



AA THORNTON

INTELLECTUAL PROPERTY LAW

# Pharmaceuticals & Biotechnology

It's our people that make the difference

## About us

We are a leading firm of Intellectual Property (IP) professionals, including UK Chartered and European Patent Attorneys, UK Chartered and European Trade Mark Attorneys and IP Solicitors, based in London. We have been providing specialist advice and IP services to our clients since 1911, when the firm was founded by former president of The Chartered Institute of Patent Agents (CIPA), Alfred Augustus Thornton.

We combine our individual experience, technical ability and legal knowledge to work as flexible, integrated teams. This ensures that our clients receive an excellent service that meets their commercial aims.

Our corporate vision is “To be *your* preferred Intellectual Property Firm”, and we are committed to providing every client with a personalised and client focused service.

As part of our ongoing commitment to ensure that our clients’ needs and wishes can be effectively addressed, we are very pleased to be the only UK IP firm invited by the EPO President to join the European Patent Office’s new Quality Working Group for 2017-2020. This enables us to provide feedback on behalf of our clients and to represent their concerns in front of the Standing Advisory Committee before the European Patent Office (SACEPO).

We are delighted to have been consistently ranked by Legal 500 UK as a “Leading Firm”. Our IP professionals are regularly recommended in WTR 1000 World’s Leading Trade Mark Professionals, Who’s Who Legal and Managing IP’s IPStars.

## Our values



**IP INCLUSIVE**  
Working for diversity and inclusion in IP

We are delighted to be involved with IP Inclusive, which is an organisation that promotes diversity and inclusion within the various IP professions. AA Thornton were among the first signatories to the IP Inclusive charter, which is part of our ongoing commitment to improving diversity and inclusion. We take an active lead in IP Inclusive, such as the project to promote careers in IP to schools and universities through the “Careers in Ideas” initiative.

## Our expertise

The firm's Chemistry, Biotechnology and Pharmaceuticals team enjoys an international reputation, and benefits from attorneys and solicitors from a wide range of professional and academic backgrounds. A number of our professionals have previously held in-house positions within the pharmaceutical industry and we actively leverage this experience across the team.

The diverse professional skill set of our team members means that we are well placed to provide advice on both contentious and non-contentious issues across the full spectrum of patent matters.

Collectively, we are proud to have represented a wide range of companies within the pharmaceutical and biotechnology industry, from universities and SMEs to large multi-national corporations.

We are a friendly and approachable team with an open and collaborative working style. Clients tell us that they value our understanding of their businesses, and the holistic approach that we take to the assessment of the legal, commercial and regulatory issues which affect them. We work regularly alongside in-house legal counsel, but are equally comfortable liaising directly, for example with colleagues in R&D, Business Development, Regulatory and Commercial affairs. Quite simply, our aim is to integrate seamlessly as a trusted adviser upon whom anyone can call.

## Our clients in the sector

We are proud to have a significant number of long-standing clients based worldwide with whom we have very strong relationships. Our approach is always to ensure that we provide our services in a way which complements each and every client, and reflects their preferred way of working. This involves creating close relationships with individuals and teams at our clients, and significant effort is invested to develop these through regular client visits and international travel wherever in the world they are based.

Here are some of the Pharmaceuticals & Biotechnology clients we represent:



Merck



Bial



Cipla



Germains



Hovione International



King's College London



Meda Pharma



Medimop Medical Projects



Merix Pharmaceutical



Orbel Health

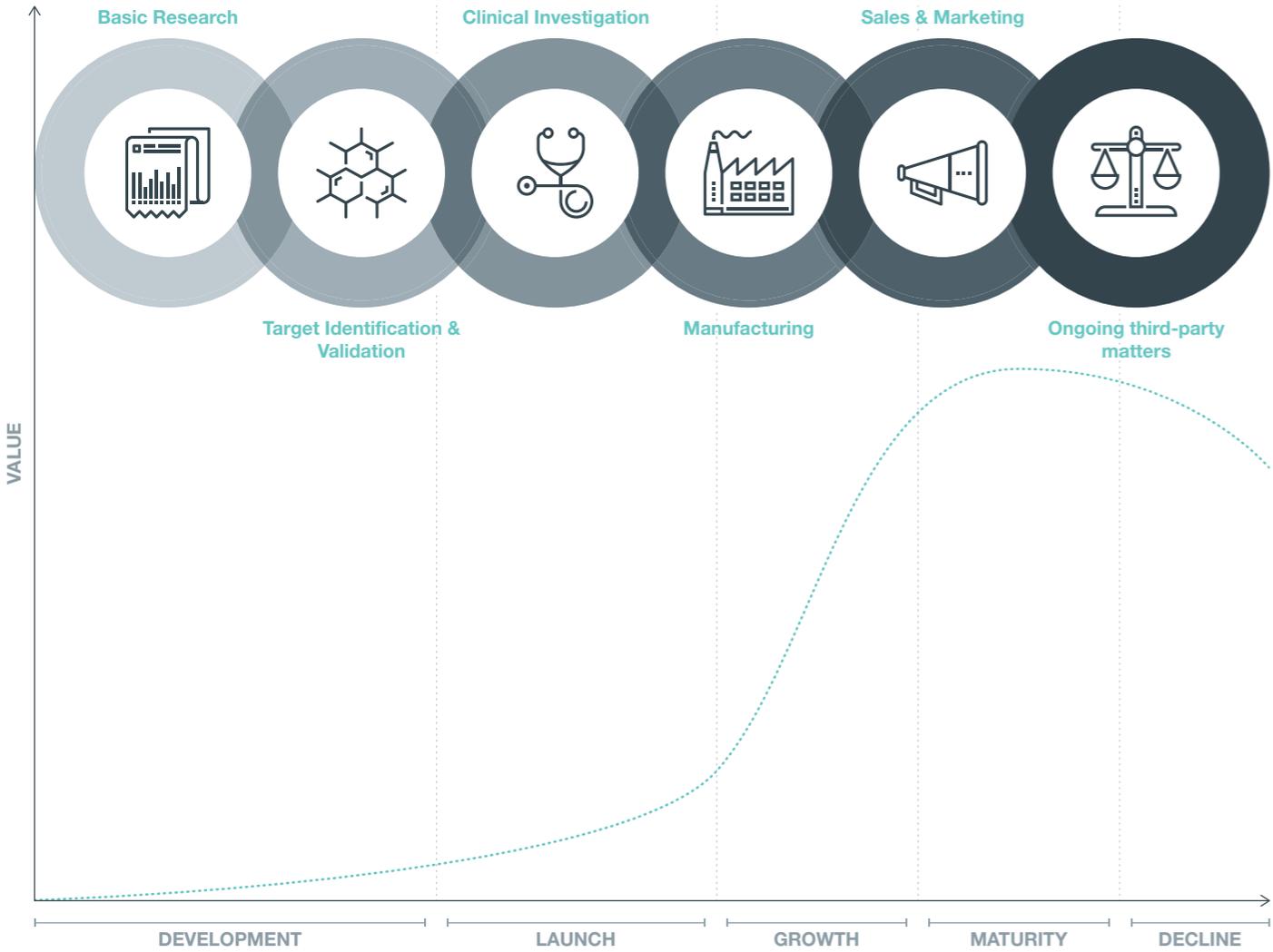


RB (formerly Reckitt Benckiser)



RSR

# Our support to you at each stage of your product life cycle



<p><b>Basic Research</b></p> <ul style="list-style-type: none"> <li>Subject-matter searches</li> <li>Competitor landscaping</li> <li>Identify potential alliances</li> <li>Freedom-to-operate advice</li> <li>Ownership/entitlement determinations</li> <li>Agreements and advice regarding alliances</li> </ul>	<p><b>Clinical Investigation</b></p> <ul style="list-style-type: none"> <li>Continued patent prosecution</li> <li>Global strategic programme</li> <li>Additional and defensive patent applications</li> <li>Uses, formulations, dosage regimes, batch processes</li> <li>Updated freedom-to-operate/validity opinions</li> </ul>	<p><b>Sales &amp; Marketing</b></p> <ul style="list-style-type: none"> <li>Patent term extension/restoration activity: SPCs, US Bolar/Waxmann-Hatch, etc.</li> <li>Data/market exclusivity considerations</li> <li>Competitor IP response scrutiny</li> <li>Patent maintenance &amp; renewals</li> <li>Portfolio status reports</li> <li>Litigation – enforcement</li> </ul>
<p><b>Target Identification &amp; Validation</b></p> <ul style="list-style-type: none"> <li>Validity and patentability advice</li> <li>Patent drafting</li> <li>IP strategy advice</li> <li>Patent filings – priority and global</li> <li>Product, process, formulation, use protection</li> <li>Further freedom-to-operate/entitlement opinions</li> </ul>	<p><b>Manufacturing</b></p> <ul style="list-style-type: none"> <li>Additional patent applications: full-scale manufacturing processes – conditions, apparatus techniques, packaging</li> <li>Specific label protection</li> <li>Updated freedom-to-operate review</li> </ul>	<p><b>Ongoing third-party matters</b></p> <ul style="list-style-type: none"> <li>Follow-on/improvements</li> <li>Patent strategy</li> <li>Licensing/strategic alliance IP support</li> <li>Due diligence/audits</li> <li>Venture capital support</li> <li>Enforcement – infringement/entitlement</li> <li>Litigation – oppositions/revocation</li> </ul>

# Our key team members



**Dr Craig Turner**  
Partner, Patent Attorney

Craig is a Partner and has a wide-ranging practice covering both contentious and non-contentious patent work in the fields of pharmaceuticals, chemistry, biotechnology, and chemical engineering. His clients include large corporations in the pharmaceuticals, biotechnology, and oil and gas industry sectors, as well as SMEs. Craig’s work also includes antibody technology and he is currently actively involved in litigation in this field. He has considerable experience in both EPO patent opposition and appeal work, particularly for pharmaceuticals and medical devices, and in giving freedom to operate advice. He also handles Supplementary Protection Certificates in respect of pharmaceuticals.

**A selection of Craig’s key clients include:**

- [Cipla Ltd](#)
- [Neolab](#)
- [Meda Pharma](#)
- [Teva](#)
- [Hovione International Ltd](#)
- [RSR Limited](#)
- [BenevolentAI](#)
- [RB \(formerly Reckitt Benckiser\)](#)



*“According to clients, Craig Turner’s main strength is ‘his ability to quickly understand complex applications’ in the fields of chemistry, chemical engineering, pharmaceuticals and biotechnology.”*  
**Legal 500**



**Dr Lawrence King**  
Partner, Patent Attorney

Lawrence previously worked in-house within the Intellectual Property Department of [GlaxoSmithKline](#) for eight years, and is particularly valued by clients for his understanding of the role of in-house counsel and the commercial application of intellectual property in the life sciences field. Lawrence’s existing practice includes drafting and prosecuting patent applications for a broad range of technologies on a worldwide basis. Lawrence also has considerable experience of providing strategic advice in respect of patent infringement and validity, handling patent opposition matters, and undertaking due diligence assessments of third party IP for licensing and acquisition purposes.

**A selection of Lawrence’s key clients include:**

- [Bial – Portela](#)
- [Hovione International](#)
- [Cipla Ltd](#)
- [Chevron Phillips Chemical Company \(CPCChem\)](#)
- [Associated British Foods Plc](#)



*Lawrence King is “very knowledgeable both in Chemistry and in IP law”*  
**Legal 500**

## Geoff Hussey Partner, Solicitor



Geoff Hussey is a Partner and Solicitor whose practice areas are IP litigation and commercial IP. His experience includes acting for a broad range of clients in many sectors including pharmaceuticals and biotechnology (where he has natural focus as a result of his technical background), chemicals, electronics, telecoms, aviation, food & beverages and financial services.

Geoff has extensive experience in patent litigation before the UK Patents Court, Court of Appeal, and in EPO patent oppositions concerning pharmaceuticals and medical devices including the coordination of parallel proceedings across many jurisdictions in Europe and the US. Geoff's contentious IP experience also covers design rights as well as trade marks, passing off, copyright, and breach of contract disputes involving IP.

Geoff has advised many life sciences clients including [Gilead](#), [Cipla Ltd](#), [Bial – Portela](#), [Dr Reddy's](#), [Pfizer](#), [ConvaTec](#) and [Coopervision](#).

### Some of Geoff's notable life sciences cases include:

- Napp Pharmaceuticals v Dr Reddy's & Sandoz (buprenorphine patch patent infringement)
- Smith & Nephew v ConvaTec (gel-forming silverised wound dressing patent validity, infringement and EPO opposition)
- GE Healthcare v PerkinElmer (scintillation proximity assay patent revocation and entitlement)

Geoff has a degree in Genetics from the University of Nottingham.



*"Following the arrival of IP litigator Geoff Hussey, who joined from Bird & Bird LLP, the team is increasingly handling high-stakes contentious patent cases."*

Legal 500

## Rachel Havard Partner, Trade Mark Attorney



Rachel Havard is a Partner and a UK Chartered Trade Mark Attorney and European Trade Mark and Designs Attorney. Rachel handles a wide range of UK and international trade mark cases, and has significant experience of clearing trade marks for use and registration, and in negotiating and drafting trade mark co-existence agreements. Her portfolio of clients covers a variety of sectors, including fashion retail, oil & gas and automotives, but she has enjoyed much involvement in the clearance and protection of pharmaceutical trade marks.

Rachel is a member of PTMG (Pharmaceutical Trade Marks Group) as well as INTA (International Trademark Association) and is a regular attendee of their conferences.

### A selection of Rachel's key clients include:

- [Hovione Scientia Limited](#)
- [Hovione FarmaCiencia S.A.](#)
- [Otsuka Pharmaceutical Co., Ltd.](#)
- [Mayne Pharma International Pty Ltd](#)



*"Rachel Havard is 'very thorough' and 'recommended for her handling of a wide range of UK and international trade mark cases'."*

Legal 500

## Marianne Privett

Partner, Patent Attorney



Marianne began her patent career in 2003 at [Johnson Matthey](#). Whilst at [Johnson Matthey](#), Marianne helped draft and prosecute patent applications relating to platinum-based anti-cancer pharmaceutical products, opiate and opioid pharmaceutical products, pharmaceutical compositions and pharmaceutical manufacturing processes, and helped to manage global patent portfolios in a range of technical fields.

She moved into private practice in 2007 and has subsequently gained further experience in life sciences and biotechnology. Marianne currently works in the fields of chemistry, pharmaceuticals and biotechnology.

**A selection of Marianne's key clients include:**

- [Hovione International Ltd](#)
- [Cipla Ltd](#)
- [Ohio State University Research Foundation](#)
- [Helix Biomedix Inc.](#)

## Alex Bone

Partner, Patent Attorney



Alex joined the firm following seven years working in-house at [Novartis Pharmaceuticals Ltd](#) where he was responsible for IP support relating to medical delivery devices (particularly inhalation devices and auto injectors) and packaging projects across the Pharma division, as well as for a post-launch respiratory therapeutic product. During his time at [Novartis](#) he was responsible for developing and implementing an IP strategy for device IP, and was involved in the due diligence process and subsequent IP integration for a number of acquisitions, including the pulmonary division of [Nektar Therapeutics](#) and the UK diagnostics device company [Vivacta Limited](#).

Since joining the firm, Alex has been involved with assisting [Cipla](#) in the identification of potentially patentable subject matter in their device developments, conducting freedom to operate searches, and the preparation and prosecution of patent applications directed to some of those developments.

**A selection of Alex's key clients include:**

- [Hovione Scientia Limited](#)
- [Hovione FarmaCiencia S.A.](#)
- [Otsuka Pharmaceutical Co., Ltd.](#)
- [Mayne Pharma International Pty Ltd](#)

## Julie Barrett-Major Consulting Attorney



Julie is the firm's Consulting Attorney in our Chemistry, Biotechnology and Pharmaceuticals patent team.

Julie began training in 1979 at The Wellcome Foundation Ltd (now [GSK](#)) and qualified there in 1981. Thereafter, she moved to [Sandoz AG](#) (now [Novartis](#)) in Basel. Later at [Merck & Co., Inc.](#), including a period as Acting Head of the European Patent Department, Julie was specifically involved in proposing, developing and implementing the Supplementary Protection Certificate regime in Europe. As a member of Council of the Chartered Institute of Patent Attorneys, she also took part in the development of the EU Biotechnology Directive and rights of audience in the English courts.

Given her long experience, particularly in-house, Julie brings a strong commercial and business strategy focus to the whole gamut of IP. Whether in specification or claim drafting and amendment, opinion work, oral proceedings, managing litigation (including US discovery proceedings), auditing organisations' IP portfolios with a view to rationalising these intangible assets to fit financial

and commercial objectives, analysing licensing opportunities and undertaking due diligence, representing IP holders to venture capitalists/bankers, or advising on and undertaking global patent filing programmes, she is always mindful of the aims of the client's organisational and business interests.

### A selection of Julie's previous clients include:

- [Boots plc](#)
- [GlaxoWellcome \(now GSK\)](#)
- [Pfizer](#)
- [Reckitt & Colman \(now RB\)](#)
- [ICI Paints \(now Akzo-Nobel\)](#)
- [Johnson Matthey](#)
- [Smith & Nephew](#)
- [Inpharma \(Norway\)](#)
- [Beacon Pharma](#)
- [Dabur Oncology \(India\)](#)
- [Fermenta Biotech \(India\)](#)
- [Max India](#)
- [Siegfried \(Switzerland\)](#)
- [Trinity Pharma \(S Africa\)](#)

Most recently, Julie founded and then directed the IP department at [Norgine Ltd](#), a European specialty pharmaceutical company having a significant in-and out-licensing, venture capital, and late-stage clinical and commercial development focus.



**Varuni Parnavitane**  
Associate, Solicitor

Varuni qualified as a solicitor in 2011 and was involved in a global patent litigation co-ordination project for [Novartis](#) for several years during her time at Bristows. She has also gained experience in UK high court actions. Varuni has advised on both regulatory law aspects from a medical devices point of view and on life sciences corporate transactions from an IP perspective. She has published articles on various aspects of IP law in the pharmaceuticals sector, such as on patentability of DNA.

Varuni began her career studying Biochemistry at Imperial College and followed on to a PhD and research career studying cell signalling pathways at Cambridge University. She identified a novel signalling protein involved in the kinase pathways which impact upon cancer and cell survival, and published her research in peer reviewed journals. She sits on the Intellectual Property Advisory Committee of the UK BiIndustry Association.



**Leonita Paulraj**  
Associate, Patent Attorney

Leonita began her patent career in 2000 at De Penning & De Penning in India and subsequently joined AA Thornton.

Leonita has specialist expertise in pharmaceuticals, agrochemicals and life sciences. Leonita is also a registered Indian Patent and Design Attorney with seventeen years of experience in providing patent development and strategic advice; drafting and prosecuting patent applications; and filing and defending oppositions at the Indian Patent Office. She has worked on a large number of [Hoffmann-La Roche AG](#) cases (including opposition matters) in India. Other pharmaceutical clients with whom she has worked include [Schering Plough](#), [Novartis AF](#), and [Aventis Pharma \(Sanofi\)](#).

“

A.A. Thornton & Co.'s level of service is **'outstanding'** – 'timeliness and appropriateness of advice are a constant' according to clients, who rate the level of scientific knowledge displayed by the partners and associate lawyers as **'excellent'**.

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Legal 500

## More about our services and expertise



### Patents

Our patent attorneys have a wealth of experience in all aspects of patent law, and can advise across a wide and diverse range of technical areas.

- Chemistry, Biotechnology & Pharmaceuticals
- Electrical Engineering, Electronics, Telecoms & IT
- Engineering, Physics & Mechanical Devices

Whether you are a sole inventor or large corporation, protecting your ideas is vital. Our European and UK Patent Attorneys can act on your behalf, presenting your case to the UK Intellectual Property Office (UK IPO), the European Patent Office (EPO) and the World Intellectual Property Office (WIPO). Thanks to our network of associates overseas, we can advise on different patent laws and protect or defend you anywhere in the world.



### IP Transactions, Ownership & Licensing

We regularly advise clients in relation to commercialising their IP. When entering into negotiations for contracts involving IP it is important that clients' interests are protected and that the appropriate rights are secured in the transaction.

We have the experience and focus to help guide you through what is a technical legal area to achieve a result that meets your commercial aims for all of your non-contentious IP requirements.

#### Our services include:

- Drafting assignments and licences
- IP contract reviews
- IP due diligence
- IP audits
- Developing IP ownership and licensing structures
- Dispute settlement agreements
- Recording transactions at Intellectual Property Offices



## IP Strategy & Audits

We will work with you to put in place effective strategies for the protection and commercialisation of your IP.

**Our services include:**

- IP audits
- IP due diligence
- IP portfolio management and maintenance advice
- Project reviews to identify potential IP
- Strategy reviews
- IP litigation strategic advice
- Marketplace and competitor surveillance
- Advice on upcoming Unified Patent Court opt-outs
- Parallel imports – advice, reviews, procedures



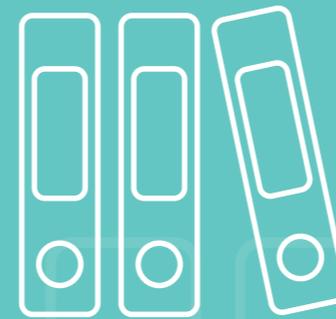
## IP Litigation

Our IP litigation and legal department advises on all aspects of IP law. Our experience and expertise ranges from dealing with small IP disputes (often resolved in negotiation), to hard-fought high-value IP litigation and coordinating parallel actions in other jurisdictions.

Our litigation approach is, where appropriate, for IP solicitors to work closely with our patent or trade mark attorneys to provide a coordinated approach to both enforcement and protection – ensuring the best possible resolution of IP disputes. The strength of our collective technical expertise also ensures that we can understand the necessary complexities involved in each case.

**Our services include:**

- IP portfolio and litigation strategies
- Patent litigation
- Trade mark, copyright and design right litigation
- Arbitration and mediation
- Licensing disputes
- Coordinating with local counsel in parallel actions around the world
- Settlement advice



## Trade Mark, Design and Copyright Portfolio Management

Our patent and trade mark attorneys regularly advise on IP portfolio management, with a focus on alignment with each client's overall corporate objectives and strategy.

We understand the need to review expenditure, IP asset value and portfolio management decisions on a regular basis, and to check alignment with the current business objectives and market conditions. We approach this with a desire to understand your business needs and to provide a solution that achieves your objectives efficiently and cost-effectively.



## IP Due Diligence & Freedom to Operate or Freedom to Use

We have considerable experience advising clients in relation to commercial due diligence activities across the full spectrum of IP rights. Clients value our commercial focus and attention to detail in helping them to evaluate and realise new business opportunities.

**Our services include:**

- IP due diligence for clients seeking to commercialise their own IP
- IP due diligence for clients seeking to acquire third party IP
- Freedom-to-operate or freedom-to-use assessments



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The information in this booklet is general information only and is not intended to constitute legal advice. If you wish to explore protection and associated costs for any of the types of intellectual property discussed, please contact one of our patent, trade mark or design attorneys. September 2018.