The Patent Lawyer

July/August 2026

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Welcome to Hamburg!

Celebrating the 2026 AIPPI World Congress with our special bumper edition

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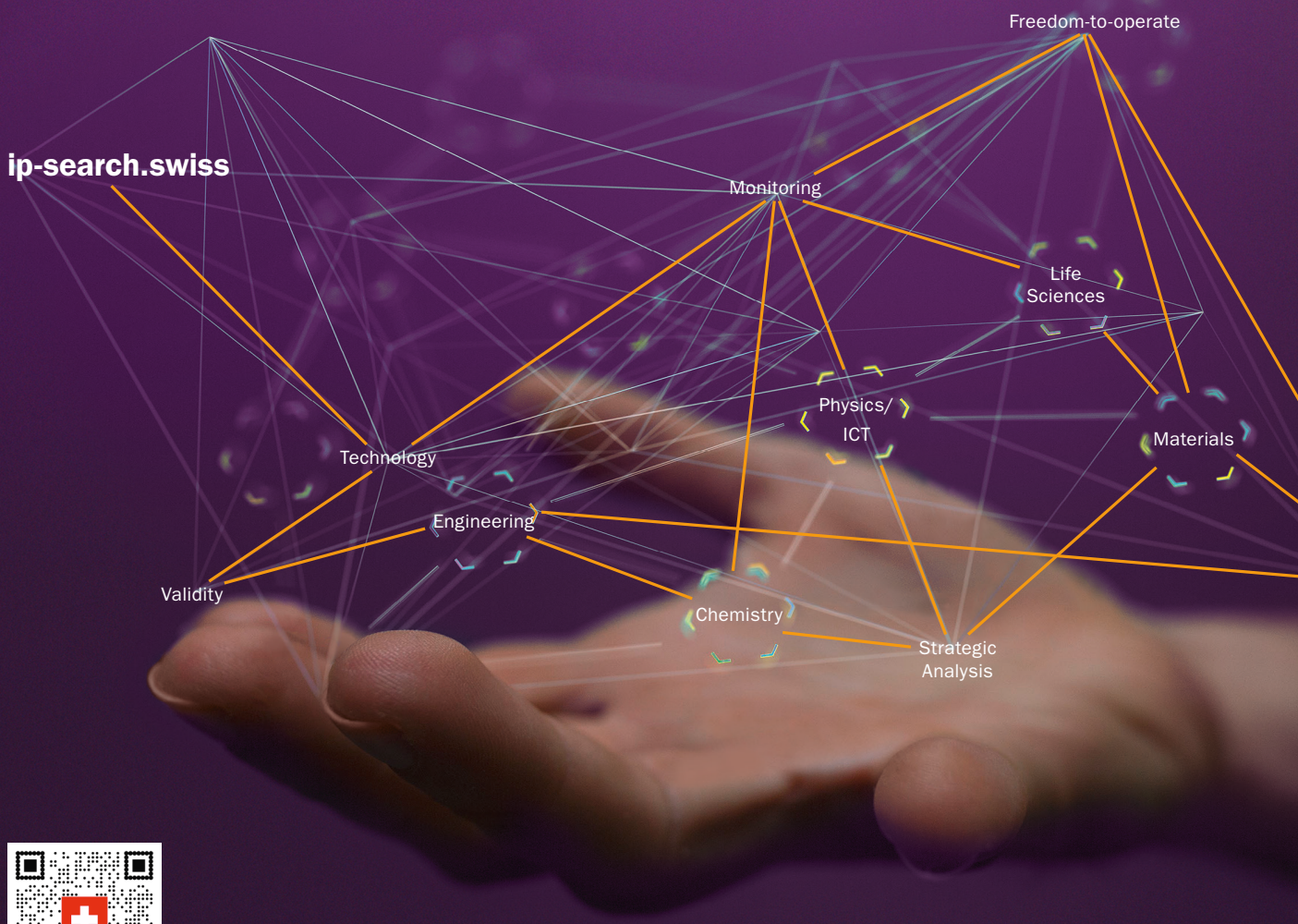


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THE PATENT LAWYER
July/August, 2026

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Editor's welcome



Welcome to our AIPPI World Congress 2026 Special Edition, and for those attending, welcome to Hamburg!

In this edition, we explore how AI is reshaping patent practice, from quality and service delivery to drafting, counseling, and enforcement, while examining the practical and compliance boundaries of generative AI tools. We also consider its wider implications for patent law, including emerging questions around technical effect and patent eligibility.

In our guest interview, AIPPI Reporter General Ralph Nack examines the key forces reshaping patent law and considers what practitioners should be prepared for by 2030.

We also look at important developments and strategies across key jurisdictions, including Article 84 EPC and the expanding scope of clarity objections, substantive examination at Mexico's IMPI, strategies for navigating the UPC, and strengthening patent portfolios in Brazil. Other topics include pharmaceutical patent term extensions and compulsory licensing in Russia, patent litigation and remedies, and developments before the Eurasian Patent Office, including an interview with EAPO President Grigory Ivliev.

Our *Women in IP Leadership* segment, in association with AIPLA, features Carina Gommers, Founding Partner of CAST. Contact us to find out how you can support this empowering platform.

We would like to remind readers of our upcoming Winter IP Conference on 5 November in London. This single day event offers specialized program tracks for trademark, brand, copyright, design, and patent professionals, alongside an interactive stream and multiple networking opportunities. Register now and start planning your day: https://winteripconference26.eventify.io/p/#/overview

We hope you enjoy the issue.

Ellen Peet, Editorial & Creative Manager



Mission statement

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

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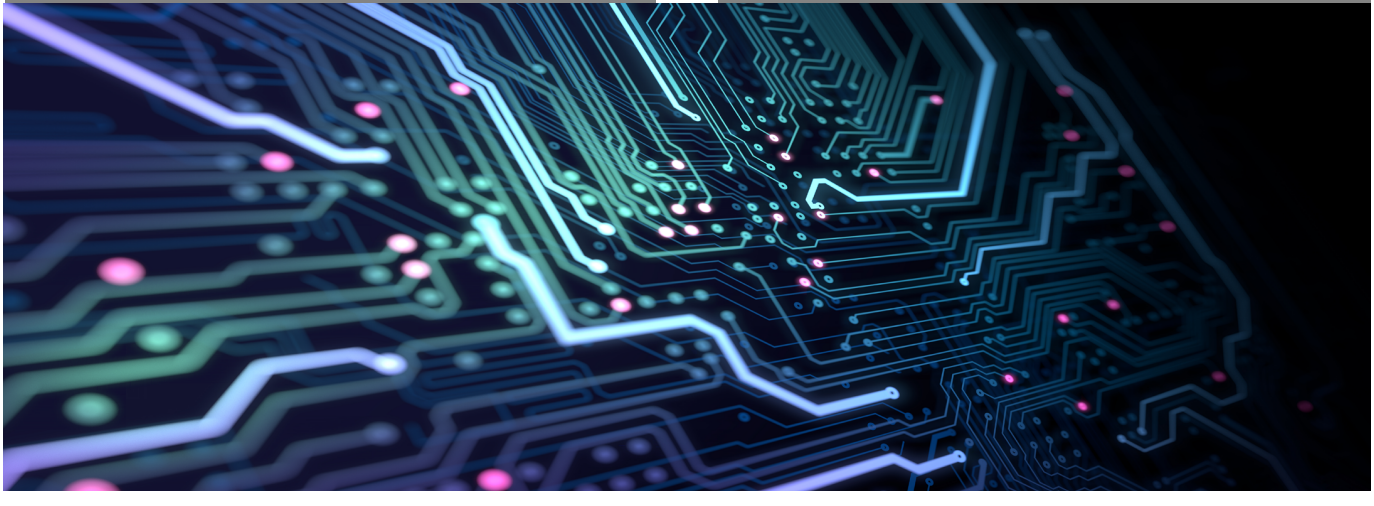
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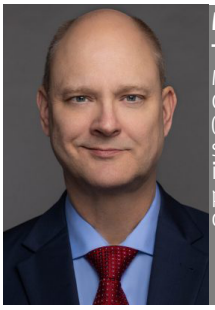




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In a career spanning over four decades, Pravin has emerged as an IP trailblazer having strengthened India's IP jurisprudence with a practice encompassing all areas of IP litigation, including patents, copyright, design, trademarks, enforcement, and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



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Using AI to redefine patent quality and service delivery

As AI rapidly reshapes patent practice, Stephen Moore, Peter Finnie, and Darren Brown of Potter Clarkson argue that its main value lies in amplifying expert judgment rather than replacing it. They present AI as a way to reallocate time away from routine, administrative, and mechanical tasks so that experienced patent attorneys can focus earlier and more consistently on strategic, high-value work for clients.



Stephen Moore



Peter Finnie



Darren Brown

> **Human ownership of the drafting process remains essential.**

Artificial intelligence is transforming patent practice at pace. A pace that is arguably unmatched by any technological shift since the introduction of email.

As innovation cycles shorten, markets evolve more rapidly, and client expectations continue to rise, the question is no longer what role AI will play, but how best to deploy it to deliver the greatest value for clients. The future of intellectual property advisory services will not be defined by how efficiently firms complete tasks. It will be defined by how effectively they apply expertise where it matters most.

Today, clients need more than technical excellence. They need faster access to insight (another email analogy), earlier involvement from senior advisers, and guidance that maps IP strategy to commercial objectives. They want advisers to focus their high-value time on the work that shapes opportunities and outcomes.

At Potter Clarkson, we see a clear distinction between reallocation and replacement. AI is not replacing expertise. It is allowing us to apply that expertise where it has the greatest impact for clients.

By embedding AI across fee-earner workflows and operational processes, we can remove administrative burdens, create more capacity for strategic work, and open up opportunities that were previously uneconomic or impractical. The result is a more responsive and senior-led client experience. Our patent attorneys and IP solicitors can spend less time managing processes and more time providing the insight, judgment, and commercial perspective that add most value.

This is not a distant vision or the future of patent practice. It is how we are operating today, and clients are already seeing the benefits.

As AI creates greater capacity for insight, judgment, and strategic input, clients receive more than faster processes. It creates opportunities for deeper client relationships, stronger protection, and earlier strategic involvement.

AI cannot replace expertise, but it can amplify it

From the outset, our objective was to use AI to improve outcomes, not simply to work faster.

This is primarily about reallocation rather than replacement. We have moved effort away from routine, time-intensive tasks and created more opportunity for experienced practitioners to provide strategic input earlier. This keeps the focus on the technical

and commercial issues that determine the value of our involvement.

This reflects a broader shift across the profession. Early adoption focused largely on time saved. Many firms are now assessing AI in terms of improvements in quality and capability, or what NLPatent, one of the leading AI-powered patent platforms, has described as 'quantum value.'

Potter Clarkson has made substantial progress in using AI to create space for earlier senior involvement. Our experience has also shown that the benefits extend beyond fee-earning work.

As clients began to see the benefits, our internal discussions broadened. The initial objective was to improve quality and increase strategic input. We then considered how the same tools could also support a more consistent and responsive client experience.

This has led to two related areas of development: improving the work carried out by our patent attorneys and improving the operational processes that support each client interaction.

A deliberate shift: from efficiency to enhanced value

Potter Clarkson has identified three core areas where AI is improving quality, capability, and strategic value: searching, drafting, and prosecution.

1. Searching

Prior art searching underpins good patent work. Potter Clarkson has been using AI-based natural language searching for more than three years, and that experience has shaped how we use these tools in practice.

AI allows attorneys to search using concepts rather than keywords alone, identifying relevant prior art more quickly and with greater contextual relevance. The benefit is not simply speed. Identifying the distinguishing features earlier provides a stronger basis for assessing patentability and developing an informed filing strategy.

The additional insight has also increased human interaction. We can carry out further searches and assessments live in client meetings when more information is needed. This allows the discussion to develop in real time and can support earlier go/no-go decisions.

The attorney therefore spends less time gathering information and more time discussing what it means. That is where the greatest value lies.

2. Drafting

Drafting remains central to patent quality. Technology can assist with background and descriptive sections, the structure of detailed specifications, testing claims against prior art, identifying inconsistencies and weaknesses, and administrative tasks such as renumbering and formatting. Human ownership of the drafting process remains essential.

All claims are written by experienced attorneys. AI can accelerate the mechanics of drafting, improve clarity and internal consistency, and identify potential issues earlier. It remains an aid to an attorney's experience and judgment, not a substitute for either.

By taking on some of the more mechanical aspects of drafting, AI gives attorneys more time to define claim scope, anticipate examiner objections, and align applications with commercial strategy. Clients benefit from more attorney time being directed to the parts of the drafting process that matter most.

> "Potter Clarkson has identified three core areas where AI is improving quality, capability, and strategic value."

3. Streamlined prosecution

In prosecution, AI is reducing friction and improving responsiveness at several stages of the workflow.

We use tools to analyze office actions, identify relevant prior art in context, test amendment strategies before submission, and automate administrative updates. This shortens iterative processes and allows attorneys to make informed decisions earlier.

More importantly, it supports a move from reactive prosecution towards a more proactive approach. Attorneys can anticipate challenges, refine arguments earlier, and maintain closer alignment with wider portfolio objectives.

It also creates more opportunity for senior attorneys to contribute throughout the workflow.

Bringing it together

These three areas formed the basis of our initial AI adoption. Since then, our practice has continued to evolve.

Rather than applying individual tools only to routine tasks, we are increasingly combining them to support more complex aspects of patent practice.

For example, we can take a client's technical input, identify the inventive kernel, conduct targeted prior art searches, assess patentability, and begin developing an appropriate filing strategy. Similar workflows can support EPO opposition work, FTO analysis, building claim charts against target products/processes, identifying divisional claim opportunities, and testing alternative claim strategies before substantial attorney time is invested.

The technology does not replace attorney

judgment. It allows us to spend more time applying it.

Experience still matters

AI makes experienced attorneys more effective. It does not make inexperienced attorneys experienced.

The value of AI depends as much on the person using it as the technology itself. Experienced practitioners know which questions to ask, how to test the output, and when further investigation is needed. Those skills develop through practice and cannot be supplied by the tool.

Patent work has traditionally been delivered through a layered model, with substantial delegation to junior attorneys and later-stage involvement from senior practitioners. By reducing the time spent on routine tasks, AI can make earlier and more sustained senior involvement economical.

This has practical benefits for clients. Greater continuity means fewer handovers and less fragmentation. Earlier access to experience and judgment can improve the quality of the work, while faster decision-making reduces delays between stages.

Junior attorneys still need to develop through supervision, experience, and exposure to real cases. AI should support that process rather than shortcut it. The aim is not to replace the traditional apprenticeship model, but to use the technology in a way that allows senior practitioners to contribute where their judgment adds most value.

> “Earlier access to experience and judgment can improve the quality of the work, while faster decision-making reduces delays between stages.”

Transforming the operational ‘engine room’

While much of our AI discussions have rightly been focused on how we can adapt our legal work to deliver more value for clients, our strategy is naturally extending to the firm's operational infrastructure.

As described internally, there is a 'quiet revolution' taking place behind the scenes that spans systems, processes, and data management. The firm made a deliberate decision early on: AI would not replace legal expertise, but would instead optimize everything surrounding it. We are on our mission to embed effective, safe, and enterprise-grade AI solutions to support our operational functions, including embedding it across a number of key operational functions, including:

- **Billing and finance:** automating generation and validation of complex billing data, reducing errors, and accelerating invoicing
- **Matter and data management:** cleaning, classifying, and maintaining records at scale, improving data quality
- **Compliance and conflict checking:** faster, more reliable screening processes
- **Document processing and routing:** intelligent handling of correspondence and internal documentation
- **Management information:** delivering more timely and accurate insight for better decision-making.

While all of this may not be visible to clients directly, the impact will be significant. Cumulatively, this will deliver a better client experience. More specifically, the emerging benefits for clients include cleaner, more accurate billing with fewer queries, faster onboarding and administrative turnaround, more responsive communication, reduced delays in internal processing, and greater transparency through improved reporting.

As with the patent functions, this will free up significant amounts of time that can be used to better effect in terms of supporting our clients because, as one of our colleagues wants to say, "every hour we save on process is an hour our people can spend on the things that require expertise, creativity, and judgment." Growing adoption will start to create a powerful loop. Better operations enable better legal work, which in turn enhances overall service delivery. It is the integration of these two strands, fee-earning enhancement and operational optimization, that we believe distinguishes Potter Clarkson's approach.

While many, if not most firms, are focusing on one or the other, Potter Clarkson is aligning both:

- **Front office (attorneys):** AI enhances insight, improves quality, and enables earlier senior professional involvement
- **Back office (operations):** AI removes friction, improves accuracy, and accelerates service delivery.

Together, these changes will create a more coherent and consistent client experience. Clients may not see the technology directly, but they will begin to experience it through faster, more informed advice, greater consistency across matters, improved responsiveness and communication, and, ultimately, a smoother end-to-end service.

Lessons learned

Our experience has highlighted several key principles for successful AI implementation that may be broadly applicable:

1. Data quality is foundational

AI effectiveness depends on the quality of underlying data. Investing in data integrity is critical to unlocking value.

2. People come first
Technology adoption only succeeds when teams understand, trust, and engage with it. Training and change management are as important as the tools themselves.

3. Focus drives results
Targeted, well-defined use cases deliver better outcomes than broad, unfocused deployment.

4. Governance is essential
Clear frameworks are needed to determine when and how AI should be used, ensuring quality and accountability.

These principles reinforce a broader point. AI transformation is as much organizational as it is technological.

While selecting the right tools is important, the greatest barriers to success are often cultural, operational, and behavioral. Again, lawyers and business services teams must understand how AI reallocates rather than replaces. This is particularly true with the most critical success factor for any law firm, its client relationships.

Implementation plans must extend beyond technology deployment.

Firms should establish clear governance structures, define accountability for AI initiatives, and secure visible sponsorship from senior leadership. Cross-functional working groups, including legal, risk, IT, knowledge management, and L&D teams, can all help align AI use cases with business priorities.

Early engagement is also essential to identify practical needs and address concerns around accuracy, confidentiality, and job impact. Firms should also invest in role-specific training, update policies and workflows, and measure adoption through user feedback and business outcomes, not simply usage metrics.

> “while selecting the right tools is important, the greatest barriers to success are often cultural, operational, and behavioral.”

Looking ahead
AI will continue to change what clients expect from their IP advisers. Those expectations will extend beyond technical excellence to faster access to insight, more proactive guidance, and a more consistent experience throughout the client relationship.

By reducing routine and administrative work, AI creates capacity for earlier and more meaningful involvement from experienced professionals. It allows advisers to focus more of their time on strategic counsel, anticipating risks, and helping clients make better commercial decisions.

The real opportunity presented by AI is not simply greater efficiency, although that is valuable. It is the opportunity to apply expertise more effectively and deliver greater commercial value for clients.

RÉSUMÉS

Stephen Moore, Senior Associate, Patent Attorney | Potter Clarkson
Stephen Moore is a UK and European Patent Attorney with expertise in semiconductors, photonics, medical devices, and other deep-tech fields. Drawing on eight years of industry experience as an inventor and engineer, he combines technical, legal, and commercial insight to help clients protect and commercialize innovation.

Peter Finnie, Partner, Patent Attorney | Potter Clarkson
Peter Finnie is a UK and European Patent Attorney, Partner at Potter Clarkson, and internationally recognized IP strategist. He works closely with innovative startups, scale-ups, and investors, helping them develop IP strategies that support fundraising, growth, and exit value. Combining patent expertise with strong commercial insight, Peter advises technology companies on IP risk, due diligence, and business planning.

Darren Brown, Programme Director | Potter Clarkson
Darren Brown is Programme Director at Potter Clarkson, where he leads strategic transformation programs focused on organizational design, stakeholder alignment, and cultural change. With more than 20 years’ experience in change management and strategy, he oversees the firm’s technical transformation, aligning the firm’s people, technology, and goals to deliver sustainable improvements and lasting success.

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Patent law at a crossroads: AI, harmonization, and emerging innovation

In this interview, AIPPI Reporter General Ralph Nack examines the key forces reshaping patent law, from AI and standard-essential patents to the Unified Patent Court and the growing influence of emerging innovation regions, while considering what practitioners should be prepared for by 2030.



Ralph Nack

> "AIPPI's unique strength lies in its global membership and its balanced, rigorous scientific approach to developing policy positions."

Ralph Nack is an expert in complex issues of patent law. He advises German and international clients primarily in patent litigation and in nullity and opposition proceedings. He is a leading international expert in patent licensing, especially regarding standard-essential patents (SEP FRAND licensing). His practice focuses on the areas of electronics, telecommunications, mechanical engineering, and pharmaceuticals.

What does the AIPPI Reporter General role involve, and what did you hope to achieve when you took on the role?

The Reporter General serves as the intellectual leader of AIPPI's substantive work program. All my work is teamwork – with the Reporter General Team (RGT) comprising six further highly dedicated members. Our role involves overseeing the development of AIPPI's Resolutions—authoritative statements on key IP issues that are shaped through contributions from our National and Regional Groups worldwide. Further, we coordinate the work of the Standing Committees of AIPPI. In addition, the RGT is responsible for the substantive program of all AIPPI events, in particular the World Congress and the MidTerm.

When I took on this role, my primary goal was to lead and shape the transformation of IP law in the era of artificial intelligence (AI). This is a monumental project, and I'm confident that my successors will continue the various projects I started. Next, I aimed to leverage the expertise of AIPPI in geographical regions of the world that are under dynamic economic development, most importantly the ASEAN countries, Africa, and Central America. Under my leadership, AIPPI organized several high-profile events in these regions, which triggered sustainable awareness of the importance of IP rights. Further, I believe that Model Laws are a very powerful tool to promote international harmonization of IP laws; therefore, I initiated AIPPI's work on a Model Law on Attorney-Client-Privilege and a further Model Law on Protection of Traditional Knowledge, which aims to follow the established principles of the protection of Geographical Indications.

What are currently the most significant developments or uncertainties facing the international patent system?

Several developments stand out. First, the continued fragmentation of approaches to patentability—particularly for software, AI, and biotechnology—creates uncertainty for innovators operating across multiple jurisdictions. Second, the enforcement of standard-essential patents (SEPs) and the ongoing debate around Fair, Reasonable, and Non-Discriminatory (FRAND) licensing remain highly contentious, with recent regulatory initiatives having failed. Third, the Unified Patent Court (UPC) in Europe represents perhaps the most significant structural change to the international patent landscape in decades, and its early jurisprudence will have far-reaching consequences. Finally, there is growing tension between the traditional territorial nature of patent rights and the increasingly global competition of jurisdictions, leading to critical questions of sovereignty and territorial interference.

How important is international harmonization of patent law, and where do the biggest obstacles to harmonization remain?

Harmonization is critically important. Innovators and businesses operating globally benefit enormously from predictability and consistency across jurisdictions. However, complete harmonization remains elusive—and perhaps unrealistic—given the deeply embedded differences in legal traditions, economic priorities, and policy objectives among nations. The biggest obstacles remain in areas such as the grace period, the treatment of computer-implemented inventions, and remedies for patent infringement. On substantive patent law, progress has been slow. AIPPI continues to advocate for convergence where possible, while recognizing that some degree of diversity may be both inevitable and, in certain respects, beneficial for fostering regulatory competition and experimentation. As said before, I believe that Model Laws are a very powerful tool to promote international harmonization of IP laws.

AI is rapidly changing both innovation and the practice of patent law. What are the most urgent questions the international IP community needs to address?

AI raises profound questions at every stage of the patent lifecycle. The most urgent issues include whether AI shifts or raises the required level of inventiveness (and sufficiency of disclosure), and whether inventions made by agentive AI systems without any human contribution shall be patent-eligible subject matter. The advent of AI fundamentally questions the core assumption underlying the global IP system, namely that intellectual achievements are the exclusive domain of human beings. AI

> "The biggest obstacles remain in areas such as the grace period, the treatment of computer-implemented inventions, and remedies for patent infringement."



also transforms how practitioners work—from prior art searching to claim drafting to litigation analytics. The international IP community needs to engage proactively with these questions rather than waiting for courts to address them case-by-case. AIPPI has been at the forefront of this discussion, and our Resolutions aim to provide balanced guidance that respects both the incentive function of patents and the unique characteristics of AI-driven innovation.

Do you expect AI-assisted or AI-generated inventions to fundamentally challenge existing concepts of inventorship, ownership, and patentability?

This is one of the defining questions of our time. Current patent law in virtually all jurisdictions requires a human inventor. The DABUS cases have tested this principle globally, and courts have consistently held that, under existing law, an AI cannot be named as inventor. However, the question remains whether this position should be maintained as AI capabilities advance. In my view, we must distinguish between AI as a tool—where human creativity directs and shapes the inventive process—and hypothetical scenarios of truly autonomous invention. For the foreseeable future, most AI-assisted inventions will fall into the former category, where existing concepts can be adapted. Nevertheless, legislators and patent offices should monitor developments closely. The greater challenge may be practical: ensuring that patent offices can properly examine AI-related applications and that the disclosure requirements remain meaningful when AI is involved.

How do you see the UPC developing, and what impact will it have on international patent strategy?

The UPC represents a historic development for patent litigation in Europe. After decades of discussion and several false starts, we now have a functioning unified court system that can grant pan-European injunctions and revoke European patents with unitary effect. The early decisions have been encouraging—the court is demonstrating both efficiency and legal sophistication. For international patent strategy, the UPC creates both opportunities and risks. Patentees can now enforce their rights across multiple EU Member States in a single proceeding, but they also face the possibility of central revocation. Companies must carefully evaluate whether to opt out their existing European patents and how to structure their portfolio strategy going forward. The interplay between the UPC and national courts, as well as the relationship with the European Patent Office (EPO), will continue to evolve. I expect the UPC to become an increasingly important global forum, and a model that other regions may study.

How can patent systems strike the right balance between rewarding innovation through strong patent rights and avoiding unnecessary barriers to competition and access to technology?

This is the perennial tension at the heart of patent policy, and there is no simple formula. Patents exist to incentivize innovation by granting limited exclusivity, but overly broad or poorly examined patents can impede follow-on innovation and competition. The key lies in rigorous examination standards, meaningful post-grant review mechanisms, and proportionate remedies. In the SEP context, FRAND commitments and access to dispute resolution mechanisms—including courts and arbitration—help mediate between patentees' legitimate interests and the needs of implementers. I believe the international system has generally struck a reasonable balance, but vigilance is required. Patent thickets, excessive litigation costs, and strategic behavior by some actors can distort the system. AIPPI plays an important role in identifying best practices and advocating for reforms that preserve the innovation incentive while ensuring that patents serve their public purpose.

What makes AIPPI's work particularly valuable to the global IP community, and how does it influence the development of international patent policy?

AIPPI's unique strength lies in its global membership and its balanced, rigorous

> "Companies must carefully evaluate whether to opt out their existing European patents and how to structure their portfolio strategy going forward."

scientific approach to developing policy positions. Our Resolutions are not advocacy documents for any particular interest group—they represent the considered views of IP professionals from over 100 countries, including private practitioners, in-house counsel, academics, and judges. This credibility makes AIPPI's voice influential at WIPO, in national legislative processes, and in judicial proceedings where courts seek guidance on international best practices. The AIPPI World Congress provides an unparalleled forum for exchanging ideas and building the personal relationships that underpin effective international cooperation. In an era of increasing geopolitical tension and regulatory divergence, AIPPI's role as a neutral convener and thought leader is more valuable than ever.

What emerging issue do you think the patent profession is currently underestimating?

I believe the profession is underestimating the speed and scale of change that AI will bring—not only to the substance of patent law but to the practice itself. Many firms and patent offices are still approaching AI as a marginal efficiency tool rather than a transformative force. Additionally, the intersection of patent law with data governance, cybersecurity, and sustainability regulations deserves more attention. We are also seeing a growing disconnect between the technical complexity of modern inventions—particularly in areas like quantum computing, synthetic biology, and advanced materials—and the capacity of legal systems to evaluate them properly. Finally, geopolitical fragmentation poses real risks to the international IP system. The profession should be more actively engaged in defending the multilateral frameworks that have served innovation well.

Looking ahead to 2030, what do you think the international patent system will look like, and what should practitioners and businesses be doing now to prepare?

By 2030, I do not think today's major powers will simply disappear. They will remain major powers, but much of their effort will be directed towards maintaining their position and preserving their technological advantage.

The more significant change may come from those who are not yet considered major powers. AI is lowering some of the barriers that have traditionally separated technological leaders from emerging economies. Countries that were previously seen primarily as markets, manufacturing bases or followers may increasingly become sources of innovation themselves.

And this is where I think we should pay particular attention. The real geopolitical shift may not be the decline of existing powers, but the emergence of new centers of invention that the international patent system has not traditionally been designed around. We are already seeing ambitious industrial and technological strategies in regions such as North Africa, as well as in India and Brazil.

By 2030, the geography of invention could therefore be much more open than the geography of economic power is today. AI can accelerate that transition because knowledge, research capabilities and technological tools are becoming less constrained by borders.

So the question for the patent system is not simply whether we will have more inventions. It is whether we will have the legal frameworks, the institutions and the courts capable of recognising, understanding and protecting innovation wherever it emerges.

The real challenge may be that innovation will move faster than the legal systems designed to protect it.

> **"The real geopolitical shift may not be the decline of existing powers, but the emergence of new centers of invention that the international patent system has not traditionally been designed around."**

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Inventing unclarity: the expanding reach of Article 84 EPC

Jan Goering of Boehmert & Boehmert argues that Article 84 EPC clarity objections have expanded beyond their intended procedural role in European patent examination. Drawing on the EPC's legislative history and international patent frameworks, Jan contends that clarity should facilitate examination rather than operate as a substantive tool for narrowing otherwise allowable claims. He warns that overuse of clarity objections risks shifting attention from technical contribution to semantic precision, and might even breach the institutional division between examiners and judges.



Jan Goering

> The EPC entrusts examining divisions with deciding whether an invention merits a patent, while leaving the ultimate determination of the patent's scope to the courts.

For decades, the European patent system has been admired for its rigorous and technically sophisticated examination. The European Patent Office's (EPO) reputation rests on its ability to distinguish genuine innovation from the prior art through a careful assessment of novelty and inventive step. However, one requirement that occupies only a modest place in the legal framework has gradually assumed a disproportionate importance during prosecution.

Clarity under Article 84 of the European Patent Convention (EPC) has gained an ever more prominent presence in the dialogue between applicant and examiner, often at the expense of attention to the underlying technical contribution. For many applicants familiar with prosecution before the IP5 group, including the USPTO, the JPO, the KIPO, and the CNIPA, this emphasis is difficult to understand. European examination practice appears to be drifting away from that of many other major patent offices.

Applicants are often surprised that objections based on Article 84 EPC can become a major issue during prosecution, even where the invention itself is technically sound and encounters little difficulty elsewhere. The result is increased prosecution costs and the perception that formal issues are being elevated above substantive patent law.

The perceived imbalance is increasingly difficult to justify and to reconcile with the practical realities of patent litigation, where courts routinely interpret claims through the eyes of the skilled person rather than demanding semantic precision.

What Article 84 EPC was meant to do

This raises an obvious question. Was Article 84 ever intended to carry such weight?

History offers little support for that proposition.

The EPC was developed in parallel with the Patent Cooperation Treaty (PCT). Drafts for the EPC, according to which "the specification

must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art," resemble the wording of Article 5 PCT, further elaborating that "The specification shall conclude with one or more claims defining the protection applied for."

The requirement ultimately set out in Article 84 EPC was derived from initial drafts of the implementing regulations "regarding formal requirements of different parts of a patent application" in various articles concerning "form of the request for grant of a patent," "form of the drawings," or "form and content of claims."

It is evident regarding the conception of Article 84 EPC that its authors intended to draw a line between the different parts of a patent application, namely the claims, the description and drawings, and the request. Initial precursors of Article 84 EPC essentially consist of the requirement that claims should not contain references to the description and drawings. As the Travaux Préparatoires show, it was agreed that the article concerning the form and content of the claims should not immediately jump to this issue but rather commence with a general definition of what "patent claims" entail. It was initially suggested that "The patent claims embody the fundamental principle of the invention and, where applicable, the secondary aspects that characterise that principle."

To achieve a more general definition, "to state the essential purpose of the patent claims, which is to specify the element for which the inventor seeks protection," the redactional sub-committee was tasked with additional polishing due to the farsighted concern that "A definition that goes into too much detail would lead to numerous difficulties."

Against this background, the following wording was eventually adopted in the preliminary draft of April 1971, corresponding to Article 6 PCT: "The claims shall define the matter for which protection is sought. They shall be clear and concise and be fully supported by the description."

Subsequent discussions in the legislative bodies were focused on the relevance of the claims' support through the description. The term "fully" was deleted prior to ratification. Before the revision of the Convention, concerns were found to be adequately covered through Article 83 EPC. The conclusion of the legislative discussion rejects giving Article 84 EPC a more important role, finding that "the potential for abuse would be considerable."

Nothing in the Travaux Préparatoires of the original EPC or its revision suggests that the provision of Article 84 EPC was intended to become a substantive hurdle comparable to novelty or inventive step.

> **"The benchmark is whether the skilled person can practice the invention – not whether every linguistic ambiguity has been eliminated."**

The international benchmark

An examination of the international framework is likewise instructive.

The Paris Convention and the TRIPS Agreement, the major international treaties forming the foundation of the modern patent system, contain no independent requirement for patent claims to satisfy a "clarity" standard comparable to that set out in Article 84 EPC. They require disclosure sufficient to enable the invention and recognize the traditional conditions for patentability, but they do not elevate linguistic precision to an independent legal principle. The focus remains technical. The benchmark is whether the skilled person can practice the invention – not whether every linguistic ambiguity has been eliminated. This reflects an important policy choice. Patent law is concerned with the communication of technical knowledge. Language is merely the vehicle through which that knowledge is conveyed – the international standard concerns technical understanding rather than semantic perfection.

The implementation of Article 6 PCT in accordance with paragraphs 9.34 – 9.39 of the PCT International Search and Preliminary Examination Guidelines maintains the treatment of clarity subordinate to the substantive requirements of patentability.

The "clarity" requirement serves an important but limited procedural function. It ensures that the applicant defines the matter for which protection is sought with sufficient precision to enable the examination to proceed and the public to understand.

Lack of clarity is excluded from the grounds on which a granted European patent may be revoked. A patent remains enforceable even though its claims could, in hindsight, have been drafted more elegantly. This was no legislative oversight. It reflects a deliberate choice during both the conception and the revision of the EPC that clarity should facilitate examination rather than determine the validity of granted rights.

Yet examination practice has gradually moved in another direction. Over the past decades, Article 84 EPC has evolved from an auxiliary drafting provision into one of the most frequently invoked objections during prosecution. It is no longer unusual for applicants to spend considerably more effort defending the wording of otherwise patentable claims than addressing the substantive requirements of Articles 54 and 56 EPC.

The Enlarged Board's decision in G 1/24 sent an encouraging signal by placing renewed emphasis on a technically meaningful interpretation of patent claims. However, early indications suggest that the underlying tendency has by no means disappeared. Recent decisions such as T 1420/24 appear to be indicative of a trend expand on T 68/85 in order to scrutinze functional claim language even more by considering functional features, as a matter of principle, as objectionable "results to be achieved."

If this tendency were to become established practice, it would represent more than a refinement of the clarity doctrine. Such an approach would constitute a significant departure from established case law, beginning with T 238/88, which has long recognized that broad, functional features are entirely appropriate when the skilled person is provided with sufficient technical information. It would alter the balance between legal certainty and effective patent protection that Boards of Appeal jurisprudence has developed over several decades.

Breadth is not unclarity

Breadth itself is not a defect. Patent law has always been intended to allow applicants to claim in proportion to their technical contribution. The relevant question is whether the limits of the claim can be understood – not whether they are commercially ambitious. Terms like "a vehicle" or "a fastening element" are extremely broad but nevertheless perfectly clear.

Moreover, the question is not whether an applicant *desires* broad protection, but whether the law *entitles* the applicant to it. That entitlement is determined through the substantive requirements of the EPC: novelty, inventive step, sufficiency, added matter. It is not determined through an assessment by the examining division of what might be considered an appropriate commercial monopoly.

The effective breadth of patent protection has always been governed by substantive patent law and, ultimately, by judicial claim interpretation – as confirmed by the answer of the enlarged Board of Appeal in G 1/24 with regard to the first referred question.

It has never been the function of examination proceedings, nor the mandate of the examining division, to reshape claim scope based on assumptions about future litigation or commercial strategy. It is questionable whether it has the mandate to decide whether the applicant is entitled to a broader or narrower formulation once the statutory requirements of patentability are met. That question concerns the extent of exclusive rights – a question that the EPC reserves for judicial interpretation and, limited to the prohibition of amendments according to Art. 123(3) EPC, to revocation proceedings based on the substantive grounds laid down in the Convention.

> **"Moreover, the question is not whether an applicant *desires* broad protection, but whether the law *entitles* the applicant to it."**

Examination under Article 84 EPC, therefore, serves a different purpose: ensuring that the claimed subject-matter can be identified for the purposes of grant, rather than anticipating every future question of claim construction.

The European patent system deliberately allocates different responsibilities to different institutions. Examining divisions determine whether an application satisfies the statutory requirements for the grant of a European patent. They assess novelty, inventive step, sufficiency, and the other conditions set out in the Convention.

The determination of the scope of the resulting rights is a different constitutional function. It arises only in concrete disputes, where the Unified Patent Court and national courts interpret the granted claims with respect to the allegedly infringing embodiment through the eyes of the skilled person in light of the specification and the prior art.

This division of responsibilities reflects the architecture of the EPC. Examination is conducted ex ante, before any commercial product or infringement dispute exists. Courts operate ex post, with the benefit of an actual controversy and adversarial proceedings. The examiner therefore asks whether the statutory conditions for grant are fulfilled. The court asks what protection the granted claims confer in the circumstances of a particular case. These are related but fundamentally different inquiries.

For that reason, breadth and clarity should not be conflated. Whether a claim is broad is a question of the extent of protection, not of clarity. A claim may deliberately encompass numerous technical embodiments while remaining perfectly intelligible to the skilled person. Whether such breadth is justified by the applicant's technical contribution is ultimately tested through the substantive requirements of patentability and, after grant, through judicial interpretation and revocation proceedings. If Article 84 EPC were instead used as an indirect mechanism for restricting otherwise comprehensible claim language, the examining division begins to perform a function that the EPC appears to reserve for the courts.

A means – not an end

Using clarity objections as an indirect mechanism to narrow otherwise allowable claims risks assigning Article 84 EPC a function that neither its wording, nor its legislative history, nor the architecture of the EPC appears to support. Read that way, the objection is itself the invention.

What emerges from this analysis – historical, structural, and comparative – is a straightforward conclusion: No patent system can function without claims defining the scope of protection. Yet their clarity is a means, not an end. The EPC entrusts examining divisions with deciding whether an invention merits a patent, while leaving the ultimate determination of the patent's scope to the courts.

Preserving that institutional balance is not a weakening of Article 84 EPC but rather a recognition of the limited but important role that its drafters intended it to play. If examination increasingly prioritizes semantic perfection over technological contribution, the balance envisaged by the EPC risks becoming skewed. The EPO was established to grant exclusive rights in exchange for the disclosure of technical contributions, not to police language.

RÉSUMÉ

Jan Goering is a German and European Patent Attorney, a Representative before the UPC, and a partner at BOEHMERT & BOEHMERT. He provides strategic counsel on intellectual property protection. He is experienced in adversarial patent proceedings and involved in prosecuting patents before patent offices. His career includes positions at the German Patent and Trademark Office, the Federal Patent Court, and a patent litigation division of the Düsseldorf Regional Court. He is a member of the Executive Board of the Bundesverband Deutscher Patentanwälte (Federal Association of German Patent Attorneys) and co-author of their amicus curiae brief in the G1/24 case.

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Compliance boundaries of generative AI tools in patent drafting

Kaiwen LIU of Beijing Sanyou IP Agency Ltd. examines the growing use of generative AI in patent drafting and Office action responses, identifying where it can be deployed compliantly and where it risks crossing professional and ethical boundaries. While AI can improve efficiency in routine tasks, Liu argues that it must never replace attorney judgment. Instead, patent agencies should adopt a comprehensive compliance framework centered on secure AI tools, human oversight, client consent, rigorous manual review, and traceable audit records.



Kaiwen LIU

> **Deepening adoption has given rise to global compliance risks, including trade secret leakage, substantive document defects from AI hallucinations, abnormal application findings, and disciplinary sanctions.**

The proliferation of generative large language models is reshaping patent agency practices. Widely used for background art polishing, claim wording optimization, and preliminary prior art screening, AI tools have become routine efficiency boosters for patent attorneys. Yet deepening adoption has given rise to global compliance risks, including trade secret leakage, substantive document defects from AI hallucinations, abnormal application findings, and disciplinary sanctions.

Since 2025, regulators and industry associations in major jurisdictions (China, the US, Europe, and Japan) have issued AI application guidelines to define practice red lines. By 2026, the industry has shifted from debating AI adoption to managing compliant AI usage. For patent attorneys, clarifying compliance boundaries, identifying full-chain practice risks, and building a systematic prevention framework are fundamental to service quality, risk mitigation, and professional accountability.

Boundaries of AI application in patent drafting and Office action responses

Generative AI use in patent drafting is not inherently non-compliant. The core compliance test is whether attorneys retain substantive control and full professional responsibility for final documents. Per global industry consensus, use cases fall into compliant auxiliary scenarios and prohibited red-line scenarios.

Compliant auxiliary scenarios

AI is limited to administrative tasks without involvement in core technical or legal judgments, subject to full attorney review and revision:

1. **Text and format standardization:** Polishing wording, unifying terminology, and formatting finalized drafts to align with jurisdictional drafting conventions.
2. **Preliminary prior art screening:** Generating general narrative frameworks or conducting initial prior art searches, with final screening and

verification completed by attorneys.

3. **Office action response support:** Structuring conventional defense frameworks to streamline response drafting, while final legal arguments and amendments remain human-driven.
4. **Multilingual translation assistance:** Providing machine translation drafts for professional proofreading and legal term calibration by attorneys.

Prohibited practice red lines

Global regulators uniformly bar AI from replacing core professional judgment. Four scenarios constitute clear red lines:

1. **Direct generation of final filing documents:** The 2025 revised *Code of Professional Ethics and Practice Discipline for Patent Attorneys* by the All-China Patent Attorneys Association explicitly prohibits AI-generated final filing documents. Japanese and European patent attorney bodies likewise hold attorneys fully accountable for final submissions, with no exemption for AI output.
2. **Substantive core claim drafting:** AI may not independently design claim structures, define protection scopes, or combine technical features with only superficial review. Claim strategy, a core professional judgment, must be led by human attorneys.
3. **Fabrication of technical content:** Using AI to invent embodiments, falsify experimental data, or supplement undisclosed details to remedy inadequate disclosures, which risks insufficient specification disclosure and bad-faith application findings.
4. **Concealment of the actual extent of AI usage:** Concealing the deep involvement of AI in core drafting stages from clients or patent offices and misrepresenting AI-generated content as the original work of patent attorneys violates the principle of good faith in professional practice.

Core practice risks of generative AI

Use of AI beyond compliance boundaries triggers multi-level risks, including patent validity impairment, disciplinary sanctions, and civil liability, the consequences of which are often irreversible.

Patent law validity risks

1. **Substantive defects from AI hallucinations:** Generative AI's inherent tendency to fabricate facts may produce false parameters, non-existent prior art citations, and inconsistent features, leading to rejections for insufficient disclosure or indefinite claims. Even granted patents face fatal invalidation risks from such defects.
2. **Novelty loss from technology leakage:** Inputting undisclosed disclosures or confidential parameters into public consumer-grade AI risks information entering the public domain via platform data retention and training reuse, destroying patent novelty.



> "Japanese and European patent attorney bodies likewise hold attorneys fully accountable for final submissions, with no exemption for AI output."

Such loss falls outside statutory grace periods and is nearly irreversible.

3. **Defective inventor designation:** Listing only natural persons as inventors when AI has substantially contributed to conception constitutes false inventorship. The US and Japan restrict inventorship to natural persons making substantive creative contributions; undisclosed material AI involvement may render patents unenforceable or invalid.
4. **Training data infringement risks:** AI trained on unauthorized patent texts may generate claims substantially identical to existing patents, triggering abnormal application findings or infringement liability.

Disciplinary and administrative risks

1. **Industry disciplinary sanctions:** In China, improper AI use for filing documents may result in criticism, public condemnation, membership revocation, and credit file entries. In Europe, epi code violations trigger disciplinary investigations jeopardizing practice qualifications.
2. **Abnormal application penalties:** In 2026, CNIPA clarified that AI-generated, randomly pieced-together applications constitute bad-faith filings, subjecting agencies and attorneys to license revocation, qualification cancellation, and serious dishonesty listing. Local pre-examination authorities have already suspended services for agencies with AI-generated filings.
3. **False representation liability:** The USPTO's 2024 guidance holds attorneys accountable for document authenticity upon filing. AI-generated false statements do not excuse liability, and attorneys face administrative fines and practice restrictions for breaching good faith obligations.

Civil and commercial risks

Improper AI use that leads to patent rejection, invalidation, or trade secret leakage exposes agencies and attorneys to breach-of-contract damages, covering direct costs and indirect competitive losses that far exceed service fees. Given the profession's reliance on trust, such quality incidents also cause lasting reputational damage and client attrition.

Comparison of regulatory rules across major jurisdictions

Global AI regulation shares the principle of "permitted use with clear accountability," but enforcement stringency varies:

- **China:** The strictest ex-ante regime, with explicit bans on AI-generated final filing documents. Enforcement relies on abnormal application screening, credit grading, and coordinated self-regulatory and administrative oversight.
- **United States:** No blanket ban on AI-assisted drafting or universal mandatory disclosure. Disclosure is required only when AI materially affects patentability, with regulation centered on ex-post accountability for concealed usage.
- **Europe:** epi's 2024 guidance sets principled self-regulatory standards without blanket bans, focusing on good faith, manual verification, client informed consent, and confidentiality.
- **Japan:** AI is explicitly defined solely as an auxiliary tool, and patent attorneys (benrishi) shall bear full legal liability for AI output. The rules focus on data security, requiring prior written consent from clients for the use of public cloud AI, and giving priority to local on-premises deployment solutions.

Building a full-process compliance prevention framework

Compliant AI use requires a system of "controllable tools, traceable processes, and clear accountability" to keep AI in an auxiliary role and uphold attorney oversight.

Tool selection: mitigating data security risks at source

Frequent AI users should prioritize on-premises private models to keep all data internal. Public tools, if necessary, must be enterprise-grade services with confidentiality agreements and no training data reuse; consumer-grade AI is strictly prohibited for confidential cases. Agencies should maintain

> "Generative AI's inherent tendency to fabricate facts may produce false parameters, non-existent prior art citations, and inconsistent features."

an allowlist of approved tools vetted by IP compliance teams.

Process control: defining human-AI roles and accountability

A tiered usage policy governs drafting stages: unrestricted use for administrative tasks; auxiliary use with extensive human revision for semi-professional tasks; and full AI prohibition for core professional tasks (claim structuring, technical argumentation, legal opinions). Clients must be informed of AI usage scope and risks, with written consent obtained in advance.

Quality audit: strengthening substantive manual review

An "AI generation – human verification" workflow mandates full technical and legal review by assigned attorneys, with revision trails documenting substantive human intervention. High-value and key client cases require secondary review by senior attorneys to catch AI-introduced latent defects.

Audit trail management: enabling traceability and evidence

Case-specific AI usage logs should record tools used, application stages, input scope, revision rates, and reviewers. Full version histories must be retained to demonstrate the extent of human modification and clarify liability in disputes or regulatory investigations.

Conclusion

Generative AI's efficiency gains are an industry inevitability, but efficiency must never override compliance and quality. For patent attorneys, AI amplifies professional expertise rather than replacing it—core competencies in technical analysis, scope balancing, and legal reasoning remain irreplaceable. Tightening global regulation defends the profession's foundational standards amid technological change. Clear compliance boundaries and robust prevention frameworks are essential for both risk mitigation and sustained competitiveness. Only by leveraging AI within compliance boundaries and retaining human professional leadership can the industry advance efficiency while upholding the quality and integrity of patent services.



RÉSUMÉ

Kaiwen LIU serves as a patent attorney specializing in foreign-related intellectual property practice at Beijing Sanyou IP Agency Ltd., a full-service IP law firm founded in 1986 in Beijing, P.R. China. He earned his degree from RWTH Aachen University in Germany. He possesses extensive expertise in technical fields, including electronics, telecommunications, and mechanical engineering, covering comprehensive IP services such as patent prosecution, reexamination and invalidation proceedings, patent searches, and IP consultation.

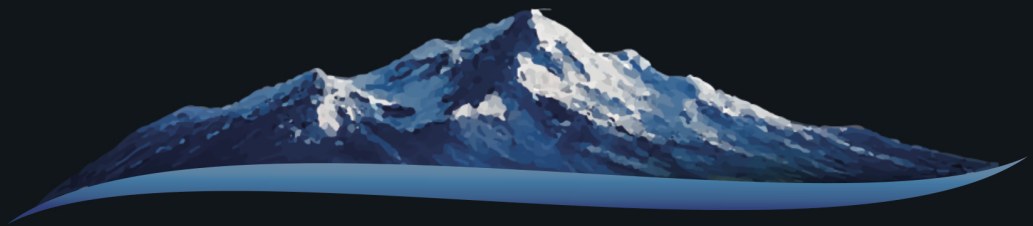
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Springboard effects in German patent litigation: post-expiry sales, consumables, and foreign profits

Recent German case law is making damages claims more attractive for patentees – and more complex for defendants – particularly where infringing products create long-term revenue streams beyond the initial sale. Dr Christian Meyer and Heike Röder-Hitschke of Maiwald explain how German courts are expanding patent damages to capture infringement-driven follow-on revenues.



Dr Christian Meyer



Heike Röder-Hitschke

> An infringing act may create commercial opportunities that continue to generate revenue even where the later transaction is not itself an act of infringement.

German patent litigation has traditionally been associated with fast injunctive relief rather than large damages awards. That perception is changing. In substance, recent German case law increasingly addresses effects that comparative lawyers might describe as a "springboard effect": an infringing act may create commercial opportunities that continue to generate revenue even where the later transaction is not itself an act of infringement. The decisive issue is not whether each later transaction is itself infringing, but whether it has a sufficient causal and economic nexus to an infringing act committed within the patent's temporal and territorial scope.

Recent decisions of the German Federal Court of Justice, the Higher Regional Court of Karlsruhe and the Munich Regional Court illustrate this shift. Damages may now reach beyond the first sale of an infringing product and extend to follow-on revenues from an installed base, consumables, leasing, maintenance, or service contracts. In suitable cases, even post-expiry revenues or profits generated through foreign performance may become relevant.

This does not mean that German law has introduced punitive damages. Patent damages remain compensatory, and there is no general German equivalent to enhanced damages for willful infringement under US law. The change lies elsewhere: compensation is increasingly assessed by reference to the commercial reality of the infringement and the economic opportunities it created for the infringer.



Importantly, this development does not replace the traditional German damages framework; it reshapes how that framework is applied. German law continues to recognize three established methods of calculating patent damages: lost profits of the patentee, infringer's profits, and a reasonable royalty by license analogy. The recent springboard cases are most important for infringer's profits, but their reasoning also influences how courts and parties approach lost profits and reasonable royalties.

The doctrine: causation, not formal infringement

The springboard idea is straightforward. A patented product may do more than generate revenue from its initial sale. It may create an installed base, provide access to customers, support recurring revenue from consumables or service contracts, or allow the infringer to enter a market earlier than it otherwise could have done. In such cases, the infringement operates as a commercial springboard.

German courts do not necessarily use the term "springboard damages" as a doctrinal label, but recent Federal Court of Justice case law recognizes the substance of the concept. The question is whether later profits are sufficiently causally and economically linked to an infringing act committed within the patent's temporal and territorial scope.

This distinction between liability and quantum is important. The infringing act must still fall within the patent's territorial and temporal scope. But once liability has been established, the damages analysis may look at broader economic consequences. The subsequent profit may arise from a consumable, a service contract, a post-expiry transaction, or a foreign project. If the causal and value-based nexus is sufficient, it may become relevant.

Three dimensions of the new case law

Subject-matter: consumables, leasing, and maintenance

The starting point is the Federal Court of Justice's decision in *Polsterumarbeitungsmaschine*.[1] The case concerned machines for converting paper into cushioning material. The defendant's business model was not limited to the supply of machines; it also generated revenues from leasing arrangements, maintenance, and paper consumables used with the machines.

The procedural background is worth noting. The Karlsruhe Higher Regional Court had already taken a broad view of accounting claims for leasing, maintenance, and consumables, including post-expiry revenues traceable to pre-expiry infringement in 2021 and 2023.[2] The Federal Court of Justice later upheld the core findings of this approach. The Court held that, when damages are calculated on the basis of the infringer's profits, all profits causally linked to the patent infringement must in principle be considered. This is not limited to profits made on the infringing product itself. Profits from additional transactions may also be relevant if (1) they are causally connected to the infringing act and (2) have a sufficient nexus to the infringing product.

> "The Federal Court of Justice held that profits realized after patent expiry may be taken into account if they were caused by infringing acts committed during the patent term."

This reasoning produces effects that resemble a springboard analysis: maintenance contracts, leasing arrangements, consumables, and potentially spare parts may fall within the damages analysis even if they are not themselves acts of infringement. Otherwise, an infringer could retain part of the market opportunity created by placing infringing machines in the market.

This does not mean that all follow-on revenue must automatically be surrendered in full. The attributable share must still be assessed, and revenues may also be influenced by service quality, customer relationships, pricing, or non-patented features. But such arguments usually belong to the damages quantum stage. They do not normally defeat the accounting claim, for which it is sufficient that the follow-on transaction may be relevant.

This is a key practical point. Defendants usually cannot avoid accounting for consumables, maintenance, or leasing revenues merely by asserting that those revenues were driven by factors other than the patented invention. Those arguments belong primarily to the damages quantum stage.

Time: post-expiry revenues

The same decision also clarified the temporal dimension. The Federal Court of Justice held that profits realized after patent expiry may be taken into account if they were caused by infringing acts committed during the patent term. The Court emphasized that this does not extend the patent monopoly beyond expiry. The legal anchor remains the pre-expiry infringement.

The practical effect is significant. If the infringement created an installed base during the patent term, later revenues from that installed base may remain relevant. Products placed on the market in infringement of the patent do not simply become economically "clean" when the patent expires.

This is particularly relevant for durable goods and equipment that generate after-market revenues. In such cases, the

commercial value of the infringement may lie not only in the initial sale or lease, but in the longer-term customer relationship created by the infringing placement of the product.

Territory: foreign performance

The Federal Court of Justice's decision in *Verdampfungstrockneranlage* adds the territorial dimension.[3] The defendant had made an infringing offer from Germany for a plant to be built in Sweden, where no patent protection was in force. The Court held that profits from the foreign performance of that contract must not be excluded merely because the delivery and installation took place in a patent-free country.

The causal link was established because the delivered product was the subject of the infringing offer that led to the contract. This does not violate the territoriality principle: liability remains anchored in an infringing act within Germany, while recovery is limited to the part of the profit attributable to that act.

Quantification: the Munich Regional Court's *Glätteverfahren* judgment

Most recently, the Munich Regional Court's 2026 first-instance judgment in *Glätteverfahren* illustrates how these principles may operate in practice. The decision is likely to attract attention, as it translates the Federal Court of Justice's "springboard" reasoning into numeric terms.[4]

The patent concerned a smoothing process for 3D-printed objects. The defendant sold machines suitable for performing the patented process and solvents used in those machines. The Court awarded more than EUR 1 million based on the infringer's profits, applying an attribution factor of 50% for the machines and 70% for the solvents due to their closer functional connection to the patented process.

The case is also important because the patent was a process patent. The Court considered follow-on sales of consumables relevant where the machines were effectively dedicated to carrying out the patented process and no realistic non-infringing use had been shown.

The judgment also addressed post-expiry sales. For sales of formerly infringing products made within three months after patent expiry, the Court accepted a rebuttable presumption that those sales were based on offers made during the patent term. For post-expiry consumables and supporting services, the Court considered unlimited participation difficult to reconcile with the limited term of patent protection. As a pragmatic, case-specific approach to quantification, it considered a 10-year period after patent expiry, with the attributable share decreasing linearly by 10 percentage points per year. This should not be understood as an established 10-year rule under German patent law. The Munich Court referred to this as a "blurry factor", reflecting the decreasing causal force of the original infringement over time.

> **"Defendants may argue that a fixed 10-year model is too mechanical and that causation must be assessed individually."**

This approach is new and will likely be debated. Defendants may argue that a fixed 10-year model is too mechanical and that causation must be assessed individually. Patentees, however, will welcome the model as a workable way to value long-term installed-base effects.

The decision is also notable for its comments on reasonable royalties.[5] Although the case was decided on infringer's profits, the Court indicated that a damages royalty rate may, in appropriate circumstances, be increased up to three times the market rate. The reasoning was not punitive: a hypothetical negotiation after judicial confirmation of infringement is not the same as an ordinary pre-dispute licensing negotiation.

Any such uplift will likely remain controversial, but if followed by other courts, it could make the reasonable royalty method more attractive for patentees.

The Munich Court also confirmed a patentee-friendly approach to deductible costs, being in line with Federal Court of Justice case law,[6] and lost profit substantiation, but those issues go beyond the springboard focus of this article.

Whether appellate courts will endorse the 10-year model, the blurry factor, or the royalty uplift remains to be seen. Still, the judgment has clear signal value: German courts are prepared to engage with the economic reality of installed-base business models and to develop practical tools for quantifying springboard effects.

Strategic takeaways

For patentees, the accounting claim is the gateway to meaningful damages. It should not stop at sales of the infringing product where the business model suggests recurring revenue. Already in the first infringement action, patentees should consider requesting accounts for the entire commercial ecosystem surrounding the infringement:

- consumables, spare parts, and replacement components;
- leasing, rental, or usage income;
- maintenance, service, and support contracts;
- post-expiry transactions linked to pre-expiry infringement; and
- foreign revenues resulting from an infringing act in Germany.

If follow-on transactions are not included in the accounting request, the patentee may face limitation issues or may need to bring a separate action for supplementary accounting. The defendant's business model should therefore be analyzed early.

For defendants, the strategic focus shifts to causation and the break of the causal chain. Arguments that follow-on revenues were driven by customer relationships, service quality, price, brand reputation, or non-patented technical features usually matter only at the damages quantum stage. They do not normally reduce the scope of the accounting obligation.

Defendants should therefore build evidence early, in particular on:

- realistic non-infringing uses of the accused product,
- independent reasons for consumable or service purchases,
- customer-specific procurement decisions,
- the timing of offers, orders, deliveries, and follow-on contracts, and
- detailed direct cost documentation.

Most importantly, defendants should consider workarounds early, potentially already in first-instance infringement proceedings. A genuine redesign, conversion, or replacement may help break, or at least reduce, the causal nexus to later revenues.

> **"For defendants, the strategic focus shifts to causation and the break of the causal chain."**

Outlook

The risk area for companies active in Germany has expanded. Profits generated abroad, after patent expiry, or through formally non-infringing consumables or services may all become relevant if they can be traced back to an infringing act within the German patent's scope.

German patent damages remain compensatory, not punitive. But compensation is now being assessed with greater attention to commercial reality. Where an infringement acts as a springboard for later revenue streams, those revenues may become part of the damages analysis. Damages in German patent litigation are therefore no longer merely an afterthought after the injunction.

Footnotes

1. Federal Court of Justice, judgment of 14 November 2023 – X ZR 30/21, GRUR 2024, 273 – *Polsterumarbeitungsmaschine.*
2. Karlsruhe Higher Regional Court, judgment of 10 March 2021 – 6 U 9/16, GRUR 2022, 641 – *Polsterumarbeitungsmaschine*; Karlsruhe Higher Regional Court, judgment of 22 February 2023 – 6 U 245/21, GRUR-RS 2023, 26668 – *Polsterumarbeitungsmaschine* II.
3. Federal Court of Justice, judgment of 7 May 2024 – X ZR 104/22, GRUR 2024, 1201 – *Verdampfungstrockneranlage.*
4. Munich Regional Court I, judgment of 16 April 2026 – 7 O 8367/25, GRUR-RS 2026, 11822 – *Glätteverfahren.*
5. See also Munich Regional Court I, judgment of 25 March 2010 – 7 O 17716/09, NJOZ 2011, 1318 – *Gülleausbringungsvorrichtung.*
6. Federal Court of Justice, judgment of 2 November 2000 – I ZR 246/98, GRUR 2001, 329; Federal Court of Justice, judgment of 24 July 2012 – X ZR 51/11, GRUR 2012, 1226 – *Flaschenträger.*

RÉSUMÉS

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Eurasian patent term extensions for pharmaceutical inventions

Ekaterina Petrova and Victor Lisovenko of Patentica explain how centralized EAPO procedures interact with differing national rules across EAPC member states, compare extension eligibility and duration by jurisdiction, and highlight strategic advantages of Eurasian patents over national filings. They also discuss practical risks, including claim-to-authorization alignment, national enforcement differences, and recent Russian IP Court practice, before offering drafting and portfolio management recommendations for patentees seeking effective regional protection.



Ekaterina Petrova



Victor Lisovenko

> The allowance rate of Eurasian patents is up to 90%.

With 200+ million people, the Eurasian region represents a rapidly developing pharmaceutical market that has become increasingly significant on the global stage. While the Eurasian Economic Union (EAEU) drives economic integration across this territory, securing comprehensive intellectual property rights across these jurisdictions relies on the Eurasian Patent Organization (EAPO). The Eurasian patent system constitutes a cornerstone of strategic protection and market planning for pharmaceutical companies operating across the EAEU and adjacent markets. For international life sciences companies seeking maximum geographical coverage with minimal administrative friction, the Eurasian patent remains the most efficient tool available.

The Eurasian patent — advantages relative to national systems

The Eurasian patent provides enforceable protection across all eight member states of the Eurasian Patent Convention, including Armenia, Belarus, Kazakhstan, Kyrgyzstan, Russia, Azerbaijan, Tajikistan, and Turkmenistan, subject to the national legal rules of each contracting state. Practically, this means a single Eurasian filing can influence several domestic markets without requiring separate regional patent grant procedures in each country.

The first five of the above-mentioned countries form the EAEU with a common set of rules governing the registration process of pharmaceutical products. Therefore, a Eurasian patent provides immediate regional protection in the EAEU as well three more countries of the region after grant, avoids national translations, and enables provisional protection from publication of the application to grant. It also serves as a centralized mechanism for managing the extension of protection across the region, unlike the European model, which relies on national supplementary protection certificates (SPCs) and validations.

The allowance rate of Eurasian patents is up to 90%. If the EAPO rejects a Eurasian patent application, the applicant may still convert it into a national application designated in any EAPC contracting state, preserving the original filing and priority dates. Patent owners may license rights across all participating territories.

The prosecution and grant procedures are carried out in Russian, while translation may be required only after grant in patent litigation, which is handled at the national level. All patent fees, including filing, examination, and renewal fees, are paid centrally to the EAPO.

Principles of Eurasian patent term extension practice

Patent term extension (PTE) is available in every EAPC member state where regulatory approval of a patented pharmaceutical product — specifically, a registration certificate, also known as a marketing authorization — is required before commercialization. The extension is anchored in national regulatory timelines and the particular product that obtained a registration certificate, and it is subject to a maximum duration that varies by jurisdiction.

Although the EAPO handles the central procedure for patent term extension, each member state applies its own calculation of extension length, boundaries of protection, and any statutory caps, which the EAPO must follow when examining the PTE request. Consequently, the same Eurasian patent may yield different extension lengths and scope across different EAPC jurisdictions.

When it comes to terms and conditions, the fragmentation can be categorized into three distinct jurisdictional approaches:

1. In Armenia, Belarus, Kazakhstan, and Russia, the extension applies to inventions relating to pharmaceuticals, petrochemicals, and pesticides, and its duration is calculated by subtracting five years from the time elapsed between the patent application filing date and the date of the first MA. The total extension cannot exceed five years. In Tajikistan, a similar calculation is used, but the formula subtracts four years from the interval between the filing date and the first authorization date, subject to a five-year maximum cap
2. In Azerbaijan, the extension is granted to inventions relating to pharmaceuticals, petrochemicals, pesticides, and methods for producing the same based on the specific duration of the administrative authorization procedures, capped at five years. If this regulatory period overlaps with the time between the patent application filing date and the actual patent grant date, that overlapping period is deducted from the final extension.
3. In Kyrgyzstan and Turkmenistan, patent term extensions are not permitted under local statutes.

**below we provide a comparative table with respect to the PTE conditions for the EAPC member states.*

Country	Subject matter	Due date for filing a PTE request	PTE duration
Armenia	Pharmaceuticals, pesticides, agrochemicals	6 months from patent issuance or marketing authorization (whichever is later)	Time from filing to first authorization minus 5 years (Max 5-year extension)
Azerbaijan	Pharmaceuticals, pesticides, agrochemicals	During the validity period of the patent	Total time of administrative procedures (Max 5 years), minus any overlap between filing and grant dates
Belarus	Pharmaceuticals, pesticides, agrochemicals	6 months from patent issuance or marketing authorization (whichever is later)	Time from filing to first authorization minus 5 years (Max 5-year extension)
Kazakhstan	Pharmaceuticals, pesticides, agrochemicals	6 months from patent issuance or marketing authorization (whichever is later)	Time from filing to first authorization minus 5 years (Max 5-year extension)
Kyrgyzstan	None	N/A	No extension is legally possible
Russia	Pharmaceuticals, pesticides, agrochemicals	6 months from patent issuance or marketing authorization (whichever is later)	Time from filing to first authorization minus 5 years (Max 5-year extension; restricted to authorized product)

Tadjikistan	Pharmaceuticals, pesticides, agrochemicals	6 months from patent issuance or marketing authorization (whichever is later)	Time from filing to first authorization minus 4 years (Max 5-year extension)
Turkmenistan	None	N/A	No extension is legally possible

Importantly, the EAPO extends Eurasian patents with respect to certain claims as originally granted. However, the scope of extension for national patents differs in some countries. For example, Russian PTE practice tends to be more restrictive regarding the scope of extension, requiring an additional patent with claims limited to the specific product approved for market entry. In most cases, broad claims or compositions are subject to substantial limitations if the product registration certificate does not map identically to the features of the claimed invention as interpreted under Russian national patent law. In contrast, the Eurasian Patent Office extends the scope of claims as originally granted.

This diversity of rules creates the possibility of obtaining broader overall regional protection with a Eurasian patent than a strictly national patent would permit, but it also requires substantial planning and diligence to prevent mismatches between regional records and national practice.

In this context, illustrative is the Russian IP Court case SIP-954/2022 (GLENMARK PHARMACEUTICALS v. ROSPATENT), where the Russian PTO refused to extend the term of the Russian patent RU2687551 (RYALTRIS) based on the finding that the claim relating to a pharmaceutical composition was not amended enough during the PTE procedure with respect to neutral excipients to become literally identical to the composition described in the registration certificate.

To sum up, in terms of general enforceability, obtaining a Eurasian patent can be more advantageous than a national patent, as it provides broader protection for the original claims as granted and does not require narrowing the claims to the marketed product for the PTE to take effect.

Challenging decisions of the EAPO with respect to the patent term extensions — the interaction of regional and national processes

While requesting a PTE at the EAPO streamlines regional administration and seemingly offers broader protection for patentees, it makes it difficult to challenge the EAPO's extension decision at the national level, especially when the EAPO rejects the patent term extension. Such a rejection cannot be challenged at the national level because the EAPO, as an international intergovernmental organization established by the EAPC, enjoys full judicial immunity from the jurisdiction of national courts in all its member states. This is not the case for rejections of PTEs for any national patents, which are always appealable before national courts.

> "Following the publication of a patent term extension, and at any point until the extended patent expires, third parties are entitled to file an opposition against the extension before the EAPO."

For post-grant challenges to extended Eurasian patents, Rule 16(7) of the Patent Regulations under the EAPC provides a post-grant mechanism. Following the publication of a patent term extension, and at any point until the extended patent expires, third parties are entitled to file an opposition against the extension before the EAPO. These challenges must be grounded in non-compliance with the specific national laws of the contracting state for which the extension was granted, but the EAPO processes the opposition centrally. The decision on the opposition may be appealed once before the President of the EAPO, and, in certain circumstances, at the national level as well.

A notable decision in this respect is the decision of the Russian IP Court SIP 730/2022 ("PSK PHARMA" V. "PFIZER PRODUCTS INC", INN - tofacitinib). The IP Court considered the notice of appeal filed by a generic company against the EAPO's opposition decision, which the IP Court upheld.

Strategic recommendations for practitioners seeking PTE in the EAPC countries

1. Independent claims for independent value

When a Eurasian patent application relates to multiple chemical entities or compositions, it would be highly recommended to design and draft independent claims for each object of potential commercial interest, even if they are described under a common Markush structure. This modular approach minimizes the risk that a national court or the EAPO will consider the extension overbroad. This is all the more important because, currently, different claims of the same Eurasian patent relating to different pharmaceutical products can be extended separately based on the same registration certificate (and different patents can be extended based on the same

registration certificate).

2. Being ready for parallel invalidation tracks

It is necessary to recognize the dual threat posed by regional opposition (Rule 16(7) at EAPO) and national court challenges and develop tailored arguments, evidentiary strategies, and regulatory mappings for each patent application, recognizing that regional and national standards may diverge in the degree of required specificity, sufficiency of data, and interpretation of claim scope.

3. Alignment of patent claims with regulatory dossiers

It is recommended to draft claims and claim language to reflect the exact regulatory-level features (e.g., specific polymorphs, salts, stabilizers, or delivery systems) described in the registration certificate. When the regulatory dossier emphasizes a particular crystalline form, stabilizer, or delivery mechanism, ensure that the patent claims track that terminology to reduce the risk of divergence that could undermine an extension.

4. INN and nomenclature considerations

Where feasible, it is advisable to anchor claim language to International Nonproprietary Names (INN) to improve regulatory alignment, while preserving the flexibility to tailor product-specific language to the registration certificate. This balance helps maintain coherence between regulatory submissions and patent protection across jurisdictions.

5. Proactive drafting for lifecycle management

It is desirable to consider the long-term lifecycle of key assets across Eurasia and design a strategy that allows the holistically protected product to maintain protection as market exclusivity evolves. This includes anticipating potential registration certificate changes, formulation updates, or new salt forms and ensuring that such developments can be accommodated with coherent, modular claims in subsequent Eurasian extensions or national filings.

Conclusion

The Eurasian PTE regime reflects an important intersection of centralized regional administration and diverse national enforcement. For pharmaceutical portfolios, extensions of Eurasian patents offer meaningful leverage for regional protection, provided that strategic drafting, regulatory alignment, and proactive post-grant enforcement planning are integrated into the portfolio design from the outset. The evolving Eurasian framework—under the auspices of EAPO and the strengthening role of the EAEU—offers significant opportunities. The most robust path for patentees is to implement a disciplined, modular claim architecture, ensure good correspondence with future registration certificate dossiers, and prepare for potential parallel challenges in regional and national venues. With these elements in place, patentees can optimize protection across Eurasia while mitigating the risk of post-grant limitation or strategic narrowing of the extension. In light of their substantial experience in this field, the authors will be pleased to provide details and assistance with PTE extensions of Eurasian patents across the EAPC contracting states.

> “It is desirable to consider the long-term lifecycle of key assets across Eurasia and design a strategy that allows the holistically protected product to maintain protection as market exclusivity evolves.”

RÉSUMÉS

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Breaking borders: the expanding reach of UPC jurisdiction after *BSH v. Electrolux*

Dr Michael Pfeifer and Dr Dirk Schüßler-Langeheine of Hoffmann Eitle consider the growing reach of European cross-border patent litigation after *BSH v. Electrolux*, focusing on recent UPC and national-court decisions and their strategic implications for patent proprietors and defendants.



Dr Michael Pfeifer



Dr Dirk Schüßler-Langeheine

> **Patent proprietors increasingly have opportunities to pursue multifaceted cross-border enforcement strategies before a single court.**

Since the start of the Unified Patent Court ("UPC"), litigants have continuously tested the limits of the Court's international jurisdiction. As discussed in our contribution "*Key Insights After Two Years of the UPC and UP: Q&A for IP Managers*",[1] early UPC decisions already suggested that the Court's international jurisdiction would systematically extend beyond the territory of the UPC Contracting Member States ("the UPC Territory"). Such development was based on the decision of the Court of Justice of the European Union ("CJEU") in *BSH v. Electrolux*,[2] paving the way for the UPC to judge on infringement of national parts of European patents validated outside the UPC territory (for example, in the UK, Switzerland, Spain, Turkey, etc.), provided that one defendant is domiciled in the UPC Territory. In 2026, the case law has evolved considerably.

The result is a new era of European cross-border patent litigation. Patent proprietors increasingly have opportunities to pursue multifaceted cross-border enforcement strategies before a single court. Defendants thus face broader exposure and more complex defense considerations. After a brief recap of the CJEU decision *BSH v. Electrolux* of 2025, we will discuss 2026 case law of the UPC Court of Appeal ("CoA"), a pending referral to the CJEU, and a remarkable case decided by the German national Munich Regional Court, all dealing with important aspects of multinational litigation in Europe.

Recap of *BSH v. Electrolux*: moving beyond borders

The fundamental CJEU decision *BSH v. Electrolux* of 2025 arose from a referral in national Swedish proceedings, but applies to all courts in the EU, i.e., the UPC as well as national courts in the EU. The CJEU confirmed that an EU court hearing an infringement action against a defendant domiciled in its territory does not lose jurisdiction merely because the defendant raises an invalidity defense regarding a patent (or national part thereof) valid outside the infringement court's home jurisdiction. For the UPC, this relates to national parts of EP patents outside the UPC Territory or even outside the EU. While the UPC can decide only on EP patents, national courts can decide not only on national parts of EP patents outside their home country, but also on foreign national patents, even patents granted outside Europe (e.g., in the US or China). In relation to patents registered in the EU (or in the Lugano

Convention states Switzerland, Norway, or Iceland, referred to as "LC"), infringement proceedings may continue unless the court sees "a reasonable, non-negligible possibility of that patent being declared invalid". For patents registered outside the EU/LC, the infringement court may even rule on validity with effect inter partes. For example, it may base an infringement decision concerning a UK patent on its own finding that the UK patent is valid or invalid.

The practical consequences are significant. Patent proprietors are now able to bring a single infringement action before the defendant's home court in the EU covering multiple international patent designations, even if the defendant contests validity of a patent outside the jurisdiction of the infringement court. As a result, legal options that once seemed theoretical are becoming part of everyday litigation strategy not only at the UPC, but also at national courts.

Some breathing room for defendants regarding national validity objections: *Fujifilm v. Kodak*

In the basic *BSH v. Electrolux* decision, the CJEU confirmed, *inter alia*, that, in the EU, the courts of the country where a patent is registered have exclusive jurisdiction to decide on validity. In UPC infringement proceedings, defendants can thus file a revocation counterclaim, but only for national parts of EP patents in the UPC Territory. Thus, confronted with a UPC action covering infringement of national parts of EP patents outside the UPC Territory, defendants had to consider whether and when to file corresponding national revocation actions (e.g., in the UK) if they wished to rely on invalidity arguments for those parts validated outside the UPC Territory.

In *Fujifilm v. Kodak*, the CoA clarified how to deal with a situation where no such parallel revocation action has been filed outside the UPC territory: where the UPC considers the patent valid and infringed in the UPC Territory, injunctive relief and other remedies may extend to EU Member States outside the UPC Territory and even third states outside the EU. Defendants could then still rely on subsequent national validity proceedings, provided they anticipated that national courts would reach a different conclusion regarding validity.

On the other hand, where the UPC considers the patent infringed but invalid in the UPC Territory, the patentee should first be given an opportunity to withdraw the broader infringement claims insofar as they concern non-UPC patent designations. In this case, defendants are spared the necessity to file national invalidity actions (at least as far as the UPC proceedings are concerned).

If the patentee maintains the infringement claims outside the UPC Territory, defendants should then be given the opportunity to initiate revocation proceedings before the competent foreign courts, so that the UPC can subsequently stay the relevant parts of the infringement action pending the outcome of such national proceedings.

This means that the defendant is not required to proactively file national invalidity proceedings unless the UPC finds the patent to be infringed and invalid, and the claimant maintains the infringement claims for non-UPC countries despite the UPC's decision to invalidate the European patent in the UPC Territory.

How powerful an "anchor" is needed to draw international defendants into the proceedings?

For defendants based outside the UPC Territory, the UPC's jurisdiction is generally limited to infringement of European patents in the UPC Territory. However, such limitation does not apply as soon as at least one defendant is involved who is domiciled in the UPC Territory, a so-called "anchor" defendant. With such a defendant based in the UPC Territory, the UPC's broader potential can be unlocked, and claimants can maximize the impact of an injunction and other remedies by extending them also to acts of infringement outside the UPC Territory committed by defendants domiciled outside the UPC Territory.





For such extended jurisdiction, the subject matter of the cases against the co-defendants must be so closely connected that deciding them in different courts would create a risk of irreconcilable decisions. Where multiple companies (local affiliates, distribution entities within a corporate group, or members of a supply chain) act together in a coordinated manner, the argument for consolidation in one single legal action is relatively straightforward.

The UPC CoA recently had to decide in *Dyson v. Dreame* whether an EU company not even alleged to have infringed the asserted patent by its own acts, but merely providing services for a non-EU company as an EU representative (required for placing products on the EU market under a CE declaration) can serve as the "anchor" for infringing acts of the non-European company outside the UPC Territory, e.g., in Spain. The CoA held that the EU rules on international jurisdiction for such a constellation were unclear and referred the case to the CJEU.[3]

The CJEU's answer, either way, is expected to have significant further consequences for multinational litigation strategies.

German national court in Munich attributes cross-territorial "lighthouse effect" to the German Federal Patent Court's validity assessment

The trend towards broader cross-border enforcement is not confined to the UPC.

> **"Legal options that once seemed theoretical are becoming part of everyday litigation strategy."**

In September 2025, the German national Regional Court in Munich ordered the first cross-border injunction covering Germany and 19 additional EPC countries based on the doctrine of equivalents, granting injunctive relief extending well beyond the Court's own national territory.[4]

Particularly noteworthy was the Munich court's willingness to conduct a largely centralized assessment of infringement by equivalent means across multiple EPC states. Rather than undertaking a separate national analysis for every country concerned, the Court relied on the "lighthouse effect" of a first-instance validity ruling of the German Federal Patent Court, and the Court's own assessment of infringement by equivalent means, assuming that assessment by the courts of other countries would yield no other results. The case attracted considerable attention because it appeared to move beyond jurisdictional centralization and toward a more centralized substantive

assessment of infringement itself.

Although subsequent developments prevented definitive appellate guidance, the case illustrates the increasing willingness of European courts to consider centralized approaches to cross-border patent litigation. National courts also have one potential advantage over the UPC: their jurisdiction is not limited to European patents. This allows claimants to assert national patents, or even patents from non-European jurisdictions. The practical impact for non-European patents remains to be seen, given the risks of asking a court to resolve a complex dispute under foreign law outside the familiar EPC framework. One campaign involving the assertion of US patents against a German car manufacturer before the Munich Regional Court settled quickly.

Conclusion

Europe has entered a new era of patent litigation. More than one year after *BSH v. Electrolux*, the debate is no longer whether cross-border patent litigation is possible. The focus has shifted to how far such litigation can extend and how competing concerns of jurisdiction, validity, and procedural fairness should be balanced.

The UPC CoA's decision in *Fujifilm v. Kodak* has provided breathing room regarding the filing of national nullity actions for defendants facing UPC infringement claims covering territory outside UPC Contracting Member States. The pending *Dyson v. Dreame* referral to the CJEU demonstrates that the limits of anchor-defendant jurisdiction remain under active development, while the national German Regional Court in Munich has embarked on a centralized substantive assessment of infringement under the doctrine of equivalence.

For patent proprietors, opportunities for centralized enforcement continue to expand. For defendants, coordinated, multinational defense planning is crucial. Broader jurisdiction also brings increased legal and procedural complexity. As European courts continue to test the boundaries of cross-border litigation, parties will need to weigh carefully not only what is legally possible, but also what is strategically desirable.

Footnotes

1. Michael Pfeifer and Dirk Schüßler-Langeheine, "Key insights after two years of the UPC and UP: Q&A for IP managers", *The Patent Lawyer*, Issue 78 (2025), available at: https://patentlawyermagazine.com/wp-content/uploads/2025/09/TPL78_interactive.pdf.
2. CJEU, Judgement of 25 February 2025, Case C-339/22 - BSH Hausgeräte v Electrolux.
3. CoA, Order of 6 March 2026, UPC_CoA_789/2025 and UPC_CoA_813/2025 – Dyson Technology Ltd v Dreame International (Hongkong) Ltd and Others.
4. LG München I, 25 September 2025 – 7 O 16055/24 and 7 O 9383/25.

> **Europe has entered a new era of patent litigation.**

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RÉSUMÉS

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Compulsory licensing in pharma: trends of Russian court practice and position of the Constitutional Court

Natalia Nikolaeva, Partner, and Ilya Goryachev, Counsel, at Gorodissky & Partners explore the development of Russian disputes of compulsory licensing in a pharma-relevant context, including the recent decision of the Constitutional Court setting the interpretation of legal issues for such disputes.



Natalia Nikolaeva



Ilya Goryachev

> **The Constitutional Court's attention to compulsory licensing issues indicates the complexity of these disputes.**

Russian legal standards of compulsory licensing

Russian judicial practice of patent disputes in the pharmaceutical industry has recently faced an increase in previously rare disputes involving compulsory licensing lawsuits.

As such, Russian legal norms on compulsory licensing are based on the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights, with domestic specifics provided in the Russian Civil Code.

There are two situations in which a court can grant compulsory licensing. In addition, Russian law provides that the Russian Government can issue an order allowing use of the invention without the patentee's consent in cases of extreme necessity related to ensuring the defense and security of the state and protecting the life and health of citizens.

Lack of use/insufficient use of patent

The first legal ground for granting a compulsory license is lack of use or insufficient use (work) of the patent.

The applicable norm (Section 1, Article 1362 of the Russian Civil Code) does not provide for specific criteria for what shall constitute insufficient use.

However, by the sense of the norm in a pharma-related context, lack of use/insufficient use alone is not enough – such lack/insufficient use shall lead to insufficient offer of the medicine on the Russian market.

Overall, the key conditions to apply this ground are as follows:

- Four years (grace period) have passed since the grant of the patent;
- There shall be a legitimate interest of the potential licensee – namely, they shall prove their desire and readiness to use the invention;
- The potential licensee shall prove deficiency of the patentee's medicine on the market;
- There is no reasonable excuse established for lack of use or insufficient use;
- The lawsuit for seeking the compulsory license shall list terms of license, including scope of use of the invention, amount, ways and deadlines for license payments;
- License payments shall not be

lower than license payments under comparable circumstances.

If the compulsory license is granted, the patentee is also entitled to file a separate lawsuit, arguing that the circumstances that led to the license grant ceased to exist and that their future appearance is unlikely. In this case, the court shall set the terms and consequences of license termination.

Patent dependency

The other ground for compulsory licensing featured in pharma disputes is the presence of the so-called "dependent patent," defined either:

- as the invention whose use is impossible without using (infringing) the patent with an earlier priority date; or
- as the invention whose set of claims differs from the set of claims of the invention with earlier priority date only in the purpose of the product or method.

Key conditions also accompany the enforcement of this compulsory license ground by the court:

- The owner of the dependent invention cannot use their invention without infringing the rights of the owner of the patent with an earlier priority date;
- The owner of the dependent patent has the burden to prove that their dependent invention represents an important technological achievement and has a significant economic advantage as compared with the invention with an earlier priority date;
- The lawsuit for seeking the compulsory license shall list the terms of the license, including the scope of use of the invention, amount, ways, and deadlines for license payments;
- License payments shall not be lower than license payments under comparable circumstances.

Although the applicable norms do not expressly indicate how to terminate this type of license, from a legal perspective it is correct to argue that the license shall be terminated if the dependent patent is invalidated.

Pre-trial compliance is necessary for both situations of granting a compulsory license. A potential licensee shall send the patentee an offer to enter into a license and indicate specific terms of such license. If the patentee rejects the offer, then a compulsory license lawsuit can be filed with the court.

Governmental order

Grant of a compulsory license by the court under the above-discussed conditions shall not be mixed up with the specific administrative procedure that the Russian Government can use in cases of extreme necessity related to ensuring the defense and security of the state, as well as protecting the lives and health of citizens.

The specifics of these provisions are that they can be initiated by any interested person who files the application to the Ministry of Economic Development. As result of consideration of the application with involvement of other stake-holders (Ministry of Industry and Trade, Ministry of Health, Russian Patent Office, Federal anti-trust authority), the Ministry can send the opinion to the Governmental commission that makes a final decision whether to issue the Government order and what is the amount of remuneration that shall be paid to the patentee (with notification of the patentee).

Currently, more than 10 Government orders allow the use of pharma inventions, the first of which was issued during the COVID-19 pandemic. There were also examples where a Government order was challenged in the Supreme Court (procedurally, it is possible); however, the Supreme Court did not find grounds to revoke the order.

> "Currently, more than 10 Government orders allow the use of pharma inventions, the first of which was issued during the COVID-19 pandemic."

Evolution of compulsory licensing cases

For many years, the compulsory licensing provisions were not explored in judicial practice, and references to them were extremely low. However, in recent years, generic companies have made more active use of the compulsory licensing mechanism.

The first case where the court considered insufficient use of the patent started in Russia in 2022 and was considered by the Moscow City Commercial Court as the first-instance court. As a result of the court's consideration, the compulsory license seeker failed to receive the compulsory license. The court specifically indicated that:

- the plaintiff did not provide evidence indicating lack of use or insufficient use of the patents;
- the defendant provided evidence of the presence of the patented medicine in the Russian market (namely, evidence of supply to the special patients fund, customs declarations, information of state tenders where the defendant's medicine was supplied) and the court considered such evidence indicating sufficient use;
- the plaintiff did not prove their legitimate interest and readiness in using the defendant's patents;
- no evidence of relevance of the claimed

patents to either the plaintiff's or the defendant's medicines was provided by the plaintiff.

Remarkably, the court also applied the concept of estoppel because the plaintiff initially indicated several patents for which the four-year grace period had not expired. Later, the plaintiff had to exclude those patents from the lawsuit. However, the court noted that the plaintiff, by indicating those patents, admitted that the license on those patents would be necessary for legal import of the plaintiff's medicine. In this regard, the court concluded that granting a compulsory license in this case for the other patents (for which the grace period expired) will not lead to the validity of the license as such, and patent clearance and the court decision in this regard will not be enforceable.

The court also dismissed as irrelevant the plaintiff's reference to the number of patients that can potentially need the defendant's medicine – the reason for dismissing that argument was that the plaintiff did not provide evidence that for each patient the specific defendant's medicine was or should have been prescribed by their attending doctor.

However, on appeal, the plaintiff managed to reverse the court decision, and a compulsory license was granted. The appeal court disagreed with the first-instance court and considered that some of the state tenders that were canceled because the participants filed no applications for supply indicated insufficient use of the patents. Moreover, the appeal court also relied on the position that the number of patients can be used as the criterion for establishing where use is sufficient – thus ignoring the position of the first-instance court that there shall be evidence of whether each patient indeed needs the defendant's medicine.

The Intellectual Rights Court and the Supreme Court upheld the position of the appeal court. In this regard, the defendant (patentee) and the third party (official distributor of the patentee's medicine) filed complaints to the Constitutional Court arguing that such application of Section 1, Article 1362 of the Russian Civil Code is unconstitutional.

Position of the Constitutional Court

Although the Constitutional Court ruled that the challenged legal norm is constitutional, it still formulated some legal positions regarding the application of Section 1, Article 1362 of the Russian Civil Code. In particular:

- compulsory license shall be an extraordinary measure for limiting IP rights;
- compulsory license shall not be a sanction for improper use of IP rights, but shall be considered as having the purpose of remedying the market deficiency and ensuring that such deficiency will not arise;
- the Constitutional Court outlined that excessive use of compulsory licensing without sufficient grounds may lead to the risk of discrediting the Russian jurisdiction in terms of its investment attractiveness for business activities and the import of innovative products into the country;
- it is expressly noted that court decisions on compulsory licenses must be substantiated and properly reasoned, taking into account the complexity and specifics of the case and the established factual circumstances;
- not in all cases, as such a discrepancy between the actual volume of deliveries and the number of potential consumers (e.g., patients) is absolute proof of insufficient use;
- in assessing insufficient use, courts must examine whether the current demand for the patented product is being satisfied and whether, and to what extent, the patentee is capable of satisfying such demand in the future;
- the patentee must demonstrate their readiness to supply the patented product taking into account the capabilities of their production facilities and any other contractual supply obligations they have. These capabilities and other objective factors may be of significance to the patentee and considered as circumstances that can be recognized by the court as valid and therefore prevent the granting of a compulsory license;
- the Constitutional Court specifically noted the necessity to study what patents are actually relevant for the plaintiff's products – to avoid the grant of excessive licenses;
- attention is given to the price difference issue – undue and unmotivated high pricing of the patented medicine can be among the factors triggering the grant of the compulsory license;
- specific attention is made by the court to the determination of the term (duration) of the compulsory license by indicating that duration depends on the analysis by the court of each specific situation in its dynamic (bearing in mind that the duration of

> **"Not in all cases, as such a discrepancy between the actual volume of deliveries and the number of potential consumers (e.g., patients) is absolute proof of insufficient use."**

the license shall serve to eliminate the established deficiency);
- determination of the patent relevance as well as determination of license financial terms can require special knowledge, which makes it necessary to engage experts/specialists in the relevant fields;
- lawsuits to terminate compulsory licensing can be filed by the patentee numerous times.

Potential impact

The position of the Constitutional Court shall not be considered as inviting the filing of compulsory license lawsuits or making the process of their grant easier – on the contrary, it sets stricter standards for the plaintiffs and calls for more careful analysis by courts.

However, since the decision is quite fresh, it remains to be seen how lower courts will apply the Constitutional Court's legal position in final decisions.

Furthermore, the Constitutional Court indicated that the legislator may additionally specify the conditions for granting compulsory licenses, in particular by establishing methods for calculating the shortage of supply of goods, works, and services for the purposes of applying Section 1, Article 1362 of the Russian Civil Code.

Meanwhile, the Constitutional Court's attention to compulsory licensing issues indicates the complexity of these disputes, the numerous factors requiring special approaches, and the need to use clear criteria that balance the public and private interests of all parties to the case, rather than vague or insufficiently detailed positions. Currently, such disputes are considered by general commercial courts that previously have not dealt with compulsory licensing cases regularly.

However, quite recently, the legislative initiative has taken shape to transfer consideration of compulsory license disputes to the specialized court – the Intellectual Rights Court that already operates as the exclusive jurisdictional court for some IP-rights-related disputes. If the bill is passed, the procedure can change starting from January 1, 2027.

The Russian Government supports that initiative that may indeed have a positive impact on further consideration of compulsory licensing disputes, ensuring correctness and a more effective approach to those cases while avoiding unnecessary restrictions on exclusive rights.

RÉSUMÉS

Natalia Nikolaeva joined Gorodissky & Partners in 1999 and was promoted to Partner in 2010. Advises clients on all legal aspects of IP issues, including copyright and related rights, patents and know-how, trademarks and brands, as well as other IP assets. Natalia counsels clients on various IP and technology transfer issues, such as licenses, franchises, and assignments. She assists clients with IPR enforcement and anti-piracy, handles all kinds of IP infringement cases before the courts and administrative bodies. As one of the firm's leading litigators, she has extensive experience enforcing intellectual property rights across a broad range of jurisdictions and industries, with particular expertise in life sciences and the pharmaceutical sector.

Ilya Goryachev has about 15 years of extensive legal experience in intellectual property and joined Gorodissky & Partners in 2013. He focuses on providing legal support in intellectual property and general commercial matters, including unfair competition; domain disputes, licensing, assignments; franchising and other IP-related transactions; advertising and marketing regulations; IP issues in M&A transactions; IP due diligence; and personal data protection and industry-related regulatory affairs, including advising life science companies and representing innovative pharmaceutical companies in patent disputes. Assists with IP enforcement and anti-piracy, handles all kinds of IP infringement cases before the courts and administrative bodies.

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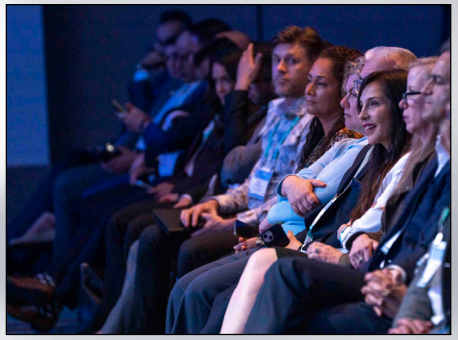
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An interview with the EAPO President Grigory Ivliev

Dr. Alexey Vakhnin of Vakhnina and Partners sits down with Dr. Grigory Ivliev, President of the Eurasian Patent Office (EAPO), to discuss recent developments in the Eurasian patent system, with a particular focus on industrial design protection.



Dr. Grigory Ivliev



Dr. Alexey Vakhnin

> **For the Eurasian Patent Office, accession to the Hague System is a major step towards greater integration into global protection systems.**

The Eurasian Patent Organization is an international intergovernmental organization established in 1994 under the Eurasian Patent Convention (EAPC). The World Intellectual Property Organization (WIPO) and its former Director General, Dr. Arpad Bogsch, made significant contributions to the drafting of the EAPC.

The Eurasian Patent Organization brings together eight countries: Azerbaijan, Armenia, Belarus, Kazakhstan, Kyrgyzstan, Russia, Tajikistan, and Turkmenistan. The Eurasian Patent Office is the executive body that administers the regional system for the legal protection of inventions and industrial designs based on a single Eurasian patent. Mr. Grigory Ivliev is the President of the Eurasian Patent Office.

A Eurasian patent for an invention is valid from its granting date in the territory of all eight Member States. Only one application in Russian and one set of fees are required, with no additional validations and translations into national languages. Companies have the opportunity to significantly reduce financial, timing, and organizational expenses and obtain protection that covers the entire region. Users from more than 130 countries highly valued the advantages of the Eurasian patent system.

It is possible to keep the Eurasian patent for the invention in force selectively, just in the territory of those countries where you need it. This requires payment of annual fees for the designated countries. The Eurasian patent for the industrial design is extended throughout the whole territory.

A considerable number of EAPO applications are Patent Cooperation Treaty (PCT) applications, which have entered the regional phase. Since 2021, the Eurasian Patent Office has functioned as an International Searching Authority and an International Preliminary Examining Authority under the PCT.

A. Vakhnin: Mr. Ivliev, what are the key recent developments in the Eurasian patent system?

Perhaps the most significant development of 2026 has been the accession of the Eurasian Patent Organization to the Hague System for the International Registration of Industrial Designs. On July 10, 2026, the instrument of accession was deposited with WIPO Director General Daren Tang. On October 10, 2026, the Eurasian Patent Office will begin processing international applications and registrations under the Hague System. The EAPO is the third intergovernmental organization to join the Hague System and the 84th member of the Hague Union.

A. Vakhnin: Let me congratulate you and the Eurasian Patent Office on this

important milestone. What does this accession mean for applicants and for the Office?

For applicants, this means a new tool and a great opportunity to reduce the time and costs of obtaining design protection.

A Eurasian patent for an industrial design is unitary, providing protection across the territories of all eight Member States without any additional validations or translations. The ability to designate the EAPO through the Hague procedure will allow applicants to extend the territorial scope of protection for an industrial design in a single step.

Applicants will still have the optionto designate individual EAPO Member States. It should be noted that the Eurasian procedure is highly flexible and applicant-friendly. It retains all the key advantages already built into the Eurasian system for inventions: a single procedure and a single patent. The application requirements under the Eurasian system for the protection of industrial designs have been optimized as much as possible.

One application can cover up to 100 industrial designs in one class of the International Classification for Industrial Designs. The industrial designs included in a single application are not examined to determine whether they share a common creative concept, the so-called "unity of the industrial design" requirement.

There is also no need to renew the patent annually. A Eurasian patent for an industrial design can be renewed every five years, but the total term cannot exceed 25 years from the application filing date. The term will be renewed for all EAPO States' territories at once.

> "The ability to designate the EAPO through the Hague procedure will allow applicants to extend the territorial scope of protection for an industrial design in a single step."

For the Eurasian Patent Office, accession to the Hague System is a major step towards greater integration into global protection systems. Our organization has been working within the PCT system practically since its establishment. Since 2021, the EAPO has strengthened its status within the PCT system by becoming an International Searching Authority and an International Preliminary Examining Authority. Now the Office has joined another global registration system – the Hague System.

The EAPO began processing industrial design applications only five years ago, on June 1, 2021. During this time, the number of applications has increased sixfold, while the geographical reach of our users has expanded from nine countries in the first year to more than 30. Participation in the Hague System opens up new horizons.

A. Vakhnin: Looking back over the past five years, are there any industrial designs that have particularly stood out to you?

We received our very first application for an industrial design from Roscosmos. They obtained protection for the design of an energy-absorbing seat for cosmonauts. Incidentally, the term of its protection was extended this year.

Another outstanding example is when a single application included 100 designs – the maximum allowable number. All of the designs fell under a single class of the International Classification of Industrial Designs. Such applications are a good indicator of our system's flexibility.

Designs created by children are always impressive. The Eurasian Patent Office



participates annually in themed competitions for schoolchildren in EAPO countries and recognizes the best works by young designers. Such projects are very inspiring and reinforce the belief that our future is in good, creative hands.

A. Vakhnin: In your view, why is international protection of industrial designs so important?

International protection of intellectual property, particularly designs, is no longer simply a tool for market expansion, but a business necessity for many companies. The economic environment and the growth of e-commerce are creating new opportunities for businesses of all sizes. Access to international markets is no longer a privilege reserved for large corporations; it is a prerequisite for competitiveness, including for small and medium-sized companies and startups.

In my opinion, industrial designs remain an underappreciated form of IPR. This may seem paradoxical, since, after all, there is a widespread understanding that the commercial success of any product today is directly linked to how attractive or creative the design is.

A Eurasian industrial design patent is a convenient tool for commercializing design solutions at the regional level, especially when licensing agreements are concluded with licensees from multiple countries. There is a case in which a patent for a Eurasian industrial design served as collateral in a loan agreement for a small business. I am confident that the potential for growth in industrial design applications remains very high.

A. Vakhnin: Which industries, in your view, offer the greatest potential for design protection?

Designs in the digital environment, in their broad sense. As the digital economy grows, so does the value of graphical user interfaces (GUIs) and virtual graphic symbols. This is a rapidly growing and dynamically evolving market. In addition, such designs by their nature require cross-border protection.

Although the protection of GUIs has already become an established practice worldwide, certain issues remain relevant, including the preparation of such applications, the representation of animated elements, obtaining protection for the appearance of objects that are not fixed in form or are non-permanent, and determining the scope of protection.

I believe that harmonizing regulatory frameworks and approaches to the protection of GUIs would increase predictability and trust in the system. This would, in turn, increase interest in obtaining protection for such designs.

The Eurasian Patent Office's practices in this regard are fully aligned with developers' interests and demonstrate a progressive approach to protecting digital assets. The absence of requirements to specify a particular device is especially valuable for developers of cross platform solutions (web, mobile apps, desktop), as it provides a mechanism to protect the entire interface ecosystem. The limit of 100 design options in a single application is also a strategic advantage, as it allows applicants to avoid submitting dozens of separate applications for each pop up banner, button, or page. Instead, the applicant can protect an entire visual interface system in a single application.

> "As the digital economy grows, so does the value of graphical user interfaces (GUIs) and virtual graphic symbols."

A. Vakhnin: What other key challenges in the international protection of industrial designs would you highlight?

When it comes to the regional system, it is the examination of designs that include elements of protected trademarks and copyrighted works.

Given that the Eurasian patent covers eight countries, it is crucial to ensure the legitimate rights of rights holders. Searching national databases helps prevent situations in which, under the regional procedure, applicants could obtain protection for designations or services that are similar to or identical to those previously registered by others under national procedures.

We are continuing our work on developing the Common Register, which is designed to provide publicly available information on industrial property patented or registered in the Eurasian region at both the regional and national levels through a "one-stop shop" system. For the Eurasian Patent Office, this will improve the quality of examination and minimize the risk of disputes.

As for the Hague System, the issue of expanding the number of working languages has long been on the agenda. The current level of machine translation development now makes it possible to introduce additional languages – Russian, Chinese, and Arabic – into the registration systems. This will expand access for new users not only to the Hague System, but also to the Madrid System for the international registration of trademarks, and make these systems more attractive.

A. Vakhnin: How can the more complex challenges associated with obtaining protection for industrial designs be addressed?

Any challenges can be addressed through professional and constructive dialogue. The Eurasian Patent Office maintains strong working contacts with examiners at the national patent offices of the EAPO Member States. This year, design protection was the main focus of the annual training program for patent examiners from the EAPO countries.

We regularly hold a wide range of events involving the professional community, patent attorneys, and specialists, where we discuss regulatory frameworks and practice. The Eurasian Patent Office is open to dialogue with users: applicants and the quality of our work remain our top priorities.

Speaking of the global level, I would like to highlight the adoption of the Riyadh Design Law Treaty. We welcome the completion of the long and challenging work on the text of this important international agreement. We are confident that the adoption of the Treaty will mark an important milestone in the global harmonization of industrial property registration procedures.

This group of "harmonizing" treaties, namely the Patent Law Treaty (PLT), the Trademark Law Treaty (TLT), and the Singapore Treaty on the Law of Trademarks, makes the filing of applications and registration procedures for all key types of industrial property in different countries more predictable for applicants worldwide. It is particularly important that regional industrial design registration systems are reflected in the Treaty.

I am confident that professional cooperation will help make the process of obtaining design protection more transparent and predictable for applicants and right holders around the world, reduce costs of application filing and registration, improve the quality of examination, and shorten examination time.

A. Vakhnin: Dr. Ivliev, thank you very much for your detailed and informative interview. At the end of the interview, I would like to wish the Eurasian Patent Office continued professional growth and development, and an increase in the number of participating countries.

"I am confident that professional cooperation will help make the process of obtaining design protection more transparent and predictable for applicants and right holders around the world."

RÉSUMÉS

Dr. Grigory Ivliev is the EAPO President. The Eurasian Patent Office (EAPO) is an executive body of the Eurasian Patent Organization, administering the regional patent registration system covering eight countries in the Eurasian region.

Dr. Alexey Vakhnin is a Partner and Managing Director of Vakhnina and Partners, a Eurasian Patent Attorney, and a Patent and Trademark Attorney of the Russian Federation, with extensive experience in IP since the 1990s. Dr. Vakhnin is a member of the Eurasian Patent Attorneys Assembly (EPAA), FICPI, AIPPI, LESI, INTA, ECTA, and PTMG. With a PhD in Medicine (Biochemistry and Immunology) and experience in patent matters, Alexey specializes in Medicine, Biotechnology, Biochemistry, and Pharmacology.

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The enforcement gap in the age of AI

AI has made intellectual property cheaper to create and cheaper to assert. It has done little to make it cheaper to defend. David Bloom of Safeguard IP argues that for the businesses caught between those two facts, the gap is widening.



David Bloom

> "Structurally, the cost of asserting rights has fallen, and materially so for those able to take advantage."

In May, a Stockholm company called Stilta raised USD 10.5 million in a round led by Andreessen Horowitz. Its product is artificial intelligence that identifies the companies infringing its customers' patents. Those customers already include Roche, Maersk, and three of the five largest IP law firms in the world.

The funding was reported as a story about efficiency. Clever software, less manual review, faster results. It is better understood as a story about asymmetry, and about a gap in the IP system that has been widening for years.

That gap is straightforward to state. It has never been cheaper to create intellectual property. For many claimants, it has become cheaper to assert it. However, the overall cost of defending it remains stubbornly high. AI is now accelerating the first two while leaving the third untouched, and the businesses caught in the middle are the ones the system was designed to serve.

Creation has become cheaper

The good news sits at the creation end. AI drafting tools, automated prior art searching, freedom-to-operate analysis, and claim review have compressed work that once took days into hours. AI is reducing some of the costs associated with securing registered rights, and it has fallen most sharply for those who could never previously justify the spend.

A founder who might once have filed a single core patent can now build something closer to a portfolio. A small business that treated trademarks as an afterthought can afford to take them seriously. This is a genuine democratization of ownership, and it is welcome.

The filing statistics reflect it. The European Patent Office received just under 202,000 applications in 2025, the first year the figure has passed 200,000. Worldwide, a record 3.7 million patent applications were filed in 2024, the fifth consecutive year of growth. More businesses now hold more rights than at any point in history.



But a registered right is not an asset in the way premises or stock are assets. It is a right of action. Its value depends entirely on the holder's capacity to assert it against infringers, and to resist challenge when the position is reversed. It is worth examining what has happened to the cost of each.

Assertion has become cheaper, but not for everyone

It would be wrong to claim that enforcement costs have stood still. Structurally, the cost of asserting rights has fallen, and materially so for those able to take advantage.

The Unified Patent Court (UPC), operating since 2023, allows a patentee to enforce a single right across 18 member states in one action, where the alternative was parallel national litigation in each. Measured per jurisdiction, that is a substantial reduction. In the UK, the Intellectual Property Enterprise Court (IPEC) caps recoverable costs and limits damages to GBP 500,000, making modest claims viable, and a three year pilot under the Patent Court's Shorter Trial Scheme now caps costs at GBP 500,000 for mid-tier cases.

Two qualifications matter, however. The first is that cheaper is not the same as affordable. Costs to trial at the UPC typically run to several hundred thousand euros per party. A serious patent action in the English High Court commonly runs into hundreds of thousands of pounds and often exceeds GBP 1 million. These reforms have reduced the cost of assertion for parties who were already able to litigate. They have not brought it within reach of parties who were not.

The second is more important. Every reduction in the cost of bringing proceedings is also an increase in the likelihood of facing them. Cheaper assertion means more assertion. The UPC gives a claimant the prospect of an injunction across most of the European market in a single step. For a well-resourced claimant, that is efficiency. For a smaller defendant, it is exposure, arriving on a compressed timetable designed for speed.

Defense costs have barely moved

This is the distinction the current debate tends to blur. Assertion and defense are not the same cost problem, and reforms that improve one can worsen the other.

A claimant chooses whether to sue, when, in which forum, and with what budget. A defendant chooses none of these things. The proceedings arrive on someone else's terms, in someone else's chosen court, and the costs begin immediately. None of the reforms described above materially reduces those costs. AI has made some aspects of disclosure review, legal research, and document analysis more efficient, but those savings have not significantly altered the overall cost of defending substantial patent litigation. The IPEC caps assist the defendant of a modest claim, but any serious dispute is conducted at High Court or UPC scale, and the UPC's front-loaded procedure requires a defendant to commit substantial costs within months of service.

The result is that the historic imbalance survives in sharper form. Between a well-funded claimant and a smaller business, a dispute has rarely been a contest about who is right. It is a contest about who can afford to find out.

> "Assertion and defense are not the same cost problem, and reforms that improve one can worsen the other."

AI lowers the cost of attack

This is where the Stilta story matters. If AI were reducing costs evenly across the system, the playing field might level. It is not. The tools now attracting investment work by reading across enormous volumes of patent, scientific, and commercial data to surface infringement and licensing opportunities that manual review would never identify. They reduce the cost of finding a target and building a case against it. They do less to reduce the cost of answering one.

Stilta's Chief Executive describes the market as an arms race, in which the adoption of these tools by one rights holder compels adoption by every competitor. The economic consequence follows directly. As the cost of identifying infringement falls, claims that were never previously worth pursuing become worth pursuing. Some will be well founded. Some will be marginal. All of them can now be acted upon.

The trademark field offers a preview. Larger brands have long pursued smaller ones aggressively, sometimes beyond the point the law would support. Giving that behavior a cheaper engine does not make it more measured. It makes it more frequent.

The position of the recipient

Consider the recipient of the resulting correspondence. A sound business with a good product and a modest portfolio of its own receives a letter from a far larger company, alleging infringement that has been identified, quantified, and evidenced by an automated system.

The legal merits are only part of the problem, and frequently not the worst part. The immediate damage is commercial. Costs are incurred at once. Management attention is diverted from running the business. Cash flow tightens at precisely the moment flexibility is most needed. Whether or not the recipient is ultimately vindicated, the disruption lands long before any tribunal

considers the question.

This is the quiet shift the Stilta funding round signals. AI is not only helping innovators protect what they own. It is equipping the parties most able to pursue everyone else. The asymmetry that has always favored the well-resourced is widening from both ends at once. A smaller business can now create more and is now more likely to be pursued for it.

Implications for attorneys

For those advising these businesses, there is a practical consequence. Securing a right has always been necessary. It is no longer sufficient. A client who files more, faster, and more cheaply is accumulating exposure alongside assets, and is now more likely to become a target rather than simply a right holder.

The adviser who addresses prosecution alone is doing half the job. The adviser who also asks how a dispute would be funded, on either side of it, is doing the whole of it. That conversation is one most attorneys are well placed to begin, and one very few currently do. It is not a counsel of despair. It is an opportunity to be the commercial adviser the client actually needs.

The honest position is this. A portfolio built cheaply must still be defended expensively. Better the client understands that while filing than discovers it the week a dispute arrives.

Funding the fight

If the problem is that litigation costs money the smaller party does not have, the answer must involve money. Litigation funding and conditional or damages-based arrangements each have their place, but their reach is limited. Third-party funding is generally viable only where damages run to several million pounds, which is why it remains rare in UK patent disputes and why most small and medium-sized enterprise (SME) claims never qualify. Conditional arrangements leave the client exposed to the other side's costs. Both are reactive. They arrive, if at all, once a dispute already exists.

Insurance written specifically to meet the cost of pursuing or defending IP claims works differently, because it is arranged before any dispute arises. I should be direct about its limits, since this is the field I work in. It will not prevent a business being targeted. Nothing will. What it does is meet the cost of the fight, so that the decision to stand or settle is made on the merits rather than on the state of the bank balance. For an SME facing a far larger opponent, that is the difference between settling because it must and settling because it chooses to. It is the most practical means I know of contesting a dispute on something approaching equal terms.

The technology behind the Stilta story is genuinely impressive, and its builders are entitled to their success. But every tool that makes assertion cheaper for the powerful widens the gap for everyone else. AI is changing who can own intellectual property. It has not yet changed who can afford to defend it. Until it does, that gap is the real story, and the advisers who understand it are the ones their clients will keep.

> **A portfolio built cheaply must still be defended expensively. Better the client understands that while filing than discovers it the week a dispute arrives.**

RÉSUMÉ

David Bloom is the founder of Safeguard Intellectual Property, the UK's only specialist intellectual property insurance broker. A former intellectual property litigator with over 15 years' legal experience, he advises innovative businesses, investors, universities, and patent attorneys on managing IP risk through tailored insurance solutions. David has become a recognized voice in the sector, speaking regularly at industry events and contributing to leading publications on the role of insurance in supporting innovation. His practical litigation experience, combined with deep insurance expertise, enables him to help clients mitigate the costs associated with IP litigation.

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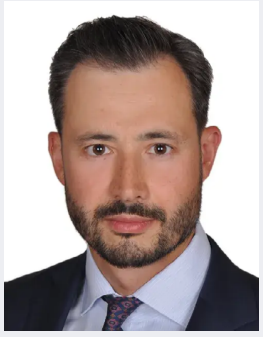
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A Foundation to Your Success

Patent litigation in Russia in 2026: coordinating evidence, validity, and remedies

Russia's patent litigation system is specialized, but not unitary. Infringement and validity usually travel on separate procedural tracks, while technical evidence determines how successfully the two tracks are coordinated. Recent decisions of the Supreme Court, the Constitutional Court, and the Intellectual Property Court, together with a major compensation reform effective from January 2026, make early case design more important than ever. Ramzan Khusainov and Anton Khomyakov of Khusainov Khomyakov & Partners outline the present framework and the points that most often decide the commercial outcome for international patent owners and their counsel.[1, 2]



Ramzan Khusainov



Anton Khomyakov

> Russian patent litigation in 2026 is neither a purely technical contest nor a simple registration-based claim.

A split, specialist court structure

A patent infringement action between commercial parties normally begins in a regional commercial (arbitrazh) court, usually at the defendant's registered place of business. The judgment may be appealed to the competent arbitrazh appellate court. The Intellectual Property Court (IP Court) then acts as the first cassation court, and a further cassation complaint may be considered by the Judicial Chamber for Economic Disputes of the Supreme Court if a Supreme Court judge transfers it for hearing.

The IP Court has a different role in validity matters. Technical challenges to a Russian patent - for example, lack of novelty, inventive step or sufficiency, or an impermissible extension beyond the application as filed - are first examined administratively by Rospatent. Rospatent's decision can then be challenged before the IP Court as a court of first instance, with the IP Court Presidium hearing cassation. Disputes over the correct inventor or patent owner are judicial and may also come before the IP Court at first instance.

A Eurasian patent in force in Russia is enforced under the same Russian rules as a national patent. The centralized EAPO administrative revocation procedure is available for three years from publication of the grant; national invalidity routes must be considered separately thereafter. The result is a functionally bifurcated system: the infringement court cannot simply revoke the asserted patent as a defense, and an invalidity attack does not automatically stay the infringement action.[3]

The infringement test starts with a disciplined claim chart

Under Article 1358 of the Civil Code, an accused product or process must contain every feature of an invention's independent claim. An equivalent may suffice only if it was known in the relevant field as such before

the priority date. Utility models require every claim feature and have no corresponding equivalents rule. The description and drawings may interpret a claim but cannot supply a missing limitation.

Relevant acts include manufacture, use, importation, offering for sale, sale, other introduction into commerce, and storage for those purposes. Where a patented process produces a new product, an identical product is presumed to have been made by that process unless the defendant proves otherwise. The claimant must still prove the patent, product identity, and the defendant's acts.

The strongest pleading is built around a feature-by-feature chart that ties each limitation to identified evidence: a specimen, drawing, manual, test result, or inspection record. Equivalence should be addressed separately, including function, result, technical interchangeability, and the date it became known. A conclusory assertion that two products apply the same 'idea' is rarely enough.

Technical evidence: no discovery, but more than one route to proof

Russian procedure has no broad US-style discovery; each party produces the evidence on which it relies. A court may order disclosure of a sufficiently identified document that the requesting party cannot obtain independently, but not an entire category of technical or commercial records. Before sending a warning letter, parties should secure test purchases, dated specimens, manuals, webpages, offers, customs documents, and, where appropriate, a notarial record of online content.

> The Supreme Court's March 2026 ruling in case No. 305-ES25-15716 is a useful evidentiary signal.

Where both sides are businesses, a monetary claim for damages or compensation will normally require a written pre-action demand and a 30-day waiting period. Evidence should therefore be secured before the letter is sent.

Court-appointed patent expertise is common, but not mandatory. The court frames the technical questions and retains responsibility for claim construction and the legal conclusion. Party-commissioned opinions can define the issues, support interim relief, expose gaps, and help formulate questions for a neutral expert.

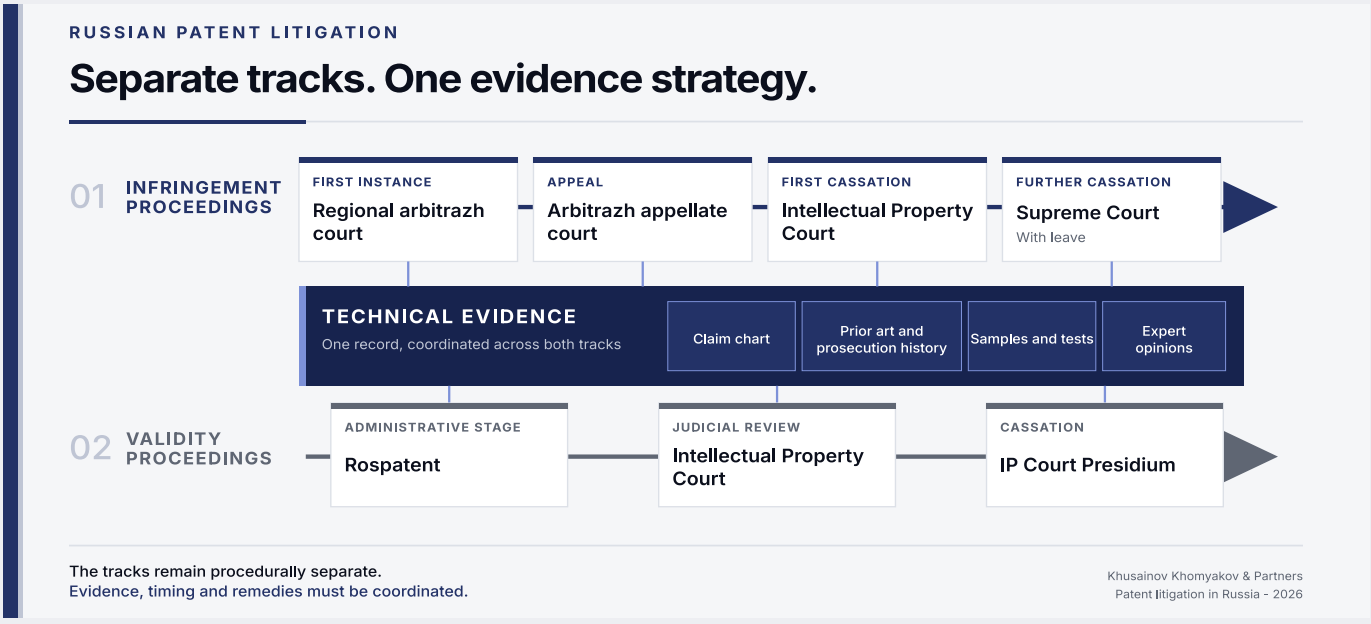
The Supreme Court's March 2026 ruling in case No. 305-ES25-15716 is a useful evidentiary signal. Although the case arose from antimonopoly proceedings, the Court rejected an artificially elevated standard of proof. It considered the opinion's source data, the specialist's qualifications, and the absence of a substantive rebuttal. It rejected the proposition that a court-appointed examination was the only acceptable means of proving patent use.[4]

That approach rewards early technical preparation. It also places a real burden on the opponent. If a specialist opinion is wrong, the answer should be a specific technical rebuttal, not a generic objection that the opinion was commissioned by the other side.

Validity and infringement must be planned together

An infringement defendant should assess validity before the merits hearing. Prior art, prosecution history, sufficiency, and added-matter analysis may support a Rospatent opposition. The infringement court may grant a discretionary stay where validity

Two procedural tracks in Russian patent litigation; Credit: Khusainov Khomyakov & Partners



proceedings can determine the outcome. Conversely, the patentee should test resilience before seeking urgent relief and ensure that defending narrower claims would not undermine the infringement theory.

The sequencing should be both commercial and procedural. An early invalidity filing may improve settlement leverage, but it can also reveal prior art and construction positions before the infringement record is complete. Foreign counsel should therefore coordinate the Rospatent case, the infringement defense, and any licensing dialogue as a single strategy.

Remedies after the 2026 compensation reform

The principal civil remedies are a specific injunction, withdrawal or destruction of infringing products where legally available, publication of the judgment, and damages, or statutory compensation instead of damages. Interim measures are possible before or during the action, including prohibition on specified sales or imports and the arrest of goods. Still, courts apply a demanding test of urgency, proportionality, and connection to the final relief. A vague request to prohibit any future infringement is harder to grant and enforce than an order that identifies the patent, products, and prohibited acts.

Federal Law No. 214-FZ, effective from January 4, 2026, introduced a general Article 1252.1 and revised patent compensation. For inventions, utility models, and industrial designs, the ordinary fixed range is now RUB 50,000 to RUB 10,000,000. Alternatively, the claimant may seek twice the value of the right to use the patented subject matter in comparable circumstances. If the selected valuation method does not fit the proven facts, the court may move to fixed compensation rather than dismissing the monetary claim solely for that reason.[5]

The reform emphasizes proportionality. It discourages mechanical multiplication, in which several rights or economically dependent methods of use are embodied in a single commercial product. It also permits a lower fixed range of RUB 10,000 to RUB 500,000 for an entrepreneur who proves that it neither knew nor should have known of the infringement. Professional manufacturers and importers will usually need convincing evidence of clearance, supplier checks, and contractual assurances before relying on that provision.

Actual loss need not be proved when statutory compensation is claimed, but the factual basis for the requested amount does. Relevant evidence includes duration, sales volumes, prices, comparable licenses, repeated conduct after notice, and the patented feature's economic contribution. In case No. A40-71253/2022, the IP Court relied on technical expertise and external production records to establish patent use and the number of units supporting a substantial royalty-based compensation award.[6]

> “Interim measures are possible before or during the action, including prohibition on specified sales or imports and the arrest of goods.”

Constitutional limits and compulsory licensing

The Constitutional Court's Resolution No. 13-P of March 12, 2026, addressed compulsory licensing for insufficient use under Article 1362. The immediate dispute concerned medicines, but the Court expressly stated that its approach may apply in other fields with appropriate sectoral adjustments. A court must examine real market insufficiency, the patentee's reasons and conduct, the applicant's ability to supply, the proposed scope, and commercially grounded remuneration. A patentee may seek termination if the conditions that justify the license later cease. The decision confirms that compulsory licensing is a fact-intensive judicial remedy, not an automatic consequence of local non-production or a lower-priced alternative.[7]

Notably for this AIPPI edition, the Constitutional Court expressly referred to AIPPI's 2025 Yokohama Resolution on Compulsory Licensing, including its emphasis on exceptional use, good-faith efforts to obtain a voluntary license, market-based remuneration, and termination when the overriding public interest ceases.[8]

Foreign patent owners remain entitled to enforce

A foreign patentee, including one connected with a jurisdiction officially designated as 'unfriendly,' is not deprived of standing or substantive patent protection on that ground. The Supreme Court confirmed this general principle in its June 2026 review of special economic measures. Special measures may affect the mechanics of payment rather than standing; depending on the claimant's status and the applicable exceptions, compensation or royalties may have to be paid in roubles through a special type 'O' account. Foreign corporate status, authority documents, legalization or apostille requirements, translation, and service abroad should be prepared early.[9]

What instructing counsel should send first

For an efficient first assessment, instructing counsel should provide the current patent

register extract and ownership chain; the Russian and English claims and prosecution history; dated product samples, manuals, and online evidence; known supply chain and sales information; and the commercial objective, including any sanctions or payment constraints. These materials allow infringement, validity, evidence, and remedies to be tested in parallel.

Practical outlook

Russian patent litigation in 2026 is neither a purely technical contest nor a simple registration-based claim. Its decisive feature is coordination: infringement evidence, claim construction, validity, interim relief, and quantum must be built as a single strategy across different institutions. Courts will accept varied forms of technical proof but expect the evidence to be transparent and testable; they will protect patents but scrutinize procedural abuse; and they will award monetary relief, but with closer attention to economic proportionality. For patentees and defendants alike, the strongest advantage is obtained before filing - through a rigorous claim chart, an honest validity review, preserved market evidence, and a remedy that can be enforced in practice. That preparation also improves settlement leverage by allowing both sides to quantify procedural risk before positions harden and costs accelerate.

> “For patentees and defendants alike, the strongest advantage is obtained before filing.”

Footnotes

1. Khusainov Khomyakov & Partners, *A Practical Guide to Patent Protection in Russia and Eurasia* (updated 2026): https://en.khp.legal/guides/patent-protection-russia-eurasia/
2. Khusainov Khomyakov & Partners, *A Practical Guide to IP Litigation in Russia* (updated 2026): https://en.khp.legal/guides/ip-litigation-russia/
3. EAPO Annual Report 2023, *Development of the Eurasian Dispute Resolution System*: https://www.eapo.org/wp-content/themes/eapv-theme/reports/report2023/disputs_en.php; Supreme Court Plenum Resolution No. 10 of 23 April 2019, On the Application of Part IV of the Civil Code: https://www.consultant.ru/document/cons_doc_LAW_323470/
4. Supreme Court, ruling No. 305-ES25-15716 of 16 March 2026, case No. A40-264483/2024: https://kad.arbitr.ru/Card/b30e9453-9242-414b-af55-9aff4ae7a884
5. Federal Law No. 214-FZ of 7 July 2025, On Amendments to Part IV of the Civil Code: https://www.consultant.ru/document/cons_doc_LAW_509330/
6. IP Court, ruling No. S01-686/2023 of 4 February 2025, case No. A40-71253/2022: https://kad.arbitr.ru/Card/a9bee51c-733b-4493-b358-742fa32c8870
7. Constitutional Court Resolution No. 13-P of 12 March 2026: https://www.consultant.ru/document/cons_doc_LAW_528505/
8. AIPPI, 2025 *Yokohama Resolution on Compulsory Licensing*: https://aippi.soutron.net/Portal/Default/en-GB/RecordView/Index/6325
9. Supreme Court Thematic Review No. 8/2026 of 17 June 2026, *On the Application by Arbitrazh Courts of Legislation on Special Economic Measures Adopted to Protect the National Interests of the Russian Federation*: https://www.consultant.ru/document/cons_doc_LAW_537231/

RÉSUMÉS

Ramzan Khusainov is Managing Partner of Khusainov Khomyakov & Partners. He has practiced intellectual property law since 2009 and is an IP lawyer and a Russian Patent Attorney specializing in trademarks and industrial designs (No. 1800). Ramzan advises international counsel, patent owners, and technology companies on contentious IP matters, litigation strategy, licensing, cross-border coordination, and sanctions-related issues in Russia and Eurasia. He holds an LL.M. in Intellectual Property from the joint program of the WIPO Academy, Ankara University, and the Turkish Patent and Trademark Office. Ramzan serves on the Bureau of AIPPI's Russian National Group and the Council of the Russian Chamber of Patent Attorneys.

Anton Khomyakov is a Senior Partner at Khusainov Khomyakov & Partners and has specialized in patents and technology since 2013. He is a Russian Patent Attorney (No. 1959), Eurasian Patent Attorney (No. 551), and holds a Ph.D. in Radio Engineering. Anton advises technology companies, inventors, and foreign counsel on patent drafting and prosecution, freedom-to-operate, validity, technical evidence, litigation, and portfolio strategy across Russia and Eurasia. His research background in computational algorithms informs his approach to claim analysis and expert evidence. Anton is a Council member of AIPPI's Russian National Group and a member of the Russian Chamber of Patent Attorneys.

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FROM THE BOARD:
AI-mediated patent counseling: when every client already "asked a chatbot"

As AI becomes inventors' first stop before patent counsel, Mark G. Bloom examines how chatbots are transforming patent intake, bringing new disclosure risks, deceptively polished drafts, and heightened expectations for immediate advice.



Mark G. Bloom

> "The role of the patent lawyer is not to ban these tools, but to help clients use them without undermining their own rights."

Not long ago, inventors and in-house teams walked into the first patent counseling meeting with lab notebooks, slide decks, or a rough invention disclosure form. Today, they often arrive with something else: a draft that started life in a chatbot prompt box. By the time they meet counsel, many have already "*tested*" the idea online, searched for prior art with an AI tool, or asked a consumer chatbot whether the invention is patentable.

This shift changes the counseling conversation in three important ways. It raises the stakes around premature disclosure. It affects the quality and focus of inventor-generated drafts. And it reshapes client expectations about speed, certainty, and cost.

The invisible disclosure event

Most inventors do not think of a chatbot prompt as a public disclosure. They see it as a private research tool. Patent law, however, focuses on whether information is made available to the public without an obligation of confidence, not on whether anyone actually reads it. Many popular AI tools process user inputs on external servers and reserve rights, through their terms of service, to store, review, or reuse those inputs to improve future models.

Several recent commentaries warn that feeding detailed inventive concepts into general-purpose AI tools may be treated as making the invention available outside the company, especially when the tool's terms allow training on user data. That risk is particularly acute in jurisdictions with absolute novelty rules, where any public disclosure before filing can permanently destroy patent rights. Even in countries with grace periods, the timing and nature of the disclosure can complicate later validity arguments.

For patent lawyers, this creates a new counseling task at the first meeting. Before discussing claim strategy, they may need to ask, in plain language, "Have you already put details of this invention into any AI tool, and under what account?" The answer can affect not only filing strategy and jurisdiction choices, but also how urgently a provisional

application should be prepared.

Drafts that look finished but aren't

AI-generated invention write-ups present a second challenge. Inventors increasingly use general-purpose tools to "*clean up*" technical descriptions or expand rough notes into something that reads like a patent application. The result is often long, polished text with headings and formal language, but it may blur the core inventive concept or introduce speculative language that does not match actual support.

From the patent lawyer's perspective, this can make counseling harder instead of easier. Reviewing a dense, AI-generated draft can take more time than reviewing the inventor's own short, focused description, because counsel must first strip away filler and identify what is actually new. There is also a risk that the draft includes unintentional admissions, overbroad statements of "*the prior art*," or inconsistent embodiments that later complicate prosecution.

Several practice notes now advise inventors to use AI cautiously and to keep their own short, human-written summary of the inventive idea as the primary input for counsel. In counseling sessions, lawyers can reinforce this by explaining why a lean, honest description of what the team actually built is more valuable than a "*near-patent*" text generated by a consumer chatbot.

Expectations shaped by instant answers

Finally, AI tools change what clients think a patent lawyer does. A chatbot can produce instant responses on questions like "Is this patentable?" or "What is the chance of getting a patent on this idea?" Even when those answers are simplistic or wrong, they shape expectations: clients may assume that counsel can provide similar certainty and speed, and may be surprised when the real answer is "It depends, and we need more facts."

Recent guidance from legal commentators also highlights the risk that clients who seek AI "*legal advice*" before meeting counsel may inadvertently waive privilege or create confusing records of mixed human and machine input. In patent counseling, this can show up as emails or notes that quote chatbot assessments of prior art or patentability, which do not reflect the nuanced standards applied by offices and courts.

A practical response is to treat AI use as another part of the intake process. At the outset, patent lawyers can ask what tools the client has already used, listen to how those tools have framed the client's expectations, and then explain the differences between automated output and legal analysis. This conversation can also be an opportunity to introduce safer practices, such as using enterprise-grade AI platforms with clear confidentiality guarantees, or limiting AI use to formatting and non-novel background content once a filing date is secured.

Re-centering counseling in an AI world

AI tools are not going away. They are now part of how inventors think, write, and prepare for that first meeting with counsel. The role of the patent lawyer is not to ban these tools, but to help clients use them without undermining their own rights.

That means asking early and specific questions about AI use, educating clients on the difference between presentation and disclosure, and resetting expectations around what good patent counseling looks like in a world of instant answers. If patent lawyers can take ownership of this "*AI-mediated*" front end of the patent process, then they can turn a new source of risk into a new space for trusted advice.

"Several practice notes now advise inventors to use AI cautiously and to keep their own short, human-written summary of the inventive idea as the primary input for counsel."

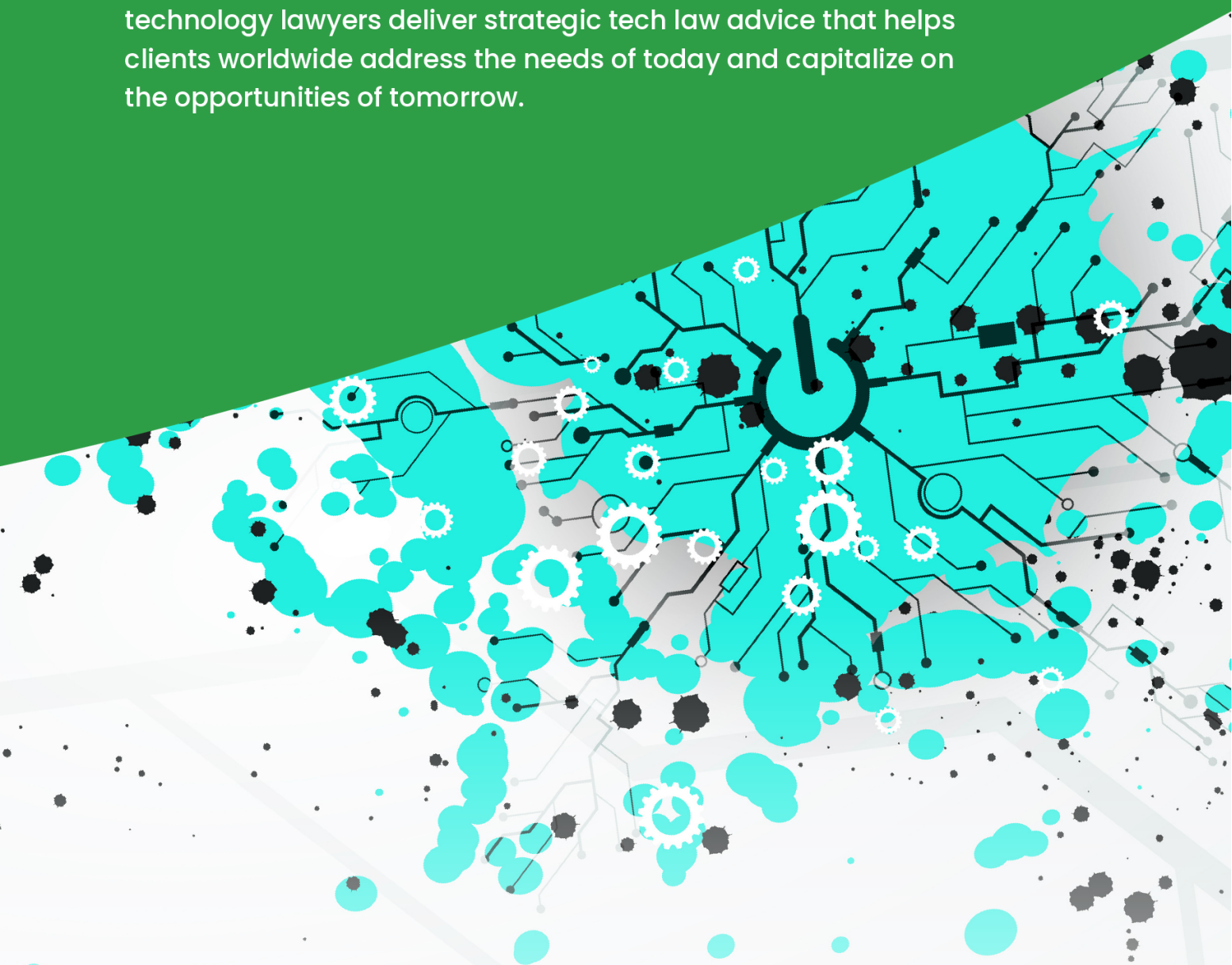
RÉSUMÉ

Mark G. Bloom, BS, D.Jur. CLP®, RTTP™ is Co-Founder of AI Transforms Today, LLC.

Dr. Bloom is a Registered Patent and Trademark Attorney, serial entrepreneur, and general business professional. He is a member of the Bars of Massachusetts and New York, various Circuit Courts, the U.S. Court of Federal Claims, the U.S. Court of International Trade, and the U.S. Supreme Court. Dr. Bloom is also a Certified Licensing Professional and a Registered Technology Transfer Professional.

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The dual inhaler case: defending market share against anti-competitive utility model claims

Chamelia Sari of PRAWIRANEGARA Intellectual Property examines a recent case in which her client successfully defeated an anti-competitive utility model enforcement attempt after a competitor sought to block its dual inhaler product. Drawing on global prior art and evidence of the client's independently established brand strength, Chamelia demonstrates that the asserted features lacked novelty and could not lawfully be used to restrict legitimate market competition.



Chamelia Sari

> **A systematic deconstruction of each claim in our formal response demonstrated that the allegations completely lacked merit under international patent law doctrines.**

How can an innovative product holding a 30% market share suddenly face a commercial shutdown? The answer lies in the strategic weaponization of utility models—leveraged not to protect genuine innovation, but as an anti-competitive tool to achieve an illicit market monopoly. A recent patent infringement cease-and-desist notice issued in Indonesia serves as a practical case study on how competitors attempt to privatize the public domain to eliminate fair competition, and how robust global prior art can successfully dismantle these predatory legal tactics at the pre-litigation stage.

Part 1: the allegations and functional claims overreach

Opposing counsel issued a cease-and-desist letter, demanding an immediate halt to the manufacture and distribution of our client's premium dual inhaler product. The claimant alleged that the product infringed upon the exclusive rights of a registered Utility Model in Indonesia.

The statutory basis for this aggressive demand relied on Articles 143 and 162 in conjunction with Article 163, Paragraph (1) of Law No. 65 of 2024 regarding the Third Amendment to Law No. 13 of 2016 concerning Patents. The allegations of infringement were anchored on four specific functional claims of our client's product:

1. The shared use of a dual-aperture design (dual inhaler)
2. The inclusion of an integrated reservoir for health formulas or aromatherapy
3. The utilization of dual connecting channels leading from the reservoir to distribute the formula into both apertures
4. A shared functional utility designated for respiratory therapy via the nasal passages.

Part 2: deconstructing claims via global prior art

A systematic deconstruction of each claim

in our formal response demonstrated that the allegations completely lacked merit under international patent law doctrines. By executing a meticulous global patent database search and analyzing commercial physical markets, we presented undeniable evidence that the features claimed by the opposing party lacked the requisite statutory novelty due to the long-standing existence of established prior art:

> **The claim over the formula storage reservoir is structurally and historically flawed.**

- **Claims 1 & 3 (dual-aperture design & connecting channels):** The mechanical framework of a dual-aperture inhaler alongside dual fluid channels is not a novel technology. Comparative evidence reveals that structurally identical inhaler products were manufactured, marketed, and widely distributed in the Southeast Asian market (specifically Thailand) long before the priority or filing date of the competitor's utility model in Indonesia.

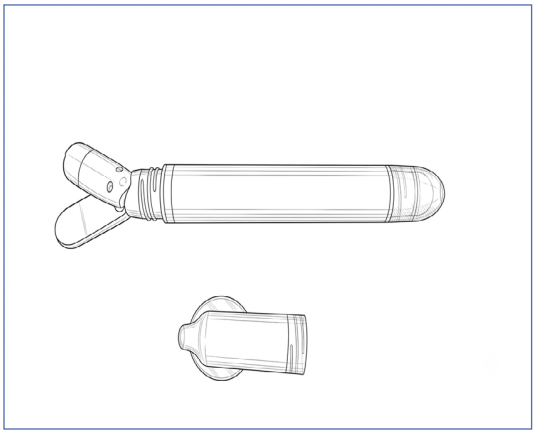


Figure 1: Technical sketch of the client's dual-aperture inhaler product currently circulating in Indonesia.

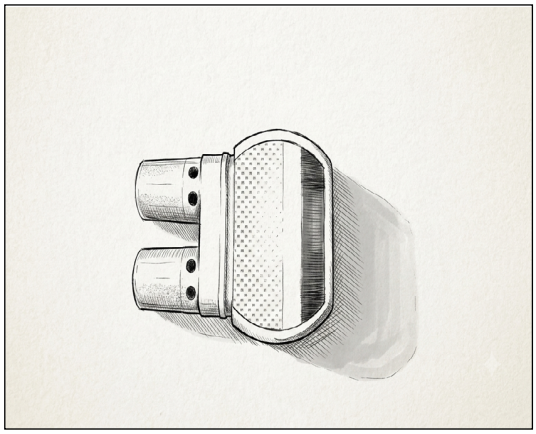


Figure 2: Technical sketch of the structurally identical prior art inhaler established in the Thai market.

- **Claim 2 (integrated reservoir):** The claim over the formula storage reservoir is structurally and historically flawed. Global patent database searches reveal that leading global manufacturers have patented and utilized similar reservoir mechanisms for decades. Specifically, US Patent No. 3,027,897 (invented by Louis Edward Carofiglio, granted on April 3, 1962, and associated with Vicks) and US Patent No. 3,198,193 (invented by Sam Schwartzman, granted on August 3, 1965) both demonstrate well-documented, historical structures for nasal inhaler components and reservoirs. Consequently, this functional layout has long entered the public domain and cannot be legally privatized.

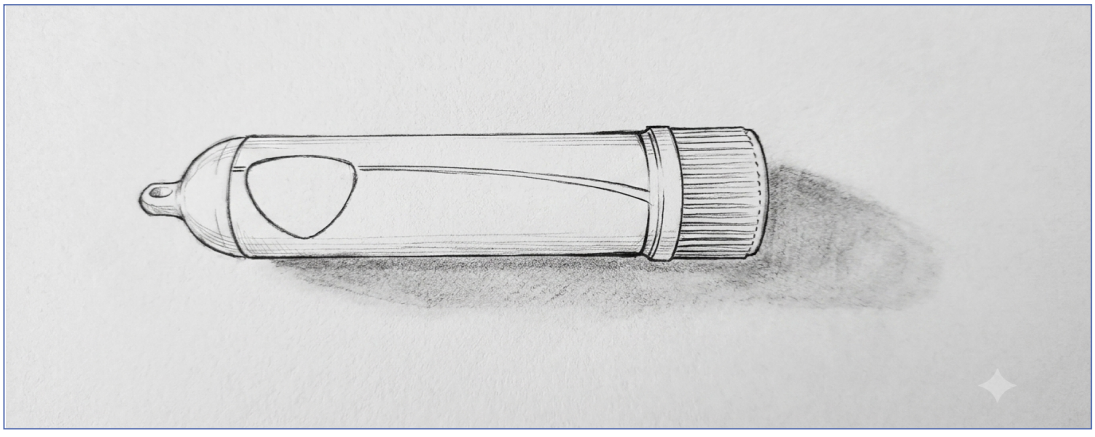


Figure 3: Technical sketch outlining the historical nasal inhaler structure and reservoir mechanism, referencing decades-old global public domain technology (such as traditional Vicks designs).

- **Claim 4 (therapeutic function):** Providing respiratory therapy through nasal passages is the inherent, generic purpose of any nasal inhaler globally. Essential, public-domain product functions cannot be monopolized by a single entity under the guise of local utility model protection.

By presenting these historical facts, the formal response effectively shifted the burden of proof back to the claimant, making it clear that their underlying utility model was highly vulnerable to invalidation due to an absolute lack of novelty.

Market logic: independent branding vs. sham enforcement

In intellectual property jurisprudence and market economics, a genuine infringing party typically seeks a commercial shortcut. Infringers generally replicate products to offer them at a lower price point, aiming to free-ride on the goodwill and established reputation of the original creator.

However, this commercial logic does not apply to this market scenario for two clear reasons:

1. **Premium pricing structure:** In the open market, our client's inhaler product commands a higher retail price than the competitor's product. Consumers choose our client's product based on intrinsic quality and brand loyalty, eliminating any risk of market confusion or deception.
2. **Sustained marketing investment:** The reputation, commercial value, and 30% market share enjoyed today are the direct results of legitimate, independent brand building—not a reliance on a competitor's market presence.

The claimant's legal action was identified not as a legitimate exercise of IP protection, but as a form of "sham enforcement" designed to orchestrate market foreclosure against a dominant market leader.

Conclusion: safeguarding fair market competition

Based on robust legal arguments and undeniable global prior art evidence, the aggressive cease-and-desist demands were successfully and fully refuted at the pre-litigation stage. By demonstrating that the competitor's utility model attempted to monopolize public domain technology, we established that no viable legal grounds existed to restrict our client's operations.

Consequently, our client's product remains entirely clear to circulate across all commercial networks in Indonesia, successfully safeguarding their 30% market share without entering into protracted and costly litigation. This case serves as a vital reminder to patent experts worldwide that utility model frameworks must be monitored closely to ensure they incentivize true innovation, rather than serving as tools to stifle fair market competition.

"The claimant's legal action was identified not as a legitimate exercise of IP protection, but as a form of "sham enforcement."

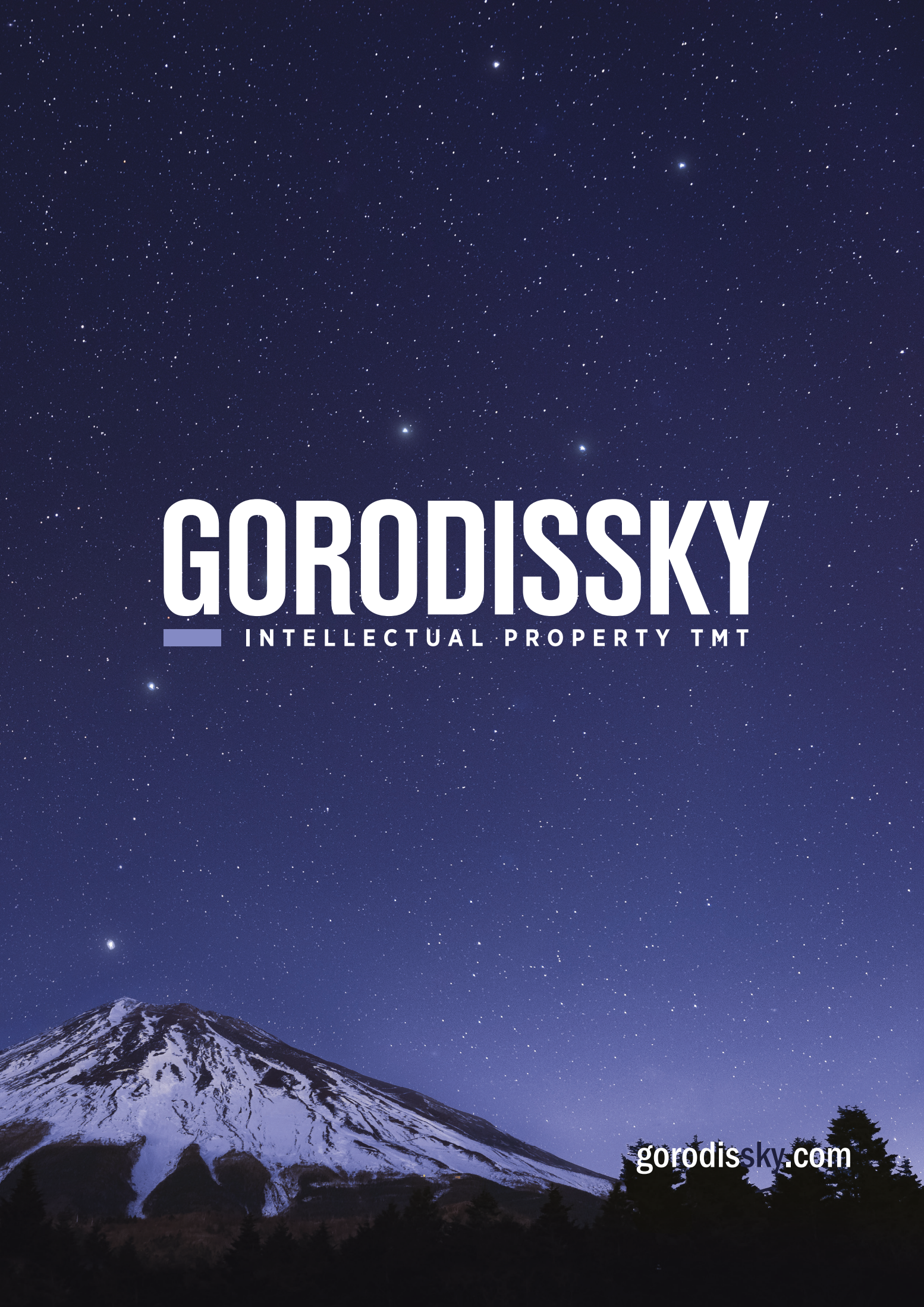
RÉSUMÉ

Chamelia Sari: Founder, International IP Specialist & Certified Mediator

Ms. Sari is the Founder and Managing Partner of PRAWIRANEGARA IP, with over 25 years of expertise in Intellectual Property, Technology Transfer, and International Law. An alumna of Gadjah Mada University and Northeastern University (LL.M.), she became a Licensed Mediator with IMAC Jakarta in December 2025. She holds prestigious leadership roles as Vice President of the AEA – Association of European Lawyers (Asian region) and sits on committees for INTA, AIPLA, and BIPLA. With a dual background in Law and Economics, she is a premier consultant for cross-border IP strategy between Asia, Europe, and the USA.

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Women in IP Leadership

In association with AIPLA
American Intellectual Property Law Association

Carina Gommers

Founding Partner of CAST

Carina is a founding partner of CAST and one of Belgium's most prominent intellectual property lawyers, with a strong international reputation for delivering results in both complex disputes and strategic advisory work.

Alongside her practice, Carina is a key figure in the international IP community. As former President of ECTA and through numerous leadership roles over the years, she plays an active role in shaping the future of IP law and policy. A respected voice in the field, Carina serves on the editorial board of the Journal of Intellectual Property Law & Practice, publishes widely, and frequently lectures.

What inspired your career?

At the start of my career, I got the opportunity to work in the intellectual property department of a well-known Belgian law firm for a summer internship.

At the time, I was not even sure I wanted to become a lawyer, let alone an IP lawyer, but that internship convinced me that intellectual property was the way forward for me.

I have always been drawn to creativity and innovation, and intellectual property law fits, of course, well in that respect. Intellectual property law is not abstract law in isolation but is very much connected to our everyday lives.

What inspired me then, and still inspires me now, is that IP lawyers are often invited into the process at an early stage as we see the idea or the new product before it is launched. Seeing the product later in the market is particularly rewarding.

My career was also inspired by a desire to continuously learn. IP lawyers are involved in so many different sectors; one day you are looking at a pharmaceutical innovation, another day at a luxury brand, a media format, a design, a piece of technology, or a cultural trend. It is impossible to be bored in this profession, and that has always suited me perfectly.

How have you found the pathway to your current position? What advice would you offer from your experience?

Earlier this year, I embarked on an exciting new chapter by co-founding CAST, a Belgian boutique law firm. We are a diverse team of eight lawyers working together in IP law, media and entertainment law, and art law.

My pathway to this point has not been perfectly linear, and I think that is one of its greatest strengths. Many defining moments in my career did not arrive with a formal announcement. It is more about seizing opportunities when they arise, such as volunteering as an associate on a particular matter, joining a committee, contributing to an article, or attending an international conference. I still remember attending my first IP events, in rooms full of people whose names I only knew from publications, case law, and professional circles. Over the years, as I became more active in the profession, I was able to contribute more and more. I understood that the important thing is to actively participate, build connections, and share expertise.

> “In those moments, I learned that resilience is not about pretending everything is effortless. It is about prioritizing and continuing even when the pace is demanding.”

My advice would be read, prepare, work hard, but also raise your hand and say yes to opportunities, even if they stretch you. Build relationships and be generous with your knowledge.

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

I did not grow up in a family of lawyers, which meant that the legal profession initially felt like an unfamiliar world. Without established connections or insider guidance, I had to navigate my own path. Looking back, that challenge became one of my greatest strengths, teaching me determination and adaptability.

Another challenge of building a career in business law as a woman is navigating a profession where women, particularly in leadership positions, remain underrepresented. There have been moments when I was the only woman in the room, and that can feel challenging. However, I learned that expertise, preparation, confidence, and authenticity speak for themselves.

I also had to learn how to combine ambition with endurance. A career in IP, especially with international work, clients, court deadlines, conferences, leadership responsibilities, and a family, is intense. There have been periods where everything seemed to happen at once: major files, travel, speaking engagements, management decisions, and personal commitments. In those moments, I learned that resilience is not about pretending everything is effortless. It is about prioritizing and continuing even when the pace is demanding. I am lucky to be surrounded by people who are both excellent and kind. That combination is underrated, but essential.

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

Apart from co-founding CAST earlier this year, becoming President of ECTA is certainly one of the most meaningful milestones in my career.

Awards, rankings, and titles are wonderful acknowledgments, and I do not take them for granted. But the achievement that matters most is trust.

Trust from clients, from peers, from colleagues, and from the wider IP community. That is earned over many years, and it remains the thing I value most.

And if I look at achievement more personally, I would say I am proud to have built a career that still feels true to who I am. I consider it a privilege to have clients who have entrusted me with their matters. I am grateful for colleagues who have become friends. I am proud of younger lawyers who have grown in confidence after a recommendation or a small push in the right direction.

What are your aspirations for the future and how will you work to achieve them?

I want to continue contributing to the development of IP at a time when the field is undergoing profound change. Artificial intelligence, new technologies, the growing value of intangible assets, and changing consumer behavior are all redefining how we think about creativity and innovation. IP law has always evolved with society, but the pace today is extraordinary.

I would like to help ensure that this evolution remains balanced. That requires dialogue between lawyers, judges, policymakers, businesses, academics, and users. I have always believed that IP is strongest when it is not treated as a closed technical discipline, but as part of a broader societal conversation.

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

We have made progress, and that should be recognized. When I look at the IP world today, I see more diverse voices in professional organizations and more openness around inclusion than when I started. That is encouraging.

But representation must go beyond presence. It is not enough to invite diverse professionals into the room. They must also be heard, trusted, promoted, and given real decision-making power.

I would still like to see more diversity in leadership positions, on boards, in institutions, in expert groups, in arbitral and judicial appointments, and in the informal networks where opportunities are often created. Equality and diversity are also not only about formal rules. It is about who gets the phone call, who is recommended, who is introduced, and who is encouraged to apply.

The IP sector is global, creative, and intellectually sophisticated. Its leadership should reflect that same richness.

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

I believe empowerment begins with visibility. If younger women see women arguing cases, building firms, leading panels, shaping policy, and chairing organizations, something important happens. Ambition becomes more imaginable.

But visibility as such is not sufficient. Mentorship is also important. We all need advice, perspective, and encouragement. And we also need sponsorship, which goes further than mentorship. A sponsor says your name when opportunities are being discussed. A sponsor recommends you for a panel, a leadership role, a client opportunity, or a committee position. A sponsor does not simply tell you that you are capable. They help make sure others see it too.

Looking back, I can identify moments when people did that for me. Sometimes it was a senior professional who invited me into a discussion. Sometimes it was someone who suggested me for a role. Those gestures can be career changing.

I believe women in IP can continue to empower one another by being intentional. Recommend each other. Share platforms. Give credit publicly. Make introductions. And when you reach a position of leadership, do not close the door behind you. Hold it open for others.

“It is not enough to invite diverse professionals into the room. They must also be heard, trusted, promoted, and given real decision-making power.”

Patent strategies for mitigating the impact of the UPC

Adapting strategies for European patent risk mitigation and patent portfolio development for the Unified Patent Court (UPC).



Greg Corcoran

> **The UPC at least reasonably expects an active stakeholder in an industry to monitor the relevant patent landscape before placing a new product on the market.**

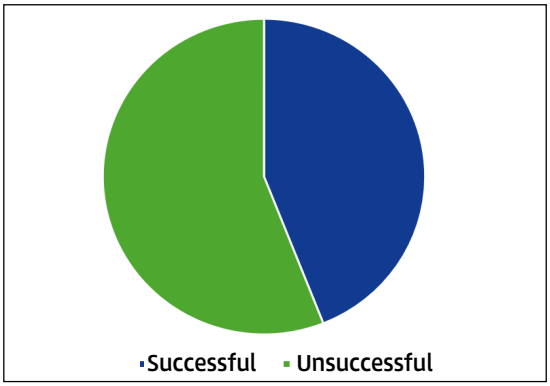
Three years after beginning operations on June 1, 2023, the UPC is widely regarded as a success.[1, 2] The court fulfills the long-held ambition of a single patent court for Europe – a counterpart to the European Patent Office (EPO) in granting patents. The founders of the UPC designed the court to decide cases in a reasonable time.[3] The court has met this ambition. It currently concludes infringement cases in 398 days, under its 14-month target.[4] How does the court keep to this target and maintain a strict schedule while managing its continually increasing workload?[5] What other characteristics of the court attract claimants? How do these changes impact parties to proceedings, especially defendants, and what can they do to mitigate the new risks that the UPC presents?

1. The characteristics of UPC and its proceedings

The UPC is fast, efficient, cost-effective, reliable, and predictable. Its procedural rules are prepared so that first instance decisions are handed down in around 14 months.[6] This is much faster than in many European national proceedings – except for German infringement proceedings. Globally, UPC proceedings are comparable in speed to those of the International Trade Commission (ITC) in the US, which has jurisdiction only over the importation of allegedly infringing products.

Its decisions are reliable and predictable. Rather than being dependent on a jury, decisions are made by a panel of professional judges, usually including a technical judge selected for their technical expertise. In contrast to the US courts, injunctive relief is usually granted by the UPC.[7] As of January 2026, the UPC had granted an injunction in around 50% of all first-instance decisions, see Fig. 1 from the UPC Court of First Instance (CFI). (Please note that the statistics derived from UPC decisions are presented for illustrative purposes. Statistics using UPC decision data are an unreliable reflection of all UPC proceedings because most UPC cases settle before being decided.)

Fig. 1: Outcome of 84 UPC CFI decisions, decided before June 1, 2026.[8]



Key is the change from the diverse, fragmented national proceedings across Europe to a single, coherent process. Today, the UPC has jurisdiction covering 18 UPC contracting states, which together have a population of approximately 320 million. All UPC contracting states are member states of the European Union (EU), so a UPC injunction

may frustrate a defendant's trade across the EU, which has a population of approximately 450 million. The impact of a UPC decision can be exacerbated if a claimant, under special circumstances, requests "long arm jurisdiction" to enforce equivalents of the asserted patent in European jurisdictions, even outside the EU, e.g., the UK, Norway, and Turkey. Long arm jurisdiction may extend the consequences of a UPC decision to markets with a population reaching around ~550 million. A UPC injunction can therefore disrupt a larger consumer market than that of the US, which has a population of about 340 million.

Because the UPC seeks to maintain the cost-effectiveness of European litigation, even the most expensive UPC cases are cheaper than US proceedings.[9]

In view of its reliability, speed, and cost-effectiveness, US commentators, such as David Kappos,[10] report that some US lawyers are advising clients to start UPC proceedings first. In 2025, the US is ranked fifth by number of UPC actions based on the country of claimant.[11] The jurisdictional balance in global litigation strategies is changing.

2. Timing: the key challenge of UPC proceedings

To meet the target timeline, UPC proceedings feature tight deadlines. Response times are short, e.g., three months to file an infringement defense, see the red box in Fig. 2. Proceedings are "front-loaded".[12] A claimant should elaborate in its initial pleadings the arguments and evidence on which it relies, ensuring that the defendant is aware of the factual elements and grounds on which the claim is based. This enables the defendant to prepare an adequate defense, expediting the proceedings. The court perceives that this objective would be undermined if the claimant were permitted to gradually introduce new facts, legal arguments, or evidence. Only in exceptional circumstances are time extensions granted and late filings accepted.

3. The need for a counterclaim

The UPC may hear infringement and revocation proceedings simultaneously, assuring procedural certainty by allowing a defendant to seek revocation of the asserted patent with the infringement proceedings. This is unlike German national proceedings in which the invalidity and revocation proceedings are separate. Infringement[13] may be decided months before the German nullity decision.

Reliance on invalidity arguments is not automatic. A defendant should file a counterclaim for revocation including arguments by the same deadline as its infringement defense. Meeting this deadline can be challenging. It can also be costly because filing a counterclaim for revocation entails payment of official fees: a fixed fee of EUR 14,600[14] and a value-based fee dependent on the value of the proceedings. Even if a small entity benefits from reduced official fees, the remaining 50% could still be burdensome. Nevertheless, filing a counterclaim for revocation is strategically important. Filing a counterclaim for revocation improves the chances of a successful defense by about 50%; see Fig. 3.

Fig. 3: The effect on the outcome of infringement proceedings by filing a counterclaim for revocation.[15]

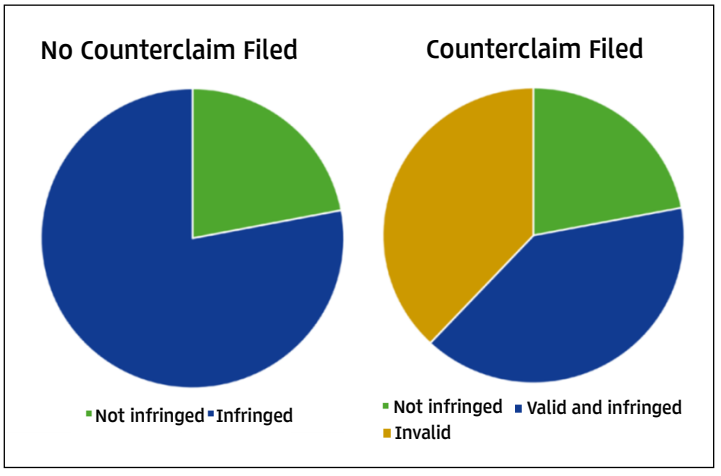
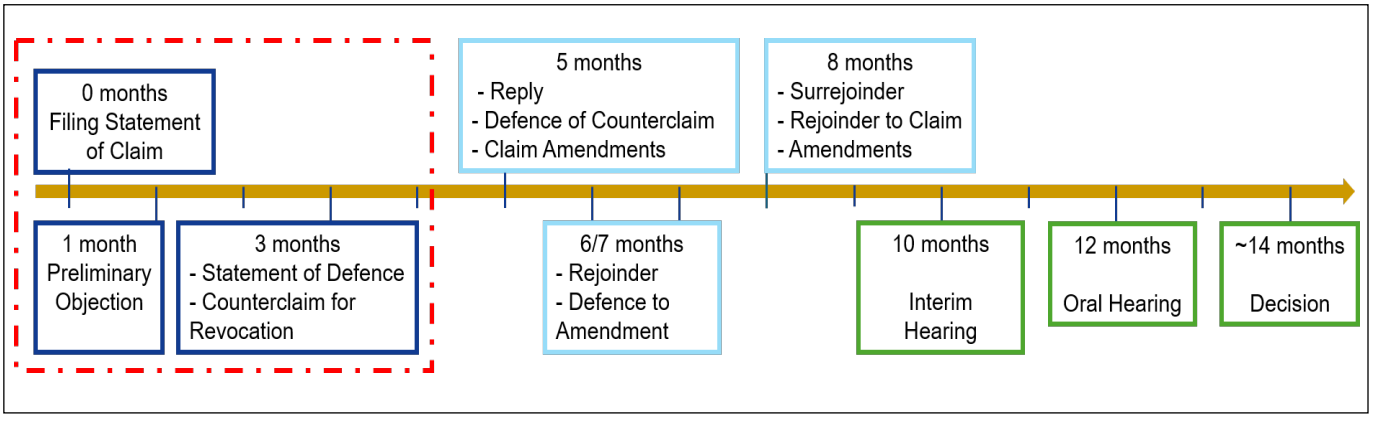


Fig. 2: Timeline for UPC infringement proceedings with a counterclaim for revocation.



Failing to file a counterclaim for revocation forgoes the possibility of putting forward invalidity arguments. Invalidity arguments may not be included in a statement of defense[16] because the UPC framework requires the filing of a counterclaim for revocation to advance invalidity arguments. If they are included in the infringement defense to save on official fees, they will be ignored.[17] Even a Gillette (or Formstein) defense requires a counterclaim for revocation[18] to be filed.

Without invalidity arguments, only infringement arguments will be considered, and then the outcome is more likely than not to favor the claimant (see Fig. 3). Filing a counterclaim for revocation significantly increases the odds of a successful defense. Developing invalidity arguments for such a defense requires time and knowledge of the patent landscape. Preparation has a purpose.

4. The need to know the landscape

Knowledge of the patent landscape is not optional. Parties active in a market covered by the UPC ought to be aware of the relevant third-party patent landscape. The UPC at least reasonably expects an active stakeholder in an industry to monitor the relevant patent landscape before placing a new product on the market.[19] The party should have had reasonable grounds to know of the existence of a patent and of any potential infringement by their products. (Specialized companies may have a general obligation to monitor intellectual property rights.[20])

UPC practice differs from US practice, in which actively seeking knowledge of infringement risks triple damages in later associated US proceedings. If the US is an important market, a strategy should be developed with European and US counsel that observes the requirements of both jurisdictions.

5. Preparation is inevitable

UPC practice is a driver for change. The requirements of a court drive a specific set of strategies to mitigate patent risk for that respective jurisdiction. The UPC has its own requirements, which - as mentioned - include: the speed of its proceedings, frontloading of arguments, the strategic value of filing a counterclaim for revocation, and the standards of knowledge it expects of a market participant. The practice of the UPC differs from that of European national courts, which, for example, permit late filing of pertinent information and arguments. UPC decisions are encouraging the development of patent risk mitigation strategies as common practice across UPC territories.

Preparation appears to be fundamental to the evolving practice for mitigating risk of UPC litigation. It enables maximum use of the limited time available to prepare pleadings for the defense and counterclaim. Waiting to receive a summons before undertaking any preparation risks incurring significantly greater costs for basic preparatory work than if that work is done earlier.[21] Carrying out preparatory steps after proceedings commence (such as identifying likely sources of funding and selecting litigation counsel) eats into the limited time available.

6. Strategies for optimizing application of resources

Parties that would find mitigating litigation risk expensive, such as SMEs, should take basic precautions: identification of litigation counsel who would be able to start work the day that the summons is received, and securing access to funding. A prepared party can make maximum use of the time available to prepare its defense.

Extensive defensive preparation enables a party to assert their own patents the day after proceedings start in which they are defendant. Yet predicting which patents the same party will defend always features guesswork. How much defensive preparation is appropriate and cost-effective has a practical limit. Even if an asserted patent is correctly identified in advance as a potential assertion candidate, the precise infringement arguments that will be used are unpredictable.

Preparation is useful, for example, for improving familiarity, with part of a third-party patent portfolio that is associated with a specific technical feature or function that has a high assertion risk. Such preparation would improve the underlying technical understanding and understanding of the commercial context of the client's products. A party undertaking such preparation is likely to improve its ability to defend against whichever patent of the portfolio is asserted. Preparation can aid identification of prior art common to multiple patents and helps to develop a sound understanding of the disclosure of the patents. The client's employees who assist in this work would also become familiar with how a defense may be prepared. Team members can be identified who have appropriate technical knowledge and suitable capabilities to support future litigation.

Some types of defense require work before their value can be appreciated. Persuading a business to investigate and to decide to adopt a redesign to avoid patent infringement requires the business's willingness to change the design of its product. IP counsel should

demonstrate that traditional defenses such as invalidation are weak. Adopting a secret prior-use defense[22] may be a high-risk strategy. A court may often decide an apparently strong secret prior use defense is insufficient. The development of these types of defense requires close collaboration with business colleagues, who may be in development roles. Their help inevitably diverts resources from regular business activities and requires a demonstration that traditional invalidity defenses have been exhausted.

Using either of these defenses, and the option of preparing and filing a protective letter for a specific patent in advance of proceedings, demonstrates preparation began more than the three months available for filing an infringement defense. UPC decisions show that defendants have used secret prior use defenses.[23] So, some UPC defendants start preparing well before UPC proceedings commence. However, these parties tend to be established businesses familiar with sophisticated patent strategies.

Adopting an IP strategy that includes such preparation is not limited to established players. Smaller parties can develop a UPC risk-mitigation strategy by building mitigating activities into their product development processes, for example treating the costs as a gradual investment. Temporary or fractional external patent expertise, with familiarity with an in-house environment, can enhance the capability of the permeant in-house function.

A similar preparatory approach can be applied when selecting a patent to enforce. Not every granted patent is good enforcement material. Suitability should be verified. Evidence might not withstand scrutiny. New relevant prior art can be found. Patent litigators tend to be highly selective in their choice of patents for assertion to achieve the best outcome for their clients. A patent with even one blemish may be doomed.

Timely preparation well in advance, with incidental input from litigators, can enable development of a patent portfolio with a higher proportion of patents better suited for enforcement. An improved portfolio may deter a claimant from initiating proceedings, thereby mitigating litigation risk, because claimants usually assess counter-patent risk before patent assertion. Improving a patent portfolio may delay or even postpone litigation in favor of a more mutually favorable commercial resolution. Litigation can be avoided, and unexpected commercial opportunities can be generated and realized.

Advanced preparation, that is tailored to the available budget and to the market in which the party operates, provides better-informed options if and when proceedings commence. Preparations may reveal different lines of argument and allow a more forensic and considered approach, when appropriate, thereby deriving stronger arguments for proceedings. If litigation occurs, costs would be more focused. This approach enables more effective use of the available time through efficient consultation with litigators on the questions that count.

7. Summary

Businesses are cost averse. Without clearly delineated benefits, a business is likely to perceive litigation as a risk that interferes with its operations, diverting finance and resources. Litigation would be a tool of last resort. Such a business is unlikely to agree to expenditure on IP and dispute resolution unless management is persuaded that it is essential for the business's commercial success.

The characteristics of the UPC (e.g., its speed, its predictability, the size of the market it impacts, and its expectation that a business monitors the relevant patent landscape) mean that a business of whatever size could mitigate UPC litigation risk according to its cost appetite. When a business perceives mitigating UPC risk as an investment opportunity that avoids significant litigation costs that could otherwise be incurred, better outcomes may be realized, leading to unexpected business outcomes.

At the very least, the key is engaging litigation counsel and implementing a strategy to secure access to funding, especially if resources are internally unavailable. Mitigating significant costs and accessing a broad range of strategic options can be realized by bringing on board counsel with relevant in-house experience and appropriate expertise well in advance of expected proceedings.

The UPC is changing the litigation landscape. Parties active in Europe should consider adapting their risk mitigation strategies accordingly.

Footnotes

1. UPC turns three: statistics, milestones, and trends | BARDEHLE PAGENBERG, June 2026.
2. "UPC is like an orchestra missing crucial instruments for the full sound" - JUVE Patent, 4 June 2026.
3. 13th Preamble of the Agreement on the Unified Patent Court (UPCA)
4. p100 of the UPC Annual Report 2025 (UPCAR'25)
5. p101 UPCAR'25 – 164 infringement actions

lodged in 2024, 266 in 2025. The number is increasing through 2026 with 123 new infringement cases by August (see slide 3 202606 - UPC Statistics - July.pdf).
6. This statistic is based only on the dataset provided in UPCAR'25.
7. To the end of 2025, all successful claimants in infringement proceedings were granted injunctive relief.
8. UPC turns three: statistics, milestones, and trends, courtesy of BARDEHLE PAGENBERG, June 2026.
9. An estimate of entry level first instance with revocation is from €300,000; see "UPC is like an orchestra missing crucial instruments for the full sound" - JUVE Patent, 4 June 2026
10. Ipfray Linkedin post 27th April 2026 – quoting David Kappos reporting US lawyers are advising clients to start UPC proceedings first because it reliable, fast and cost effective.
11. See p105 table 4a of UPCAR'25 – only Germany, the Netherlands, France and China have more.
12. UPC_ CoA_36/2026 Angelalign v Align 8 July 2026 (e.g. paragraphs 158 to 164); UPC_CFI_308/2023 NJOY. v. VMR 27 November 2025 (paragraphs 13 to 28); and UPC_CoA_312/2025 UPC_CoA_333/2025 UPC_CoA_880/2025 UPC_CoA_882/2025 Kodak v Fujifilm 2 June 2026 (paragraphs 126; 239)
13. Note: more accurately, limited invalidity arguments may be presented in German infringement suit.
14. See UPC fee sheet; small and micro-entities may apply to benefit from a 50% fee reduction.).
15. Carpmaels & Ransford, Patent Litigation Europe 2026, 19th January 2026. From 73 decisions of all local divisions prior to mid-January 2026.
16. UPC_CFI_373/2023 SodaStream v Aarke, 31 October 2024
17. Ibid [Footnote 16]
18. UPC_CFI_493/2025 Agathon AG v Intercom SRL, 5 May 2026
19. UPC_CoA_8/2025, Bhagat v Oerlikon, 9 December 2025; relating to assessment of damages Art 69 UPCA.
20. UPC_CFI_559/2204, Düsseldorf, Quantificare v Canfield, 23 April 2026
21. Contradictorily, funding for some defendants is more readily available after proceedings start.
22. UPC_CoA_312/2025; UPC_CoA_333/2025; UPC_CoA_880/2025; UPC_CoA_882/2025, Court of Appeal, 2 Jun 2026 (Kodak v FUJIFILM)
23. Ibid

RÉSUMÉ

Greg Corcoran is a UPC Representative and a Chartered (UK) and European patent attorney with significant in-house experience of managing large portfolios and related patent litigation in the semiconductor sector. He founded his own practice, Greg Corcoran IP, in early 2025 to bring his in-house experience to a broader range of clients. He can assist companies and their existing lawyers in mitigating their European patent litigation risks and help them secure robust patent protection to help them meet their commercial goals in a rapidly evolving patent landscape shaped by the UPC. He is an occasional conference panelist (such as this year's CTC Legal Events Winter IP Conference) and an active writer, with several recent publications on international patent practice.

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> Ryan L. Marshall,
> Partner, Barnes & Thornburg, LLP



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1 https://www.pharmexec.com/view/2024-pharm-exec-top-50-companies

2 https://www.wipo.int/edocs/pubdocs/en/wipo-pub-941-2023-en-world-intellectual-property-indicators-2023.pdf

Recent changes in substantive examination practice at IMPI

Luis Fernando Granados of Uhthoff explains how recent reforms to Mexican patent law and practice are significantly accelerating substantive examination before the IMPI, creating a major opportunity for applicants in the pharmaceutical, biotechnology, and other time-sensitive sectors. He highlights that while shorter timelines may also introduce risks, they can ultimately be beneficial provided the IMPI maintains examination quality, legal certainty, and sufficient flexibility to address complex inventions.



Luis Fernando Granados

> For applications filed on or after April 2026, patent applications filed before IMPI have begun receiving substantive official actions on a timeframe without precedent in Mexican practice.

For a long time, one of the most persistent problems of the Mexican Institute of Industrial Property (IMPI) was the slow pace of substantive examination of patent applications, which in many cases prolonged patent prosecution by seven years or more. Current law in Mexico provides that a possible delay in patent prosecution may be considered only after a period of more than 60 months from the filing date. However, due to recent changes in the law and practice, this picture has changed abruptly. For applications filed on or after April 2026, patent applications filed before IMPI have begun receiving substantive official actions on a timeframe without precedent in Mexican practice, in sharp contrast with the common practice in Mexico over several years, and also with the pendency currently observed at foreign patent offices that have been a common support for Mexican patent prosecution, such as the European Patent Office (EPO) and the United States Patent and Trademark Office (USPTO). This is generated by a new regulatory framework closely linked to international treaties, such as the United States-Mexico-Canada Agreement (USMCA), and entails significant practical advantages and associated risks for applicants seeking patent protection in Mexico.

The first move came in March 2026, when IMPI published an Agreement in the Federal Official Gazette (DOF) reducing the maximum number of technical office actions that IMPI may issue during substantive examination of a patent application from four to two, and introducing the option of non-officially registered telematic interviews between Examiners and applicants to discuss patentability objections raised against the cited prior art. These amendments were in force from March 12, 2026, and the main objective, as noted by IMPI, was to reduce examination timeframes.

Less than a month later, the DOF published a decree amending, adding to, and repealing several articles of Federal Law for the Protection of Industrial Property (FLPIP), being the most significant reform of that statute since it came into force in 2020, which IMPI has expressly linked to the ongoing USMCA review. Among the provisions related to patent prosecution times, some of the most relevant are:

- **New Article 111 Bis**, which caps the maximum term for resolving substantive examination of a patent at one year, counting from the beginning

of in-depth examination. It is relevant to note that the Federal Law does not restrict a specific period for the beginning of substantive examination, but only the maximum term for resolving the same.

- **The provisional patent application in Article 105 Bis**, a figure with no precedent in Mexican law and mirroring that available in the US practice: providing 12 months after filing of a provisional application to proceed with the filing of the corresponding non-provisional complete version of the same, meanwhile without a publication or examination of the application, or an associated priority right.
- **A Specialized Technical Committee,** considered in the DOF issued on June 8, 2026, comprised of representatives of different government sectors and empowered to conduct a "Mandatory Resolution" proceeding when the Institute exceeds statutory deadlines without justification.
- **For pharmaceutical patents,** new Article 136 Bis, which allows the patent term to be adjusted by a maximum of five years, where the Mexican marketing authority COFEPRIS (Federal Commission for the Protection against Sanitary Risks) causes an unreasonable delay in granting marketing authorization, in furtherance of USMCA Article 20.46.

Additionally, this development in the functions of IMPI is not only related to domestic actions, since on July 13, 2026, at a meeting in Geneva during the World Intellectual Property Organization (WIPO) Assemblies, the PCT Union Assembly approved by consensus the designation of IMPI as an International Searching Authority and International Preliminary Examining Authority (ISA/IPEA) under the Patent Cooperation Treaty. The Institute thereby became the 26th authority within the PCT system, and the third to operate in Spanish, alongside the offices of Spain and Chile; operations as ISA/IPEA are expected to begin in January 2027, as noted by WIPO in communication PCT/CTC/33/27.

This designation is quite significant, since applicants filing PCT applications before the IMPI have had to rely on foreign authorities for international search and preliminary examination. Following all of the above and trying not only to have a strong legal infrastructure but also a refined personnel force to perform all necessary actions, IMPI announced the hiring of 500 new specialized Examiners to join a current staff of just 197 Examiners to help clear a backlog of more than 56,000 pending patent matters, 44,000 of which are awaiting examination.

"IMPI announced the hiring of 500 new specialized Examiners to join a current staff of just 197 Examiners to help clear a backlog of more than 56,000 pending patent matters."

All these facts confirm an important number of actions from IMPI to improve timeframes for patent applications, leading to a natural comparison between examination times before and after this reform and between new practice and current international practice at relevant foreign office for Mexico, such as EPO and USPTO, since the speed at which substantive office actions are now issued in Mexico could be better understood when compared to the international practice in other leading offices. In this sense, according to the provisions of the FLPIP, a prosecution could be considered as a delayed examination only when the time from filing to allowance is more than 60 months, which, in the absence of clear and official data, could be considered as a reference to the prosecution length of applications in Mexico before the entry of new reforms. On the other hand, according to the USPTO's public Patents Dashboard, the average pendency to a first office action increased from 19.9 months in 2024 to 22.6 months in 2025, while the traditional total pendency stands at 26.3 months. On the European side, the jointly published 2023 statistics report of the world's five largest IP offices (the IP5) reports a mean time of 24.9 months between the request for examination and the communication of the intention to grant, while 77.2% of intentions to grant were issued within 36 months and the overall time to grant for first filings (standard cases) was 44.1 months on average.



Table 1. Comparison between international practices regarding timeframes of patent applications EPO-IMPI-USPTO

Indicator	IMPI	USPTO	EPO/IP5
Statutory cap on substantive examination	From 2026, 12 months (Art. 111 Bis, FLPIP)	No equivalent statutory cap	No equivalent statutory cap
Observed time to first substantive action	Too early to obtain official conclusive data. Some applications filed before these reforms have received a first office action. No legal term for beginning substantive examination.	22.6 months (2025)	24.9 months from examination request (2023)
Total pendency (historical/average)	Less than 60 months is considered a non-delayed examination for IMPI before the reform. For patent applications filed after these new actions and already having received an official action under the provisions of Article 111 BIS, a final decision of allowance or denial will be issued wihtin a period of at most 15 to 16 months.	26.3 months (traditional); but up to 44.2 with Request of Continued Examination	44.1 months (first filings, 2023)
Maximum substantive office actions	2	Variable, no fixed	Variable, no fixed
Patent Examiners	197 current and 500 being hired	8,599 (USPTO Patent stats of 2024)	N/A

Although there is no legal term for the beginning of substantive examination, it is clear that new Article 111 BIS caps Mexican substantive examination at 12 months, a term that would be substantially shorter than the time the USPTO or the EPO currently takes to issue a first substantive communication. It is important to note that the US and EP figures noted below are values observed over years of practice. In contrast, the target in Mexico is a newly enacted statutory ceiling whose sustained compliance has not yet been demonstrated, given the rising technical complexity of chemical, pharmaceutical, and biotechnology applications, as well as the new ISA/IPEA standard. It will then be a matter of time to see how these new timeframes will affect practice in Mexico regarding the prosecution of patent applications.

In this sense, clear advantages are available to applicants with pending applications in Mexico. The most favorable reading of this shift could be, for example, for companies that depend on timely patent protection, such as a pharmaceutical molecule facing imminent generic competition, or a biotechnology start-up seeking certainty ahead of an investment round; obtaining a substantive decision within roughly a year is a genuine competitive advantage over years of prosecution uncertainty. The reduction in the backlog and the hiring of technically specialized Examiners could be a good sign for applicants requiring a fast resolution.

> “The most favorable reading of this shift could be, for example, for companies that depend on timely patent protection.”

This accelerated timeframe serves as an explicit trade-policy objective to bring Mexico’s patent system into line with the required standards of the USMCA, since Mexico was noted on the Priority Watch List in the Office of the United States Trade Representative's (USTR) Special 301 Report. The designation of IMPI as an ISA/IPEA authority under the PCT is clear evidence of international recognition of the Mexican Institute’s technical capacity. It reinforces IMPI as an Institute for protecting inventions in the region, in keeping with the cooperative spirit the USMCA promotes.

On the other hand, these accelerated timelines could also pose significant risks and challenges that will play a key role in the prosecution of patent applications in Mexico.

Firstly, with a maximum of two office actions and a two-month response deadline for each one (Article 111, FLPIP) and in absence of parallel defined strategies, applicants will have almost no time to deeply analyze objections of novelty, inventive step, or sufficiency of disclosure, with higher relevance for applications including Markush-type claims, polymorphs, synthesis processes, medical use claims, biological sequences, etc., where the cited prior art normally tends to be extensive and specialized argumentation is required. Additionally, the complexity of technical examinations has been rising for these types of applications, given the patentability requirements for experimental support and enablement, among others.

Now, in applications where IMPI objects to a lack of unity of invention (Articles 100, 102, and 113, FLPIP), the applicant must restrict the claims to the main invention and file the corresponding divisional application(s) within that same office-action deadline. For patent applications, and in most cases, patent complex families covering multiple compound variants, different medical uses, or genetic constructs, deciding what subject matter to claim in each application and drafting new claim sets for each invention of interest can be quite demanding. Additionally, the cost of each divisional application within a very short period demands a level of planning that is not even provided to applicants during the very short window after filing and before receiving a first official action. This problem is also extensive in the consideration of voluntary filing of divisional applications before initiating technical, in-depth examination, which normally takes many months to define a clear strategy for the inventions of interest. This time will not be available in the Mexican patent system.

Additionally, it is worth noting that IMPI currently maintains PPH agreements with many important foreign patent offices, such as USPTO, EPO, JPO, and CIPO, all of which require that substantive examination in Mexico not yet begun. With the current timeframes of IMPI, the window to use a PPH strategy may be almost closed, with no time for a favorable foreign allowance to serve as a basis for the Mexican examination and with just a few months in Mexico to have the opportunity to file a request that could set the application ready for allowance. This option is an opportunity for applicants not only to take an accelerated exam, but also to mirror a scope consistent with international practice and carefully developed through extensive examinations. In practice, this forces applicants to prosecute applications in Mexico on a stand-alone basis, without the benefit of a search or examination already validated by a parallel office: precisely the inverse of the strategy long favored by many global applicants. In contrast, under the current practice of IMPI, PPH requests are not a direct window to allowance, but an aid to the secondary technical examination that could add information, prior art, or patentability notes to those considered in the IMPI examination.

The number of Examiners at IMPI is another relevant note. The Institute acknowledges that it has only 197 Examiners and plans to hire 500 new Examiners to improve examination performance. However, this recruitment will require a complex training process to be considered complete; the real question remains whether this process can be sustained without compromising examination time or quality in highly specialized scientific subject matter. This consideration takes greater importance, given that the Institute will also have to absorb new ISA/IPEA functions starting in 2027.

> “The cost of each divisional application within a very short period demands a level of planning that is not even provided to applicants during the very short window after filing and before receiving a first official action.”

As a final note, accelerated substantive examination could be considered good news for the Mexican patent system by reducing uncertainty of applications due to long, undefined prosecutions, addressing a commitment undertaken under the USMCA, and, with its new status as an ISA/IPEA authority, providing Mexico a more visible role within the PCT system. However, speed in prosecution matters alone is no substitute for actual legal certainty. For applicants in the chemical, pharmaceutical, and biotechnology sectors, whose inventions typically demand high elaborate technical analysis, the immediate challenge is to reduce examination timeframes, but without sacrificing protection opportunities and quality examinations, additionally providing opportunities of developing substantive strategies for applicants that clearly know that building a calm strategy over the first years is the precise key for obtaining the best available protection of its unvaluable IP matters.

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RÉSUMÉ

Luis Fernando Granados is a patent expert specializing in applications within the biochemical sciences. Luis began his career in the Intellectual Property (IP) field in 2015. His practice focuses on drafting and prosecuting patent applications in the Chemical, Pharmaceutical, and Biotechnological sectors. He has extensive expertise in the technical analysis of inventions during substantive examination to achieve patent allowance, as well as providing strategic counsel to applicants, inventors, and patent owners throughout prosecution, validity assessments, and contentious proceedings.

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How AI is transforming intellectual property practice

As patent volumes rise and technologies become more complex, AI is emerging as an indispensable tool in intellectual property practice. This article examines how AI is augmenting rather than replacing IP professionals, enabling them to focus on oversight, interpretation, and higher-value decision-making.

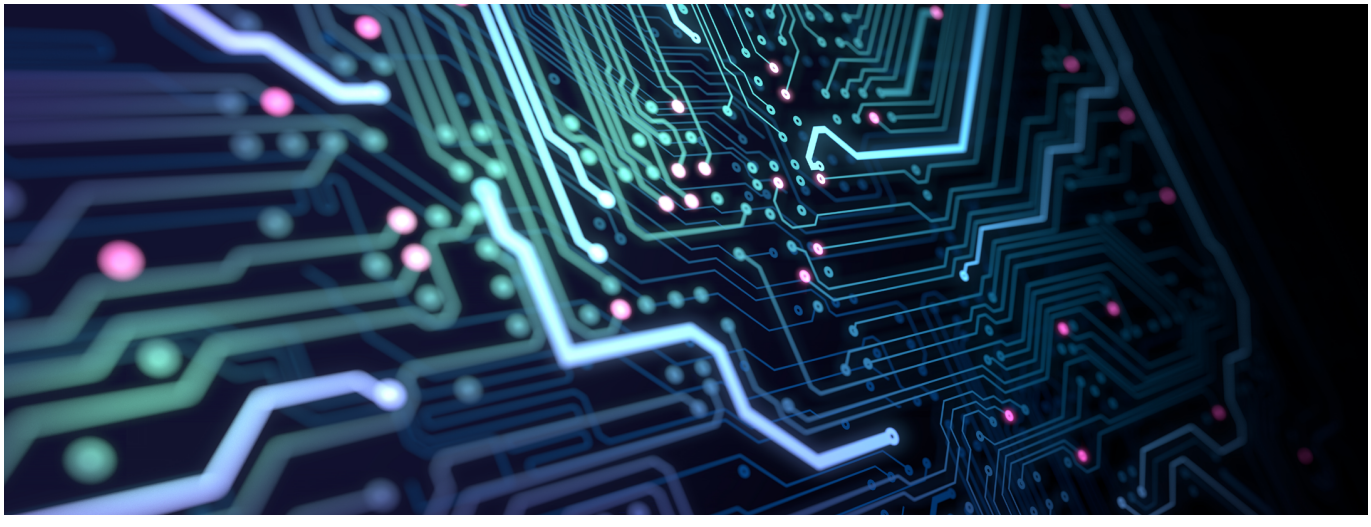
The intellectual property (IP) profession is at an inflection point. Patent application volumes have grown at a compound annual rate of 5.1% among the world's top five patent offices, while application complexity has risen alongside. More claims, prior art citations, and cross-disciplinary inventions require practitioners to command ever-broader domains of knowledge. AI is emerging not as a replacement for professional judgment, but as a means of scaling that judgment.

Productivity and prior art search

The clearest evidence of AI's impact comes from patent office deployments. In a collaboration between CAS and Brazil's National Institute of Industrial Property, an AI-driven prior art search workflow reduced examination times by up to 50%, with 77% of applications requiring less examiner search time and 29% requiring little or no additional search. The office reduced its backlog by 80% without adding staff. These results required scientist-curated training data, multiple specialized algorithms, and ongoing human validation, not off-the-shelf tools.

“In a collaboration between CAS and Brazil's National Institute of Industrial Property, an AI-driven prior art search workflow reduced examination times by up to 50%.”

Prior art search is where AI is making its most measurable early impact. Traditional Boolean methods struggle with patent literature spanning more than 60 languages and containing chemical structures described inconsistently across publications. AI systems combining semantic analysis, syntactic pattern recognition, knowledge graphs, and structural similarity scoring surface relevant documents that conventional searches miss. Natural language processing further allows practitioners to query in plain language rather than constructing complex Boolean strings, lowering barriers for less specialized users, and accelerating examiner onboarding.



CAS Newton for CAS IP Finder illustrates what this looks like in practice. As an agentic AI built on STN's specialized databases, it allows IP professionals to pose queries in plain language and receive precisely executed searches, selecting the right databases automatically, handling chemistry-specific lookups, decoding complex patent number formats, and compiling cross-database patent family reports. Rather than replacing the expertise of the searcher, it removes the technical friction that slows them down, freeing practitioners to focus on interpretation and strategy rather than search construction.

The shifting role of IP professionals

For its 2026 IP Industry Outlook Research, Questel surveyed more than 500 IP professionals globally and found that 73% believe AI will permanently transform their roles, up from 64% the prior year. The shift is already underway: 88% of respondents now spend up to half their time reviewing work produced by trainees, AI agents, or external suppliers, representing a fundamental move from expert creation to expert review. Legal knowledge and strategic acumen remain the most valued skills. Still, expertise in IP search platforms and workflow coordination has become more important as practitioners configure, supervise, and validate AI-assisted processes.

Data quality and governance

The quality of training data is as important as the sophistication of the model. A CAS study found that human-curated content could increase AI prediction accuracy by 30%. For complex technical domains such as chemistry, where substance attributes are often embedded in images or tables that most systems cannot parse, domain-specific curation is essential.

Governance concerns are equally pressing. Data security, confidentiality, and the risk of AI hallucinations rank among practitioners' foremost worries, and rightly so. An undetected error in patent prosecution can invalidate a patent or expose a client to liability. The emerging consensus favors a human-expert-in-the-loop model, where AI handles high-volume processing, but practitioners retain supervisory authority at defined checkpoints. Robust internal policies governing tool authorization, output validation, and data confidentiality are now essential elements of responsible IP practice.

> **Rather than replacing the expertise of the searcher, it removes the technical friction that slows them down.**

Looking ahead

With 82% of IP professionals planning to increase AI use in 2026, adoption is accelerating across search, drafting, office action response, translation, and portfolio analytics. The professionals best positioned to benefit are those who neither dismiss AI as hype nor surrender judgment to its outputs, but who deploy it thoughtfully on quality data and within well-governed workflows. The intelligence of the system is inseparable from the intelligence of the practitioners who direct it.

Learn more, download our white paper.

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Why invest in patents, not start-ups?

Robert Klinski of Patentship argues that patents can give investors lower-risk exposure to high-growth technologies than start-up equity. He explains how well-timed patent portfolios, aligned with market demand and patentability requirements, can capture value as technologies such as 5G, IoT, blockchain, AI, and cybersecurity begin to scale.



Robert Klinski

> **Instead of investing in a 'hard asset' such as equity, can you use a 'soft asset' such as a derivative to leverage your position?**

Looking for exposure in your portfolio to high-growth technologies? The conventional answer is to pick a promising start-up and line up EUR 10 million in equity. It remains fraught with difficulty. Even the smartest investors only expect to make a significant gain on one investment in 10. Another two of their start-ups might break even. The rest will burn their capital.

The challenges in proving a technology are hard enough. You have to put in place the right operation and the right team. Then do it again when it comes time to scale. Can you save yourself the risk of losing all your capital, while still retaining the option for a gain on the upside? In other words, instead of investing in a 'hard asset' such as equity, can you use a 'soft asset' such as a derivative to leverage your position?

In the case of equity, options give you the right, but not the obligation, to buy or sell an underlying asset (or just the option itself) at or before a date in the future at a fixed financial risk (the premium). In the case of technology, patents can serve as a highly effective equivalent to options. Instead of investing in hard assets such as technologies or start-ups, why not invest in intellectual property as an analogy to options?

In fact, as an investor, you can gain up to 31 months by filing a patent application under the Patent Cooperation Treaty at a fixed capital risk and establishing a priority date to determine whether a patent is worth pursuing in the future. The capital at risk is roughly 1% of the commitment to a start-up.

For a number of investors, notably from China, patents are starting to represent a more efficient way of making a return on technologies. Instead of risking EUR 10 million on a start-up, they are using patents to catch a technology at the right point, not too early, not too late, but just at the sweet spot when it stops emerging and starts to grow.

The economics are compelling. If you build a quality patent portfolio with 10 patents for a technology in the five main countries worldwide, you are putting roughly EUR 1 million at risk, based on an average cost of



EUR 20.000 per patent in each country. So, you could build 10 such portfolios for the cost of investing in one start-up.

You might think everyone is following this logic. Far from it. All industries are in the midst of a digital transformation, deploying technologies such as artificial intelligence, the Internet of Things (IoT), and the new ultrafast mobile standard, 5G. In fact, engineers in research and development are mostly focused on incremental technology development rather than on strategic patent development. Moreover, the software implementations at the core of digital innovations are widely viewed as non-patentable.

Let me give you a real-life example. At a large mobile operator, the engineering team was struggling with creating valuable innovations around 5G, which is now being deployed across Europe. In addition, they saw little point in pursuing patent applications directed to network solutions implemented in software.

As it turned out, in the course of one-to-one conversations with the engineering team, a significant number of valuable inventions were identified that could be patented. Most of them related to 5G and the configurations of networks developed for real-time services such as IoT applications.

In the long term, any one of these patents has the potential for creating significant extra value for the operator. So how were such applications being overlooked not just by this operator but by many other companies in a similar position, not to mention potential investors?

Patents only ever have any value if they are written in the language of the technology and of the market. So, the potential for any upside depends on four states of mind: an understanding of technology, an insight into the market, a capacity to direct engineers towards the disruptive, and a grasp of patent strategy.

For this particular mobile operator, a change in mindset led to more than 80 harvested technical inventions resulting in more than 50 applications for patents in the field of 5G, of which a majority have already been granted.

The technology sweet spot

All technologies follow a lifecycle as they emerge, grow, and mature. At the start, everything is new. There is no history. Comparisons are hard to draw. Platform IP can be secured at relatively little cost, even though it is hard to know which technology trend to follow and the risk-to-reward ratio is speculatively high.

> **“The sweet spot is at the point when an emerging technology establishes itself, rewarding those who can articulate what the market demands.”**

At the growth stage, innovation becomes more incremental, driven more by R&D and less by inventors. Many more patents are filed, the scope for protection narrows, IP costs rise, and the risk-to-reward ratios drop. Once a technology matures, innovation plateaus, IP becomes expensive to maintain, and the risk-to-reward ratio reaches its low point.

If you make your move too early, you can be technically brilliant but with no foundation in the market. If you’re too late, you will join a saturated market with low returns. The sweet spot is at the point when an emerging technology establishes itself, rewarding those who can articulate what the market demands.

These technologies are typically disruptive in their effects, as first identified by the Harvard professor Clayton Christiansen in his 1997 book, *The Innovator’s Dilemma: When New Technologies Cause Great Firms to Fail*. He argued that disruptive technologies often begin in low-value segments of the market and involve high degrees of technical difficulty. So, it opens up the way for disrupters to steal a march and open up the potential for innovation.

Blockchain is proving just such a technology, with mainstream companies now doing what they can to keep up. Its origins lie in the search for a secure digital currency, and the solution, which links a chain of digital signatures across blocks of data, bypasses any directly comparable technologies. As an innovation, it managed to articulate what the market required and frame the technical challenge in a way around which developers could invent.

For those who can join up the pieces of such disruptive ideas, it opens up the prospect of a highly productive three-step strategy: clearly articulate the challenge for your market, set a technical problem, and then let your engineers or developers create a series of innovations that you can patent.

Engineering mindsets

Engineering teams develop technical solutions incrementally by nature. They work on the basis of identifying improvements to existing technologies. They are typically responding to requests from their managers for more speed, less weight, more stability, or better security. It is the basis for how ever higher levels of performance are reached in technologies such as the combustion engine and the microprocessor, even though they both passed the emerging stage many years ago.

Or put it another way. Engineers excel in making tangible improvements and creating new features. However, they are less trained

in making the intangible, based on what the market is seeking as opposed to what existing technologies can offer.

Patent offices work in the same way. They look for the difference between your invention and the prior art. They then judge whether it justifies a patent. Like engineers, they are not taking their cue from the market. They want a defined technical platform from which to start.

Although 5G is not as disruptive as blockchain, the same thinking applies in realizing its value. From the point of view of an engineer or a patent office, you could argue that you have little scope for innovation, as the existing 4G technology infrastructure (LTE) is widely being used for 5G networks as well. The difference in the communication technology per se is thus hard to identify.

The transmission technologies and the communication protocols might even be the same, but the fundamental difference lies in how you design a 5G network. By using network slices, which essentially are service-oriented sub-networks, you can scale it up and down depending on what kind of service you are trying to deliver, whether it is making a phone call, screening augmented reality to a crowd of fans, or sending signals to a driverless car. The speed and quality of the connection that is required will vary: you can have some leeway on a phone call; you can have none in a driverless car.

The value lies in how you design each of these slices of the network for different applications. You take your cue from what the market expects in specializing 5G configurations for use in smart cities or for IoT, then you set yourself a technical challenge. The solutions you develop will be a rich source for harvesting innovations that can be patented.

Patentability

These 'network slices' are becoming one of the most highly sought and potentially lucrative sources of patents. Like the mobile operator, you may be dissuaded from applying for them by lack of prior art, and you may worry that no patents will be granted on any software. However, you can chart a course that satisfies the disruptive demands of the market and meets the tests for patentability.

Essentially, you have to run two lines of inquiry: check out how the market is defining your purpose and keep exploring potential inventions. Your two searches will come together at the point when you can define a technical challenge for your engineers to solve. By harvesting innovation in this way, you are speaking both the language of disruption and IP.

> **Essentially, you have to run two lines of inquiry: check out how the market is defining your purpose and keep exploring potential inventions.**

Your solution will directly correspond to an application within the market. It will also avoid the trap into which disruptive technologies can fall and meet the tests for patentability by clearly defining the technical challenge.

Like engineers, patent examiners at the EPO rely on a problem-solution approach in identifying an inventive step: what is the prior art? What is the objective technical problem? Could a person skilled in the art arrive at the inventive solution of the technical problem when starting from the prior art? Does the invention relate to a computer program that per se is not patentable? By framing your network slice as providing a solution to a technical problem, it cannot be excluded just because it is implemented by software. The same thinking applies to AI, big data, or cybersecurity.

So those who invest in capturing the innovative new services that flow from 5G and provide solutions to technical problems that comply with the EPO's tests for patentability will be putting themselves at a significant advantage over those who rely on conventional engineering for more speed, less weight, and more security for their returns.

RÉSUMÉ

Robert Klinski is a pioneer of invention on demand. He began in the field of signal processing at the Fraunhofer Institute ESK in Munich. Now a German and European patent, trademark, and design attorney, he is the founder of Patentship, where he and his team have created and patented over 150 inventions in edge technologies, such as AI, IoT, 5G, blockchain, and cryptography. Patentship is currently expanding in Asia, focusing on clients and investors looking at patents to improve their rates of return.

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The relationship between Japan's GX policy and GXTI-based patent applications

Yoshiteru Mizumoto of Asamura IP explores how Japan can translate its clean-energy patent leadership into global market competitiveness amid growing international competition.



Yoshiteru Mizumoto

> Japan continues to hold the world's leading position in international patent families (IPFs), which include applications filed in multiple countries and regions.

Japan's Green Transformation (GX) policy is designed not only as an environmental policy for reducing greenhouse gas emissions but also as an industrial policy that leverages Japan's accumulated GX-related technologies to strengthen industrial competitiveness, stimulate capital investment, accelerate commercialization, and promote international expansion. Patent analysis based on the Green Transformation Technologies Inventory (GXTI) reveals the following structure:

- Japan has been overtaken by China in the total volume of GX patents, including both domestic and overseas filings.
- By contrast, Japan continues to hold the world's leading position in international patent families (IPFs[1]), which include applications filed in multiple countries and regions.
- In particular, Japan's patent competitiveness closely aligns with GX policy priorities in such fields as secondary batteries, building energy efficiency, fuel cells, and electric mobility.
- Hydrogen, offshore wind power, CCS, and the decarbonization of materials and manufacturing processes are important policy areas; however, Europe, the United States, and others have established strong technological capabilities in many of these fields. Japan therefore needs not only to commercialize technologies for which it already holds patents but also to strengthen its technological capabilities and create markets.
- Japan's challenge therefore lies less in the number of patents itself but in its ability to connect its technologies into mass production, standardization, supply chains, and market capture.

Accordingly, the relationship between Japan's GX policy and patent applications can be summarized as follows:

Japan's GX policy has a two-tier structure: accelerating social implementation, mass production, and market capture in areas where Japan has patent strengths, while strengthening technological capabilities through R&D, investment, international collaboration, and market creation in strategically important fields where patent competitiveness remains insufficient.

Patent applications are a leading indicator of R&D activity and do not directly reflect product sales, manufacturing capacity, or emission reductions. Since the latest survey covers 2014–2022, continued monitoring will be needed to assess the impact of GX policies implemented in earnest from 2023 onward using patent data.

Framework of Japan's GX policy

GX is an initiative to transform fossil-fuel-centered economic, social, and industrial structures into ones centered on clean energy, while simultaneously achieving the following three objectives:

1. Stable energy supply
2. Economic growth and stronger industrial competitiveness
3. Reduced greenhouse gas emissions.



The GX Promotion Act and the GX Promotion Strategy were established in 2023, and the GX 2040 Vision was approved by the Cabinet in February 2025 as a medium- to long-term national strategy. To mobilize more than JPY 150 trillion in public- and private-sector GX investment over the next 10 years, the government is implementing the following measures:

- Upfront investment support of approximately JPY 20 trillion through GX Economy Transition Bonds
- An emissions trading system
- A fossil fuel surcharge
- Transition finance
- Creation of GX markets through regulation, standardization, public procurement, and other measures
- Support for R&D, capital investment, mass production, and supply-chain development.

In other words, the central policy objective is not merely to support R&D and increase the number of patents but to implement patented technologies in society as products, equipment, and services and develop them into profitable industries.[2]

What is GXTI?

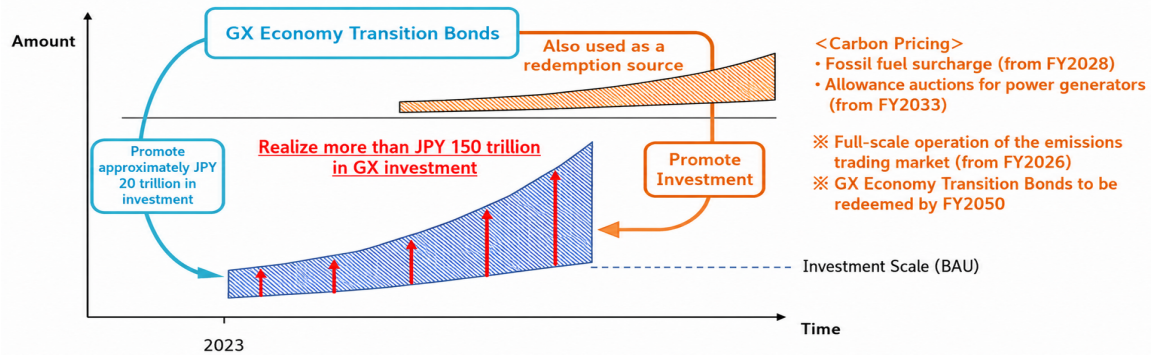
The GXTI (Green Transformation Technologies Inventory) is a technology classification table developed by the Japan Patent Office (JPO) in June 2022 to analyze GX-related technologies using patent information.

GXTI is broadly organized into the following five fields:

Category	Examples of covered technologies
gxA: Energy supply	Solar, wind, geothermal, hydropower, nuclear power, fuel cells, hydrogen, and ammonia
gxB: Energy conservation, electrification, and supply-demand adjustment	ZEBs and ZEHs, high-efficiency motors, electric mobility, electrification of heat, and smart grids
gxC: Batteries and energy storage	Secondary batteries, mechanical and thermal energy storage, and capacitors
gxD: CO_2 reduction in non-energy fields	Biomass chemicals, steelmaking processes, and recycling
gxE: Greenhouse-gas capture, storage, utilization, and removal	CCS and CCUS, negative emissions, and measures addressing non-CO_2 gases

It also covers cross-cutting categories such as control and adjustment, metrology and measurement, business technologies (e.g., authentication and settlement), and ICT-related technologies.

Since search queries based on IPC and other classifications are available for each subcategory, companies, governments, and investors can compare technological capabilities across countries and firms on a consistent basis.[3]



Japan's position as revealed by the latest GXTI patent analysis

The JPO's FY2024 survey analyzes patents with priority years from 2014 through 2022.

GX patents overall

Indicator	Global total	Japan	Japan's position
Patent families	Approx. 1 million	159,061 (15.8%)	Third after China and South Korea
International patent families (IPFs)	269,564	72,311 (26.8%)	1st worldwide

By ordinary patent-family count, Chinese applicants account for 533,524 families, or 53.2% of the total. By contrast, Japan ranks first in international patent families with 72,311, followed by Europe with 67,246, the United States with 47,383, and China with 38,650.

- China is strong in high-volume filing centered on its domestic market.
- Japan has a relatively large number of commercially important inventions for which protection is sought in multiple countries.
- Japan's GX technologies therefore form a patent portfolio oriented toward international markets to a greater extent than raw filing counts alone would suggest.

However, Japan's international patent-family count increased through 2018 and has since trended downward, while China and South Korea are trending upward. While Japan continues to hold a leading position, its technological advantage cannot be taken for granted.[4]

Relationship with policy by technology field

Secondary and storage batteries

Among GXTI intermediate categories, secondary batteries have the largest numbers of both patent families and international patent families.

- Japan: 22,366
- China: 13,492
- South Korea: 14,280
- Europe: 11,216
- United States: 10,325.

Japan has a clear strength in this field, consistent with government support for storage batteries across the value chain, from manufacturing and materials to automotive batteries, stationary storage, and recycling. However, China far exceeds Japan in ordinary patent-family count. Japan's challenge is to convert its technological advantage into mass-production capacity, secure supply chains, cost competitiveness, and global market share.

Building energy efficiency

For ZEBs, ZEHs, and related technologies, Japan ranks first with 19,944 international patent families and holds 42,790 ordinary patent families, making this—along with secondary batteries—a key area of strength. Policy support for insulation, high-efficiency equipment, energy management, and building renovations helps connect this patent base with domestic demand and commercialization.

Fuel cells and hydrogen

Japan ranks first in fuel-cell international patent families with 5,475. For hydrogen technologies as a whole, however, Europe has 4,004, compared with Japan's 2,237.

Thus, although Japan is strong in the specific field of fuel cells, Europe appears to have greater technological strength across the hydrogen supply chain as a whole, including hydrogen production, transportation, storage, and use.

Policy measures to bridge the hydrogen price gap, develop hydrogen supply hubs, and establish supply chains, including those for ammonia, are intended to complement Japan's weaker areas while leveraging its existing strengths in fuel cell technologies.

Electric mobility

Japan ranks first with 10,633 international patent families, slightly ahead of Europe's 10,236, reflecting the technological strengths accumulated in its automotive and electrical industries, including batteries, motors, inverters, and control systems. However, patent leadership does not directly translate into EV market share, as competitiveness also depends on factors such as software, charging infrastructure, vehicle costs, production speed, and battery supply chains.

Solar power and next-generation renewable energy

Analyses covering the period through the first half of the 2010s identified solar power as one of Japan's representative strengths. For 2014–2022 international patent families, however, the figures are:

- Europe: 4,214
- Japan: 4,177
- United States: 3,764
- China: 3,537.

Japan has lost its leading position in solar technologies, while China dominates ordinary patent-family counts. The government's focus on next-generation technologies such

as perovskite solar cells reflects an effort to rebuild competitiveness in advanced materials and technologies, where Japan can differentiate itself from China's strength in conventional crystalline-silicon solar manufacturing.

In wind power, Europe holds a dominant position with 6,517 international patent families compared with Japan's 754. For floating offshore wind, Japan must therefore strengthen not only R&D but also domestic supply chains, demonstration projects, and mass-production capabilities.

CCS and CCUS

For international patent families in CCS, CCUS, and negative-emission technologies, the ranking is:

- United States: 2,132
- Europe: 1,877
- Japan: 1,289.

Although Japan has a technological foundation in CCS, it does not yet surpass those of the United States or Europe. CCS policy has entered a stage requiring both technological development and commercialization through comprehensive frameworks covering CO_2 capture, transportation, storage, monitoring, and liability management.

Steelmaking, chemicals, and resource circulation

Under the GX policy, hard-to-abate industries such as steel, chemicals, cement, and pulp and paper are priority fields. In GXTI international patent families, however, Europe exceeds Japan in CO_2 reduction in steelmaking processes and in recycling.

This shows that Japan's policy is not limited to investing in technologies in which it is already strong; it also strategically reinforces fields that account for substantial domestic industrial emissions and are essential to future competitiveness.

Correspondence between policy and patent applications

GX policy priority	Japan's position identified by GXTI	Policy significance
Storage batteries	Ranks first in international patent families	Connect strong technologies to mass production and market capture
Energy efficiency in homes and buildings	Ranks first in international patent families	Create domestic demand and implement technologies in society
Automobiles and electrification	Among the leaders in international patent families	Extend strengths in batteries, motors, etc. into competition in vehicles and services
Fuel cells	Japan ranks first	Leverage the existing advantage in hydrogen-use technologies
Hydrogen and ammonia	Europe and others are relatively strong	Reinforce weaker areas including production, transportation, and storage
Next-generation solar cells	China has a quantitative advantage in conventional technologies	Shift the competitive axis to perovskite and other technologies
Offshore wind power	Europe is overwhelmingly strong	Develop domestic supply chains and demonstration and mass-production capabilities
CCS and CCUS	The United States and Europe lead	Catch up through institutions, infrastructure, and business models
Steel, chemicals, and resource circulation	Europe and others are strong in certain fields	Prioritize support to maintain the competitiveness of Japan's core industries
GX × metrology and ICT	Japan is strong in international patent families	Apply strengths to emissions tracking, control, authentication, and energy management

Challenges for Japan's GX policy from the perspective of patent analysis

Shift toward "winning in technology and in business"

Although Japan is strong in international patent families, solar cells and other fields provide examples in which it fell behind in mass-production costs, capital investment, and market creation despite possessing patents and technologies.

Accordingly, from the patent-acquisition stage onward, Japan must integrate:

- development into standard-essential patents;
- incorporation into international

standards;
- combination with manufacturing know-how and trade secrets;
- mass-production bases in Japan and overseas;
- secure supply chains;
- licensing and joint ventures; and
- enforcement of rights in overseas markets.

These elements need to be managed as an integrated whole.

Responding to China's quantitative expansion

China ranks first in ordinary patent-family count in every major GXTI category. While Japan currently has an advantage in international patent families, this advantage may narrow if Chinese companies increase their international filings.

Rather than competing on filing volume, Japanese companies need to develop strong claims that cover key markets, foundational patents that attract citations, and patent portfolios linked to standardization.

Concentrating policy support on areas of strength

Japan's patent strengths are concentrated in secondary batteries, building energy efficiency, fuel cells, electric mobility, high-efficiency equipment, metrology, ICT, and related fields.

For these fields, it is reasonable to shift the emphasis toward manufacturing facilities, supply chains, demand creation, and overseas expansion rather than distributing R&D support broadly and thinly.

By contrast, offshore wind power, CCS, hydrogen production, materials processes, and similar fields will also require collaboration with overseas companies and research institutions, technology introduction, and joint development.

Footnotes

1. IPF stands for International Patent Family: a patent-application family that includes filings in two or more countries or regions, or that includes an application filed with the European Patent Office or a PCT application.
2. Ministry of Economy, Trade and Industry, "GX"; Cabinet Decision on the GX 2040 Vision
3. Japan Patent Office, "GXTI"
4. Japan Patent Office, FY2024 Survey of Patent Filing Trends—GXTI Edition



RÉSUMÉ

Yoshiteru Mizumoto is a qualified patent attorney and Director of the Mechanical and Electrical Department, with more than 20 years' experience in the profession. His practice involves domestic and overseas patent prosecution, Office actions, appeals and litigation. In addition to patent prosecution, Yoshiteru advises on appraisals to determine whether products infringe patents and occasionally teams up with lawyers from Asamura Law Offices to handle invalidation trials.

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Building a strong and enforceable patent portfolio in Brazil: beyond composition of matter

Eduardo Hallak and Rafaella Oliveira of Licks Attorneys explain how pharmaceutical companies can build stronger and more enforceable patent portfolios in Brazil by going beyond composition-of-matter patents and strategically protecting incremental innovations.



Eduardo Hallak



Rafaella Oliveira

> **While composition-of-matter patents remain the cornerstone of exclusivity, a strong portfolio in Brazil must rely on a diverse set of incremental patents.**

Brazil is a jurisdiction in which incremental pharmaceutical innovation can be meaningfully protected if applicants understand the stringent standards applied by the BRPTO and prepare strategically from the drafting stage. While composition-of-matter patents remain the cornerstone of exclusivity, a strong portfolio in Brazil must rely on a diverse set of incremental patents, each with its own requirements, challenges, and enforcement pathways.

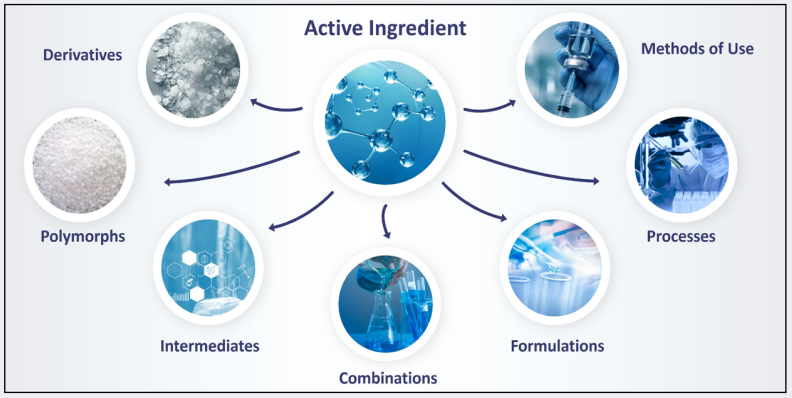


Figure 1. Overview of the principal forms of innovation that may be protected around an active ingredient.

Understanding the differences between the patentability standards is essential for developing a layered and strong patent portfolio capable of maximizing protection throughout the product incremental lifecycle. The sections below discuss some of the most relevant and challenging forms of innovation under Brazilian patent practice, highlighting their key patentability requirements, prosecution hurdles, and drafting considerations.

New use of known compounds

The current acceptable format for claiming medical uses in Brazil is the "Swiss-type" format (*"Use of a compound X, characterized by being for the manufacture of a medicament for the treatment of disease Y"*). This format must be applied regardless of whether it is the first, second, or subsequent use.

Notwithstanding this structural homogeneity, second and further medical uses are subject to a markedly more stringent substantive examination. In practice, the BRPTO applies heightened scrutiny to these

inventions, particularly with respect to novelty and enablement. This examination framework was, until June 2026, primarily governed by Chapter 9 of the Examination Guidelines for Patent Applications in the Chemical Field (BRPTO's Rule No. 208/2017), and is now governed by BRPTO's Ordinance No. 80/2026, which revoked that Chapter.

Important to highlight that for a second medical use to be considered novel by the BRPTO, it must relate to the treatment of a disease different from the one for which the compound is already known in the prior art. The BRPTO deems characteristics such as dosage regimen and/or patient groups to pertain to therapeutic methods rather than to the use of the compound in the manufacture of a medicament. As a result, Examiners disregard such features when assessing novelty.

Notwithstanding the above, for a second medical use to be considered by the BRPTO duly enabled and, consequently, for the claims to be considered supported by the specification, the application, as originally filed, must present enough evidence of the claimed use to ensure that the asserted technical effect is not merely speculative. In this context, BRPTO's Ordinance No. 80/2026 foresees the possibility of accepting post-filing data, provided that the application as originally filed contains sufficient information to render the claimed use credible. For new medical uses, *in vitro*, *ex vivo*, or *in silico* data can serve as a basis for claiming therapeutic activity, though the BRPTO considers *in vivo* data preferable for validating such an effect. In any case, if the application includes only instructions, research plans, descriptions of incomplete studies, or trials, the medical use will not be considered enabled.

Drafting tip: Ensure that the specification as originally filed includes sufficient experimental basis to avoid being deemed speculative, thereby allowing post-filing data as a supplemental measure.

"In any case, if the application includes only instructions, research plans, descriptions of incomplete studies, or trials, the medical use will not be considered enabled."

Polymorphs

Although patentable in Brazil, the BRPTO has specific Guidelines that establish rigorous criteria for compliance with patentability requirements. The result is that around 40% of patent applications directed to a crystalline form are rejected in Brazil on the grounds of: (i) lack of novelty (64%); (ii) obviousness (30%); and (iii) lack of enablement, clarity and precision (6%).[1]

For the purpose of assessing the novelty of crystalline forms, the BRPTO requires the physicochemical characterization data of the solid compound described in the prior art, which can be submitted either at the time of filing or during substantive examination. The absence of such data to enable a direct comparison with the claimed crystalline form commonly leads to the rejection of applications on the grounds of lack of novelty.

In addition, to be deemed inventive, the applicant must be able to demonstrate, by means of comparative data, which may be submitted during examination, that the claimed crystal form presents a non-obvious property or a technical advancement over the solid form known from the prior art, as the BRPTO understands that the identification of crystalline forms of a compound constitutes a routine task in the industry for the improvement of physicochemical properties.

Last but not least, for a proper enablement of a crystalline form, the specification as originally filed must contain identification data obtained through physicochemical characterization techniques for solids. In this context, single-crystal XRD is the only isolated technique deemed sufficient by the BRPTO for the proper characterization of the crystalline structure of a solid. In the absence of this data, XRPD must be combined with other techniques to ensure unequivocal identification. Additionally, although examination practice is not entirely consistent on this point, it is common for the BRPTO to require that such data be incorporated into the independent claims to achieve a clear and precise definition of the claimed crystalline form.

In addition to physicochemical characterization data, the specification as originally filed must disclose sufficient process parameters to obtain the claimed crystalline form, enabling a person skilled in the art to reliably reproduce the claimed subject matter.

Drafting tip: Include multiple characterization techniques and detailed crystallization parameters to ensure enablement and reproducibility.

Stereoisomers

It is possible to protect a stereoisomer of a known compound in Brazil if it was not specifically disclosed in the prior art. Once the compound has already been disclosed in the prior art as a stereoisomeric mixture, such as a racemic mixture, the pure enantiomeric or atropisomeric compounds themselves are not considered new, since the stereoisomeric mixture already contains both stereoisomers. In case of diastereoisomers, novelty will be established when the prior art does not specifically describe the claimed diastereoisomer. In some cases, the assessment of novelty of the claimed

diastereoisomer only becomes possible through the submission of characterization data of the known compound, either at filing or during examination, so that a comparison can be made between the claimed diastereoisomer and the prior art.

Apart from the above, for the BRPTO, the clear and sufficient description of the stereoisomer in pure form lies in the characterization of the absolute configuration of its chiral center at the time of filing of the patent application. Additionally, the parameters of the process for obtaining the stereoisomer, either by asymmetric synthesis or by a purification process subsequent to the synthesis of the compound, should be described in the specification as originally filed to ensure reproducibility by a person skilled in the art.

Moreover, it is also necessary to demonstrate the unexpected technical effect of the claimed stereoisomer over the prior art compound, since the BRPTO understands that, when the prior art compound purpose is known, there is an expectation that the pure stereoisomer of this compound presents this same property. Thus, it is considered that a person skilled in the art would be motivated to obtain this stereoisomer to identify the most appropriate form for industrial use, for example, the more active stereoisomeric form.

Drafting tip: Provide the characterization of the absolute configuration of the chiral center along with the parameters of the process of obtaining the stereoisomer to ensure enablement and reproducibility.

Combinations

Combination claims are allowable once the interaction between the associated compounds produces an unexpected effect, such as, for instance, a synergistic or supra-additive effect, which does not correspond to an additive effect, that is, the mere sum of individual effects of each compound of said combination. Proof of the unexpected effect of a combination frequently involves presenting data that enable comparison between the effects observed for the respective compounds when used separately and those obtained from the combination under the same experimental conditions. Post-filing data may be submitted for this purpose, provided that the technical effect of the invention was described in the specification as originally filed, even if not in a quantitative manner.

Drafting tip: Provide support for synergistic effect to be proved during examination.

> “For instance, in the case of analogous processes, the steps are generally well known to a person skilled in the art, and a simple generic mention of the method is sufficient.”

Processes

Properly drafted process claims define the starting material, the product obtained, and the means of transforming the former into the latter, as well as the various steps necessary to achieve the proposed objective.

The parameters involved in the process do not necessarily need to be specified in detail. For instance, in the case of analogous processes, the steps are generally well known to a person skilled in the art, and a simple generic mention of the method is sufficient.

Drafting tip: Although Brazilian law provides for a reversal of the burden of proof in cases involving process patents, the inclusion of clear and identifiable process markers can significantly strengthen the evidentiary basis for infringement analyses and facilitate the demonstration that a third party is practicing the claimed process.

Combining practice and patent drafting to ensure strong and enforceable patents

Building a robust portfolio in Brazil requires not only technical compliance with BRPTO’s Guidelines but also foresight into enforcement scenarios. Drafting must anticipate both examination hurdles and litigation realities, ensuring that patents are not only granted, but also enforceable and strong enough to remain valid after facing challenges by third parties.

In this context, it is important to anticipate BRPTO’s objections in drafting, for example, by including multiple characterization techniques for polymorphs and stereoisomers, ensuring credible disclosure at filing for new medical uses, and providing comparative data up front or ensuring that the specification allows supplementation during examination.

Moreover, patent applications may be drafted with enforcement considerations in mind. For example, claims may be tailored to encompass the technologies of greatest commercial value, while the specification may incorporate identifiable process markers to support future infringement analyses. Likewise, claims may be drafted broadly enough to capture inevitable off-label use, thereby mitigating the impact of skinny-labeling strategies adopted by generic manufacturers.

Once granted, patents in Brazil tend to enjoy a relatively high degree of legal stability. The likelihood of invalidation, whether through an administrative nullity proceeding (PGO), which may be filed before the BRPTO within six months from the granting date, or through a judicial nullity action filed before the Federal Courts, which

may be brought at any time during the patent term, remains comparatively low. This is reflected in Brazil's modest patent invalidation rate. Notably, shown in Figure 2, among the PGO decisions issued over the last 12 months, only 26.06% resulted in the patent being completely revoked.

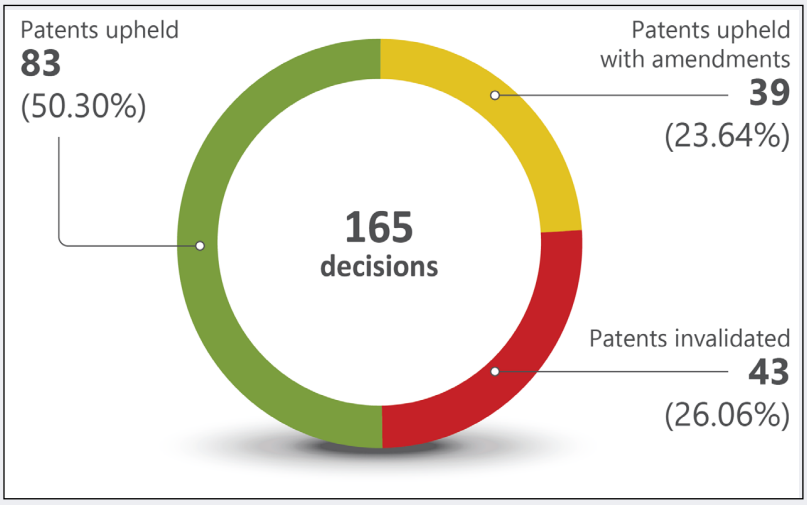


Figure 2. Outcomes of PGO proceedings decided in the last 12 months (up to August 5, 2026).

Conclusion

While composition-of-matter patents remain the cornerstone of exclusivity in the life sciences sector, a robust patent strategy in Brazil should not rely on a single layer of protection. By combining different categories of incremental patents, such as new medical uses, polymorphs, stereoisomers, combinations, manufacturing processes, and formulations, applicants can build a diversified and resilient portfolio capable of extending and reinforcing market exclusivity well beyond the expiry of the original compound patent.

Success, however, depends not only on identifying protectable innovations, but also on anticipating the strict standards applied by the BRPTO and the practical challenges of enforcement. Careful drafting supported by robust technical data, a thorough understanding of Brazilian examination practice, and claims strategically tailored to facilitate future infringement analyses can substantially enhance both patentability and enforceability. When these elements are considered from the outset, incremental patents become far more than defensive filings: they become valuable commercial assets capable of supporting long-term market protection, strengthening competitive positioning, and maximizing the return on innovation in the number one pharmaceutical market in Latin America.

Footnotes
1. Considering the decisions published between Jan/2024 and May/2026.

RÉSUMÉS

Eduardo Hallak is a founding partner at Licks Attorneys and heads the firm's São Paulo office. With more than 20 years of experience, he represents clients in complex litigation involving intellectual property, regulatory, patent, and competition matters, particularly in the life sciences and agribusiness sectors. He advises multinational companies on regulatory compliance, technology transfer, data exclusivity, and IP enforcement. Hallak is also a professor at PUC-Rio and a recognized speaker, consistently ranked by Chambers, The Legal 500, and Lexology Index.

Rafaella Oliveira is a chemist and patent specialist at Licks Attorneys' Rio de Janeiro office. With experience in intellectual property since 2009, she focuses on patent prosecution before the Brazilian Patent and Trademark Office (BRPTO), particularly in the chemical field. Her expertise includes drafting and prosecuting patent applications, prior art and freedom-to-operate searches, patent landscaping, third-party observations, and technical opinions. She is highly knowledgeable in Brazilian IP law, BRPTO examination guidelines, and major international intellectual property treaties.

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Technical effect without the architecture: India's 2025 CRI Guidelines and the AI question

Shrawan Chopra and Achyut Tewari of Anand and Anand examine India's 2025 CRI Guidelines, which consolidate the law on patent eligibility for computer-related and AI inventions. They caution, however, that the Guidelines do not align Indian practice with the UK or European approaches, and that their true impact will depend on how examiners apply them and how the courts respond to the first appeals under the new framework.



Shrawan Chopra



Achyut Tewari

> **For AI filings, this is now the main prosecution risk in India, and it is made worse by a tension built into the subject matter.**

Within seven months, two common-law patent systems approached the same problem from opposite ends. On July 29, 2025, the Office of the Controller General of Patents, Designs and Trade Marks issued revised *Guidelines for Examination of Computer Related Inventions*, replacing the 2017 guidance and settling on "*technical effect*" as the test by which a computer implemented invention escapes Section 3(k) of the Patents Act, 1970.[1] Then, on February 11, 2026, the UK Supreme Court in *Emotional Perception AI Ltd v. Comptroller General of Patents* discarded the four step test in *Aerotel*, which had governed UK practice since 2006, and brought the UK into line with the European Patent Office. Under *Aerotel*, the examiner construed the claim, identified the actual contribution, asked whether that contribution fell solely within excluded subject matter, and checked whether it was technical in nature. The inquiry thus turned on what the inventor had really added to human knowledge, assessed at the eligibility stage itself.[2]

Read together, these developments suggest convergence, and an applicant filing artificial intelligence (AI) applications in all three jurisdictions might reasonably assume that the same analysis applies in each jurisdiction. It does not. The three systems use similar language but arrange the inquiry differently, and in AI applications, that difference determines the stage at which the application is won or lost.

The Guidelines and what they settle

The Guidelines are administrative instruments, not delegated legislation, and the Office has recorded that if they conflict with the Act or the Patents Rules, 2003, the statute prevails.[3] Their value lies in consolidation rather than innovation. Section 3(k) excludes "*a mathematical or business method or a computer programme per se or algorithms*", and it is worth noting that the qualifier "*per se*" attaches only to computer programs; a drafting choice whose consequences applicants from other jurisdictions routinely underestimate.

The key to that qualifier came in December 2019. In *Ferid Allani v. Union of India*, the Delhi High Court held that the bar applies to computer programs per se and not to every

invention built on one, that the words "*per se*" were inserted so that genuine software based inventions would not be refused, and that what matters is the effect the program produces.[4] The Court further held that in a digital world it would be retrograde to treat innovations in AI and blockchain as categorically unpatentable;[5] an observation made before machine learning applications reached the Office in any volume, and the foundation on which the Guidelines have since been built.

What followed is a decade of application. *Microsoft Technology Licensing* confirmed that an invention run on a general-purpose computer cannot be refused as a computer program per se where it produces a technical effect that improves how the system functions.[6]

The two *Blackberry* appeals, decided on the same day and by the same court, show how fact sensitive the inquiry has become: one failed as a bare sequence of instructions, while the other succeeded because device functionality was made materially more efficient within the same storage envelope.[7] On the other side of the line, *Kroll Information Assurance* failed because a keyword search across a peer to peer network showed no technical advancement and no effect on the hardware,[8] while *OpenTV Inc* was refused because an invention aimed at a commercial objective does not become patentable merely by being implemented through a network architecture.[9]

The Guidelines set this out in a stepwise method: the invention must be read as a whole; the examiner must ask whether it delivers a concrete technical solution or merely a conceptual or commercial one; and only then may a ruling on exclusion follow.

Two points emerge. First, new hardware is not a precondition of patentability. Second, the business method exclusion carries no "per se" qualifier of its own, so it applies absolutely: if the substance of a claim is a method of doing business, no amount of technical implementation will save it.

> **On the same specification, the Delhi High Court found a concrete technical effect where the EPO had found none.**

The architecture which the vocabulary conceals

This is where the comparison with Europe becomes misleading. After *G 1/19*, and now after *Emotional Perception*, the EPO and the UK work in two stages.[10] The first stage, eligibility, is deliberately easy to clear, since a claim involving any technical means passes Article 52 EPC. The real filtering happens at the second stage, within the *COMVIK* approach to inventive step, where features that do not contribute to the technical character are set aside before obviousness is assessed. Eligibility is close to a formality, and the contest is fought over the prior art.

India has taken the European vocabulary without the European structure. Section 3(k) is not an easy threshold that postpones the real question; it is a substantive bar, applied by the Controller before novelty and inventive step are reached, and capable, on its own, of ending an application. In India, technical effect is an admission ticket, not a weighting exercise.

That this difference is real, and not merely one of expression, was shown in *Blackberry* itself, where the Court recorded that the corresponding European application had been refused and declined to accept the EPO's reasoning that the invention did no more than select files by popularity rating.[11] On the same specification, the Delhi High Court found a concrete technical effect where the EPO had found none.

Two consequences follow, and neither is obvious to a practitioner trained on European practice. The first is that the prior art cannot be used to establish technical character. Under *COMVIK* the contribution is identified by comparing the invention with the closest prior art, but in India the Controller may refuse under Section 3(k) without making that comparison at all. The second consequence is even stricter: the technical effect must be visible in the specification as filed. Section 59 allows amendment only by way of disclaimer, correction or explanation, so an applicant who realizes during prosecution that the technical effect was never stated cannot add it later in the specification. In Europe, that applicant still has inventive step as a second chance; in India, there is none because there is no second stage.

Three routes to the same question

Parameter	India	EPO / United Kingdom	United States
Eligibility provision	Section 3(k), Patents Act, 1970	Article 52 EPC; s.1(2), Patents Act 1977	35 U.S.C. 101 (Alice/Mayo)
Nature of the threshold	Substantive bar; may terminate the application on its own	Deliberately low; any technical means suffices	Threshold inquiry, but applied substantively
Where non-technical features are filtered	Nowhere else; Section 3(k) is itself the filter	Intermediate step, thereafter COMVIK within inventive step	Step 2A Prong Two and Step 2B
Role of prior art in showing technical character	None; refusal may precede any comparison	Central; contribution measured against closest prior art	Limited at Step 2A; engaged at Step 2B
Business methods	Excluded; no "per se" qualifier	Excluded "as such"; technical implementation may rescue	Abstract idea; may survive if practically applied
Autonomous AI as named inventor	Not permitted; s.2(1)(y) read with s.6	Not permitted; J 8/20	Not permitted; Thaler v Vidal
Test for human contribution to an AI-assisted invention	No published framework	No AI-specific framework; ordinary rules apply	Conception (Pannu approach rescinded, Nov. 2025)
Principal prosecution risk for AI filings	Sufficiency under s.10(4), read with s.3(k)	Inventive step	Subject-matter eligibility

Disclosure as the real battleground

This is what makes the least-discussed feature of the Guidelines important: the higher disclosure expectations placed on AI and machine learning applications. Examiners are now directed to look for the network architecture, the training data, and the parameters used, rather than a general statement that a model is trained and then applied.

The statutory basis is Section 10(4)(a), and the Madras High Court gave a sharp illustration six months before the Guidelines were issued. In *Caleb Suresh Motupalli v. Controller of Patents*, an application concerning the non-invasive integration of a human user with AI was refused for insufficiency.[12] Applying *No-Fume Ltd v. Frank Pitchford & Co Ltd*,[13] the Court held that while a specification need not set out every detail precisely, it cannot require the skilled person to carry out undue experimentation or to exercise an inventive faculty they do not have. The specification there referred to standard techniques of integration but gave no teaching and no working example showing how this was to be done. An application that assembles published literature around a promising objective is not enabled merely because the objective is well described.

For AI filings, this is now the main prosecution risk in India, and it is made worse by a tension built into the subject matter: the valuable detail of a trained model, namely the architecture, the hyperparameters, and the curation of the training set, is exactly what an applicant would prefer to keep as a trade secret. Indian practice leaves progressively less room for that reticence, and an applicant who files thin, hoping to argue technical effect later, is exposed twice over, under Section 3(k) and again under Section 10(4).

Inventorship: the settled half and the unsettled half

On inventorship, the Guidelines read as though the matter is closed. An invention generated autonomously by an AI system is not patentable, because such a system cannot be the true and first inventor under Section 2(1)(y) read with Section 6, while inventions merely assisted by such tools are assessed on ordinary criteria. That places India in unremarkable company: the Federal Circuit, the UK Supreme Court, the Legal Board of Appeal of the EPO, and the Full Federal Court of Australia have each reached the same conclusion - as has the Indian Patent Office, which in April 2026 refused Dr. Thaler's own DABUS application on precisely this ground.[14]

The reasoning provided was that that because an AI system cannot own property or execute an assignment, it cannot be the true and first inventor, and the requirements of inventorship and proof of right were therefore unmet.

That, however, was always the easy half, and a further difficulty attends it. The rule works only for as long as the applicant volunteers the fact, as Dr. Thaler did. No examiner can detect machine authorship from the face of a specification, and an applicant who names a human being will never encounter the rule. The proposition India states with most confidence is therefore the one least likely to be tested, while the question that arises in nearly every serious AI filing, namely how much human contribution is needed before an AI-assisted invention has a proper human inventor, is left unanswered.

How hard that question is can be seen from the US, which has answered it twice. In February 2024, the USPTO issued guidance applying the Pannu factors, a test developed for disputes between two or more human co-inventors, to AI-assisted inventions.



On November 28, 2025, it withdrew that guidance completely. The reason was that a test designed to divide credit among people cannot sensibly measure one person working with a machine, and it returned to the older test of conception.[15] A jurisdiction with a well-developed law of inventorship thus found its own framework unworkable in 21 months. The lesson is not that the USPTO drafted badly. It is that inventorship law everywhere was designed to divide credit between people, and has no language for comparing a person with a tool.

India is still in a weaker position. Section 2(1)(y) defines the true and first inventor only by saying who is not one: it excludes a person who imports an invention and a person to whom an invention is first communicated from outside India. It says nothing about what a person must actually do to count as an inventor, and India has no equivalent of the US doctrine of conception to fall back on. In practice, inventorship is declared on Form 1, and the Office does not question that declaration, so the issue never arises during prosecution. It arises after grant, as a ground of revocation under Section 64(1)(b), that the patent was granted to a person not entitled to apply, or Section 64(1)(j), that it was obtained on a false suggestion, and it will be argued before a court with no guidance to apply. The Guidelines have drawn a clear line and left the difficult ground just behind it untouched.

> **"It says nothing about what a person must actually do to count as an inventor, and India has no equivalent of the US doctrine of conception to fall back on."**

Consequences for drafting

The practical points are unglamorous but worth stating plainly. The technical effect should be written into the specification at the outset and expressed as a measurable improvement in how a system works, whether in latency, memory, bandwidth, or error rate, and never left to argument afterward. The model should be disclosed in enough detail that a skilled reader can work it without inventive effort of their own, and every claim whose commercial purpose is a business objective should be tested against the absolute exclusion. Records should also be kept of who contributed what, because the inventorship question is coming even though nobody is asking it yet.

Conclusion

The new Guidelines are a considerable improvement on their predecessor and reflect genuine consultation across two published drafts. They also arrive at a moment of unusual movement elsewhere: the UK has abandoned a 20-year-old test, and the US has revised its eligibility guidance and reversed its inventorship guidance within 18 months of each other.[16] The point worth noting, however, is that the Guidelines bind nobody. They do not amend Section 3(k); they cannot displace judicial interpretation; and their success depends on whether examiners actually apply the stepwise method or continue to refuse whenever algorithmic language appears in a claim.

The real measure will therefore be the first refusal decided under them to reach a High Court on appeal, and the reception the Court gives to the Office's reasoning. Until that judgment arrives, applicants would be well advised to assume what has always been true in India: that the burden of showing technical effect rests on the four corners of

the document they file.

Footnotes

1. Office of the Controller General of Patents, Designs & Trade Marks, Guidelines for Examination of Computer Related Inventions (CRIs), 2025, notified 29 July 2025 <https://www.pib.gov.in/PressReleasePage.aspx?PRID=2149719> accessed 5 August 2026. Text available at <https://www.ipindia.gov.in>.
2. Emotional Perception AI Ltd v Comptroller General of Patents, Designs and Trade Marks [2026] UKSC 3, overruling Aerotel Ltd v Telco Holdings Ltd [2006] EWCA Civ 1371.
3. The Guidelines expressly record that they do not constitute rule-making and that in the event of any conflict, the Patents Act, 1970 and the Patents Rules, 2003 shall prevail.
4. Ferid Allani v Union of India, W.P.(C) 7/2014, 2019 SCC OnLine Del 11867 (Prathiba M. Singh J.).
5. Ferid Allani (n 4) para 10.
6. Microsoft Technology Licensing LLC v Assistant Controller of Patents and Designs, C.A.(COMM.IPD-PAT) 29/2022, 2023:DHC:3342.
7. Blackberry Limited v Controller of Patents and Designs, C.A.(COMM.IPD-PAT) 318/2022, and Blackberry Limited v Assistant Controller of Patents and Designs, C.A.(COMM.IPD-PAT) 229/2022, both decided on 30 August 2024 (Prathiba M. Singh J.).
8. Kroll Information Assurance LLC v Controller General of Patents, Designs and Trade Marks, C.A.(COMM.IPD-PAT) 439/2022 (Amit Bansal J.).
9. OpenTV Inc v Controller of Patents and Designs, C.A.(COMM.IPD-PAT) 14/2021, 2023:DHC:3305.
10. G 1/19 (Pedestrian simulation), Enlarged Board of Appeal, 10 March 2021; T 641/00 (Two identities/COMVIK) [2003] OJ EPO 352.
11. Blackberry Limited, C.A.(COMM.IPD-PAT) 318/2022 (n 7), para 36.
12. Caleb Suresh Motupalli v Controller of Patents, C.M.A.(PT) No. 2 of 2024, 2025:MHC:293 (Senthilkumar Ramamoorthy J.).
13. No-Fume Ltd v Frank Pitchford & Co Ltd (1935) 52 RPC 231.
14. Thaler v Vidal, 43 F.4th 1207 (Fed. Cir. 2022), cert. denied, 143 S. Ct. 1783 (2023); Thaler v Comptroller-General of Patents, Designs and Trade Marks [2023] UKSC 49; J 8/20 (Designation of inventor/DABUS), Legal Board of Appeal, 21 December 2021; Commissioner of Patents v Thaler [2022] FCAFC 62; and, in India, Application No. 202017019068 (Stephen L. Thaler), refused 15 April 2026, holding that an artificial intelligence system cannot be the true and first inventor under the Patents Act, 1970.
15. Inventorship Guidance for AI-Assisted Inventions, 89 Fed. Reg. 10043 (13 February 2024), applying Pannu v Iolab Corp., 155 F.3d 1344 (Fed. Cir. 1998); rescinded in its entirety by Revised Inventorship Guidance for AI-Assisted Inventions (28 November 2025) <https://www.federalregister.gov/documents/2025/11/28/2025-21457/revised-inventorship-guidance-for-ai-assisted-inventions> accessed 5 August 2026.
16. 2024 Guidance Update on Patent Subject Matter Eligibility, Including on Artificial Intelligence, 89 Fed. Reg. 58128 (17 July 2024).

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