

Katten Patent Review

Katten
Katten Muchin Rosenman LLP

Perspectives on industry news, events and cases provided by Katten's patent attorneys.

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Letter From the Editor

Welcome to the inaugural issue of *Katten Patent Review*, a publication that addresses legal issues and developments in the patent arena. We strive to offer valuable analyses and resources to keep you informed on the developments that could affect your business.

This issue contains articles on patent reform legislation, ANDA specifications and unpatentable subject matter (as a result of *Alice*). Several of the topics also are available as short training programs that are eligible for CLE credit. Please contact us for more information.



—Mimi Addy
National Head of the Patent Litigation Group

Alice Sends Business Method Patents Down the Rabbit Hole

Nearly one year after the Supreme Court's decision in *Alice Corp. Pty Ltd. v. CLS Bank Int'l*, courts are striking down business method patents in record numbers and they are doing so at the outset of litigation. In cases asserting business method patents, district courts are granting more than 50 percent of motions to dismiss based on lack of patentable subject matter. The Patent Trial and Appeal Board is finding more than 75 percent of challenged business method claims to be unpatentable. In view of the Supreme Court's *Alice* decision and these first-year statistics, what can patent owners do to survive these challenges? What can accused infringers do to increase their chances of invalidating business method patents?

[Learn More.](#)

More Patent Reform, But Do We Need It?

Proposed legislation purports to address perceived abuses by patent assertion entities. But is it necessary? After the US Supreme Court's decisions in *Octane* and *Highmark*, district courts are increasingly granting attorney fees to prevailing parties. Is a fee-shifting law needed?

Katten partner **Eric Cohen** addresses these questions in a recent *IPO Law Journal* article. He also asks if recent amendments to the Federal Rules of Civil Procedure requiring that discovery be proportional to the needs of the case, coupled with patent local rules and the patent pilot program, obviate the need for legislatively imposed case management procedures for patent cases.

The article addresses the ongoing debate of whether the Patent Trial and Appeal Board should continue to apply the broadest reasonable interpretation standard for claim construction in inter partes review proceedings.

[Read the article.](#)

A Winning Proposition: Amendments to ANDA Specifications

Since the enactment of Hatch-Waxman, patent litigation has been an integral aspect of the pharmaceutical industry. Katten attorneys **Martin Masar** and **Thomas Maas** recently offered their perspectives on a strategy for certain patent infringement litigation involving generic drugs. Their article, in *Intellectual Property Westlaw Journal*, provides tips and describes potential pitfalls for amendments to Abbreviated New Drug Applications (ANDA) to avoid infringement. These include directly addressing the inquiry, ensuring that specifications are wholly inconsistent with one or more claim element, and accounting for the timing of the amendment.

[Read the article.](#)

Polymorphous Perversity? Lessons and Landmines

Under Hatch-Waxman, polymorphs of an active substance are considered the same drug, but pharmaceutical companies often patent each one. This can result in litigation before the FDA approves generic versions. Generic manufacturers have the option of trying to design around polymorph patents, in addition to pursuing an invalidity challenge.

In a recent issue of *Pharmaceutical Law & Industry Report*, Katten attorneys **Brian Sodikoff** and **Martin Masar** discuss the risks and rewards of patenting polymorphs for both generic and brand firms. Brian and Martin review more than a dozen cases that show that this area is complex, fact-specific, and full of potential landmines for generic and brand pharmaceutical companies alike.

[Read the article.](#)

Katten's [Patent Litigation team](#) represents both plaintiffs and defendants in patent infringement actions filed in federal jurisdictions throughout the United States and before the US Patent and Trademark Office (USPTO) and the US International Trade Commission. Our clients come from a variety of industries, including biotechnology, pharmaceuticals, life sciences, electronics, software, e-commerce and telecommunications. Our attorneys have litigated virtually every type of patent infringement case.

Katten's Federal Circuit team has handled more than 50 cases before the US Court of Appeals for the Federal Circuit originating from the federal district courts, the USPTO—including the Patent Trial and Appeal Board—and the International Trade Commission (ITC). Our attorneys have an experienced understanding of this specialized court and its precedent. Many of our practitioners have advanced technical backgrounds, including members who serve on the Federal Circuit Advisory Council and in leadership positions in the Federal Circuit Bar Association.

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