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IP Lawyers Are Paying Close Attention to Supreme Court's Upcoming Term

It's a big day for MoloLamken partner Jeffrey Lamken, who is counsel of record to petitioners Amgen and Abitron.

BY SCOTT GRAHAM

What You Need to Know

- The Federal Circuit has been using patent's law of enablement to limit broad genus claims.
- Amgen says the Federal Circuit has added requirements that aren't in the statute.
- The trademark case asks whether $90 million in damages is appropriate when only $3 million sales were in U.S.

This article is adapted from Scott Graham's Nov. 4 briefing.

The Supreme Court of the United States' upcoming term just got a lot more interesting for intellectual property lawyers, and for MoloLamken partner Jeffrey Lamken in particular.

First, the justices decided to wade into the Federal Circuit's handling of genus claims in biopharma cases.

Genus claims are found in patents that don't claim a specific compound, but rather a group of compounds that perform the same function. Genus claims block competitors from getting around infringement by making a trivial change to a patented compound. But a broadly claimed genus also risks shutting down competition altogether.

(Photo: Diego M. Radzinschi)

MoloLamken partner Jeffrey Lamken.

Section 112 of the Patent Act requires that inventors describe "the manner and process of making and using" an invention. This is also known as the enablement requirement.

The question presented in *Amgen v. Sanofi* is whether Section 112 requires that persons of skill in the art are able to identify and make all of the potential embodiments of an invention without undue experimentation.

The Federal Circuit has used Section 112 to place limits on the genus that drugmakers can claim, costing the industry some recent mega-verdicts. Amgen Inc. has won its dispute with Sanofi over cholesterol-busting drugs twice at trial, only to lose each time on appeal.

"The impact on innovation is devastating, particularly for critical biotech and pharmaceutical innovations, as the Federal Circuit invalidates genus claims based on perceived size alone," Amgen argued in its cert petition, on which Lamken is counsel of record.

The justices had asked Solicitor General Elizabeth Prelogar's office for her recommendation last spring, and the SG recommended against taking it. Kirkland & Ellis represents Sanofi.

The court also granted cert in the trademark extraterritoriality case *Abitron Austria v. Hetronic International*, this time agreeing with Prelogar's recommendation to take the case.

Hetronic International Inc. won a $90 million jury verdict against its former European distributor, Abitron Austria GmbH, for selling copycat radio remote controls for heavy-duty construction equipment.

Abitron is based in Austria, and 97% of the sales occurred outside the United States. But the Tenth Circuit ruled that remaining 3%—a few million dollars' worth—had a "substantial effect" on U.S. commerce, and that all of the foreign sales would have flowed into the U.S. but for the infringement. So all of the sales were fair game.

Abitron argues and the solicitor general agrees, that the Lanham Act does not support damages for foreign conduct that causes no confusion for U.S. consumers.

"Awarding damages for 100% of worldwide sales on the theory that 3% of them implicate the Lanham Act would allow a very small tail to wag a very large dog," Arbitron's counsel of record—who else?—MoloLamken partner Jeffrey Lamken argued in the company's cert petition.

Hetronic's Jenner & Block counsel argue that Abitron used fake letterhead and email addresses as part of an acknowledged scheme to "attack [Hetronic] at their doorstep in the U.S.," and that the company has thumbed its nose at an injunction imposed by the Florida district court.

Jenner partner Matthew Hellman is Hetronic's counsel of record.