



DR. TOBIAS HAHN

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Tobias Hahn has worked as an attorney since 2004 and advises German and international clients in all matters of intellectual property. He specialises in national and international patent litigation as well as subsequent proceedings for damages. He also has long-standing experience in unfair competition and pass-off litigation. He mainly litigates in the areas of telecommunications, electronics, medical devices, pharmaceuticals, automotive and mechanics.

A significant part of his practice focuses on litigation involving standard-relevant patents. He advises and represents several international telecommunication companies regarding "FRAND" and antitrust defences. He further represents clients in opposition, revocation and nullity proceedings before the German and European Patent Offices, the German Patent Court and the German Federal Court of Justice and in advises clients in arbitration proceedings. Moreover, he has extensive experience in drafting and negotiating patent and copyright licence agreements, R&D contracts, software agreements and know-how agreements.

Since his studies at the Universities of Heidelberg and Leeds (UK) he has specialised in intellectual property law. During his legal traineeship, he continued this specialisation while working for several international law firms. His PhD, which he obtained from the Free University Berlin, dealt with the liability of companies for acts of unfair competition by third parties.

Tobias regularly publishes on current issues of intellectual property and procedural law and has written a procedural commentary on inspection proceedings. He is a co-author of the e-learning module on patent litigation of the European Patent Academy of the European Patent Office for the Judicial Training of, inter alia, future judges of the Unified Patent Court. He is also a frequent speaker at conferences on patent law and licensing and is a visiting lecturer for patent law at the Hagen Law School, Germany.

REPRESENTATIVE MATTERS

- Representing one of the major international mobile telecommunications companies in multi-patent litigation relating to standard-essential and implementation patents (2014 - present)
- Representing a leading global supplier of automotive technology in extensive multi-jurisdiction and multi-patent litigation relating to navigation systems (2011-2012) and windscreen wipers (2014) right up to the Federal Court of Justice
- Representing a major mobile phone producer in arbitration proceedings relating to a patent license agreement, involving

significant antitrust issues and the question of how to determine FRAND (2012 - present)

- Representing a major UK communications and equipment provider against the technology leader in test, measurement and communication equipment in multi-patent litigation. (2012 - present)
- Representing a long-standing German medical devices company against several competitors in litigation involving patents, trademarks, pass-off and regulatory issues (2012 - present)
- Representing and advising a major mobile network operator in multi-patent litigation based on standard-essential patents, particularly in relation to antitrust and FRAND issues (2009-2013)
- Acting for a German software company in licensing negotiations relating to a major procurement for photocopiers (2013)
- Representing a global pharmaceutical player in preliminary injunction proceedings regarding second medical use claims (2013)
- Representing a supplier of TETRA radio communications networks in multi-patent litigation and achieving landmark decisions on the scope of indirect infringement (2012-2013)

PUBLICATIONS

- Hahn/Breuer (2015), „Ausstellen auf internationaler Leitmesse im Inland“, GRUR-Prax 2015, 187
- Hahn in: Ceppl/Voß, Prozesskommentar zum Gewerblichen Rechtsschutz, §§ 484 - 494a (procedural commentary on inspection proceedings), C.H Beck (2015)
- Reimann/Köhler/Hahn, „International Patent Litigation, Global Law and Business, 2nd ed. (2015)
- “A powerful tool (Preliminary injunction proceedings in Germany)”, The Patent Lawyer (2014)
- Hahn/Richter, Patent- und Gebrauchsmusterverletzung, BWV, 3rd ed. (2013)
- Hahn, Judgement Review Federal Court of Justice (BGH), XZB 19/12 - Kommunikationsrouter, GRUR-Prax (2014), 458
- Hahn, „Nach der BGH-Entscheidung ‘MPEG-2-Videosignalcodierung’: Verschärfte Anforderungen an mittelbare Patentverletzung“, GRUR-Prax (2013), 261
- Hahn, Judgement Review Federal Court of Justice (BGH), decision of 20.12.2011 - Installiereinrichtung II, GRUR-Prax (2012), 167
- Hahn, “Ändert der BGH seine “Voreinstellung” zur Haftung des Unternehmensinhabers für Wettbewerbsverstöße Dritter”, GRUR-Prax (2011), 412
- „Reimann/Hahn, Orange-Book - Ratgeber oder Buch mit sieben Siegeln?“ Festschrift for von Meibom (2010)
- Haft/Hahn et al, “Litigating standard-essential patents - FRAND and antitrust implications”, Managing IP (2009)
- "Liability of the owner of a company according to Sec. 8 (2) German Unfair Competition Act, Carl Heymanns Verlag (2007)

SPEAKING ENGAGEMENTS

- Visiting lecturer for patent law, Hagen Law School
- Regular speaker at the Fordham IP Conference (NYC) on SEPs, FRAND and privateering (2012 - present)

- Regular speaker at IBC's annual Standards & Patents Conference, London on international SEP Litigation (2011 - present)
- Licensing Executive Society (LES): Licensing Projects, Presentation of Module I: Introduction to the exploitation of intellectual property rights, 19.02.2016, Stuttgart
- IBC Biotech & Pharmaceutical Patenting 2014, Munich: Second medical use & dosing regimens

PROFESSIONAL AFFILIATIONS

- Intellectual Property Owners Association (IPO), Member of the Antitrust and European Practice Committees
- European Patent Lawyers Association (EPLAW)
- Licensing Executives Society (LES)
- Association of Intellectual Property Experts (VPP)
- German Association for the Protection of Intellectual Property (GRUR)

WHAT OTHERS SAY

- "Often recommended" JUVE Handbuch 2015/2016
- "Brilliant technically and tactically", Tobias Hahn "is a pleasure to deal with and a joy to work with." IAM Patent 1000 - 2014
- "efficient and reliable", Client JUVE Handbook 2014/2015
- One in-house counsel enthuses: "He has shown a technical understanding and willingness which I have not found anywhere else. Adding in his technical skills, he is a force to be reckoned with. I can recommend him without hesitation." IAM Patent 1000 - 2014
- "[...] highly recommended at the firm." Patents, Who's Who Legal Germany 2015
- "Tobias Hahn wins acclaim for his 'great technical acumen'. IAM Patent 1000 - 2012

LANGUAGES

Deutsch, Englisch, Französisch, Spanisch

ADMITTED

2004 Düsseldorf

EDUCATION

Free University of Berlin (PhD, 2006)

Higher Regional Court of Cologne (Law, 2003)

University of Heidelberg (Law, 2000)

University of Leeds (Law, 1998)