



SESSION 7.3 LIABILITY – LIABILITY AND DISCIPLINARY RISKS OF AN IP FIRM

If the bread falls on the buttered side: Liability and disciplinary risks.

Attorneys and law firms have to cope with very high standards for due care and diligence on both a personal and an organisational level in order to avoid malpractice and liability issues. At the same time, IP work requires the handling of large commercial values on a daily basis. What happens if things do go awry?

This session gives examples of what can go wrong, how to deal with it and how to avoid it. We shed light on cases that have been brought before disciplinary committees and insurance companies, and on measures a firm may take to hedge organisational risks.

Dr Roberto Pistolesi (IT)
Redvers Cunningham (GB)
Barry W. Graham (US)
Huw Hallybone (GB)
Dr Shoichi Okuyama (JP)



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INTERNATIONAL FEDERATION OF
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DR ROBERTO PISTOLESI (IT) – MODERATOR

Worked for Fedegari Autoclavi Spa and Nalco from 1994 to 1995. Joined Dragotti & Associati in 1995.

Roberto has an extensive experience both in prosecution and opposition procedures before the EPO, where he has been involved in more than 50 cases before the Opposition Divisions or the Boards of Appeal. He also has a wide expertise in multi-national patent litigations, having been involved in more than 50 litigations both in Italy and abroad (mainly USA, UK, Germany and France). In particular, he has been involved in patent litigations concerning the following active principles: alendronic acid, atorvastatin, cefaclor, citalopram, docetaxel, enoxaparin, esomeprazole, phosphatidylserine, gabapentin, irbesartan + HCT, latanoprost, olanzapine, omega-3, omeprazole, montelukast, quetiapine, ramipril, repaglinide, rupatadine, samleterol + fluticasone, and terbinafine. He frequently advises clients on patent strategies and provides infringement and validity opinions.

Roberto has been technical expert of the Court of Milan since 2002, where he assists Judges in patent infringement and/or validity cases.

He has been also adjunct Professor at the "Università degli Studi" of Milan since 2011, where he has been teaching a course on chemical patent practice to the students of Chemical Science, Industrial Chemistry and Biotechnology.

Since 2012 he has also been the chairman of FICPI's study and work commission dealing with inventions in the pharmaceutical and biotechnology area.

He frequently lectures on intellectual property both in Italy and abroad. He has published several articles on "Il Sole-24 Ore", "Pharmachem" and "Il Diritto Industriale".



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REDVERS CUNNINGHAM (GB) – SPEAKER

Redvers Cunningham is a barrister. He is the Chief Executive of Thomas Miller Professional Indemnity, an insurance business in the City of London which specialises in managing mutual insurance companies for professionals.

These companies include the Bar Mutual, which insures all 14,000 practising barristers in England & Wales and PAMIA, which insures over 95% of the firms of patent attorneys in the UK and Ireland.

He has been involved in the management of PAMIA for over 20 years and in that time has defended hundreds of claims against patent and trade mark attorneys, giving him a privileged insight into the errors attorneys make and how they may be avoided.



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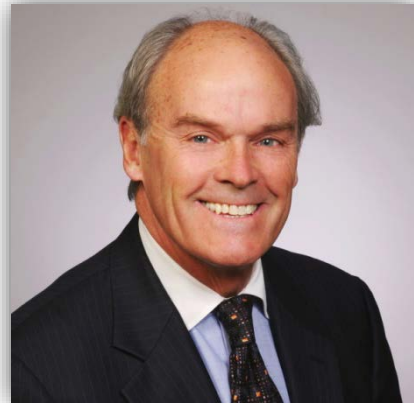
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BARRY W. GRAHAM (US) – SPEAKER

Barry Graham has a B.S. (Electrical Engineering) degree from the University of Virginia (1970), a JD with honors from the University of Georgia (1977), and a LLM (Patent and Trade Regulation) from George Washington University National Law Center (1983).

He served as a judicial law clerk to Federal Appellate Judge Phillip B. Baldwin at the U.S. Customs and Appeals Court, the predecessor court to the U.S. Court of Appeals for the Federal Circuit (1980-82). He is a U.S.P.T.O. registered attorney practitioner (1980).

Barry is a partner at Finnegan, Henderson et al., having joined the firm in 1982. His practice focuses on patent infringement litigation and related client counselling. He represents both domestic and foreign patent owners and accused infringers and frequently counsels clients regarding issues such as patent infringement, enforceability, and validity that may end up in litigation. His practice concerns a variety of technologies, primarily consumer electronics, semiconductor design and fabrication, telecommunications systems, and computers.



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HUW HALLYBONE (GB) – SPEAKER

Huw Hallybone is with the London firm, Carpmaels & Ransford. He started at the firm after graduating from Oxford University with a degree in Chemistry in 1980, and has been a partner in the firm for more than 25 years. Huw's technical portfolio extends across a wide range of chemical and biotechnological technologies.

Procedurally, Huw has broad experience in the preparation, filing and prosecution of UK and European patent applications and, especially, EPO opposition proceedings. In the latter area he has been the lead advocate in a large number of high profile (frequently multiparty) oppositions before both the Opposition Divisions and the Technical Boards of Appeal of the EPO.

Although based in London, Huw spends a considerable amount of time in Munich, meeting clients and preparing for and attending hearings and Examiner interviews.

He is a member of EPO Disciplinary Board of Appeal, Immediate Past-President of the Biotechnology Commission of UNION, and a committee member of the CIPA Benevolent Association.



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DR SHOICHI OKUYAMA (JP) – SPEAKER

Dr Okuyama is a registered patent attorney. He specialises in electrical engineering and chemistry.

He has been Principal of Okuyama & Sasajima since 2009. Prior to that, he had been Principal Partner at Okuyama & Co. from 2001 to 2009.

Dr Okuyama is a former President of Japan Patent Attorneys Association. He was an Assistant Reporter General of AIPPI for four years between 2006 and 2010. He is currently Vice President of AIPPI Japan. Also, he is a tutor of the EURO-SEAD Patent Drafting Course organised by FICPI. He serves as an expert member of the Intellectual Property Strategy headquarters organised by the Prime Minister of Japan.

Dr Okuyama has received a number of awards including an award from the Commissioner of the Japan Patent Office for his contributions to the IP community in 2003, an Award of Merit from AIPPI in 2011, and a Distinguished Service Medal from The Linn Inn Alliance of the American Inns of Court in 2013.

Dr Okuyama studied at Waseda University, Tokyo, Japan (B.E., Electrical Engineering, 1980); Iowa State University, Ames, Iowa (B.A., Chemistry, 1982); and the University of Chicago, Chicago, Illinois (Ph.D., Physical Chemistry, 1987).



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