

APPLE BITES BACK

Chat logs, talent raids, and trade
secrets in Silicon Valley



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Large language muddle



APPLE IS "GETTING THIS WRONG", APPARENTLY. So says OpenAI in a blog post rebutting a scary-looking lawsuit, and the cover topic of this issue.

The complaints that former Apple employees stole a laptop, coached Apple staff on how to hide their defection, and asked staffers to bring actual product parts to interviews at OpenAI, represent a classic of the genre. And something that could happen almost anywhere, let alone with two of the biggest companies in the world.

When tech companies clashed in court a decade ago, the battleground was usually defined by patents, design rights, and pinch-to-zoom gestures. Apple's box office lawsuit against OpenAI and its hardware designer, io Products, shows how the front lines have shifted.

In 2024, the pair signed a partnership to integrate ChatGPT into Siri. That deal didn't prevent OpenAI from hiring some of its top people, including Tang Tan, a 24-year veteran of the Cupertino company who is now OpenAI's chief hardware officer. But it may provide useful leverage for Apple.

Just why OpenAI felt it necessary to respond to the complaint via a blog, complete with redacted text messages between the accused parties, is interesting in and of itself.

The ChatGPT maker has a different language problem to solve this time. Should it get to trial, the narrative required to convince a jury that a competitor stole hard-earned IP needs an equally convincing counterstory. And one could argue, given the public concern over data centres and job losses in the US, that Apple is tech royalty, more popular, and therefore on surer footing.

Underlying it all is OpenAI's pivot to hardware. The AI company's \$6.5 billion purchase of ex-Apple Jony Ive's design company turned the employee defections into an issue affecting the bottom line for Apple and investor confidence on both sides.

We shall be watching with interest. 

Tom Phillips, Group editor

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TRADEMARKS

Louis Vuitton wins case against Molly Tea but faces backlash

LOUIS VUITTON HAS SECURED A VICTORY IN CHINA

against floral tea chain Molly Tea, prompting a widespread debate over the scope of trademark protection, cross-sector brand enforcement, and the use of traditional cultural motifs in Chinese commercial branding.

In a first-instance judgment delivered in late June—but made public on July 2—the Suzhou Intermediate People's Court found that Molly Tea's stylised four-petal floral logo infringed seven of Louis Vuitton's registered trademarks.

The court ordered the company to pay RMB 10.3 million (approximately US\$1.5 million) in damages and legal expenses to the Paris-headquartered brand, and to publish public apologies across its official social media channels.

Celebrating Chinese culture

Molly Tea is a fast-growing Chinese tea chain that specialises in floral tea drinks, particularly jasmine-based milk teas.

Founded in 2021 in Shenzhen, China, the brand has expanded rapidly across China and internationally, with stores in the UK, the US, Canada, Australia and other countries.

Unlike many bubble tea chains that focus on sweetness and toppings, Molly Tea positions itself as an 'Eastern Modern' tea brand, designed to celebrate Chinese tea culture through premium ingredients, minimalist store design and floral fragrances.

The company has also collaborated with brands such as L'Oréal and Hello Kitty in recent years.

In May 2025, Louis Vuitton sued Molly Tea, claiming that elements of the tea chain's floral branding were sufficiently similar to its protected designs to create an unlawful association with the luxury brand.

Molly Tea countered that consumers would be unlikely to associate a luxury fashion house with a beverage retailer.

However, the court held that collaborations between luxury brands



Legal experts emphasise that trademark law protects the distinctive commercial identity embodied in a registered mark, rather than the underlying artistic motif itself.

and food and beverage businesses have become sufficiently commonplace that consumers may reasonably assume the existence of an authorised commercial relationship.

The decision comes after the French fashion house built an extensive portfolio of registered trademarks in China covering its name, logos and designs across multiple classes of goods and services, and is increasingly known for its vigilance in monitoring the market and enforcing those rights.

The development of specialist IP courts in cities such as Beijing, Shanghai and Guangzhou has also strengthened the enforcement landscape, with Chinese courts increasingly recognising the reputation of well-known international luxury brands.

An online backlash

Molly Tea has indicated that it intends to appeal the decision, but it has already begun revising its branding and updating its logo.

While it is a legal win for Louis Vuitton, the court of public opinion is sharply divided according to reports by Chinese media outlets including the *South China Morning Post*.

The judgment continues to generate heated debate on Chinese social media, concerning the extent to which traditional floral motifs, long used in Chinese decorative art, can be protected through trademark registration.

In one corner, many Chinese influencers on platforms such as Weibo insist that these types of designs should remain part of the public domain, arguing that Louis Vuitton's four-petal monogramme resembles the traditional Chinese *Baoxiang* flower, an ancient motif frequently used in public domain designs.

Many influencers and commenters have accused the luxury brand of "cultural appropriation", claiming that it is unfair to sue a local brand over a floral pattern rooted in Chinese history.

This, in turn, has fuelled a massive viral trend on Weibo, with case-related hashtags drawing hundreds of millions of views.

A wave of support saw netizens flock to defend the local business, causing Molly Tea's official TikTok account to gain more than 100,000 new followers in a single day following the court ruling.

Meanwhile, legal experts emphasise that trademark law protects the distinctive commercial identity embodied in a registered mark, rather than the underlying artistic motif itself.

In an interview with *The Straits Times*, Liu Bin, an intellectual property (IP) lawyer from the Beijing Zhongwen Law Firm, called for a rational perspective on the ruling, pointing out that legal protection for figurative marks does not require the disputed sign to be identical to the registered trademark. Instead, the key consideration is whether consumers are likely to be confused. **ip**

IMAGE: SHUTTERSTOCK.COM / CASIMIRO PT

TRADEMARKS

OpenAI loses fight to trademark its own name

OPENAI HAS LOST ITS BID TO OVERTURN AN EU COURT'S

refusal to register its mark, following an earlier decision that ruled that the sign is descriptive.

In a judgment handed down on July 15, the European Union Intellectual Property Office's (EUIPO) General Court upheld a decision by the Board of Appeal, which had agreed with an earlier examiner that the mark should be refused.

OpenAI applied to register 'OPENAI' as an EU trademark in June 2023.

After narrowing the scope of its application during the registration process, the company sought protection for a wide range of goods and services in Classes 9, 38, 42 and 45, including software, artificial intelligence (AI) applications, and identity verification.

In December 2024, an EUIPO examiner refused the application in part, finding that 'OPENAI' was descriptive and lacked distinctive character for those goods and services.

OpenAI appealed that decision, but the Board of Appeal dismissed it, leading the company to challenge the ruling before the General Court.

The ruling is unlikely to be the final word on the matter. While the court has confirmed that 'OPENAI' is descriptive, the EUIPO must still consider OpenAI's fallback argument that the name has become distinctive through use before the trademark application is finally resolved.

Splitting the name in two

At the heart of the dispute was a provision of the EU Trade Mark Regulation that prevents the registration of signs that describe the kind, quality or intended purpose of goods or services.

The EUIPO's Board of Appeal found that the relevant public would naturally split the mark 'OPENAI' into its two elements: "open" and "AI".

The General Court noted that the board considered "open" to mean, among other things, "not closed or



The Board of Appeal had already indicated that, once the refusal of registration becomes final, EUIPO would resume examining OpenAI's alternative claim.

barred; available; not limited; ready for business; free to all to join".

It also agreed that "AI" would be understood as the abbreviation for "artificial intelligence".

Taken together, the board concluded that the term could be understood as "accessible or unrestricted artificial intelligence, artificial intelligence based on open source principles or transparent or explainable artificial intelligence."

OpenAI argued that the board had effectively linked "open" with "open source" without justification.

It also claimed that 'OPENAI' was an invented word with no established dictionary meaning and should be viewed as a distinctive brand rather than a descriptive term.

Court unconvinced by defence

The General Court was not persuaded. It found that the board had relied on several dictionary definitions of "open", rather than treating it as shorthand for "open source".

It also pointed to established case law, which says a mark can be refused if just one of its possible meanings describes

a characteristic of the relevant goods or services.

The court went on to find that 'OPENAI' does not create "on the part of the relevant public, an impression sufficiently far removed from that produced by the mere juxtaposition of the words of which it is composed to alter its meaning or scope."

Finally, the court said "it is of little consequence that the expression 'open AI' has no lexical meaning and does not constitute a recognised expression in English," explaining that a trademark does not need to appear in a dictionary or be in everyday use to be refused registration.

One size fits all

OpenAI also argued that the Board of Appeal should not have relied on the same reasoning for all of the goods and services covered by the application, given how broad they were.

The General Court disagreed. It found that all of the goods and services shared a common feature: they could be based on, or operate using, freely accessible AI.

Because of that shared characteristic, the court said the board was entitled to treat them as a sufficiently similar group and did not need to assess each product or service individually.

The court dismissed the action in its entirety and ordered OpenAI to pay EUIPO's costs.

The judgment does, however, leave one issue unresolved. The Board of Appeal had already indicated that, once the refusal of registration becomes final, EUIPO would resume examining OpenAI's alternative claim.

That fallback argument is that, even if the mark 'OPENAI' is not inherently distinctive, it has acquired distinctive character through use.

The General Court did not rule on that issue, meaning it will now return to EUIPO for consideration once the present decision becomes final. **ip**

IMAGE: SHUTTERSTOCK.COM / EVOLF

PATENTS

WIPO reaching 'critical mass' on searchable SEP data

THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO) has enlarged the number of patent applications that are searchable as pool-verified standard-essential patents (SEPs) on its global Patentscope database.

The organisation has partnered with Via Licensing Alliance (Via), the world's largest collaborative licensing organisation and the second patent pool to join.

WIPO announced its first patent pool partnership with Sisvel in February.

The addition of Via now brings the number of patent applications that are searchable as pool-verified SEPs on Patentscope to more than 9,000 across 11 licensing programmes.

Those provided by Via alone number approximately 5,400 new pool-verified distinct applications, and include three major licensing programmes: Advanced Audio Coding (AAC); Video (AVC/H.264); and Qi Wireless Power.

The overall aim of Patentscope is to help achieve greater transparency in the SEP ecosystem—important because SEPs underpin many of the most widely used technologies.

Patentscope allows users to find information on international patent applications, as well as patents and published patent applications in more than 80 countries, translating them into 18 languages using artificial intelligence.

WIPO: We cannot do this on our own

András Jókúti is director of WIPO's Patent and Technology Law Division, which leads on the implementation of the organisation's SEP strategy.

"We are very happy that Via [is] on board," he told *WIPR*. "It is an important partner, and the whole success of any of the projects that we are doing with SEPs is predicated on external collaboration. We cannot do any of this on our own."

He added that all of the data that WIPO is integrating into Patentscope is public,

either from standard development organisations (SDOs) or patent pool administrators, but Patentscope differentiates SEPs as declared or pool-verified.

"As we all know, declarations are not necessarily informative on the true essentiality of those patent records, because they are declared at an early stage," explained Jókuti. "They are not verified for essentiality, and they are basically a self-declaration from companies."

[Via] is an important partner, and the whole success of any of the projects that we are doing with SEPs is predicated on external collaboration.

András Jókúti, WIPO

'Critical mass'

The development comes a little more than a year after WIPO first launched the SEPs searchability function to Patentscope, which was originally launched in 2001.

The May 2025 update enabled users to search SEP declarations from three key SDOs: ETSI, the European Telecommunications Standards Institute; IEEE SA, the IEEE Standards Association; and ITU, the United Nations' International Telecommunication Union.

Jókuti explained that patent databases at SDOs "are huge", especially ETSI. ITU is smaller, and IEEE is the smallest, because it also allows for blanket declarations.

"We were very happy to have Sisvel on board, and all this prelude was important because what we are doing with Via is an expansion of all that.

"We are extremely delighted to have a second patent pool administrator joining this initiative, because we are actually starting to reach some kind of critical mass.

"Of course, there is a limited number of major patent pool administrators that we can work with. Via is definitely one of the biggest ones and their openness is providing more credence to this extra transparency measure that we are implementing now in Patentscope."

He warned that without working with SDOs, patent pool administrators, or the industry, "then we cannot really move forward".

Jókuti also added that it is "very important to emphasise that WIPO is not re-verifying or endorsing the essentiality of these patents, and we do have a very hefty disclaimer to this effect in Patentscope.

"But we do appreciate the openness of the patent pool administrators to partner with us and share this data."

He revealed that WIPO plans to bring other patent pool administrators on board.

'An easy decision'

Via's licensing programmes depend on independent third-party experts to evaluate patent essentiality, said Via.

Kevin Mack, president of Via, added: "WIPO's efforts to create greater transparency for the IP licensing ecosystem through Patentscope are fully aligned with Via's mission, so joining this important effort was an easy decision."

WIPO's Patentscope team hosted two complimentary demonstration sessions in September to show users how to find and use the 'verified' SEP search feature, including the new data collection. [ip](#)

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Music rights holders win key victory against Suno AI in Germany



A GERMAN MUSIC RIGHTS COLLECTIVE HAS TRIUMPHED in its copyright dispute against Suno AI, with a first-of-its-kind ruling that will have major implications for artificial intelligence platforms and music rights holders far beyond Europe.

The Munich Regional Court I delivered its verdict orally on July 31, agreeing with Gema that the US-based music AI platform had infringed the copyrights of nine well-known songs by German artists without permission.

Among them are 1980s classics *Big in Japan* and *Forever Young* by Alphaville; Boney M.'s 1970s hits *Daddy Cool* and *Rasputin*, written by German producer Frank Farian; and Lou Bega's 1999 version of *Mambo No. 5*.

Gema, which represents more than 100,000 members and over two million music users in Germany, provides examples of the original recordings named in the lawsuit against Suno's AI versions on its website.

Gema CEO Tobias Holzmüller told *Reuters*: "This is a verdict of global significance."

In a statement issued to the press, Suno said that it disagreed with the ruling, "which rests on a fundamental mischaracterisation of how Suno's technology works, how it is used and how US law applies".

The Massachusetts-based company—which was valued at \$5.4 billion in a

June funding round—added that it was "evaluating all available options, including an appeal".

'Stream ripping' and 'memorisation'

Germany's state-mandated licensing agency Gema sued Suno in January 2025, claiming that it had processed protected recordings of the nine songs without paying remuneration.

"In numerous cases, the AI tool generated audio content that is confusingly similar to the original songs," Gema said in a press release at the time.

In its July verdict, the Munich court found that Suno, which generates songs

In numerous cases, the AI tool generated audio content that is confusingly similar to the original songs.

Gema

as audio files using generative AI (genAI), used 'stream-ripping' techniques to extract the original recordings from YouTube, deliberately bypassing technical protection measures to train its AI model.

Suno produced these outputs by inputting specific prompts that proved 'memorisation', meaning the protected

works were reproduced almost identically by the model, without any compensation to the original creators.

The court verbally granted injunctive relief, disclosure, and damages to the rights holders, with a written verdict yet to be published.

OpenAI win

The ruling follows Gema's landmark victory against OpenAI in November 2025, when the Munich Regional Court found that OpenAI's ChatGPT models infringe German copyright law—both in how they are trained and the content they produce.

According to Gema, it was the first collecting society worldwide to file lawsuits against providers of genAI systems that used copyrighted musical works to train their systems without acquiring a licence.

Gema holds almost 35 million songs and musical works in its database, and recently paid out €331 million (\$380 million) in royalties to creators and publishers worldwide.

Munich-based IP lawyer Maria Cristina Trujillo explained on LinkedIn why this case matters far beyond Germany.

The Barrera & Asociados IP lawyer pointed out that it's the first European ruling on AI training on copyrighted audio recordings—not just lyrics or text, but the music itself.

In addition, the win "could reshape the entire industry".

"Under German law, a first-instance ruling can be enforced immediately, even during appeal. That means Gema could seek an injunction against Suno's European operations starting today."

She also highlighted that the same Munich court already ruled against OpenAI for song lyrics in November 2025, suggesting that US cases against Suno won't reach a fair-use ruling until 2027.

Gema's win sends a "clear message" to every AI music company, she added. "In Europe, you pay before you train." **ip**

IMAGE: SHUTTERSTOCK.COM / YALCIN SONAT

INFLUENTIAL WOMEN

WIPR launches Influential Women in IP 2026 list



WORLD IP REVIEW (WIPR) HAS UNVEILED ITS INFLUENTIAL WOMEN IN IP 2026 LIST, which celebrates an exceptional selection of women spanning private practice, in-house corporate legal departments, academia, and international public institutions.

Chosen through a selection process combining industry nominations and independent editorial research, this year's honourees are recognised for driving innovation, rewriting legal precedents, and actively dismantling barriers for women in law.

A global power list

The 2026 list highlights women operating at the peak of the legal profession, navigating complex matters with profound commercial consequences.

Among the standout litigators is Sheila Swaroop, chair of the litigation practice at Knobbe Martens, who served as a leader on the trial team that secured a \$634 million jury verdict for Masimo against Apple over heart-monitoring wearable technology.

Debevoise & Plimpton partner Megan Bannigan is a leading figure in US trademark and brand protection litigation, who has acted for MHSCF against Nike in the widely publicised 'Satan Shoes' litigation involving Lil Nas X, which raised significant issues of trademark and trade dress protection in fashion and cultural collaborations.

Widely regarded as a 'go-to lawyer' in Paris for complex litigation, Marianne Schaffner, partner and co-head of IP at Gowling, is influential in the IP field not only through her litigation practice but also through her contributions to the development of IP procedure and policy.

Since her departure from the US Patent and Trademark Office in late 2024, Kathi Vidal has established herself as a global thought leader in IP and AI governance, frequently speaking at international forums on innovation, technology policy, and the future of IP systems.

In the UK, Asima Rana earned widespread acclaim for leading the intellectual property team at DWF that secured a landmark UK Supreme Court victory for Dairy UK against plant-based giant Oatly, establishing a major precedent regarding protected dairy designations.

On the transactional front, Megan Baca, managing partner at Ropes & Gray in Silicon Valley, directed some of the year's largest life sciences deals. Her 2026 milestones include advising Eli Lilly and Company on its \$1.2 billion cash acquisition of Ventyx Biosciences.

The 2026 honourees are not just practising law; they are actively running global legal operations and driving international IP policy.

Sylvia Fang is celebrated for more than two decades of legal leadership at Taiwan Semiconductor Manufacturing Company (TSMC), where she serves as senior vice president, general counsel, and corporate governance officer.

Edyta Demby-Siwiek is the first woman to serve as deputy executive director in the EU Intellectual Property Office's 30-year history. Her appointment reflects the growing presence of women in senior roles across European IP institutions, where they remain underrepresented overall.

Championing inclusion and mentorship

At the heart of the WIPR Influential Women in IP list is a commitment to advancing inclusion, fostering the next generation

of professional talent, and promoting innovation from communities with different backgrounds and perspectives.

Laila Beynon, director of IP litigation at Regeneron Pharmaceuticals, is a leading voice in the UK chapter of ChIPs and pioneered Perfect Pitch—a programme allowing junior counsel to pitch their law firms to corporate tech giants using mock patent litigation frameworks.

From advising pioneering startups to championing women in the profession, Fran Salisbury, patent attorney and 'Women's Champion' at Mewburn Ellis has spent her career making innovation count. She is widely recognised for her leadership in gender equality and workplace culture transformation within the IP profession.

In South Africa, Bilkis Daby, senior partner at Adams & Adams, chairs her firm's D&I Committee while serving on the International Trademark Association's (INTA) global Women's Leadership Initiative.

In Argentina, Raquel Flanzbaum co-founded the specialised boutique Bullrich Flanzbaum, introducing progressive blind recruitment practices to provide equal corporate access for women at all career stages.

Manisha Singh, founder and managing partner of LexOrbis in India collaborates with *Haath ka Bana* (Made by Hand) to support artisan communities across the country, promoting geographical indications protection and raising awareness of IP rights among traditional creators.

Our editorial team extends its gratitude to the legal community for an exceptional standard of entries this year. The 2026 list stands as an inspiring testament to the depth of female leadership strengthening the IP system worldwide.

Find the full Influential Women in IP list under Rankings at www.worldipreview.com.

PATENTS

Masimo keeps \$634m smartwatch award and moves to appeal



A CALIFORNIA JUDGE HAS REJECTED APPLE'S BID to overturn a jury verdict that ordered it to pay \$634 million to Masimo as part of the pair's high-profile smartwatch dispute, which is now heading for appellate proceedings.

In a final judgment entered on July 20, US District Judge James Selna affirmed the jury's finding that Apple had infringed Masimo's US patent 10,433,776, which covers blood oxygen monitoring technology.

The judge determined that Apple's infringement was not willful, and that the relevant claims of the patent were not invalid.

Addressing Masimo's trade secrets claims, which alleged that Apple had stolen proprietary pulse-oxygenometry know-how, Judge Selna formalised the findings that Apple had not misappropriated certain secrets but had done so with others.

However, this was not to lead to any injunction, monetary relief or attorneys' fees for Masimo, which had failed to establish either irreparable harm or that it lacked an adequate monetary remedy.

In another win for Apple, the tech giant held on to ownership of five US patents covering inventions that Masimo had

long staked a claim to.

These are US patent numbers 10,078,052; 10,247,670; 9,952,095; 10,219,754; and 11,009,390.

'Patient monitor' contested

Last year, Masimo hailed its \$634 million jury award, delivered in November 2025, as a "significant win in our ongoing efforts to protect our innovations and intellectual property".

Following the verdict, Apple told the court that "no reasonable jury" could

In another win for Apple, the tech giant held on to ownership of five US patents covering inventions that Masimo had long staked a claim to.

have found the Apple Watch and its accused features infringed any claims of the '776 patent, or that Masimo was entitled to more than nominal damages.

Judgment as a matter of law "or at least a new trial" was required on all issues, the tech giant said, arguing that its watch could not be described as a "patient monitor", as required by the patent's claims.

Apple said its device was not designed to try and capture "all important medical events" as a patient monitor would, and that its accused 'High/Low Notifications' would "in fact miss many of those events"—functionality that was "perfectly acceptable in the broader context of a consumer device like Apple Watch".

The company also argued for no infringement under the doctrine of equivalents, contending that Masimo's case rested on "conclusory statements" from an expert witness that "virtually any device measuring 'medically relevant information' satisfies the 'patient monitor' requirement".

"The Federal Circuit rejected just such a 'because I said so' approach as insufficient as recently as last year," Apple's lawyers told the court.

Masimo appeals

On the same day as the final judgment was entered, Masimo filed a notice of appeal at the US District Court for the Central District of California.

The filing lists several orders dating back to 2021, including a 2023 order regarding lost profits, a 2024 ruling on claim construction, and the latest final judgment entered on July 20.

A Knobbe Martens team is representing Masimo, which was acquired by Danaher in an all-cash transaction valued at approximately \$9.9 billion that was completed in June this year.

Apple—represented by Wilmer Hale—said last year that it disagreed with the jury verdict and planned to appeal.

In separate proceedings earlier this year, Masimo failed to convince the International Trade Commission (ITC) to reinstate an import ban on redesigned Apple Watches.

Masimo also sued US Customs and Border Protection in August 2025 for "unlawfully" allowing imports to the US of the redesigned watches—a case that was dismissed with prejudice in April. **ip**

IMAGE: SHUTTERSTOCK.COM / MICHAEL VI



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PATENTS

‘Record breaking’ intangible asset investment exceeds \$10trn

INVESTMENT IN INTANGIBLE ASSETS HAS SEEN A “RECORD-BREAKING RISE” as new figures show that it exceeded \$10 trillion for the first time in 2025, with the US taking the lion’s share at almost half of the total.

The World Intellectual Property Organization (WIPO) and Italy’s Luiss Business School (LBS) published the details in a report on July 8.

It shows that intangible investment now accounts for nearly 13% of GDP across the economies covered, having grown by 5.5% annually between 2020 and 2025, compared with 3.2% for tangible investment.

Fuelling this growth was rising investment in software, data, brands and other IP-backed assets, despite a lag on spending on machinery and buildings under tight financing conditions and economic uncertainty, said the report authors.

The third edition of the *World Intangible Investment Highlights* covers 29 high and middle-income economies, collectively representing 57% of world GDP. This includes first-ever estimates for Canada and the Philippines and updated figures for Brazil, India and Japan.

Japan was the second-largest investor, pumping \$810 billion into intangibles in 2024, followed by Germany, which invested \$695 billion.

Sweden, the US and France lead in terms of intensity, while India, Japan and the Philippines recorded the fastest growth.

But not all countries showed increased investment in intangibles. The five high-income economies where tangible investment outpaced intangible investment between 2015 and 2025 were Italy, Latvia, the Netherlands, Portugal and Slovenia.

Mature and emerging economies

WIPO director general Daren Tang said: “This record-breaking rise in intangible asset investment...cuts across both

mature and emerging economies”.

He added: “This data shows that countries and businesses are increasingly turning to innovation, technology and creativity to drive growth.

“I hope that the report gives decision makers insights into these trends and help them put in place the right policies, practices and programmes to support their innovators and creators.”

Companies and government entities in the US invested nearly \$5 trillion in intangibles in 2025, according to the findings.

And the gap between the US and the next four economies (Japan, Germany, France and the UK) combined has roughly doubled over the past decade, from about \$1 trillion in 2015 to \$2 trillion in 2025.

Japan’s rise to second-biggest investor “marks a clear change in its investment mix”, said the report, with stagnating tangible investment. Its intangible investment grew by 4.8% in 2024, faster than in other major high-income economies such as the US, Germany and France.

And emerging economies are proving to be growing strongly as investors

This data shows that countries and businesses are increasingly turning to innovation, technology and creativity to drive growth.

Daren Tang, WIPO

of intangible assets, as official data revealed for the first time that intangible investment is growing strongly beyond high-income countries.

In India and the Philippines, intangible investment grew by 5.3% and 3.9% annually over the past decade respectively, exceeding the growth recorded in several high-income economies.

Brazil ranks among the world’s largest intangible investors, with \$312 billion invested in 2023.

An AI-driven revolution

The findings also unveil how artificial intelligence (AI) is accelerating investment in both intangible and tangible assets.

“After years of weak growth, tangible investment is regaining strength—but the revival is narrow” and “remains geographically concentrated, particularly visible in the US,” said the report authors.

Data centres, semiconductors, power systems and networks required to run advanced AI models have largely driven this trend.

But the broader wave was seen in intangible investment, as firms invest in data, software, R&D, brands, organisational capital and training.

Cecilia Jona-Lasinio, professor at Luiss Business School and co-author of the report, said that “AI is not just a new technology. It is changing how knowledge itself is produced, making intangible investment the key to understanding its economic impact.

“AI runs on intangibles like data, software and organisational know-how, and it reinforces them: it makes them cheaper to produce, widens the range of activities they can transform, and in doing so encourages firms to invest even more in them.

“Yet much of this investment, particularly organisational capital, brands and training, still goes unrecorded in official statistics. Without better measurement of these assets, we will keep underestimating what AI actually contributes to our economies and miss the policies needed to make the most of it.”

The report, showing quarterly and annual figures, is produced under the WIPO–LBS Partnership on Intangible Assets in the Global Economy. **ip**



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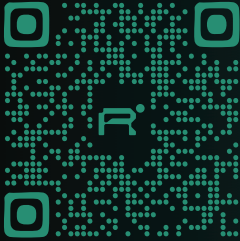
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WINSTON TAYLOR'S UK HEAD OF IP ON PITCHING \$1.75BN FIRM'S 'HUMBLE, BUT LETHAL' PRACTICE

A transatlantic firm with intellectual property at its heart—what's not to like? The firm's 30-year veteran tells *WIPR* why leading a recruitment drive is a "big responsibility" as the combined firm looks to out-scale the opposition.

IMAGE: SHUTTERSTOCK.COM / SS STD

It is unbelievable where I started to where we are." When Niri Shan joined Taylor Joynson Garrett in 1993, the UK firm counted perhaps 30 partners and a turnover of £30 million (\$40.44 million).

More than three decades later and still in the honeymoon period following a mega-merger with Winston & Strawn, Shan is reflecting on leading the UK arm of a critical practice for the combined firm.

Unusually for a transatlantic tie-up, intellectual property (IP) played a significant part in making Winston Taylor happen. The US side of the equation counted as one of the world's busiest patent litigation teams, defending more clients in patent trials than any other US law firm from 2020 to 2024.

While in the UK, Taylor Wessing's IP practice was a pan-European success story, strong in areas such as life sciences and tech litigation, brand protection and enforcement, and copyright, media and entertainment.

Shan is a media litigator by

trade, working for broadcasters and newspapers, and a confident and articulate interviewee.

So when questioned about the rationale behind Winston Taylor and stickier topics like partner exits and cultural integration, he is calm and steadfast about the positive aspects of the transition.

Recruitment drive

The firm he now works for boasts 1,400 lawyers, 200 IP partners and a turnover of \$1.75 billion. Shan is clear about one thing: IP is a cornerstone of Winston Taylor's future.

"There's a lot of investment appetite within the senior management of the new firm to invest in IP."

In addition, Shan's position on the global executive committee gives him a "degree of influence on behalf of the group", he adds.

It's a pitch he is using more these days—he is on the hunt for recruits.

Shane Gleghorn, the ex-managing partner of Taylor Wessing who now heads up

Europe and Middle East for WT, is "heavily involved" in the hires Shan is talking to. It helps when your boss—a banking and fraud litigator by trade—can speak "fluently" about the Unified Patent Court (UPC).

"One of our straplines is 'humble but lethal'—I think that does describe us. We're quite understated in the way that we operate, but there are lots of impressive partners in the firm."

And Shan says that both pre- and post-merger, partners at other firms have shown interest in joining.

Transatlantic mergers driven by corporate or finance teams are creating opportunities for Winston Taylor, as talented and seasoned practitioners find themselves on uncertain ground and potentially looking for a new home.

"There are a lot of IP partners in those big firms that are thinking, 'where do we fit now? Have I gone lower down the pecking order here because the firm is doubling down in corporate and finance?'"

"I think we've got a great 'sell' to the market given that we're going

to be this huge firm, but with a real focus on IP.

"There are a lot of European firms that are in the mid market that are looking to do US mergers, but haven't been able to achieve that. There are a lot of partners in those firms that are looking for a platform like ours because we have the US piece now.

"And there are lawyers in the US who are also looking at us, because IP is not a focus for their firms."

It is not just about the money, he adds. "Nine out of 10 times, it's how important IP is in this firm, and the reputation of the firm in IP."

IP at the heart

But first, a recap. Why did the firms merge?

"The fundamental point is, I think we're just in a much better position to service our clients in a more global way, and that is very important to us given the nature of our client base," he explains.

On the trademarks side, being able to serve multi-jurisdictional portfolios means having that US



I think we've got a great 'sell' to the market given that we're going to be this huge firm, but with a real focus on IP.

Niri Shan,
Winston Taylor

business is important. And to beat competition from boutiques and big firms, you need scale—the kind that only a \$1 billion-plus revenue firm can command.

With this in mind, Shan confirms that Winston Taylor is likely to be spending more on artificial intelligence (AI), particularly in the area of trademark portfolio management.

Taylor Wessing used Legora, but it also still operates bespoke systems. WT's investment will be "significantly more" than TW was able to manage.

But Shan insists that the sheer number of employees is as important as any IT solution.

"We're very focused on how we can have the most optimal leverage to make the whole process as cost-effective as possible," he says.

"That was one of the drivers for the merger. We understand that you need scale to be able to make these big investments. And now we've got that scale in a way that a lot of our previous competitors don't have."

Shan suggests the merger is adding heft in all areas, so Winston Taylor's bank of paralegals and teams spread across offices, including in London, Liverpool, and Cambridge, is perhaps a good bet.

The firm is also increasingly using AI to make the process as cost-efficient as possible, because actually trademark prosecution work "lends itself" to applying technology, says Shan.

New firm, new faces

Although it is not fair to speculate on people's reasons for leaving, the senior teams at Winston & Strawn and Taylor Wessing saw significant changes immediately pre- and post-merger.

A strong reason for any US firm to join with a UK player is the UPC. UPC experience is increasingly important for patent owners looking to enforce in Europe, and partners with experience at the court are coveted.

Winston Taylor's UPC practice

looks different, in personnel and on paper, after the German and French offices left the firm and now serve their former parents through a cooperation agreement.

WT still operates its 100-lawyer Benelux office.

Over 2025/26, 12 lawyers, including five equity partners, left Taylor Wessing Germany to found UPC boutique, Pentarc.

The legacy firm's UPC offering already looked different at that point. In June 2025, Taylor Wessing's Benelux office benefited from a triple hire courtesy of Simmons & Simmons.

A month earlier, Taylor Wessing's Paris office, now under a cooperation agreement with WT, drafted in a patent team led by ex-Pinsent Masons partner Jules Fabre.

Benelux, alongside its contracted colleagues in Paris and Munich, will be critical to WT's combined UPC offering.

In the US, Winston & Strawn saw a group of 17 leave for King & Spalding, including 11 partners, in February this year.

This was followed by a trio of seniors, among whom was co-chair of the Global IP practice, Jennifer Golinveaux, who joined Alston & Bird.

April saw a litigator join WT from Sidley Austin, then in May, Fenwick recruited Krishnan (KP) Padmanabhan and Scott Border in New York and Washington, DC.

Meanwhile in July, the newly-minted Winston Taylor welcomed four DLA Piper IP partners to its litigation practice—"with more to come", insists Shan.

Amid the merry-go-round of hires and leavers, Shan distinguishes the US and UK sides of the business. The US movers were during "one of the most active periods" of partner moves the market has seen, he says.

The lack of restrictive covenants means "someone can walk out the door one day and join the next", he says. It works both ways, and he praises the ex-DLA Piper crew for bringing a book of business and "hitting the ground running".

"Sophisticated clients are used to that sort of movement in the US market, and I don't think the level of movement is unusual."

In the UK, it's worth noting Taylor Wessing hired the experienced Jeremy Drew from RPC around the time the partners voted in favour of the merger.

"On the European level, I think the team is very stable, and actually we've had a lot of new joiners," says Shan.

"One of the key drivers of the merger was the strength of the IP practice, both in the US and in Europe. And the firm is focused on investing in that."

Culture: 'We did the due diligence'

Among the long list of must-have elements that make a successful law firm merger, clients and culture are up the top.

Shan is glowing about the US side of the deal on both. The legacy firm had plenty to shout about on the client side and claims the Hikma 'skinny label' case handed down by the Supreme Court in June this year among its successes.

A team with Charles Klein leading arguments before the Justices won it for Hikma, in a case that had a big impact on generic drug makers in the US.

Winston's anti-trust practice is also "top rate", says Shan, as evidenced by Paramount Skydance bringing in Winston Taylor co-executive chairman Jeffrey Kessler to defend its acquisition of Warner Bros. Discovery.

"If you're talking about complementary areas, antitrust and competition is one that is really important to IP."

And the UK side of the business is interested in its new sibling's brand litigation work, particularly around comparative advertising, which is more often seen in the US.

Does the risk of losing the established culture post-merger worry him?

"No, because we did so much



IMAGE: SHUTTERSTOCK.COM / LUCA PBI

We were in a very fortunate position to be a very attractive merger partner to US firms, and we've had a lot of approaches.

due diligence before the merger. We were in a very fortunate position to be a very attractive merger partner to US firms, and we've had a lot of approaches."

Both firms did a "deep dive" on each other's culture and liked what they saw.

"We spoke to a number of people as part of the process. And now we're merged, everything that I saw beforehand has then continued. I think their culture is

very similar to ours."

The prize on both sides of the Atlantic is the same.

"We want to be the premier global IP law firm. And when I mean IP, it's the whole sort of suite of IP services, the life cycle from IP strategy, filing, through to litigation."

And from a size and revenue perspective?

"Be considerably bigger than we are now," says Shan. **ip**

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JACK DANIEL'S LOSES LATEST ROUND IN 'BAD SPANIELS' TRADEMARK SAGA

A US appeals court has ruled that the drinks brand failed to prove that a **parody dog toy damaged its reputation**, raising the evidential bar for brand owners bringing trademark tarnishment claims.

In a blow for Jack Daniel's, the US Court of Appeals for the Ninth Circuit unanimously overturned a previous ruling favouring the whisky maker, holding that a dog toy did not unlawfully dilute or tarnish its mark.

The decision, handed down on August 4, is the latest in a protracted legal clash over a squeaky dog chew toy manufactured by VIP Products, known as 'Bad Spaniels' that mimics the square-shaped bottle of Jack Daniel's Tennessee Whiskey.

In 2014, VIP Products sought a declaration of non-infringement, with the Arizona District Court ruling for Jack Daniel's in 2018.

The Ninth Circuit reversed that decision in 2020 on First Amendment grounds, but the US Supreme Court ruled in 2023 that the lower court had applied the wrong legal test and sent the case back without deciding the ultimate outcome.

In 2025, an Arizona district court again sided with Jack Daniel's and imposed a permanent sales ban, before the Ninth Circuit overturned that ruling in August.

'We can laugh again'

But this latest decision effectively lifted the permanent injunction that had prevented sales of VIP Products' toy.

As Matthew Hintz, trademark and copyright partner at Lowenstein Sandler, put it: "The Ninth Circuit has let us know we can laugh again."

The Ninth Circuit has let us know we can laugh again.

Matthew Hintz,
Lowenstein Sandler

After finding no convincing evidence that the toy's toilet humour caused genuine harm to Jack Daniel's reputation, the appeals court rejected the argument that references to dog faeces would create the same level of consumer revulsion as similar imagery on a food or drink product.

Hintz explained: "The court clarified that proving fame for dilution by tarnishment is by individual mark under the TDRA (Trademark Dilution Revision Act).

"The court also characterised Jack Daniel's expert's conclusion as 'pure conjecture' with no evidence in the record for the court to infer that scatological references made on a dog toy have the same potential to generate disgust as identical references on a consumable product."

Insufficient weight given to parody

Further, the court criticised Jack Daniel's expert evidence for relying on broad theories of consumer behaviour rather than proof of actual reputational damage.

The judges also said the lower court had failed to give sufficient weight to the toy's obvious status as a parody when assessing trademark tarnishment.

The latest judgment reinforces that owners of famous trademarks cannot rely on the strength of their brand alone to defeat parody-related products.

Instead, they must present

specific, context-based evidence that the alleged parody has caused genuine reputational harm in order to succeed on a claim of trademark tarnishment.

Sherli Furst, a partner at Ellenoff Grossman & Schole, said that the Ninth Circuit's decision confirms that "the Supreme Court's *Jack Daniel's* ruling did not sound the death knell for trademark parody, it simply changed where the battle is fought.

"Identifying use may bring a parody within the Lanham Act, but it does not predetermine liability; and mere offensiveness, or an unwanted association with a famous brand, is not necessarily tarnishment.

"That distinction will become increasingly important as brands confront memes, parody products, and other commercial expression[s] that deliberately borrow from the visual vocabulary of famous marks."

Hintz added that the opinion ultimately raises the bar for expert testimony on dilution, because "the plaintiff must present evidence tying the alleged harm to the specific junior mark and product at issue".

He concluded: "Any expert analysis that ignores the parodic context of a junior mark is likely to be rejected as incomplete.

"A clear, obvious parody effectively increases the plaintiff's burden to prove reputational harm, making it harder for brand owners to shut down humorous or satirical products."

The case is *VIP Products v Jack Daniel's Properties*, No. 25-2027. **ip**

TESLA VICTORY 'SHIFTS BALANCE TOWARDS IMPLEMENTERS'

By allowing Tesla's appeal against InterDigital and its licensing platform Avanci over patent royalty rates, the UK's highest court has **altered the course of global SEP disputes** heard in England & Wales.

Tesla could now be closer to rolling out its 5G connected vehicles in the UK after securing a major victory at the UK Supreme Court in July.

In a unanimous decision delivered on July 27, the country's highest court decided to allow the electric automaker's appeal against InterDigital and patent pool Avanci, in its dispute over standard-essential patent (SEP) royalty rates.

Crucially, the ruling means that English courts now have jurisdiction to determine claims challenging the FRAND rates offered by SEP holders as part of pool or platform joint licensing.

A victory for Tesla, but it hasn't won yet

After bringing proceedings in 2023 against SEP holder InterDigital, a member of the Avanci 5G platform, Tesla seeks a declaration that the rate of \$32 per vehicle offered by the Avanci pool for a 5G global licence is not FRAND.

The five judges found that:

(i) Tesla has a real prospect of successfully arguing that (a) the FRAND obligation applies to a pool licence offer; (b) the only FRAND licence under InterDigital's UK SEPs on the Avanci platform is a pool licence; and (c) declaratory relief can fairly and properly be granted.

(ii) Tesla's claim is properly characterised as relating principally to InterDigital's UK SEPs on the Avanci platform.

(iii) Tesla's claim was properly served on InterDigital.

(iv) In the related US proceedings, the Delaware Court of Chancery was not an alternative available forum for the determination of the dispute.

However, whether or not Avanci's 5G offering is actually FRAND will be heard at trial.

'Sensible, pragmatic relief'

Simmons & Simmons partner Joel Smith, based in London, said that the decision is a "timely reminder of the UK court's ability to provide a remedy to parties in global (F)RAND patent disputes, especially in the tech sector.

"It demonstrates (again) the ingenuity and willingness of UK judges to provide parties with sensible, pragmatic relief, away from trading threats of cross-border injunctions."

Smith's colleague in Paris, partner Abdelaziz Khatab, warned that: "Parties facing similar SEP disputes, especially those with exposure to large periods of purported unlicensed use, should approach FRAND hearings with careful consideration of industry context, evidential precision, and flexibility in negotiating position."

'Significant implications' for tech

John Brunner, a partner at Carpmals & Ransford and head of the Patent Tech Group, called it "a big judgment", arguing that it will have significant implications for emerging tech companies looking to protect their assets.

"It overturns the successful defences brought by Avanci and

[Implementors] need not wait to be sued for patent infringement before seeking a court determination of FRAND terms.

John Brunner,
Carpmals & Ransford

InterDigital against Tesla's claims in the High Court and Court of Appeal," he said, "even though the experienced patent judge on the Court of Appeal (LJ Arnold) had heavily dissented to the Court of Appeal's earlier judgment on the three-judge panel."

The judgment makes the UK "the forum of choice for SEP licensing disputes", he said, adding that "the balance of power in SEP licensing has shifted towards implementers".



Brunner explained that implementers can now proactively sue to challenge SEP platform rates as non-FRAND—"they need not wait to be sued for patent infringement before seeking a court determination of FRAND terms."

Previously, "an implementer unhappy with a platform rate had two realistic options: pay it, or walk away and risk infringement proceedings", explained Brunner. This judgment creates a third option, he said: "Sue first and ask the court to set the rate. That fundamentally changes the negotiating dynamic in every SEP licensing discussion worldwide that touches UK patents." **ip**

TAKEAWAYS

- 'Big judgment' has implications for emerging tech firms
- UK is 'forum of choice' for SEP licensing disputes
- Implementers can sue to challenge platform rates

'DON'T DO IT': HOW NIKE'S LAUNCH LOST ITS FOOTING OVER A 7-ELEVEN LAWSUIT

A high-profile trainer launch was scrapped after convenience store giant 7-Eleven accused the sportswear brand of copying its distinctive branding in a trademark dispute that goes far beyond a colour scheme.



IMAGE: SHUTTERSTOCK.COM / HAFKOT

July 11 was meant to be a big day for Nike. The launch of a special edition Air Max 95 was to be accompanied by the usual fanfare for passionate sneaker fans looking to snap up a streetwear classic in an unusual colourway.

Instead, the sportswear brand was forced to put a big red X through the date after global convenience store giant 7-Eleven filed a trademark infringement lawsuit in Texas and Nike swiftly pulled the planned release.

The retailer claimed that the shoe's green, orange and red colour scheme, along with convenience store-inspired design details, closely resembled its distinctive branding. It also argued that the intended release date—known in the US as '7-Eleven Day'—could mislead consumers into believing it was an official collaboration.

It's fair to say the fallout has created a significant headache for Nike. Not only was the company forced to withdraw the Air Max 95 'Big Bubble' before launch, it must also now absorb production, marketing and distribution costs for the cancelled roll-out.

TAKEAWAYS

- 7-Eleven sued Nike over colourway
- Contextual factors could be key
- Agreements can strengthen brands

What's more, the legal action fuelled demand on the resale market, with prices for early pairs rising sharply following news of the cancellation—the product is currently selling on sneaker trading website StockX for more than \$500.

Beyond the financial implications, the case has generated negative publicity and legal costs, marking the second failed 7-Eleven-related Nike release after an official collaboration planned in 2020 was scrapped.

More than a colour scheme

Lee Curtis, partner at HGF, tells *WIPR* that despite initial appearances, the fallout is more than a squabble between two major brands over a colour scheme.

"I must admit, when I first saw the news of 7-Eleven's claim against Nike, I thought what was 7-Eleven's problem? However, when one delves deeper into the claim, one can understand 7-Eleven's position much more clearly and I do have some sympathy," he says.

Notably, 7-Eleven claims that the colourway at issue is not

solely restricted to retailing, and the disputed colour scheme has already been used on clothing, footwear and headgear.

"7-Eleven has collaborated in the past with prominent footwear and sporting goods brands such as Crocs, Sunday Golf, Breezy Golf and the skate-boarding brand DGK in the use of the colourway.

"Also, what may have rubbed salt in 7-Eleven's wounds is that it claims that Nike's e-commerce app 'SNKRS' scheduled the release of the product for July 11, 2026 or 7/11, which is also well known as '7-Eleven Day' or 'Free Slurpee Day' in honour of 7-Eleven."

Further, 7-Eleven had originally planned an official Nike SB Dunk Low collaboration for the 2020 Tokyo Olympics, but scrapped the project after COVID-19 delayed the event.

"What is clear is that the parties' commercial activities are much closer to each other than one might have originally thought and it will be interesting to see how this dispute over a colourway will pan out," says Curtis.

Why context matters

According to trademark search

and monitoring platform GleanMark, data held by the US Patent and Trademark Office tells a more nuanced story than many might expect.

The company found 113 active registrations—held by 95 unique owners—claiming orange, green, red and/or white, so the colours themselves are not unique.

However, when GleanMark narrowed the search to registrations describing those colours as stripes, rectangles or lines, there were only 14 registrations across all classes.

In fact, in Class 35 (covering business, administrative, and advertising services) every registration matching that description belongs to 7-Eleven.

For Gavin Strube, senior counsel at Greenspoon Marder, 7-Eleven "appears to have a plausible trademark and trade dress claim", particularly because it is not relying solely on the use of colours in the abstract, but rather on a specific arrangement of coloured stripes or bands.

"The complaint alleges that Nike adopted a combination of visual elements that consumers closely associate with the 7-Eleven brand,

including the orange, green and red stripe configuration, alongside other contextual references," says Strube.

Even though Nike has not used the 7-Eleven name or logo, he notes that trade dress can itself constitute "explicit branding" if recognised as a valid trademark.

While the protectability of trade dress can be "exceedingly difficult" to establish, brands that are able to demonstrate long-term, exclusive use and strong consumer recognition can find that such protections "can also be incredibly strong and build immense value in a brand".

Strube explains that a successful outcome in this scenario usually hinges on a highly fact-specific examination rather than solely on existing case law.

"The parties will have to submit significant evidence—most likely in the form of consumer surveys—that consumers not only recognise 7-Eleven's tri-colour branding as a trademark, but that they perceive Nike's products as either originating from or being sponsored by 7-Eleven."

Contextual factors, according to Strube, could prove extremely important in such cases.

"Trademark cases do not generally focus on side-by-side comparisons of particular design elements, but rather on the overall commercial impression of a mark.

"The contextual factors go to that overall commercial impression—tying the shoes to 7-Eleven's established marketing practices—as well as the intentionality of Nike's conduct."

Nike's possible defence

On the other hand, Withers IP counsel Emily Borich points out that there are technical defences in Nike's toolbox given "the cautious jurisprudence surrounding colour marks".

For example, trainers and convenience stores are unrelated industries, and Nike could argue the colours are not being used in a

What is clear is that the parties' commercial activities are much closer to each other than one might have originally thought.

Lee Curtis, HGF

trademark manner but rather as a functional element.

"There are likely many fashion brands that incorporate colours as a design element that may be protected by other famous brands, such as Tiffany blue, UPS brown and T-Mobile pink."

However, she notes that 7-Eleven does not have "the most ubiquitous or aesthetic colour combination", and the additional facts of the July 11 release date and marketing language that could lead consumers to believe this is a collaboration between two famous brands "are problematic".

Courts, she adds, "increasingly look to market realities and less on relatedness of goods and services, particularly when famous brands that are granted broader protection are involved".

'Don't do it'

Looking beyond this dispute, what lessons should brand owners take from the case before drawing inspiration from well-known brands or cultural touchstones?

For Strube, the lesson is a straightforward one.

"Quite simply: don't do it. Even if there are strong and valid defences to a claim of trademark or trade dress infringement, asserting those defences and emerging victorious is a long and costly process.

"It is far better to enter into an agreement with the owner of the 'inspiration' that can strengthen both brands."

Curtis concludes that 7-Eleven's allegations that Nike sought to take advantage of its brand reputation raise difficult questions about intent and consumer perception.

"The question of whether this was a homage to 7-Eleven, a marketing idea gone wrong or simply trading off 7-Eleven's reputation is open to debate.

"However, if this is true, I doubt that it would paint Nike in a good light with any judge of this case, if it gets that far." **ip**

IP IN RUSSIA: FACTS, FICTION AND STRATEGIC GUIDANCE

Global stakeholders face a fundamentally altered risk profile in the country—but engaging is vital to protect rights, says **Riikka Palmos** of Papula-Nevinpat.

Russia's intellectual property (IP) system is often viewed through sharply contrasting narratives.

One view suggests that IP rights have effectively ceased to exist in Russia. Another assumes that foreign rights holders can safely ignore the market because sanctions and geopolitical developments have fundamentally altered the legal landscape.

Neither view fully reflects the current situation.

In 2026, Russia's IP system continues to function. At the same time, foreign rights holders face practical challenges that make the maintenance and enforcement of IP considerably more demanding than before 2022.

The most important question for international businesses is therefore not whether IP rights still exist in Russia, but whether they are prepared to manage those rights actively.

Fact: Russia's IP system continues to operate

One of the most common assumptions is that sanctions have rendered IP protection ineffective in Russia. This is not the case.

Rospatent continues to process applications, while courts continue to hear cases concerning the validity of IP rights. Foreign applicants continue to maintain protection through both national filings and international

registrations. Recent filing activity also demonstrates that IP remains commercially relevant for both domestic and foreign businesses.

Moreover, it is not accurate to suggest that all foreign companies have left the Russian market. While many international businesses have suspended, reduced or restructured their operations, numerous foreign brands remain active. Others continue to maintain IP portfolios even where commercial operations are limited. The increase in foreign trademark filings and re-filings demonstrates that many businesses still consider Russian IP rights worth preserving.

For some companies, Russia remains an active market. For others, maintaining IP protection is about preserving future strategic options.

Fiction: Withdrawing from the market eliminates IP risk

A common assumption is that companies that have reduced their commercial activities in Russia face fewer IP risks. In reality, the opposite may be true.

Businesses that have withdrawn or scaled back operations often face increased exposure to non-use cancellation actions, bad-faith trademark filings and unauthorised use of their brands.

Russian trademark law continues to require genuine use. A trademark may be challenged if it has not been

used for a continuous three-year period. Importantly, sanctions and geopolitical circumstances are generally not accepted as automatic justification for non-use.

As a result, many companies have discovered that withdrawing from the market does not eliminate IP obligations.

The rise of non-use cancellation actions

The most significant trademark development in Russia during 2025 and 2026 has been the growing number of cancellation actions based on non-use.

Many of these actions target foreign-owned trademarks and seek to remove earlier rights that prevent the registration of similar signs. Recent statistics indicate a significant increase in such proceedings.

At first glance, this trend appeared highly problematic for foreign rights holders. However, recent Intellectual Property Court decisions have introduced an important nuance.

The IP Court has increasingly examined whether claimants genuinely possess a legitimate commercial interest in obtaining cancellation. In several high-profile disputes involving internationally recognised brands, the IP Court focused not only on the question of trademark use but also on

whether the claimant was acting in good faith or merely attempting to exploit the reputation of an established foreign mark.

The *Nokia* (SIP-802/2024), *Michelin* (SIP-801/2024), *Hugo Boss* (SIP-1315/2024) and *Ray-Ban* (SIP-582/2025) cases illustrate this development. In all instances, the IP Court examined the claimant's interest and broader commercial objectives. Claims were dismissed where the claimant failed to demonstrate a *bona fide* commercial interest or where the action was considered abusive. In some cases, the IP Court did not even proceed to assess whether the trademark had been used.

This is an important development and provides a degree of protection against opportunistic challenges. At the same time, other non-use actions have succeeded where trademark use could not be established and the claimant demonstrated a legitimate commercial interest. Rights holders should therefore not view the recent case law as a guarantee. Non-use remains a genuine risk where evidence of use is unavailable or insufficient.

Parallel import nuances

Another area frequently misunderstood by international observers is parallel imports.

Russia has not introduced full international exhaustion of trademark rights. Instead, it operates a selective parallel import regime under which only specific products included in an official government list may be imported without the consent of the trademark owner. Products outside that list remain subject to ordinary trademark protection.

This distinction has important practical consequences. A rights holder may enjoy strong control over one product category while facing reduced control over another. The legal position depends not only on the trademark itself but also on whether the relevant products are included in the current parallel import framework.

Importantly, the regime is not

developing solely in the direction of liberalisation. In May 2026, more than 30 categories of products were removed from the parallel import list, restoring greater control to trademark owners in those sectors. This demonstrates that the framework remains dynamic and requires ongoing monitoring.

New enforcement battleground

Online marketplaces have become one of the most important fronts in IP enforcement.

Platforms such as Ozon, Wildberries and Yandex Market host both lawful parallel-imported goods and counterfeit products, often within the same product categories. This creates a significantly more complicated enforcement environment than traditional anti-counterfeiting work. Rights holders must distinguish between genuine goods entering the market through unofficial channels and genuinely infringing products.

The challenge is compounded by fragmented seller networks.

There are, however, signs of progress. Since April 2026, marketplaces have been granted direct access to Rospatent databases, enabling earlier verification of IP rights. Together with broader platform reforms scheduled for October 2026, these measures may gradually move enforcement away from a purely reactive system. Whether they will materially reduce infringement remains to be seen.

The overlooked challenge

For many foreign rights holders, the greatest practical challenge is no longer registration but evidence. Before 2022, proving trademark use was often straightforward. Goods moved through established distribution channels and documentation was generally available.

Today, products may reach Russia through indirect routes, distribution arrangements may have changed, and supporting documentation may be fragmented across multiple jurisdictions. In some situations, companies possess evidence that products are reaching



A common assumption is that companies that have reduced their commercial activities in Russia face fewer IP risks. In reality, the opposite may be true.

Riikka Palmos,
Papula-Nevinpat

the market but face greater difficulties proving admissible use under trademark law.

This evidentiary challenge plays a central role in non-use disputes and has become one of the key practical concerns for international brand owners.

Strategic guidance

The businesses that have been most successful in protecting their IP rights in Russia generally follow one principle: remain engaged.

Practical measures include monitoring trademark registers, maintaining evidence of use, reviewing licensing arrangements, recording assignments where appropriate, monitoring marketplace activity and assessing whether defensive re-filings may be justified for key brands. Companies should also ensure that IP strategy remains coordinated with compliance, legal and commercial decision-making.

Particular attention should be paid to trademarks that may become vulnerable to non-use cancellation actions. Rights holders should regularly assess whether sufficient evidence of use exists and, where appropriate, consider supplementary filing strategies to safeguard key brands and future business options.

Russia's IP landscape in 2026 is neither the environment that existed before 2022 nor a system in which IP rights have ceased to function.

Perhaps the biggest misconception about Russia is not that IP rights have disappeared, but that they continue automatically. Businesses that actively manage their portfolios can often preserve valuable rights and future strategic options. Those that disengage entirely may discover that rebuilding an IP position is considerably more difficult than maintaining one. **ip**

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BEHIND THE NUMBERS: CHINA'S NEXT PHASE OF IP DEMAND

Understanding the commercial objectives of the companies driving the filing volumes will be key to accessing significant future opportunities, says **Chris Li** of the Beijing International Intellectual Property Convention (IIPC).

For more than two decades, scale has dominated international discussion of China's intellectual property (IP) market.

The numbers remain difficult to ignore. In 2025, China was the world's largest source of international patent applications under the Patent Cooperation Treaty, with 73,718 filings. Applicants based in China also filed 5,636 international trademark applications through the Madrid System, down 4.9% from 2024 but still the third-highest total by origin. Collectively, these applications included 76,530 designations of Madrid System members, the highest number from any origin for the second consecutive year.

But these figures point to something more significant than filing volume alone. They reflect a growing number of Chinese companies protecting technology, brands and commercial interests across multiple markets.

Technology companies are expanding overseas operations, advanced manufacturers are becoming more deeply integrated into global supply chains, and Chinese brands are entering new consumer markets. For many innovative businesses, international

protection is also becoming relevant earlier in their development.

As their commercial footprint broadens, so do their needs for portfolio strategy, enforcement, transactions, disputes and trusted local advice across jurisdictions.

For the global IP community, the practical question is therefore changing. The size of the Chinese market remains relevant, but increasingly so does another question: which companies are entering which markets, and what expertise will they need when they arrive?

That is where headline statistics begin to turn into identifiable business demand.

In April 2027, Beijing will host the inaugural Beijing International Intellectual Property Convention (IIPC), bringing Chinese companies with international business needs together with IP professionals from China and overseas. Its development comes at a time when understanding China's IP market increasingly means looking beyond aggregate activity to the companies generating cross-border demand.

TAKEAWAYS

- Beijing will host inaugural IIPC in 2027
- Capital is 'point of access' to wider market
- Relationships are key to identifying demand

From filings to business demand

For international law firms, patent and trademark practices and other

IP advisers that have followed China for years, filing data is a starting point rather than complete market intelligence.

An opportunity becomes actionable only when it can be connected to a company, a destination market and a defined need.

Chinese companies should not be treated as a single category. Some already manage established overseas operations and substantial global portfolios. Others are entering their first regional markets, developing international brands or beginning to build formal relationships with advisers outside China.

Their requirements differ by sector, destination and stage of expansion. A technology company entering Europe may face questions around patents, freedom to operate, licensing or disputes, while a consumer brand expanding into Southeast Asia may be more focused on trademarks, enforcement and commercial arrangements.

The relevant distinction is therefore not simply whether a company is "international", but where it is going, how far its expansion has progressed and what capability it needs next.

Those details are difficult to capture through aggregate market data. Direct engagement can reveal jurisdictions under consideration, the timing of expansion, the decision-makers involved and the areas in which outside support may be required.

It also broadens the range of people involved. Cross-border IP decisions may sit with dedicated IP teams, but they can also involve legal, innovation, commercial and senior business leaders. As IP becomes more closely connected with market entry and international growth, IP strategy increasingly forms part of a wider business decision.

A more two-way market

China and the international IP market have long been closely connected. Foreign companies entering China, and international advisers supporting them, remain an important part of that relationship.

The overseas expansion of Chinese companies is strengthening the flow in the opposite direction.

As Chinese businesses enter Europe, North America, other parts of Asia and emerging markets, they require expertise in those jurisdictions. For an international firm, the opportunity associated with a Chinese client may therefore arise in its own home market rather than in China.

At the same time, Chinese IP firms serving internationally active clients need broader relationships with overseas counterparts. A single client, transaction or dispute may require coordinated advice across several jurisdictions.

This is making cooperation between Chinese and international professional firms increasingly important alongside direct relationships between companies and advisers.

The result is a more two-way and networked market, in which the traditional idea of "China work" becomes less useful. Chinese demand may originate in China, while the resulting professional work takes place across multiple overseas markets.

Beijing as a point of connection

China's innovation and business

activity is distributed across multiple regions. Shenzhen-Hong Kong-Guangzhou ranked first in the World Intellectual Property Organization's (WIPO's) 2025 global innovation cluster ranking, while Beijing ranked fourth, reflecting the depth of innovation across several of the country's major commercial centres.

For an inaugural convention, Beijing nevertheless provides a particularly concentrated point of access to that wider market. As the national capital, it brings together government and regulatory institutions, corporate headquarters, universities, research organisations, technology and innovation resources, and a substantial professional services community.

That professional depth is also reflected in IIPC's industry network. One of the convention's co-organisers, the Capital Intellectual Property Services Association (CIPSA), is a leading and broadly representative industry body in China's IP services sector. According to CIPSA, its membership includes more than 80% of China's large IP service organisations, including firms and institutions based not only in Beijing, but also in Shanghai, Guangzhou, Shenzhen and other major cities.

Beijing therefore serves here as a point of connection rather than a geographic definition of the market. The companies and professional networks relevant to China's next phase of cross-border IP demand are spread across the country's major commercial and innovation centres, while the markets they are entering extend far beyond China.

Closing the information gap

One of the practical challenges in an increasingly international IP market is not a shortage of expertise, but limited visibility between demand and capability.

Chinese companies may know where they want to expand without having a clear view of which advisers combine the right jurisdictional reach, sector experience and professional capability. International firms may recognise the broader growth of Chinese outbound business but have limited visibility into which



An opportunity becomes actionable only when it can be connected to a company, a destination market and a defined need.

Chris Li, IIPC

companies have defined plans and where specific needs are emerging.

Chinese professional firms face a related challenge when identifying reliable overseas partners for clients operating across multiple jurisdictions.

More information alone does not solve this problem. Effective professional relationships depend on a more specific understanding of where a company is going, what stage it has reached, what issues it expects to face and which advisers have relevant experience.

That is the context in which platforms such as IIPC can have a role. Their value should not ultimately be measured by the number of participants or introductions they can claim, but by whether they help companies and professional advisers identify relevant counterparties earlier and develop a clearer view of where real demand is emerging.

For any new industry platform, that is a more meaningful test: whether participants encounter relationships they would not otherwise have reached and leave with a better understanding of the market than they had before.

China's IP market no longer lacks evidence of scale. The next phase will increasingly be defined by what happens behind those numbers: which Chinese companies internationalise, which markets they enter, what IP challenges follow and how efficiently the resulting demand finds the right expertise.

For global IP practitioners, paying attention to China now means following the companies behind the filings, the markets they are entering and the professional networks forming around them.

A significant source of future IP demand may be taking shape in China, but its effects will be felt across markets far beyond China's borders. **ip**

Chris Li is global marketing director of the Beijing International Intellectual Property Convention (IIPC). He can be contacted at lica@chgje.com

IMAGE: SHUTTERSTOCK.COM AI GENERATOR

OpenAI

APPLE V OPENAI: A STRATEGIC PLEADING OR A PROCEDURAL MISSTEP?

In what could be the trade secrets dispute of the year, Apple and OpenAI both adopt unconventional—and statutorily curious—strategies in a ‘talent-raiding’ case with a difference, finds **Sarah Speight**.

Apple and OpenAI are locking horns in potentially one of the most important trade secret cases of the year. On July 10, Apple sued two former engineers and their new employer OpenAI in California, claiming they had stolen trade secrets relating to hardware devices.

After filing its complaint, Apple filed a motion for a preliminary injunction (PI) on August 3, barring OpenAI from using or retaining the allegedly stolen secrets and demanding the return of its intellectual property.

The iPhone maker also filed a concurrent motion seeking expedited discovery, including production of documents relating to the defendants’ alleged access of Apple’s proprietary and trade

secret information.

While you would normally associate OpenAI with software, the ChatGPT creator is developing hardware products through a company it acquired last year called io Products.

Since io Products’ founding, hundreds of Apple designers and engineers have left to “join OpenAI’s effort to design a new family of devices for the AI era”, according to OpenAI.

On the same day as Apple’s motion for a PI, OpenAI responded first with a publicly available blog titled *Apple is getting this wrong*, followed by a motion to dismiss Apple’s complaint.

Both documents reveal internal messages between the defendants and current staff at

Apple, and emails between internal and external counsel.

That alone is notable, but with myriad trade secrets cases involving ‘talent raiding’, what makes this case stand out?

Tech giant’s plea is a ‘strategic decision’

In its complaint, Apple names Chang Liu, former senior system electrical engineer, and Tang Yew Tan, former VP of Product Design who has become OpenAI’s chief hardware officer.

It also names three OpenAI entities—the OpenAI Foundation (the non-profit entity of OpenAI); OpenAI Group PBC (the for-profit public-benefit corporation side of the business); and io Products.

Apple claims that the

defendants solicited prototypes and technical details from job candidates, downloaded internal documents, and used confidential information in discussions with Apple suppliers.

The California-based company pleads four separate claims under the Defend Trade Secrets Act (DTSA)—one each against Liu, Tan, OpenAI, and io Products. It also pleads two breach-of-contract claims against the individuals under Apple’s Intellectual Property Agreement.

But as James (Jim) Gale, ranked in *WIPR*’s USA Trade Secrets Rankings, points out, Apple makes no claim under the California Uniform Trade Secrets Act (CUTSA)—despite having filed the complaint in that state.

“California has one of the most robust trade secret statutes in the nation,” he tells *WIPR*, “and I think that that was a strategic decision”.

OpenAI, also based in the ‘Golden State’, points out in its motion to dismiss Apple’s complaint that “California law and policy not only permit but encourage such employee mobility”.

Under the DTSA, complainants usually have to describe their trade secrets with ‘particularity and specificity’, even in federal court.

But by not pleading CUTSA, Apple is “trying to avoid having to plead with ‘specificity and particularity’ later on,” suggests Gale, chair of Cozen O’Connor’s Trade Secrets Group and co-chair of the firm’s Intellectual Property Litigation Group.

A publicity piece?

Together with its public blog, OpenAI’s motion to dismiss is “a publicity piece”, reckons Gale.

“It is two things: a publicity piece for the media, and an attempt to take two bites at the apple in opposing the motion for preliminary injunction.”

He adds that “typically, the best defence is an aggressive offence”.

Avery Williams, co-chair of

the trade secret practice area at McKool Smith and author of the firm’s AI Litigation Tracker, echoes this view.

“Open AI’s PR department is on the offensive, making Apple look like they didn’t do their homework,” he tells *WIPR*.

“I don’t know anything about the truthfulness of the allegations here, but I can say that this wouldn’t be the first time a plaintiff misinterpreted cloud-access or download logs at the head of a trade-secret case.”

He adds that this also isn’t the first time OpenAI wrote a blog about one of its cases, doing the same thing for the *New York Times* lawsuit.

“I wouldn’t say it’s a typical litigation practice, but these aren’t typical cases in terms of profile and public impact.

“As for the chat logs, I suspect we’d see all this in the response to the motion for preliminary injunction anyway, but the blog makes it far more accessible.”

OpenAI’s ‘extraneous evidence’ is ‘totally inappropriate’

In its blog and motion to dismiss, OpenAI denies any interest in Apple’s proprietary information and refutes the allegations, describing the lawsuit as “careless, aggressive and oddly personal”.

OpenAI added that “Apple’s request for a preliminary injunction is both based on false information and completely unnecessary because we do not have, nor want, any of their trade secrets.”

But Gale points out that in its motion, OpenAI “tries to challenge the accuracy of the facts alleged in the complaint, which is what you do in an opposition to the motion for preliminary injunction.”

Under well-established US law, “you can only challenge what is within what we call the ‘four corners of the complaint’.” In other words, the court is limited to looking solely at the factual allegations set out in the complaint.”

And those facts are ones that

The court will cut through this like a hot knife through butter.

Jim Gale,
Cozen O’Connor

the court can “judicially notice”, explains Gale, meaning they are inherently indisputable, such as court records and public governmental filings.

“You cannot bring in extraneous evidence,” he adds. “This is totally inappropriate on a motion to dismiss. All of that factual evidence should go in the opposition, which isn’t due until August 17.”

Has Apple taken reasonable measures?

OpenAI argues that “Apple’s request for a preliminary injunction is both based on false information and completely unnecessary because we do not have, nor want, any of their trade secrets. We’re much more interested in building innovative products and technologies that push the frontier.”

But according to Gale, OpenAI is “injecting facts” into their defence. “They’re trying to raise a factual dispute as to whether Apple took ‘reasonable measures’ in protecting their trade secrets. That’s a requirement of a claim for misappropriation.

“‘Reasonable measures’ is a factual issue—not appropriate for a motion to dismiss. It doesn’t mean that you need absolute measures, which is what OpenAI is suggesting.”

Gale adds: “If I were the judge, I would deny the motion to dismiss.

“And quite frankly, I would not be happy with defence counsel for knowingly going ahead and violating one of the basic tenets of law.

“Even if OpenAI was able to convince the judge that Apple was missing an element of its claim, all the judge would do is dismiss the complaint without prejudice, with the ability for Apple to come back and re-plead it with the missing elements.

“So even if OpenAI wins, it would be a pyrrhic victory because Apple gets to re-plead. In my opinion, the court will cut through this like a hot knife through butter.” **ip**

Open AI’s PR department is on the offensive, making Apple look like they didn’t do their homework.

Avery Williams,
McKool Smith

MCDONALD'S FAILS TO DEFEND TMS IN UK AGAINST IRISH FAST-FOOD CHAIN

McDonald's relied on decades of reputation to take on an Irish fast-food chain rival, but a UK court has decided just how far its famous marks could reach.

McDonald's has failed to defend its famous family of 'Mc' and 'Mac' trademarks after a UK ruling found no likelihood of confusion between an Irish fast-food chain's trademarks and the fast-food giant's McCafé and Big Mac brands.

The UK Intellectual Property Office (UKIPO) dismissed McDonald's challenge to two trademark applications filed by Supermac's, clearing the way for its name and stylised logo to be registered for restaurant, takeaway and fast-food services.

In a decision dated July 31, 2026, hearing officer June Ralph rejected McDonald's arguments that consumers could confuse the brands or believe they were commercially connected.

For brand owners, the decision sheds light on the limits of relying on a well-known family of trademarks when the marks themselves are not close enough to cause confusion—even for a brand with the reputation and recognition of McDonald's.

A name with a history

Supermac's filed two UK trademark applications in April 2021—one for its name and another for a stylised version of its logo.

McDonald's challenged the applications, relying on its registered rights in McDonald's, Big Mac, McCafé and Grand Big Mac, as well as unregistered rights in several of its best-known brands.

But the Supermac's name has a history stretching back decades.

Founder Pat McDonagh said he

A key part of McDonald's case was its claim that its trademarks formed a recognisable 'family' built around the 'Mc' prefix and 'Mac' name.

first used the name in 1978 when he opened his first restaurant in Ballinasloe, Ireland.

The name came from a childhood nickname that combined a play on 'Superman' with a shortened version of his surname.

McDonald's, meanwhile, pointed to the sheer scale and recognition of its business in the UK.

Evidence from its head of menu, Thomas O'Neill, showed that annual UK turnover had topped £1 billion (\$1.3 billion) since 2006, while the company spent more than £500 million on advertising between 2015 and 2020. By 2019, its UK network had grown to around 1,300 restaurants.

The hearing officer accepted that McDonald's had built up a strong reputation and distinctiveness in its trademarks through years of use.

She also found that the restaurant and fast-food services covered by Supermac's applications were identical to those protected by McDonald's trademarks.

There was some overlap with the 'Big Mac' mark too. Hamburgers, cheeseburgers and similar products were considered complementary to Supermac's restaurant and fast-food services, although only to a medium degree.

'Family' of trademarks falls short

A key part of McDonald's case was its claim that its trademarks formed a recognisable 'family' built around the 'Mc' prefix and 'Mac' name.

The company argued that consumers had become so familiar with this pattern that they could assume similarly structured trademarks were connected to McDonald's.

But the hearing officer was not convinced. She found there were not enough different trademarks to establish the kind of family McDonald's was claiming.

Once duplicate registrations were stripped out, the McDonald's and McCafé group and the Big Mac and Grand Big Mac group contained just two marks each.

There was another important difference: McDonald's uses 'Mc' at the beginning of names such as McCafé, while Supermac's uses 'mac' within its name and ends with a possessive apostrophe.

When the trademarks were compared directly, the hearing officer found that Supermac's had only a low level of visual and sound similarity with McDonald's and McCafé, and no similarity in their meaning.

The comparison with Big Mac and Grand Big Mac was closer because of the shared 'Mac' element. Ralph found a medium level of visual and sound similarity, but said the additional words—'Big', 'Grand Big' and 'Super'—were enough to distinguish the brands.

Consumers were therefore unlikely to confuse the brands or assume the businesses were commercially connected, the court ruled.

McDonald's did succeed in showing that its trademarks have a strong reputation in the UK. However, the marks were different enough that consumers would not make the necessary connection between Supermac's and McDonald's.

That meant Supermac's would not gain an unfair advantage from or cause damage to the reputation of the US fast-food group's trademarks.

The hearing officer accepted that the company had genuinely used its trademarks and built up significant distinctiveness. This time, it was the differences between the competing marks that proved decisive. **ip**

IMAGE: SHUTTERSTOCK.COM / NEW AFRICA

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IP WARNING LETTERS: LESSONS FROM PMT 10686-25

A Swedish court has clarified when warning letters may constitute marketing, confirming that the key question is whether they serve a sales-promoting purpose, explains **Maria Zamkova** of Fenix Legal.

Swedish IP practice has long recognised warning letters as a legitimate and often necessary part of enforcing patent and trademark rights.

Yet a warning letter may, in certain circumstances, fall within the scope of the Swedish Marketing Act (MFL 2008:486). Once that threshold is crossed, statements in the letter may be scrutinised as potentially misleading marketing.

The latest and most important development is the Patent and Market Court of Appeal's (PMÖD) judgment of May 12, 2026 in *PMT 10686-25*, concerning Power Stow International and Lifts All.

The PMÖD reversed the first-instance judgment, holding that two patent warning letters did not constitute marketing. The decision is significant because it draws a particularly clear distinction between two questions that should not be conflated:

- (1) Does such communication constitute marketing at all?
- (2) If it does, are the statements contained in it misleading or otherwise unfair?

The distinction is more than semantic. In *PMT 10686-25*, the warning letters contained incorrect information concerning Swedish patent protection.

Nevertheless, PMÖD held that the letters were not marketing. Consequently, the court did not proceed to assess whether the incorrect statements were misleading under the MFL.



TAKEAWAYS

- PMÖD issued significant judgment
- Classification precedes content review
- Legal function needs to be identified

What makes a warning letter 'marketing'?

Under Swedish law, a communication does not become 'marketing' merely because it concerns commercial activity or is sent by a business to another business.

The relevant measure is whether the action is of a distinctly commercial nature, including whether it is undertaken in commercial activity, concerns purely commercial circumstances and has a commercial, or sales-promoting, purpose. This last element is particularly important in warning-letter cases.

The starting point is that a warning letter is normally part of dispute resolution rather than sales promotion. The courts have repeatedly acknowledged that warning letters are a natural and accepted feature of civil litigation, including IP disputes. The fact that the dispute concerns competing products does not, by itself, transform legal correspondence into marketing.

In *PMT 13795-22*, the Court of Appeal held that three warning letters relating to a patent dispute were not marketing measures. The court emphasised that correspondence which contains factual and nuanced information about a party's position in a dispute will normally not have a sales-promoting purpose.

PMT 10686-25 now strengthens that principle. The dispute concerned Power Stow's allegation that Lifts All's E-CUS baggage-

handling product infringed Power Stow's European patent.

The facts of PMT 10686-25

Power Stow's lawyers sent two warning letters to Lifts All. The letters demanded that Lifts All cease commercial activities connected with the allegedly infringing product, remove the product and marketing material from specified jurisdictions and provide documentation concerning sales and manufacturing.

The problem was that the letters incorrectly stated that the patent enjoyed protection in Sweden and that Lifts All infringed the patent there.

The Patent and Market Court (PMD) considered the letters to constitute marketing. Among other things, it attached importance to the categorical nature of the allegations, the absence of sufficiently developed legal analysis and the fact that the asserted Swedish patent protection did not exist.

The PMD considered these circumstances capable of weakening the impression that the letters constituted genuine legal correspondence and strengthening the inference of a sales-promoting purpose.

PMÖD focuses on the purpose of the letters

However, the PMÖD disagreed. It accepted that the measures had been taken in commercial activity and concerned commercial

circumstances.

The decisive question was whether they had been undertaken with a sales-promoting purpose. On that point, the court found that the letters presented Power Stow's position in an IP dispute in a factual and sufficiently nuanced manner. Their content did not itself indicate a sales-promoting purpose.

The recipient was also decisive. Both letters were addressed exclusively to the alleged infringer. There was no evidence that they had been sent to customers, distributors or other third parties. The court also accepted evidence from Power Stow's counsel that an important purpose of the letters was to put Lifts All on notice of the alleged infringement—in other words, to establish bad faith—rather than to promote Power Stow's own sales.

The court therefore concluded that the letters formed part of legal correspondence and were not marketing.

Classification comes before content review

The most important doctrinal point in *PMT 10686-25* is that classification precedes content review. Lifts All's case was based substantially on the incorrect statements concerning Swedish patent protection.

But the PMÖD expressly held that those inaccuracies did not affect the assessment of whether the letters constituted marketing. The court accepted that the statements had been included by mistake and found no evidence that the error had a sales-promoting purpose.

The consequence was decisive: because the letters were not marketing, the court did not assess whether the incorrect statements were misleading under the MFL.

This should not be misunderstood as judicial approval of inaccurate IP assertions.

Rather, it establishes that the MFL is not engaged merely



The PMÖD accepted that the measures had been taken in commercial activity and concerned commercial circumstances.

Maria Zamkova,
Fenix Legal

because a warning letter contains an incorrect statement. The question of whether the communication is marketing is conceptually distinct from the question of whether a marketing communication is misleading.

Earlier case law

That distinction is also visible in *PMT 13795-22*, where PMÖD held that the warning letters themselves were not marketing, while a separate email inviting recipients to a trade fair was marketing.

The court then assessed the claims in that email and found them not to be misleading. By contrast, a statement on the company's website about the development of a seed-treatment machine was marketing and was found to be misleading.

The older case law demonstrates that the protection afforded to legal correspondence is not unlimited.

In *MD 2009:27*, warning letters were sent to customers of a competitor in a dispute concerning music-download services. The letters alleged that the competitor's service infringed copyright and threatened legal consequences. Crucially, the recipients were not the alleged infringer.

The letters also offered the recipients an opportunity to enter into an agreement with the sender instead. The Market Court held that the letters had a commercial purpose because their object was to persuade the recipients to stop doing business with the competitor and instead purchase the corresponding service from the sender. The court subsequently found several of the infringement allegations excessively categorical and far-reaching.

Forcefulness vs marketing

The cases demonstrate why recipient and commercial effects are so important. However, the case law does not require warning letters to be neutral or tentative.

In *MD 2004:14*, the Market Court

stressed that warning letters are a natural part of civil disputes and that the uncertainty inherent in a dispute means that the same assessment cannot simply be applied as would be applied to conventional advertising.

The court nevertheless acknowledged that excessively unqualified and far-reaching allegations may constitute unfair marketing. In that case, however, the letters were sufficiently supported and contextualised, including through references to an earlier arbitration proceeding. The court therefore did not consider the statements so unqualified or far-reaching as to be unlawful.

The lesson is important: forcefulness is not the same as marketing.

Practical takeaways

The relevance of warning letters extends beyond the MFL. In trademark litigation, a warning may establish that the alleged infringer was aware of the rights asserted against it. That may become relevant to questions of intent, negligence and compensation.

The warning therefore has a legitimate litigation function: it identifies the right, communicates the alleged infringement and gives the recipient an opportunity to modify its conduct before proceedings are commenced.

To summarise, here are six short recommendations:

- Identify the legal function of the letter.
- Keep the audience narrow.
- Separate facts from legal conclusions.
- Verify territorial rights with particular care.
- Avoid unnecessary sales-oriented language.
- Preserve the evidentiary function. **ip**

Maria Zamkova is CEO at Fenix Legal and a registered EUIPO trademark and design attorney as well as a patent attorney. She can be contacted at info@fenixlegal.eu

PATENT PROSECUTION MADE SIMPLER, FASTER, AND MORE EFFICIENT

By adapting applications, using fast-track routes and managing claims, applicants can strengthen protection for inventions in Brazil, say **Otto Licks**, **Pablo Barbosa** and **Rafael Tögel** of Licks Attorneys.

As Brazil continues its trajectory as a global economy, securing robust and enforceable patent protection is paramount. With a modernising patent office, political commitment, and experienced partners such as Licks Attorneys, Brazil offers a compelling venue for protecting inventions.

Lean prosecution strategies

Thanks to the efforts made by the Brazilian Patent and Trademark Office (BRPTO) in recent years to reduce the examination backlog, filing-to-grant times have gradually and perceptibly decreased.

Prosecution speed before the office is not solely a matter of the examination queue. Applicants can reduce friction by timing claim adaptations and examination requests, using foreign exams, seeking a fast-track and deploying divisional or alternative claims.

Although foreign decisions do not bind the BRPTO, and no procedure substitutes the BRPTO's assessment for patentability, strategic prosecution can ease the path to grant.

Licks Attorneys helps applicants select the most effective strategy based on the technology involved, the desired scope of protection, and business objectives.

This includes recommending pre-examination and post-examination amendments, adapting claims and specifications to Brazilian practice, and considering additional claim formats available under



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Brazilian practice where they are strategically advantageous.

Choose the right route

The BRPTO currently offers two main mechanisms for accelerating patent prosecution in Brazil:

(i) Priority Examination: Available for specific categories of applicants, technologies, and circumstances, including green technologies related to alternative energy, transportation, energy conservation, waste management, and agriculture (environmentally friendly technologies), startups, public-interest technologies, and infringement-related cases.

(ii) Patent Prosecution Highway (PPH): This enables applicants to leverage favourable patentability findings from partner patent offices and thereby expedite examination before the BRPTO.

The PPH is often the most efficient acceleration route because it allows the BRPTO to leverage patentability analyses previously conducted by participating foreign patent offices that have found at least one corresponding claim allowable, including the US Patent and Trademark Office (USPTO), the European Patent Office (EPO), the Japan Patent Office (JPO), and the China National Intellectual Property Administration (CNIPA), among others. This approach substantially reduces the time required to reach a final decision.

Under BRPTO's Ordinance No. 48/2024, the Brazilian claims must sufficiently correspond to those claims, examination must have been requested, and substantive

examination must not have started.

A focused claim set, a clear correspondence table and the relevant examination results from the earlier examining office can significantly speed up examination. Those results inform but do not bind the BRPTO.

Where no positive foreign result exists, BRPTO Ordinance No. 79/2022 offers the routes of prioritised processing that may be requested when all or part of the claimed technology has been licensed, offered for sale, imported or exported in connection with the Brazilian market.

Evidence of alleged infringement is another ground for prioritising processing, normally requiring prior notification, such as a cease-and-desist letter, together with proof of receipt and supporting indicia. An accused third party may also seek prioritisation.

The average time for issuing decisions on patent applications under these programmes is nine months, offering a rapid path for strategic inventions.

Shift a preliminary office action

A preliminary office action relies on prior art identified by other patent offices and gives applicants 90 days to amend the application or submit counterarguments. The response should address every citation, map each independent claim, and explain the technical differences and effects, rather than merely report a foreign grant.

If a corresponding application has been allowed, submit its

claims and latest examination result, explain correspondence and adapt the wording to Brazilian practice. Aligning the Brazilian claims with claims already found allowable abroad can often provide the most direct path to allowance. If broader protection remains important, defend a compliant main claim set and submit one or two narrower alternative claims, preferably supported by the foreign result.

Adapt the application

When filing in Brazil, patent applications should be adapted to local requirements, including the BRPTO's two-part claim format. Under Ordinance #16/2024, independent claims should identify the claim category, followed by known prior-art features (if applicable) and a 'characterised by' clause defining the novel and inventive features.

Although similar to a Jepson claim, all claim limitations contribute to the scope of protection. As a best practice, the preamble should be kept as short as possible.

Substantive adaptation should be completed before requesting examination, especially for non-statutory subject matter. Articles 10 and 18 of the Brazilian Patent Statute (Law #9,279/1996) exclude computer programs *per se*; commercial and business schemes; presentation of information; therapeutic, surgical and diagnostic methods; certain natural biological materials; and living beings, except transgenic microorganisms.

Computer-implemented or business-related inventions may be patentable when defined through technical means and effects and to solve a technical problem. Where supported, treatment methods can often be redrafted as Swiss-type manufacturing-use claims.

Biotechnology claims may focus on eligible processes or material distinguishable from their natural counterparts. Terminology

The average time for issuing decisions on patent applications under these programmes is nine months, offering a rapid path to patent grants for strategic inventions.

alone cannot cure excluded matter: the formulation must be supported by the specification filed.

Use the examination-request window

Applicants may request examination at any time within 36 months from the filing date. Absent an immediate commercial or enforcement need, using part of this period may help. A corresponding PCT or foreign application may yield a search report, written opinion or allowance, enabling a tested strategy before examination.

Delay is not always advisable: the patent term runs from filing, and the ordinary examination queue follows the examination-request date. If enforcement is urgent, request examination early or seek fast-track processing. Monitor the family, select the foreign claims best serving commercial objectives and retain a safe margin before the deadline.

Be smart with the claim-scope

Voluntary amendments within the original disclosure, including amendments that broaden claim scope, are permitted until examination is requested. In practice, that date establishes the broadest claim scope that may subsequently be pursued.

Matter disclosed but not claimed by then generally cannot later be introduced unless it restricts an existing claim. During examination, amendments may clarify or narrow claims, but cannot broaden protection.

Applicants should file their broadest defensible claim set before the examination request, preserving supported categories and commercially relevant alternatives. A divisional cannot recover scope absent from the parent's claims when examination was requested.

Division and alternative claim sets

Voluntary division is generally permitted until the end of first-instance examination, although

filing earlier is often preferable. A divisional application must refer to the parent application, remain within its disclosure and respect the broadest claim scope fixed at the parent application's examination request.

It should remove, rather than duplicate, parent subject matter. Division is useful after a lack-of-unity objection or when distinct embodiments or claim strategies warrant separate prosecution.

The BRPTO also accepts alternative claim sets in the same application, although no dedicated regulation currently governs them. Rank them as 'main claims', 'first auxiliary claims' and, if justified, 'second auxiliary claims'.

Each should be complete, progressively narrower, and accompanied by a concise explanation of amendments and support. Used prudently, they may provide a fallback without another office action but cannot exceed the broadest scope established at the examination-request date.

The leanest path is sequentially straightforward: adapt the application to Brazilian rules; define the broadest defensible claim; time the examination request to use foreign results.

If needed, choose an acceleration route before examination begins; answer a preliminary office action as though allowance could follow; and reserve divisions or alternative claim sets for commercially meaningful fallbacks. The objective is an enforceable Brazilian patent, not speed alone. **ip**

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SURVIVING THE NEW AI PROSECUTION GAUNTLET

Navigating the AI patent landscape requires moving beyond § 101 eligibility to master the complex interplay with § 112(a) enablement, says **Bradford Fritz** of BSKB.

In 2023, the main hurdle when prosecuting patents for artificial intelligence (AI) and blockchain technologies was often surviving a 35 U.S.C. § 101 challenge. At the time, overcoming a § 101 rejection required a targeted strategy of moving away from generic hardware recitations and instead focusing on how the alleged abstract idea integrated into a “practical application.”

As I detailed in a previous *WIPR* article three years ago, amending a claim to recite a real-world result that improves upon existing technology is an effective way to overcome a § 101 rejection.

Fast forward to 2026, and the patent landscape has fundamentally shifted. Passing the subject matter eligibility threshold is now only part of the battle. Securing robust, enforceable AI patents demands mastering the delicate interplay between the established *Alice* framework and escalating § 112(a) enablement hurdles. Navigating this narrowing path successfully requires a robust disclosure that heads off potential pitfalls before they become fatal rejections or litigation vulnerabilities.

TAKEAWAYS

- AI patents require robust disclosure
- Example 39 can help overcome rejection
- Inventors need to crack open ‘black box’

The diverging § 101 landscape: Examination vs litigation

For prosecuting AI inventions today, a noticeable divergence has emerged between the United States Patent and Trademark Office (USPTO) examination trends and strict litigation outcomes in the federal courts.

Fortunately, the USPTO is starting to push back on examiners relying on aggressive, boilerplate § 101 rejections for AI. Under the pro-innovation leadership of director John Squires, the agency has signalled a clear policy shift. In the 2025 precedential appeals review panel decision *Ex parte Desjardins*, the USPTO warned against overbroad subject matter eligibility rejections that equate any machine learning with an unpatentable algorithm. Instead, the panel instructed examiners to utilise §§ 102, 103, and 112 as the traditional, appropriate tools to limit patent scope. For applicants, *Desjardins* provides an important shield during examination, proving that AI claims improving the operation of the model itself are patent-eligible.

However, the courts present a stricter reality. In its landmark April 2025 decision, *Recentive Analytics v Fox Corp*, the Court of Appeals

for the Federal Circuit held that simply applying generic machine learning techniques to a new data environment (in that case, event scheduling and network maps) fails § 101. To survive litigation, an invention cannot merely perform a known human task faster using existing AI. Rather, the claims must disclose an improvement to the underlying machine learning model itself.

This disconnect between the patent office and the courts is frustrating for practitioners. The *Alice*/*Mayo* framework frequently overlaps with traditional novelty (§ 102) and obviousness (§ 103) considerations, such as whether a technique is “conventional”.

While legislative efforts like the pending Patent Eligibility Restoration Act (PERA) aim to eliminate the judicially created “abstract idea” exception entirely, practitioners must currently draft applications capable of satisfying both the USPTO’s shifting standards and the Federal Circuit’s exacting scrutiny.

Leveraging example 39 as a useful tool for AI eligibility

While tying claims to a practical application or a real-world result remains a solid strategy,

practitioners often overlook a relevant tool for navigating § 101 in AI cases, which is USPTO subject matter eligibility example 39.

Example 39 illustrates a method for training a neural network for facial detection. It outlines a multi-stage training process involving the collection of digital facial images, applying transformations, and utilising distinct training sets to detect human faces despite variations in scale and rotation.

Notably, the ultimate result of this claimed process is the generation of a trained AI model. The USPTO’s guidance confirms that such a claim is statutory because it avoids reciting a judicial exception altogether. The office recognised that a person cannot realistically generate a trained AI model in their mind, meaning the computational steps transcend any abstract “mental process”.

This framework is highly adaptable to complex electromechanical and AI arts. Instead of claiming the abstract idea of organising data, the claim can focus on the concrete, non-human computational operations. For example, when prosecuting a patent for a predictive AI model, the claims could recite the specific preprocessing of the input datasets and the complex data transformations required to train a specific attention layer within the network architecture. Focusing the claims on the specific technical architecture and training steps can prove the method is too complex for a mere “mental process”, making it an effective strategy to overcome a § 101 rejection.

Surviving § 101 can provoke a rising § 112(a) threat

The very techniques patent prosecutors use to survive the § 101 gauntlet are now acting as a lightning rod for § 112(a) enablement scrutiny.

By aggressively reciting functional results, data transformations, and complex models to satisfy § 101, practitioners expose their applications to the strict enablement standards solidified

by the Supreme Court in *Amgen v Sanofi* and the Federal Circuit in *In re Starrett*. As the USPTO pivots away from § 101 per *Desjardins*, examiners are increasingly turning to § 112(a) to reject AI claims that lack sufficient technical depth.

Amgen effectively ended the era of broad functional claiming, prohibiting applicants from claiming a broad functional result without providing a commensurate disclosure of how to achieve that result across the full scope of the claim. If an application requires engineers to engage in a “research assignment” to practice the full scope of the invention, it likely is invalid.

Starrett compounded this vulnerability for software and AI. The Federal Circuit invalidated claims where the specification merely assigned a name to a function but failed to describe how the machine learning elements actually operated. Claiming “generation of a trained video upscaling model” might satisfy example 39 and pass § 101. However, if the specification merely provides a “black box” label and a single working example without disclosing the underlying neural network architecture, the training data structures, or the specific logic for handling edge cases, then the claim could face a fatal § 112(a) enablement challenge.

Furthermore, relying on the knowledge of a person having ordinary skill in the art (POSITA) to fill in the gaps is a dangerous gamble. Under the *Wands* factors, the predictability of the art is crucial. Because AI is a highly unpredictable field, courts and examiners are likely to conclude that an engineer would have to engage in unreasonable experimentation to build the system if the specification lacks concrete, detailed guidance.

Practical drafting guidelines for AI applications

Practitioners cannot rely on clever claim amendments alone to survive both § 101 and § 112(a). It ultimately comes down to pressing the inventors to crack open that “black box” before drafting the



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specification. A robust, exhaustive specification is the most reliable defence against § 112(a) attacks.

To successfully navigate this dual threat at the USPTO and in the courts, patent prosecutors should consider these practical drafting guidelines:

1) Detail the architecture and data:

Never assume the AI model is a standard component. The specification should explicitly describe the training data (how it is collected, structured, and labeled) and the specific neural network architecture being utilised. If the invention adjusts any part of a transformer configuration or modifies network layers to solve a specific problem, those modifications should be documented in exhaustive detail.

2) Expose LLM prompting techniques:

Many modern systems rely on large language models (LLMs) or generative agents. If an invention uses an LLM, the specific prompting techniques are often central to how the invention actually works. Include example prompts or prompt templates in the specification to prove exactly how the system guides the LLM to produce the claimed result.

3) Map intermediate steps and transformations:

Do not skip over the messy middle steps. Explain the intermediate input/output transformations to prove exactly how an algorithm handles edge cases, ambiguities, and variable data. Explain the logic as a step-by-step recipe.

4) Provide diverse working examples:

Do not rely on a single use case. To satisfy *Amgen* and support broad claims, the specification should provide multiple, diverse working examples across the entire claimed scope. **ip**

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USING IP INTELLIGENCE TO INCREASE CORPORATE VALUE

Effective understanding and analysis of IP information can support strategic decisions on investment, budgeting and growth, explains **Shinya Kinuta**, managing director of Dennemeyer Japan.



IMAGE: SHUTTERSTOCK.COM / NERZA

An increasingly globalised world inevitably brings heightened competition alongside its scope for expansion, and it is within this context that Japanese businesses are facing a number of challenges in extracting the greatest advantage from their intellectual property (IP) assets.

Foremost among these are budget constraints and a lack of internal IP resources or expertise.

These troubles are compounded for many companies in the country by problems integrating IP into corporate processes and systems. This is often due to the lack of effective analytics and portfolio reporting and insufficient investment in suitable software, not least artificial intelligence (AI) tools, that promote efficiency, accuracy and quality evaluation.

The result is that, while many Japanese operations have very strong portfolios of IP, including patents, designs, trademarks and unregistered rights, they are frequently not deploying them suitably to drive commercial growth. This means missing out on new opportunities and partnerships and possibly losing ground to international

rivals capable of seizing upon exploitable inactivity.

It follows, then, that by overcoming internal obstacles, triaging to meet cost pressures and aligning analytics with company targets, registered and unregistered IP rights can deliver real monetary value for Japanese businesses.

Getting IP information to decision makers

There are several reasons why IP portfolio data might not reach strategic decision makers.

One barrier arises when IP information is not compiled or arranged appropriately, or is incomplete or outdated. This may be due to poor record-keeping, in turn caused by inadequacies in the procedures or means used. To address this issue, the first step is to employ sophisticated databases and systems that can be viewed by all relevant personnel and updated in real time.

Another impediment commonly seen is that the information is stored but is not in an accessible format, particularly for non-IP specialists. It may be contained within overly complicated software or written in technical language: IP law, like most regulatory

frameworks, has its own jargon. This is exacerbated when the people in an organisation who most need to understand IP are in different departments and/or different locations.

Careful thought should therefore be given to how to record, present and convey IP data in ways that are clear, available and concise.

However, all these practical challenges can be part of a more fundamental dilemma, namely that the leadership team in a given enterprise might not understand or appreciate the significance of the IP portfolio. This is frequently the case where budgets are tight and investment has been cut.

Why budget pressure makes prioritisation essential

One consequence of the budget strain that has persisted since the COVID-19 pandemic and the economic crises of the past five years is that organisations must be watchful in how they apportion strategic emphasis.

This is particularly true for IP portfolios, which are often viewed as expenses and even as drains on corporate resources in situations where their worth is not being fully realised.

To demonstrate the value inherent in an IP portfolio, it is vital to be able to make evidence-based assessments about which properties to favour and where to direct funds. For example, certain assets may be suitable for assignment, or they may be appropriate for a patent pool or joint licensing arrangement. Other IP rights may make the biggest financial contribution (especially in the short term) if they are sold to another party.

In some cases, the best course of action may be to allow an IP right to lapse in certain jurisdictions, or, in the case of a trademark, for certain goods or services, if the cost of maintaining it outweighs its commercial importance.

How better IP analytics can change thought processes

Effective prioritisation can only be carried out based on true, timely and relevant data about the IP portfolio. That is why it is crucial to maintain comprehensive records covering not only the business's own registered and unregistered IP assets (including details of pending and lapsed rights) but also agreements such as licenses and settlements with third parties.

Where available, knowledge of competitors' portfolios should also be recorded, along with other relevant facts such as public judgments, IP office decisions and corporate announcements.

Large organisations are likely to have substantial amounts of IP-related detail logged. However, this is only useful internally if it informs activity. That means ensuring that output data are read, not exclusively, with respect to the company's objectives and that they contribute to profitability.

IP intelligence driving future growth

There are several ways in which IP intelligence can yield tangible benefits to businesses in Japan.

First, IP rights can help bring about new or improved products and services to meet customers' needs. Thus, patents in the portfolio might protect inventions or manufacturing processes that give an advantage over competitors. Meanwhile, design rights and 3D trademarks can be deployed to protect certain features of products that appeal to consumers and are distinctive in their markets.

Second, analysis of the IP portfolio can advance expansion plans into new markets. For example, an enterprise may own patents relating to a technology that it is not currently commercialising. This could open up new revenue streams that will further supply the business without jeopardising existing income.

Third, an internal review of a portfolio *vis-à-vis* those of competitors can identify products that may be infringing IP rights. The organisation can then assess whether to take action against those rivals that could lead to a financial settlement and/or ongoing royalties. Such proceedings are most likely to be effective where the claim is legally robust and based on detailed insights into both the scope and strength of the relevant IP rights and the nature of the third party's



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products and IP position.

Fourth, the IP portfolio may include "hidden treasures" that are not being fully utilised, possibly because they do not map to the company's current product offering or corporate strategy. However, these assets may be ripe for licensing to third parties. For example, a company may own patents for inventions in one industry sector that also have applications in other sectors: Licensing those patents can turn them from costs to revenue-generating properties.

Finally, understanding the IP portfolio can guide research and development priorities. Existing patents may suggest fruitful fields in which to invest, innovation gaps and future technology prospects. This can, in turn, offer long-term sustainable income that builds on and develops existing technology strengths.

Making best use of what is already owned

Corporations, universities and research institutes are under more stress than ever to manage resources and improve profitability. IP portfolios can play a critical role in helping to realise these goals by indicating where to direct investment, where spending can be cut and where new opportunities may lie. This, accordingly, produces positive results for investors, customers, commercial partners and other stakeholders.

But for an IP portfolio to contribute meaningfully to earnings and strategic positioning, it must be consolidated, inspected and understood across departments and management levels. Only then can Japan's innovators and entrepreneurs turn IP latency into measurable capital. **ip**

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PLAYBACK: LESSONS FROM PHILIPS V BANSAL

Eight years on, India's first standard-essential patent decree has redefined the country's evidentiary bar for enforcement, explains **Pankaj Soni** of Remfry & Sagar.

On July 12, 2018, the Delhi High Court delivered India's first post-trial judgment in a standard-essential patent (SEP) dispute, decreeing royalties, interest and punitive damages in favour of Koninklijke Philips Electronics against local assemblers of DVD video players.

On May 18, 2026, a Division Bench of the same court allowed the assemblers' appeals, and set the decree aside in its entirety (*KK Bansal v Koninklijke Philips Electronics* (2026)).

Other than being the first reversal of the first SEP decree, the decision is important for setting a specific standard in what makes (or breaks) an SEP case.

The road to the appeal

Philips had sued in 2009, asserting Indian Patent No. 184753, a "decoding device" it said was essential to the

DVD Forum standard, against Rajesh Bansal (Mangalam Technology) and KK Bansal (Bhagirathi Electronics), who assembled DVD players using imported MediaTek chips.

The Single Judge found the patent to be a valid, essential and infringed SEP and, since the patent had expired on February 12, 2015, decreed royalties, interest, and punitive damages against Rajesh Bansal.

Before turning to the four issues that were framed on appeal ie, whether the patent was an SEP, whether Philips was barred by exhaustion, whether the patent had been infringed, and whether the damages were sustainable, the Division Bench set out the sequence an SEP holder must follow after it initiates a suit for infringement.

First, the patentee must establish that its patent is an SEP. Second, it must show that the defendant's product infringes the patent. Third, the patentee must establish that it

acted as a willing licensor offering FRAND terms. Only once these three steps are cleared does the implementer's alleged unwillingness to take a licence become relevant. The Bench found that Philips had not crossed the first hurdle.

No proof that patent was an SEP

To establish essentiality, Philips had relied on "essentiality certificates" prepared for the corresponding US and European patents by law firms in those jurisdictions. The Bench treated these as no more than private expert opinions because no author of either certificate entered the witness box and, therefore, were not cross-examined. Further, no claim charts were placed on record mapping the claims of the suit patent, or of the US and European patents, onto the DVD standard.

It was not in dispute that the DVD Forum is a standard-setting organisation; the difficulty lay entirely

in proving that the suit patent was essential to its standard.

To compound the issue, the Bench zeroed in on a mismatch at the heart of the essentiality case. The suit patent is directed to a product, whereas the corresponding US and European patents on which the certificates were prepared are method patents.

The attempt by Philips to carry essentiality across from one to the other did not find favour with the court. Turning to the patent itself, the Bench observed that although every claim was for a "device", the complete specification opened by describing a "method", a description the court found to be at odds with both the claims and the title of the patent.

Reiterating that protection extends only to what is claimed, the Bench held that the claimed device resided in the chip, or the printed circuit board, of a player, and that anything outside the PCB lay outside the patent—a point that worked against Philips in the damages calculations.

No proof of infringement

Having found the essentiality case wanting, the Bench turned to infringement and found it equally unproven. Philips had not mapped the suit patent onto the standard, and its indirect case rested on the same essentiality certificates the court had already rejected. The direct case fared no better.

Where the Single Judge had been content to accept the plaintiff's expert analysis, the Division Bench insisted on the accepted method of proving infringement, ie, a mapping of the claims onto the defendant's product, and found that this exercise had not been done. The infringement affidavit of Philips' witness had reduced credibility because he never entered the witness box; and the independent testing spoken to by Philips' other witness was unsupported by any test logs. Thus, the Division Bench opined that there was an adverse

inference under Section 114 of the Evidence Act.

The court also noted that testing had been carried out on the entire DVD player rather than on the chip or PCB which, in the Bench's construction, is where the invention resided. The Bench therefore concluded that there is "no evidence of infringement, either direct or indirect".

Exhaustion defence and damages

The Bansals' exhaustion defence turned on their supply chain, which the Bench found had gone un rebutted. The Bansals had bought MediaTek chips from Shuntak and Sheen Land (in China). These entities were registered vendors of MediaTek, and MediaTek was, in turn, a registered vendor of Philips. Interestingly, the witness who spoke to this supply chain was not cross-examined, which weighed heavily in favour of the Bench accepting the accuracy of the supply chain.

Particularly, the Bench observed that following the amendment of Section 107A(b), the provision no longer requires a seller to be "duly authorised by the patentee"; it is enough that the seller be "duly authorised under the law". Therefore, once Philips had released the patented chip into the market, its rights in respect of that chip were exhausted. The point was reinforced by Philips' own evidence that the same MediaTek MT1389-family chip was found not only in the Bansals' players but in the products of Philips itself and other sellers.

On damages, the Bench held that Philips had placed no comparable licence on record, even though its witness had admitted to holding such agreements, again attracting an adverse inference under Section 114. Rates exchanged in pre-suit or informal negotiations, the Bench held, can never fix a final FRAND royalty and, at most, they might support an interim *pro tem* arrangement.

It further held that royalty could not be levied on the entire player,



Once Philips had released the patented chip into the market, its rights in respect of that chip were exhausted.

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which would compensate Philips for components it had never patented, and that Philips's practice of offering royalties "per player" was a commercial choice that could not dictate the royalty payable in litigation. With no sustainable finding of infringement or of a FRAND breach, the punitive award was no longer sustainable.

What it means

Read together, the Bench's findings recalibrate the evidentiary bar for SEP enforcement in India. A patentee must (i) prove essentiality with claim charts and with witnesses who can be cross-examined; (ii) prove infringement by mapping the claims onto the accused product or the product to the standard (while establishing that its patent reads on the standard); and (iii) prove its own FRAND conduct with comparable licences rather than negotiation correspondence.

The exhaustion holding is a particular caution for patentees who both license a component without field of use restrictions, and sell it themselves. The harder FRAND questions, meanwhile, remained unanswered, because on its findings there was no properly proved SEP or infringement to price. Notably, the Bench remarked that arriving at a legally correct FRAND rate in India is, in its words, "frankly, impossible", which underscores the fact that even courts may not have a settled royalty-setting methodology.

In the wider arc of India's growing body of post-trial jurisprudence, the present case reads less as a retreat from SEP protection than as an insistence that it be earned on evidence. How the decision cements the standard of proof set for the SEP cases remains to be seen, as by last count, the appeal to the Supreme Court of India has been admitted, and the fight continues. **ip**

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IMAGE: SHUTTERSTOCK.COM / STAVKLEM / DIGITALLY ALTERED USING AI

COMBATING MALICIOUS IP LITIGATION IN CHINA

A Supreme Court decision finding that the plaintiff acted contrary to good faith signals the country's tougher stance on the abuse of IP rights, says **Xiaojun Guo** of CCPIT Patent and Trademark Law Office.

On April 7, 2026, the Supreme People's Court of China promulgated the revised Interpretation on the Application of Punitive Damages in the Trial of Civil Disputes Involving Intellectual Property Infringement. The revised Interpretation took effect on May 1, 2026, and repealed the 2021 version.

This reaffirms China's commitment to strengthening IP protection. In parallel with this, the court has turned its attention to curbing the abuse of IP rights and has issued benchmark cases targeting malicious litigation, since adding malicious IP litigation as a separate cause of action in 2011.

In Case No. 96 rendered on April 24, 2026, the IP Court of the Supreme

Court demonstrated its firm stance against malicious litigation by applying a multi-factor test.

Brief of Case No. 96

The plaintiff (appellant) sued the defendant (appellee) over its Go2 robot dog for patent infringement, and lost at both first instance (Case No. 79) and second instance (Case No. 756).

Shortly after suing the defendant over its Go2 robot dog, the plaintiff sued the defendant over its A2 robot dog for patent infringement. After losing at first instance (Case No. 113), the plaintiff appealed to the IP Court of the Supreme Court (the present Case No. 96). The defendant counterclaimed for malicious litigation, among other things, and

sought damages in the two cases.

One of the key issues in dispute was whether the plaintiff acted maliciously. In determining this, the IP Court of the Supreme Court cited Guiding Case No. 278 as precedent and applied a multi-factor test.

Multi-factor test

In Guiding Case No. 278, the IP Court of the Supreme Court held that initiating a patent suit while knowing the claims lack any legal or factual basis constitutes malicious litigation and abuse of rights.

In the present case, the court further elaborated that, to determine whether malicious litigation exists, a court shall systematically assess all relevant factors, integrating subjective and objective elements,

taking into account factors before and during the litigation, and considering circumstances both inside and outside the proceedings.

In addition to examining whether the litigation lacks a legal or factual basis, the court shall comprehensively evaluate factors such as the rights holder's claims, the timing of initiating the litigation, litigation risks and strategy, and the degree of imbalance of interests caused to the parties, among other things.

In general, priority shall be given to four factors: (a) whether the action is manifestly devoid of legal or factual basis; (b) whether the rights holder is aware of this and thus acts with subjective fault; (c) whether the action causes harm; and (d) causation.

The reasons

Applying the above test, the IP Court of the Supreme Court found and ruled that the plaintiff acted maliciously in both Case No. 79 and the present case.

Firstly, the infringement actions were evidently unsupported by any factual grounds. The evidence showed that the accused products, Go2 and A2 robot dogs, plainly lack several features that are identical to or equivalent to the patent claims. Moreover, the plaintiff, despite having full capability, did not follow the usual practice of producing the accused products for comparison.

Secondly, the plaintiff acted with clear subjective fault.

(i) The plaintiff's legal representative Zhou had previously filed over 20 patent infringement suits against others directly or indirectly, none successful; the plaintiff should have exercised greater caution when initiating a patent infringement action again.

(ii) The plaintiff filed two separate suits based on the same patent over two robot-dog models. Case No. 79 had already found the Go2 robot dog non-infringing. Since the technical issues for the A2 robot dog were essentially the same as those with the Go2 robot dog and the A2 robot dog clearly fell outside the patent scope, the plaintiff nevertheless pursued the present case, and sought court orders for production of sales/financial records, evidence preservation, and judicial audit.

(iii) The timing is telling. Although Case No. 79 was filed less than 20 days before the media reported the defendant's IPO guidance filing, the defendant was already a hot media and industry topic. The present case was filed after extensive IPO coverage, during the defendant's critical regulatory-inquiry stage. The plaintiff, having acquired the patent from a third party, quickly initiated the first suit and then, shortly after IPO-related reports, filed this second suit and even threatened more. This forced the defendant to make IPO disclosures and explain risks, causing market concern and negatively affecting its IPO. The plaintiff was



The evidence showed that the accused products, Go2 and A2 robot dogs, plainly lack several features that are identical to or equivalent to the patent claims.

Xiaojun Guo, CCPIT Patent and Trademark Law Office

aware of and intended this, evincing stronger fault.

(iv) The plaintiff's litigation conduct has been capricious and contrary to good faith: it sought nominal damages plus later audit-based amounts, then added a punitive claim; it claimed Go2 and A2 robot dogs were unrelated yet later sought to add Go2 robot dog as an infringing product in the present case; on appeal, it reserved damage claims while seeking production/sale and financial records, evidence preservation and judicial audit; and it raised groundless procedural objections. These examples show the plaintiff's baseless, contradictory, and harassing tactics.

Thirdly, the plaintiff's conduct directly harmed the defendant. It negatively impacted normal business operations, especially by dragging a non-competitor at a critical IPO stage into costly litigation at minimal cost to itself, disregarding the defendant's lawful rights and even its viability. This caused a gross imbalance of interests and disproportionate negative effects on both the major commercial activities and daily operations of the defendant.

Comment

Article 7 of China's Civil Code stipulates that civil subjects shall comply with the principle of good faith, adhere to honesty, and abide by their pledges. Article 20 of China's Patent Law further mandates good faith in exercising patent rights and forbids abuse harming public or private interests.

Case No. 96 signals that IP litigation should not be used as a strategic tool to exert commercial pressure, interfere with normal operations, or seek unjustified benefits. Chinese courts are prepared both to protect legitimate IP rights and to sanction abusive assertions. **ip**

Xiaojun Guo is a patent attorney at CCPIT Patent and Trademark Law Office and the secretary general of AIPPI China. He can be contacted at guojxj@ccpit-patent.com.cn.

CAREERS



UNITED STATES Former USPTO acting director takes the helm at C4IP

The Council for Innovation Promotion (C4IP) has appointed former US Patent and Trademark Office (USPTO) official **Coke Morgan Stewart** as its new president and CEO.

Stewart served as acting director of the USPTO for much of 2025 before becoming deputy under secretary of commerce for intellectual property and deputy director of the agency, a position she held until July 2026.

Her appointment is intended to mark “a new chapter for C4IP as it expands its reach and advocacy for strong and secure intellectual property rights”.

Commenting on the move, Stewart said the US IP system is “fundamental to our economic strength and global competitiveness”.

Stewart previously held senior legal and policy roles across government, academia and private practice, including almost 12 years at the USPTO.

She has also worked as senior counsel in O’Melveny & Myers’ Intellectual Property and Technology group and served as deputy attorney general for the Commonwealth of Virginia, where she supervised 150 attorneys and other professionals.

Andrei Iancu, C4IP board co-chair and a former USPTO director, described Stewart as an “exceptional leader who combines deep expertise in intellectual property with the judgment and experience needed to turn ideas into action”.

UNITED STATES Brown Rudnick hires 34-lawyer IP group

Brown Rudnick has added a 34-lawyer intellectual property (IP) litigation team, marking the largest group hire in the firm’s history and prompting the launch of a new Silicon Valley office.

Announced on August 5, the move brings on board a group of trial litigators and patent prosecutors who join from HSF Kramer, strengthening Brown Rudnick’s position in technology, life sciences and global litigation. The incoming team includes five partners based in Silicon Valley—**Paul Andre, Lisa Kobialka, James Hannah, Kristopher Kastens** and **Michael Lee**—along with two New York partners, **Jonathan Caplan** and **Aaron Frankel**.

Kobialka will join Brown Rudnick’s management committee and serve as co-chair of the firm’s Intellectual

Their stellar reputation in the market for providing sophisticated IP counsel and their deep industry experience strengthens our position as a market leader in technology, life sciences and global litigation.

Vince Guglielmotti, Brown Rudnick

Property Litigation group, alongside current chair Ian DiBernardo.

Vince Guglielmotti, chairman and CEO of Brown Rudnick, said the firm was pleased to welcome “this exceptional team of intellectual property litigators”, adding that “their stellar reputation in the market for providing sophisticated IP counsel and their deep industry experience strengthens our position as a market leader in technology, life sciences and global litigation”.

Andre said the group was drawn to Brown Rudnick’s shared vision “for building a globally prominent IP practice”, noting the firm’s “boutique approach to client service” and its litigation funding capabilities as factors behind the move.



UNITED KINGDOM Ex-Nokia head of litigation returns to Bird & Bird

The former head of litigation at Nokia has returned to private practice at his former employer Bird & Bird, becoming a partner in the firm’s London Intellectual Property team.

Huw Edwards, an experienced tech patent litigator, brings more than 20 years’ experience in patent litigation, including a decade managing major campaigns at Nokia.

He started his career in private practice, at Linklaters in 2000, moving on to Bird & Bird and two other firms before working in-house, including at Sandoz.

Edwards joined Nokia in 2014 as senior IPR litigation counsel, working his way up to become director, head of litigation operations.

As Edwards left this role, Adrian Howes—former president of the IP Federation—became senior director, litigation at Nokia, after almost a decade as the firm’s head of IP and standards in the IP policy and advocacy group.

Edwards has particular expertise across in electronics, engineering and construction, pharmaceuticals and life sciences, and telecommunications.

Commenting on the appointment, Tom Snaith, co-head of Bird & Bird’s London Intellectual Property practice, said: “Huw’s appointment reflects our continued investment in our international patent litigation practice.”

“As global patent disputes become increasingly sophisticated, Huw’s experience leading complex, multi-jurisdictional patent disputes, particularly in the standard-essential patents space, will further strengthen our ability to support clients across our international network.”



CHINA East IP appoints duo to lead new office in Guangzhou

China-based East IP has appointed **Lin He** and **Maisy Ling** (pictured) as partners, along with a team of four colleagues.

The pair will be based in the firm’s Guangzhou office, where they will lead East IP (Guangdong) Law Firm.

Lin He brings more than 15 years’ experience advising domestic and international clients on trademark infringement, unfair competition, criminal IP matters, complex civil litigation and cross-border intellectual property disputes. She also coordinates investigations and enforcement strategies in support of contentious IP matters.

Maisy Ling brings more than 23 years’ professional experience advising domestic and international brand owners on anti-counterfeiting strategies, criminal investigations and litigation, administrative raids, cross-border e-commerce infringement disputes and customs protection. They both join from Funtto Law Firm in Guangdong.

“Together, they bring extensive experience supporting domestic and international clients across the full spectrum of contentious IP matters,” said the firm in a statement.

East IP provides patent and trademark services in seven cities in China and is supported by East IP Law Firm in litigation matters. In 2024, 90 partners and staff from trademark firm SIPS joined East IP. And later that same year, a group of 35 partners and staff led by trademark practitioner Jimmy Huang Jingwen joined from a prominent Chinese law firm, swelling its size to approximately 400 professionals.

UNITED STATES Holland & Hart adds litigation team from Ashurst

Holland & Hart has appointed a patent team from Ashurst Perkins Coie in a move that it says deepens its ability to represent technology companies in high-stakes, business-critical patent matters in the US.

The new team, based at the firm’s Denver office, is led by partners **Amanda Tessar, David St. John-Larkin, and Daniel Keese**. They will be joined by **Matt Pierce** (of counsel) and **Trevor Bervik** (associate), and a paralegal.

The news comes less than a month after Perkins Coie and Ashurst officially completed their merger, launching as Ashurst Perkins Coie with 52 offices across 20 countries and regions.

Chris Balch, chair of Holland & Hart, said: “Patent disputes and portfolio decisions sit at the centre of commercial strategy for technology companies.”

Our team brings additional patent depth, technical expertise, and full-service national patent litigation capability.

Amanda Tessar, Holland & Hart

“With Amanda, Dave, Dan, Matt, and Trevor joining—alongside the recent additions Molly Kocialski and Elizabeth Manno—we’re strengthening our ability to support clients with trial-ready litigation and sophisticated counsel around intellectual property assets, whether the need is defensive, offensive, or transactional.”

Commenting on her move to Holland & Hart, Tessar said: “Our team brings additional patent depth, technical expertise, and full-service national patent litigation capability. We couldn’t be more pleased or optimistic about what lies ahead.”



GERMANY K&L Gates expands with Munich team

K&L Gates has added partners **Christian Wende** (pictured) and **Markus Eustermann** and their nine-person team in Munich.

The group joins from German boutique Wende IP, which was founded by Wende and Eustermann, and includes patent attorneys, trainees and specialist professionals.

Wende focuses on patent, trademark, design and utility model matters, with particular experience of advising companies in the medical technology and automotive sectors. Eustermann advises clients on patent prosecution, post-grant proceedings and patent litigation, including UPC proceedings.

Martina Ortnher, co-managing partner for Germany at K&L Gates, said: “Christian and Markus have established a highly regarded intellectual property practice advising innovative companies across Europe on complex patent and other intellectual property matters.”

“Their addition expands our intellectual property capabilities in one of Europe’s leading innovation and patent markets and further strengthens our ability to advise clients on patent protection, enforcement, and UPC-related matters across jurisdictions. We are pleased to welcome Christian, Markus, and their team to K&L Gates.”

Jason Engel, lead practice area leader for the firm’s global intellectual property practice, added: “The team brings significant experience in patent prosecution, litigation, portfolio management, and strategic counselling across a broad range of technologies, including proceedings before the UPC.”



UNITED STATES

ArentFox Schiff hires 'powerhouse' team

ArentFox Schiff has added an "elite" trademark and brands team and is opening an office in Silicon Valley, expanding the firm's California footprint.

Consisting of three partners and one senior counsel, the group—which joins from Reed Smith—brings decades of collective experience.

Jason Garcia (pictured) joins as equity partner; **Katherine (Katy) Basile** joins as senior counsel; while **Justine Lee** and **Kat Kershner** join as partners. Additionally, ArentFox Schiff will be opening a new office in Silicon Valley.

Anthony Lupo, chairman of the firm, said: "Welcoming this exceptional team marks an exciting milestone for ArentFox Schiff."

"Katy and Jason have together built a cohesive, powerhouse team of trademark professionals. With Justine and Kat rounding out the group, the four of them bring complementary strengths that deepen our bench and expand our geographic reach. There's no better group to anchor our new Silicon Valley office."

The team brings a comprehensive end-to-end brand protection and trademark practice, including a powerful blend of private practice, in-house, litigation, and international experience, said the firm.

Their core capabilities span global trademark strategy, digital brand protection, copyright registrations and protection, and related transactional matters.

UNITED KINGDOM

IP Federation elects Philips licensing chief

The IP Federation—a membership body which represents the views of UK industry—has elected its new president for the next 12 months.

Kevin Scott, licensing programme leader in Philips' Intellectual Property & Standards division, officially began the role on July 10.

He replaced the now-immediate past president, Sarah Vaughan, who was president of the organisation from 2025 to 2026. The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Among its members are Microsoft, IBM, Arm, Shell, BP, Airbus, BAE, Vodafone, Unilever and AstraZeneca.

Scott is a UK chartered patent

I look forward to building on [Vaughan's] success with continuing high-quality policy work and expanding interactions with national and international organisations.

Kevin Scott, IP Federation

attorney, European patent attorney and UPC representative, with almost 30 years of experience in IP matters—including extensive experience in multinational litigation of standard essential patents (SEPs).

He then moved to Philips' IP department, where he has spent most of his time licensing the company's patents to third parties. As licensing programme leader, Scott leads a global team of licensing professionals in technical areas including telecommunications and television.

Commenting on his new post at the IP Federation, Scott said on LinkedIn: "I look forward to building on [Vaughan's] success with continuing high-quality policy work and expanding interactions with national and international organisations."



UNITED STATES

Former senior attorney-advisor to ITC joins Mintz

Michael Leib, a former senior attorney-advisor to multiple commissioners at the US International Trade Commission (ITC), has joined US firm Mintz.

Based in the firm's Washington, DC, office, he joins Mintz as a member of its Intellectual Property Practice after more than 14 years at the ITC. Prior to this, he spent almost a decade at Finnegan as an associate.

Leib's practice draws on significant experience at the intersection of complex commercial disputes, international trade, and regulatory matters, said Mintz.

During his time at the ITC, Leib advised multiple commissioners on hundreds of Section 337 investigations involving a broad range of technologies and industries.

"I was drawn to Mintz because of its premier ITC practice, collaborative culture, and continued growth in the life sciences sector," he said.

Bob Bodian, managing partner of Mintz, said that Leib is "widely recognised for his deep knowledge of the ITC and his significant contributions to the development of Commission precedent over the past decade."

"Having shaped hundreds of Commission decisions, he brings clients an extraordinary perspective on the legal and strategic issues that drive outcomes in high-stakes disputes."

Leib's arrival follows the addition of former ITC co-chair Robert Vlasits earlier this year.



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