

INTELLECTUAL PROPERTY

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PROSECUTION & PATENT LITIGATION: NAVIGATING COMPLEXITY IN A GLOBAL IP LANDSCAPE

By Ken Adamo & Alex Shtraym

Patent prosecution and enforcement litigation have shifted from routine legal functions to strategic imperatives in the current era of rapid technological advancement and global market integration. Intellectual property is no longer a passive shield – it is a core driver of competitive advantage, shaping product launches, influencing M&A valuations, and determining market positioning.

Patent applications filed in isolation, driven by volume or deadlines rather than enforcement strategy, rarely deliver leverage when disputes arise. A coherent strategy integrates prosecution and enforcement, anticipates forum standards, and hard-wires injunction and damages planning into portfolio design.

The expanding global patent environment

Modern patent portfolios comprise thousands of assets across multiple jurisdictions, each with distinct procedural rules and interpretive standards. This global reach creates operational pressure – not only for filing and maintenance but also for harmonising enforcement strategies across divergent regimes.

Rapid advances in AI, cloud computing, and connected devices blur traditional product boundaries, creating infringement footprints that cross platforms and geographies. Proving infringement in these environments is increasingly difficult, as key evidence often resides in distributed systems or embedded algorithms that are difficult to obtain and analyse.

Intellectual property management can no longer operate in silos. Patent prosecution and enforcement litigation must function as a coordinated system. Without such coordination, claims misalign with forum standards and remedies weaken – eroding leverage and market position.



Structural challenges: From prosecution to enforcement

Jurisdictional fragmentation constitutes one of the most significant current hurdles for global patent enforcement. Differences in claim construction standards, damages methodologies, and injunctive relief availability create strategic variability that companies cannot ignore. In some jurisdictions, injunctions remain a powerful remedy. In others, courts prioritise monetary compensation and impose stringent evidentiary requirements rendering injunctions harder to obtain. Discovery rules also vary widely, influencing timelines and litigation costs.

As a result, enforcement planning must start at the drafting table. Claims should be built around the facts you will need to prove, supported by a contemporaneous evidence plan that captures technical and commercial data from day one. One must align venue and remedy objectives early so prosecution choices translate into enforceable rights when disputes arise.

Notable rule changes shaping litigation tactics

Patent enforcement strategies are no longer static. They are being rewritten by procedural shifts that ripple from the USPTO to U.S. district courts. Doctrine and rulemaking shape outcomes at every stage, from how claims are drafted to how post-grant proceedings and litigation unfold, making continuity between prosecution and enforcement the new competitive edge.

That continuity is tested in U.S. courts, where injunctive relief is discretionary under the four factor test, which affects remedial leverage and warrants early planning for both equitable and

monetary paths.¹ Damages analysis likewise demands rigorous apportionment and reliable expert methodology under Fed. R. Evid. 702. In *EcoFactor, Inc. v. Google LLC*, 137 F.4th 1333 (Fed. Cir. 2025) (en banc), for example, the Federal Circuit reaffirmed strict Rule 702 gatekeeping and reversed for a new damages trial where license-based royalty testimony lacked a reliable, case-specific foundation.

PTAB practice has been harmonised with U.S. courts on claim construction since 2018, when AIA trials adopted the *Phillips* claim construction standard.² As a result, PTAB judges must consider prior district-court and ITC constructions that are timely made of record.

The most consequential change of late is the USPTO's centralisation of institution authority in PTAB proceedings. Since October 2025, the Director personally issues summary institution or denial notices after weighing both discretionary and merits factors, elevating the stakes for pre-institution strategy. In parallel, the USPTO has encouraged Subject Matter Eligibility Declarations (SMEDs) (standalone, evidence-based submissions with a clear nexus to claimed technological improvements) as a targeted, evidence-based tool for addressing § 101 rejections.

Collectively, these policy and procedural shifts require patent enforcement to rest on a single, well-built record that moves seamlessly from the USPTO to the courts.

Balancing enforcement with cost-efficiency

USPTO Director level institution taken with the PTAB's *Phillips* alignment push costs upstream.



discretionary denials can block IPRs before the merits are even reached. For patent owners, concise, evidence-driven briefing and procedural moves that squarely address the Director's factors are essential. Done well, this reduces the risk of discretionary denial and converts spend into leverage. Done poorly, it adds cost without gain.

These dynamics underscore the necessity of intensive early case assessment: realistic balance of claims in the drafting process, the clarity and power of infringement evidence, and the procedural posture of parallel proceedings must lead before committing to litigation. To remain cost-efficient, adopt tiered tactics: aggressively enforce revenue-critical patents and route non-core assets to licensing or ADR.

Future outlook: Adaptability as a core capability

AI is poised to become the cornerstone of IP management. Yet, technology alone cannot replace legal judgment. The interpretive nuances of claim language, the strategic implications of venue selection, and the balancing of equitable remedies will continue to demand experienced counsel who are poised to translate business objectives into enforceable rights.

¹ See *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388 (2006).

² *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc); Final Rule: 83 Fed. Reg. 51340 (Oct. 11, 2018).



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Patent portfolios must remain modular and alive, built on disciplined continuation practice, alternative embodiments, and layered claims that survive shifting standards and multi actor implementations. Prosecution must anticipate downstream enforcement: draft to the intrinsic record, curate contemporaneous technical and commercial evidence, and stage damages presentation narratives early so they are ready for solid, rapid deployment when disputes arise.

Conclusion

Successful patent strategy demands integrated prosecution to enforcement planning. Prosecute so the right remedy is available in the right venue at the decisive moment, and litigate on a coherent record with costs you can defend.



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