



Jonathan B. Roses

Counsel

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Education

Connecticut College, BA,
Chemistry

Boston College, JD, *cum
laude*

Practice Groups

Pharmaceutical

Jonathan Roses counsels an array of clients, including life sciences companies focused on the areas of small molecule pharmaceuticals, pharmaceutical formulations, medical devices and surgical methods. Jonathan is highly skilled in conducting and managing domestic and foreign patent prosecution and pre-litigation investigations, including worldwide freedom to operate, patentability and exclusivity analyses. He is also experienced in representing clients in federal district court litigation and in post-grant proceedings before the United States Patent and Trademark Office and foreign counterparts. Jonathan has also provided regulatory advice and representation to clients relating to patent term extension and Orange Book listings under the Hatch-Waxman Act. He has a proven track record of building client relationships, teaching and mentoring junior attorneys, and providing top-notch service and results.

Prior to joining Wolf Greenfield, Jonathan served as Counsel at Wilmer Hale, where he prosecuted and managed prosecution of patent applications worldwide for domestic and foreign life sciences, universities and consumer clients in the chemical, pharmaceutical, biotechnology and materials science arts. He represented innovator pharmaceutical companies in ANDA (Hatch-Waxman) and 505(b)(2) patent infringement litigations involving Paragraph III and IV challenges of Orange Book listed patents covering several blockbuster drugs.

Before beginning his legal career, Jonathan was a medicinal chemist at Ariad Pharmaceuticals and Millennium Pharmaceuticals.

Experience

- Represented U.S. subsidiary of 140-year old global pharmaceutical company based in Japan in parallel *Inter Partes Review* (“IPR”) and federal district court Hatch-Waxman proceedings related to its antihyperglycemic drug used in the

management of type 2 diabetes. Won in a Final Written Decision on all claims of one patent after taking deposition of defendants' sole expert witness and presenting oral argument before the United States Patent and Trademark Office's Patent Trial and Appeals Board. Achieved Denial of Institution for two Petitions filed on another patent related to the same drug.

- Represented global pharmaceutical company in Hatch-Waxman patent litigation related to its subsidiary's blockbuster oncology drug. Achieved a significant victory at the Court of Appeals for the Federal Circuit when the appeals court reversed a district court finding of patent invalidity based on obviousness and remanded the case with instructions to enter judgment in favor of the client. Further representation for second wave of defendants in the United States and foreign counterpart litigation and post-grant proceedings.
- Managed a global patent portfolio and provided strategic advice on behalf of a United States-based antibiotics company. The portfolio included well over 600 matters, including nearly 200 pending applications and over 300 granted patents, and included three approved products and one clinical stage candidate.
- Provided regulatory advice related to and performed regulatory submissions to the Food and Drug Administration, including providing advice on and drafting forms for listing of patent information in the Orange Book and providing advice on, drafting, and filing Patent Term Extension applications related to both drug products and medical devices.
- Advised non-profit foundation that manages a historic house museum in Washington, D.C. on strategic trademark prosecution, brand building and protection, and collaboration agreements with brewers and food scientists to produce historic recreations of pre- and post-prohibition era beer offerings.
- Performed intellectual property due diligence investigations related to investments in and acquisitions by a range of domestic and foreign companies in the areas of small molecule pharmaceuticals, and software related to implementation of medical technology and healthcare administration. Analyses included freedom-to-operate, patentability, market exclusivity, and confirmation of status (such as pendency, enforceability,

and ownership).

Activities

- American Chemical Society (1999-present)
- American Institute of Chemists (1999-present)
- American Bar Association, Intellectual Property Section (2007-present)
- Boston Bar Association (2007-present)
- Boston Patent Law Association (2007-present), Patent Office Practice Committee Co-Chair (2017-present)

Recognition

- Massachusetts Super Lawyers' Rising Star (2015-2018)
- Harvard CopyrightX (2015)
- Boston College Law School Environmental Law Society Regulatory Skills Series (2007)