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IP Law Group Gives Fed. Circ. Input In Ariad Case

By **James Armstrong**

Law360, New York (October 19, 2009) -- The New York Intellectual Property Law Association has filed an amicus brief in the appeal of the Ariad Pharmaceuticals Inc. patent suit — which could make patents easier to prosecute and tougher to invalidate — saying the court should look to the enablement requirement to settle the case.

NYIPLA filed the brief on Thursday with the U.S. Court of Appeals for the Federal Circuit, which is holding an en banc hearing of the suit.

The case, an infringement suit over osteoporosis drug Evista and septic shock treatment Xigris, is asserting a patent is valid so long as it enables any person skilled in the art to make and use the claimed invention, even if a given application is not explicitly described in writing.

The association, which includes more than 1,600 attorneys whose professional interests and practices lie principally in intellectual property, said in the brief that without the modern description requirement, applicants would be able to broaden their claims to embrace subject matter they did not invent.

Any subject matter put off-limits to the public by a patent grant must be commensurate with the public's enrichment by the invention's advance over prior art, according to the brief.

Written descriptions play a role by preventing applicants from later claiming more than they actually invented, the association says.

However, in the present case the work done by the inventors of the patent-in-suit was of great scientific and technical merit, NYIPLA says.

The inventors did not just write down a hoped-for solution to a known problem, but seemingly opened doors to a new class of important drugs, according to the brief.

The proper balance between competing theories about whether broad claims spur innovation or stifle it is a matter of legitimate dispute, the association maintains, but the case should be resolved on its own merit in a way that does not subvert the long-established role of the written description requirement.

“The position we take in the brief is that there is a debate going on that has occurred in patent law for many years, which is the proper balance of rewarding innovation by the grant of broad claims, versus stifling innovation by granting overly broad claims,” said Charles Weiss, chair of the NYIPLA amicus committee.

That debate has been going on in the biotechnology area for many years now, Weiss said.

The proper way that debate should be looked at and resolved is through the careful application of the enablement requirement, not by upending more prosaic but still very important rules surrounding written description requirements, he maintains.

“Don't throw the baby out with the bathwater,” Weiss said.

Other amicus briefs in the matter have been filed by law professors Mark Janis, Timothy Holbrook and Christopher Holman, as well as others.

Fried Frank Harris Shriver & Jacobson LLP and Kaye Scholer LLP represent Ariad in the case. Finnegan Henderson Farabow Garrett & Dunner LLP represents Eli Lilly. Counsel were not immediately available for comment.

The case is Ariad Pharmaceuticals Inc. et al. v. Eli Lilly & Co., case number 08-1248, in the U.S. Court of Appeals for the Federal Circuit.

--Additional reporting by Erin Coe