

AVOIDANCE OF LITIGATION



REBUTTAL OF AGGRESSIVE ASSERTIVE LICENSING APPROACH

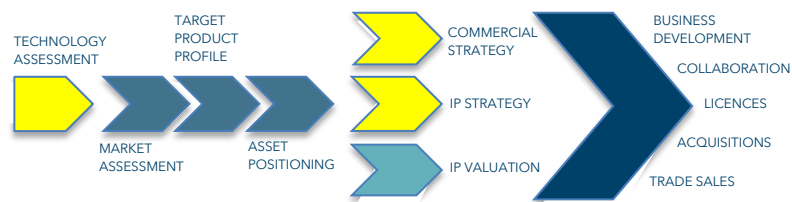
IP legal and patent office processes can sometimes be used to great effect to defend against well-funded and apparently powerful commercial aggressors. In a classic “David and Goliath” scenario, a major European company with a history of forceful assertive licensing tactics in the area of drug delivery contacted our client with the threat of litigation unless our client paid a retro-active annual licence fee and future royalties on its product. The product was in Phase III clinical trials at the time. An independent Patent Opinion confirmed that the aggressor’s patent claims were all in force and appeared to cover the use that our client was relying on for its product.

We examined the patent claims and demonstrated that the allegedly infringed claims were not supported by any supporting disclosure in the patents; in other words, the apparently relevant claims were likely invalid.

We advised our client on a strategy whereby the client would stay a request for a UK patent office re-examination of the aggressor’s claims in return for a royalty-free freedom to operate licence in perpetuity from the aggressor. Thus, the small company was not only able to defend itself against the much larger corporate player (and do so relatively cheaply), it also secured freedom to operate IPRs which allowed it to continue development of its product without any threat of litigation.



The workplan:



CASE STUDY NOTES

The Patent Opinion requested in this case was confined to the question of legal status of the disputed claims. We took it further, questioning the validity of the claims. This drove us to a very different conclusion than might otherwise have been reached.

CONTACT US

www.murrayinternationalpartners.com/CONTACT