Info ja keskustelutilaisuus: "Patenttiuudistus etenee – onko yrityksesi valmis?" – a biotech SME perspective -


Jukka Hiltunen, Ph.D. MBA
Chief IP Counsel
Glykos Finland Oy
Patents are **essential** for business
Patents are out-licensed or sold

- Technologies:
  - Antibody drug conjugates (ADC)
  - Glycomarkers and antibodies for stem cells, cancer and cancer stem cells
  - Glycoengineering of biomolecules and host cell organisms
  - Glykos Analytics
How to prepare for UPC?

- How do you commercialise your patents? (SME)
- How your clients commercialise their patents? (Big Pharma/Biotech)

**Patent value €**

- Actions taken not to decrease value (or actions taken even to increase the value)?
Decisions and actions!

- National route(s) or Euro-PCT?
- Opt-out (opt-in)?
  - Grantend EP patents
  - Pending applications
- EP or UP?
  - Filing divisionals
  - UP: no pruning vs EP bundle: pruning
  - UPC vs national courts (litigation)
  - Traditional SPCs vs Unitary SPC
  - Costs of validations vs markets covered: EP vs UP
National filings (to avoid UPC)?
Patentees shall have – finally – possibility to construct multilayered patent protection in Europe

- Filing (many) divisionals possible at low(er) cost because one translation - or few translations - required to cover Europe
  - Also in pharma patents
- Together with PACE and EPO initiatives – waiving R. 70(2) EPC, R. 70a(2) EPC, R. 161/162 EPC and R. 71(3) EPC – time to grant may be considerably shortened
SPCs

- Not single SPC for all UP countries, yet (but in future?)
- Opt-out / opt-in
- Current SPC regulation does not allow granting of national SPCs by national IP office on the basis of UP (SPC Regulation needs to be amended)
- Proprietors of both basic patent and of SPC must register opt-out
“Most of our patents will be UP” (a big pharma representative at a Life Science conference 2015)

Pessimistic big pharma perceptions on the UPC have started changing...

Good news for SMEs!
Decisions and actions?

- Patent filings strategy: priority (FI/EP) → PCT → EP → UP
  - Patent owner(s) correctly registered at the EPO (the first applicant in the registry matters)

- UP or EP – opt-out?
  - If at time of granting EP no clear commercial path ahead → UP
  - UP is better than few EP validations (i.e. ratified countries)
  - UP much cheaper compared to EP bundle of same country coverage (translations and annual fees)
  - Any hurdles of obtaining SPCs based on UP will be taken care of in near future!
  - Current granted EP patents opted out
  - Creation of multilayered protection by divisionals

- Business risk – injunctions vs central revocation
- Further emphasis on oppositions (UPC fees high [for SMEs])
- Business intelligence updated, competitor’s patent strategies [opt out, UP]

- In any case patent claims must be stronger, even further emphasis on determination of prior art
UPC is up and running in 2017...

- Thinking exercises / scenarios / simulations:
- Effects of UPC on your business
- Effects of UPC on your patent filing strategy and portfolio
  - Each technology sector different (IT, pharma, etc.)
  - SME vs big players (SME-Big, Big-Big)
  - Agreements
  - Competition
  - Litigation, forum shopping/selling, infringement criteria
  - Who are (will be) experts (UK, DE, FR attorneys)?

**You have to start making proactive decisions and taking actions**

PATENT VALUE €
ONLY BY PLAYING UPC YOU CAN PROSPER AND CONQUER!
Glykos Finland Oy
Viikinkaari 6
00790 Helsinki
Finland

Tel: +358 9 3193 6340

www.glykos.fi

Email: jukka.hiltunen@glykos.fi