

The Patents Centre of the University of Barcelona and
the Oficina Española de Patentes y Marcas are offering this course:

Obtaining and Enforcing Patent Rights in Asian Countries: Japan, China, India, South Korea, etc.

Madrid, 9-10 April 2008
Barcelona, 14-15 April 2008

• Venues:

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

In Barcelona: Auditori Antoni Caparrós
Parc Científic de Barcelona
Baldiri Reixac 4
08028 Barcelona

• Time:

10:00 to 18:00 h (with a lunch break)

• Registration:

Núria Sans / Email: nuriasans@pcb.ub.es / Tel: +34 93 403 45 11 / Fax: +34 93 403 45 17.

• Attendance Fee:

500 € (VAT not applicable): Includes course documentation and lunch.

• Payment:

By cheque payable to Fundació Bosch i Gimpera (projecte 3584) or by bank transfer to the account no. 2013-0088-63-0200326711. **Payment must be received before 25 March.** Provide invoice details. Invoice and confirmation will be forwarded to you.

• Cancellation Policy:

Fee will be refunded (less 4% administration expenses) if cancellation occurs on 25 March at the latest.

• 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 speaker.

• Introduction (by Pascual Segura):

The data on gross domestic product (GDP) published by the International Monetary Fund in October 2007 for the countries of the world show the following top-16 ranking (estimates in millions of millions of dollars): Total World, 72.3; USA, 13.5; China, 11.6; India, 4.7; Japan, 4.3; Germany, 2.7; UK, 2.3; France, 2.1; Brazil, 2.0; Russia, 1.91; Italy, 1.89; Spain, 1.31; South Korea, 1.25; Mexico, 1.24; Canada, 1.22; Indonesia, 1.05, and Taiwan 0.75. According to these figures, the six Asian countries mentioned above represent virtually one third of the value of all final goods and services produced in the world, with India -and particularly China- in positions much higher than expected two years ago. In 2005 China and India were fourth and thirteenth in the ranking, respectively.

As the economic size of the country where a patent is granted is an essential aspect to consider in any patenting decision, for the UB Patent Centre and the Spanish Patent and Trademark Office (*Oficina Española de Patentes y Marcas, OEPM*) organizing a course on this subject was something "obvious to try". But to have a "reasonable expectation of success" we needed both an appropriate approach and a good speaker.

Concerning the approach, we have thought that, instead of limiting to only one Asian country, it will be more useful for the participants to obtain a general overview of the four most important Asian countries, also including some features of a few less important ones.

Concerning the speaker, we have been extremely lucky, as we have Philip Grubb, the author of "Patents for Chemicals, Pharmaceuticals and Biotechnology", the book with an international approach that is recommended at the Patent Centre for self-study and reference. Dr. Grubb is a very gifted teacher, as illustrated by his accompanying CV and as we have experienced several times in Spain, after we first invited him in 1991 to lecture at the OEPM on peculiarities of patent systems in non-European countries, including Japan. Besides, he is currently teaching a course on International and Comparative Patent Law at a reputed US law centre. Last, but not least, he has experience in patenting and enforcing patent rights in the countries covered in this course.

Few years ago, the view that it was not worth patenting in Asian countries was widespread among Spanish patent professionals and decision makers, mainly because to obtain patents -and particularly to enforce them- was considered difficult and expensive. Today such a view would be an unsupported prejudice, and in general patenting in the most important Asian countries should be considered to be a good investment. Costs are not higher than in many other countries of lesser interest. Enforcement has been good in Japan for many years; it is already reasonable in China and South Korea, and it is expected to be better in India in the near future. As a matter of fact, Spanish applicants have already started to extend the protection of many of their inventions to some Asian countries, as illustrated by the 2006 statistics on patent applications of Spanish origin: There were around 1,100 European and 700 North American applications, but also nearly 200 Japanese and 260 Chinese. Hopefully this course will help to increase the two latter figures!

• Objective:

This two-day course will provide a detailed, updated and comparative description of the procedures for obtaining and enforcing patent rights in the four economically most important Asian countries (China, Japan, India and South Korea), as well as a brief description of a few other Asian countries. Emphasis will be on both policy and practice. Focus will be on how Spanish or European companies can take full advantage of Asian patent systems.

• Who should attend:

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

Program

Day 1: Obtaining Patent Rights

- Requirements of TRIPs agreement.
- PCT filings:
 - Available in all significant countries other than Taiwan.
 - Japanese, Korean and Chinese patent offices as ISAs and IPEAs.
- Japan:
 - Request for examination.
 - Search, prosecution.
 - Opposition/revocation.
 - Inventor remuneration.
- Korea:
 - Similarities to and differences from Japan.
- China:
 - Patent law in conformity with TRIPs.
 - Examination in patent office.
 - Opposition/revocation proceedings in patent office.
 - Viagra* decision.
- India:
 - New Indian Patent Act. In conformity with TRIPs?
 - Restrictions on patentability.
 - Black box applications and EMRs. *Glivec* case.
 - Decentralised structure of Indian patent office.
 - Prosecution of applications in India.
- Other countries:
 - Malaysia
 - Singapore
 - Pakistan
 - Thailand
 - Indonesia

Day 2: Enforcing Patent Rights

- Requirements of TRIPs agreement.
- Japan:
 - Court system: responsible courts, new Patents Court.
 - Separate hearing of validity and infringement issues.
 - Court procedures.
- Korea:
 - Court system, procedure.

- China:
 - Problems with enforcement of IP rights generally.
 - Choice of administrative or judicial proceedings.
 - Separate hearing of validity and infringement issues.
 - Need for legalization of all written evidence.
- India:
 - Court system based on English courts.
 - Validity and infringement considered together.
 - Delays in procedure.
- Other countries:
 - Malaysia
 - Singapore
 - Pakistan
 - Thailand
 - Indonesia

Speaker

• Philip Grubb

Philip Grubb was born in Manchester, England, and studied organic chemistry at Oxford University (D.Phil. 1964). After a year at the University of Wisconsin, he worked as research chemist first for Du Pont in Wilmington, Del. then for ICI in Runcorn, before entering the patent department of ICI in 1970. He qualified as a UK Chartered Patent Agent in 1974 and in the same year moved to Sandoz in Basel, Switzerland, where he was active in patents and licensing in the fields of pharmaceuticals and biotechnology. After the merger of Sandoz with Ciba-Geigy, he was Intellectual Property Counsel in Novartis International AG, where he was responsible for IP liaison with the research institutes of the Novartis Research Foundation (Friedrich Miescher Institute, Basel, and Genomics Institute, San Diego) and the Novartis Institute for Tropical Diseases in Singapore, as well as professional training, current awareness and IP policy issues. He is the author of "Patents for Chemicals, Pharmaceuticals and Biotechnology" (OUP, fourth edition December 2004).



Between 1980 and 1986, Dr. Grubb was a member of the EPO Examination Committee for Paper C. He acted as a tutor in the CEIPI seminars in Strasbourg and Basel from 1990 to 2007. He retired from Novartis in January 2005, and now acts as consultant in intellectual property and licensing matters. In 2006 he was one of two tutors in a training programme for examiners in the Indian Patent Office, and in 2007 was Adjunct Professor of Law at the Franklin Pierce Law Center, Concord, New Hampshire, where he taught a course in International and Comparative Patent Law.