

Eric J. Marandett

Practice Group Leader

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“very business-savvy and [clients’] first port of call for litigation”
Chambers USA



Eric Marandett represents biotech, pharmaceutical and technology companies in high stakes patent litigation and other intellectual property and commercial disputes. Mr. Marandett’s approach to litigation combines a keen business savvy with the courtroom skills of a seasoned trial lawyer. In 2017, Mr. Marandett was named to *Who’s Who Legal’s* list of top patent attorneys and 2017 Boston “Lawyer of the Year” for Intellectual Property Litigation. He was named the 2015 Boston “Lawyer of the Year” for Patent Litigation by *Best Lawyers*, and was included in the *Patent Expert Guide* in 2015 and 2017, placing him among “the world’s leading practitioners” in patent law. He is listed in the *Massachusetts Super Lawyers Top 100* and is also listed in *Chambers USA*. He has been listed in *The Legal 500*, and named a World’s Leading Patent Litigator by *IAM 250*, a World’s Leading Patent Practitioner by *IAM Patent 1000* and an “IP Star” by *Managing Intellectual Property*.

Mr. Marandett co-chairs the Firm’s Intellectual Property Litigation Practice Group. He is also a member of the firm’s Executive Committee.

EDUCATION

University of Pennsylvania
Law School JD, 1992

Tufts University
magna cum laude, BA, 1988

PRACTICE FOCUS

Complex Intellectual Property Disputes

Patent infringement (including Hatch-Waxman litigation), licensing disputes and other intellectual property litigation on behalf of major pharmaceutical and biotech companies and clients in the high tech industry.

Complex Commercial Litigation

Securities and antitrust litigation, unfair competition, theft of trade secrets, state and federal investigations of Medicare and Medicaid Fraud, anti-kickback and drug record keeping violations.

Intellectual Property Counseling & Due Diligence

Assessment of freedom to operate and patentability, valuation of intellectual property, Orange Book and other regulatory and strategic questions in connection with collaborations, acquisitions and joint ventures, particularly in the life sciences industries.

ADMISSIONS

Massachusetts

U.S. District Court,
District of Massachusetts

U.S. Court of Appeals,
First & Federal Circuits

U.S. Supreme Court

PRACTICE AREAS

Complex Intellectual
Property Disputes

Complex Commercial
Litigation

Life Sciences

Antitrust

Intellectual Property
Protection

REPRESENTATIVE ENGAGEMENTS**PATENT LITIGATION**

- Currently representing Shire before the U.S. Patent Trials and Appeal Board in *Inter Partes* Review filed by Green Cross Corporation.
Green Cross Corp. v. Shire Human Genetic Therapies, Inc., PTAB
- Currently representing Shire in Hatch-Waxman litigation involving generic versions of ADDERALL XR®.
Shire LLC v. Abhai LLC, D Mass
- Co-Lead Counsel to Momenta in patent infringement action relating to innovative methods of processing therapeutic polysaccharides. Obtained preliminary injunction precluding sales of generic enoxaparin by Amphastar Pharmaceuticals.
Momenta v. Amphastar et al.
- Lead counsel for Wyeth (now Pfizer) in patent infringement litigation involving industry leading genetically engineered porcine circovirus vaccines.
Wyeth v. Intervet, Inc and Boehringer Ingelheim Vetmedica, Inc, D Del
- Lead counsel for Millennium in patent infringement action relating to combinatorial phage display libraries.
Pieczenik v. Abbott Laboratories, et al., D NJ
- Lead counsel for Wyeth in Hatch-Waxman patent action brought against Teva relating to prescription sleep aid marketed by King.
King Pharmaceuticals and Wyeth v. Teva, D NJ
- Counsel to Momenta in patent infringement action relating to innovative methods of processing therapeutic polysaccharides.
Momenta Pharmaceuticals, Inc and Sandoz, Inc v. Teva Pharmaceuticals, Ltd, et al, D Mass
- Lead counsel for Iovate in patent infringement action relating to novel nutritional supplements.
Iovate Health Sciences v. Allmax Nutrition, D Mass
- Lead counsel for Cypress and Hawthorn in patent infringement relating to cough and cold medicine.
Tiber Laboratories, LLC v. Hawthorn Pharmaceuticals, Inc, D Northern District of Georgia

Tiber Laboratories, LLC v. Cypress Pharmaceuticals, Inc, Southern District of Mississippi Jackson Division
- Counsel to Eisai, Inc and Eisai Research Institute of Boston, Inc (collectively "Eisai"), one of 11 major pharmaceutical companies sued for infringement of four patents to certain cell-based screening assays.
Housey Pharmaceuticals, Inc v. Abbott Pharmaceutical Corp et al., D Del
Counsel for Eisai Co, Ltd

- Obtained judgment on appeal reversing \$34 million verdict against Powerscreen.
The Read Corporation, et al v. Powerscreen International, PLC, et al, D Mass
- Lead counsel for Sapidyne in patent infringement action involving antibody affinity assays.
Sapidyne Instruments, Inc v. Gyros US, Inc, D Mass
- Counsel for Genetics Institute in patent infringement and breach of contract litigation relating to development of recombinant Factor VIII.
Genetics Institute v. Baxter International, Inc, D Mass
- Along with co-counsel, represented defendants TKT and HMR in patent infringement litigation brought by Amgen to prevent TKT from commercializing its patented gene-activated erythropoietin product.
Amgen, Inc v. Hoechst Marion Roussel, Inc and Transkaryotic Therapies, Inc, D Mass
- Along with co-counsel, represented Berlex Laboratories in patent infringement litigation involving recombinant beta interferon for treatment of multiple sclerosis.
Biogen v. Berlex Laboratories, D Mass

Other Intellectual Property and Commercial Litigation

- Lead counsel to Celgene in breach of contract litigation regarding exclusive license agreement related to Revlimid and Pomalyst.
Children's Medical Center Corporation v. Celgene Corporation, D Mass
- Counsel to Shionogi Pharmaceuticals in contract action related to manufacturing and marketing of Fenoglide.
HCRP v. Shionogi Pharmaceuticals, NY Ct
- Counsel to Alnylam Pharmaceuticals in trade secret misappropriation lawsuit brought against Dicerna Pharmaceuticals.
Alnylam Pharmaceuticals, Inc. vs. Dicerna Pharmaceuticals, Inc.
- Counsel to AlCana in trade secret litigation brought against AlCana and its research collaboration partner Alnylam Pharmaceuticals by Tekmira Pharmaceuticals Corp. Technology at issue involves novel lipid nanoparticles used as drug delivery vehicle for Alnylam's short interfering RNA therapeutics.
Tekmira v. Alnylam & AlCana
- Represent Adimab in patent interference dispute with Dyax Corp. relating to antibody display.
Adimab, LLC v. Dyax Corp.
- Lead counsel for Wyeth in breach of contract dispute relating to Celera's genomics database products.
Applera Corp., d/b/a Celera Genomics Group v. Wyeth, Montgomery County Maryland Circuit Court
- Counsel to Astellas Pharma in breach of contract and unfair competition litigation relating to drug formulation collaboration.
Alamo Pharmaceuticals v. Astellas Pharma Inc, Central D of CA

- One of three partners representing Genetics Institute in contract dispute relating to the manufacture of recombinant Factor VIII for treatment of hemophilia A. *Baxter HealthCare, Inc v. Genetics Institute, Inc*, Delaware Chancery Court
- Counsel to KiOR in breach of contract and misappropriation of trade secrets litigation involving biomass catalytic conversion technology. *KiOR, Inc v. George Huber, et al.*, D Mass

PUBLICATIONS AND PRESENTATIONS

- "Fundamentals of Taking and Defending Depositions 2018," *speaker, Practicing Law Institute*, March 2018.
- "In the Hot Seat—Upcoming Cases in the Supreme Court and Federal Circuit," *moderator, BIO IPCC Fall Conference*, November 2017.
- "Licensing and Collaboration Agreements: Traps for the Unwary," *moderator, BIO IPCC Fall Conference*, November 2016.
- "The Supreme Court Speaks...Again," *moderator, BIO IPCC Fall Conference*, November 2015.
- "Ariosa V. Sequenon Signals Trouble Ahead For Life Sciences," *co-author, IP Law360*, November 2015.
- "Will The Pendulum Swing Back In IPR Proceedings?," *co-author, IP Law360*, April 2015.
- "Safe Harbor Provisions Broadly Construed, Due for High Court Review, Panelists Say," *moderator, BIO IPCC Fall Conference*, November 2014.
- "Secondary Consideration for Pharma Patents get 2nd Look," *co-author, IP Law360*, November 2014.
- "How Federal Circuit's Commil Ruling Could Affect Drug Patents," *co-author, IP Law360*, December 2013.
- "Trade Secrets in Life Sciences: Challenges and Opportunities in a Collaborative and Mobile Environment," *co-author, Bloomberg BNA*, November 2013.
- "Is There a New Paradigm for Indirect Infringement?" *moderator, BIO IP Counsels Committee Fall Conference and Meeting*, November 2013.
- "Adopt IP Protections to Ensure Regulatory Exclusivity for Orphan Drugs," *co-author, ACC Docket*, August 2013.
- "Q&A with Choate's Eric Marandett," *featured, IP Law360*, June 2013.
- "Managing Outside Counsel Efficiently and Effectively," *panelist, The Consero Group's Pharmaceuticals & Biotechnology IP Forum*, Palm Beach Garden, FL, December 2012.

- “The Trade Secret Minefield,” *moderator, BIO IP Counsels Fall Conference and Meeting*, Charleston, SC, November 2012.
- “Avoiding Trade Secret Litigation in the Life Sciences,” *co-author, IP Law360*, August 2012.
- “Finance & BD: Strategies for Building & Realizing Value in the Evolving Biotech Landscape,” *panelist, MassBio*, April 2012.
- “Preempting Patent Litigation With 3rd-Party Submissions,” *co-author, IP Law360*, February 2012.

PROFESSIONAL AND COMMUNITY INVOLVEMENT

Mr. Marandett is a member of the American Bar Association Intellectual Property and Litigation sections, the American Intellectual Property Law Association, the Boston Bar Association and the Massachusetts Bar Association. In addition, he is counselor of the Boston IP Inn of Courts. Mr. Marandett is also active in the Dana Farber Leadership Council. He is a past member of the firm’s Executive Committee.