



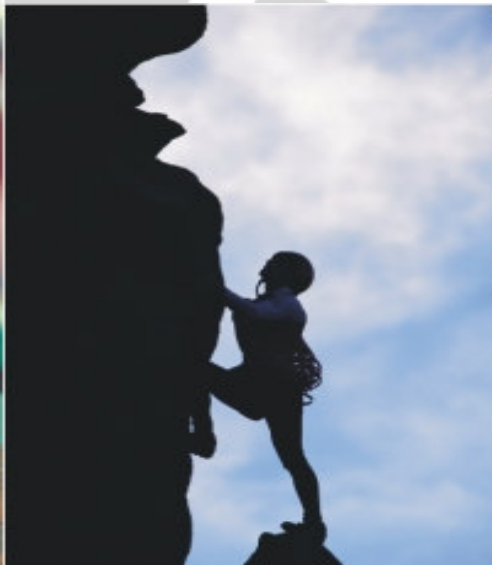
**AIPS**

ACADEMY OF  
INTELLECTUAL  
PROPERTY  
STUDIES



**WORKSHOP  
ON  
DRAFTING NON-INFRINGEMENT, FREEDOM TO OPERATE  
AND  
VALIDITY OPINIONS**

January 11- 14 , 2007



## INTRODUCTION :



**Freedom to operate opinion** : Freedom to operate analyses and addresses the question of whether you are free to produce your product or engage in your proposed activity without being blocked by someone else's patent(s). Such a freedom to operate analysis typically involves a search to identify relevant patents, and then careful analysis of the claims in those patents. Such an analysis can be used informally, or can be prepared in a formal freedom to operate opinion letter.

Since this considerably limits the chances of facing potentially risky and expensive patent litigation, all technology companies are well-advised to look into the matter early on in the research and commercialization process. In some cases, minor product adaptations or working around patents, or payment of a small licensing fee to the patent owner may be sufficient to avoid future disputes. Systematically evaluating your freedom to operate prior to launching a new product is, therefore, a way of minimizing (but not eliminating) the risk of your product infringing the patents owned by others.

**Non - Infringement opinion:** In addition to being used in freedom to operate analyses as just discussed, analyses concerning possible infringement of a patent may be useful in a variety of other situations that may arise later in a project or during practice of the invention. For example, this type of analysis may be useful if another patentee notifies you of a patent they own, and states or suggests that you are infringing that patent. The analysis is intended to determine whether you actually do or do not infringe any claim of that patent. On the other hand, you may be concerned with protecting your own patents. In this case, an infringement analysis may be useful after you have obtained a patent and you believe that someone may be infringing it. A non-infringement or infringement analysis will frequently include an analysis of the validity of the patent. This analysis includes consideration of potential defects in the description, prosecution history, and claims, as well as consideration of prior art that may affect validity of the patent claims.

## WORKSHOP OBJECTIVE:

This 4 day workshop aims to provide an insight into the issues considered while drafting the opinion and also provides hands on experience by making participants draft such agreements:



- Determine whether a patent is blocking and knowing your options if it is
- Legal principles applied for infringement analysis
- Elements of a typical non – infringement / freedom to operate opinion
- Anticipate how the *doctrine of equivalents* will be determined by a court of law in the US and EU
- Complete a claim construction analysis and present it – preparation of claim charts
- Drafting a Non- infringement / freedom to operate opinion.
- Prepare your in-house opinion and know when a second opinion by outside counsel is necessary
- Comparative example of claim interpretation
- Invalidity opinion

This in-depth, interactive workshop will provide you with practical and tactical advice from the perspective of both in-house and outside counsel on drafting opinion letters that will provide well-reasoned legal analysis within the context of freedom to operate and infringement opinions.

**Dates** : January 11- 14 , 2007 [ Thursday – Sunday]

**Venue:** Academy of Intellectual Property Studies, 2<sup>nd</sup> Floor, Metro House, Metro Estate, Vidya Nagari Marg, Kalina, Mumbai 400 098. **Tel:** 65221097 / 26509035 **Email:** [info@aips.ac.in](mailto:info@aips.ac.in)

**Fees:** Rs 15,000 – [early bird] until December 15

Rs. 20,000 – after December 15.

## **FACULTY:**

Our speakers have had extensive experience in opinion letters and also litigations. Their experience of more than a decade on both prosecution as well as litigation gives the added advantage while analyzing the claims. They are the leaders in this field.

### **Matthew K. Ryan**



Matthew K. Ryan is one of the founding partners of Frommer Lawrence & Haug LLP. He has extensive experience in litigation, prosecution, transactional matters and client counseling with respect to intellectual property.

Mr. Ryan represents multinational and emerging companies in a wide range of high- and low-technology areas. He has represented these clients in numerous state and federal courts at both the trial and appellate levels. In addition, Mr. Ryan supervises an aggressive prosecution practice for these clients in proceedings before the U.S. Patent and Trademark Office and assists in representing these clients before various international patent authorities. He also regularly counsels these clients in complex business matters and transactions, including drafting and negotiating research and development, sales and license agreements. Prior to the founding of Frommer Lawrence & Haug LLP, Mr. Ryan was a partner in the law firm of Curtis, Morris & Safford P.C.

### **Dr. Heinz Goddar**

Dr. Heinz Goddar is a German Patent Attorney and European Patent and Trademark Attorney. He is a Partner of Boehmert & Boehmert and of Forrester & Boehmert, Munich. He is one of the senior partners of his firm and is particularly involved in international patent and licensing matters, including litigation and arbitration. He is an Associate Judge at the Senate for Patent Attorneys Matters at the German Federal Court of Justice and a Senior Advisor to the German Industrial Investment Council (IIC), Berlin, with a specific responsibility for IIC Life Sciences and Chemical. Dr. Goddar has a Technical background (as well as PhD degree) in physics and physical chemistry. Before his career as a patent attorney, he was Assistant Professor at the Polymer Department of the University of Mainz, Germany. He presently teaches Patent and Licensing Law as a Lecturer at the University of Bremen, Germany, the Munich Intellectual Property Law Center (MIPLC), Munich, Germany, and as a Visiting Professor at the University of Santa Clara, CA, U.S.A., the University of Washington, Seattle, WA, U.S.A., and the National ChengChi University, Taipei. And the Academy of Intellectual Property Studies, Mumbai. Dr. Goddar is a Past President of LES International and of LES Germany.



### **Dr. B. N. Roy**

Dr. Roy has obtained his PhD in the U.S., and is a leading expert in the field of Synthetic Organic Chemistry. Currently associated with Lupin Laboratories Ltd, he is their Technical Adviser also looking after their research programmes. Dr. Roy handles the Intellectual Property functions of the organization involving novelty studies, drafting, prosecution of patent applications, infringement, opposition and revocation proceedings, litigations, etc. A speaker at various Patent forums, Dr. Roy regularly contributes papers on patent matters. He is also a faculty to the Academy of Intellectual Property Studies.

### **Mr. H. Subramaniam**



Mr. H. Subramaniam, holder of a first-class degree in both Science and Law from Delhi University (Gold Medallist), is a leading Intellectual Property Attorney with over 25 years experience. Mr. Subramaniam has extensive experience in researching scientific documents. He commenced his practice with Remfry & Sagar, one of the oldest Patent and Trademark Attorney firms in the world, and was with them for nearly sixteen years. A major part of this tenure was as Head of its Patent and Designs Department. Mr. Subramaniam is on the teaching faculty of TIFAC and Indian Law Institute. He is a regular guest speaker at CII, various educational Institutions and

Universities and is a member of the working group of the CII on GATT/TRIPS related issues. Presently, he is Senior Partner of a Delhi based IP Law Firm Subramaniam, Natraj and Associates.