

TaylorWessing

AI & patents in the life sciences industry – what do I need to know for my business?

AI in Life Sciences #2

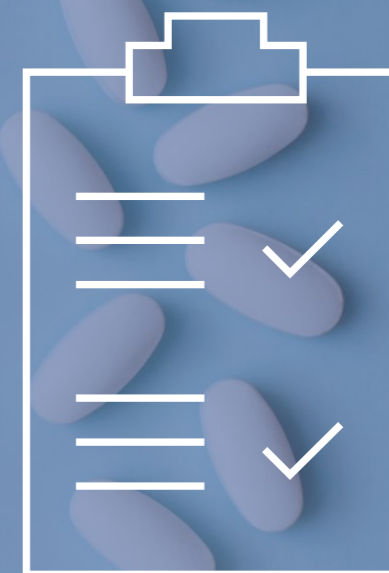
Webinar

28 November 2023 | Dr. Anja Lunze, Dr. Jan Phillip Rektorschek

Privat und vertraulich

Agenda

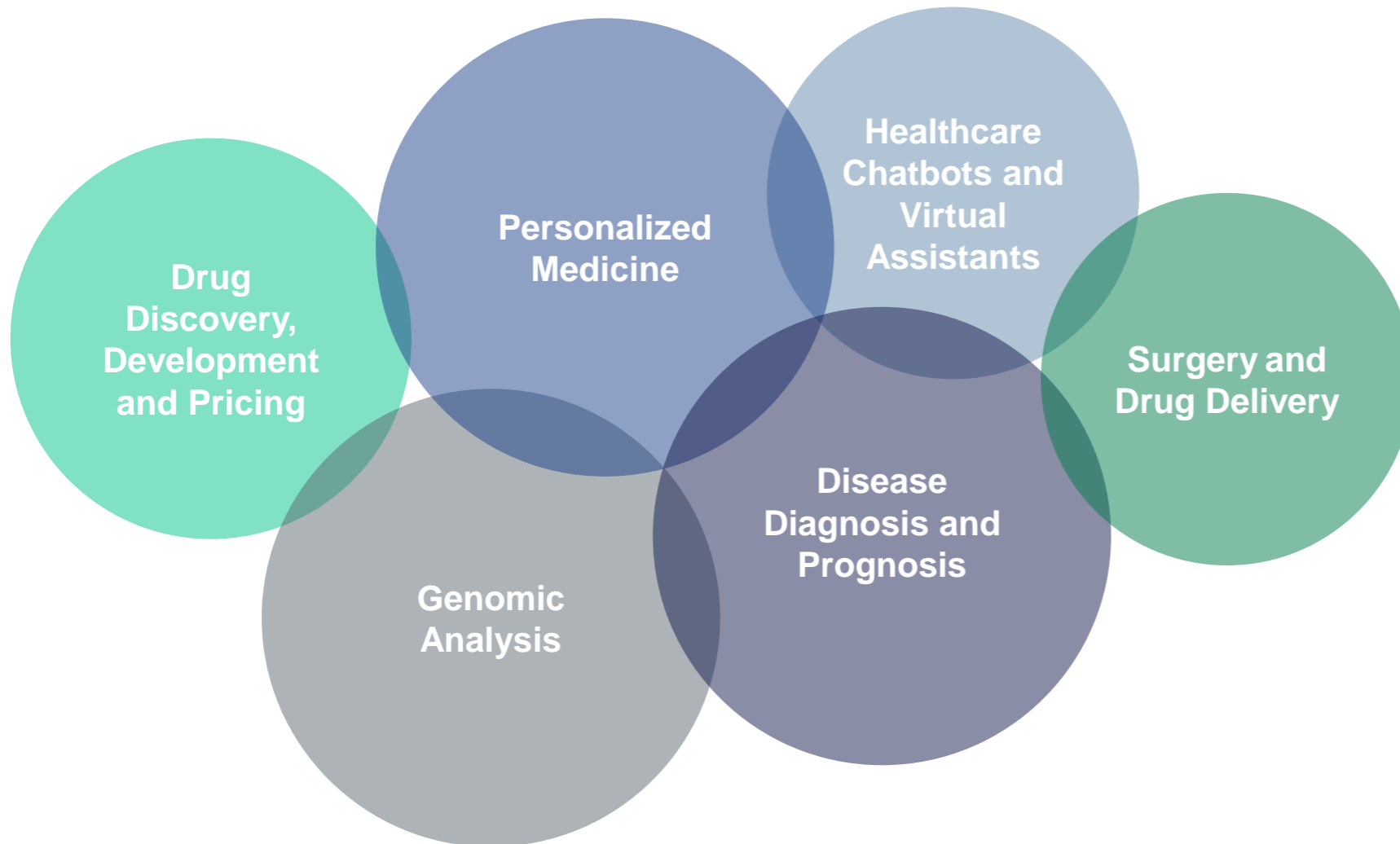
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AI in the Life Sciences – Scope of Use

AI in the Life Sciences – Scope of Use





2

Who is the inventor of AI inventions?

Who is the Inventor of AI Inventions?

Sec. 37 (1) German Patent Act

“The applicant shall (...) name the inventor or inventors and affirm that no **other persons** to his knowledge are involved in the invention.”

Sec. 81 EPC

“The European patent application shall name the inventor.”

35 U.S. Code § 100 (f)

“The term “inventor” means the **individual** (...) who invented or discovered the subject matter of the invention.”

USPTO, EPO and all other patent offices (except South Africa) have refused to recognize AI as inventor, because

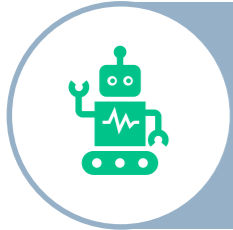
- underlying legal framework is interpreted to require the inventor to be a human being
- AI is (up to now) not capable to bear the associated rights

High-Profile-Case:
DABUS



a | **What can be patented?**

What can be patented?



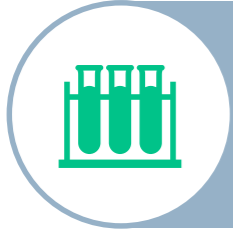
AI as such = Algorithm
P: „Technical Effect“?



Therapeutic and diagnostic Procedures?
P: excluded from patentability if performed at human body (EU)



Medical Devices?
P: novelty or inventive step in algorithm as such?



Medicinal Products and Drug Mixtures





b | Challenges in drafting AI-related Patents

Challenges in drafting AI-related Patents



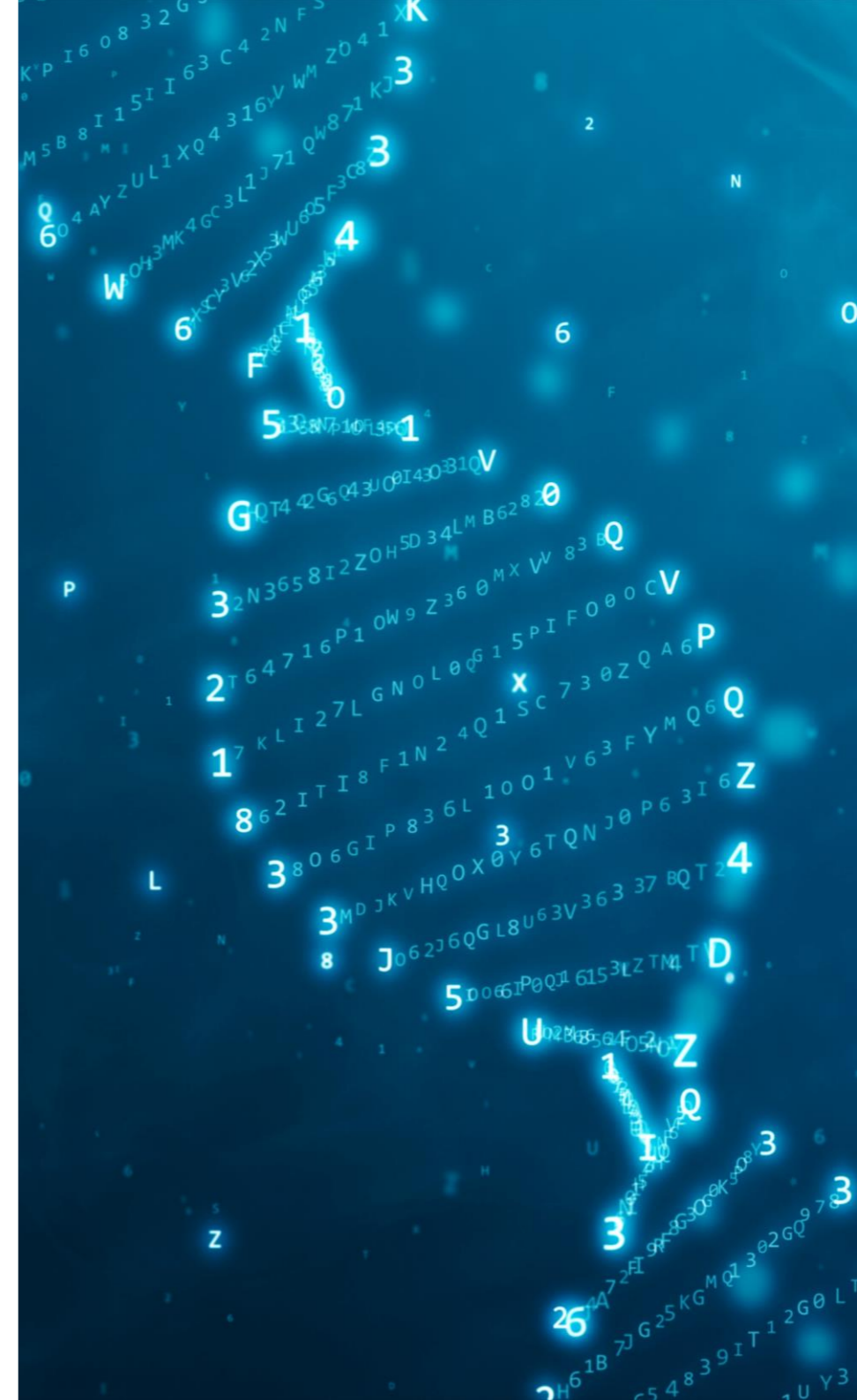
Impact on Non-Obviousness-Requirement



Unpredictable and complex AI results challenge Patent Clarity



Rapid AI Advancements outpace Patent System





3 | Enforcement of Infringement (German Courts and UPC)

Enforcement of Infringement – Challenges

Decompilation of Software Code

- AI-related invention is usually implemented in compiled software code
- Decompilation (if available) substitutes original names and labels of functions and variables with random character strings – but may still be helpful
- Other possible solution: court-contracted inspection procedure (Higher Regional Court of Düsseldorf, 22.05.2019 – I-15 U 11/14)

Principle of Territoriality

- AI-related patent infringement actions often transcend national boundaries (esp. method patents) → Partial infringement in several countries → Attribution of infringing acts?
- General principle: Domestic Connection necessary (see next slide).

Enforcement of Infringement in Multiple Countries

German Courts

- Partial Infringement takes place in Germany, if
 - **technical success** of the invention occurs in Germany and
 - foreign process acts are **consciously** made use of for this purpose.
- Technical Success is not only completion but also achievement of advantages of a process → can occur in Germany, regardless of previous / subsequent steps abroad
- Attribution of foreign partial infringements: **Economic-normative considerations**
- Also: **Contributory Infringements**

Enforcement of Infringement in Multiple Countries

UPC

- Partial infringement of UPs in UPCA Member States: UPs cover territory of several states as one unitary right → no attribution needed
- Partial infringement of EPs in countries in which EP has effect: Attribution to one EP-country (will be possible either by domestic connection or reciprocal attribution)
- Partial infringements outside area of UPCA or in contracting states in which an EP has no effect: similar approach to the German one can be expected
- Contributory infringements: broad scope of protection

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Contacts

Your Taylor Wessing Team

Anja co-heads our Life Sciences & Healthcare group in Germany.

She is a specialist lawyer for intellectual property law and has been working in the area of patent law for over 15 years. Anja manages and coordinates complex, multinational patent infringement proceedings and drafts infringement and nullity opinions. She advises on parallel opposition and nullity proceedings before the European Patent Office, the Federal Patent Court and the Federal Supreme Court.

In particular, Anja represents clients from the fields of pharmaceuticals, biotech, personalised medicine and precision medicine as well as from the chemical and medical device industries and advises on related issues of digitisation.

Having spent time in Geneva, Strasbourg, Tokyo and London, Anja has intercultural competence and language skills (including English, French and Japanese).

Languages

- German, English, French, Japanese



‘Superb in pharma cases’, [Competitor, JUVE 2023/2024](#)

Recommended as Best Lawyer for Patents, [Best Lawyers in Germany, Handelsblatt 2022, 2023](#)

“Outstanding technical understanding, dynamic advisor“, [Competitor, JUVE 2021/2022](#)

“A very reliable partner, whose constant high level of work and performance can be relied on at any time. We really appreciate her careful working style and her friendly nature, which makes every collaboration very enjoyable.”

[Legal 500 2021](#)

Recommended as Global Leader Patents 2020 and National Leader - Patents 2020 Germany, [Who's Who Legal 2020](#)



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Key areas of expertise

- Patents
- Litigation & Dispute Resolution
- Life Sciences & Healthcare
- Licensing, R&D Agreements

Your Taylor Wessing Team

Phillip has been handling patent litigation for national and international companies for more than a decade. He represents clients in the fields of IT/electronics and pharma/life sciences and mechanics/automation.

He also has extensive experience in trade fair matters - both in the enforcement and defence of rights.

Another main focus is on advising clients in the fields of robotics, industry 4.0, IoT and artificial intelligence. Phillip is also involved in complex trade-secret disputes, IP-related arbitration proceedings as well as in drafting and negotiating license and R&D agreements.

Phillip is a Certified Specialist Lawyer for Intellectual Property, gives lectures for Intellectual Property Law at the Munich Business School, publishes articles on current IP topics on a regular basis and is co-author of several IP-litigation handbooks and handbooks on IP-related aspects of AI and robotics.

Phillip is President of the Software and Integrated Circuit Commission and member of the board of the German Group of the European Practitioners in Intellectual Property (UNION-IP), as well as member of the German Association for the Protection of Intellectual Property (GRUR).

Languages

- German, English



“extremely efficient lawyer, very good work”, competitor, [JUVE Patent 2023/2024](#)

“It is enriching and refreshing to work with him.”, client [Legal 500 2023](#)

“Jan Phillip Rektorschek has been involved in complex patent litigation for over 10 years. A wide-ranging practitioner, he takes on clients across the IT, life sciences and mechanical industries. Alongside his disputes practice, transactional advice, especially in the robotics, AI and IoT fields, is also a significant component of his workload.” [IAM 1000 2023](#)

“Jan Phillip Rektorschek: Fast feedback and good, clear processing of issues.”, client [Legal 500 2021](#)

Recommended as “key lawyer”, [Legal 500 2020 – 2023](#)

Frequently recommended lawyer for Patent Litigation [JUVE 2021 – 2023](#)

Highlighted as Best Lawyer for Intellectual Property Law, [Best Lawyers in Germany, Handelsblatt 2021 – 2023](#)



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- Technology, Media & Communications

