

Pharma Patents and Licensing Are Transformed by Landmark 2007 Court Decisions, Wolf Greenfield Lawyer Tells American Chemical Society

BOSTON—Sept. xx, 2007—The patent and licensing landscape for the pharma industry changed significantly in 2007 as a result of major court decisions, attorney Patrick Waller of Wolf, Greenfield & Sacks, P.C., told the American Chemical Society’s national meeting in Boston.

The US Court of Appeals for the Federal Circuit, the nation’s top patent court, issued more than 20 pharmaceutical decisions in 2007 though August, Waller pointed out. Two of them will have a lasting impact, he said.

Pfizer, Inc. v. Apotex established that certain pharmaceutical salts are “obvious,” even if more effective, and thus can’t be patented. Fact-specific analysis of unexpected properties must be undertaken.

Integra Lifesciences v. Merck KGaA confirmed the broad exemption to the infringement of method claims relating to regulatory submissions.

And there were several key decisions in 2007 affecting licensing in all industries.

MedImmune, Inc. v. Genentech, Inc. established that a licensee may challenge a patent’s validity even if the licensee is not in breach of the license agreement. The SanDisk Corp. v. STMicroelectronics decision said that a potential licensee may challenge a patent’s validity during license discussions.

“These two decisions mean that patents are now more vulnerable to being challenged in the context of a license agreement,” Waller said.

In the year’s most controversial case, KSR v. Teleflex, the US Supreme Court reinstated the “obviousness” standard and “clearly raised the bar for patentability,” said Waller, a shareholder in the firm with a PhD in biology who specializes in biomedical patents.

Wolf Greenfield, the largest law firm in New England devoted exclusively to intellectual property law, serves companies that make everything from pharmaceuticals to

software to electronics to snowboards, as well as representing academic research centers. The firm counsels clients in the areas of patents, trademarks, copyrights, designs, trade secrets, and related licensing and litigation. In 2006, the firm filed 2266 patent applications and 883 trademark applications in over 130 countries. Web:

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