

Invitation to Vossius & Partner Get Together

How to Effectively Enforce a Patent in Japan, the United States and in Europe

Topics

- I. Japanese Patent Litigation
- II. US Patent Litigation
- III. German Patent Litigation
- IV. The Development of the Biotech Practice in the EPO, G1/07, G2/08

Speakers

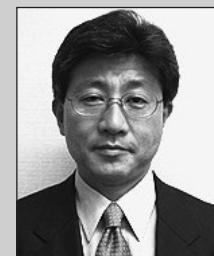
Kozo Yabe, Yuasa & Hara

Kozo Yabe, partner of Yuasa & Hara, is an expert in all fields of IP, cyberspace law, licensing, litigation and ADR, including domain name dispute resolution. He also has extensive experience in international business transactions and corporate compliance. He studied at the Chuo University, LL.B. in 1985, at the Legal Training & Research Institute in 1991, and at the University of Illinois at Urbana-Champaign, LL.M. in 1994. He has been an adjunct Professor at the University of Illinois College of Law since 2000 and is a board member of AIPPI/Japan.



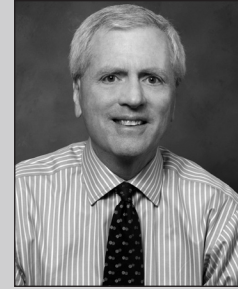
Chihiro Onishi, Yuasa & Hara

Chihiro Onishi joined Yuasa & Hara in 2005. He is expert in cross-border transaction law, general corporate and all fields of intellectual property. He studied at the Waseda University, LL.B. in 1984, at the Legal Training & Research Institute in 2000 and at the Columbia University, LL.M. in 2005. He is member of the Daini Tokyo Bar Association and has published several books in intellectual property issues.



James F. Haley, Jr., Ph.D., J.D., Ropes & Gray LLP

James Haley, partner of Ropes & Gray, focuses on the worldwide procurement, defense and enforcement of patents in the biotechnology, biopharmaceutical, pharmaceutical and chemical industries. He has counseled biotechnology and biopharmaceutical clients since 1978. Dr. Haley has handled numerous United States and foreign patent litigations, European and other patent oppositions and United States interferences in biotechnology and biopharmaceuticals. Patents he has prepared and prosecuted have earned clients more than 4 billion dollars in royalties.



John P. White, Cooper & Dunham LLP

John P. White, partner of Cooper & Dunham, earned a BS degree in chemical engineering, an MA degree in chemical biology and an MPh degree in biophysical chemistry. He received his J.D. degree from Fordham University. Dr. White has lectured extensively on strategies for optimizing patent prosecution, both in the United States and internationally. His practice primarily focuses in the area of pharmaceuticals and biotechnology, representing corporations, start-up ventures, and university research centers in counseling, patent prosecution, licensing, and litigation.



John R. Wetherell, Ph.D., Pillsbury Winthrop Shaw Pittman LLP

John R. Wetherell, partner of Pillsbury, has over 20 years experience in IP law. His counseling experience includes Intellectual Property acquisition, due diligence, patent infringement and validity analyses, freedom-to-operate opinions, licensing and strategic counseling. His patent prosecution experience includes obtaining US and foreign protection in biotechnology areas such as molecular biology, immunology, nanotechnology, medical diagnostics and pharmacology. Dr. Wetherell also evaluates intellectual property portfolios for both companies and investors and has written and lectured extensively for organizations and institutions around the world.



Dr. Johann Pitz, VOSSIUS & PARTNER

Johann Pitz, partner, is an attorney-at-law and heads the patent litigation department. He graduated from the Munich Max-Planck-Institute for IP Law and was admitted to the German bar in 1991. Dr. Pitz counsels and represents clients in multinational disputes before the German Civil Courts and the Federal Patent Court. He is member of the Patent Law Expert Committee of the German Intellectual Property Association and author of Beck's Practitioner Handbook „Patentverletzungsverfahren“ concerning German patent law and infringement proceedings.



Dr. Thure Schubert, VOSSIUS & PARTNER

Thure Schubert, partner, studied law at the Universities of Passau, Munich and Cardiff. He wrote his doctoral thesis at the Max Planck Institute for IP law and was admitted to the German bar in 1994. Dr. Schubert represents his clients in national and international patent litigation cases, in particular in the field of medical devices. He is a frequent lecturer on patent law and co-author on the topics of Licensing and the Law on Employees' Inventions in the Munich Contract Handbook and in the Beck's Collection of Forms Handbook.



Dr. Georg Andreas Rauh, VOSSIUS & PARTNER

Georg A. Rauh studied law at the University of Munich. He is a consultant for national and international clients in all fields of patent law and protection of intellectual property. During his legal clerkship he worked at Intellectual Property law firms in Munich, Madrid and Buenos Aires. He wrote his doctoral thesis on “Indirect Patent Infringement in Germany, Japan and the US” under the supervision of Prof. Joseph Straus at the Max Planck Institute for IP, Anti-Trust and Tax Law. Dr. Rauh is author of several judicial publications and speaks German and Spanish as a native speaker as well as English.



Dr. Mathias Kleespies, LL.M., VOSSIUS & PARTNER

Mathias Kleespies, partner, heads the trademark department. He advises clients in all areas of trademark, design, competition and food law and is responsible for the trademark portfolios of some of the world's leading companies in the area of pharmacy, chemistry, paper, automotive and consumer goods. Dr. Kleespies frequently represents clients before Civil Courts in litigation proceedings. He is co-editor and author of the Practitioner's Handbook on Trademark Law “Formularkommentar Markenrecht” and frequently lectures on trademark and design law.



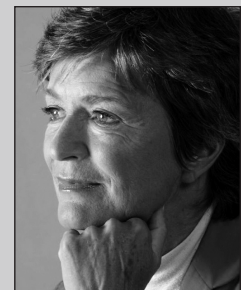
Dr. Stefanie Nabrotzki, LL.M., VOSSIUS & PARTNER

Stefanie Nabrotzki studied law at the Universities of Münster, Uppsala (Sweden) and Freiburg. She earned her LL.M. degree in the field of European Intellectual Property Law at the University of Stockholm. As a scholar and research assistant at the Max-Planck-Institute for Intellectual Property, Competition and Tax Law, she pursued her doctoral thesis in the field of Licenses' Suitability as Contribution in Kind and obtained her doctoral degree from the University of Freiburg. She focuses on Patent Litigation, Unfair Competition Litigation and the Law on Employees' Inventions.



Dr. Ursula Kinkeldey, former chair of Technical Board 3.3.04

Ursula Kinkeldey has a Ph.D. in molecular genetics and had been the first biologist to become a German Patent Attorney before she joined the Technical Boards of Appeal of the EPO. Dr. Kinkeldey became the chair of Technical Board 3.3.04 in 1994. Her career was of utmost importance for creating foundational guidance in the EPO's approach to patenting biotech inventions. Before Dr. Kinkeldey retired in early 2010, she was also for a couple of years a member of the Enlarged Board of Appeal in the EPO.



Dr. Hans-Rainer Jaenichen, VOSSIUS & PARTNER

Hans-Rainer Jaenichen, partner, is a German and European Patent Attorney. He has advised clients in the area of biotechnology for more than 25 years. Dr. Jaenichen has represented clients in important cases dealing with, e.g. PCR, Herceptin, tPA, erythropoietin, soluble TNF-receptor proteins and neutrokin-alpha. He has frequently lectured internationally and has chaired numerous conferences. Together with Dr. Haley he has published the book “From Clones to Claims” on European and US biotech patent practice.



VOSSIUS & PARTNER Get Together, Summer 2010

Because of their size and economic strength, the US, Japan and Europe are major markets in the worldwide economy. The protection and enforcement of intellectual property in these countries is, therefore, a decisive competitive factor for internationally operating companies. In order to establish and coordinate effective enforcement strategies, the knowledge of the respective patent enforcement systems is of increasing significance. An exchange of different national views offers a unique opportunity to highlight the differences between the IPR systems, with the goal to aid in development of effective international IP strategies.

Therefore, we would like to invite you to attend one of our special Get Together sessions focusing on Japanese, US and European intellectual property law being held in Munich on the 22nd and 23rd of July 2010. This Get Together will provide you an in-depth understanding of Japanese, US and European intellectual property law with particular emphasis on patent prosecution, invalidation and enforcement.

The 2010 Summer Get Together is free and open to all interested IPR people.

How does our 2010 Summer Get Together benefit you?

- It provides an in-depth understanding as well as a comprehensive comparison of Japan, US and European intellectual property law, with particular emphasis on patent prosecution, invalidation and enforcement.
- Learn why it is critical to monitor, protect and enforce patent rights in these countries.
- Discover how to better protect and enforce patent rights in Japan, US and Europe in the current economic climate.
- Learn how to apply patent rights in Japan, US and Europe during the training courses featuring some of the most distinguished IPR experts.

Agenda (all presentations will be given in English language)

Thursday, 22nd July, 2010 VOSSIUS & PARTNER, Siebertstraße 3, 81675 Munich

08:30

Registration

09:00

Welcome Address

Hans-Rainer Jaenichen, Partner of VOSSIUS & PARTNER

09:15

Japanese Patent Litigation

A. Overview of Procedure

Kozo Yabe, Partner of Yuasa & Hara

- Forum
- Composition of the court and the role of technical adviser
- Role of counsel
- Filing of complaint
- Provisional and/or restraining order
- Items to be covered in the complaint and answer
- Schedule of proceedings
- Hearing and preparatory hearing
- Overview of plaintiff's activity
 - a) In how much detail should defendant's product or process be identified?
 - b) How is the scope of the patent claim determined and construed?
 - c) When and how to explain technology to the court
 - d) Literal infringement and infringement under the doctrine of equivalence
 - e) Function of file wrapper estoppel
 - f) Joint infringement/inducement/contributory infringement
(a.k.a. "indirect" infringement)
 - g) Calculation of damages
- Overview of defendant's activity
 - a) Invalidating the patent
 - b) Defense of restriction on the exercise of right by patentee (§104-3/ a.k.a. defense of "invalidity" in general)
- Judgment and settlement
- Disclosure of court's view on the infringement before settlement
- How soon is the judgment issued at the Tokyo district court?

B. Issues Related to Invalid Patents

Chihiro Onishi, Yuasa & Hara

- Interplay between infringement and validity
- Overview of the JPO's patent invalidation trial procedure and action against the trial decision at the IP High Court
- Schedule of proceedings
- Will court procedure be suspended if a patent invalidation trial procedure is started at the JPO?
- What will happen if the court finds reasons that are serious enough to invalidate the patent?
Is that based on the lack of inventive step?
- What will happen if the court's finding on the invalidity issue and the JPO's finding on it differ?
How often are the court findings and the JPO's findings contradictory?
- Recent criticism and development

10:45

Coffee Break

11:00

Japanese Patent Litigation

A. Issues Related to Plaintiff's Establishment of a Case and Protective Order

Kozo Yabe, Partner of Yuasa & Hara

- Rules
- Disclosure of technical information and financial information
- What are "secrets" under the law?
- Role of counsel and court
- How are trade secrets treated in the litigation?

B. Recent Development of Discussion on Damages

Chihiro Onishi, Yuasa & Hara

- Rules on compensation under the civil code
- Difficulty in estimating what plaintiff should have obtained had there not been a patent infringement - what should be proven?
- Special rules under patent law on how to calculate losses
- What is the work of patent by plaintiff?
- How to extract infringer/defendant's profit
- Recent development of opinion for expansive application of law
- Recent case decisions

C. Questions and Discussions

12:00

Luncheon

13:15

US Patent Litigation

A. Overview of Procedure

James F. Haley, Partner of Ropes & Gray LLP

Organization of U.S. Courts

- Necessary parties
- Choice of trial counsel
- Forums for commencing infringement litigation
- Forums for commencing DJ action for non-infringement/invalidity
- Complaint/counterclaims/crossclaims
- Scheduling/discovery/timeliness
- Trial – role of court and juries
- Cost of litigation

B. Remedies/Post Trial Proceedings

John P. White, Partner of Cooper & Dunham LLP

- Damages
 - Ways damages are calculated
 - Enhanced damages and attorney fees
 - Use of experts and witnesses
- Injunctions – preliminary/permanent
 - Role of market facts and relative harms
- Appeals
 - Federal Circuit
 - U.S. Supreme Court

C. Relationship to U.S. Patent Office

John R. Wetherell, Partner of Pillsbury Winthrop Shaw Pittman LLP

- Important considerations when filing application
- Important considerations before patent issues
- Alternative proceedings before U.S. Patent Office
 - Reexamination (ex-parte and inter partes)
 - Reissue
 - Interference
- Patent term adjustments, patent term extensions
- Double patenting and terminal disclaimers
- Duty of disclosure

D. Questions and Discussion

15:00
Coffee Break

15:15

US Patent Litigation: Infringement

A. Acts of Infringement

John P. White, Partner of Cooper & Dunham LLP

- Direct/induced/contributory
- Filing ANDA
 - Drugs vs. biologicals
- Safe harbor
- Research
- Willful infringement
 - Role of opinion of counsel/patent attorney – in-house/outside counsel

B. Critical Activities in U.S. Patent Office

John R. Wetherell, Partner of Pillsbury Winthrop Shaw Pittman LLP

- Role of prosecution history
- Effects of claim amendments and arguments
- Considerations when drafting and prosecuting patent application

C. Proving Infringement

James F. Haley, Partner of Ropes & Gray LLP

- Claim construction/markman hearing
- Literal/equivalents/file history estoppel
- Burden of proof – special considerations for ANDAs
- Local court rules
- Use of experts/other witnesses/claim charts
- Successful strategies – case examples

D. Questions and Discussions

17:00
Drinks and Snacks

19:00 End of 1st Day

09:00

US Patent Litigation: Validity/Invalidity/Enforceability

A. General Considerations

John P. White, Partner of Cooper & Dunham LLP

- Interplay between infringement and validity
- §101, §102, §103, §112, etc.
- Inherency
- Double patenting
- Inequitable conduct
 - Persons to whom duty of disclosure applies
 - Obligation to disclose material information

B. Critical Activities During Prosecution

John R. Wetherell, Partner of Pillsbury Winthrop Shaw Pittman LLP

- Effects of drafting and prosecution on validity
 - differentiating prior art
 - swearing back of reference
 - sufficiency of specification under §112
- Submission of IDS
- Submission of terminal disclaimer

C. Proving Validity/Invalidity

James F. Haley, Partner of Ropes & Gray LLP

- Impact of claim construction/markman hearing
- Burden of proof
- Local court rules
- Use of experts/witnesses/claim charts
- Successful strategies – case examples

D. Questions and Discussion

10:45

Coffee Break

11:00

Infringement Litigation in Germany

Johann Pitz, Thure Schubert, Georg A. Rauh, Mathias Kleespies, Stefanie Nabrotzki, VOSSIUS & PARTNER

A. Pre-Litigation Strategy

- Determination of rights: patents vs. utility models
- Fact finding
- Pre-trial notice

12:00

Luncheon

13:15

Infringement Litigation in Germany

Johann Pitz, Thure Schubert, Georg A. Rauh, Mathias Kleespies, Stefanie Nabrotzki, VOSSIUS & PARTNER

B. Adequate Proceedings

- The dual system
- Proceedings on the merits
- Preliminary injunction proceeding
- Revocation proceedings

C. Determination of Infringement

- Direct/indirect infringement
- Literal/equivalent infringement
- Claims and claim construction
- Post-grant amendments of claims

D. Available Relief and Enforcement

- Injunction to cease and desist
- Claims of „Torture“
- Damages
- Execution of judgements
- Custom seizure

14:15

Coffee Break

14:30

Infringement Litigation in Europe

Johann Pitz, Thure Schubert, Georg A. Rauh, VOSSIUS & PARTNER

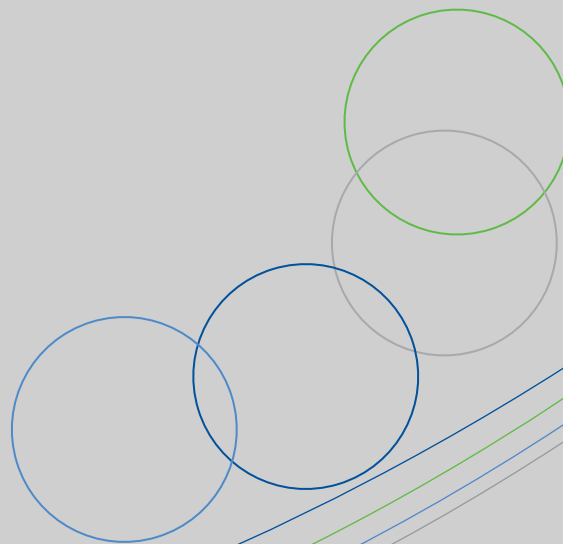
A tabular comparison of infringement litigation in European countries

15:30

The Development of the Biotech Practice in the EPO, G1/07, G2/08

Ursula Kinkeldey, former chair of Technical Board 3.3.04

16:30 End of Conference



Any Further Questions?
Please send any questions and/or enquiries to the following address:

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