

UNIVERSITAT DE BARCELONA

Centre de Patents

MINISTERIO DE ENERGÍA, TURISMO Y AGENDA DIGITAL

Oficina Española de Patentes y Marcas

2018 Chem-Pharma-Biotech Highlights

on Patentability and Patent Infringement

Barcelona, 6 February 2018
Madrid, 7 February 2018

Outlook

As "Highlights" the organizers will be offering advanced patent training of major significance or special interest in the form of two one-day sessions to be held in Barcelona and Madrid on consecutive days.

The "Chem-Pharma-Biotech Highlights" will bring patent practitioners up to date on some of the most critical and recent issues on IP in the field of life sciences. Speakers are experienced patent attorneys and patent litigators who have handled a multitude of proceedings before patent offices and courts.

Focus will be on the patentability of life science inventions before the European Patent Office, and their enforcement before some national patent courts, with special emphasis on inventive step, claim construction, medical use claims, and product-by-process claims. Other topics of interest will be advanced strategies for enforcing pharma patents, and generics-related issues.

Join us as we discuss these recent developments and how they affect our everyday practice. Discover how to utilize these recent changes for the benefit of your companies or clients. **PASCUAL SEGURA**

Objective

This one-day course will provide an in-depth and updated analysis of some topics related to patents in life sciences, to which practitioners should pay special attention for the benefit of their employers or clients, as the topics are either problematic, controversial, challenging or new.

Who should attend

Spanish or European patent attorneys, patent lawyers, patent examiners, intellectual property consultants, experts from patent departments in industry and from technology transfer offices of research institutions or universities.



PROGRAM

1. Technical effects in the EPO's assessment of inventive step

- The application of the EPO's problem-solution approach
- Can technical effects be relied upon if they are not mentioned in the application?
- To what extent are improvements over the prior art required?
- Data support in the application and breadth of claims

2. Therapeutic effects, experimental data and plausibility

- Applicant's position: When to file? Which data to include?
- Which therapeutic effect is relevant?
- Treatment of drug combinations

3. Claim construction in validity and infringement proceedings

- Doctrine of equivalence: *Pemetrexed* before the German and UK courts
- De *minimis* use: *Napp v. Dr. Reddy's* ([2016] EWHC 1517 (Pat)) et al.
- Claim construction in validity assessments: *Polymerschaum* II et al.
- Further recent decisions on claim construction

4. Second medical use claims

- Which product is a 'substance or composition' - When does a claim fall within the scope of Art. 54(5) EPC?
- Effect-based definition of medical indication - New clinical situation versus explanation of a known therapy
- Selection of patient group - Evolving criteria for assessment of novelty



PROGRAM

5. Enforcement of use claims in pharmaceutical patents

- What constitutes an infringing act for use claims?
- Overview of recent German case law: what has happened since *Ribavirin* and *Buspiron*
- Infringement of use claims: direct, indirect or both?
- Ribavirin, Pregabalin & Co: European diversity
- Off label use: who is responsible?
- Rebate agreements: what can the generics do?

6. Product-by-process claims

- The EPO's current position
- 'Obtainable by' and 'obtained by': any material difference?
- Recent decisions of the British and German courts

7. Advanced strategies for enforcing pharma patents in Europe

- Effective use of competitive intelligence: early preparation is key
- Legal steps based on generic pre-launch activities: different standards country by country
- Availability of provisional injunctions in various European jurisdictions
- Use of the 'specific mechanism' against parallel imports

8. The generics' toolbox

- Torpedos and counter-measures
- Lessons from the *Pemetrexed* and *Adalimumab* litigations: NDAs regarding infringement and validity
- Early triggering of an injunction request
- Damages for unjustified injunctions



SPEAKERS

GUSTAVO FUSTER

Gustavo is a European and Spanish Patent Attorney as well as a Spanish Attorney-at-law with Hoffmann Eitle in Madrid. After several positions both in private practice and industry, he joined Hoffmann Eitle in 2011. He advises mostly Spanish clients in the life sciences, from small molecules to cellular technologies, with an emphasis on European and international patent prosecution. He is also involved in Spanish patent litigation.



JOACHIM RENKEN

Joachim is a European and German Patent Attorney with Hoffmann Eitle in Munich and Madrid. He joined Hoffmann Eitle in 1996. He is particularly active in the field of life science patents, mainly in oppositions and appeals. He also regularly provides strategic advice and is involved in patent litigation before the German courts. He is co-editor of the book "The European Patent Convention for Japanese Patent Practitioners".





CLEMENS TOBIAS STEINS

Tobias became a German attorney-at-law in 1999 and joined Hoffmann Eitle in Munich in 2007. He is particularly active as a patent litigator, mainly regarding pharmaceutical and telecommunication patents. He further specializes on IP contracts and transactional work such as licensing, R&D agreements, acquisitions and divestitures of IP portfolios. He regularly publishes on IP law and is co-editor of the book "The European Patent Package".

HOFFMANN EITLE

In Barcelona

Tuesday, 6 February 2018
Parc Científic de Barcelona
Aula Fèlix Serratosa
Edifici Clúster - Baldiri Reixac 10
08028 Barcelona
www.ub.edu/centredepatents

Time

10:00 to 17:00 h
1 hour lunch break

Registration

Centre de Patents de la UB
Núria Sans
Email: nuriasans@patents.pcb.ub.es
Tel: +34 93 403 45 11

Notes

A certificate of attendance will be provided on request. The organizers reserve the right to cancel this course or to modify any aspect thereof. In addition, they will not be responsible for the opinions expressed by the speakers. Lectures will be delivered in English. Questions may also be asked in Spanish.

In Madrid

Wednesday, 7 February 2018
Oficina Española de Patentes y Marcas
Sala Julio Delicado (planta 16)
Paseo de la Castellana 75
28046 Madrid
www.oepm.es

Attendance Fee

250.00 EUR + 21% VAT (if applicable)
This includes course materials and lunch

Payment

By bank transfer to the account
IBAN ES4201826035430201602137/BIC BBVAESMMXXX
Account holder: Fundació Bosch i Gimpera
(VAT No. ES-G08906653)
Payment must be received by 22 January 2018
Provide invoice details

Cancellation

Fee will be refunded
(minus 4% administration expenses)
if cancellation occurs on
22 January 2018 at the latest.

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