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Q&A With Choate's Eric Marandett

Law360, New York (June 06, 2013, 4:01 PM ET) -- Eric Marandett co-chairs Choate Hall & Stewart LLP's litigation department and intellectual property litigation practice group in Boston. He focuses his practice on representing biotech, pharmaceutical and technology companies in high-stakes patent litigation and other IP and commercial disputes.

Q: What is the most challenging case you have worked on and what made it challenging?

A: I spent more than a decade (on and off from 1997 until 2009) working on the long-running patent litigation between Amgen Inc. and Transkaryotic Therapies Inc. (now part of Shire) and its partner Hoechst Marion Roussel Inc. (now part of Sanofi) relating to erythropoietin (EPO) products. That litigation unquestionably was the most challenging case I have worked for a number of reasons. First, the stakes were huge (EPO is a multibillion-dollar market). Second, the issues were complex and, in many cases, groundbreaking. The factual record in the case spanned more than 15 years and covered the earliest days of the biotech industry. The legal issues were both fascinating and unusually diverse even for a case of such magnitude. The case provided incredible exposure to the biotech industry and to the myriad of difficult questions of patent law that can arise when dealing with truly innovative and standard setting technology on both sides.

The case also presented a fascinating case study in personalities. Our clients and adversaries were brilliant scientists and innovative thinkers who demanded the most from their counsel. We also had to navigate through the sometimes disparate strategic thinking of multiple law firms on both sides through three separate district court trials and three trips to the Federal Circuit. To this day, I can trace much of what I've learned about patent litigation to issues and challenges I saw over the course of that litigation. I also worked with and against some extraordinarily talented lawyers and clients from whom I learned many lessons that I continue to rely on in my practice today.

Q: What aspects of your practice area are in need of reform and why?

A: Last year, Congress implemented the most sweeping patent reform of a generation. The America Invents Act fundamentally altered our patent system by moving us from a first-to-invent to first-to-file approach. The act also added new procedures including post-grant review whereby anyone can challenge the validity of a patent within the first nine months after issuance; a new re-exam procedure by which flawed patents can be challenged on various grounds; elimination of the "best mode" defense in patent litigation; and a new supplemental examination designed to limit the number of inequitable conduct (fraud on the patent office) challenges to patents.

For me, the big question is not what areas are in need of reform, but whether the new reforms will work. It will be an exciting area of practice over the next three to five years as we all begin to acclimate to this statutory paradigm.

Q: What is an important issue or case relevant to your practice area and why?

A: In recent years, the Federal Circuit and U.S. Supreme Court have issued a number of seminal decisions affecting intellectual property. Since I spend most of my time working in the biotech and pharmaceutical industry, one of the most closely watched issues at present is the Supreme Court's impending review of so-called "pay-for-delay" settlement agreements between branded pharmaceutical companies and generics.

In most circumstances, courts actively encourage settlement between litigants, particularly in complex high-stakes cases that drain judicial resources and create uncertainty in the marketplace. However, in the arena of patent litigation between branded pharmaceutical companies and generics, unusual economic considerations have produced intense government (particularly the Federal Trade Commission) skepticism about the competitive impact of settlements involving payments by branded companies to generics in exchange for delayed market entry. These factors make settling patent infringement cases in this context unusually complicated. The FTC generally challenges any settlement that involves a substantial payment by a branded company to a generic even where the agreement also permits the generic to enter the market prior to expiration of the litigated patent.

These "pay-for-delay" settlements are the subject of recently introduced legislation co-sponsored by Sen. Amy Klobuchar, D-Minn., and Sen. Chuck Grassley, R-Iowa. The Supreme Court is considering the issue this term in the case of The FTC v. Watson Pharmaceuticals Inc., involving a testosterone replacement therapy marketed by Solvay Pharmaceuticals Inc. under the trade name AndroGel. How this case is decided and the fate of the "pay-for-delay" bill in Congress are likely to have far-reaching effects on pharmaceutical patent litigation going forward.

Q: Outside your own firm, name an attorney in your field who has impressed you and explain why.

A: I work with a number of extraordinarily talented in-house lawyers in the biotech and pharmaceutical space who display an unusual mix of pragmatic business judgment coupled with a keen understanding of the economic drivers of this industry. Two who stand out in my mind are Dan Darnley, chief IP counsel at Millennium and Kerry Flynn, chief IP counsel at Shire Human Genetic Therapies, Shire's biotech division in Massachusetts. Working with each, I have been impressed by their adept ability to balance their client's insistence on results with delivering effective, pragmatic legal advice. Achieving this balance is no small task in an incredibly demanding and complex area of practice.

Q: What is a mistake you made early in your career and what did you learn from it?

A: The most important advice I now give young litigators is to develop a presentation style that fits your own personality. When I was a junior lawyer, I often sought to emulate other litigators I admired. I quickly learned, however, that success for me would come not from mimicking others, but from developing a style that suited me. I see many styles that work effectively. But, what never works is attempting to be someone you are not. That is a lesson I learned early and that I think is critically important for all successful litigators.

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