

Course offered by

Centre de Patents



UNIVERSITAT DE BARCELONA



MINISTERIO
DE INDUSTRIA, TURISMO
Y COMERCIO



Oficina Española
de Patentes y Marcas

Patent Highlights 2012

Patents in Life Sciences: An Update

Madrid, 27 February 2012
Barcelona, 28 February 2012

Introduction

Under the term "Patent Highlights" the organizers want to offer advanced patent training of major significance or special interest, in the form of one-day sessions. This training is held in duplicate: in Madrid and in Barcelona, in two consecutive days. This is the first Patent Highlights of 2012. Two others are being planned for 2012, and they will be announced in due time.

"Patents in Life Sciences: An Update" intends to bring patent practitioners up to date with some of the most critical and recent issues on IP in the field of life sciences, and it supplements and updates the two-day course "Patents in Life Sciences" delivered by the same speakers in 2009. Overlapping with our *Curso Avanzado sobre Patentes*, particularly its *Módulo de química y farmacia* and its *Módulo de biotecnología y biomedicina*, has been reduced to a minimum.

Speakers are experienced patent attorneys who have handled a multitude of proceedings before the patent offices and courts. They will report about the newest developments and trends in the IP field of life sciences inventions. New case law in SPC matter will be included. Inventions in some borderline fields, namely nutraceuticals and cosmeceuticals, will be dealt with as well. Biotech patents will occupy a large part of the program, both from the patentability and the enforcement viewpoints. Pharma litigation and recent national and ECJ rulings in this field will also be included. The course ends with some remarks about the attorney-client privilege and the possible impact of the proposed European unitary patent system on life sciences. We look forward to updating on the latest developments in patents in the field of life sciences and to discussing these important topics with course participants. **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, because they are problematic, polemic, 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

1. Supporting inventive step with experimental data

- Comparison with the closest prior art and the closest approximation to the claimed invention
- Demonstration of an unexpected and advantageous technical effect
- Origin of the technical effect in the distinguishing feature of the claimed invention compared to the closest prior art
- Existence of the technical effect within the whole range as claimed
- Derivability of the technical effect from the application as filed
- Allowance of post-published evidence
- Relevant case law: T1329/04 (*Growth Factor-9*), T1336/04 (*cellulases*), T715/03 (*ziprasidone*), EP 1175904 (*alendronate*), EP 1506041 (*ibandronate*)

2. New case law in SPC matters

- Protection of combinations of active compounds (*Medeva, Georgetown University, Yeda*)
- Enantiomer and racemate - different active compounds (*escitalopram*)
- Several SPCs for the same active compound (*AHP Manufacturing*)
- SPCs for medical devices? Conflicting decisions
- Paediatric SPC extensions - missing documents and the filing date of the extension request (*losartan*)
- Accession of new Member States to the EU and transition periods for SPC applications (*Kirin Amgen Inc.*)
- The protective scope of granted SPCs

3. Nutraceuticals and cosmeceuticals - patenting IP in a grey area

- Available claim formats and patentability considerations
- Protective scope and infringement scenarios
- Impact of health claims regulation
- T1635/09 Contraceptive Composition/Bayer Shering

4. Recent EPO case law

- G1/10: Correction of errors during opposition
- G2/10: Disclaimers for disclosed subject-matter
- Review by Enlarged Board under Art. 112a EPC
- Recent EPO policy on double patenting
- Admissibility of Requests on Appeal (T1186/06)
- Lack of Clarity in Opposition (T1459/05)

5. New biotech case law

- Introduction: news and statistics
- Procedural aspects: T390/07, etc.
- When is a "kit" a "kit" ? T1898/07
- What is a "direct/unambiguous" gene disclosure? T18/09, etc.
- Receptor applications and Articles 56/83 EPC: T1329/04 etc. vs. T1642/06 etc.

6. Enforcement of biotech patents

- Protection for the product directly obtained by a claimed process
- Enforcement of gene related patents (*Ajinomoto vs. GB & HELM*)
- Enforcement of gene patents in multiple jurisdictions

7. New chances for the patentee in pharma litigation

- Obtaining evidence: Recent case law on inspection and seizures
- Cross-border injunctions - the return of a Dutch zombie?
- Provisional injunctions in Germany after *Harnkatheterset*
- New strategies for enforcing patents which are about to expire

8. Recent national and ECJ rulings on life sciences patents

- Cross-border impact of national decisions
- *Actavis vs. Merck* (FR, GB) on *finasteride*
- *Novartis vs. Johnson & Johnson* (FR, GB, DE) on compatible contact lenses
- *Eli Lilly vs. Human Genome Sciences* (GB) on the validity of gene patents
- ECJ decision on "embryonic stem cells"

9. Attorney-client privilege

10. Update on the European unitary patent system - possible impact on Life Sciences

Thorsten Bausch

Thorsten Bausch studied chemistry and has a Ph.D. in technical chemistry. He is a German *Patentanwalt* and European Patent Attorney. His main area of work concerns pharma and biotech patents, with a focus on European opposition and appeal proceedings as well as cross-border and national litigation. He is the editor of *Nichtigkeitsrechtsprechung in Patentsachen* ("German Patent Nullity Cases"), a collection of decisions in patent nullity matters from the German courts



Joachim Renken

Joachim Renken studied chemistry and has a Ph.D. in biophysical chemistry. He is a German *Patentanwalt* and European Patent Attorney. His main area of work concerns chemical and biotech patents, principally in prosecution and opposition proceedings. He has litigation experience, inter alia with patents involving drugs and biochips



Joseph P. Taormino

Joseph P. Taormino studied chemistry and has a Ph.D. in molecular biology. He is a European patent attorney. His main area of work concerns biotech patents, principle in opposition and appeal proceedings as well as freedom-to-operate opinions and due diligence work. He has experience in proceedings involving a diverse range of biotech compositions including erythropoietin, transgenic plants, antibodies and biochips, and methods including screening and diagnostic methods



Venue in Madrid

Oficina Española de Patentes y Marcas
Sala de Usos Múltiples (planta 16)
Paseo de la Castellana 75
28046 Madrid

Time

10:00 to 18:00 h
With lunch break

Registration

Centre de Patents
de la Universitat de Barcelona
Núria Sans
Email: nuriasans@pcb.ub.es
Tel: +34 93 403 45 11
Fax: +34 93 403 45 17

Notes

A certificate of attendance will be provided under request
The organizers reserve the right to cancel this course or
to modify any aspect thereof. Besides, they are not
responsible for the opinions expressed by the speakers

Venue in Barcelona

Aula Fèlix Serratosa
Parc Científic de Barcelona
Edifici Clúster - Baldiri Reixac 10
08028 Barcelona

Attendance Fee

250,00 EUR + 18% VAT
Includes course documentation and lunch

Payment

By bank transfer to the account
no. 2013-0088-63-0200326711
By cheque payable to Fundació Bosch i Gimpera (projecte 3584)
Payment must be received by 13 February 2012
Provide invoice details
Invoice and confirmation will be forwarded to you

Cancellation

Fee will be refunded
(less 4% administration expenses)
if cancellation occurs on
13 February 2012 at the latest