

Dr. Frederick Ch'en

Office Managing Partner
Tokyo

Biography

For over 15 years, Dr. Frederick Ch'en has combined his scientific training and cultural background to advise on a broad range of contentious and non-contentious IP matters, especially in the life sciences area. His particular focus is multijurisdictional patent litigation, which also allows him to assist more pragmatically on IP licensing and IP aspects of transactions (e.g., M&A, private equity, and corporate finance).

A former research scientist at Oxford University (with the top First Class Honours degree in Molecular and Cellular Biochemistry (Balliol College) and a doctorate in Medical Sciences (Merton College)), Frederick brings technical insight into clients' disputes or transactions coupled with cross-border perspectives that stem from having been raised in four different cultures.

Frederick is a solicitor (England & Wales), U.S. attorney (California), U.S. patent attorney, a registered foreign attorney in Japan, and a U.K. chartered biologist. He has been recognised as a leading practitioner by various publications, including *Chambers Asia*, *Legal 500*, and *MIP*. *Chambers Asia* calls him "an exceptional IP specialist" and "meticulous, responsive, and comfortable working on complex matters in multiple jurisdictions," and *Legal 500 Asia Pacific* an "excellent advisor," "responsive and experienced," "diligent and talented," and someone who "can easily understand the technical issues and is very good at figuring out a solution."

Prior to joining Hogan Lovells, Frederick was head of IP



Phone

+81 3 5157 8263

Fax

+81 3 5157 8210

Email

frederick.chen@hoganlovells.com

Languages

English
Japanese

Practices

Commercial
Intellectual Property
Patents
Pharmaceuticals and Biotechnology
Regulatory
Trade Secrets and Confidential
Know-how
Blockchain and DLT
IP Litigation, Arbitration, and
Alternative Dispute Resolution

in the Tokyo office of another top-tier law firm (2010-2013), having initially trained and worked for seven years in the London office of a top-tier "Magic Circle" international law firm. He is a member of AIPPI Japan, the Licensing Executive Society in Japan, and Pharma Delegates. Frederick speaks English and Japanese.

Representative experience

Acting for various Japanese and non-Japanese companies with commercial disputes, most recently arbitration matters (ICC and LCIA) in the Life Sciences and Energy sectors, as well as civil litigation in conjunction with Japanese *bengoshi*

Acting for various global originator pharmaceutical companies in relation to numerous patent disputes in Japan, including patent invalidation actions before the Japan Patent Office, appeals before the IP High Court and patent infringement proceedings (as claimant and defendant) before the Tokyo District Court in conjunction with Japanese *bengoshi* lawyers

Acting for a Japanese pharmaceutical company in relation to its European strategy for filing Supplementary Protection Certificates in 26 countries

Acting for a Japanese pharmaceutical company in relation to regulatory data exclusivity in Europe and the U.S.

Acting for a Japanese pharmaceutical company in relation to patent infringement proceedings against three generic companies in Hong Kong

Acting for a Japanese life sciences company in relation to contract negotiations with a U.S. counterparty

Acting for a Japanese life sciences company in relation to a patent licence from a U.S. counterparty

Acting for a Japanese engineering company in relation to its licensing negotiations with a European university in respect of joint research, development and exploitation

Acting for a Japanese electronics company in relation to UK patent litigation proceedings

Industries

Life Sciences and Health Care

Areas of focus

Cell, Tissue, and Gene Therapies

IP Licensing, Commercialization, and Technology Transfer

IP Rights in Transactions

Pharmaceuticals and Biotechnology

Regulatory Exclusivities, Hatch-Waxman, and Similar Statutes

Strategic Counseling and Portfolio Development

Technology Contracts

Education and admissions

Education

Pg.D.I.P.L.P. (Intellectual Property Law & Practice), University of Bristol

Pg.D.L.P., Oxford Institute of Legal Practice

D.Phil., University of Oxford, Merton College

Pg.D.L., Oxford Brookes University

M.Biochem. (Molecular and Cellular Biochemistry), University of Oxford, Balliol College, First Class Honours

Memberships

Member and Editorial Board

Member, AIPPI (Japan)

Member, Licensing Executive Society (Japan)

Member, Pharma Delegates (Japan)

Acting for a Japanese technology company in relation to its global trademark and brand licensing

Acting for a European pharmaceutical company in relation to the assignment and licence-back of certain patents from a Japanese pharmaceutical company in the context of its multi-million US dollar acquisition by a U.S. pharmaceutical company

Acting for Merck & Co., Inc. in relation to defending patent revocation proceedings in relation to its enzyme inhibitor product (finasteride), a ground-breaking case that changed the English law on the patentability of dosing regimens and the rules of precedent in the UK Court of Appeal

Awards and rankings

- Sole winner of Client Choice Award for Patents in Japan, *International Law Office*, 2017, 2018, 2021
- Leading individual for Intellectual Property in Japan, *Chambers Asia-Pacific*, 2012-2021
- Leading individual for Life Sciences in Japan, *Chambers Asia-Pacific*, 2018-2021
- Leading individual in Intellectual Property, *Legal 500 Asia-Pacific*, 2019-2022
- Leading individual for Intellectual Property in Japan, *Chambers Global*, 2011-2021
- Global IP Star, *Managing Intellectual Property IP Stars*, 2018
- Patent Star in Japan, *Managing Intellectual Property IP Stars*, 2014-2021
- Leading individual for Patent Transactions and Patent Litigation in Japan, *IAM Patent 1000*, 2017-2021
- The Best Lawyers in Japan, Intellectual Property, *Best Lawyers*, 2015-2022
- "The Lawyer of the Year" in Japan, Life Sciences Practice, *Best Lawyers*, 2020
- The Best Lawyers in Japan, Life Sciences Practice, *Best Lawyers*, 2020-2022
- Leading individual in IP, *Who's Who Legal Japan*, 2017-2020

Member and Chartered Biologist,
Royal Society of Biology (UK)

Member, Biochemical Society (UK)

Bar admissions and qualifications

Solicitor, England and Wales

California

U.S. Patent and Trademark Office

Japan - Daiichi Tokyo Bar Association (Gaikokuho Jimu Bengoshi)

Court admissions

Senior Courts of England and Wales

- Leading individual in Life Sciences, *Who's Who Legal Japan*, 2018-2020
- Patent Leader, *World IP Review*, 2017-2021
- Foreign Lawyer of the Year, *Asian Legal Business Japan Law Awards*, 2020
- Global Elite Thought Leader in Patent Litigation, *Who's Who Legal Japan*, 2021

Latest thinking and events

- Webinar
 - Select IP with Hogan Lovells | Webinar no. 10: IP Transactions: JV, R&D agreements, collaboration agreements, and related contractual arrangements (Part II)
- Press Releases
 - Hogan Lovells' Tokyo Office Managing Partner Dr Frederick Ch'en named as one of Asia's Top 15 IP Lawyers 2021 by Asian Legal Business
- Webinar
 - Select IP with Hogan Lovells | Webinar no. 9: IP Transactions: JV, R&D agreements, collaboration agreements, and related contractual arrangements (Part I)
- Webinar
 - Select IP with Hogan Lovells | Webinar no. 8: Patent Litigation: Discovery & evidence-gathering (Part II)
- Webinar
 - Select IP with Hogan Lovells | Webinar no. 7: Patent Litigation: Discovery & evidence-gathering (Part I)
- Webinar
 - Select IP with Hogan Lovells | Webinar no. 6: Cross-over topics: Brexit