

To Successfully Enforce Your Patent Do Not Let Form Triumph Over Substance While Writing The Patent

Chemical and pharmaceutical companies protect their investment in research and development and the future of the companies by securing patents on their inventions. Patents help you resist competition. Success or failure of the company often depends on the strength of the patent. The words in the patent document must meet rigid formality requirements under the patent laws. Even if the invention covered by the patent is a fantastic one, the court will throw out the patent if it violates any one of the formality requirements.

The patent document is normally divided into several sections, for example, one section describing the background of the invention, another section describing the invention as a summary, another section describing the drawings of your invention, yet another section describing in detail how to make and use the invention, and a final section that lists various aspects of your invention in numbered sentences, typically from 1 to 20. These numbered sentences or claims form the most important section of the patent.

It is the claims that define the invention. When a competitor wants to design around your invention, he will look to the language of the claims. When you sue someone for infringing your invention, the court will look at the claims in your patent. It is clear that the claims are of paramount importance.

The patent contains independent claims and dependent claims. Dependent claims will refer back to an earlier claim. Independent claims do not refer back to any other claim. For example, dependent claim 2 will refer back to independent claim 1. When dependent claims refer back to other claims, they should meet certain rigid formality requirements, one of which is that the dependent claim cannot be broader in scope than the claim it refers back to. Thus, for example, if claim 1 describes a drug in acid form or its salt form, claim 2 can describe the drug in salt form. However, if claim 1 describes only the acid form, claim 2 cannot describe the salt form. If it so describes, then claim 2 will be broader than claim 1, which is forbidden under the patent laws.

In a recently concluded battle between pharmaceutical giant Pfizer Inc. and generic drug maker Ranbaxy Laboratories, the generic drug maker was able to knock out a patent that covered the blockbuster drug Lipitor. The patent claim that Pfizer asserted against Ranbaxy was held invalid by the high court. Here, Pfizer asserted claim 6 describing a calcium salt of the drug against the opponent. Claim 6 referred back to claim 2 which described an acid form of the drug but not the salt form. The high court held that claim 6 cannot properly refer back to claim 2. The harsh result faced by Pfizer is somewhat surprising because it was believed by many that a court would not look at the form over substance, just as the lower court did. The lower court was reluctant to find fault with the patent claim.

The high court opinion emphasizes the fact that filing a winning patent requires careful consideration of various legal concepts including the intricate formality requirements of the patent law.

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