorneys will know the intricacies of how a court would review them. However, the



EPO applies a different approach from the national courts—"and now everyone gets confused," says Kortekaas.

"If there's a difference, then a court will look into this and will always review it from the perspective of a person skilled in the art, but will consider what's in the description and the drawings. Now—and this is the victory that I achieved—this will also be done by the EPO."

### Route to a new 'diamond standard'

A challenge for Kortekaas, who was aided by colleague Thomas Remmerswaal, was to show that the question was relevant enough for the EBA to consider.

"That, I think from my end, was easily answered, because interpreting the claim is at the heart of the patent system," says Kortekaas.

"The position of the patentee was different. Having much more to lose—the validity of the patent is at stake—they argued unsuccessfully that this question was already

answered. The EBA disagreed and instead agreed to consider this important point of law."

At issue was the EPO's own standard—the way it approaches its work. In this, Kortekaas saw an opportunity.

"You can't change the way claims are interpreted by a court, because this is set in the law, but you can change the principles as applied by the EPO."

The so-called 'gold standard' is one such principle, which refers to a test used to assess whether an amendment to a European patent application or patent complies with Article 123(2) EPC.

"I thought: we are not applying an article, we are not applying a rule, we are applying a principle, which I refer to as the 'diamond standard'."

It was a case that allowed the experienced attorney to research the foundations of the patent process and ask: why?

"Patent attorneys do have a double background: technical as well as basics in law.

"And here I was actually challenged to look into the legal principles, the history of the European Patent Convention, how it was set up, reviewing the history where people commented whether clarity should be a ground for opposition and why that was rejected, how they reviewed opposition proceedings, whether that should be the same or not," he recalls.

### Implications for patent drafting

Claims remain "at the heart of the system", maintains Kortekaas. "This is where interpretation starts."

But the claims will now be interpreted in light of the description and drawings. Not just in court, but also before the patent office.

What may happen more as a result is that when people amend their claims, they will amend the description of the invention and/or the drawings too, in order to indicate within the description that some embodiments of the invention and/or some of the



**We are not applying an article, we are not applying a rule, we are applying a principle, which I refer to as the 'diamond standard'.**

Marcel Kortekaas,  
EP&C

drawings are no longer part of the invention. But it is too early to say for sure.

There's a sense check for those using artificial intelligence (AI), though, which is famously inconsistent at providing the kind of clarity on which a well-drafted patent relies.

The EPO now has work to do because it has to change established examination practice in which the description was minimally used.

Kortekaas believes AI is an "excellent tool", but G1/24 demands that its output is reviewed more thoroughly.

### RIP the 'angora cat'?

The days of the infamous angora cat may now be over.

It's common practice to add definitions for interpreting expressions in the claim in the text and this is unchanged, says Kortekaas.

"However, you must keep in mind that there needs to be consistency between the claim and the definitions in your text," he warns.

"And keep in mind that you need to have fallback positions in your text for those broad definitions."

He gives the example of a life science patent claim with a reference to microorganisms. You can include a definition, but now you must make sure that you also have a fallback for what specific microorganisms you are targeting.

"Because if that's the only broad definition that you have—and that's the only expression you have in the claim—you may run into problems when there's overlap with the prior art," he explains.

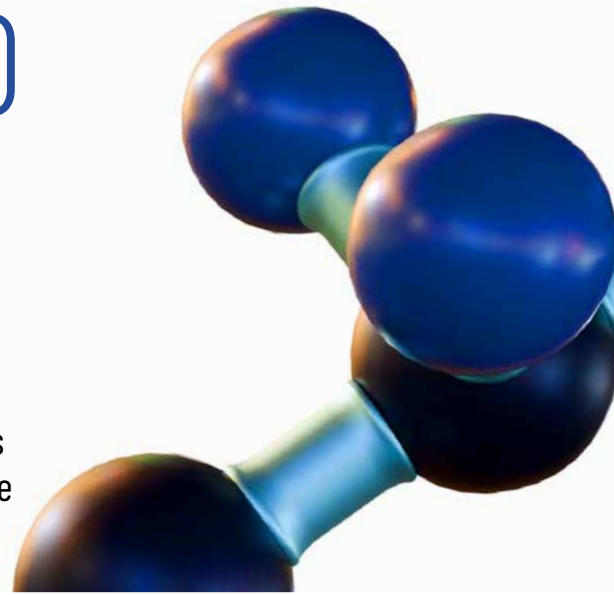
For many years, the EPO has focused on its case law as the standard. But the arrival of the UPC in 2023 and rulings from its Court of Appeal mean it has competition. Many say: the UPC has primacy and the EPO should listen. **ip**

*An extended version of this interview is available to read at [www.worlddipreview.com](http://www.worlddipreview.com)*



# HOW G1/23 CHANGED EUROPEAN PRIOR ART RULES

The lawyer behind a landmark ruling that reshaped prior art rules reveals how the decision will impact patent-opposition proceedings and influence trade secrets, and why strong legal arguments should never be lost in a 'sea of weaker ones'. **Marisa Woutersen** reports.



**T**he European Patent Office's (EPO) highest appeals body has brought clarity to a question that has divided patent professionals for decades: does a commercial product count as prior art if it cannot be reverse engineered?

In G1/23, Neil Campbell helped overturn a decades-old precedent that has shaped European patent practice for more than 30 years.

The case arose from a clash between Mitsui Chemicals, owner of EP 2626911 for a polymer product, and challenger Borealis, which claimed a similar product—Engage 8400—was already on the market.

The Dehns partner represented Borealis in the landmark case in which the EPO's Enlarged Board of Appeal swept aside a controversial test, ruling that any commercial product placed on the market before a patent filing counts as prior art—even if its structure or composition cannot be fully analysed or reproduced by a skilled person.

Campbell explained to *WIPR* why the board found his arguments persuasive, why written submissions carried the day, and what it means for patentees and opponents going forward.

***WIPR: Given that the board had a fairly strong preliminary view, do you think the hearing had a real impact on the final decision?***

Campbell: The decision hasn't

**The EPO livestreamed the hearing and that's a pretty rare thing. It was quite a strange experience, and it's definitely higher pressure.**

## TAKEAWAYS

- G1/23 overturned decades-old precedent
- Decision 'opens door to wider range of prior art'
- Importance of written submissions emphasised

changed much from the preliminary opinion. You could possibly argue that the hearing was of less importance in terms of how the board came to its decision.

All parties—and interested third parties—had the right to file written submissions. Primarily, those written submissions, filed before the hearing, shaped the view of the board.

The board didn't really interact with the parties at all at the hearing, and they appeared almost reluctant to have ever appointed a hearing in the first place.

The arguments we presented in writing were coherent, convincing, and clearly explained my client's concerns with the law as it then stood.

## Do you think the board's reasoning and decision went far enough?

I don't think it could go much further. I think it really clarifies the law and removes ambiguity. Some might find that it possibly broadens the prior art too much, but at least now we have absolute clarity, in my view, on what constitutes the state of the art in this situation.

Historically, there was this requirement that came out of G1/92—the ability to reproduce the products—which was just this inherently subjective test. They've concluded that this reproduction requirement is essentially satisfied when you put the product on the market.

They're saying that there is still a reproduction requirement, but it's fulfilled when you put the product on the market—and that's our position.

They've also maintained the requirement that whatever it is you allege has been disclosed has to be determinable. You have to be able to analyse that product to determine, for example, that it has a viscosity of X. Only things that are analysable are disclosed.

They didn't go for the alternative middle position, which would have been a partial reproduction requirement, because they saw many of the same problems I see with it.

Namely, at what point is something partially reproduced? How close does it have to be? How many features do you need to have reproduced? Is that purely a function of what you're comparing it against? It would have opened another can of worms if they'd gone down that route.

## What do you think was the most persuasive argument to the board?

The most persuasive argument was that a reproduction requirement creates an endless chain of questions.

To make a product, you might need material X—but then you have to ask: can X itself be reproduced? And to make X, you might need Y—so can Y be reproduced? This can keep going backwards until you're left asking whether even

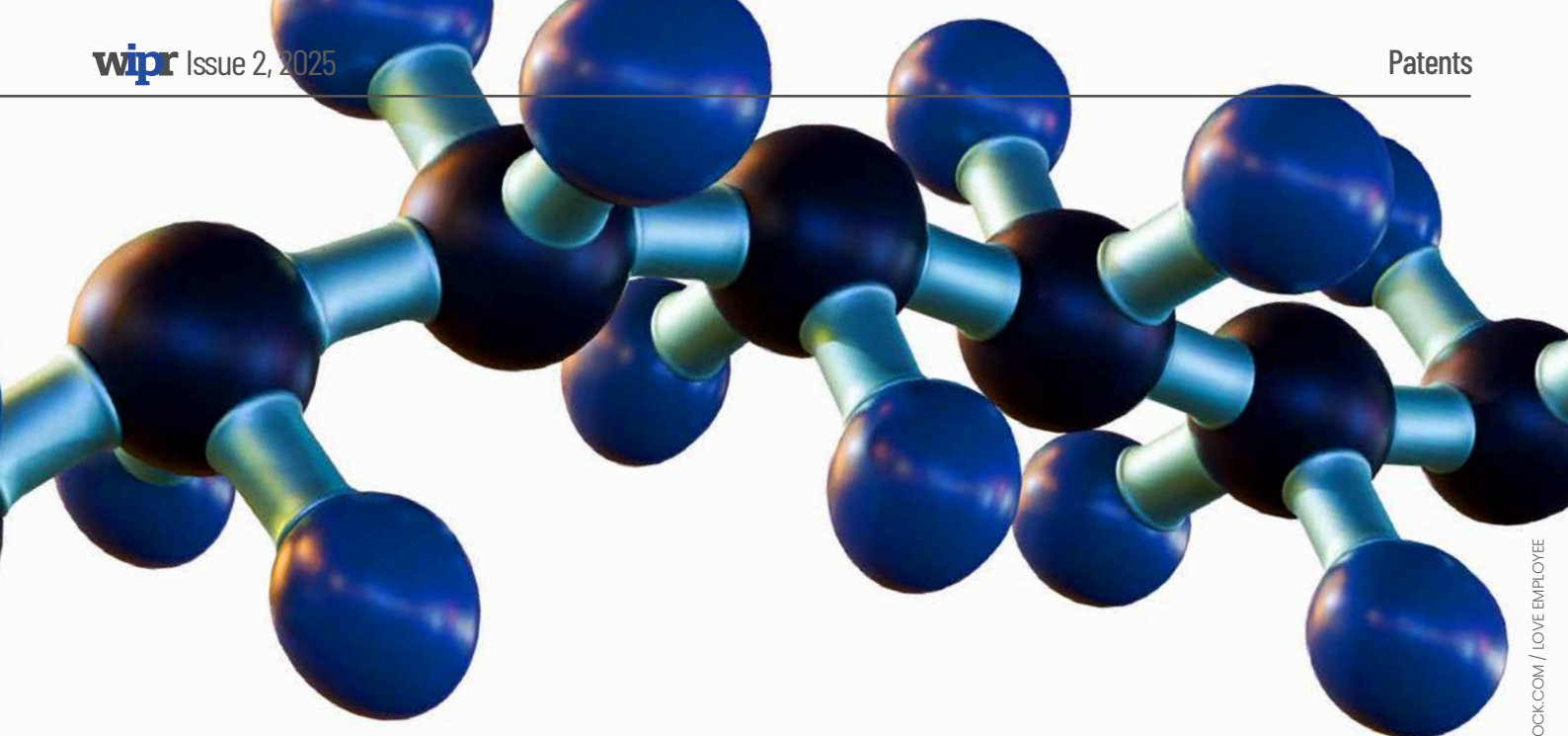


IMAGE: SHUTTERSTOCK.COM / LOVE EMPLOYEE

a chemical element can be reproduced.

The board has stepped back and looked at some of the ramifications of this requirement.

In its decision, the board saw this problem and said: you could eventually start arguing that nothing is reproducible, because it all has to come from somewhere, and that initial “something” isn’t itself reproducible.

#### What lessons do you take away from handling such a high-profile case?

It emphasises that you need to get your written documents right. Obviously, there are fixed deadlines. But it was important for us to set out our position very clearly in the written submissions, and to counter, as far as possible, the arguments of the case proprietor.

What we do is make sure we’ve set out our position very clearly, and we’ve clearly pointed out the flaws in the other side’s position in writing.

The main take-home is: the importance of the written submissions really cannot be underestimated.

The EPO livestreamed the hearing and that’s a pretty rare thing. It was quite a strange experience, and it’s definitely higher pressure. You find yourself asking: how much should I say? How long should I speak for? You really have to get it just right. The key lesson there, and this is true more broadly,

is: never bury your good points in a sea of weaker ones.

#### What challenges did you face, and how did you overcome them?

The other side had some very coherent legal arguments. One of the most interesting and potentially challenging points they made was: what happens if a product that’s on the market today is discontinued tomorrow?

My colleague came up with a good analogy. It’s not really any different than if you have a book in a library and the library burns down.

The book no longer exists, but you can’t pretend that it never did. It then becomes an evidentiary question—what did the book actually say? The same applies to products, it’s an evidentiary question of what the product was.

The other side also argued that the test under article 83 and article 54 should essentially be the same. When you file a patent application, there’s an obligation to disclose the invention in a sufficient manner—that’s article 83. They argued that the same standard should apply to a commercial product placed on the market.

In order for it to be deemed reproducible, essentially the same amount of information would be needed as for a patent application, because it should be the same test.

If that had been correct, we probably would have lost. But I believe the board concluded



**The main take-home is: the importance of the written submissions really cannot be underestimated.**

Neil Campbell, Dehns

correctly that the requirements for prior art are not the same as the requirements for a patent application. The law is not the same.

#### Do you expect this decision to change any practices at the EPO, particularly in relation to opposition proceedings? If so, how?

This decision opens the door to a wider range of prior art—especially in industrial chemistry, where many commercial products are large, structurally complex macromolecules that even the manufacturer may not fully understand.

Opponents will now be more likely to consider these products when drafting an opposition to a granted patent. They can ask: do any of my commercial products fall within the scope of this claim?

If so, and if they can prove those products were on the market before the patent application was filed, they now have a viable basis for an attack. There’s still an evidential hurdle as you have to demonstrate that the product was on the market, and that what you sold had these properties.

But it is going to open the door and it’s going to make it slightly easier to run a prior use attack. A prior use attack is certainly going to become a more common route for opponents before the EPO now. **ip**

*An extended version of this interview is available to read at [www.worldipreview.com](http://www.worldipreview.com)*

# CREATIVE LICENCE: INSIDE THE LEGO GROUP'S ASIA PLAYBOOK



The VP and general counsel for China & APAC tells *WIPR* how creativity and psychology help her protect one of the world's biggest toy brands.

It was a passion for storytelling and the stage that led Robin Smith, vice president and general counsel for China & APAC at LEGO Toy Shanghai (the Chinese subsidiary of the Danish multinational), onto the unexpected path to IP.

A chance conversation with a law student friend helped the theatre and psychology double major see how the field could merge her legal curiosity with her creative instincts.

"Before, I had never really thought that there was any way to combine my passion for law with my love of creativity," she says.

This serendipitous advice led to Smith's over 25-year tenure at one of the world's largest toy brands, which certainly hasn't been short of exhilarating twists and turns.

"I have seen so many changes, growth and development of the company in different directions, just on a major scale. We've grown massively, and that, of course, affects the legal work that we need to do," she says.

## Exciting growth and opportunities

The group's latest financial figures reflect this assessment.

In 2024, the company achieved a 13% increase in revenue, reaching approximately \$10.85 billion—a growth driven by strong demand across the Americas, Europe, and the Middle East. Notably, consumer sales rose by 12%, outpacing the overall toy market, which declined by 1%.

Smith has achieved a number of milestones during her time at the multinational, including landing the company's first IP attorney role outside of Denmark.

## China remit

As part of her current remit, she looks after legal matters across Asia, including IP rights and compliance



**We've grown massively, and that, of course, affects the legal work that we need to do.**

Robin Smith,  
LEGO Toy Shanghai

issues, and leads a team of lawyers in China, Vietnam and Singapore.

The IP team across the region comprises six people, who spend about 50% of their time on various IP enforcement work, both online and offline. The remainder is spent on trademark prosecution, IP training, and supporting the business's day-to-day IP queries.

What does she think is the biggest misconception people have about the role of an IP counsel, particularly at a company like the LEGO Group?

"Some believe that we're only there to remind employees about the proper use of our trademark, or that maybe we handle a lot of paperwork—that we don't actually do a lot of exciting things."

This perspective, she argues, could not be further from the truth.

## Pivotal cases

To prove her point, she refers to major IP enforcement raids that her team in China has been directly involved in. "My lawyers in China have cooperated with the Shanghai police during these operations, including some of the largest criminal copyright enforcement raids ever completed in China."

The biggest raid to date concerned products called Bela sold by a Chinese toy manufacturer producing infringing toy sets, including copycats of the popular LEGO Friends line. This saw the Danish toy company participate in an operation seizing 1.2 million infringing product sets.

Even more notable from an IP perspective was the LEGO Group's legal action against Shantou Meizhi Model, a company that sold counterfeit LEGO sets under the brand name Lepin.

Between 2015 and 2019, the Chinese company produced more than 600 counterfeit LEGO Group

products, including copies of sets from popular themes like Ninjago, Nexo Knights, and Legends of Chima.

In November 2018, the Guangzhou Yuexiu District Court ruled in the Danish toy company's favour, ordering the Chinese company to cease production.

In January 2020, the Guangzhou Intellectual Property Court recognised 18 sets and corresponding minifigures as copyrighted works of art under Chinese law. The Lepin case was a game-changer in China, according to Smith. "The judge ruled that our models, when fully built outside of the box, can actually be protected as artistic works under the copyright law, which is huge for us."

"If somebody is advertising a copycat for sale on a platform somewhere, and they're only showing the built model—which is an actual copy of our product—then we can enforce against that. That was a major step forward for us."

## Know your team

Unsurprisingly for a psychology major, understanding the mindset and dynamics of her team matters. To get the best from her team, Smith uses coaching tools such as StrengthsFinder training.

While this tool lists many strengths per individual, it's the top five that truly matter. She explains: "It's very rare for two people to have the same top five in the same order. That itself proves that having diverse strengths on your team is an advantage—as long as you get to know what they are, what each person brings, and encourage collaboration."

"If you do that, your team can probably handle just about anything." **ip**

*An extended version of this interview is available to read at [www.worldipreview.com](http://www.worldipreview.com)*



AI

# Getty Images v Stability AI: Five takeaways from the courtroom

**THE UK'S HIGH-PROFILE** *Getty Images v Stability AI* trial, which took place in June, delved into tricky issues concerning trademark, copyright, and database rights.

But the stakes go beyond the courtroom for both artificial intelligence (AI) companies and creatives.

WIPR spoke with those who attended courtroom 30 in London's Rolls Building to discover the key takeaways.

## 1. Review pleadings regularly

The first few days of the trial were overshadowed by procedural points, including Getty's unsuccessful appeal to the Court of Appeal on the scope of its pleaded trademark tarnishment claim.

Getty asked the Court of Appeal to rule on whether its original claim—alleging that Stable Diffusion produced violent and pornographic images with Getty's watermark—specifically included child sexual abuse material (CSAM).

The court upheld an earlier decision that CSAM had never been specifically pleaded, and it was too late to expand the claim.

Louise Popple, senior knowledge counsel at Taylor Wessing, describes the ruling as “a reminder to plead a case properly”.

## 2. Ensure nothing is missed early on

Rebecca Newman, managing associate at Addleshaw Goddard, agrees.

“It does highlight the importance of making sure counsel is aligned with every update that is made to the pleadings, even at procedural stages such as the CMC,” she explains.

Newman advises that if a party is asked early on in a case to provide examples to further detail a claim, counsel should be fully engaged with what's being added.

## 3. Do your due diligence

Ellen Keenan-O'Malley, senior associate at EIP, cautions AI companies about



IMAGE: SHUTTERSTOCK.COM / WILLIAM BARTON

**To enforce your IP rights, the copyright owner may have to be willing to litigate overseas, which requires deep pockets.**

Ellen Keenan-O'Malley, EIP

the reputational risks of using unvetted data.

While Stability was successful on the CSAM issue, the fact that “it dominated the headlines for many days, and will live on in the court transcripts, should be a warning to all AI companies using data scraped from the internet and/or unknown sources,” Keenan-O'Malley says.

The reputational damage, let alone the legal risk of being in possession of such data, should push tech companies to enter into licensing arrangements with the copyright holder.

This is to “ensure they have assurances that no such data is in their dataset as well as having legal recourse in the event that it is”.

## 4. Creatives should join forces to build litigation funds

According to Popple, a “significant hurdle” for Getty will be establishing a clear connection to the UK when arguing that the training breached UK copyright law.

This may be difficult, as most of the model training appears to have taken place overseas, and any UK-based activity involved materials stored on cloud servers located abroad.

Keenan-O'Malley notes that proving infringement in the UK requires evidence that the infringement occurred in the UK.

This is especially difficult in proving copyright infringement of input data as many AI models are trained on cloud-based networks located outside of the UK, she explains.

“To enforce your IP rights, the copyright owner may have to be willing to litigate overseas, which requires deep pockets,” Keenan-O'Malley says.

She suggests that creative companies may want to consider “getting together to build litigation funds solely for the purpose of being prepared to enforce their rights”.

One option could be a rise in ‘before-the-event’ insurance to cover risks.

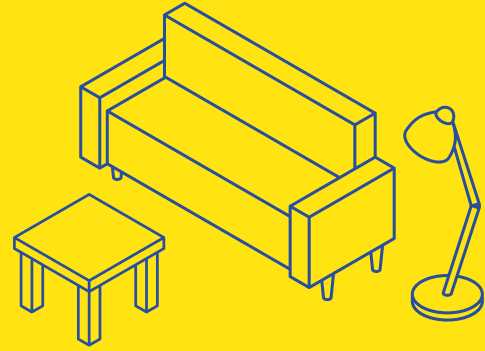
## 5. AI companies should assess risks of UK offerings

Another issue is whether Stability could be held liable for secondary infringement by bringing the allegedly infringing model into the UK.

Newman notes that the trial could lead to an important ruling that AI models trained abroad using data scraped without permission cannot be offered to users in the UK. **ip**

# 'I AM SUPER HONEST—WHAT YOU SEE IS WHAT YOU GET'

The legal counsel for the world's largest furniture company sits down with **Muireann Bolger** to address misconceptions about her role and the IKEA brand—and to explain why an in-house legal team should be 'more than a showstopper'.



**A**sk Lara Doyle what her secret talent is and chances are she might say an ability to assemble a fully functioning chest of drawers in just over half an hour.

Compare this with the one to two hours it takes the average person—more than a third of whom will require help from another.

But as the IP counsel of IKEA, Doyle is happy to admit that team-building assembly exercises over the years have given her something of an edge.

The Dutch native tells *WIPR*: "I am super honest—what you see is what you get."

The same could be said for the brand identity that the Swedish multinational has carefully cultivated since its founding in 1943.

Known for its flat-pack furniture, minimalist Scandinavian design, and affordable pricing, it's the world's largest furniture company. Its no-nonsense approach to products has made it a household name across the globe.

It's a strategy that shows little sign of slowing: currently operating in more than 60 countries, it draws more than 4.6 billion online visits annually and 800 million in-store visitors.

Doyle sits down with *WIPR* to explore her role at IKEA.

## **WIPR: Can you tell us about yourself and your journey into the world of IP?**

**Lara Doyle:** I chose IP as a career because it's super relatable and quite fun. I worked for Bird & Bird for many years and really enjoyed that.

After about eight years in private practice, I went in-house for a company called Bugaboo, which produces high-end strollers. After that, I joined the IKEA team, where I've been for the past four years.



**We really rely on external counsel, so our relationships with them are super important.**

Lara Doyle, IKEA

## **What's one of the biggest differences between working in private practice and in-house?**

As a lawyer in private practice, you always say, "Oh, we really know the client inside out," but then you start on the client side in-house and you think, "They had no idea!" You really have to know the business very well when you're in-house.

As an external lawyer, there's only so much you can understand from the outside. Being in the company itself is completely different.

## **What is the biggest misconception about your role at a well-known brand like IKEA?**

The first thing I think of is that legal is always seen as the showstopper. When companies engage an external lawyer, it's often because there's something seriously wrong.

But when we're in-house and working with all the teams, we want to work in a collaborative manner. We want to help them do their job and be involved early so we don't have to be the showstopper at the end.

## **Can you tell us about your team and the different functions within it?**

In the team, we have a fairly lean structure—only six people in Delft in the Netherlands where we're based. There are also legal teams in Sweden and Switzerland who have their own IP lawyers, but overall it's not a very big group.

We have a fairly standard structure, but I think the difference is that we don't just specialise in one area of IP which makes the work very diverse.

Because we're a lean organisation, we don't have people in every country, but we work with external counsel. We really

rely on external counsel, so our relationships with them are super important.

## **What qualities do you look for in external counsel?**

The first that comes to mind is fees because IKEA is very cost-conscious. When we work with suppliers—not just legal suppliers but product suppliers—we have very strict rules and guidelines which we call IWAY.

For example, IWAY is the IKEA way for responsibly procuring products, services, materials and components. It sets clear expectations for environmental, social and working conditions, as well as animal welfare, and is mandatory for all suppliers and service providers that work with IKEA.

On a general level, it's really important for us to have good relationships with them, which means we can have a quick conversation if needed.

## **How do you approach difficult conversations, eg, if something has gone awry or a particular project hasn't worked out the way you wanted?**

I don't shy away from difficult conversations. I think it's important because you don't want to just fire someone because they made a mistake. We all make mistakes. What's most important is that you're able to address it, talk through it.

I think it's the self-reflective skills on the other side that matter—their ability to say, "Indeed, we didn't go about this the right way, and we'll do better". **ip**

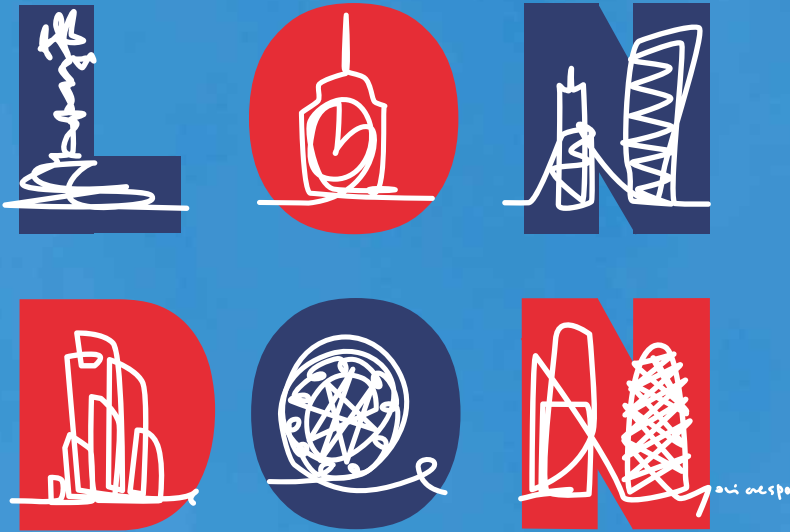
*An extended version of this interview is available to read at [www.worlddipreview.com](http://www.worlddipreview.com)*

## **TAKEAWAYS**

- IKEA counsel emphasises value of collaboration
- Company's IP team has 'fairly lean structure'
- IWAY sets guidelines for suppliers and service providers



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# EXTERNAL COUNSEL 'SHOULD UNDERSTAND OUR BUSINESS GOALS'

The VP of IP strategy at Netlist tells **Sarah Speight** why Big Tech favours 'efficient infringement', why he believes new patent acts will redress the balance, and what it's like swapping a law firm for a corporation.

**R**ichard (Rich) Kim moved to US tech firm Netlist in January 2025 after almost three decades in private practice.

Now, as VP of IP strategy, he heads up the company's legal group, managing a team of in-house and outside counsel who work on Netlist's litigation, appeal, patent prosecution and other matters.

The California-headquartered company designs and sells high-performance computer memory and storage devices, and has a current market cap of \$188.7 million and a 2024 revenue of \$147.1 million.

The company is active in prosecuting and litigating its patent portfolio, which comprises more than 210 patents globally. An aggressive litigation approach has paid off, securing, for example, favourable outcomes in its ongoing disputes with Samsung and Micron Technology.

WIPR sits down with Kim to hear more...

## What are your priorities right now for Netlist?

One of my highest priorities right now is to obtain licence/settlement agreements that will provide fair value for the use of Netlist's innovations and patented technologies. Related to this, I'm working with both in-house counsel and outside counsel to maximise our chances of success for our ongoing litigations, and ongoing appeals before the Federal Circuit.

I continue to work with our engineering team here to build our patent portfolio covering HBM [high-bandwidth memory] and other artificial intelligence-enabling technologies.

## What do you look for in external counsel?

As a baseline, they must be intelligent, hard-working, possess attention to detail and a mastery of the law in their respective practice areas.



Unfortunately, large companies such as Samsung, Micron, and Google don't like paying royalties for patents owned by startups and smaller companies.

Richard Kim,  
Netlist

## TAKEAWAYS

- Kim manages a team of in-house and outside counsel
- Licence/settlement agreements a top priority
- PTAB 'being used to challenge most important patents'

On top of this, outside counsel must have strong communication skills, be responsive to our queries, and be mindful of our budgets and expectations. Also, they should understand our business goals.

## What are the most pertinent IP challenges in your industry?

Over the past 15 years or so, there have been some significant Supreme Court decisions as well as the creation of the AIA [America Invents Act] post-grant proceedings that have, without doubt, weakened patent rights in the US and disincentivised investments in innovation.

Startups and smaller companies like Netlist develop new, disruptive technologies and drive innovation in America. For example, Netlist's IP was organically created in connection with developing and selling over \$1 billion worth of products to the world's largest computer manufacturers.

Unfortunately, large companies such as Samsung, Micron, and Google don't like paying royalties for patents owned by startups and smaller companies. Instead, they've decided that it's cheaper and more efficient to infringe patent rights rather than simply license them.

It doesn't matter whether they believe the patent rights are strong or weak; their standard playbook is to infringe, delay and drive up the cost for these patent owners. It's a strategy that has been termed 'efficient infringement'.

Supreme Court decisions such as *eBay* [*eBay v MercExchange*, 2006]—which made it very difficult for patent owners to obtain injunctions against infringers—and the AIA's creation of *inter partes* reviews (IPRs) to challenge patents post-grant, have enabled Big Tech to implement their 'efficient infringement' strategy and cause increased delay and costs to patent owners.

## What is your view of the PTAB—in particular, the recent changes to the discretionary denial process?

The PTAB was originally created to curtail and decrease 'hold-ups' by patent trolls that often file frivolous lawsuits in pursuit of 'nuisance' settlements. But the PTAB is not being used to challenge these types of frivolous lawsuits.

Instead, it is being used to challenge the most important patents that cover disruptive and widely adopted technologies.

The new bifurcated discretionary denial process is a very good one, and hopefully will curtail the abusive use of the PTAB by Big Tech against patents owned by smaller companies.

## What prompted you to move in-house, and how does it compare with private practice?

After three decades, it was time for a change. I wanted to try something new and reignite my passion for practising law, which working for Netlist definitely has done.

At Netlist, every decision I make has to be assessed, not only from a legal perspective, but with overall business objectives in mind. I often collaborate with various personnel at Netlist, such as the CEO, CFO, engineers, as well as in-house and outside attorneys to arrive at practical and business-minded decisions.

When making decisions as an in-house attorney, I always take into account multiple viewpoints and goals from a business perspective. I never really did that working as outside counsel where I was not necessarily privy to all those business issues and considerations. It really is a very different type of practice. **ip**

An extended version of this interview is available to read at [www.worldipreview.com](http://www.worldipreview.com)

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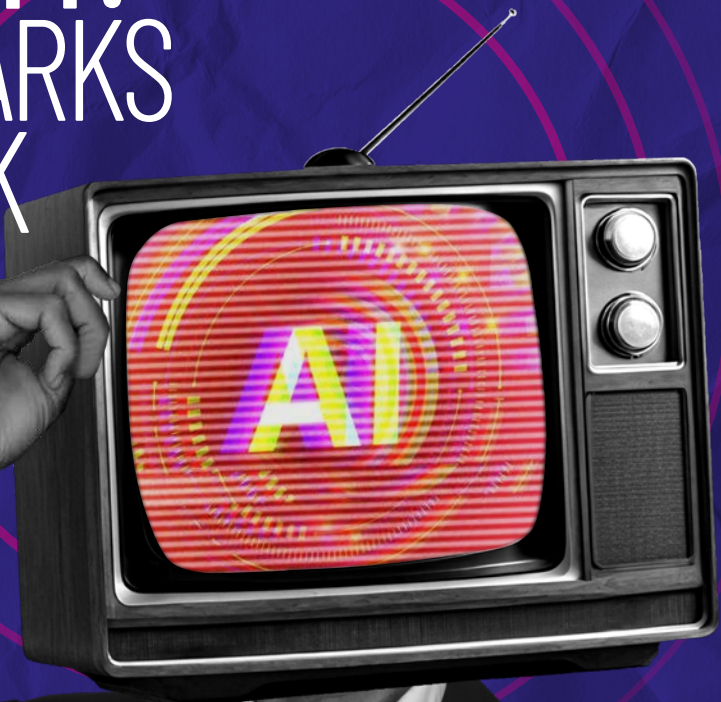
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# BEYOND GETTY: ARE TRADEMARKS A BIGGER RISK TO AI THAN COPYRIGHT?

As the *Getty* case showed, trademark law is emerging as the primary battleground between rights owners and AI, but where might this end up and what is 'sentimental similarity'? **Muireann Bolger** explores.



When it comes to legal showdowns between brand owners and artificial intelligence (AI) developers, copyright is no longer taking centre stage—at least not in the UK.

Instead, the spotlight has shifted to trademarks in this evolving area of litigation.

Take the dramatic trial hearing between Getty Images and Stability AI. In a surprise, late-in-the-day move, Getty dropped its primary copyright claims over training data and AI outputs in a UK High Court battle with the AI developer.

The withdrawn claim concerned primary copyright infringement involving Stability training models on Getty images in the UK, and the outputs of those models, which had allegedly reproduced Getty content.

According to IP experts, the training claim was probably

One small comfort to brand owners is that, as technology accelerates, AI developers are also becoming more adept at avoiding risk.

## TAKEAWAYS

- Getty dropped primary copyright claims against Stability AI
- Use of TMs in AI could 'expand concept of infringement'
- Jurisdiction an issue for rights owners

abandoned due to jurisdictional limitations—Getty struggled to show a sufficient link to the UK for copyright law to apply.

## Getty's far-sighted move

However, Getty had already led with its trademark case, a move some now view as prescient. According to Louise Popple, senior counsel—knowledge, at Taylor Wessing, this decision immediately “raised eyebrows”.

“Getty led on its trademark claim from the beginning and, in a way, it foreshadowed what was to happen with its primary copyright claim,” she says.

Joel Smith, partner at Simmons & Simmons, agrees that the *Getty* case marks a turning point. “It was interesting that it became characterised as a trademark dispute with other claims involved.”

He predicts this focus on trademarks in the AI space will

continue—not least because copyright claims are “complex and difficult”, especially from “jurisdictional angles”.

## Getty case 'not the full picture'

But will *Getty* set a good precedent for future AI-related trademark cases? Perhaps not.

Popple, for one, believes that the complicated nature of the *Getty* case is “unlikely” to provide a template for future litigation.

“*Getty* is interesting but it’s not going to give us the full picture,” she says. “It is quite specific because it concerns watermarks and that makes it difficult because the watermarks are garbled. So there’s this question: is it an identical mark?”

By far the easiest trademark infringement claim to bring in every space, including AI “is one where you’ve got an identical mark used on identical goods”, she adds.



One such example is the quarrel between Perplexity AI and Comet over trademark registrations for the latter's 'Comet' browser (in June, a US court issued a narrow, partial injunction permitting Perplexity to continue using 'Comet' only for its AI browser but blocking it from using the 'Comet' mark on any other services).

But unquestionably, *Getty* throws up more complex questions concerning outputs.

"There are so many little hurdles to get over [in *Getty*]. It's a difficult case, but that won't necessarily be the same for other trademark cases," notes Popple.

### Training vs outputs

But why haven't we seen more trademark litigation targeting AI developers? According to Popple, this comes down to several factors.

To date, AI hasn't been viewed as visibly damaging brands and their marks to the same extent as copyright owners—especially "when it comes to the training of the models".

Consequently, she suggests it's "highly unlikely" that training of AI constitutes trademark infringement. "The training of AI on material bearing a trademark is not extracting the value of that brand. It's not affecting the trademark owner's ability to differentiate its goods and services based on that particular brand."

Trademark infringement in outputs is a different matter.

However, the dearth of such material to date, along with a lack of concrete evidence, has put the brakes on any meaningful trademark litigation related to outputs.

But this is expected to change—and soon.

"As we see businesses adopting AI in their own external client-facing arenas, then clearly there is more scope for misuse and a trademark claim," says Popple.

### Slippery slope: When AI gets it wrong

Iain Connor, partner at Michelmores, agrees that rights owners will increasingly turn

towards trademarks to prevent the unauthorised use of their works.

Providing an example, he suggests that 'rogue' trademarks appearing in AI outputs could provide "both the evidential link back to the original source material and a standalone trademark infringement action".

Explains Connor: "The models are not always trained to distinguish between trademarks and common words. Is an 'Apple' a fruit or a product from the technology giant, Apple? And so the output from the model could misrepresent the origin of the work by the misuse of a trademark."

Smith believes that we will see "more clear-cut cases" compared to *Getty*.

Like Connor, he believes that errors stemming from prompts could lay the groundwork for future cases and draws parallels with keyword advertising litigation.

### Grounds for infringement cases

Popple predicts it will take "a slip-up of some kind" to trigger a brand owner to take action.

One scenario, she suggests, is an AI model putting a luxury brand on a third-party's lower-end product that "somehow allows the trademark to be imported across to the wrong product that the brand owner would not want it to be associated with, and which doesn't conform to the image or prestige of the mark".

Added to that, don't be surprised to see some rather more unconventional arguments emerging, eg, arguments based on the 'sentimental similarity' of an output to a registered mark.

For Gareth Dickson, partner at Mishcon de Reya, there are "more existential questions" arising from the use of trademarks in AI, with the potential to "expand our concept of trademark infringement".

Look at this intriguing scenario: if an AI machine is able to look at millions of trademarks for different goods and services, it can potentially identify common themes through those trademarks.

It may be able to identify



As we see businesses adopting AI in their own external client-facing arenas, then clearly there is more scope for misuse and a trademark claim.

Louise Popple,  
Taylor Wessing

that a characteristic, eg, a configuration of colours or shapes, "is correlated with particularly effective brands".

Dickson continues: "If you combine that correlation with, eg, research into how the brain perceives sensory inputs and translates them into feelings of appreciation, gratitude and loyalty, you could, in theory, conceive of a system that is able to break down trademarks that are particularly effective for that purpose—and regenerate those same functions in a different trademark."

This, he explains, falls within a potential new realm of 'sentimental similarity', which currently lies outside the traditional trademark standards of visual, aural and conceptual similarity.

### Are the courts psyched for change?

Given that brand owners and their lawyers are primed for more trademark litigation against AI developers—with the potential for far-reaching legal arguments—that leaves one big question: are the courts ready?

Smith believes the courts will approach it much as they do already—albeit with a greater emphasis on evidence.

And that gives rise to the same hurdle that confounded *Getty*'s copyright claim: jurisdiction.

"Trademark law is jurisdictionally limited, so whether it's the UK or the EU as a unit, or the US.

"So you've still got the issue about where the infringing act occurred, and at what point in the AI data chain? Is it when the user generates an output and sees it on screen? Or is it when it's being generated elsewhere, on a server in another jurisdiction? It's complicated."

One small comfort to brand owners is that, as technology accelerates, AI developers are also becoming more adept at avoiding risk.

Dickson explains: "Their systems are getting better and better, not just at generating the output, but also in avoiding infringement." **ip**

# STARJACKING AND REVERSE ENGINEERING: HOW AI IS CHANGING IP CRIME

AI is driving new forms of crime, including reverse engineering and 3D printing to create 'indistinguishable' counterfeits, warns a CITMA report.

**A**rtificial intelligence (AI) is enabling sophisticated new forms of IP crime, while also reshaping the nature of IP work, according to a new report by the Chartered Institute of Trade Mark Attorneys (CITMA).

The report, *Artificial intelligence and intellectual property*, released on July 17, outlines the transformational impact of generative AI (genAI) on the UK IP sector to date.

CITMA President and CMS partner, Kelly Saliger, said the report represented "an important moment for the IP profession".

"AI is not merely an emerging trend but a fundamental force with the power to reshape how we practise. CITMA is committed to leading our profession through this transformation—we will not simply react to technological change, we will help to shape what the future looks like," she said.

A central theme was that while genAI represents a disruptive force in the industry, it "is essential to communicate a balanced message" to practitioners, who should consider "both the threats and opportunities" ahead.

## 'Starjacking threat'

One major risk on the horizon is a new AI-driven IP crime known as 'starjacking'—using AI to artificially inflate GitHub repository credibility as well as AI-generated counterfeits that combine reverse engineering with 3D printing to produce replicas indistinguishable from originals.

With advancements in genAI, criminals can now create sophisticated, yet counterfeit, codebases that are indistinguishable from genuine projects at first glance, warns the report. From the codebases, they can then make infringing digital products or applications.



**We will not simply react to technological change, we will help to shape what the future looks like.**

Kelly Saliger,  
CITMA

The report highlights how AI-powered starjacking enables the creation of fake repositories that serve as fronts for malicious activities, such as distributing infringing content or malware.

These repositories often contain highly sophisticated, AI-generated code that mirrors legitimate apps or environments.

## Fake accounts and projects

In addition, AI can generate hundreds or even thousands of fake accounts to give 'stars' and fake endorsements to these repositories.

By inflating the popularity of a fake project, criminals can attract developers and IP holders into engaging with these repositories or cloning the code—increasing the reach of the infringement or fraud.

Major problems can arise when a project gains credibility through starjacking, because it can serve as a base for more sophisticated IP infringements, adds the report.

These repositories may hide counterfeiting tools or pirated software within the code. Alternatively, they could promote other forms of IP theft under the guise of open-source collaboration.

For example, a starjacked repository could offer AI-based trademark search tools that claim to provide automated IP services but, in reality, these tools might steal sensitive data or promote counterfeit goods.

## A 'changing profession'

In addition to spotlighting these threats, the report outlines how the advent of AI is set to revolutionise IP practice. Notable benefits include increased efficiencies in preparing submissions and summarising case law, but it cautioned that, on both counts, accuracy and consistency remain patchy.

These drawbacks, it suggests, may be due to the current use of tools that draw upon the vast amount of information available online, instead of using tailored data sets that would suit the profession's needs.

However, the report notes that, "through persistent use", AI can recognise a person's style and mimic it. Further, it points to data showing that 75% of solicitor firms in the UK are already making use of AI in this fashion, with "limited negative stories" so far.

Key transformational effects and risks in working practices identified by the report include:

### Trademark searching and watching:

AI tools can scan millions of data points almost instantaneously, enabling more comprehensive results than traditional manual methods.

**Portfolio management:** AI-driven analysis identifies competitor activities and potential opportunities, though effectiveness depends on data quality.

**Legal drafting and research:** GenAI assists in document preparation but carries risks of 'hallucinations' where AI fabricates information.

While AI is set to redefine professional roles, the report emphasises that the role of humans remains vital as AI will enhance what lawyers can do—rather than replace it. In short, AI tools can provide valuable assistance, but their output should always be subject to human judgement and feedback, the report warns.

## Transparency is key

Transparency with clients about AI usage is also becoming essential. "Clients should understand how AI contributes to their case and the benefits it brings in terms of cost and efficiency," advises the report.

Additionally, the report examines varying global approaches to AI regulation, from the EU's risk-based AI Act to the UK's developing principle-based framework, and provides guidance on building trust through transparency and ethical AI use. **ip**

## TAKEAWAYS

- CITMA report highlights AI threats and opportunities
- GitHub repository credibility being falsely inflated
- Human judgement still needed to assess output

# BAYER: 'FOCUS ON QUALITY EARLY; STAY CLOSE TO INVENTORS'



After almost 30 years as head of IP at Bayer, Jörg Thomaier is to retire and is handing the baton to Dorian Immler. Speaking to [Sarah Speight](#), the pair explain what makes a good IP strategy, why the UPC is largely 'useless' without SPCs, and more.

After 28 years with Bayer, veteran IP leader Jörg Thomaier has announced that he will retire this autumn.

Thomaier was head of IP Bayer Group for 14 years, with a legacy including major mergers, litigation, and the structural integration of Bayer's IP operations.

Among his key accomplishments are the centralisation of Bayer's previously fragmented IP teams into a single, global organisation based in Monheim, Germany, and his role in the 2006 acquisition of multinational pharma company Schering.

Thomaier also led the integration of Monsanto's IP portfolio following its 2018 acquisition, and oversaw litigation involving the blockbuster drug Xarelto.

During a transition period he will act as senior IP advisor to Dorian Immler, a role Thomaier clarifies will be "outward-facing" as he becomes "less present" until retirement.

## 'Two hats'

Immler, who has been with Bayer IP for 20 years, took over as head of IP at Bayer Group on July 1. Based in Cologne, Germany, his remit will cover global patents and trademarks, in all divisions across the board.

However, he will also retain his previous role as head of patents for Bayer's two healthcare divisions—pharmaceuticals and consumer health. Between 2012 and 2019, this role included the animal health division.

For his new double-role, wearing "two hats is obviously a challenge", Immler explains. "I will have to work out over time how to deal with that, because it's a lot of people, a lot of reports, a lot of topics."



Some players want to basically [defame] all patents that do not cover active ingredients.

Dorian Immler,  
Bayer

Bayer IP was established in 2012 in Germany, when its previously fragmented IP teams were centralised into a single, global organisation based in Monheim. The division currently employs 150–160 people, a number that has shrunk from around 200 due to various business divestments.

Immler is keen to point out, however, that all three divisions within Bayer—pharma, personal health, and agriculture—"are highly IP-dependent".

First among his priorities, he says, will be to familiarise himself with the current challenges in the crop science area.

Although he worked in crop science patents for about five years at the company between 2005 and 2010, that was prior to Bayer's acquisition of Monsanto's crop science business in 2018, which was very much focused on chemical crop protection, Immler explains.

"Now, we are roughly equally [focused] on crop protection and on the seeds and traits business, which, from an IP perspective, has very different strategies and challenges."

Those areas will include patents on genetically modified plants, "which is a highly difficult and political topic", he admits.

## The threat of generics

Immler adds that "some players want to basically [defame] all patents that do not cover active ingredients".

"They say there should be a one-product, one-patent system, which, of course, totally ignores how complex drug development is—that after initial discovery of a new active ingredient, you are merely at the start of translating this into a safe and efficacious drug."

The amount of follow-on innovation after this point "is under very strong attacks from generic companies who are basically trying to broadly deny that that is a real innovation, and that it is an innovation that deserves protection via patents".

## Lack of SPCs at the UPC

Thomaier explains that Bayer was one of the companies pushing for the Unified Patent Court (UPC), but it is not currently using it to the extent many people expected, for "a very simple reason".

"As long as there is no unitary supplementary protection certificate (SPC), it's useless for large parts of the life science industries," he says.

"In Europe, you can have the SPC for pharma products as well as for chemical crop protection products, and they are important because those extensions are where you really can get the money back on the research.

"Without that, it doesn't make sense—that's why it's maybe underused in these areas."

## High-quality drafting

From an IP perspective, Thomaier advises doing as much work in-house, where you are close to the inventors. "The core work—working with inventors on the patents, making the patents happen, and defending them—that's something which really should be there."

The really important step is very early on in the process—drafting and prosecution must be done at a "super high-quality level".

"That work is frequently underestimated," he adds, "because if it's not done well, you can have the greatest litigator, and he or she may lose, because the patent was just not well done. So focus on quality—don't save at the wrong point." **ip**

An extended version of this interview is available to read at [www.worldipreview.com](http://www.worldipreview.com)

## TAKEAWAYS

- Bayer's three divisions all 'highly IP dependent'
- Crop science area one of Immler's first priorities
- 'Super high-quality level' needed for patent drafting





# TRUMP'S TARIFFS: WILL YOUR TMs SURVIVE THE TRADE WARS?

As the US president ramps up tariffs in his second term, brand owners are rethinking where they make their products to avoid rising costs. But the IP risks of relocating are growing, finds **Muireann Bolger**.

President Donald Trump proudly dubs himself the “tariff man”—and several months into his second term, he’s certainly living up to the title.

With a spate of US tariffs reshaping global trade, many brand owners are shifting their operations to new locations—or strongly considering it.

A handful of big names have already made the leap. Apple, Samsung, and Nike have heavily shifted production from China to Vietnam; Apple and Tesla are expanding rapidly in India; and Tesla, HP, and Whirlpool are scaling operations in Mexico.

But critical questions loom: what are the IP risks to businesses when production moves to unfamiliar territories? And, given how mercurial the president can be, how wise is it to make any such shift in the first place?

## TAKEAWAYS

- Having TMs in order can ease stress of relocating
- Production shifted to Vietnam, India and Mexico
- Due diligence needed to avoid IP risks when moving

On the other hand, do brand owners risk being stranded in limbo, facing mounting costs, if they don’t take action?

Preetha Chakrabarti, partner at Crowell & Moring, describes it as “an overwhelming time” for many brand owners.

“It’s hard to make these big moves, you can’t do it overnight,” she tells *WIPR*.

“Every other day there’s a headline like ‘these tariffs are extended’ or ‘the date for execution is now getting pushed out, and there’s more negotiation’. That’s been very challenging for companies.”

## Escalating costs

To recap, the US administration’s tariff escalation began in early 2025, with China emerging as the regime’s biggest target—the country was facing a rate as high as 145% in spring 2025.

Then, a 90-day truce scaled the rate down to 30%, a deal that was renewed on August 11. However, if the respite is not further extended in November, tariffs could shoot up once again.

Additionally, the US has introduced new tariffs as high as 50% on imports from India and Brazil, and approximately 15% on goods from the EU and Japan.

Undoubtedly, tariffs are proving lucrative for the federal government, bringing in \$152 billion in revenue so far this year.

On the flip side, the measures are hiking prices on everyday consumer goods in the US such as clothing, fresh produce, and cars, meaning the average household could see an additional \$2,400 in annual expenses.

Inevitably, some brands are attempting to dodge tariffs that will undoubtedly increase the cost of

exporting to the US, by relocating manufacturing and supply chains.

But while moving a factory to another country offers clear cost advantages, it also raises the cost of producing the goods in the short-to medium-term—costs that are ultimately passed onto consumers.

### Trademark hurdles

Relocating also presents significant challenges in protecting IP and trademarks.

Eric Lamb, partner at Frost Brown Todd, explains that companies venturing to pastures new encounter more than a few obstacles.

"Companies face stress and uncertainty when making these potentially significant business decisions in terms of engaging with new suppliers, dealing with new factories, and doing all the things that are necessary just to physically move the production and getting the legal contracts in place."

With such pressures, the focus on trademarks can often fall by the wayside.

"Sometimes it may be easy to forget that trademarks are an important part of that transition," says Lamb.

"It may not appear to be the most important pressing issue, but it certainly can have significant implications.

"The last thing you want is a new run of goods ready for shipment, and then to have them detained by customs. Having your trademarks in good order can certainly help avoid or resolve those issues much more easily."

Francelina Perdomo Klukosky, counsel at Saul Ewing, agrees that while you can "save some money" by relocating, the "burdensome" nature of these transitions should never be underestimated.

Starting afresh in another region is a daunting task, she adds.

"While we don't have to reinvent the wheel, we do need to reinvent strategies to try to learn these new markets and be able to start the process anew."

### Weighing up country risk profiles

To date, Vietnam, India and Mexico have emerged as the most popular alternative location options for brands on the move—but each presents a different risk profile.

Vietnam has IP laws aligned with global standards, but enforcement is perceived as weak, particularly outside major cities, and counterfeiting remains a persistent issue.

India has a strong legal IP framework on paper, but enforcement is often slow and inconsistent, with piracy and counterfeiting still posing problems.

Mexico offers relatively strong enforcement, especially for US-linked brands, and has been improving steadily under USMCA/T-MEC. However, trademark squatting and the need for local vigilance remain concerns.

Some brand owners may choose to explore other jurisdictions, particularly countries with designated "free zones" that offer tariff relief. However, the exact scope, duration, and conditions vary by country and zone.

### Register, register!

On the face of it, brand owners seem to have numerous options when expanding into new territories—especially if they're familiar with local trademark laws. However, many still fall into common traps.

The most frequent oversight? Assuming that because their brand is well-recognised and they have trademark rights in other jurisdictions, they automatically have rights in a new one.

"It sounds crazy," sighs Klukosky, "But it's the mistake I keep seeing. Most brands, in general, don't recognise the importance of the territorial effects on trademarks. They don't really think about that proactively ... and that's when they get into trouble."

In short, some jurisdictions have a first-to-file rule, not a first-to-use rule.

"So if someone wins the race to register, then you have an issue,



Do due diligence way in advance, and get preliminary legal opinions and overviews before you decide to dig deeper into these jurisdictions.

Francelina Perdomo Klukosky, Saul Ewing



Some companies have been working with the same factories for decades, and if they're making a move, it's a steep learning curve.

Preetha Chakrabarti, Crowell & Moring

because you have to pay them off in order for you to be able to register your mark," she explains.

Chakrabarti echoes these concerns, arguing that the time is ripe for legal departments to conduct an audit and ask: "What is the scope of my global portfolio? Where do I have rights?"

"Doing that kind of analysis right now is really important, and making sure that you have your enforcement protocols really robust and in place."

### Monitor quality control

Then there are IP risks that emerge after the shift and (hopefully) trademark clearance are completed. Key challenges include maintaining trademark integrity, ensuring quality control, and understanding supply chain partners.

Chakrabarti warns of the need for continuous monitoring and adaptation to avoid reputational risks and legal issues.

"Some companies have been working with the same factories for decades, and if they're making a move, it's a steep learning curve.

"If they don't have experience with factories or manufacturers or suppliers, understanding what kind of quality control protocols are in place is crucial."

Today's savvy consumer, she warns, "can tell right away if it's a sub-par product, or even just a different one from what they are used to".

### Use local counsel as 'foot soldiers'

To avoid such risks, knowledge is power. And this means cultivating good relationships with local counsel, who "can be on-the-ground foot soldiers, especially in hard-to-get-to places", urges Chakrabarti.

Ultimately, Klukosky advises brands to take their time—ideally a year, but at least six months—to learn and weigh up options.

"Do due diligence way in advance, and get preliminary legal opinions and overviews before you decide to dig deeper into these jurisdictions," she warns. **ip**

# BLANK CHEQUE FOR BIG TECH

By ducking the copyright licensing debate, Trump's AI plan leaves creators in the cold, finds **Marisa Woutersen**.



**T**he Trump administration's AI Action Plan is drawing sharp attention from the IP community—not for what it includes, but for what it noticeably leaves out.

While the plan, published in July, lays out an aggressive national push to win the global race in artificial intelligence (AI), it makes little to no mention of IP rights, copyright protections, licensing structures, or creator compensation.

The strategy, titled *Winning the Race: America's AI Action Plan*, places "AI dominance" as essential to US national security, economic leadership, and what the White House calls a "new era of human flourishing".

Drawing comparisons to the Cold War space race, the plan urges federal agencies to dismantle any rules or agreements that "unnecessarily hinder AI development or deployment".

Backed strongly by Big Tech interests, the 28-page policy calls for reduced regulation, rapid AI integration across government,

**If you're going to be beating China ... then you have to be able to play by the same set of rules.**

Donald Trump

## TAKEAWAYS

- IP barely addressed in AI Action Plan
- Strategy prioritises 'winning the race'
- Some view plan as handout to Big Tech

and the expansion of data centres, energy infrastructure, and software businesses.

But its lack of protections for creators and copyright owners is raising alarm across legal and creative industries.

## Silence on copyright

The Trump administration's strategy, built around three main pillars—innovation, AI infrastructure, and strengthening international leadership—barely addresses IP, despite concerns over how AI companies use copyrighted material in training models. The 28-page plan mentions IP just once, even as lawsuits against major AI firms continue to mount.

The strategy does highlight the need for the federal government to work with private industry to balance AI growth with national security.

"It is also essential for the US government to effectively address security risks to American AI companies, talent, intellectual property, and systems," the report said, recommending that the

government and AI developers collaborate to protect innovations from cyber threats, insider risks, and other security challenges.

The report also mentions tackling deepfakes with the growing concern of fake audio, video, or images created by AI but avoids directly addressing copyright concerns.

Many took to LinkedIn to share their thoughts on the plan. "Now that AI is within the sphere of 'national interest,' a grand scheme to compensate copyright owners **MUST** be made," argued AI strategist E.C. De Spain, CEO and chief scientist at BrainThrob Laboratories in a typical post. "Otherwise, there is no incentive for copyright owners to create anything further."

## Trump's 'common sense' approach

President Donald Trump did address the issue more directly during his announcement speech on July 23.

He argued for what he called a "common sense application" of AI and IP rules, warning that strict





IMAGE: SHUTTERSTOCK.COM / SHUTTERSTOCK AI

licensing requirements would “cripple progress in the race”.

“You can’t be expected to have a successful AI programme when every single article, book, or anything else that you’ve read or studied, you’re supposed to pay for.

“We appreciate that, but you just can’t do it ... If you’re going to try and do that, you’re not going to have a successful programme,” Trump said.

He argued that learning from existing content is not the same as copying it, and compared AI training to human reading.

“When a person reads a book or an article, you’ve gained great knowledge. That does not mean that you’re violating copyright laws or have to make deals with every content provider.”

Trump stressed the need for the US to compete with China, which he claimed is not burdened by the same copyright constraints.

“If you’re going to be beating China ... then you have to be able to play by the same set of rules,” he said.

He also issued a stark warning

that the US must keep a close eye on other countries so they don’t make rules and regulations that make it impossible to do business as US businesses would have to “cater to the toughest country”.

Trump called for a single federal regulatory framework for AI, warning against the risks of state-by-state policies to avoid ending up in “litigation with 43 states at one time”.

He acknowledged that his position on copyright and federal authority might be “unpopular”, but said he was prioritising the success of the US AI industry.

### Largest ecosystem sets the standards

The plan supports open-source AI initiatives and the creation of “world-class scientific datasets,” but offers no direction on how these efforts should align with existing copyright laws or fair use limitations.

This omission stands out in light of the growing number of lawsuits facing major AI developers over the unauthorised use of copyrighted material in training datasets.

OpenAI, Meta, Anthropic, and Stability AI are all embroiled in disputes with authors, artists, publishers, and record labels.

Prominent cases include *The New York Times* suing OpenAI and Microsoft, a class action brought by the Authors Guild, and action from music labels targeting AI-generated music platforms like Suno and Udio.

These lawsuits allege that generative AI models have been trained on copyrighted works without permission.

While the courts have delivered mixed outcomes, a pair of federal rulings in June favoured AI companies, with judges dismissing copyright claims brought by artists against Meta and Anthropic.

Despite this backdrop, the administration’s plan is silent on copyright not only in its innovation agenda, but also across its other two pillars: infrastructure and international diplomacy.

The contrast with international

If there was any doubt before, it is now clear that Big Tech’s lobbyists have achieved what they set out to.

Ben Maling, EIP

approaches is stark. While the EU’s AI Act prioritises transparency, safety, and ethical compliance, the US strategy prioritises competitive position and “winning the race” over IP frameworks.

“Whoever has the largest AI ecosystem will set global AI standards,” the plan said.

Katja Muñoz, a research fellow at the German Council on Foreign Relations, posted: “While Trump didn’t call out the EU directly, the implications are pretty clear. The US is treating AI like the new space race. It’s a zero-sum game mentality.”

### ‘No copyright, no accountability’

Some viewed the plan as a broad handout to Big Tech. Ben Maling, partner and AI expert at EIP, called the strategy “characteristically aggressive in its call for dominance and deregulation”.

“If there was any doubt before, it is now clear that Big Tech’s lobbyists have achieved what they set out to do,” he wrote in a post.

Maling urged the UK and other governments to learn from this approach rather than follow it blindly: “It’s time to lean into the principles of democracy and decency, and an objective analysis of the impact of the technology.”

Michael Pfundheller, founder and CEO of music licensing company 1000TRAX, warned that copyright could be just the beginning: “The next thing to fall will probably be patents ... Why not just take people’s inventions and exploit them for free?”

He likened the strategy to a return to a “Wild West” era where “the one with the biggest gun wins.” Virginia Berger, strategic adviser, music, AI, IP, innovation and writer at Music X, criticised the music industry’s inconsistent stance on AI, pointing out that its mixed messaging has only added to the confusion.

“We can’t pretend we didn’t see it coming,” she said. “The music industry’s been playing the ambiguity card for years ... saying ‘AI is great for creativity’ while suing AI companies and trying to get licensing deals behind the scenes.” **ip**

# A BRIGHT FUTURE FOR BRAZIL

Securing IP rights in the world's 10th largest economy—with its high-growth industries, modernising patent office and vast consumer base—is a strategic imperative, say **Cátia Gentil**, **Gislaine Zulli**, and **Otto Licks** of Licks Attorneys.

**B**razil, currently ranked as the world's 10th largest economy with an estimated nominal GDP of US\$2.2 trillion in 2024, represents approximately 2% of global GDP. Beyond these figures, Brazil stands out as one of the world's most attractive and dynamic markets across several key economic sectors, making it an increasingly vital jurisdiction for IP protection. For international innovators and businesses, understanding and leveraging the Brazilian patent system is no longer optional but a strategic imperative.

The nation's vast consumer base, growing middle class, and robust industrial landscape create fertile ground for technological advancement and market expansion. Protecting inventions in Brazil is not merely about securing rights in a large economy; it is about establishing a foothold in a burgeoning innovation ecosystem that serves as a gateway to the broader Latin American market.

## A deep dive into Brazil's thriving sectors

Brazil's economic dynamism is particularly evident in several high-growth sectors, where innovation is paramount and IP rights are crucial for competitive advantage.

**Information and communication technology (ICT):** The Brazilian ICT market is a powerhouse. According



Cátia Gentil



Gislaine Zulli



Otto Licks

## TAKEAWAYS

- Brazil's ICT market valued at \$96bn in 2023
- BRPTO working to reduce patent examination time
- Fast-track initiatives available for strategic inventions

to Global Data consultancy, it was valued at \$96 billion in 2023 and is projected to grow at a compounded annual growth rate (CAGR) of 17.11%, reaching \$213 billion by 2028. Data from the ICT macrosector, encompassing in-house IT and telecommunications, shows an impact of approximately \$142 billion in 2023, equivalent to 6.5% of Brazil's GDP, as reported by the Brazilian Association of Information and Communication Technology and Digital Technology Companies (BRASSCOM).

This growth is fuelled by a digitally-savvy population and rapid technological adoption. Focusing specifically on smartphones, telecoms consultancy Teleco indicates that Brazil had 263.4 million mobile phone subscriptions in 2024, a figure that significantly outstrips its population of approximately 221 million people. The deployment of the 5G network continues to expand rapidly, with this technology now used by approximately 20% of cell phones in Brazil. Expectations for the coming years point to increased adoption of smartphone connections, a growing ecosystem of connected devices, and significant advancements in areas such as fintech, agritech, e-commerce, and artificial intelligence (AI), all of which are ripe for patentable innovation.

**Pharmaceutical sector:** Brazil is also a significant player in the

global pharmaceutical market. Data from life sciences analytics company IQVIA reveals that Brazil is the world's ninth largest pharmaceutical market, ranking even ahead of Canada. The sector alone generated \$31.7 billion in 2023, representing a 9.2% increase over the previous year. The consultancy estimates a CAGR for the Brazilian pharmaceutical market of between 9% and 10% through 2027.

According to consultancy firm Redirection, nearly 7% of Brazilian household consumption is spent on pharmaceutical products. This positive outlook is driven by the country's favourable macroeconomic conditions, an ageing population, the expansion of e-commerce, and increasing access to digital healthcare solutions. The demand for innovative drugs, medical devices, and biotechnological solutions continues to surge, making patent protection in this sector particularly valuable.

**Agribusiness:** As a global agricultural superpower, Brazil's agribusiness sector is a major driver of its economy and a hotbed of innovation. Brazil is the world's largest producer and exporter of several key commodities, including soybeans, coffee, and sugar. This sector is highly dependent on technological advancements in areas such as biotechnology,

precision agriculture, sustainable farming practices, and new crop varieties. Research and development in these fields are robust, often involving collaborations between universities, research institutions, and private companies. Protecting patents related to agricultural machinery, crop science, animal health, and food processing technologies is crucial for companies seeking to capitalise on Brazil's leadership in this vital industry.

#### **Renewable energy and biofuels:**

Brazil boasts one of the cleanest energy matrices in the world, largely due to its extensive hydropower resources and its pioneering role in biofuels, particularly ethanol. The country is also rapidly expanding its investments in solar and wind energy. This commitment to sustainable energy solutions fosters significant innovation in renewable energy technologies, energy storage, and advanced biofuels.

#### **A landscape of growing certainty**

Given such an attractive and diverse market, protecting inventions in Brazil becomes extremely important. Fortunately, the Brazilian Patent and Trademark Office (BRPTO) has made significant strides in recent years, offering increasingly favourable conditions to both applicants and patent owners, whether national or foreign.

The BRPTO has maintained an overall PCT allowance rate of 82% over the past 24 months. This rate is even higher for inventions in specific high-tech sectors, reaching 93% for telecommunications and 95% for mechanics. Furthermore, the patent invalidation rate after post-grant oppositions is remarkably low, at 22% in the last 24 months. These positive figures provide greater legal certainty and predictability for patent owners exercising their rights in Brazil, signalling a robust and reliable system for securing valid patents.

#### **Streamlined examination and political commitment**

The era of significantly delayed

decisions on patent applications in Brazil has largely become a thing of the past. Since 2019, the BRPTO has made substantial and progressive strides to optimise examination timelines. The average examination time currently stands at three years and two months from the request for substantive examination, with ongoing efforts to further reduce this time.

Even more ambitiously, the BRPTO is committed to working with the Brazilian government to issue decisions on patent applications within just two years from the application's entry date in Brazil by 2026. Achieving this target will place the Brazilian PTO on par with the world's leading patent authorities, significantly enhancing Brazil's attractiveness as a patent filing destination.

This ambitious goal is supported by tangible actions: new examiners were hired in 2024 to bolster examination capacity. The BRPTO is also developing innovative projects to help reduce examination time, such as outsourcing prior art searches and developing AI tools to assist in the substantive examination of patent applications, among other initiatives in its current Action Plan. These actions aim to optimise the process, increase efficiency, and ensure the quality of the service provided to users.

Crucially, there is strong political support to achieve these goals. Geraldo Alckmin, the Minister of Development, Industry, Commerce, and Services—overseeing the BRPTO—is also the vice president of the Republic. This high-level endorsement underscores the national strategic importance placed on a modern, efficient, and reliable IP system.

#### **Accelerated prosecution pathways**

For applicants seeking even quicker decisions on their patent applications, the BRPTO offers a range of fast-track programmes designed to accelerate the examination process. The office joined the Global Patent Prosecution Highway (PPH)

**The era of significantly delayed decisions on patent applications in Brazil has largely become a thing of the past.**

**Brazil is the world's ninth largest pharmaceutical market, ranking even ahead of Canada.**

in June 2024, a programme encompassing 27 other member countries. It also maintains bilateral PPH agreements with eight other foreign patent authorities. This extensive network of 35 partners allows applicants to leverage positive examination results from participating offices, significantly reducing the average time from PPH requirement to patent application decision by six months. This mechanism not only speeds up the process but also reduces prosecution costs and provides greater certainty.

Several administrative fast-track programmes are also available, catering to specific needs and priorities, such as Green Patents (for environmentally beneficial technologies), Start-up Entities (to support emerging businesses), and Alleged Infringement (for cases where a patent is already being infringed), among others. The average time to issue decisions for patent applications through these programmes is 10 months, offering a rapid path to patent grant for strategic inventions.

As Brazil continues its trajectory as a global economic and innovation leader, securing robust patent protection is paramount. With a modernising patent office, clear political commitment, and experienced legal partners like Licks Attorneys, Brazil offers a compelling and increasingly efficient venue for protecting your most valuable inventions. **ip**

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# CHINA: COURTS AND AI FACE OFF

Courts in China are increasingly rejecting 'algorithmic neutrality' as a defence in AI cases—and businesses need to adapt, say **Xiaojun Guo** and **Hongxia Wu** of CCPIT Patent and Trademark Law Office.

**T**he rise of artificial intelligence (AI)-driven technologies, such as deep synthesis algorithms, has revolutionised content creation, enabling applications like one-click "face-swapping" and "makeup-swapping".

While these innovations enrich digital experiences, they also raise significant legal concerns, particularly in copyright and personal information protection.

Recent cases in China highlight how courts are addressing these challenges, offering critical guidance for balancing technological innovation with legal accountability.

## Case 1: Copyright infringement in AI face-swapped videos

In April, the Supreme People's Court released a landmark copyright case made by the Shanghai Jiading District People's Court (Case No. [2024] Hu 0114 Min Chu 1326).

The plaintiff, Chen, had posted 13 original short videos on Douyin (TikTok), featuring women in traditional costumes. A tech company developed a mini-program that allowed users to replace the faces in Chen's videos with their own via AI synthesis.

The modified videos retained the original scenes, camera

Two models discovered their likenesses had been used in an AI face-swapping app's video templates.

### TAKEAWAYS

- Rulings establish critical precedents
- Liability and fair use limits addressed
- Safeguards in AI development are vital

angles, character modelling, and movements, differing only in facial features. Users could access the service by watching ads or purchasing memberships, generating revenue for the company.

### Court's analysis

1. Originality of Chen's work: The court affirmed that Chen's videos constituted audiovisual works under copyright law. Their creative selection and arrangement of the content arrangement, scene selection, shooting angle, etc, reflected sufficient originality.
2. Substantial similarity: The AI-modified videos replicated the core creative elements of Chen's work, differing only in facial details. This constituted unauthorised reproduction.
3. Rejection of "technical neutrality" defence: The court rejected the defendant's claim of passive algorithmic processing, noting that the company actively promoted "AI face-swapping" as a commercial feature and profited from it.
4. Fair use inapplicable: The modifications were neither transformative adaptations nor covered under permissible uses like parody or education.

**Outcome:** The defendant removed the infringing content, registered its algorithms, and accepted judicial guidance on ethical AI deployment. Chen withdrew claims for an apology, and the court ordered only monetary compensation. This case clarifies that AI-assisted modifications do not circumvent copyright obligations, even if partially altered.

## Case 2: Personal information rights in AI-generated templates

In June 2024, the Beijing Internet Court addressed a dual claim involving portrait rights and personal information infringement. Two models discovered their likenesses had been used in an AI face-swapping app's video templates. While their faces were replaced via deep synthesis, their dress-ups, hairstyles, clothing, movements, lights, and camera switching remained intact. The plaintiffs argued that their portrait rights and personal information rights were violated.

### Court's analysis

1. No portrait right infringement: The replaced facial features made the plaintiffs unrecognisable, negating claims under China's portrait rights laws.



2. Personal information violation: The app had obtained the plaintiffs' biometric data such as facial features, and processed the facial features, without consent. Even anonymised, such data qualifies as personal information under China's Personal Information Protection Law.

**Outcome:** The defendant committed illegal processing of the plaintiff's personal information, using their personal data in commerce, even if anonymised, shall be liable for its conduct.

### Legal implications for AI innovation

These court rulings establish critical precedents for AI governance:

#### 1. Copyright protection in the AI era

**Originality threshold:** Courts recognise AI-modified content as infringing if it retains the original work's creative essence (eg, scene arrangement, camera angles).

**Service provider liability:** Companies leveraging AI tools bear responsibility for ensuring content legality. "Technical neutrality" defences fail if the technology is marketed for infringing uses.

**Fair use limits:** Minor modifications (eg, face-swapping) lack transformative value and do not qualify as fair use.

#### 2. Privacy and data compliance

Even anonymised data used for commercial purposes mandates user authorisation, aligning with global trends like the EU's GDPR.

#### 3. Proactive compliance strategies

To mitigate risks, businesses should: **Audit training data:** Ensure copyrighted materials are licensed or in the public domain.

**Implement consent frameworks:** Obtain explicit user permissions for data collection and processing in advance.

**Register algorithms:** Comply with regulations like China's Deep Synthesis Management Provisions, which mandate transparency for AI tools.

### Conclusion: Striking the balance

These cases mark a pivotal step in defining legal accountability for AI-driven content. As courts increasingly reject an "algorithmic neutrality" defence, businesses must integrate rights clearance and privacy safeguards into AI development.

The rulings strike a delicate balance—fostering innovation while ensuring creators and individuals retain control over their works and identities in the digital realm.

China has been actively exploring

These cases mark a pivotal step in defining legal accountability for AI-driven content.

the establishment of a dedicated legislative system for AI. This includes advancing the formulation and implementation of regulatory documents like the Interim Measures for the Management of Generative AI Services.

The legislative initiative not only aims to provide institutional safeguards for AI technological innovation, but also prioritises the construction of risk prevention mechanisms across multiple dimensions, including algorithm governance, data compliance, and ethical review.

By striving to achieve a dynamic equilibrium between technological advancement and rights protection, this approach seeks to contribute Chinese solutions to the development of global AI governance paradigms. **ip**

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# FIVE KEY 2025 TRADEMARK JUDGMENTS FROM THE EU GENERAL COURT

In most cases, the General Court is the final level of appeal for EU trademark disputes. **Olivier Lombardo** of Denemeyer & Associates analyses five of the most compelling decisions from this year so far.

Since Article 58a of the Statute of the Court of Justice of the European Union (CJEU) came into force on May 1, 2019, to relieve judicial duplication, the General Court of the European Union has solidified its role as the final decision-maker in almost all trademark appeals for which it is competent. The General Court publishes approximately 300 judgments in European Union trademark (EUTM) cases each year, arising from opposition and cancellation actions at the European Union Intellectual Property Office (EUIPO).

These judgments cover topics such as distinctiveness, likelihood of confusion, bad faith and genuine use. Here, we examine five thought-provoking rulings on absolute grounds of refusals from the first seven months of 2025, which are likely to be of general interest to trademark practitioners in Europe.

## Descriptive characters of geographical terms

**Cases T-105/23 and T-106/23: Iceland Foods**



The General Court upheld the decision of the EUIPO Grand Board of Appeal in two cases concerning word and figurative EUTMs incorporating the word “Iceland”. The marks were registered for a range of goods and services by Iceland Foods, a British supermarket chain. In 2016, Promote Iceland, a marketing



The court also found that the concept of ‘shape’ in Article 7(1)(e)(ii) should not be interpreted ‘in an excessively narrow manner’.

Olivier Lombardo

## TAKEAWAYS

- Rubik’s Cube shape EUTMs deemed invalid
- EUIPO’s approach to figurative marks affirmed
- Position marks represent just 0.02% of applications

agency under the Icelandic Ministry for Foreign Affairs, filed an application to invalidate the marks, which was upheld by the EUIPO Cancellation Division and by the Grand Board of Appeal.

In its T-105/23 judgment, published on July 16, 2025, the General Court stated that a sign may be refused registration on the basis that it is descriptive under Article 7(1)(c) of Regulation No. 40/94 (now Article 7(1)(c) of Regulation (EU) 2017/1001) if the geographical name applied for is associated in the mind of the relevant public with the germane category of goods and services, or it is reasonable to assume that such an association may come to be.

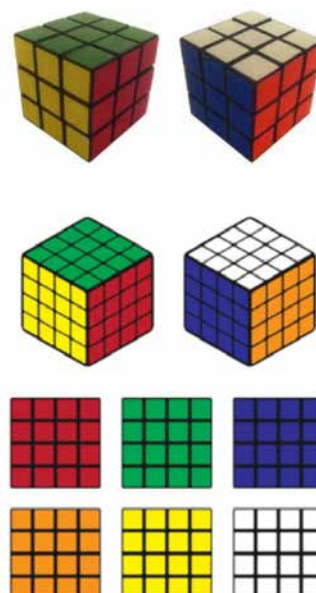
To establish whether or not this applies, account must be taken of all the pertinent circumstances “such as the nature of the goods or services designated, the greater or lesser reputation, especially within the economic sector involved, of the geographical location in question and the relevant public’s greater or lesser familiarity with it, the customs obtaining in the area of activity concerned and the question to what extent the geographical origin of the goods or services at issue may be relevant, in the view of the persons concerned, to the assessment of the quality or other characteristics of the goods or services concerned”.

The court concluded that, for each of the goods and services covered, the marks had a descriptive character. Together with that of T-106/23, the judgment affirmed the decisiveness of

assessing in detail how the class of persons in point would perceive trademarks that include or comprise geographical terms.

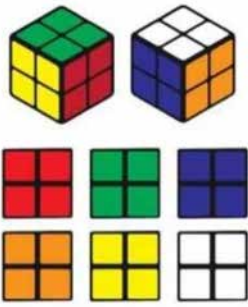
## Essential characteristics of a shape mark

**Cases T-1170/23, T-1171/23, T-1172/23 and T-1173/23: Spin Master Toys UK**



In four cases, the General Court upheld decisions that EUTMs for the shape of the Rubik’s Cube were invalid for “toys, games, playthings and jigsaw puzzles, three dimensional puzzles; electronic games; hand-held electronic games” in class 28 and for certain services in classes 35 and 41 on the ground that they had been registered contrary to Article 7(1)(e)(ii) of Regulation (EU) 2017/1001. This precludes the registration of signs that consist exclusively of the shape of goods necessary to obtain a technical result. This exclusion applies if all the “essential characteristics” of the shape are functional after this fashion.





The court held that the six colours on the faces of the cube and their “specific arrangement” did not constitute an essential characteristic of the mark as they were “of minor and secondary importance in relation to the cube shape, the grid structure and the differentiation of the faces of the cube, namely the fact that those faces are distinguishable”.

The court also found that the concept of “shape” in Article 7(1)(e) (ii) should not be interpreted “in an excessively narrow manner”. Given that the mark was registered as a shape mark, the court concluded: “the third essential characteristic of that mark, namely the differentiation of the small squares on each face of the cube by means of six basic colours [...] is inherent in and inseparable from the shape represented and [...] forms an integral part of that shape.”

“The opinion across the four cases follows a 2016 CJEU judgment (Case C-30/15) finding that a trademark for the shape of the Rubik’s Cube (without colours) was invalid.

### Distinctiveness of colour combinations

#### Case T-38/24: OMV



In a judgment on June 11, 2025, the General Court upheld a finding that an international trademark registration for a blue-green colour combination designating the EU was devoid of distinctive character under Article 7(1)(b). OMV had applied to register the mark for various goods and services in classes 1, 4, 35 and 37.

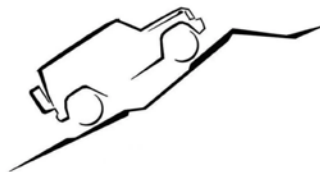
When assessing the distinctiveness of a colour-combination trademark, it is essential to consider all applicable factors, particularly the arrangement

of the colours within the mark and the prevailing market practices in the relevant industry. Hence, the General Court noted that to be registrable, a colour combination “must contain elements capable of distinguishing it from other colour combinations and of attracting the consumer’s attention”.

The Board of Appeal had previously found that green and blue were both commonly used to represent the environment. Bearing out that determination, the court ruled that “even though the colours blue and green may convey meanings not related to ecology or the environment, that does not alter the fact that the mark applied for is incapable of conveying specific information concerning the origin of the goods and services at issue”.

### Distinctiveness of figurative marks

#### Case T-400/24: Mercedes-Benz Group



On March 19, 2025, the General Court upheld a finding that a figurative EUTM application filed by Mercedes-Benz lacked distinctive character under Article 7(1)(b) for “motor vehicles and parts thereof; pneumatic tyres and wheels” in class 12.

The court delivered that the EUIPO Board of Appeal had rightly ascertained that the mark applied for corresponded to a “usual representation of an all-terrain vehicle climbing a hill”, and did not contain any message or element likely to be remembered by the consumer as a reference to the commercial origin of the goods concerned.

The judgment affirms the EUIPO’s strict approach to differentiability for figurative marks and reiterates that for marks comprising the image or outline of a product, distinctiveness arises only when the mark departs significantly from industry norms or expectations.

For marks comprising the image or outline of a product, distinctiveness arises only when the mark departs significantly from industry norms or expectations.

### Distinctiveness of position marks

#### Case T-195/24: VistaJet



In the VistaJet ruling of February 5, 2025, the General Court maintained that an EUTM application for a position mark running nose to tail along the centre of an airplane’s fuselage was devoid of any distinctive character within the meaning of Article 7(1)(b).

The description of the applied-for mark detailed a horizontal red stripe on a silver fuselage, passing above the wings. The application covered services such as air transport by means of private aircraft and transport of passengers and/or goods by air by means of private aircraft in class 39.

Confirming the Board of Appeal’s decision, the court resolved that “in the absence of elements capable of distinguishing it in such a way that it does not appear as a simple geometrical figure, the red line cannot fulfil an identifying function with respect to the services in question.”

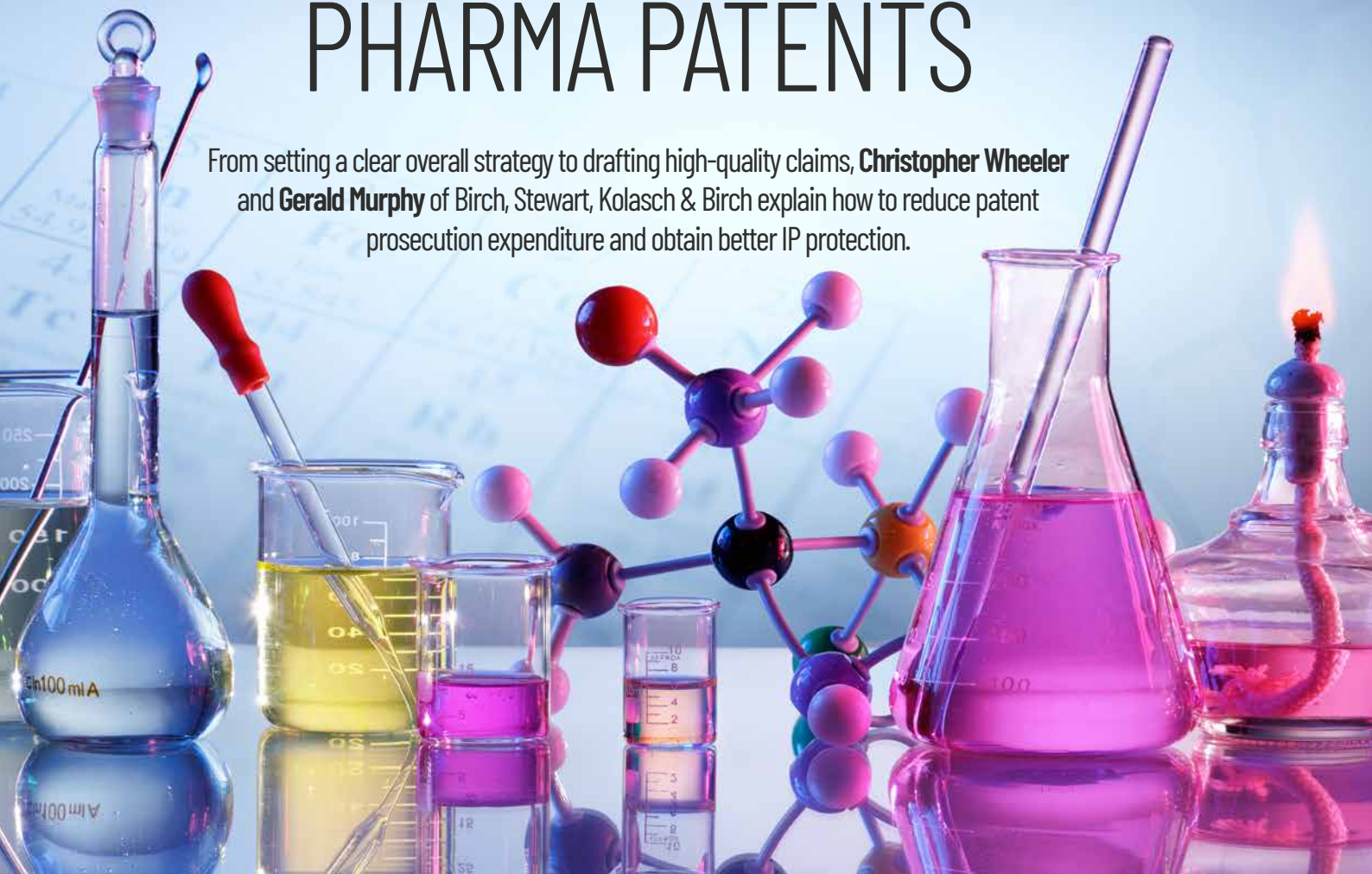
The court remarked that though the colour red is highly noticeable, striking and commonly used for decorative or attention-grabbing purposes, this inherent quality worked against its distinctive character. Similarly, the silver fuselage did not stand out sufficiently from the colour white, which is conventionally used in aviation. Consequently, the mark did not depart significantly from the norms or customs of the sector to reach the required level of distinctive character.

Position marks are characterised by the specific way in which the mark is placed or affixed on the goods and must be represented by a reproduction showing its situation and size or proportion in relation to the product. However, they remain rare in Europe: as of July 2025, just 634 had been filed, representing 0.02% of all EUTM applications.

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# THE RIGHT FORMULA: MINIMISING THE COST OF CHEMICAL AND PHARMA PATENTS

From setting a clear overall strategy to drafting high-quality claims, **Christopher Wheeler** and **Gerald Murphy** of Birch, Stewart, Kolasch & Birch explain how to reduce patent prosecution expenditure and obtain better IP protection.



**P**atent prosecution is a significant driver of IP costs in the US and abroad. With rising fees and other industry cost pressures, it is important to streamline your prosecution processes. This article focuses on key strategies in the chemical and pharmaceutical arts that reduce prosecution costs and result in better patents.

## 1. Develop an overall patent and prosecution strategy

It is important to develop an overall strategy that will inform your decision making throughout the prosecution process.

### TAKEAWAYS

- High potential for drawn-out prosecution in chemical/pharma
- Invest in quality patent applications to save costs later
- Carefully consider response to first office action

You should have a clear understanding of where the application fits in your overall portfolio, valuation, cost sensitivities, and the risk-reward profile. You should also consider the goal of securing the patent, which may include commercialising a new product/process, simply getting a patent, getting a provisional filed for funding pitches, or adding to an existing portfolio to block competitors.

Clearly articulating an overall strategy is particularly important in the chemical and pharmaceutical arts given the complexity of the

issues, crowded technical space, and high potential for drawn-out prosecution.

It is also important to recognise that prosecution strategy may change during the pendency of the application due to shifting business priorities or other factors. Recognising this potential and being able to adapt in response to changing priorities is also key to reducing overall prosecution costs.

## 2. Draft a broad and high-quality patent application

You should spend the extra time and effort up front to ensure that you have a broad and high-quality patent application. This will save



Christopher Wheeler



Gerald Murphy

- **Draft high-quality claims**

The claims define the scope of the patent rights. It is important to ensure that the claims cover the scope of the invention and that the claims are drafted in line with the overall prosecution strategy. To reduce claim fees, a more complete disclosure of various aspects of the invention in “claim form” could be provided in the specification. These “aspects” can be quickly converted to claims during prosecution.

Alternatively, a more robust claim set could be submitted up front. This may result in excess claim fees, but it could also result in quicker identification of allowable subject matter, and therefore allowance.

Good claims also avoid potential §112 issues. For applications that were first filed in a foreign country, consider filing a preliminary amendment to conform the claims to US practice and avoid such issues.

- **Describe important details of invention features in specification**

For composition claims, you should define ingredients functionally; provide generic and sub-generic terms (eg “solvent”, “polar solvent”, and “polar organic solvent”); disclose effective amounts and amount bases; describe relevant physical properties, and list specific preferred ingredients. Ranges with many endpoints for disclosed conditions, components, parameters, etc, should also be included.

For process of preparation claims, you should provide functional and numerical descriptions of various important features such as actions, time, temperature, pressure, etc.

For method of use claims, you should describe the “target” of the method and features of the intended use(s). For industrial products or chemicals, you

should describe how they are employed. For pharmaceutical uses, you should define target patient attributes. For herbicide/plant growth claims, you should define the target plants or weeds and relevant effective dosages.

These details will provide options for potential claim amendments during prosecution and could help rebut examiner rejections. They can also help distinguish from prior art and overcome “scope rejections” for lack of written description support and/or enablement.

- **Provide comparative data in the specification**

You should provide comparative data in the specification. The data should compare with the closest prior art (if available) and show criticality of features and parameters of the invention, eg, amounts, properties, etc. The data should show the presence of important features (eg ingredients) versus the absence of the same features.

Such data will be treated as evidence and allow you to establish unexpected results, which can be useful in rebutting an obviousness (or inventive step) rejection. Examiners review the data in the specification before issuing a first office action and should make an initial determination of the sufficiency of such evidence. Such evidence can also be submitted later in prosecution after filing but often at higher cost and complexity.

### 3. Have an IDS policy that is not overly burdensome

It is essential to timely file information disclosure statements (IDSs) to avoid US Patent and Trademark Office (USPTO) fees and to avoid costs associated with filing requests for continued examinations (RCEs). Prior art cited in the background should normally be filed. Category X references

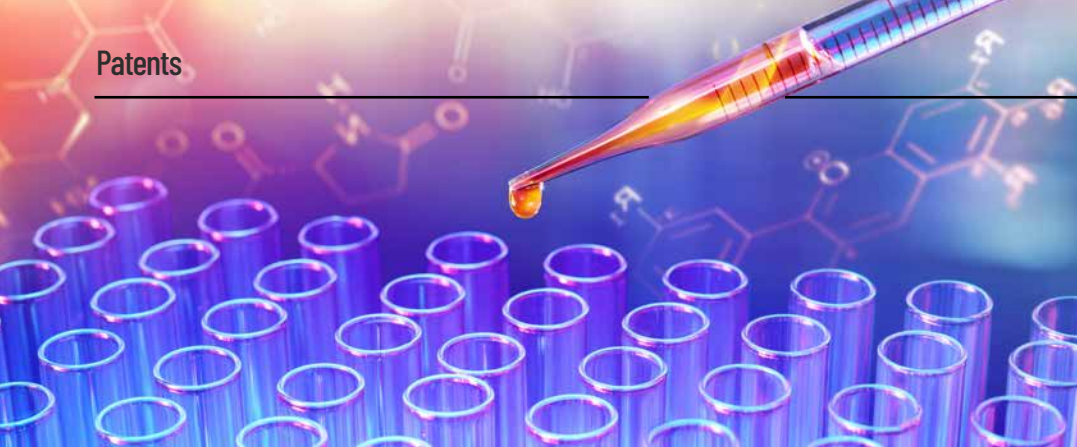
If the goal is to secure broad claim scope, strategic arguments and/or supplemental evidence should be considered in responding to the first office action.

on downstream costs and ensure a strong and enforceable patent.

- **Draft claims for all categories of the invention**

Drafting claims for all categories of the invention increases the likelihood of receiving a robust initial prior art search. If additional searching during prosecution is required, it can lead to piecemeal prosecution and increased costs. Including all claim categories is also important in making your application portable to foreign countries where categories may be treated differently.





from foreign search reports and prior art submitted by third parties should be filed.

Because there is no *per se* rule that all prior art from foreign applications must be filed, you should consider whether all prior art, search reports, and patent office communications need to be filed, especially references that are Category A references and/or general state of the art.

A first IDS should be filed at the time of filing or within three months after filing. For subsequent IDSs, consider filing just after the case has been assigned to an examiner but before a first action issues. Once the application is under examination, you should quickly file additional prior art to avoid significant USPTO fees and limitations on filings.

#### 4. Unity of invention (restriction requirement) and election of species

Unless there is no reasonable basis for traversal, make a short traverse of requirements for restrictions. Simple traversals should usually suffice. Longer traversals will often not significantly increase the chances of withdrawal.

Traversing an election of species requirement may result in risky admissions on the record, eg, that various aspects (species) of the invention are not patentably distinct from each other.

Making claim amendments or adding claims to an elected group when filing a response may facilitate a more productive first action from the examiner. Cancellation of claims that will not be examined could avoid the expense involved in handling examiner's amendments or *ex parte* quayle actions.

#### 5. Responding to a first office action

Most patent applications will receive a first office action on the merits.

##### • Make your response to the first office action count

The response to the first office action should be considered in view of your overall strategy.

If the goal is quick allowance, claim amendments should be considered, not only to the independent claim(s) to distinguish over prior art, but in the form of new dependent claims as potential "back-up" positions that contain features that further distinguish from the cited art. Any amendments made in response to a first office action are entered as a matter of right.

New dependent claims may include narrower claims that identify allowable subject matter sooner. If a final office action is issued, it is unlikely that any substantive claim amendments will be entered without a request for continued examination (RCE).

If the goal is to secure broad claim scope, strategic arguments and/or supplemental evidence should be considered in responding to the first office action. But this may extend prosecution and increase overall costs.

##### • Conduct an examiner interview

You should conduct an examiner interview before filing a response to a first office action that contains any substantive issue. Conducting the interview will incur extra attorney fees, but the downstream benefits are significant. The attorney can get a better understanding as to the examiner's concerns

Drafting claims for all categories of the invention increases the likelihood of receiving a robust prior art search.

and determine what approach will work best.

#### 6. Post-first office action strategy

Many patent applications will receive a second office action on the merits, which is usually a final rejection. Once an application is after the final rejection stage, patent prosecution costs begin to add up. For this reason, it is important to check in with your overall strategy to help inform the best next steps.

One option in responding to a final rejection is to submit additional arguments and/or evidence (and conduct another interview), particularly if claim scope is important to you. This approach could expedite allowance and avoid an RCE or an appeal.

Another option would be to respond to the final rejection with additional amendments. Such amendments may require an RCE. But if the amendments are likely to lead to allowance, eg, by significantly narrowing the claims around the prior art, or by recommendation of the examiner during an interview, the RCE may be worth the cost to receive a notice of allowance in the next action.

Yet another option would be to appeal the rejection(s). Appeals are costly and time-consuming. However, the issues in the chemical and pharmaceutical arts can be complex and subjective. Therefore, appeals could offer an expedited (and sometimes only) path to allowance if an application is "stuck" before a difficult examiner.

The above actions will undoubtedly result in saving incremental costs during prosecution and should result in earlier allowance and better patents. **ip**

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in 

# AN UPDATE ON PATENTING IN UKRAINE, RUSSIA AND EURASIA

**Erik Viik** of Papula-Nevinpat looks at the dynamics international applicants need to be aware of to secure and manage their patent rights across the region.

## Ukraine

When Ukraine declared martial law in early 2022, wartime IP rules were implemented that suspended deadlines for renewal fees and other procedural actions. A new law effective from May 31, 2025 now cancels these wartime rules and introduces a 75-day grace period to recover missed deadlines or fees.

The grace period, which had already expired at the time of publication of this article, allowed applicants to complete all necessary legal actions and pay overdue official fees to maintain their IP rights in force. In addition, new national entries based on Patent Cooperation Treaty (PCT) applications were permitted, even if the deadlines had long since passed.

We've seen several foreign applicants use this opportunity to enter the national phase well past the 31-month due date, or to restore the prosecution of inactive applications.

Another update in Ukraine requires applicants to submit detailed contact information on all inventors. While this data is treated as confidential, the rule has raised concerns among foreign applicants. Ukraine's local patent attorney association is actively challenging the change.

It is suspected that the intent is to ensure there are no Russian inventors or beneficiaries behind



**The most prominent fee change in Russia came into effect in October 2024, with annual renewals for patents, utility models, and designs now requiring five-year advance payments.**

Erik Viik

## TAKEAWAYS

- Ukraine requires detailed inventor contact information
- Compulsory licensing in Russia becoming a reality
- Changes in Eurasia relate to increased official fees

an application. But the rule creates extra work for foreign applicants, and not all are comfortable disclosing this information.

The requirement is not aligned with the PCT, and so far, the national phase applications are still being prosecuted as before. We have not been submitting overly detailed inventor data, and time will tell how strictly this rule is enforced.

## Russia

Despite ongoing geopolitical upheaval, the Russian patent office remains fully operational and continues to process filings. No significant recent amendments are targeting foreign applicants. That said, domestic applicants filed more patent applications in 2024 than in previous years. China now surpasses the US as the top foreign filer in Russia.

Most official patent fees in the country increased by 20–25% in 2024, but remain relatively low in comparison to Eurasia. The most prominent fee change in Russia came into effect in October 2024, with annual renewals for patents, utility models, and designs now requiring five-year advance payments.

This important development is clearly aimed at encouraging foreign applicants to stay in the patent system. By paying in advance, rights remain in force

even if future sanctions or other restrictions affect payments or prosecution in the Russian Federation.

Another prominent development is Federal Law No. 214-FZ on "compensation for IP infringement", which was published on July 8, 2025. It introduces significant changes to the Russian Civil Code regarding the award of compensation for the infringement of intellectual property rights.

The law will come into effect in January 2026 and provide clearer, more structured rules, with flexible options for courts and stronger penalties in serious cases.

The maximum fixed compensation has been increased to 10 million rubles (\$125,000) for most types of IP. For patents, the minimum is now 50,000 rubles. If several IP rights are violated together (eg, in one counterfeit product), the total compensation is still calculated as if only one right was violated.

In case the method of calculating compensation chosen by the rights holder doesn't suit the situation, the new law allows the court to choose a different method, including setting a fixed amount.

Another notable change allows applicants to request that their names and those of rights holders and licensees remain unpublished. This is likely aimed at protecting foreign companies that





IMAGE: SHUTTERSTOCK.COM / SHUTTERSTOCK/AL-GENERATOR-OVAL

license rights to Russian entities. However, the measure offers little practical benefit and is expected to end this year.

### Compulsory licensing

In certain cases, the Russian government or courts may allow a company to use a patented invention without the owner's consent. This compulsory licensing is especially relevant in the pharmaceutical sector.

Russian legislation sets out three distinct legal grounds for granting compulsory licences: (1) non-use or insufficient use of the invention; (2) dependent patents, where a patented invention cannot be used without infringing on another; and (3) use in the interests of national security or public health.

While the local commercial (*Arbitrazh*) courts grant compulsory licences under legal grounds (1) and (2), Russian Resolution 380 of March 27, 2024 outlines the procedure for granting the same under legal ground (3), and establishes a subcommittee to review requests.

Those Russian legal entities that meet the prerequisites defined in the resolution can, under certain conditions, submit compulsory licence requests to the Ministry of Economic Development. The subcommittee then drafts a decision for government approval. Final

decisions are signed by the prime minister and may be appealed to the Russian Supreme Court.

Several granted compulsory licences—with many additional cases still pending—show that compulsory licensing in Russia is becoming a reality that must be factored into business decisions. This is especially important when the IP holder is no longer present in the country but still owns rights there.

### Eurasia

The Eurasian Patent Convention (EAPC) provides a single, harmonised prosecution procedure in one language (Russian) before the Eurasian Patent Office located in Moscow. A granted Eurasian patent has the same effect as a national patent, and it is kept in force in the EAPC member states chosen by the applicant by paying annuity fees to the Eurasian Patent Office.

There are neither validation fees nor requirements to translate the claims into any other language than Russian. The following eight states are party to the EAPC: Armenia, Azerbaijan, Kazakhstan, Kyrgyzstan, Tajikistan, Turkmenistan, Belarus, and the Russian Federation.

According to the Patent Office's latest annual report, applicants originating from the EAPC member states are becoming more active,

More than half of [patent] applications filed in Eurasia last year related to pharmaceuticals, biotech, and organic chemistry.

while filing volumes from non-member states have declined modestly. The US continues to lead foreign filings, ahead of China.

More than half of applications filed in Eurasia last year related to pharmaceuticals, biotech, and organic chemistry. Yet some fields of science and engineering are remarkably underrepresented, including nanotechnology, semiconductors, and telecom. Applicants in these fields often choose the Russian protection route over the Eurasian one.

Most recent developments in Eurasia relate to increases in official fees. These were raised in 2024 and then again in February this year. The increases were quite substantial, although fees remain lower than those in many Western jurisdictions. Official fees in Eurasia are quite a bit higher than in Russia. But the applicant has the option of keeping the Eurasian patent in force in the desired EAPC member states.

It is not required to designate the chosen member states at filing. Only after the granting does one need to decide in which Eurasian member states the fees will be paid to keep the patent in force. **ip**

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# A UNIFIED APPROACH: SWEDEN'S KEY TO IP LEADERSHIP

The Scandinavian country is the second most innovative nation in the world but capitalising on this position will require a comprehensive, coordinated IP rights strategy, says **Petter Rindforth** of Fenix Legal.

According to the World Intellectual Property Organization's (WIPO) Global Innovation Index 2024 (GII), Sweden is keeping its place as the second most innovative country in the world, with Switzerland as number 1, the US number 3, Singapore number 4 and the UK number 5.

The GII notes that Sweden is number 1 in Infrastructure; business sophistication; researchers; and intellectual property (IP) payments and receipts, but only ranked as number 3 for human capital and research; knowledge-intensive employment; and global brand value.

In the autumn of 2024, the Royal Swedish Academy of Engineering Sciences (IVA) initiated a feasibility study to investigate the need for a national IP strategy in Sweden and what it should contain if so. The study was based on a survey of how other countries strategically manage IP through legislation, policy and support measures, and the result was compared with the situation in Sweden.

The main conclusion of the study was that the Swedish government should develop a strategy and an action plan for knowledge-based assets with a focus on innovation



Petter Rindforth

## TAKEAWAYS

- Swedish govt to develop innovation plan
- Feasibility study contains 23 proposals
- Working group coordinating issues on IP rights

and growth. Both the strategy and the action plan need to have a broad approach to cover all knowledge-based assets.

The feasibility study contains 23 concrete proposals with background and recommendations, including:

- Coordinated governance: Issues regarding knowledge-based assets cut across several policy areas and ministries. Therefore, increased coordination is needed.
- Long-term collaboration: Authorities should be given government assignments to cooperate in the long term on issues affecting knowledge-based assets and to use existing expertise effectively.
- Education and skills: An investigation should map the situation regarding knowledge-based assets throughout the education system.
- Strengthened research: The government should consider targeted investments regarding research linked to knowledge-based assets, including more doctoral positions and professorships with an interdisciplinary profile.
- More effective use of patent information: A national plan

should be developed for how patent information can be used strategically in research initiatives and the allocation of research funds.

- Improved collaboration: Identify obstacles, including regulations, to collaboration between academia and industry in the management of knowledge-based assets.
- National knowledge hub: A framework should be established to provide expert support on issues related to knowledge-based assets, including strengthening the innovation support system and ensuring a uniform interpretation of regulations.
- Support for smaller players: Map why Swedish companies register IP rights to a lower extent than the EU average and investigate how SMEs can receive better support to both strengthen and defend their IP assets.
- The role of law enforcement authorities: Law enforcement authorities should include IP rights infringement in their work against organised crime and increase international cooperation against, among other things, piracy and illegal internet protocol television (IPTV).



- Improved opportunities to act: SMEs' opportunities for support in defending knowledge-based assets need to be investigated, including limitations on legal costs and access to mediation.

### A drive from the top

The IVA's recommendations are reflected in the Swedish government's initiative to work for "A comprehensive approach to intellectual property rights", presented in a press release of February 14, 2025. The Swedish government stated that it is working towards an innovative and competitive Sweden that strengthens growth, prosperity and security, noting that "an important part of this work is to take a comprehensive approach to intellectual property rights issues".

The government therefore created a working group with the task of coordinating issues on IP rights and helping to develop a direction for the government's objectives in the area.

The press release stated that industrial, creative and cultural creation are central to Swedish innovation and competitiveness. In order for Swedish companies, innovators and cultural creators to succeed in the Swedish and

international markets, knowledge of IP rights and strategic management of IP assets are crucial.

With significant societal challenges, intensifying global competition and rapid technological development, the government sees a need to work strategically and comprehensively in the area of IP rights at a national and international level.

The Swedish Minister of Justice Gunnar Strömmer said that these issues "are central to Swedish growth and Swedish prosperity. The issues involve many actors in society and several different political areas of responsibility".

The Minister of Energy and Enterprise and Deputy Prime Minister Ebba Busch added: "We want to make it easier for Swedish actors to protect and commercialise their intangible assets. This is part of the government's efforts to maintain Sweden's position as a leading innovation country."

### Valuable perspectives

The press release also noted that in the work of strengthening Swedish innovation and competitiveness, all actors in the country's market play an important role, and that it is therefore important that Swedish stakeholders are involved in the work.

The next step was in May–June 2025, when the Swedish government invited around 60 stakeholders to roundtable discussions, focusing on issues related to the central role of IP rights in increasing cultural creation, innovation and competitiveness. The Swedish Intellectual Property Office (PRV) participated, as well as representatives from some industry organisations such as the Publishers' Association and the Swedish Federation of Wood and Furniture Industry, etc. The meetings were organised by the Ministry of Justice, together with the Ministry of Climate and Enterprise, and Ministry of Culture.

Mikael Kullberg, state secretary at the Ministry of Justice, stated

**The main conclusion of the study was that the Swedish government should develop a strategy and an action plan for knowledge-based assets with a focus on innovation and growth.**

in a press release of June 10, 2025 that: "The discussions have been very fruitful and constructive. The common thread has been the protection of IP rights and the need for increased knowledge about the role of intellectual property rights in value creation and commercialisation".

Karin Svanborg-Sjövall, state secretary at the Ministry of Culture, added that "the cultural and creative industries are a new basic industry in Sweden, and intellectual property rights in general and copyright in particular are a fundamental part of the business model for these industries".

The government's initiative for a working group to coordinate work on IP issues is of course welcomed and a good initial step. Hopefully the further discussions will take into serious consideration all the initial proposals from the IVA study. And hopefully the working group will also reach out to another group that has long and practical experience of all the IP topics: IP attorneys.

So far, not one private practice IP attorney has been invited to the roundtables, in spite of the fact that they are the people that work directly with the industry and inventors and daily assist in practical IP protection, as well as how to build a business based on patents, trademarks and designs, and understand what is needed in order to stop piracy and unfair marketing.

One good example of fruitful cooperation between authorities and the private market is the longstanding praxis of yearly open meetings between the Association of Swedish Patent Attorneys (SPOF) and the Swedish Intellectual Property Office, with discussion and information on practice and how to increase the options for Swedish companies of all sizes to create business-focused IP protection. That is what you call "a unified approach to intellectual property law". **ip**

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**Hopefully the working group will also reach out to another group that has long and practical daily experience of all the IP topics: IP attorneys.**



# CAREERS



## UNITED STATES

### Four-lawyer team joins Cozen O'Connor's new San Diego office

Cozen O'Connor is expanding its litigation team ahead of opening a new office in North County, San Diego, adding four lawyers.

**Nicola (Nick) Pisano, Scott Penner, and Jose (Joe) Patiño** have joined the firm, with **Regis Worley** following shortly after.

Pisano, Penner and Worley arrive from Eversheds Sutherland, while Patiño joins from Buchalter.

The group handles patent, trademark, copyright, and trade secret disputes across a variety of industries.

Michael Heller, Cozen O'Connor's chairman and CEO, said: "With prior backgrounds in industry and technology, Nick, Scott and Joe have decades of relevant IP experience, not only as lawyers, but as businesspeople who can help our clients uncover and develop sustainable business solutions."

Shareholder Pisano brings lead counsel experience in more than 100 matters. His practice includes patent, trade secret, trade dress, and copyright litigation.

Penner joins as a member and brings a primary focus on patent litigation handling clients from multinational corporations to technology startups.

Patiño brings 35 years of high-stakes IP dispute experience with a litigation record that spans courts in more than 25 states.

Also joining as a member, Worley counsels clients on all areas of IP including protecting and enforcing their technologies such as sensors, medical devices, software, hardware, and consumer electronics.

## UNITED KINGDOM

### Crowell gains 18-strong patent team from Dentons, London

Crowell & Moring has announced the appointment of an 18-strong technology-focused patent team in London, who have all moved from Dentons.

The team will be led by partners **Justin Hill**, who becomes head of Intellectual Property (UK), and **Marie Jansson Heeks**.

The group moved from Dentons' UK & Middle East branch in London, where Hill served as co-head of IP. As well as Hill and Jansson Heeks, the group includes 12 legal professionals and other support staff.

The patent team represents patent holders and opponents in opposition and appeal proceedings before the European Patent Office and the Unified Patent Court, as well as national courts. They also provide transactional and advisory input.

**The IP team at Crowell is widely considered one of the most accomplished in the market and we're excited to join such a top-tier team.**

Justin Hill, Crowell & Moring

Hill is a highly ranked European patent attorney and litigator with more than 20 years' experience. His practice focuses on advising on IP policy, strategy, portfolio management, and commercialisation.

Jansson Heeks is a qualified solicitor and solicitor advocate, as well as a UK and European patent attorney. Her work focuses on strategic patent portfolio management and litigation.

Commenting on the move, Hill said: "The IP team at Crowell is widely considered one of the most accomplished in the market and we're excited to join such a top-tier team."



## FRANCE

### Tech litigators join Hogan Lovells in Paris

Hogan Lovells has hired partners **Alexandre Rudoni** and **Andrea Dufaure** (pictured), who are among the latest to move from A&O Shearman since its merger just over a year ago.

Rudoni and Dufaure began their roles on June 21, and will be based at the firm's Paris office.

The pair bring "market-leading expertise" across copyright, trademark, and entertainment litigation, with a focus on the tech, gaming and media industries, said Hogan Lovells.

Rudoni has more than two decades of experience advising multinational clients in the tech, media, and entertainment sectors, and is particularly renowned for his work in the video gaming industry.

Dufaure handles high-profile disputes before French courts, with a strong track record of building trusted relationships with clients navigating fast-evolving online IP challenges.

Prior to the A&O Shearman merger, Rudoni was at Allen & Overy for more than 21 years, while Dufaure was there for more than a decade.

In a joint statement, they said: "Hogan Lovells has a standout reputation in IP and extensive experience in cross-border litigation thanks to its global platform. We're excited to join such a dynamic team and to contribute to its continued success in Europe and beyond."



## MEXICO

## FisherBroyles expands Latin America team with latest hire

FisherBroyles has added partner **Jesús García-Moncada**, who brings 24 years of IP experience to the firm's Mexico City office.

Before joining FisherBroyles, García-Moncada cofounded Law+dgtal, described as Mexico's first cloud-based, non-traditional law firm. He previously served as in-house counsel and head of the IP legal office for Universidad Nacional Autónoma de México.

García-Moncada has developed expertise in IP protection and enforcement, portfolio management, and strategic IP development for both Mexican and international clients.

His practice includes patent and trademark counselling, technology licensing, copyright matters, trade secrets, and IP due diligence in M&A transactions.

García-Moncada's client base includes authors, creators, inventors, corporations, entrepreneurs, universities, startups, and research and development entities.

Kevin Broyles, co-founder and managing partner at FisherBroyles, noted that the hire supports the firm's "commitment to serving clients globally with the industry's most talented legal minds".

Beyond traditional IP work, García-Moncada also advises on cybersecurity risk, privacy and data security, and restrictive covenants.

The appointment is part of FisherBroyles' broader Latin American expansion, which began in February with the opening of offices in Mexico City and Monterrey.

García-Moncada joins alongside new recruits Rodrigo García-Moncada (corporate and transactional) and Mario Facio Salazar (environmental), and his appointment follows the recent addition of Pedro Suarez in the firm's Los Angeles office.

## UNITED KINGDOM

## Deloitte team of tech and brand experts joins Pinsent Masons

Pinsent Masons has added a team of four from Deloitte to its London offices.

The new arrivals include partners **Rachael Barber**, **Jeremy Harris** and **Paul Garland**, alongside legal director **Richard Reeve-Young**.

Garland brings over two decades of experience in strategic IP management for technology clients and previously served as global head of IP and technology at Deloitte.

His practice includes protection and enforcement across the full range of IP rights and digital assets.

Tom Nener, co-head of IP, said: "With technological development disrupting traditional IP strategies, these hires position us to execute increasingly complex global work on behalf of high-profile brands and leading technology clients."

Barber specialises in retail and luxury brands, focusing on trademark, copyright and design enforcement alongside strategic IP portfolio management.

**With technological development disrupting traditional IP strategies, these hires position us to execute increasingly complex global work on behalf of high-profile brands and leading technology clients.**

Tom Nener, Pinsent Masons

She has advised leading luxury brands and retailers and has expertise in deploying AI for online brand protection.

Harris covers a broad practice including disputes, transactions and advisory work across all IP rights in software, data, and emerging technology.

His litigation experience ranges from copyright to database rights and breach of contract matters in the High Court, while his transactional work centres on IP licensing and joint ventures.

Reeve-Young advises on IP ownership, enforcement and exploitation strategies, combining traditional litigation with technology-enabled enforcement.



## UNITED STATES

## PierFerd taps experts in trade secrets and USPTO proceedings

PierFerdinand has added a trade secrets expert and a US Patent and Trademark Office (USPTO) authority to its IP department.

**David Pardue** (pictured) joins as partner in the firm's Atlanta office, having moved from Parker Poe, and **David Boundy** joins as a partner in the Boston office, making the move from Potomac Law Group.

Pardue brings over three decades of experience in trade secrets, IP, employment, and complex business litigation. He has served as lead counsel in over 125 federal lawsuits, with clients running from global public companies to small businesses.

Pardue focuses on sectors including manufacturing, technology, automotive, construction, and insurance.

Naira Simmons, co-chair of IP at PierFerd, said: "David [Pardue] is widely recognised as a leading authority in trade secrets law, with more than three decades of experience guiding clients through complex, high-stakes litigation."

"His deep experience spans a broad range of industries, and his thoughtful, strategic approach to resolving sophisticated disputes is highly valued by clients and colleagues alike," she added.

Boundy brings specialised experience in administrative law as it applies to the USPTO, particularly in cases before the Patent Trial and Appeal Board and US Court of Appeals for the Federal Circuit.

He focuses on patent prosecution, licensing, acquisitions, financing, and transactional due diligence. He also advises growth companies on IP portfolio structures designed to appeal to investors.

Boundy has previously worked at Willkie Farr & Gallagher, Schulte Roth & Zabel, and Shearman & Sterling (now A&O Shearman), with in-house experience at Proper Orange and Cantor Fitzgerald.



#### UNITED KINGDOM

### D Young & Co appoints London rival's former head of brand protection

Pan-European IP firm D Young & Co has brought in brand protection specialist **Charlotte Duly** to expand its trademark team.

Duly joins from Charles Russell Speechlys, where she was head of brand protection, and has over 16 years' experience of managing global trademark portfolios for large clients.

Her expertise includes clearing new brands and devising protection and enforcement strategies; opposition and cancellation actions; domain name disputes, settlement negotiations; and mediation.

Prior to her time at Charles Russell Speechlys, Duly spent over a decade at Boulton. She has worked with clients in diverse sectors including software, finance, insurance, fashion, retail, food and drink, sports, leisure, entertainment and technology.

Duly is an active member of the International Trademark Association (INTA), the Chartered Institute of Trade Mark Attorneys (CITMA) and Marques, where she is the co-chair of the Marques Education Team.

She also co-authored the fifth edition of *A User's Guide to Trade Marks and Passing Off*.

Matthew Dick, partner and solicitor in the trademark team, said: "We are delighted to welcome Charlotte into our award-winning trademarks team. Her skills and experience perfectly complement our expanding practice and the needs of our clients."

D Young & Co was rated 'Outstanding' in WIPR's UK Trademarks Rankings this year for its non-contentious practice.

The firm's trademark team, located across London, Southampton and Munich, handled a significant increase in work from 2023-2024 from new and existing clients, with active trademark clients up 42%.

#### UNITED STATES

### US firm Brownstein nabs five from Crowell 'at pivotal moment'

US law firm Brownstein has hired five partners from Crowell & Moring, two of whom join the firm's IP department.

**Anne Elise Herold Li** and **Paul Keller** join as shareholders, based in the New York office. Li was at Crowell for more than a decade, while Keller spent more than two years there before joining Brownstein.

The other hires join the Government Relations Department, based largely in the Washington, DC office:

**Aaron Cummings**, **Jim Flood**, and **Evan Chuck** (shareholders), and **Scott Douglas** (policy director).

"This is a pivotal moment for Brownstein, expanding our capabilities and expertise with an accomplished group of legal and policy professionals," said Rich Benenson, Brownstein's managing partner.

The new recruits "bring a depth of knowledge and sophistication that will strengthen our firm and deliver meaningful results for our clients", added Benenson.

**We are delighted to welcome Charlotte into our award-winning trademarks team. Her skills and experience perfectly complement our expanding practice and the needs of our clients.**

Matthew Dick, D Young & Co

Li is a first-chair trial lawyer and a member of the patent team in New York, with a focus on the life sciences industry. Specialising in IP litigation and counselling, she successfully handles bet-the-company cases, often securing favourable settlements well before trial, said the firm.

Keller brings more than 30 years of experience advising clients in high-stakes patent, trade secret, trademark, copyright and complex commercial matters.

A first-chair IP litigator focused on the high-tech and life sciences industries, he also brings extensive experience with alternative dispute resolution.

Cummings is a policy adviser and advocate with high-level leadership experience on Capitol Hill, including serving as chief of staff to Senator Chuck Grassley.



#### JAPAN

### Japanese firm adds ex-Norvartis and Alnylam in-house counsel

Tokyo-based law firm Isshiki has expanded its IP and corporate practice with the addition of a partner and a partner promotion.

**Hiromi Furushima** (pictured) joins as partner from Alnylam Pharmaceuticals, where she was director of international legal. Prior to that, she spent seven years at Novartis Japan, where she was general counsel and head of IP.

During her time in-house, she oversaw the legal, IP, and compliance departments, and played a role in corporate management.

Her expertise includes IP strategy development and execution, litigation management, pharmaceutical regulatory violation matters involving criminal law aspects, governance framework establishment, and business development agreement negotiations.

Furushima also serves as outside director and corporate auditor for PRISM BioLab and Cellusion.

The firm also promoted **Takahiro Yanagimoto** to partner, who brings expertise in chemical, pharmaceutical, and biotechnology matters.

His practice covers IP dispute resolution, IP-related agreements, due diligence work, and patent prosecution through the firm's affiliate, Isshiki Patent Trademark Firm.

In March, the firm added associate **Shigehiro Kawase**, whose practice includes software and IT disputes, trademark and design matters, copyright issues, and commercial and civil litigation. [ip](#)





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